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Editors:  
Thomas Dreier  
Axel Metzger  
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# Regulatory Aspects of Open Access

by **Nikolaus Peifer**, Cologne

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**Keywords:** Open Access; Definition; Regulation; Orphan Works; Academic Publishing;

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## A. Open access and regulation<sup>1</sup>

1 Open access (OSS) is a philosophy as well as a system of self-regulation that helps to organise technical or intellectual information. It has developed within existing laws as a reaction to an over-exclusive tendency in constructing and understanding property laws in intangibles. OSS follows but shifts the logic of the law of licenses.<sup>2</sup> Licenses are currently used to exclude but also to allow usages against payment and further obligations of the licensee. Open access drops the payment but keeps the obligation. Obligations are not imposed to exclude but to keep the system open and usages free (“copyleft” instead of copyright). As far as information or content is protected by IP laws, the system works like IP laws by transforming the logic of the property right (again, copyleft instead of copyright). As far as information is not protected, it works like a contract.

2 In both cases, open access models exist within a regulatory frame because they have to operate within national law systems. Certain uses cannot be allowed or forbidden because legal provisions may interfere. Other uses may be controlled only with the help of national laws. We may therefore distinguish open-access-hostile and open-access-friendly rules. The first type concerns state rules that may be used as a barrier to granting access to content. The second type relates to rules that help open access to be successful. Hostile rules include the following:

- § binding laws such as coercive moral rights legislation that may allow or enforce what participants may be willing to do (i.e. the distortion of a literary work);
  - § patent laws that may restrict the publication of information before filing because inventions lose their patentability if they lack novelty;<sup>3</sup>
  - § laws to protect property rights of third parties (neighbouring rights) that may restrict the use of content for OA platforms (i.e. audio and visual content);
  - § laws to protect property positions of unknown third parties, as in the case of orphan creations, that may do the same.
- 3 Friendly regulation pertains to the following:
- § the enforcement of contracts and licenses through legal rules and the court system;
  - § laws safeguarding priority (attribution of authorship);
  - § laws safeguarding authenticity (integrity rights);
  - § transparency rules (consumer protection, information rules).

- 4 Regulatory assistance for open access is needed where hostile state rules or the nonexistence of friendly rules jeopardize the goals of the philosophy.

## B. Regulatory assistance of open access goals

### I. A short definition

- 5 The concept of open access comes from the software world.<sup>4</sup> In this environment its main task is to uncover technical information held secret by copyright provisions that were enacted to restrict decompilation uses.<sup>5</sup> In the field of academic publications, open access is commonly defined as “making scientific articles freely accessible on the web.”<sup>6</sup> This gives rise to an access claim regarding any kind of scientific or academic knowledge, whether copyrightable or not, originally secret or pre-published. IP laws traditionally protect the interest of the contributor to keep information secret or at least to control the degree of publicity or restrict the audience the content is aimed at. Law usually does not force the contributor to disclose knowledge. A general access right to private information<sup>7</sup> is only given in situations in which there is a legal relationship between the party holding the information and the party interested in that information.<sup>8</sup> A duty to disclose knowledge will only hold if there is a special legal duty, such as the duty to inform consumers about features of a product.<sup>9</sup> Nondisclosure is the principle; access requires consent or regulatory force. If regulation to force access is unwanted, incentives to provide information are needed.

### II. How to convince contributors to uncover secrets

- 6 The traditional incentive mechanism works by giving gratification. This is the technique used in patent law where technical information has to be disclosed in exchange for a property right. The mechanism is also used in Sec. 4 subs. 2 of the GPLv3 where the right to convey copies of a program at a price is bound to the duty to deliver the source code.<sup>10</sup> Trade secrets will be uncovered only for a price. Scientific knowledge may be disclosed if a contract obliges the knowledge provider to do so. Other incentives might be that the contributors receive access to knowledge themselves or – typical for academics – receive a reputation from the academic market if they publish their work. The latter mechanism does not work if the publication is organised by a commercial publisher who cannot live from reputation alone but needs direct or indirect financing through advertising to recoup organisational costs,

such as with players like Google. Voluntary granting of access to knowledge therefore needs incentives.

### III. How to convince publishers and other right holders to cooperate

- 7 If there are no sufficient market incentives, regulation is required. This has necessitated regulation with regard to special obligations in the relationship between academics and their employing institution and between academics and publishers. The relationship between academics and the employing institution is of particular importance in a situation in which the institution pays not only for the production of knowledge but also for its distribution among academic consumers such as students and researchers.<sup>11</sup> This is the rule in the public and the private university sector. Work-for-hire rules might mean that the institution is the original owner of academic results, but the rule does not work in most continental European systems in which individual authorship is the principle. A legal duty to publish is hardly enforceable and in some jurisdictions will even violate constitutionally protected academic freedom, which encompasses the freedom not to publish.<sup>12</sup> This constitutional position of academics is also violated by a legal duty to offer publications to a university-owned or -run repository.<sup>13</sup> The place of publication is vital to the reputation of the academic. If an academic decides to publish in a commercially run, renowned, peer-reviewed journal, the university should not interfere. This is in harmony with copyright law because the moral right to first publication<sup>14</sup> encompasses the right to choose when and also where to publish.<sup>15</sup> Again, moral rights protect the personal and academic reputation of the author.<sup>16</sup> This does not preclude a contractual obligation to publish in certain journals because this preserves the author’s will. Therefore, no objections should be made if the academic applies for a funded research program and receives the funding on the premises that the results have to be published by an open access mode.
- 8 An author-friendly model reserves for the academic the right to publish on the green road of open access.<sup>17</sup> Usually commercial publishers will be reluctant to license such a right to the author. Therefore, a binding copyright provision would be needed to protect the author’s decision. Such a provision would not be an exception or limitation to copyright;<sup>18</sup> in the absence of a contractual obligation to an employer, the author retains the right to decide on the secondary publication of the author’s work.<sup>19</sup> However, the solution would at least touch upon the publisher’s freedom to contract and therefore needs a justification. The suggestion that has been discussed internationally calls for a solution in which the author retains a secondary publication right af-

ter a maximum waiting period of six months if the author publishes in a format that differs from the typographical format of the original publication.<sup>20</sup> This solution has been attacked as unsuitable for the STM world,<sup>21</sup> but I do not share this view. In most cases, STM publications will report data and facts. The expression used in these publications is very often far from being original. I would even argue that many of the texts are not even copyrightable because the reporting of facts and data does not fall into the realm of copyright law.<sup>22</sup> For social sciences and humanities, the six-month period should be adequate to protect the author's and publisher's interests as far as journal contributions are concerned. Even if the publisher's interests were harmed by such a regulation, the state is not barred from fostering and financing the free access to research results achieved with the help of public funding as long as the state does not exclude private entities from those resources.

#### IV. How to safeguard integrity and authenticity

- 9 Open access philosophy should not be interested in facilitating fraud and deceit. Authenticity and integrity of publications should be in the vital interest of the research and the publication system. These aims are backed by moral rights legislation which, however, is in a distressing state of international and European harmonisation. With the sole exception of Article 6bis RBC, international law has more or less ignored the moral interests of authors.<sup>23</sup> This is deplorable because the right to attribute the work to a certain source or author and the right to keep it intact in its original form, or at least clearly mark where modifications to the original form have been made, is vital to a legal system in which individuality is the highest value. It is also vital to a system in which truth and integrity in research have to be defended against irresponsible behaviour and misappropriation. It is no wonder that current open access license schemes and the Berlin Declaration both bind the license to use content to the obligation to indicate its source, therefore granting attribution to the author or a team of authors.<sup>24</sup>
- 10 Integrity rights are a more complex issue. All licenses allow for modifications. The GPL License is concerned with safeguarding the integrity of the original version by binding the license to an obligation to mark any changes made during modifications of the version received.<sup>25</sup> The Creative Commons License gives the author the opportunity to allow for changes, but safeguards the author's integrity right only by the obligation to clearly attribute the new version to its author and cite the name of the author of the original work. The DPPL License is mindful of the fact that modification rights may not allow for distortions and mutilations. Therefore, it follows

the path of the other licenses with regard to attribution rights (§ 6 subs. 2), but allows modifications only if "the personal interests of the original authors are respected" (§ 2 subs. 1). To safeguard these interests, the author of the original may not be cited as the author of the derivative, and the work has to be given a new title.

- 11 It is obvious that these peculiarities do not fully safeguard integrity interests. It is also obvious that they do not fully protect the authors of derivative works. In the past, authors have not aggressively fought against mutilations. The danger of copyright abuses may be much weaker in this regard than the ethical standards of the academic community. As a result, further regulation is not needed on the national level of most continental European copyright laws. However, the usual gap towards common law countries is still a concern.

#### V. How to enable access to works of known right holders

- 12 A huge problem rests with the protected content that has not been submitted to an open access license. The future of electronic content is not the static text and the pdf file. The full potential of network capacities can only be activated if texts, data, pictures and audiovisual or sound files are combined. Electronic content will have to develop into multimedia content.<sup>26</sup> The main problem these days is how to combine text with pictures, especially photos. Given the fact that most photos are protected by copyright or a neighbouring right, open access models risk remaining text-based but image-free. Access to protected content will not be available by the existing limitations to copyright as typically citation rights or free use rights will not give access to mere illustrative use of photos.<sup>27</sup> This is especially vibrant when photos are used to illustrate the situation depicted but not to explain the photo use. Citations rights usually will only be granted if the author of the citing work explains the cited work. What can be seen on the photo, however, is not the cited work but the photo itself. German copyright law at least is hopelessly outdated and overprotective in this regard. Researchers in practice have never refrained from using pictures in their lectures or at conferences. And they should not be barred from doing this by a narrow interpretation of citation rules with regard to their publications. Regulation may not be necessary if courts grant wider freedoms not only for artistic<sup>28</sup> but also for academic and educational use.
- 13 The problem remains vital with respect to audio and visual content that has a mere illustrative function, which is helpful but not necessarily needed to explain a problem. This problem calls for a regulatory approach on the European level. Rights management

regulation needs to find a way to get easy access to affordable license conditions through collective societies. One-stop shopping is vital for granting access to cultural content.

## VI. How to enable access to works of unknown right holders

- 14 The “orphan works” problem is still unsolved despite the scrutiny it has received at the national and international level. There is a clear regulatory problem.<sup>29</sup> It consists of defining what orphan works are and in granting access to the usage of these works. A brief definition reveals that orphan works are works whose “right holders cannot be identified or, if they can be identified, cannot be located” with reasonable and careful efforts.<sup>30</sup>
- 15 Roughly three models are discussed to grant access to these works:
  - § granting of a non-exclusive license for any user who is willing to pay a license fee (Canadian model), either through a government agency or through a collective society from the field the work belongs to;<sup>31</sup>
  - § extension of the collective management system to orphan works (Nordic model);<sup>32</sup>
  - § liability privilege for users who can show and prove that they have diligently searched for the author or the current right holder (US proposal to solve the orphan works problem).<sup>33</sup>
- 16 The deregulation of liability rules will not work in Europe with regard to the newly enacted Enforcement Directive.<sup>34</sup> However, the legal capacity to grant a right to license, whether via an extended license system or – where suitable – through a government agency, seems to be the right way to solve the orphan works problem. The extended collective license system is already mentioned in recital 26 of the Info Society Directive. Indeed, collective societies are under a relatively tight inspection with regard to their license practices and their pricing strategies.
- 17 The legal presumption for orphan works might not be ideal from the point of view of authors and right holders who do not know about the uses being made to their works without their fault. However, the under-usage of works does not help anybody as long as the right holders do not claim their authorship. The solution offered here is quite similar to what Google has done with its Book Search. However, whereas Google had no legal capacity to act on behalf of authors of works that are out of print or out of stock, collective societies would be in this position if the legislator helped in this regard. As collective societies

act as trustees to authors and publishers, misuse of this capacity is less probable. The funding that they receive from the licensing of orphan works can easily be used to trace right holders and let them participate in this funding. If right holders cannot be identified at all, limitation statutes might be enacted that would help to use the revenue for cultural purposes after a period of five or ten years.

## C. Future goals

### I. Do we need privileges (deregulation) for open access system managers?

- 18 The German legislator has asked interested circles whether future regulation should care for special rules in favour of and to foster open source and open access models.<sup>35</sup> This question is legitimate. Indeed, OSS models operate on the same footing as any commercial provider. Usually, commercial providers hold exclusive rights and therefore profit from legal presumptions of their rights ownership. The management of OSS systems may be complex. Rarely can the managers of wikis or complex software environments claim to be the sole right holder or owner of the rights attached to the work. A legal presumption that may be used to control the licenses given within the system would be feasible. German copyright law holds such a presumption in two cases. First, § 10 states that a presumption for rightholdership applies if a person is designated on the copies of a work.<sup>36</sup> Moreover, the members of a group of artists (i.e. the members of a rock band or an orchestra) are presumed to be represented by an elected group leader (Sec. 80 subs. 2, 74 subs. 2). Such a presumption would help manage large groups of authors as well. It requires a definition of orphan works and a definition of the position of the group leader.
- 19 So far, litigation in OSS cases is not too extensive. The cases that have come to court in Germany and the US show that individual programme developers were usually in a position to claim their own authorship.<sup>37</sup> This is a clear advantage of the GPL License, which uses the direct licensing system. However, as more contributions level up the programme, collective ownership becomes the rule. This is also the case in large academic groups or with respect to wikis. A legal presumption granting a standing to sue would help.

## II. How to reduce complexity in license schemes

- 20 OSS agreements might be very complex. The DPPL License is a good example of a fairly complex and – from the perspective of the ordinary user – possibly overly complex contract. The Creative Commons License is simpler and clearer, but it might raise doubts about legal certainty that the DPPL clearly avoids. Simplicity and clarity for the user are vital to the success of OSS models. The user will have to be able to trust simple formulations and – even better – simple icons. The Creative Commons License is a model in this regard. Other license models will have to use icons to make clear in a fast and efficient way what the right holder wishes to grant and what the user wishes to get. Icons must be internationally understandable. This requires legal rules dealing with the formation of a contract to accept this simplicity. Courts might feel enough sympathy for OSS models to grant some tolerance to help execute those contracts. However, some regulation might be helpful.
- 21 Icons should be generally accepted as verbal descriptions of what rights are granted in OSS models. Icons should grant protection by some type of collective trademark system. At least the law of deceptive advertising should be used to enforce honest uses of these icons and prevent misleading uses.
- 22 OSS terms are generally regarded as standard business terms.<sup>38</sup> Usually this means that any obscurity in interpreting these terms is at the expense of the party which uses these terms. The consumer, however, is protected. This tendency of interpretation is not suitable in cases where a right is granted generously and free of charge. Standard business terms should therefore favour the operator of the license scheme. A presumption which calls for an interpretation that favours the conclusion of a contract might be adapted by courts. A legal presumption which favours the existence of a contract, however, would give more clarity.
- 23 However, the user will also need a certain degree of protection. In copyright law, licenses usually have to use a maximum of clarity and specificity. If contracts are interpreted in favour of the operator of the OSS system, doubts will fall at the expense of the user (the consumer). This calls for a certain standardisation of license terms, a register for typical user rights adjusted to the term “open source”. A standard interpretation of user rights which are typical for the OSS model might be formulated by legislators. A definition of OSS and typical OSS user rights should be a part of copyright laws.
- 1 Director of the Institute for Media Law and Communications Law and the Institute of Broadcasting Law at the University of Cologne. Web sources cited were visited on 5 March 2010.
  - 2 Peifer, Urheberrechtliche Rahmenbedingungen von Open-Access-Konzepten (Copyright Framework for Open Access Concepts), in Peifer/Gersmann (eds.), *Forschung und Lehre im Informationszeitalter*, p. 39; see also Peifer, *Zur rechtlichen Problematik des Elektronischen Publizierens (Legal Problems of Electronic Publishing)*, in CLIO (Hg.), *Elektronisches Publizieren in den Geisteswissenschaften: Erfahrungen, Probleme, Perspektiven*, Berlin 2007, vol. I, p. 172-190 (Online-download available under [http://edoc.hu-berlin.de/histfor/10\\_1/](http://edoc.hu-berlin.de/histfor/10_1/)).
  - 3 See Art. 54 subs. 1 and 2 European Patent Convention. Patent law reserves the publication for its own filing system. The patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 83 EPC).
  - 4 [www.fsf.org/philosophy/free-sw.html](http://www.fsf.org/philosophy/free-sw.html). See also Kuhlen, *Wem gehört die Information im 21. Jahrhundert? (Whose Property Is Information in the 21st Century?)*, in Dreier/Büllesbach, (same title) 2004, p. 1 et seq.
  - 5 This is contrary to what the patent system wants to achieve by its disclosure requirement; see Art. 83 EPC and footnote 3 above.
  - 6 Document accompanying the “Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee on scientific information in the digital age: Access, dissemination and preservation, SEC (2007) 181 final, p. 3. The much more extensive definition of the “Berlin Declaration” contains a requirement to “grant to all users a free, irrevocable, worldwide, right of access to, and a license to copy, use, distribute, transmit and display the work publicly and to make and distribute derivative works, in any digital medium for any responsible purpose, subject to proper attribution of authorship (...), as well as the right to make small numbers of printed copies for their personal use;” [http://oa.mpg.de/openaccess-berlin/berlin\\_declaration.pdf](http://oa.mpg.de/openaccess-berlin/berlin_declaration.pdf).
  - 7 Public entities are sometimes forced to provide information from administrative records within “freedom of information” acts; in the US, see 5 U.S.C.A. § 552; in Germany, *Informationsfreiheitsgesetz des Bundes*.
  - 8 This is usually restricted to situations in which rights have been infringed or information is needed to seek for private relief in courts; see Art. 47 TRIPs and Art. 8 Directive 2004/48/EC on the enforcement of IP rights, OJ L 195 p. 16. Courts in Germany have argued that there is no general duty to inform nor a general right to be informed which could be based on the constitutional right to have access to private or not publicly available information; see BVerfGE 103, 44, 60 – n-TV case; Heintschel von Heinegg, AfP 2003, 295; Thum, AfP 2005, 30.
  - 9 See Article 7 Unfair Commercial Business Practices Directive 2005/29/EC, OJ L 149 p. 30.
  - 10 Article 4 subs. 2 of the GPLv3 reads: “You may charge any price or no price for each copy that you convey.” Article 2 subs. 1 and Article 6 subs. 1 GPLv3, which deal with the conveyance of “covered works,” do not hold this price clause. Art. 10 subs. 3 forbids the user to “impose any further restrictions on the exercise of the rights granted or affirmed under this License;” see Koglin CR 2008, 137, 141: “two distinct cost clauses which must never be mixed.”
  - 11 B. Bauer, *It’s economy, stupid?*, *Information Wissenschaft & Praxis (IWP)* 5/2009, p. 271; Pflüger, *The Legal Protection of Open Access*, in: *European Commission/German Commission for UNESCO, Open Access. Opportunities and Challenges*, 2008, p. 101.
  - 12 This is true for Germany with respect to university professors who have no enforceable legal duty to publish their research results, Schrickler/Rojahn, *Urheberrecht*, 3<sup>rd</sup> ed. 2007, § 43 Rn.

- 131; Haberstumpf, ZUM 2001, 819, 825. The same is true for academic staff in general, OLG Karlsruhe GRUR 1988, 536, 540; GRUR 1991, 523, 525 – Grabungsmaterialien; Ullmann, GRUR 1987, 6, 8; Ulmer, Urheber- und Verlagsrecht, 3<sup>rd</sup> ed. 1980, § 95 II 2, S. 403; but see VG Berlin, NJW 1978, 848.
- 13 Attempts to alter this situation by codifying a legal duty in this respect have been unsuccessful in Germany, but see in favour of this model *Pflüger/Ertmann* ZUM 2004, 436, 441.
- 14 This right is indirectly protected by Art. 3 subs. 3 Berne Convention, which defines “published works” as those works having been published with the consent of the author.
- 15 Hansen, GRUR Int. 2005, 378, 379; Hirschfelder MMR 2009, 444, 447.
- 16 Section 12 German Copyright Act clearly states: “The author has the right to decide *whether and how* his work is to be published.” See Art. 6-bis RBC: “... the author shall have the right to claim authorship of the work and 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 honor or reputation*.” With respect to the first publication, Art. 5 subs. 3 states: “The expression ‘published works’ means *works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work*.”
- 17 See Hansen, GRUR Int. 2005, 378, 387. The idea has been used by the German Bundesrat to argue in favour of a cogent right to publish on open access servers if the work has been licensed to a publisher; see recommendation of the Commission for Education, Science and Culture of the German Parliament, Bundestags-Drucksachen 16/5939, p. 26.
- 18 But see Hirschfelder MMR 2009, 444, 445; Heckmann/Weber GRUR Int. 2006, 995, 998.
- 19 Peifer, GRUR 2009, 22, 27. International copyright clearly distinguishes between “limitations and exceptions” (Article 13 RBC) and “the conditions under which the rights ... may be exercised” (Art. 11-bis subs. 2 RBC).
- 20 See Dewatripont et al., Study on the economic and technical evolution of the scientific publication markets in Europe, 2006, p. 69 (overview of the current open access policies).
- 21 Dewatripont et al., p. 69.
- 22 Art. 2 subs. 8 RBC states: “The protection of this Convention shall not apply to news of the day or to miscellaneous facts having the character of mere items of press information.” Art. 9 (2) TRIPS agreement clarifies with regard to the RBC: “The protection of this Convention shall not apply to news of the day or to miscellaneous facts having the character of mere items of press information.” Article 2 WCT repeats: “Copyright protection extends to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.”
- 23 See Peifer, Die Inhalte des Urheberrechts, in Riesenhuber (ed.), Systembildung im Europäischen Urheberrecht, 2007, p. 155, 173; Grosheide, Moral Rights, in Derclaye, Research Handbook on the Future of EU Copyright, 2009, p. 242, 249.
- 24 The Berlin Declaration clearly defines open access by “proper attribution of authorship.” This is not merely a copyright concern as the Berlin Declaration also refers to the publication of non-copyrightable raw data (see above footnote ##). The GPLv3 states in Article 4: “You may convey verbatim copies of the Programs source code as you receive it, in any medium, provided that you conspicuously and appropriately publish on each copy an appropriate copyright notice; keep intact all notices stating that this License and any non-permissive terms added in accord with section 7 apply to the code.” Sec. 6 of the DPPL license (version 2008) requires citing the names of the original authors. Creative Commons Licenses will in all versions oblige the user to cite the original author; see <http://de.creativecommons.org/was-ist-cc/>.
- 25 See Preamble sub. 7 which states: “... the GPL requires that modified versions be marked as changed, so that their problems will not be attributed erroneously to authors of previous versions.”
- 26 See Fröhlich, in: Information Wissenschaft & Praxis (IWP) 5/2009 p. 253, 255.
- 27 See Peifer, UFITA 2007/II, 327, 335; Stang, ZGE 2009, 167, 199.
- 28 See BVerfG GRUR 2001, 149, 151 – Germania III.
- 29 As part of the “i2010:Digital Libraries” project, the European Commission launched a Recommendation on the digitisation and online accessibility of cultural material in which it calls on the Member States to facilitate the use of orphan works; see Art. 6 a Recommendation 2006/585/EC of 24 August 2006, OJ L 236/28.
- 30 Koskinen-Olsson, in Ricolfi et al. (ed.), High Level Expert Group: Final Report on Digital Preservation, Orphan Works, and Out of Print Works, 2008, p. 10; see [http://ec.europa.eu/information\\_society/activities/digital\\_libraries/doc/hleg/reports/copyright/copyright\\_subgroup\\_final\\_report\\_26508-clean171.pdf](http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/reports/copyright/copyright_subgroup_final_report_26508-clean171.pdf). A more accurate definition is given by the Joint Report “Sector-specific Guidelines on due diligence criteria for orphan works, sub 1.2: work protected by copyright of which the first or current owner, first creator or the holder of a derivative right is unknown or untraceable by diligent search.” The Guidelines make further proposals for various work categories; see [http://ec.europa.eu/information\\_society/activities/digital\\_libraries/doc/hleg/orphan/guidelines.pdf](http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/orphan/guidelines.pdf).
- 31 Sec. 77 Canadian Copyright Act, <http://laws.justice.gc.ca/PDF/Statute/C/C-42.pdf> states: “Where, on application to the Board by a person who wishes to obtain a licence to use (a) a published work, (b) a fixation of a performer’s performance, (c) a published sound recording, or (d) a fixation of a communication signal in which copyright subsists, the Board is satisfied that the applicant has made reasonable efforts to locate the owner of the copyright and that the owner cannot be located, the Board may issue to the applicant a licence to do an act mentioned in section 3, 15, 18 or 21, as the case may be.” A similar solution is offered by Art. 70, 67 of the Japanese Copyright Act, where the Commissioner of the Agency for Cultural Affairs is competent to issue blanket licences for orphaned works. In the United Kingdom, Sec. 190 of the CDPA allows licences to be issued by the Copyright Tribunal for the use of previous recordings. In Hungary, Art. 57/A of the Copyright Act, as amended by Act CXII of December 28, 2008 and with effect from February 1, 2009, gives the Hungarian Patent Office legal status to grant a non-exclusive licence for the use of orphan works which is valid for five years. See Ágnes Dudás, Main Aspects of the Orphan Works Licensing in Hungary, <http://www.ifross.org/artikel/main-aspects-orphan-works-licensing-hungary>.
- 32 This is a solution used in the Scandinavian Copyright Laws with respect to certain privileged uses (mainly copying and broadcasting use); see as an example Article 36, 38a of the Norwegian Copyright Act. Section 36 (1) reads: “When there is an agreement with an organization referred to in section 38a which allows such use of a work as is specified in sections 13b, 14, 16a, 17b, 30, 32 and 34, a user who is covered by the agreement shall, in respect of right holders who are not so covered, have the right to use in the same field and in the same manner works of the same kind as those to which the agreement (extended collective licence) applies. The provision shall only apply to use in accordance with the terms of the agreement. The provision shall not apply in relation to the rights that broadcasting organizations hold in their own broadcasts.” Section 38a reads: “Agreements intended to have an effect as specified in section 36, first paragraph, shall be entered into by an organization which in the field represents a substantial part of the authors of the works used in Nor-

way, and which is approved by the Ministry. For use in certain specified fields, the King may decide that the organization which is approved shall be a joint organization for the right holders concerned.” See <http://www.kopinor.no/en/copyright/copyright-act>. The system currently does not cover making available rights.

- 33 Draft Orphan Works Act of 2006; see <http://thomas.loc.gov/cgi-bin/query/z?c109:H.R.5439>. Section 514 (a) of the Draft states: “(1) ... in an action brought under this title for infringement of copyright in a work, the remedies for infringement shall be limited under subsection (b) if the infringer sustains the burden of proving, and the court finds, that (A) before the infringing use of the work began, the infringer, a person acting on behalf of the infringer, or any person jointly and severally liable with the infringer for the infringement of the work (i) performed and documented a reasonably diligent search in good faith to locate the owner of the infringed copyright; but (ii) was unable to locate the owner; and (B) the infringing use of the work provided attribution, in a manner reasonable under the circumstances, to the author and owner of the copyright, if known with a reasonable degree of certainty based on information obtained in performing the reasonably diligent search.” Subsection b) states that monetary relief will usually not be given in such a case, but injunctive relief may still be granted. See also Report on Orphan Works (January 2006), <http://www.copyright.gov/orphan/orphan-report.pdf>.
- 34 Sec. 3 (2) of the Enforcement Directive 2004/48/EC, OJ L 195 p. 16 (corrected version) demands efficient, proportionate and dissuasive measures to protect intellectual property. The de-regulatory approach of the E-Commerce Directive stands in contrast to this postulate.
- 35 See Bundestags-Drucksache 16/5939 p. 26.
- 36 Sec. 10 (1) reads: “The person who is indicated as author in the usual way on copies of the published work or on the original of a work of plastic art is deemed to be author until the contrary is proven; this is also the case if a pseudonym or an identifying sign is used which is known to relate to a certain author.” Sec. 10(3) reads: “The presumption in subs. 1 applies to exclusive rightholders when preliminary injunctive relief or seize and desist orders are asked for. The presumption does not apply with respect to the author or the holder of a neighboring right.”
- 37 See LG München I, MMR 2004, 693 (GPL license, individual program developer sued against commercial user); LG Frankfurt/M., ZUM-RD 2006, 525 (same as before); LG Berlin, CR 2006, 735; LG München I, CR 2008, 57 and Jacobsen v. Katzer, 535 F.3d 1373, 1379 (C.A. Cal. 2008:); no dispute on ownership.
- 38 See the German decisions cited in previous footnote.

# Open Access and Competition Law

## Legal Restraints on the Competition between Electronic Products of Private Publishing Houses and University Press?

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**Keywords:** Open Access; Competition Law; Academic Publishing; Prohibition of State Aid

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### A. Introduction

1 On 15 July 2009<sup>1</sup> the German Research Foundation (*Deutsche Forschungsgemeinschaft, DFG*) declared that it would financially support a common platform for universities providing fast and effective access to electronic journals and repositories at a low cost of production whilst working closely with the authors, if it could be proven:

1. that the traditional market for such publications had either failed completely or at least failed with regard to certain academic disciplines
2. that there will never be a flourishing market for such services, as such publications are inherently uneconomical.

2 Market failure as described under point 1) can be said to exist as soon as the needs of academics wishing to be part of the international research community can neither be satisfied by commercial nor by non-profit service providers. Academics desire fast and easy access to highly specialised<sup>2</sup> low-threshold journals, hence, products with a very low profit margin.

3 If however, as point 2) proposes, there is no market due to lack of demand for such e-products then obviously there is no need for financial aid.

4 Without giving you any empirical evidence I would like to assume that there is an ever-growing demand for electronic journals and similar services, both nationally and internationally.<sup>3</sup> Before I will continue to speak about market failure, I would like to differentiate between different types of electronic products.

### B. Electronic publications that supplement print publications (with identical content)

5 As was stated by the president of the DFG (*German Research Society*),<sup>4</sup> one of the society's essential functions is providing open access scientific knowledge to a wide audience. Other large research organisations<sup>5</sup> in Germany have also united in their support for more open access media. Numerous German university professors, however, came together in March 2009, in what is known as the "Heidelberg Appeal"<sup>6</sup> to speak out against the growth of open access. They

believe that the publication of any article without the consent of the author is an illegal compulsory dispossession of his copyrights. The Heidelberg Appeal aims at defending copyright against open access, which is believed to rob the authors of the sovereignty over their work.<sup>7</sup> The research institutes on the other hand wish to achieve a faster and easier way for the entire scientific community to access new research results after a so-called “embargo period” of six months.

- 6 In the natural and engineering sciences digital publications have already become the order of the day.<sup>8</sup> But digital versions of traditional print media are becoming more popular in the social sciences as well. A revision of copyright law wishes to establish the right to a second electronic publication. Articles that appear in journals and anthologies could then be accessible in on-line repositories free of charge.
- 7 Only articles and papers that have already been published in print media would be made available in these repositories.<sup>9</sup> Hence, monographs would not automatically be included in these repositories. On-line access and archiving will only be the second step – following the traditional publication of a contribution in a journal. Such repositories will, therefore, not replace scientific journals, regardless of whether they will be operated either by universities or by other research institutions. Such repositories will also provide for more accurate statistics on the use, popularity and citation of certain papers.<sup>10</sup>
- 8 Reuß,<sup>11</sup> the initiator of the Heidelberg Appeal, disregards all these benefits of e-publishing with the argument that an author may and must always have control over his work and that this right includes the choice of and the control over the medium in which his work is published, as well as the choice of publisher or distributor. According to Reuß, no articles of an author may be published on-line without his explicit consent. Reuß therefore deems “the implications of the strife for more open access plainly unconstitutional”.<sup>12</sup> Rieble<sup>13</sup>, who is of the same opinion writes: “Academic as well as artistic freedom strives for an interaction between the author and his audience. Copyright secures that the communication of any author with his audience remains within his sovereignty over his work. Choice of medium and choice of audience is an elementary component of the control over this process. This is why freedom of information is not synonymous to all round access that serves only the interests of the consumers of these texts.”
- 9 I find this argument legally unconvincing. Artistic freedom as it is guaranteed by the German as well as most other constitutions gives an author the right of distribution. The fate of a text after distribution, however, is governed by a more complex and differentiated set of rules in copyright law.<sup>14</sup> Copyright is

a human right – a right that must be protected and upheld by the state. It is essential that authors have the sole right to decide on the fate of their texts until they first decide to publish them. Once the text has been published, they have the right to be named as the author of the text.<sup>15</sup> To what extent an author has the right to participate in the commercialization of his or her text after publishing it, is a question governed by copyright law. Copyright law does not take an “all-or-nothing” approach to post publication rights, but instead regulates these rights in a differentiated manner by weighing up the interests on both sides, as the limitation of copyright in section 64 of the German Copyright Act (*UrhG*) shows.

- 10 Having said this, I would like to quote a ruling of the German Federal Constitutional Court of 7.7.1971<sup>16</sup> which states: “Artistic freedom is a human right that prohibits any infringement on the methods, content and tendencies applied by an artist, rules for the creative process and (either literal or figurative) restriction of the room needed by the artist for such a process to unfold.”<sup>17</sup> This does not apply to the replication of texts for tuition purposes or copies of the work that are offered to the public with the permission of the author (see sec. 6 para. 2 *UrhG*). The free reproduction of work does not infringe on the freedom of creation or the right to decide on whether one’s work is made accessible to the public. Reproduction only affects the financial interests of the artist. Therefore, the question that needs to be asked is whether the restrictions on commercial rights are in line with the constitution. These commercial rights, however, do not fall under the protection of artistic freedom, but rather constitute a property right. An author’s work must be seen as his property which is a right guaranteed by the constitution (see art. 14 of the German Constitution). In accordance with art. 14, sentence 2 of the German Constitution, property is constrained by its social relevance. Whilst sufficient commercial freedom must be given to an artist regarding his or her work, the contribution this work makes to society must also be taken into account. In this light, it seems just and fair to increase the above mentioned “embargo period” of protection to two years – a period after which the commercial use of essays, results, articles and papers would typically be exhausted. Anyone desiring earlier open access would have to pay a fee.
- 11 Copyright legislation may take into account that books constitute an essential and universal cultural good and should therefore be bound by obligations which are determined by public interest as is the case with books and essays needed for educational purposes (see sec. 52 a ff of the German Copyright Act *UrhG*).<sup>18</sup> Legislative intent may also take into account that many creative and scientific works have been made possible by public support – be it financial or intellectual influence and stimulation. Assigning it to the public domain – for the reasons men-

tioned above – after the short period of six months seems, however, quite biased. At this point I should like to quote the German Federal Constitutional Court<sup>19</sup> again: “Public interest in an access to cultural goods justifies displaying an author’s work in churches, schools and other institutions of higher education. This, however, does not necessarily imply that the author is forced to make his work available free of charge (sec. 46 of the German Copyright Act). The critique put forth by Rieble (and others), that the above mentioned research institutions are interested solely in the utility of science and that their goals undermine the interests of their own scientists and researchers, is a little far-fetched. Their idea of an undisturbed individual communication based on the ability to choose between different channels of communication, exaggerates the notion of copyright and ignores the fact that legislation shapes but also limits copyright. Intellectual property depends on its acceptance and recognition by the legal system.”<sup>20</sup>

- 12 Once a good protected by an intellectual property right – a patent or design – goes onto the market, the holder of this right no longer has full control over this good. Exhaustion occurs.<sup>21</sup> Any scientist or scholar may decide whether or not he wants to publish his article or paper. But once he has done so, it enters the free marketplace of ideas. His free choice in using a certain means of publication is governed by his academic freedom, but cannot – at least not for all time – restrict the marketplace of ideas and opinions, see sec. 52 a et seq. of the German Copyright Act (*UrhG*). What we need, is a more advanced understanding of the notion of copyright exhaustion, to better suit the needs of today’s academic and on-line community. Commercial rights are not rights ascribed to a person (the Hegelian “personality”, rather than the Lockean “labor” justification for copyright law), but are rather categorized as part of economic freedom. Whilst commercial rights may also not be dispossessed or undermined by law, there are certain social obligations that accompany them. This social aspect of property, art and science is also shaped by the law. Any person whose work is supported with public funds may be obliged by contract to publish his or her results in open access media. Even Rieble agrees that open access is acceptable “as long as it remains the choice of the author and this is made free of any undue pressure”.<sup>22</sup>
- 13 Considering the results of the debate, it seems to be common opinion that no necessity exists for open access to works which are easily attainable such as textbooks, handbooks, reference books and commentaries.<sup>23</sup> In my opinion, the sociologist Taubert<sup>24</sup> rightly concludes that such publications contain no original or new contributions to the various sciences and are therefore not of superior importance to scientific progress in the respective fields.

- 14 Open access is, however, becoming an increasingly important addition to contributions published in archives, journals and anthologies of natural and social sciences. These publications are seldom lucrative, which often makes articles and contributions hard to come by. As long as a “cooling-off” period of two years is upheld, I see no sincere arguments against the comfort, flexibility and greater distribution of knowledge made possible by open access.
- 15 If an author’s or artist’s work is used consecutively, permission has to be granted each time. There are three main rights of exploitation in copyright law: the right of reproduction, the right of distribution and the right of exhibition. The right of distribution is a material exploitation right. It does not include the right of reproduction in non-material form and is limited by the principle of exhaustion (sec. 17 para 2, of the German Copyright Act).<sup>25</sup> The other two exploitation rights are not limited by the principle of exhaustion.<sup>26</sup> The consumer does therefore not have the right to reproduce or exhibit the work he has purchased. A publication on internet-based databases falls under the right to communicate one’s work to the public (sec. 19 a of the German Copyright Act). A single distribution – as defined by sec. 17 of the German Copyright Act – does not exhaust the author’s right to reproduction (sec. 15 of the German Copyright Act) or his right to communicate his work to the public (sec. 17 of the German Copyright Act). The latter (sec. 19 a of the German Copyright Act) should be limited *de lege ferenda*.
- 16 In my opinion the notion of copyright exhaustion should be extended to imply that after the publication of a scientific paper and after a certain “cooling-off period” the author should not be allowed to oppose an on-line-publication by a university or other research institution.
- 17 For the benefit of research institutions, this exhaustion should not be restricted to the right of distribution, but apply to other rights of exploitation as well.

### C. Electronic publications that have not been published in printed media before

- 18 It is necessary to distinguish between scientific papers published in print media before they are published electronically and those initially published electronically (some of which are then later published in print media in extended versions). Especially in the natural sciences, recognition primarily goes to the first person to publish new results or inventions. As a result, a fast and unbureaucratic means of publishing is desired. open access is therefore widely-used in these fields. In contrast, because results in the social sciences cannot be as easily verified or fal-

sified, the reputation of the journal or the status of the publisher still plays a vital role. This occurs despite the fact that research has shown that such journals are reluctant to publish papers containing new ideas that contradict either established theories or the opinions of the journal editors.<sup>27</sup> Here open access could be helpful as well. Universities' electronic platforms, which would enable fast and effective distribution of research results, could also – under terms and conditions yet to be discussed – be used to store scientific journals and anthologies in one virtual place, ensuring easy access.

- 19 Let us now discuss the problems open access poses with regard to competition law, especially concerning commercial electronic products and services. It is important to keep in mind that we are not discussing competition between open source teaching material and textbooks funded by universities and those published for commercial purposes. Where there is no market failure, state aid for publications (also being offered by competitors) is not permissible.<sup>28</sup> We are discussing the other academic publications mentioned above under I.

## D. Electronic products and open access

- 20 Open access – enabling the universal and free distribution of information – has been considered a widely accepted principle of academic publishing (at least) since the “Berlin Declaration of Public Access to Scientific Knowledge” was signed by the DFG (German Research Society) and six other research institutes on 22 October 2003.<sup>29</sup> And yet, especially in the social sciences, academics still shy away from open access internet publications. While some small publishing houses still lack sufficient software to offer internet publishing, larger ones are often only prepared to offer the electronic publications, if these accompany print publications. University facilities such as the **CeDis** at the **FU Berlin** could fill these gaps.<sup>30</sup> The goal is to establish a sustainable and self-run server for publication of open access academic material, similar to projects such as **Euclid**, **Muse** and **HighWirePress**.<sup>31</sup>
- 21 **E.publishing.net** is such a service offered by the **CeDis**. It compiles academic publications and makes them accessible in electronic form. It uses the open source software **OJS** and was designed especially for academics working in specialised fields, whose work does not have the level of distribution commercial publishing houses require. These academics want to make their work available to the entire scientific community. Hence, **e.publishing.net** makes their research results available to the public free of charge. Because it is an open-source software, it cannot be sold for the sake of utilizing its contents

commercially. The knowledge is given to the public “allmende” and anybody can use the program. Only setup and service costs need to be covered by users or public organisations.

## E. Open access and the prohibition of state aid

### I. State funding of open access projects

- 22 In the declaration of the above mentioned research organisations signed on 25 March 2009, the research institutes demand redirecting of public funds in order to create new open access opportunities.<sup>32</sup> Systems such as **e-publishing.net** would make a universal, free and cost-efficient means of publishing and distributing results possible. It is in line with the aims and philosophy of open access, that research sponsored by public funds is also made available to the public free of charge.
- 23 Because scientists aim at using **e.publishing.net** as a means of publishing their results on-line without being required to publish the same results in the printed media as well, it seems to be a fully justified tool and I see no breach of competition law. Being state institutions, universities may publish their own scientific journals and thereby participate (perhaps as a “kingpin” player; *Hecht im Karpfenteich*<sup>33</sup>) in the market without breaching any constitutional prohibitions. This has been successfully done so for decades.<sup>34</sup>

### II. State funding of scientific research and the prohibition of state aid in Art. 107 of the Treaty on the Functionality of the European Union

- 24 Economic policy in the European Union aims at establishing a system of undistorted, fair and equal competition.<sup>35</sup> State funded publications may not distort existing competition between universities and private publishing houses. This causes a certain dilemma: If the aim of state funding to create faster and more cost efficient means of publishing – this being the need of the scientific community – was achieved, the position of commercial publishing houses which are not yet willing or able to enter the market of on-line publications could be weakened.
- 25 State aid is legally assessed under application of Art. 107 EC. This provision contains the prohibition of anti-competitive benefits. State funds granted wit-

hout consideration or reciprocal payment constitute state aid in terms of Art. 107 EC. Hence, any funding of electronic media granted to university publishing houses by the DFG or any other government organisation is regarded as state aid, since the universities do not reciprocate.<sup>36</sup> Art. 87 EC only mentions “undertakings” as receivers of state aid. It has, however, been established that public institutions are also considered receivers of state aid, if they participate in a market.<sup>37</sup> This is the case with e-publishing.

### III. The research aid exemption of the prohibition of state aid

- 26 Funding research is, however, not impermissible in all cases. There are many good reasons for funding innovation, research and development under certain circumstances, see 2006/C 323/01.<sup>38</sup> But as with any other type of aid, research aid generally requires prior notification of the European Commission. Non-notified aid is prohibited (para 3.1).
- 27 Only certain types of aid do not require notification.<sup>39</sup> Unlike funding for fundamental research on electronic media, funding for experimental development of electronic media does not require notification. According to art. 30 nr. 4 of the guideline 800/2008/EC this only includes the phases of conceptualisation, planning and documentation of new products. However, funding products that do not serve commercial purposes is not prohibited and does not require notification. Electronic publishing products of universities are regarded as non-commercial products, if they are only distributed to universities and related institutions at cost price. Commercial products, on the other hand, are only exempt from the prohibition (for the sake of documentation), if their development would be too expensive (art. 30 Nr. 4 of the Guideline 800/2008/EC). In this case, profits must be subtracted from the costs covered by state aid.<sup>40</sup>

### IV. Funding electronic university journals has no noticeable competitive effect on the market for equivalent commercial print publications

- 28 Funding electronic university journals has no negative effect on private publishing houses with regard to competition, if these do not publish equivalent journals in the first place, because of a lack of promise of significant profit. Where private publishing houses do in fact publish such journals, the state may only fund the research and development of university journals offered to other universities and public research institutions up to the point where the

aid becomes noticeable on the market and distorts competition.<sup>41</sup>

- 29 The only other case in which competition would be distorted is, if the aid for the electronic journals also had an effect on the market for printed journals. In my opinion, however, print and electronic publications do not constitute one market. Rather, each product forms their own market. Only online products offer immediate publication and access to new research results. Comments and discussions can, therefore, also be posted much sooner and alterations can faster be implemented. This changes the world of scientific discourse and offers dynamics that expensive and infrequently printed journals and anthologies cannot achieve. We can therefore speak of two different markets, each fulfilling a different function.<sup>42</sup>
- 30 Books and online texts generally do not belong to the same market. Whilst the average online-reader primarily seeks information, a reader with an actual book in his hands is willing to delve into the complexity of the structure of a text, to work through and digest it in its entirety. Rieble<sup>43</sup> speaks of studying a text, instead of only screening it for information. A scientist writing in an renowned journal wants to achieve the former. He writes for a particular audience and wishes to be studied. E-publishing on the other hand is open to everyone and it is improbable that any large profits will come out of it.<sup>44</sup>

### V. Does competition between universities and commercial online products exist?

- 31 Online publication by private publishing houses should also not be included in the market of open access academic publication described above. Most of such publishing houses traditionally base on print media and only publish an online journal, if they obtain the rights to the printed version as well. Consumers are obliged to pay a fee for access to online articles. Online publications by universities directed at scientists, academics and scholars are free of charge and do not require an accompanying print publication. They offer articles strictly categorised into certain fields of research, such as those offered by projects like Euclis, Muse and HighWirePress. Hence, the consumers of the universities' products and the commercial products are not the same.<sup>45</sup>
- 32 The global market for tools to publish online journals would not be distorted by state aid. Without aid, such products would have next to no chance of entering this new market. A similar development has been observed regarding the profitability of traditional printed archives, journals and anthologies. Funding open access projects could help the market

flourish and realise its full potential, which would in turn give academics and scholars the direly needed easy and fast access to knowledge.<sup>46</sup>

## F. Conclusion

- 33 This paper takes a differentiated look at different forms of academic publishing and the perspectives and opportunities created by open access as an increasingly important substitute and expansion to the classical means of publishing in journals, archives and anthologies.
- 34 It concludes that neither competition law nor state aid regulations prohibit the funding of academic open access publications or the setting up of repositories for these.
- 35 Whilst open access challenges some of the traditional ideas on copyright and authorship, this paper concludes that at least with regards to academic publishing a more advanced stance needs to be taken to better suit the needs of today's academics and the on-line community of researchers.
- 1 See [http://www.dfg.de/forschungsfoerderung/formulare/download/12\\_17.pdf](http://www.dfg.de/forschungsfoerderung/formulare/download/12_17.pdf) (15.7.2009).
  - 2 Brochure by the Alliance of German Economic Organisations (*Allianz der deutschen Wirtschaftsorganisationen*), 19 October 2009, see <http://www.wissenschaftsrat.de/aktuelles-allianz.html>.
  - 3 Kleiner, in: *Forschung und Lehre* 2009, p. 640.
  - 4 German Research Foundation (*Deutsche Forschungsgemeinschaft*), German Science and Humanities Council (*Wissenschaftsrat*), German Academic Exchange Service (DAAD), Fraunhofer Society (*Fraunhofer Gesellschaft*), Helmholtz Society (*Helmholtz-Gemeinschaft*), Max Planck Society (*Max-Planck-Gesellschaft*), Alexander von Humboldt Foundation (*Alexander von Humboldt-Stiftung*), Leibniz Society (*Leibniz-Gemeinschaft*) and German Academy of Sciences Leopoldina (*Leopoldina*).
  - 5 *Heidelberg Appeal*, Für Publikationsfreiheit und die Wahrung der Urheberrechte (*For More Publishing Freedoms and Copyright Protection*) (22 März 2009), see [www.textkritik.de/urheberrecht/index.htm](http://www.textkritik.de/urheberrecht/index.htm).
  - 6 So Reuß, the initiator of the Heidelberg Appeal, in: *Forschung und Lehre* 2009, p. 644.
  - 7 Kleiner, in: *Forschung und Lehre* 2009, p. 640.
  - 8 Kleiner, in: *Forschung und Lehre* 2009, p. 640, 641.
  - 9 Kleiner, in: *Forschung und Lehre* 2009, p. 640, 641.
  - 10 Reuß, in: *Forschung und Lehre* 2009, p. 645.
  - 11 Reuß, in: *Forschung und Lehre* 2009, p. 645.
  - 12 Rieble, *Forschung und Lehre* 2009, p. 648; Reuß/Rieble, *Autorschaft als Werkherrschaft in digitaler Zeit (Authorship and Control in the Digital Age)*, 2009, p.29 et seq.
  - 13 Sec. 28 et seq. German copyright act (UrhG).
  - 14 Sec. 13 German copyright act (UrhG).
  - 15 Ruling of the German federal constitutional court, BVerfG 31, 229, 239.
  - 16 Ruling of the German federal constitutional court, BVerfG 30, 173, 190.
  - 17 Dreier, in: Dreier/Schulze UrhG, sec. 52 a, para. 1.
  - 18 Wandtke/Ost, in: Wandtke/Bullinger UrhG, sec. 52a, para. 3.
  - 19 Ruling of the German federal constitutional court (BVerfG, 11.10.1988), In: BVerfG GRUR 1989, p. 193, 196 – Vollzugsanstalten.
  - 20 Sec. 17 Abs. 2 German copyright act (UrhG); The doctrine of “copyright exhaustion” or “first sale exhaustion” describes the loss of certain intellectual property rights after the first unrestricted sale or use of the property subjected to such rights, see ruling of the German Federal Court of Justice (BGH) GRUR 1988, p. 206, 210 – Kabelfunkentscheidung II.
  - 21 Rieble, in: *Forschung und Lehre* 2009, p. 651.
  - 22 Taubert, in: *Forschung und Lehre* 2009, p. 657, 659.
  - 23 Taubert, in: *Forschung und Lehre* 2009, p. 657, 659.
  - 24 According to majority opinion an online publication does not fall under this provision, of different opinion: Berger, “Urheberrechtliche Erschöpfungslehre und digitale Informationstechnologie” (Copyright Exhaustion and Digital Information Technology) GRUR 2002, 198 et seq.
  - 25 BGH GRUR 2005, p. 940, 942; BGH ZUM 2000, p. 1082, 1084.
  - 26 Taubert, in: *Forschung und Lehre* 2009, p. 657, 658.
  - 27 Mestmäcker/Schweizer, EG Wettbewerbsrecht, sec. 2, para. 120 et seq.
  - 28 [http://oa.mpg.de/openaccess-berlin/Berliner\\_Erklaerung\\_dt\\_Version\\_07-2006.pdf](http://oa.mpg.de/openaccess-berlin/Berliner_Erklaerung_dt_Version_07-2006.pdf).
  - 29 <http://www.cedis.fu-berlin.de/veroeffentlichungen/index.html>.
  - 30 [www.projecteuclid.org](http://www.projecteuclid.org); [www.muse.jhu.edu](http://www.muse.jhu.edu); [www.highwire.stanford.edu](http://www.highwire.stanford.edu).
  - 31 Gemeinsame Erklärung der Wissenschaftsorganisationen Open Access und Urheberrecht: Kein Eingriff in die Publikationsfreiheit (*Common Declaration of the Research Institutes on Open Access and Copyright Law: No Infringement in the Publishing Freedom*), 25. March 2009, see <http://www.wissenschaftsrat.de/aktuelles-allianz.html>.
  - 32 Krüger, in: *Allgemeine Staatslehre* 2. Ed., p. 606 et seq.
  - 33 European Court of Justice (ECJ), 15.3.1994, C-387/92, (1994) E.C.R. I-877, 907, para.11.
  - 34 See Art. 3 (1)(g) EC; ECJ, 19.3.1991, (1991) E.C.R. I-1223, 1296, para. 4; Säcker, in: *Competition Law: European Community Practice and Procedure*, Intro., para. 1-1-001; Immenga/Mestmäcker, in: Immenga/Mestmäcker, *Wettbewer EG/I*, Intro. B. para. 8; Terhechte, *Die Rolle des Wettbewerbs in der europäischen Verfassung (The Role of Competition in the European Constitution)*, EuR Supplement 3, p. 107-226.
  - 35 Ehrlicke, in: Immenga/Mestmäcker, *Wettbewer EG/I*, Art 87 EC, para. 42; Koenig/Kühling/Ritter, EG-Beihilferecht (*EC-State Aid Law*), para. 67; Müller-Graff, ZHR 152 (1988), p. 403, 418.
  - 36 European Court of Justice, 15.3.1994, C-387/92, (1994) E.C.R. I-877, 907, para.11 – Banco Exterior de Espana/Aytuntanien-tode Valencia, ECJ, 27.10.1993, C-69/91, (1993) E.C.R. I-5335; Heidenhain, *Handbuch des Europäischen Beihilferechts (Handbook of European State Aid Law)*, § 3, para. 14; Huber, EuZW 2008, p. 171.
  - 37 Information Commission, O.J. C 323/1, 30.12.2006; Huber, EuZW 2008, p. 171; Frenz/Kühl, EuZW 2007, p. 172.
  - 38 Commission Regulation (EC) No 800/2008, 6.8.2008, O.J. L 214 9. August 2008; see Heinrich, *Die rechtliche Systematik der Forschungsförderung in Deutschland und den Europäischen Gemeinschaften unter Beachtung von Wissenschaftsfreiheit und Wettbewerbsrecht (Legal Aspects of Research Aid in Germany and the European Communities whilst Taking Academic Freedom and Competition Law into Account)*, 2003, p. 175 et seq; 210 et

- seq; *Bartosch*, Die neue Allgemeine Gruppenfreistellungsverordnung im EG-Beihilfenrecht (*The New Block Exemption Regulation in EC-State Aid Law*), NJW 2008, p. 3612 et seq.
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- 41 *Kleiner*, in: *Forschung und Lehre* 2009, p. 640.
- 42 *Rieble*, in: *Forschung und Lehre* 2009, p. 648, 650.
- 43 *Day*, Economics of Electronic Publishing, in: *The Journal of electronic publishing*, Vol. 1, no. 1&2, January 1995, siehe <http://www.journalofelectronicpublishing.org>.
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- 45 The European Commission`s Green Paper “Copyright Law in an Economy Determined by Knowledge” (*Urheberrechte in der wissensbestimmten Wirtschaft*) COM (2008) 466 final. , GRUR 2009, p. 135, 139, see also *Peifer*, GRUR 2009, 22 et seq.

# Internet Service Provider Liability

## The Swiss Perspective

by **Rolf H. Weber**, Zürich

Prof., Dr. iur., Director Center for Information and Communication Law, University Zurich, Visiting Professor University Hongkong

**Abstract:** Switzerland does not have a concrete legal framework dealing with rights and obligations of ISPs; however, legal doctrine and practice apply similar principles as stated in the E-Commerce Directive of the EU.

The liability of ISPs depends on the “closeness” to the content. Whereas in cases of solely transmitting services the risk of liability for illegal information is remote and the duty of ISPs is limited to a take-down, content, host and link providers (in cases of moderated newsgroups) can become liable if the information made available is not controlled.

**Keywords:** Access Provider; Host Provider; Content Provider; ISP; Switzerland; Liability

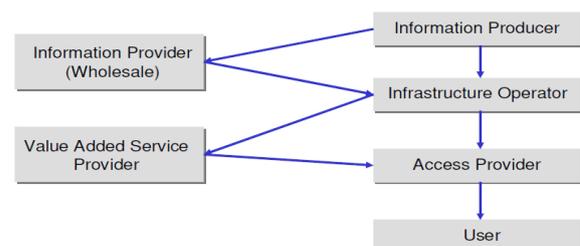
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### A. Introduction

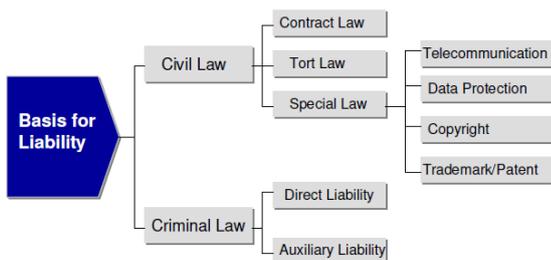
1 As an introductory remark, the following two related observations can be made: (1) Switzerland does not have a concrete legal framework dealing with Internet Service Provider (ISP) liability; and (2) Switzerland has not and most likely will not take over the corresponding provisions of the EU E-Commerce Directive of June 2000.<sup>1</sup> The Swiss Minister of Justice presented proposals for a possible revision of the Swiss Code of Obligations in 2001 encompassing rules on electronic contracting, on distance selling requirements and on ISP liability; whereas the proposals related to the electronic contracting have remained uncontested, particularly the proposals on the distance selling framework and also on ISP liability caused lively discussions. The first official reaction consisted in a “calming down” of the debate; afterwards, the subsequent Minister of Justice decided to put the file on hold and to evaluate its revitalisation at a later stage.<sup>2</sup> In February 2008, the third Minister of Justice fully “liquidated” the file, meaning that a revision of the Swiss Code of Obligations might not occur during the coming years. The “liquidation” of the file includes a potential adjustment of the Swiss Penal Code.

- 2 These facts, however, do not mean that the legal situation in Switzerland is completely different from the legal framework in the surrounding countries. Obvious similarities exist, but this diagnosis is based more on the voices of legal doctrine than on decided court cases since relevant court practice is almost inexistent.
- 3 Like the EU member states, Switzerland addresses the different participants of an information chain in the Internet in a distinct manner; liability gradually increases subject to the closeness to the illegal or offensive content. Therefore, light must be shed on the following “players” in the Internet:



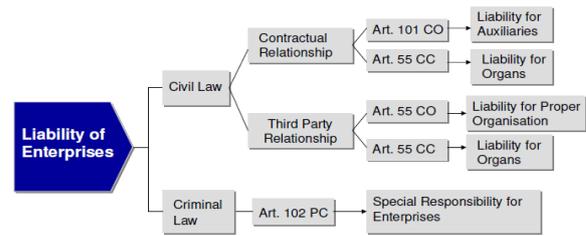
## B. Legal Framework

- 4 Looking from a general legal angle, the following situations can lead to undesired anomalies and therefore to the application of legal provisions:<sup>3</sup>
- § *Public form of the information:* The illegality of information transported by way of the Internet consists in the fact that the information becomes public and is not fully kept confidential.
  - § *Violation of privacy:* The making available of information to the public infringes the privacy and data protection provisions (Art. 28 Civil Code and Art. 15 Data Protection Act), in particular the authenticity and the integrity of information.
  - § *Content of the information:* The most important cases of illegal activities concern the content – for example, the distribution or making available of pornographic, obscene, racist and similarly critical material; mistakes in advice giving and information gathering; misleading acts in information search; unfair competition; violation of copyright; or other intellectual property rights.
  - § *Interruption of information access or problem of information transfer:* This group of anomalies encompasses technical aspects of the information delivery, including risks caused, for example, by denial-of-service attacks.
- 5 As far as the applicable legal framework is concerned, an overview leads to the following picture that encompasses various legally covered segments:

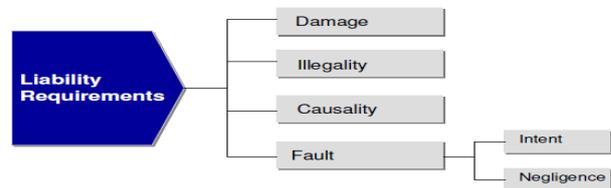


- 6 Liability can generally be based on civil or criminal law. Within the range of civil law, liability may be derived from a contractual relationship between the provider and the person concerned. If the parties involved have not entered into a contractual relationship, liability can arise from general tort law or from special laws such as copyright, trademark or data protection law. If the alleged content violates personal rights, civil liability is based on the personality right. In the criminal law framework, the provider may be held responsible directly or indirectly in an accessory function.

- 7 In respect of the civil and the criminal liability of an enterprise, specific rules dealing with recruited personnel apply:<sup>4</sup>



- 8 Generally, the four well-known elements of a liability claim need to be fulfilled in order to successfully start a legal action:



- 9 Based on this general understanding of the legal framework for the different types of ISPs, the specific legal aspects governing the Swiss legal environment will be discussed in regard to the various providers.

## C. Civil Law Differentiations for Specific Provider Types

### I. Content Provider

- 10 A content provider makes content of whatever nature (information, pictures, music, films) available to the public. Obviously, in case of harm, the content provider becomes liable. However, two major issues are at stake: on the one hand, a “clever” content provider will try to hide any traces or remain invisible and therefore not recognizable; on the other hand, a content provider could be domiciled in a jurisdiction which does not know an adequate legal framework or which does not allow the enforcement of a judgment rendered in another country.<sup>5</sup>
- 11 Contractual liability depends on whether a contract has indeed been concluded between the content provider and the person concerned. Specific problems occur if the content or information produced by the content provider is available at no charge; in that

case, it must be judged whether the parties involved had any intention to enter into a legally binding relationship. In addition, even if a contractual relationship exists between the content provider and the user, often the content is accessible free of charge, which leads to a reduction of liability according to general contractual principles for non-remunerable deliveries (Art. 99 para. 3 and Art. 44 para. 1 CO).

- 12 Copyright infringement is of crucial importance with regard to the legal position of the content provider. According to the Swiss Copyright Act (Art. 10 para. 2), the content provider – if it is not the copyright owner – is not only liable for the creation of the infringing content but also for collecting the content from third persons and making it available to third persons by uploading it on a server. The same applies for the download and integration of content created by third persons through hyperlinks.<sup>6</sup>
- 13 Similarly, a liability of the content provider can be based on Unfair Competition Law, Trademark Law or Data Protection Law if the uploaded content is not in compliance with the provisions of these laws. Furthermore, the general provisions of tort law may apply.
- 14 A specific aspect concerns the liability of the content provider under the Product Liability Law. To what extent a failure in electronic data or software can be considered a product failure is still contested; however, relevant cases in this field are not known in Switzerland. Generally, the legal doctrine is reluctant to apply Product Liability Law.<sup>7</sup>
- 15 Furthermore, according to contract law, the access provider is obliged to inform the user about upcoming access problems and also to protect its server against phishing, hacking or viral attacks. Nevertheless, access provider contracts often also contain terms about obligations of the user; mostly, such terms specifically prohibit making infringing material available.
- 16 In addition, the contractual framework can be considered sufficient grounds for an obligation of the access provider to specifically block the user's Internet access related to content being knowingly harmful to the user. So far there have been no Swiss court decisions, but such an understanding may be drawn from the general notion of a contractual framework.
- 17 The access provider is only exercising a "transport" function since normally the material is carried through an automatic technical process without acknowledgement of the access provider. Even if the usually applicable criteria of damage, illegality and causality are fulfilled, the evidence of fault in non-contractual situations must be established, which is often not easy to achieve. Legal doctrine denies an obligation of the access provider to control all possible content that can be reached through its services (similarly to Art. 12 of the E-Commerce Directive).<sup>9</sup> The fact that the access provider makes it technically possible for the user to get access to illegal content is not considered a non-diligent behaviour per se.
- 18 If, however, the access provider is advised to take down illegal content, legal doctrine generally assumes an obligation to immediately proceed to a take-down of the notified content if the complainant is reliable and the content is obviously illegal. However, it is not reasonable for the access provider to pursue every lead, so notices should be directed through a governmental agency (for example, KOBIK [Coordination Unit to Combat Internet Criminality], a special organisational unit of the federal government).<sup>10</sup> Apart from that, the illegality of content is not always visible at first glance; in particular, trademark or copyright infringements are indistinguishable for non-professionals in this area. For the time being, there is still no concrete court practice in Switzerland.<sup>11</sup>
- 19 The debate in Switzerland about the suitability and reasonableness of access blocking by the access provider is also open because a blocking may not be in compliance with freedom of expression and freedom of information as fundamental rights of the users.<sup>12</sup> Furthermore, the effect of access blocking is uncertain as such measures can be evaded easily. In such a situation, the access provider has to rely on legal advice or on the opinion of KOBIK. Since 2010, domain names suspected of being used for illegal activities can be blocked for a short time through the registry operator.

## II. Access Provider

- 15 The contractual relationship between the access provider and the user cannot qualify as a traditional contract type regulated in the Swiss Code of Obligations. Even if analogies to the provisions on Sale and Purchase Law, on Lease Law and on Mandate Law are possible, in principle the general norms on non-execution of contracts (Art. 97-109 CO) remain the most important source in case of any anomalies.<sup>8</sup> As the making available of Internet access is the main duty of the access provider, non-performance of a contract must be assumed if the user does not have access to the Internet or to the mail account. In such cases, it also has to be taken into account that malfunctions related to Internet access are part of the daily business, and the access provider is not liable for 100 percent Internet access availability. Normally, access providers commit to providing users an access ratio of 97 - 98 percent. Often this access risk is contractually transferred from the access provider to the user; however, the transfer of duties is only legally binding to the extent that the access provider complies with the general due diligence behaviour.

- 21 Similar considerations that have been developed in regard to tort law in general also apply in relation to compliance with copyright law, unfair competition law, trademark law and data protection law. A special rule applies to the telecommunications providers: user identification data must be retained during a period of six months (and disclosed to prosecution authorities), but after the expiration of this time period the respective data needs to be deleted.<sup>13</sup>

### III. Host Provider

- 22 In a webhosting agreement, the host provider leaves storage location on its server to the content provider. The contract is considered to be governed by the provisions of lease law and entrepreneur's law. Most crucial is the question whether the host provider can be held liable for illegally acting on behalf of third persons.
- 23 Similarly to Article 14 of the E-Commerce Directive, the extra-contractual liability of a host provider depends on the activities in a given situation and under the prevailing circumstances. In the case of private websites/homepages – and particularly of non-moderated newsgroups – special diligence obligations do not apply if the host provider is not advertising for its own special services. In parallel to the access provider, a host provider does not have an extensive control obligation in regard to all information available on such private websites/homepages or in non-moderated newsgroups; however, compliance with the notice-and-take-down approach is required since knowledge of illegal content can cause a liability.<sup>14</sup>
- 24 A different legal appreciation applies in the case of serviced homepages/websites and moderated newsgroups since the control activity is considered to be adequately limited because it does not exceed reasonable efforts of the provider. If a host or service provider announces in public that the content of such generally available platforms will be serviced, a similar situation to traditional media is given: the provider has to take care that illegal content is not uploaded or is removed within a short time. This obligation relates to all relevant legal provisions (copyright, unfair competition, trademark, data protection, product liability).<sup>15</sup>

### IV. Service Provider

- 25 A service provider in general can enter into different contractual relationships with a user. A mail service contract encompasses elements of a lease contract and a mandate, while an information broker or a search machine provider mainly delivers mandate services. Notwithstanding the actual qua-

lification of the contractual relationship, the traditional provisions on non-performance of contracts do apply and do not cause any specific problems in the virtual world.

### V. Link Provider

- 26 The legal position of the provider of links depends on the factual question whether its action is to be qualified as a simple transmission of the content produced by third persons or whether the provider of links – similarly to a content provider – keeps its own content available. Normally, a link provider cannot be compared with an access provider because the link provider refers to websites for their substantial content, and the link provider can check those before linking to them. However, it is not feasible for the link provider to supervise all the linked websites. Insofar, the link provider's situation is close to that of a host provider. The main legal issue concerns the suitability of a control duty of the provider setting the link.
- 27 As far as visible links (hypertext links) are concerned, the user immediately and obviously becomes aware of the fact that the link refers to a website of a third person. Nevertheless, the link provider does not completely escape any kind of liability; a similar legal treatment as in the case of a host provider seems to be justified.<sup>16</sup> Finally, it should be noted that for the link provider – even if the link provider is aware of illegal content – it is not feasible to supervise additional links (links going from the linked website to other websites).
- 28 If the link provider is setting so-called inline links and not obviously recognizable frames, giving the impression that the websites referred to are part of the website of the link provider (aspect of identity), a not limited liability regime does take place. Consequently, the link provider is liable as the content provider.<sup>17</sup>

### VI. Disclaimers and Limitation of Liability

- 29 Limitation of liability is only possible to a certain extent;<sup>18</sup> in contractual relations, fundamental obligations cannot be excluded from the stated liability, and the limitation of liability for reckless or institutional acts is null and void. However, according to Swiss law, disclaimers and clauses limiting liability apply not only in contractual relations (Art. 100/101 CO) but also, under certain conditions, in non-contractual situations.<sup>19</sup>
- 30 Switzerland has no specific law governing the use of General Business Conditions (GBC). Only a few rules

developed by court practice apply, such as the principle that General Business Conditions must be made available to the users in a transparent way and that unclear terms are to be interpreted in favour of the customer. However, court practice in Switzerland does not begin to reach the level of consumer protection given in the member states of the European Union and based on the Directive 1993 on General Business Conditions<sup>20</sup> and the Directive 2005 on Unfair Business Practices.<sup>21</sup>

- 31 As far as the visibility of General Business Conditions on the website of a provider is concerned, the legal requirements in Switzerland are relatively low. In particular, no requirement applies that would make it necessary for the user to expressly agree to the GBC by pushing a button.

## VII. Criminal Law Issues

- 32 Switzerland has ratified the Council of Europe Convention on Cybercrime (2001); the respective provisions have led to a few minor amendments of the Swiss Penal Code set to come into force in the second half of 2010 (for example, on computer hacking).<sup>22</sup>
- 33 Seven years ago, the Swiss Penal Code was revised to introduce the possibility of criminalizing enterprises apart from the sanctions that could be levied on individuals (Art. 102).<sup>23</sup> An enterprise eventually becomes criminally liable (and punishable by a fine) in the context of entrepreneurial objectives that cannot be easily allocated to an individual person. So far, this new provision has not played any practical role in relation to illegal content available on the Internet.
- 34 Apart from general criminal sanctions in cases of misuse of the freedom of expression (pornographic, obscene, racist, defamatory information), the Swiss Penal Code also covers specific computer crimes such as illegal collection of data, hacking or misuse of data collection equipment, and computer sabotage.<sup>24</sup>
- 35 For the last ten years, Switzerland has discussed the introduction of specific rules establishing the legal framework for a criminal liability of Internet service providers. However, as already mentioned, these attempts have failed. Criminal liability can arise from direct or accessory liability. A direct criminal liability of a host or an access provider is rather unlikely; the only provision that can be taken into account remains Article 322<sup>bis</sup> Penal Code, which is applicable to the media in general. This provision criminalizes those media that actively participate in making illegal information public if the author of the content cannot be found.
- 36 Since an access provider usually does not actively make available illegal content, criminal liability cannot be easily based on Article 28 and Article 322<sup>bis</sup> Penal Code.<sup>25</sup> As mentioned, an access provider only transmits material and therefore cannot be compared with a print medium editor because its part in the publication process is passive rather than active;<sup>26</sup> the same applies to the host provider. In the case of a host or service provider, a criminal sanction may only be considered for a moderated newsgroup.
- 37 Accessorial liability is possible if a provider commits “auxiliary” services and provides the means for others to commit the crime.<sup>27</sup> This notion of auxiliary services was applied once by the Swiss Supreme Court in relation to a “Telekiosk” offered through the services of the state-owned telecommunications company;<sup>28</sup> however, the decision was widely criticized with the argument that if a relevant negligence had to be assumed, a direct liability is given. Moreover, liability for auxiliary services under Swiss law requires the knowledge and the intent of the respective person that a certain offence is committed, a provision making it unlikely to be related to most access or host providers.<sup>29</sup>
- 38 To limit the risk or even to avoid criminal liability, a provider can get in touch with the above-mentioned KOBİK, which is prepared and mandated to give advice on possible lines of action.
- 39 Furthermore, it is generally assumed that service providers have a special kind of obligation to cooperate with state authorities – in particular the prosecution authorities – to combat Internet criminality. Therefore, in case of doubt, a service provider is well advised to liaise with the authorities.

## D. Conclusions

- 40 As mentioned, Switzerland does not have a concrete legal framework dealing with Internet service providers; therefore, liability of service providers needs to be assessed by the conventional legal rules. However, the legal situation is not totally different from the situation in other countries, especially in EU countries, as legal doctrine (court decisions are practically non-existent) tends to apply a similar liability regime on Internet providers as the EU E-Commerce Directive.
- 41 While content providers are responsible for all infringing or illegal materials, direct responsibility of access providers as well as host providers appears to be extremely unlikely; only in cases of serviced homepages/websites can a direct liability of host providers be taken into account. However, as soon as the access or host provider becomes aware of illegal or harmful content, legal doctrine assumes a provider’s obligation to delete the content concerned. As the legal situation in Switzerland is quite uncertain, providers are well-advised to rely on the

legal advice of state authorities in unclear situations to help avoid civil or criminal liability.

- 1 Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce), L 178 , 17/07/2000, pp. 1 et seq.
- 2 For more information, see SCHILD TRAPPE GRACE, *Strafrechtliche Verantwortlichkeit der Internet Service Provider*, Jusletter, 6. November 2000.
- 3 WEBER ROLF H., *Zivilrechtliche Haftung im Internet*, in: ARTER OLIVER/JÖRG FLORIAN S. (ed.), *Internet-Recht und Electronic Commerce Law*, Berne 2003, p.161.
- 4 **Art. 101 OC** Liability for acts of auxiliary persons:  
*If an obligor, even though authorized, has performed an obligation, or exercised a right arising out of legal relationship, through an auxiliary person, such as a co-tenant or an employee, the obligator must compensate the other party for any damages caused by the acts of the auxiliary person. The liability may be limited or excluded by prior agreement. If the party making the waiver is employed (Art. 319 et seq.) by the other party, however, or if liability arises out of the conduct of a business that is carried on under an official license, such liability may at most be waived for simple negligence.*
- Art. 55 OC:**  
*The principal shall be liable for damages caused by his employees or other auxiliary persons in the course of their employment or official capacity, unless he proves that he has taken all precautions appropriate under the circumstances in order to prevent damage of that kind, or that the damage would have occurred in spite of the application of such precautions. The principal may claim recourse from the person who caused such damage to the extent that the latter is liable in his own right (Art. 41 et seq., Art. 97 et seq.).*
- Art. 55 CC:**  
*Corporate bodies act through their official organs. These organs by their legal transactions and their other acts or commissions bind the corporate body which they represent. They are moreover personally liable for their own wrongful acts or omissions.*
- 5 WEBER, Fn 3, p. 162.
- 6 For the liability of the link provider, see C.IV.
- 7 WEBER, Fn 3, p.167.
- 8 WEBER Fn 3, p. 170.
- 9 ROSENTHAL DAVID, *Internet-Provider-Haftung – ein Sonderfall?* in: JUNG PETER (ed.) *Aktuelle Entwicklungen im Haftungsrecht*, Berne/Zurich/Basle/Geneva 2007, N 93; ROHN PATRICK, *Zivilrechtliche Verantwortlichkeit der Internet Provider nach schweizerischem Recht*, Zurich 2004, p. 247.
- 10 More information is available at: <http://www.cybercrime.ch/>.
- 11 ROSENTHAL, Fn 9 N 98 et seq.; ROHN, Fn 9, pp. 252 et seq.
- 12 ROSENTHAL, Fn 9, N 100; ROHN, Fn 9, p. 252.
- 13 SCHNEIDER JÜRG, *Internet Service Provider im Spannungsfeld zwischen Fernmeldegeheimnis und Mitwirkungspflichten bei der Überwachung des E-Mail-Verkehrs über das Internet*, AJP 2005, pp. 179 et seq.
- 14 WEBER, Fn 3, p. 176.
- 15 WEBER, Fn 3, p. 177; ROHN, Fn 9, p. 208.
- 16 WEBER, Fn 3, p. 184.
- 17 WEBER, Fn 3, p. 185.
- 18 WEBER, Fn 3, p.190; CEREGHETTI LEONARDO, *Disclaimers und Haftungsfreizeichnungen im E-Commerce*, sic! 2002, pp. 1 et seq., p. 13.
- 19 WEBER, Fn 3, p.189.
- 20 Directive 93/13/EEC of the European Parliament and of the Council of 5 April 1993 on unfair terms in consumer contracts, L 095, 21/04/1993, pp. 29 et seq.
- 21 Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market and amending Council Directive 84/450/EEC, Directives 97/7/EC, 98/27/EC and 2002/65/EC of the European Parliament and of the Council and Regulation (EC) No 2006/2004 of the European Parliament and of the Council (“Unfair Commercial Practices Directive”), L 149/22, 11/06/2005, pp. 22 et seq.
- 22 Bundesbeschluss über die Genehmigung und die Umsetzung der Europaratskonvention über Cyberkriminalität, available at [http://www.ejpd.admin.ch/ejpd/de/home/themen/kriminalitaet/ref\\_gesetzgebung/ref\\_cybercrime\\_\\_europarat.html](http://www.ejpd.admin.ch/ejpd/de/home/themen/kriminalitaet/ref_gesetzgebung/ref_cybercrime__europarat.html).
- 23 For more information, see WOHLERS WOLFGANG, *Die Strafbarkeit des Unternehmens – Art. 102 StGB als Instrument zur Aktivierung individualstrafrechtlicher Verantwortlichkeit*, Festschrift für Franz Riklin, Zurich 2007, pp. 287 et seq.
- 24 SCHWARZENEGGER CHRISTIAN, *E-Commerce – Die strafrechtliche Dimension*, in: ARTER OLIVER/JÖRG FLORIAN S. (ed.), *Internet-Recht und Electronic Commerce Law*, Zurich 2001, pp. 342 et seq.
- 25 SCHWARZENEGGER, Fn 24, p. 351.
- 26 SCHWARZENEGGER, Fn 24, p. 351; DONATSCH ANDREAS/TAG BRIGITTE, *Strafrecht I*, 8th ed., Zurich 2008, p. 205.
- 27 See also SCHWARZENEGGER, Fn 24, pp. 349 et seq.
- 28 BGE 121 IV 109, available at <http://www.bge.ch>.
- 29 SCHWARZENEGGER CHRISTIAN/NIGGLI MARCEL ALEXANDER, *Über die Strafbarkeit des Hyperlink-Setzers*, Zum Urteil des Bezirksgerichts Zürich vom 10. September 2002, *Medialex* 2003, pp. 27 et seq.

# Internet Service Providers' Liability in Spain

## Recent Case Law and Future Perspectives

by Miquel Peguera, Barcelona

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**Abstract:** The article focuses on the current situation of Spanish case law on ISP liability. It starts by presenting the more salient peculiarities of the Spanish transposition of the safe harbours laid down in the E-Commerce Directive. These peculiarities relate to the knowledge requirement of the hosting safe harbour, and to the safe harbour for information location tools. The article then provides an overview of the cases decided so far with regard to each of the safe harbours. Very few cases have dealt with the mere conduit and the caching safe harbours, though the latter was discussed in an interesting case involving Google's cache. Most cases relate to hosting and linking safe harbours. With regard

to hosting, the article focuses particularly on the two judgments handed down by the Supreme Court that hold an open interpretation of actual knowledge, an issue where courts had so far been split. Cases involving the linking safe harbour have mainly dealt with websites offering P2P download links. Accordingly, the article explores the legal actions brought against these sites, which for the moment have been unsuccessful. The new legislative initiative to fight against digital piracy – the Sustainable Economy Bill – is also analyzed. After the conclusion, the article provides an Annex listing the cases that have dealt with ISP liability in Spain since the safe harbours scheme was transposed into Spanish law.

**Keywords:** ISP liability; Spain; Case Law Review; Hosting Provider; Link Provider; Sustainable Economy Bill

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### A. Introduction

1 Ten years have passed since the European Directive on Electronic Commerce (ECD) was adopted on 8 June 2000.<sup>1</sup> One of the key aims of the Directive was to address the disparities in Member States' legislation and case law with regard to the liability of information society service providers acting as intermediaries. To this end the ECD set forth a series of exemptions from liability for specific intermediary activities, namely *mere conduit*, *caching* and *hosting*. Under these exemptions – also known as *safe harbours* – established in Articles 12 through 14 ECD, intermediaries providing those services cannot be held liable for the third-party information they transmit, cache or host, as long as they meet the requirements set forth in the relevant provisions.<sup>2</sup> In addition, with

respect to the services covered by the liability exemptions, Article 15.1 ECD prohibits Member States from imposing on intermediaries a general obligation to monitor the information they transmit or store, or a general obligation to actively seek facts or circumstances that may indicate illegal activity.<sup>3</sup>

2 This safe harbour scheme was largely inspired by the provisions set forth in the US Digital Millennium Copyright Act (DMCA), enacted in 1998,<sup>4</sup> which also establishes a number of safe harbours to limit the potential liability of Internet intermediaries – albeit exclusively in the field of copyright.<sup>5</sup> The ECD selects indeed the same intermediary activities as those covered by the DMCA – with the exception of the provision of hyperlinks and information location tools. Moreover, many of the requirements to benefit from the exemptions are the same under both statutes.

However, their basic approaches differ notably as – unlike the DMCA – the European Directive does not focus exclusively on liability arising from copyright infringement. Rather, it covers intermediaries' liability in a horizontal way for any kind of unlawful content provided by their users. In addition – among other differences – the ECD does not provide for a procedure to notify intermediaries of the presence of unlawful material, and to ask them to take it down – the so-called *notice-and-take-down* procedure, which constitutes a key element of the DMCA.<sup>6</sup>

- 3 In general, transpositions of the safe harbours into Member States' national law have closely followed the language of the ECD.<sup>7</sup> In some cases, however, there have been deviations that pose the problem of whether some transposition measures are compatible with the ECD. Moreover, the interpretation of the liability exemptions is proving to be a difficult task. Some of the difficulties consist of determining the scope of the safe harbours, in particular of that related to hosting – especially in view of the new services that have emerged in recent years, generally referred to as Web 2.0. Indeed, the applicability of the hosting safe harbour has already been the subject of some referrals to the European Court of Justice.<sup>8</sup>
- 4 This article will focus on the particular case of Spain. Part B will present the peculiarities of the Spanish transposition. Part C will examine the current trends of Spanish case law, considering the main developments with regard to each of the liability exemptions, particularly that of hosting and that of linking. Next, Part D will briefly consider the provisions of the Sustainable Economy Bill, which intend to be an effective way of preventing copyright infringement by targeting information society service providers that violate copyright. Part E will briefly offer some conclusions on these matters. Finally, the Annex to this article will list the rulings issued in Spain so far dealing with ISP liability.

## B. Some peculiarities of the Spanish transposition

- 5 The ECD was transposed into Spanish national law by means of Law 34/2002 of 11 July 2002, on Information Society Services and Electronic Commerce (hereinafter LSSICE, the Spanish abbreviation).<sup>9</sup> The system of liability limitations is laid down in Articles 13 through 17 of this law.
- 6 The first point worth noting is that – notwithstanding Article 15 ECD – the LSSICE does not contain any reference to the fact that intermediary service providers cannot be subject to general obligations of monitoring or seeking facts or circumstances revealing illegal activity or information. In addition,

the LSSICE provisions establishing safe harbours do not explicitly mention the possibility of injunctions, whereas Articles 12.3, 13.2 and 14.3 ECD state that the liability exemptions “shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement.”

- 7 The safe harbours for *mere conduit* (Art. 14 LSSICE) and *caching* (Art. 15 LSSICE) reproduce almost verbatim the language of those established by the ECD (Arts. 12 and 13, respectively). On the other hand, the safe harbour for hosting (Art. 16 LSSICE) presents some relevant deviations from that laid down in the ECD, particularly with regard to the lack of knowledge requirement. Finally, the LSSICE adds a new exemption not provided for in the ECD, which deals with hyperlinks and information location tools (Art. 17 LSSICE).

## I. Actual knowledge and awareness of facts or circumstances indicating illegal activity

- 8 The basic requirement for limiting the potential liability of hosting providers is that the provider must not know about the illegality of the third-party material. This is consistent with the rationale behind the safe harbour, which rests upon the assumption that the service provided is of a passive nature. Only when the presence of the illegal material comes to its knowledge is the provider required to take it down in order to benefit from the exemption. This general principle is laid down in the ECD considering two different kinds of knowledge – actual and constructive. Article 14.1(a) ECD sets forth the condition that the provider does not have *actual knowledge*, and that when it comes to claims for damages – i.e. civil liability – it must also lack *awareness* “of facts or circumstances from which the illegal activity or information is apparent.” Thus, a two-tiered standard is set forth: lack of *actual* knowledge for claims other than for damages, and lack of *constructive* knowledge in case of claims for damages. As some commentators have pointed out, this distinction based on the type of claim corresponds to the criminal/civil liability distinction.<sup>10</sup> Indeed, this was already clearly stated in the ECD Proposal.<sup>11</sup>
- 9 Article 16 of LSSICE, however, establishes a single standard consisting of the lack of *actual knowledge*. The provision does not distinguish between different types of claims, and disregards altogether the constructive knowledge standard. As a consequence, a hosting provider would in theory be free from any liability arising from the content hosted – even as regards claims for damages – as long as it does not have *actual knowledge* of illegal activity or informa-

tion. Merely being aware of facts or circumstances indicating illegal content would not disqualify the provider from the safe harbour.

- 10 A second deviation from the ECD concerns the concept of actual knowledge itself. While the ECD does not provide a definition, the LSSICE does offer a legal notion of what should be understood by actual knowledge in Article 16.1.II. It conceptualizes this type of knowledge in an extremely narrow way:

*It will be understood that the service provider has the actual knowledge referred to in [...] when a competent body has declared that the data are unlawful, or has ordered their removal or the disablement of access to them, or the existence of the damage has been declared, and the provider knew of this decision, without prejudice to the procedures of detection and removal of content that providers may apply by virtue of voluntary agreements, and without prejudice to other means of actual knowledge that might be established.<sup>12</sup>*

- 11 According to a strict construction of this provision, there are only three ways in which a hosting provider may gain the relevant knowledge. The first one is the existence of a prior decision, issued either by a judicial court or by an administrative body within its field of competence, concerning the hosted content. This decision may be one declaring that content to be illegal – or that it damages someone else's rights – or simply a decision ordering the content to be removed or access to it to be disabled. The second way of gaining actual knowledge refers to cases where voluntary notice and take-down agreements are in place – something that seldom occurs. The third way, somewhat undefined, concerns the possibility of establishing other means of actual knowledge – which probably relates to future regulatory instruments.
- 12 While this provision – strictly construed – affords a great deal of legal certainty to the provider, it doesn't appear to be compatible with the notion of actual knowledge laid down in the ECD's hosting safe harbour, which is obviously wider. Moreover, it grants in practice a nearly blanket immunity for the provider, particularly taking into account that, as noted, neither the ECD nor the LSSICE provides for a procedure of notice and take-down.
- 13 Spanish courts have wrestled over how to construe this provision. Some rulings have taken the strict view that only in the cases contemplated by this article does the provider have the relevant knowledge, while others have chosen a more open reading, admitting other ways of gaining this knowledge. Interestingly – as we will discuss in more detail later – the Spanish Supreme Court issued a judgment in December 2009 that explicitly rejects the strict construction of this article on the grounds that it is not in accordance with the ECD

## II. Safe harbour for information location tools

- 14 The ECD – unlike the DMCA – chose not to establish a safe harbour for information location tools, a choice that was criticized by commentators.<sup>13</sup> The reason for not providing for such a safe harbour remains unclear. In any event, Article 21, which relates to the re-examination of the Directive, establishes that every two years the European Commission shall submit a report concerning the application of the Directive, “accompanied, where necessary, by proposals for adapting it to legal, technical and economic developments in the field of information society services.” This report, according to Article 21.2, “shall in particular analyse the need for proposals concerning the liability of providers of hyperlinks and location tool services, ‘notice and take down’ procedures and the attribution of liability following the taking down of content.” The only report submitted so far, however, does not contain any proposal to amend the Directive so as to include a safe harbour for information location tools.<sup>14</sup>
- 15 The Spanish transposition law added a specific liability exemption for information location tools, modelled upon the hosting safe harbour. According to this provision – laid down in Article 17 LSSICE – information society service providers that provide links, directories or information search tools shall not be liable for the information to which they lead their users. This liability limitation is subject to the condition that the provider does not have *actual knowledge* that the activity or the information to which it directs, or which it recommends, is illegal, or that it damages a third party's goods or rights. In case the provider obtains such knowledge, it must act diligently to remove or to disable the link, in order to benefit from the exemption.
- 16 These conditions are the same as those required in the hosting safe harbour – the only difference being that in the safe harbour for information location tools the illegality relates to the linked content instead of to the hosted content. Moreover, the notion of *actual knowledge* that contemplates this provision is exactly the same as that contemplated under the hosting safe harbour. Indeed, Article 17.1.II LSSICE replicates verbatim the text of Article 16.1.II quoted above. Thus, the same kind of concerns arise, as to whether this is an excessively narrow concept of what amounts to actual knowledge. It is worth noting, however, that in the case of linking there is no possible contradiction with the ECD, as it does not provide for a safe harbour for these activities – and thus does not give any indication as to what should be considered actual knowledge in a liability exemption for linking.

17 The safe harbour for information location tools covers a wide variety of activities, which may range from the operation of a search engine such as *Google* or *Bing* to the inclusion of a hyperlink on a website or on a blog. Whatever the case may be, the requirements would be the same – mirroring those of the safe harbour for hosting. Interestingly, another Member State has established two different safe harbours, one for search engines and another for links. The one for search engines – whose activity is more of a passive and automatic nature – mirrors the conditions set forth in the transmission safe harbour, whereas that for links replicates the requirements of the exemption for hosting.<sup>15</sup>

## C. Case Law

18 So far, Spanish courts have issued rulings in some fifty cases dealing with the liability of Internet intermediaries.<sup>16</sup> Around half of the cases relate to defamatory content – particularly comments submitted by users to blogs, wikis and forums. Roughly the other half of the reported cases relate to the liability of websites that provide links to copyrighted content, whether in the form of P2P download links or in the form of links to files hosted on third-party servers. In addition, there have been a few other cases dealing also with copyright, including a lawsuit brought by a television company against YouTube, and a case that deals with Google’s cache.

19 After the eight years since the LSSICE was passed in July 2000, the Spanish Supreme Court recently handed down its first two decisions on intermediaries’ liability, both dealing with defamatory third-party content and discussing the application of the hosting safe harbour – Article 16 LSSICE. These rulings are certainly important as the decisions from lower courts on this matter have been far from uniform, especially with regard to what amounts to *actual knowledge*. The Supreme Court, as we will see below, has adopted an open interpretation of actual knowledge on the grounds that a strict one would run afoul of the ECD, which contemplates not only actual knowledge but also awareness of facts and circumstances revealing illegal content.

20 The following subparts will highlight some relevant aspects of the case law dealing with each safe harbour – mere conduit, caching, hosting and linking.

### I. Mere conduit and injunctive relief: *Emi v. Bitmailer*

21 *Emi Music Spain v. Bitmailer* is one of the very few cases that have discussed the mere conduit safe harbour – Article 14 LSSICE.<sup>17</sup> The defendant, Bitmailer, was the access provider of *weblisten.com*, a website

engaged in copyright infringement. The plaintiffs, Emi Music Spain and other music companies, requested an injunction against Bitmailer to cease providing the service to the infringing website. The court rejected the measure on the grounds that the mere conduit safe harbour set forth in Article 14 LSSICE shields access providers from injunctions.

22 It must be noted that ECD safe harbours do admit the possibility of injunctive relief against a qualifying service provider. As stated in Recital 45,

*[t]he limitations of the liability of intermediary service providers established in this Directive do not affect the possibility of injunctions of different kinds; such injunctions can in particular consist of orders by courts or administrative authorities requiring the termination or prevention of any infringement, including the removal of illegal information or the disabling of access to it.*<sup>18</sup>

23 This principle is further implemented in the language of each of the safe harbour provisions by stating that the limitation of liability “shall not affect the possibility for a court or administrative authority, in accordance with Member States’ legal systems, of requiring the service provider to terminate or prevent an infringement.”<sup>19</sup>

24 The ECD does not oblige Member States to provide for injunctive relief under their national law. Rather, it simply establishes that the safe harbours do not prevent the issuance of injunctions against intermediaries, as long as those injunctions are ordered according to national law. The availability of injunctions thus hinges on the law of each Member State, and will easily differ from one state to another, and from one field – such as copyright – to another – such as defamation. Actually, given the horizontal approach of the ECD, the injunctions envisioned may relate not only to copyright infringement, but to all types of possible unlawful content, as national law may provide.

25 However, the safe harbours set forth in the Spanish LSSICE, unlike those in the ECD, do not explicitly mention that they will not affect the possibility of injunctions against a qualifying provider. Yet this hardly can be considered an obstacle to granting injunction relief. The language of the safe harbours in the LSSICE simply states that a qualifying service provider will not be *liable* – which under Spanish law doesn’t mean it cannot be ordered to stop providing a particular service in order to terminate or prevent an illegal activity carried out by a recipient of the service.<sup>20</sup>

26 In the *Bitmailer* case the court pointed out that the mere conduit safe harbour – unlike the caching and hosting safe harbours – does not impose a duty to stop providing the service once the provider knows about the illegal nature of the information. According to the court, that means that a qualifying access provider cannot be sued for injunctive relief, a

conclusion that certainly seems to run afoul of the ECD. In any event, it must be observed that the case was decided before the transposition of the Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights, which explicitly provides for injunction relief against intermediaries.

## II. Caching: Megakinki v. Google

- 27 The *caching* safe harbour (Art. 13 ECD and Art. 15 LSSICE) is a very technical one. It exempts from liability operators that engage in *proxy caching* and subjects that liability limitation to very detailed requirements. Not a single case involving a true situation of *proxy caching* has been brought in Spain – and the situation is probably the same in other Member States. The same can be said of the United States, with regard to the caching safe harbour established in the Digital Millennium Copyright Act, the provision the ECD took as a model to draft this liability exemption.<sup>21</sup> While this safe harbour has been discussed in a few cases in Europe and in the US, they did not really involve the case provided for in that provision. In fact, those cases dealt with the operation of search engines cache, which is a completely different function than that contemplated by the safe harbour, both in the DMCA and in the ECD – and of course in the LSSICE.<sup>22</sup>
- 28 One of these cases was argued before Spanish courts and is currently pending before the Supreme Court. The case is *Megakini v. Google*, also known as the *Google cache* case.<sup>23</sup> As noted, the case does not deal with the *proxy caching* function, but with the search engine's feature of providing so-called *cached* links. However, it does discuss the applicability of the caching safe harbour.
- 29 The owner of the website [www.megakini.com](http://www.megakini.com) sued Google, claiming the search engine had violated his copyright over the website. He alleged that the short excerpt or “snippet” appearing just below the main link to his website in Google's search results page was a copyright violation, as it was a non-authorized copy of part of the website's content. Moreover, he contended that Google's acts of reproducing and making available a *cached* copy of the website by means of a “cached” link constituted a copyright infringement as well. This “cached” link is shown just after the snippet. When it is clicked, the user is led not to the actual web page, but to the copy or “snapshot” of that page that Google took when crawling the web, which is stored by the search engine until the next time its robot visits the page and takes a new “snapshot.”<sup>24</sup> The claimant requested an injunction so that Google would stop performing these activities, and asked for a small monetary compensation for the allegedly suffered harm.
- 30 The court of first instance rejected the plaintiff's claim.<sup>25</sup> It held that the type of use Google was carrying out was protected under a joint interpretation of Article 31 of the Spanish Copyright Act (TRLPI)<sup>26</sup> and Articles 15 and 17 LSSICE – the caching and linking safe harbours. Apparently, the court considered that the caching safe harbour applied to Google's cache. Moreover, it held that the linking safe harbour implicitly exempted from liability the reproductions needed to perform the indexation and the search function activities – which would only be infringing if the provider did not meet the requirements of that safe harbour. Unfortunately, the ruling is not very precise. When it mentions Article 31 TRLPI, it is not even clear whether it means that the exception for transient copies set forth in that article – which transposes the exception for temporary reproductions laid down in Article 5.1 of the Directive 2001/29 – applies,<sup>27</sup> or whether it simply means that Articles 15 and 17 LSSICE are also *limits* to copyright, just like those listed in Articles 31 and following of the TRLPI.
- 31 The judgment was appealed by the plaintiff. The court of appeals confirmed that Google was not liable, but on different grounds.<sup>28</sup> On appeal, the plaintiff identified three types of uses of his work – the Megakini website – in which Google engaged. The first one was the initial – and internal – copies that Google's robots make, for indexation purposes, of every webpage they find. The plaintiff conceded that those copies are necessary for the search engine to perform the searches, and thus he did not question them. Actually, the plaintiff admitted that they fall under the exception of technical copies set forth in Article 31.1 TRLPI (Art. 5.1 of the InfoSoc Directive), and thus they were not infringing. This was also accepted by the defendant, and therefore those copies were not an issue between the parties. The court pointed out that indeed these copies seem to fall under the said exception. However, it did not elaborate much on this, concluding that “at least the parties have so agreed.”<sup>29</sup>
- 32 The second type of Google's use the plaintiff identified was that of showing a snippet from the website just below the main link in the search results page. The plaintiff-appellant insisted that this was a copyright violation, but the court of appeals considered it to be *de minimis*. The third type of use was that involved in the provision of the “cached” link. The plaintiff contended that this was a reproduction that was neither necessary to carry out the search function nor covered by any exception. As the court rightly pointed out, the discussion was actually about the legality of *making available* the cached copy – a copy already made by Google's robots when crawling the web and stored on Google's servers.
- 33 Notwithstanding Google's contention and what was held by the lower court, the storing and making

available of those *cached* copies is not the function contemplated by the caching safe harbour. The language of Article 15 LSSICE – which closely follows that of Article 13 ECD – clearly shows that it is considering exclusively the so-called *proxy caching*. This is an activity that some access providers perform by means of a *proxy server*, consisting of keeping a copy of a webpage that a first user has requested, so that when a subsequent user requests the same page the provider can show to this user the cached copy as a substitute for the original. This way, the ISP avoids having to fetch again the information from the origin source, and thus it saves time and bandwidth. This function is different from that performed by Google's cache. Google is not a transmission service provider that serves web page requests from users. It does not create a cached copy of a webpage while responding to a request from a user; rather it copies all the pages in the first place on its own initiative. By means of *cached* links, Google makes those copies available to users much in the way of an archive – acknowledging that the cached copy may not reflect the current state of the original webpage, as this may have changed since that snapshot was taken by Google's robot.<sup>30</sup>

- 34 Interestingly, the court of appeals distinguished these two different functions, and rightly concluded that the Google cache does not fall under the caching safe harbour of Article 15 LSSICE – against what had been held by the court of first instance. In addition – again in contrast with the lower court – it held that the linking safe harbour of Article 17 LSSICE did not apply either, as it relates to the searching function and not to the making available of the cached copies stored on Google's servers. It also held that the making available of cached copies is not covered by the exception of Article 5.1 of the InfoSoc Directive (Art. 31.1 LSSICE) as it is not necessary to carry out the search function. Moreover, although the ruling did not point it out, this exception, even if it is deemed to be applicable to the making of the cached copies, would never cover the making available of those copies, as the exception concerns only the reproduction right.<sup>31</sup>
- 35 After excluding the applicability of all those protections, the court of appeals concluded nonetheless that, in that particular case, the making available of cached copies was not a copyright infringement. The reasoning of the court is an interesting one, and its analysis goes beyond the purpose of this article. Essentially, the court held that Article 40 bis of the TRLPI – which introduces the three-step test into the text of the Spanish Copyright Law – may be not only an interpretation criterion to construe the scope of the exceptions set forth in the TRLPI, but also a way through which courts may ask themselves about the limits of the concerned rights, beyond the literalness of the exceptions. The court asserted that something similar to the Anglo-Saxon doctrine

of fair use should guide a court's interpretation of the scope of intellectual property rights. It held that, ultimately, courts should apply to the context of intellectual property rights a limit similar to that of *ius usus innocui* in the context of movable and real estate property – the right of using someone else's property in a way that does not harm its owner, with a rationale of preventing an overreaching protection of the owner's right. It further concluded that, in the present case, Google's acts did not harm the plaintiff's rights, and were even implicitly accepted by the plaintiff as he published his website without restricting the access to it in any way. Therefore, the defendant Google was held not liable of copyright infringement. As noted, this ruling was further appealed by the plaintiff before the Supreme Court, which will definitely decide on the case.

### III. Hosting

#### 1. The Spanish Supreme Court's interpretation of *actual knowledge*

- 36 As already pointed out, the Spanish safe harbour for hosting activities departs from that of the ECD as regards the kind of knowledge contemplated therein. In cases involving hosting, courts have split over how to construe the notion of “actual knowledge”. Some courts have held a strict construction, which in practice implies that the provider lacks actual knowledge unless a court has previously issued a decision declaring the hosted content to be illegal. Some others have followed an open, non-limitative interpretation – admitting other means of obtaining actual knowledge. That is why it is worth briefly discussing in the following subparts the two cases already decided by the Spanish Supreme Court involving the hosting safe harbour, where an open interpretation of “actual knowledge” has finally been established.

#### a.) SGAE v. Asociación of Internautas

- 37 *SGAE v. Asociación de Internautas* is the first case dealing with ISP liability that reached the Spanish Supreme Court. It deals with the liability of the *Asociación de Internautas* (AI, an Internet users association) with regard to the hosting of a gripe site with defamatory content.<sup>32</sup>
- 38 It appears that it all started when a group of internet users – the *Plataforma de coordinación de movilizaciones contra la SGAE* – put up a gripe site against SGAE, a Spanish collective rights management society. This group registered the domain name “putasgae.com” – a word combination clearly derogatory with respect to SGAE.<sup>33</sup> In 2002, SGAE filed a complaint be-

fore the WIPO Arbitration and Mediation Center under the Uniform Domain-Name Dispute-Resolution Policy (UDRP). In a decision dated 18 December 2002, the panellist found against the defendant registrant and ordered the cancellation of the domain name.<sup>34</sup> As a consequence, the gripe website went silent, and the *Asociación de Internautas* agreed to shelter it under its own website, located at “internautas.org”. On 21 February 2003, AI posted a note on its website under the title “A space of freedom comes back to the Net”.<sup>35</sup> There AI explained how the registrants of “putasgae.com” had lost their domain name after the UDRP decision. The note stressed that, leaving aside how appropriate the name *putasgae* may be, the group against SGAE was fighting for a good cause – the cause against the system of levies on private copies. AI announced that from that moment on it would offer organisational and legal support to the group, and also a space on its own website, under a third level domain name – “antisgae.internautas.org”. In this space, the content created by the *Plataforma* were hosted. Actually, the *Plataforma* owned a new domain by then, “putasgae.org”, which was redirected to the said third-level domain in the AI servers.<sup>36</sup> Although in choosing “antisgae” as a third-level domain name AI carefully avoided using the derogatory word combination, the website hosted under it did use the term “putaSGAE” as the title of the site, even using a logo resembling that of SGAE, with the addition of the offensive word “puta”.<sup>37</sup>

- 39 In March 2004, SGAE and its President, Eduardo (Teddy) Bautista, filed a civil lawsuit against AI before Madrid’s Court of First Instance, claiming that the web hosted under “antisgae.internautas.org” included numerous defamatory statements against the plaintiffs. The plaintiffs asked the court to order the removal of the offensive statements, including the domain name “putasgae.org”. The complaint asked also for 18,000 Euros in damages for each of the claimants to compensate their moral harm.<sup>38</sup> Once AI learned about the filing of the lawsuit, it required the *Plataforma* to provisionally remove from the site all the materials the complaint cited as defamatory, which the *Plataforma* did.
- 40 Surprisingly, the defendant AI appeared as the registrant of “putasgae.org” in the WHOIS database. AI contended that the *Plataforma* had fraudulently used AI’s name in the registration process. It also alleged that it acted simply as a hosting provider and did not create the allegedly defamatory statements; rather, they were created by the *Plataforma*. The court held that all this, even if it were true, was irrelevant to the case. It simply would mean that not only AI but also the *Plataforma* would be responsible for the libel, but plaintiffs are free to choose whom to sue. The court stressed that the defendant admitted it hosted the content produced by the *Plataforma*. This was enough, according to the court, to hold AI liable, as “the one that provides the service must also con-

trol what is published on its pages, because if it provides its domain for some content to be published it also can, and must, prevent their publication if they are illicit.”<sup>39</sup> It is striking that the ruling made no reference whatsoever to the LSSICE, although the defendant had expressly alleged being shielded by the hosting safe harbour in its opposition to the complaint.<sup>40</sup> The court held AI liable and awarded 18,000 Euros in damages to each plaintiff.

- 41 The defendant appealed the ruling before the Madrid Court of Appeals (*Audiencia Provincial de Madrid*). Among the defenses put forward in the appeal were the neutral report doctrine and the fact that the court of first instance had disregarded altogether the defense based in the application of the hosting safe harbour set forth in Article 16 LSSICE, which had been raised by the defendant in its opposition to the complaint.
- 42 The court of Appeals acknowledged the existence of the LSSICE, but stated that it does not prevent the application of other norms, such as the Organic Law 1/1982 of 5 May on the civil protection of the right to honour, to personal and family privacy and to one’s own image – the law upon which the plaintiffs based their claim. The court stated that liability for illegitimate interferences with the fundamental rights to honour, to personal and family privacy and to one’s own image lies with the author and the publisher of the illicit information, but also with the service provider on the basis of its actual knowledge and technical ability to control the information. Having said this, the court took into account the fact that the domain name “putasgae.org” had been registered under the defendant’s own name, and that it failed to produce any evidence that would destroy the strong presumption of the domain name’s ownership that arises from that fact. In addition, the court weighed the fact that – as stated in the opposition to the complaint – the defendant actively holds opposite views to SGAE as regards the levies on private copies. As a result, the court rested fully convinced of the defendant’s liability as to the term “putasgae” and as to the illicit content.
- 43 The ruling was appealed for cassation before the Supreme Court,<sup>41</sup> which handed down its judgment on 9 December 2009, affirming the challenged ruling and thus the liability of the appellant.<sup>42</sup> In its brief before the Supreme Court, the *Asociación de Internautas* put forward two legal grounds or “cassational motives”. The first one was that the appealed ruling infringed the principles of freedom of expression and information enshrined in Article 20 of the Spanish Constitution. The second one was that the ruling failed to apply the limitation from liability set forth in Article 16 LSSICE. In its first motive, the appellant contended that if a hosting provider can be liable for the third-party content it hosts, this means it must control the content, and this will end up

by limiting the freedom of expression of the recipients of its service – those who want to have their content hosted. The appellate brief recalled that in order to avoid such a risk for free speech, the ECD and the LSSICE established a safe harbour for hosting service providers. The Supreme Court reasoned that precisely the equilibrium between the right to freedom of expression and the right to honour was established through the safe harbours. Therefore, the court focused the discussion on whether or not the appealed ruling failed to correctly apply the LSSICE – and did not further elaborate on the alleged violation of the principle of freedom of expression. Hence the court came to the crucial point of how Article 16 LSSICE – and particularly its notion of actual knowledge – must be construed.

- 44 The AI claimed that it was protected by the safe harbour because it didn't have "actual knowledge" of the illegal content. As discussed above, Article 16 LSSICE – unlike the ECD – contemplates a number of specific ways for the service provider to gain actual knowledge. The appellant admitted that this provision may be construed in two different ways, namely, a strict interpretation and an open one. Under the strict interpretation – the one favoured by the *Asociación* – for a service provider to have actual knowledge, there should have been a prior decision declaring the material to be illegal – absent a voluntary agreement of notice and take-down and other means of actual knowledge established by the law. Because such a prior decision did not exist, the *Asociación* had not obtained the actual knowledge contemplated by Article 16.1 LSSICE and thus it met the requirements to benefit from the liability limitation. The more open interpretation would construe the list of ways to gain actual knowledge as a merely indicative, non-closed list. The appellant contended that even if this interpretation were to be followed, it still lacked actual knowledge, as actual knowledge cannot be presumed but must be demonstrated by the plaintiff, which, according to AI, had not been the case. It argued moreover that actual knowledge must be related not only to the presence of the materials but to its illegal nature, which cannot be determined by a service provider.
- 45 The Supreme Court didn't accept the defendant-appellants' view. According to the court, a construction of Article 16 LSSICE such as that put forward by the appellant is not in accordance with the ECD because it unreasonably limits the possibilities of obtaining actual knowledge of the illegal content hosted, and, in turn, it broadens the scope of the exemption with respect to that envisioned by the ECD. To support this view, the court said that, actually, the language of Article 16 LSSICE allows an interpretation in accordance with the ECD, as it mentions "other means of actual knowledge that may be established". It assumed, thus, that this language refers not necessarily to future legislative measures, but simply

to other ways of assessing whether the provider has the relevant knowledge. Moreover, the court said that, in any event, it cannot be disregarded that the ECD attaches to awareness "of facts or circumstances from which the illegal activity or information is apparent" the same effects as to actual knowledge.<sup>43</sup> According to the Supreme Court, this was precisely the assessment made by the court of appeals, which considered that the domain name "putasgae.org" was a red flag – a circumstance from which the illegality of the hosted content should have been apparent to the provider. Indeed, the court of appeals concluded that *Asociación de Internautas* had had this awareness, and because it failed to meet the duty of care required by Article 16.1(b) LSSICE – acting expeditiously to remove or to disable access to the information upon obtaining such awareness – it could not benefit from the safe harbour. Therefore, the claim that the court of appeals failed to apply the LSSICE was dismissed by the Supreme Court, which affirmed the ruling holding the *Asociación de Internautas* liable.

## b.) The *Quejasonline* case

- 46 Some months after the judgment in *SGAE v. Asociación de Internautas*, the Spanish Supreme Court issued another ruling involving the hosting safe harbour.<sup>44</sup> The case deals with the liability of an Internet forum for third-party comments.
- 47 The defendant was the company Ruboskizo, S.L., which owns the forum [www.quejasonline.com](http://www.quejasonline.com), a site intended for people to complain online about different topics. The plaintiff was a Valencian lawyer whose reputation was harmed by a comment posted to the forum by someone who fraudulently used his name. In the comment, the user impersonating the Valencian lawyer expressed derogatory remarks against the plaintiff's main client. When he heard about the post he immediately notified Ruboskizo, who quickly removed it. However, Ruboskizo refused to reveal the identity of the poster.
- 48 The aggrieved party then filed a lawsuit against Ruboskizo, which was held liable by the court of first instance.<sup>45</sup> The defendant appealed, and the court of appeals (*Audiencia Provincial de Valencia*) affirmed the ruling.<sup>46</sup> Ruboskizo appealed on cassation to the Supreme Court, alleging that the court of appeals failed to apply the safe harbour scheme laid down in the ECD (Arts. 14 and 15) and in the LSSICE. The Supreme Court reversed the ruling, holding that the court of appeals didn't take into account those provisions – and thus didn't consider whether the defendant qualified for the exemption from liability.<sup>47</sup> The Supreme Court found that Ruboskizo had not had actual knowledge or awareness of facts or circumstances revealing the illegal nature of the offensive comment, and that it diligently took down the post when notified of it.

- 49 In spite of reaching opposite results, the Supreme Court rulings on *SGAE v. Asociación de Internautas* and *Quejasonline* do not contradict each other at all. Both opinions were written by the same judge and both held an open construction of “actual knowledge”. What explains the different outcome is that in *SGAE v. Asociación de Internautas* the court considered that the defendant had awareness of facts or circumstances from which the illegal activity or information was apparent, whereas in *Quejasonline* this was not the case, and thus the defendant did qualify for the safe harbour.
- 50 Another interesting point in the *Quejasonline* ruling is that the Supreme Court clearly admits that the hosting safe harbour applies to a forum – in other words, that, for the purposes of the safe harbour, the owner of a web forum must be deemed to be *hosting* the comments sent by users. Arguably, the same should apply to comments sent to blogs and to other Web 2.0 platforms. This is relevant inasmuch as it had been debated by commentators whether the hosting safe harbour should apply only to *true* hosting providers – companies offering space on their servers to host their client’s websites – and actually the definition of hosting in the LSSICE’s definitions annex seemed to favour the latter view.

## 2. Notice of specific infringements in order to get actual knowledge: *Telecinco v. YouTube*

- 51 *Telecinco v. YouTube* is an interesting copyright case that implements the Supreme Court’s open construction of *actual knowledge*, requiring nonetheless that, in order to get that knowledge, notices of infringement must refer to specific instances of copyright violation. The conflict was very similar to that between *Viacom* and *YouTube* in the United States,<sup>48</sup> and so was the outcome, which held *YouTube* not liable.<sup>49</sup> The case is now under appeal.
- 52 On 1 July 2008, *Telecinco*, a TV company, filed a petition for preliminary measures of protection against *YouTube* under Article 141 of the Spanish Copyright Act (TRLPI). It asked the court to grant these measures *inaudita parte*, that is, before the defendant has the opportunity to present its arguments against it. The court accepted *Telecinco*’s views about the urgent need for adopting the requested measures and issued an order granting them on 23 July 2008. The ruling ordered *YouTube* to stop using *Telecinco*’s clips on *YouTube*’s site and to remove them from it. The court further prohibited *YouTube* from using those works in the future without *Telecinco*’s authorization. At the same time, the court ordered the plaintiffs to immediately provide enough identification of the infringing content so that their use

on *YouTube* could be stopped and prevented in the future.

- 53 *YouTube* then filed a brief in opposition to the adopted measures. It argued they were technically unfeasible, essentially because the information provided by *Telecinco* didn’t allow a proper identification of the clips. In a new order issued on 21 November 2008, the court accepted this argument and acknowledged that *YouTube* was already offering a way for copyright owners to identify allegedly infringing clips. The court concluded that, at least for that initial stage of the procedure, this system could be deemed appropriate and thus modified the prior to the effect of requiring *Telecinco* to specifically provide the URLs of the claimed infringing clips.
- 54 Finally, on 20 September 2010, the court rendered its final judgment on the case. As said, it parallels some of the holdings of *Viacom v. YouTube*. However, unlike in *Viacom v. YouTube*, where almost all documents filed are available online,<sup>50</sup> in *Telecinco v. YouTube* – as is normally the case in lawsuits in Spain – the actual text of the complaint and the defendant’s opposition brief are not available. Rather, we must content ourselves with the streamlined references to the parties’ arguments offered in the ruling. Hence, it is not easy to assess to what extent the ruling actually addresses all the arguments put forward by the parties – or to what extent it sidesteps them.
- 55 The ruling addresses three main questions: first, the nature of the service provided by *YouTube*, i.e. whether it acts as a mere intermediary or rather as a content provider; second, in the event that *YouTube* is deemed to merely provide intermediary services, whether or not it qualifies for the hosting safe harbour set forth in the Spanish transposition of the E-Commerce Directive; and third, in the event that it qualifies for the safe harbour, whether or not plaintiffs may be granted injunction relief.

### a.) The nature of the service provided

- 56 As to the first question, the plaintiff contended that, despite the appearances, *YouTube* is in fact a content provider. To support this contention it pointed to the fact that in its Terms of Use, *YouTube* asks users to grant it a license for the content they upload. This would allegedly show that *YouTube* is aware that it is exploiting the copyrighted content sent by users, as otherwise it wouldn’t need to ask for a license. The ruling rejects this argument, asserting that requiring a license from users is not incompatible with carrying out a merely intermediary service. Here the court asserts that different types of intermediary services exist, one of which would be what it labels as “hosting 2.0”, as opposed to strict or pure hosting. This might be pointing to a debated issue between the parties, i.e. whether “hosting” under Article 14

of E-Commerce Directive (and its Spanish transposition) covers not only web hosting (i.e. providing server space for a website), but also the storing of users' materials by a website, like in a video sharing site.

- 57 The plaintiff further contended that YouTube acts as a content provider because it carries out "editorial functions", such as selecting "featured videos" and preventing some inappropriate but not unlawful clips from appearing on the site. The court holds that in fact it would be impossible for YouTube to control all the videos users upload. Besides, it asserts that selecting "featured videos" doesn't amount to an editorial function, as it is carried out automatically, following certain objective parameters. Nor, according to the court, would the fact that videos are displayed on a site designed by YouTube and distinguished by its trademark turn YouTube into a content provider. Similarly, the court states that exploiting the site for gain is not a sign that the service is not of an intermediary nature. The court rightly underscores that the E-Commerce Directive presupposes that intermediary services covered by the safe harbours are provided for gain.
- 58 The ruling goes on to describe the notice-and-take-down procedure YouTube has in place. Just like in *Viacom v. YouTube*, the Judge finds that this procedure works smoothly, and highlights that every time Telecinco has followed it to request the taking down of a video, YouTube has promptly reacted by removing the allegedly infringing clip. The court stresses that, being an intermediary service provider, YouTube cannot be subject to a general obligation of monitoring its site nor actively seeking facts or circumstances revealing infringements (Art. 15 E-Comm Directive).

## b.) Qualifying for the safe harbour

- 59 Once it was established that YouTube provides an intermediary service, the second group of issues relate to whether it qualifies for the hosting safe harbour laid down in the Spanish transposition of the E-Commerce Directive.
- 60 Telecinco argued for an open interpretation of the concept of actual knowledge. The court, following the Supreme Court's doctrine presented above, holds that the concept of actual knowledge must indeed be construed in an open way (thus not limited to the instances where a prior ruling has declared the illegality of the materials), but at the same time in a way that is compatible with the general principle that the provider cannot be subject to a general obligation of monitoring. As a result, according to the court, copyright owners should precisely identify the specific infringing files in order for the provider to gain actual knowledge of the infringement. The court finds that YouTube's system of notice-and-

take-down is consistent with this approach. While it acknowledges that this may be burdensome for copyright owners, the court stresses that this is nonetheless the order of priorities that both the EU and Spanish legislators have chosen.

## c.) Injunction relief

- 61 Finally, the court tackles the issue of the injunction requested by the plaintiff. According to the ruling, the plaintiff requested an injunction against YouTube under Articles 138 and 139 of the Spanish Copyright Act. These provisions allow right holders to apply for an injunction against intermediaries whose services are used by a third party to infringe, even where the acts of the intermediaries as such are not infringing, "without prejudice to the provisions of [the LSSICE]". The court rejects the injunction on the grounds of the latter clause of the provision. The court thinks it is "blindingly obvious" that this clause "completely eliminates the possibility of bringing the action" against intermediary service providers.
- 62 Arguably, however, this is not that clear. The E-Commerce Directive clearly states that the hosting safe harbour "shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement" (Art. 14.3 E-Commerce Directive). Therefore, even though the Spanish transposition remains silent about this point, it seems that the liability exemptions of the LSSICE, as such, do not prevent injunctions against the service provider – provided, of course, that the injunction doesn't imply actively monitoring the site. If the LSSICE doesn't prevent injunctions, then the "without prejudice to" clause quoted above might have a different meaning – for instance, it might simply mean that the possibility of applying for an injunction against those intermediaries doesn't undermine their protection under the LSSICE, which shields them from all types of liability but not against injunction relief.

## IV. Linking

### a.) Sites with links to information about getting unauthorised access to pay TV

- 63 The first case applying the LSSICE linking safe harbour was a 2003 case involving the website *ajoderse.com*.<sup>51</sup> The site provided links to other sites and the theme common to most of the linked materials was information about hacking encoded pay-per-view television transmissions, either by disseminating the secret keys or by other means. A group of pay-TV

companies brought a criminal action for revealing confidential information – i.e. the secret keys. While it was clear – at least from appearances – that the owner of the site had precisely selected the linked websites in accordance with the theme, the court considered that he lacked “actual knowledge”, as there had been no prior judicial decision declaring the linked materials to be illegal. The court stated that in order to be held liable:

*... there must be actual knowledge on the part of the service provider that the hyperlinked activity or information is illegal. However, even if the service provider knows that the linked pages are illegal, Law 34/2002 [the LSSICE] defines what is understood as actual knowledge in the final paragraph of Art. 17.1.<sup>52</sup>*

Following a strict interpretation of “actual knowledge”, the court found that the accused party was protected by the safe harbour and thus dismissed the case.

- 64 A recent case, *Digital+ v. Zackyfiles*,<sup>53</sup> dealt with a similar issue. The website Zackyfiles.com offers information about satellite TV receivers, satellite systems and related software. The site contains links to other pages. In one of the linked pages, keys to get unauthorized access to pay TV were found. The court acquitted the accused party, holding that he was protected by the linking safe harbour laid down in Article 17 LSSICE.

## b.) Google search results linking to defamatory content

- 65 Another case involving linking deals with Google's search results. An aggrieved party brought a civil lawsuit against Google because in its search results it provided links to sites where the plaintiff was being defamed. The lower court held Google not liable,<sup>54</sup> which was affirmed by the court of appeals.<sup>55</sup> The linked sites were deemed to be defamatory indeed. Nonetheless, both courts held that Google was protected by the information location tools safe harbour set forth in Article 17 LSSICE.
- 66 Before initiating the lawsuit, the plaintiff had repeatedly asked Google to remove the links to those sites. In some of the notices, the aggrieved party reported to Google that there was a lawsuit ongoing against the concerned sites. In one of the notices, the plaintiff even informed Google that a court ruling had been issued declaring that the information provided by one of those sites was false.
- 67 The court of appeals, following a strict construction of Article 17 LSSICE, held that those notices were not enough for Google to get actual knowledge of the illegal content. As noted above, the linking safe harbour in Article 17 LSSICE contains the exact same

wording as hosting safe harbour, Article 16 LSSICE, when it comes to the notion of actual knowledge. In order to find that knowledge, it requires not only that “a competent body has declared that the data are unlawful, or has ordered their removal or the disablement of access to them, or the existence of the damage has been declared” but also that “the provider knew of this decision”. The court thus held that even though the plaintiff had informed Google that a ruling holding the content to be illegal existed, that was not enough to deem that Google had actual knowledge, as there was no evidence that Google had been given a copy of that ruling.

- 68 The court of appeals' ruling makes no reference to the Supreme Court judgment in *SGAE v. Asociación de Internautas*, where, as explained above, the notion of “actual knowledge” was construed in an open way. It must be noted, however, that the Supreme Court's ruling dealt with that notion in relation to the hosting safe harbour, not the linking one. This may be a relevant distinction, as the Supreme Court's main argument for the open interpretation was that a strict one would run afoul of the E-Commerce Directive, something that cannot be said in the case of the linking safe harbour as no such provision is established by the Directive.

## c.) Legal actions against websites offering P2P download links

- 69 In addition to the cases mentioned above, the safe harbour for information location tools has been discussed in cases involving websites offering links to files containing music, movies, video games or software programs made available elsewhere on the Internet without authorization, whether in P2P networks or in high speed servers such as *Rapidshare*, to name just one of the best known. Litigation against websites providing this kind of link has been, and continues to be, the most relevant trend in the right holders' judicial enforcement strategy in Spain against digital piracy. However, the intent of holding them liable in court – whether criminally or civilly – has so far been almost a complete failure, not just because of the safe harbour protection, but, more importantly, because courts agree that merely linking to infringing files is not a copyright infringement.
- 70 In the field of criminal law, some thirty cases against websites linking to infringing material have been brought so far by rights holders in recent years. It must be observed that in Spain, as in many other European countries, a private party may file a criminal complaint. The prosecutor (*Ministerio Fiscal*) must take part in the procedure, but it is not necessary for the prosecutor to agree with the claimants for the case to go ahead.

- 71 While many of these cases are still pending, all those already decided have been dismissed – with only two exceptions. The main ground for dismissals is that, according to the courts, the mere provision of links does not constitute an act of communication to the public, and thus does not fall under Article 270 of the Spanish Penal Code. This article sets forth that it is a criminal offense to reproduce, plagiarize, distribute or publicly communicate a copyrighted work, with lucrative intent and without the authorization of the rights holder. To provide a link is obviously not a reproduction of the work; nor it is plagiarism or distribution. Hence, the only remaining possibility for the linking activity to fall under Article 270 of the Penal Code is that it is deemed to be a communication to the public. As courts consider that this is not so, the conduct falls outside the said article and thus cannot create criminal liability.
- 72 The leading case in this field is *Sharemula*, a criminal case dismissed in 2007 – with the dismissal affirmed by the court of appeals in 2008.<sup>56</sup> Columbia Tristar Home Video and other claimants brought a criminal action against the owner of the website *www.sharemula.com*. The site offered P2P download links to movies and other copyrighted material available in P2P networks. The claimants alleged that this activity constituted a non-authorized act of communication to the public. The owner argued that the website did not communicate the works to the public, as users did not download the works *from* the website, but from P2P networks. Furthermore, the accused party alleged that the activity was covered by the linking safe harbour laid down in Article 17 LSSICE.
- 73 The examining judge dismissed the case, holding that the owners of *sharemula.com* did not directly carry out acts of communication to the public, as *Sharemula* did not host the copyrighted files. They merely facilitated that communication, inasmuch as they selected and provided information about the files, as well as the means to download them. The judge acknowledged the merits of the argument that *Sharemula*'s activity, considered as a whole, and focusing on its final result, may fall under the general definition of communication to the public laid down in Article 20 of the Spanish Copyright Act, which defines an act of communication to the public as any act by which a plurality of persons may access the work without prior distribution of a copy of the work to each of them.<sup>57</sup> Nonetheless, the judge weighed the fact that *Sharemula* neither hosted the files nor directly caused the downloading; rather, the files were transferred by means of a P2P software client – eMule – widely available on the Internet. The judge held that while acts of arranging and providing information about the files available in P2P networks may facilitate the downloading, they cannot be equated to it, and thus they must be deemed mere intermediary activities. Besides, the judge considered the fact that the economic benefit drawn by the owners of the website stemmed from the advertising placed on it and not directly from the downloading.
- 74 The dismissal was appealed and the court of appeals affirmed it. In affirming the dismissal, the court held that the accused party was an information society service provider that qualified for the LSSICE linking safe harbour, as it lacked actual knowledge that the material to which it directed its users was illegal. The court again followed a strict construction of the notion of “actual knowledge” laid down in Article 17.1 LSSICE, holding that, as there was no prior ruling declaring the linked content to be illegal, the provider lacked the “actual knowledge” and thus could not be held liable. In addition, the court held that *Sharemula*'s activity did not constitute an act of communication to the public and that, as a consequence, it was not necessary to analyze whether the provider acted with a lucrative intent, as in any event the conduct would not constitute the criminal offense contemplated in Article 270 of the Penal Code.
- 75 After *Sharemula*, all criminal cases against websites offering links to infringing content where a final decision has been issued have been equally dismissed, with the sole exceptions of the *Infopsp.com* and the *SimonFilms.tv* cases, where the owners of the sites were convicted.<sup>58</sup> These convictions, however, hardly seem relevant as in both cases the accused party accepted a plea of guilty as a result of an agreement with the claimants and with the prosecutor. As a result, these cases did not offer a full discussion of the issues involved.
- 76 In three other cases, the dismissal issued by the examining judge was reversed on appeal. These decisions, however, did not hold that the activity was indeed a criminal offense. Rather, they simply ordered the examining judge to continue with the investigations to fully clear up the facts. One of these cases was *Divxonline*.<sup>59</sup> After the decision handed down by the court of appeals, the examining judge resumed the procedure and eventually issued a definitive dismissal.<sup>60</sup> However, this dismissal was again appealed, and the court of appeals reversed it anew.<sup>61</sup> Another case is *Elitedivx*, which is still pending.<sup>62</sup> The third case is *Todotorrente*.<sup>63</sup> This latter case is particularly relevant, as the court of appeals held that the accused party's activity did amount to a communication to the public.
- 77 To sum up, with regard to criminal liability, and with few exceptions, case law so far agrees that merely linking to infringing files, whether located in P2P networks or in someone else's server, is not a criminal offense. It cannot create criminal liability for contribution either, as the acts to which the activity contributes – those of users sharing files – are not criminal offenses, because they will normally lack lucrative intent on a commercial scale.<sup>64</sup>

- 78 With regard to civil lawsuits, the rulings handed down up to now have held defendants not liable.<sup>65</sup> The main rationale behind these decisions is actually the same one as in criminal cases – merely linking does not constitute an act of communication to the public, and thus it is not a *civil* copyright infringement, either. In their complaints so far, rights holders keep on claiming that these acts constitute acts of communication to the public – which, as noted, is rejected by courts. It remains to be seen what the outcome would be in this type of lawsuits if plaintiffs would claim *contributory* infringement. To be sure, it is not clear whether actions for contributory infringement may be brought under the Spanish Copyright Law, apart from the cases of circumvention of technological protection measures where the TRLPI expressly contemplates acts of contribution. In any event, courts have not yet discussed this possibility with regard to providers of links. In theory, another way of claiming contributory liability would be to resort to the general rules on civil liability, laid down in Article 1902 of the Civil Code, which appears to still be an unexplored argument in rights holders' civil lawsuits. However, qualifying service providers would still be protected by the LSSICE linking safe harbour.
- 79 In view of the lack of success in judicial actions against websites offering links to infringing content, rights holders have been lobbying for a legal reform that may allow them to effectively stop this activity. This resulted in a draft provision included in the Sustainable Economy Bill, which is currently being debated in the Spanish Parliament. As it relates to the liability of information society service providers, it seems appropriate to briefly comment on it.

## D. The Sustainable Economy Bill

- 80 The Sustainable Economy Bill (SEB), a bill addressing a wide range of issues in response to the present scenario of economic recession, includes a new legal mechanism conceived to tackle online copyright infringement.<sup>66</sup> Unlike other legislative measures taken by Member States such as France or the United Kingdom, the Spanish SEB isn't aimed at users that illegally make available copyrighted material. Rather, it focuses exclusively on information society service providers – whether they are acting as intermediaries or not – who may violate copyright. While its provisions cover all kinds of information society service providers, the main purpose behind the bill – as publicly stated by its promoters – is to fight against websites that provide links to copyrighted material located in P2P networks or on public servers, whether for downloading or streaming.
- 81 The bill grants to an administrative body – the newly created Second Section of the Intellectual Property

Commission – the power to assess whether an information society service is violating copyright. It also grants this administrative body the power to order the provider of that service to stop providing it or to remove the infringing material.

- 82 As it deals specifically with the freedom to provide information society services, the new rule is drafted primarily as an amendment to the LSSICE, particularly to its Article 8. Let us start by presenting the content of this provision and its links to the E-Commerce Directive, and then we will see how it would be amended if the bill is finally enacted.
- 83 Article 8 LSSICE establishes the cases in which a Spanish judicial or administrative authority may restrict the provision of information society services. It is directly connected to Article 3 ECD, which deals with the so-called country of origin principle and with the exceptions to it. According to this principle, "Member States may not, for reasons falling within the coordinated field, restrict the freedom to provide information society services from another Member State."<sup>67</sup> There are, however, some exceptions to this principle, which are set forth in Article 3.4 ECD. This article allows Member States, under certain conditions, to take restriction measures in respect of a given information society service when the measures are necessary for some of the following objectives:
- (a) public policy, in particular the prevention, investigation, detection and prosecution of criminal offenses, including the protection of minors and the fight against any incitement to hatred on grounds of race, sex, religion or nationality, and violations of human dignity concerning individual persons
  - (b) the protection of public health
  - (c) public security, including the safeguarding of national security and defence
  - (d) the protection of consumers, including investors.<sup>68</sup>
- 84 The measures must be proportionate to these objectives and "taken against a given information society service which prejudices [them], or which presents a serious and grave risk of prejudice to those objectives".<sup>69</sup>
- 85 The country of origin principle set forth in Article 3.2 ECD was transposed in Article 7 LSSICE. Next, Article 8 LSSICE – in accordance with Article 3.4 ECD – provides for the possibility of adopting restriction measures with regard to a given information society service when it prejudices or may prejudice some of the objectives listed in it. However, unlike in Article 3.4 ECD, this possibility of restriction measures in Article 8 LSSICE is not established just as an exception to the country of origin principle but in general – that is, regardless of whether the service is originated in another Member State, in Spain, or in any other country. This does not appear to be an improper transposition of the Directive. According to the ECD it is possible for a Member State to adopt restriction measures for the sake of the said objectives with

regard to services originating in another Member State. Thus, it seems that nothing prevents a Member State from subjecting the services originating within its territory to the same kind of restrictions, let alone services originating in non-EU countries.

- 86 The measures envisioned in Article 8 LSSICE may consist of the interruption of the provision of the service or the removal of the illicit material. The objectives that may motivate those measures are similar to those listed in Article 3.4 ECD: (a) the protection of public order, the investigation of criminal offenses, the public safety and the national defence; (b) the protection of public health and of consumers, including investors; (c) the respect of human dignity and the principle of non-discrimination on grounds of race, sex, religion, opinion, nationality, disability or any other personal or social circumstance; and (d) the protection of youth and childhood. The restriction measures should be adopted by the authority that is competent for the protection of the concerned objective, acting within the competencies conferred on it by the law. This “competent authority” does not always need to be a court, as the protection of some of the objectives is also entrusted to administrative bodies – for instance, in the case of public health or consumer protection.
- 87 Here is where the Sustainable Economy Bill comes into play. It introduces an amendment to this Article 8 LSSICE, which consists of adding a new objective to the list: the protection of intellectual property rights.<sup>70</sup> The purpose of the bill, as mentioned above, is to allow an administrative authority to order restriction measures against information society services that may violate copyright. Thus, Article 8 LSSICE – an article that, as noted, already allows not only courts but also administrative bodies to restrict the provision of information society services – was seen by the drafters of the bill as the best place to insert the new rule.
- 88 The next thing is creating the administrative authority that will exert the function of protecting copyright and ordering the said measures. To this end, through an amendment to the TRLPI, the SEB establishes a new section within an already existing body – the Intellectual Property Commission. While the first section of this commission will continue to exert mediation and arbitration functions, the newly created second section will have the mission of protecting intellectual property rights from violation by information society service providers, and will be the authority with the power to adopt the restriction measures provided for in Article 8 LSSICE.
- 89 According to the proposed amendment of Article 158 TRLPI, the second section of the Intellectual Property Commission will be able to order the measures for the interruption of the provision of an information society service or for the infringing materials to

be taken down. The measures may be taken against an information society service provider who acts with *direct* or *indirect* lucrative intent. It appears that the reference to “indirect” lucrative intent is meant to include the situations such as those where the owner of a website offering links to infringing content does not charge a fee for the service, but seeks economic profit through advertising placed on the page. The restriction measures may be taken as well against providers lacking direct or indirect lucrative intent as long as their conduct causes – or is capable of causing – a patrimonial harm. Arguably, this encompasses any situation involving an infringement, and thus – in spite of what was sometimes claimed in the debates – the bill does not just target people who try to profit from copyright infringement but has a potentially broader scope.

- 90 Once the first draft of the bill was made public it prompted a strong opposition from Internet users. In particular it was argued that allowing an administrative authority to order the closing down of a website would violate the principle of freedom of expression. It was contended that websites are media and therefore only a court could order to close them down. Actually, the current text of Article 8 LSSICE already takes this into account, as a measure of closing down a website adopted by an administrative authority might run afoul of Article 20.5 of Spanish Constitution, which establishes that “[t]he seizure of publications, recordings, or other means of information may only be adopted by a judicial decision”. Indeed, Article 8 LSSICE includes a paragraph stating that the competent judicial authority – as the one responsible for ensuring the rights to freedom of expression, to receive information, to academic freedom and to literary, artistic, scientific and technical creation – will be the only one who may adopt the restriction measures contemplated in that provision wherever this competence is attributed exclusively to judicial authorities by the Constitution or other laws governing the concerned rights.
- 91 It could be argued, thus, that this paragraph of Article 8 LSSICE already ensures that the proposed amendment will not allow administrative authorities to take restriction measures that may violate freedom of expression and the other related rights. However, it was contended that the reform would indeed be an assault on free speech, because the one who would decide in the first place whether the restriction measure affects those rights would be the administrative authority itself. Therefore, and in view of the strong opposition against the bill, before introducing it into Parliament the government modified it to include a truly peculiar system of judicial control. It was decided that once the commission orders a restriction measure, it must ask the court to authorize its execution. However, the court will not be able to consider the merits of the case, i.e. whether there is indeed a violation of copyright. Rather,

the court must only take into account whether the concerned measure prejudices the rights and liberties enshrined in Article 20 of the Constitution, quoted above. Moreover, the court's decision must limit itself to either granting or denying the authorization – it cannot modify or amend the measure.

- 92 This peculiar system raises important concerns. Not the least of these is that it appears to craft an administrative procedure in the hope of achieving something that courts have been denying so far – deeming that websites that link to infringing content engage in copyright infringement and closing them down. This is certainly striking, as it is difficult to see how an administrative body could find those websites to be infringing where judges have found them not to be so.

## E. Conclusion

- 93 In the eight years since the E-Commerce Directive was transposed into Spanish law, case law on ISP liability in Spain has been less uniform and predictable than desirable. Courts have issued rulings in around fifty cases so far. Roughly half of them have dealt with defamation in messages posted on websites, blogs, forums, wikis or other platforms. In some of these cases, courts did not really apply the hosting safe harbour, sometimes alleging that the safe harbour does not prevent the application of other norms, particularly the Organic Law 1/1982 of 5 May on the civil protection of the right to honour, to personal and family privacy and to one's own image. On these occasions, some courts have tended to consider that the owner of the platform is subject to a duty to control the content published on it and are thus liable for the third-party defamatory comments. In other rulings, however, the owner of the site or forum where users' comments were posted has been deemed protected by the hosting safe harbour and therefore not liable. A crucial issue regarding this exemption is the notion of actual knowledge, as the Spanish transposition departed from the language of the E-Commerce Directive, crafting an extremely narrow concept of actual knowledge and, moreover, dispensing altogether with the requirement of lack of awareness of facts or circumstances from which the illegal activity or information is apparent. The language of the LSSICE has been construed in different ways by different courts, either in a strict way – which in practice means that, for the provider to have actual knowledge, there must be a prior ruling declaring the third-party material to be illegal – or in a more flexible interpretation, admitting other ways of obtaining the relevant knowledge. The latter view has finally been endorsed by the Supreme Court. On the one hand, the Supreme Court's position increases legal certainty as to whether actual knowledge can be obtained by ways diffe-

rent than those expressly considered by the LSSICE. On the other hand, however, it poses the problem of determining on a case-by-case basis what amounts to actual knowledge, which obviously reduces legal certainty for intermediaries. Nonetheless, this type of uncertainty is the one envisioned by the E-Commerce Directive, as it clearly contemplates not only different ways of gaining actual knowledge but even mere awareness of red flags indicating the illegal nature of the information.

- 94 With regard to the liability for linking to illegal content, the Spanish situation is characterized by the safe harbour set forth in the LSSICE dealing with information location tools, a safe harbour not included in the ECD. While it protects providers of links irrespective of the nature of the linked content, case law has mainly focused on the activity of linking to copyrighted works located in P2P networks or elsewhere on the Internet. Case law generally agrees that in these cases, the safe harbour applies. Actually, however, the safe harbour is not necessary to shield from liability those websites offering links to infringing content, as courts hold that merely providing links does not constitute an act of copyright infringement, and it cannot create criminal copyright liability either. This has frustrated the expectations of rights holders as all cases against those websites that have been decided so far have been dismissed, with only two exceptions. This appears to be the reason behind the proposal included in the Sustainable Economy Bill, which targets information society service providers that violate copyright. The bill, still being debated at the Spanish Parliament, is under much criticism. It opens a dangerous door as it entrusts to an administrative body the task of determining whether a service provider has engaged in copyright infringement, and grants to this authority the power of ordering the service to be interrupted. The judicial intervention in this procedure – before a restriction measure is applied – will be limited to determining whether the restriction measure harms freedom of expression, but it cannot assess whether or not a copyright infringement has occurred in the first place. This is particularly shocking as case law has repeatedly held that the type of services supposedly targeted by the bill are not infringing. This would be enough to predict the failure of the bill, at least with regard to its main goal – closing down websites offering P2P download links.

## F. Annex: List of cases

- 95 This annex aims to provide an overview of the Spanish cases on ISP liability. The list includes all cases that I know of which have been brought to courts in Spain in which at least one ruling has been issued. Surely there must have been some other cases; this is always difficult to know, as lower court's rulings

are normally not reported on case law databases. In any event, these are the cases that in one way or another have been known to lawyers and scholars in Spain. The names of the cases provided here are only for clarification purposes – it must be observed that in Spain, cases do not have an official name; rather they are just identified by the name of the court and the date of the ruling. Within each subpart, cases are presented starting with the newest, taking into account the date of the last ruling issued in each case.<sup>71</sup>

## I. Civil cases dealing with defamation

- *PSOE Mérida*. Defamatory comments were posted on a website devoted to politics. The website owners were held liable: Judgment of the Court of First Instance No 2 of Mérida, 1 July 2009. Ruling affirmed on appeal: Judgment 280/10 of the *Audiencia Provincial* (Court of Appeals) of Badajoz, 3<sup>rd</sup> Section, 17 September 2010.
- *Quejasonline.com*. Defamatory comments posted by an anonymous user on a website devoted to criticism. The court of first instance held the owner of the website liable for the third-party comments: Judgment of the Court of First Instance No 23 of Valencia, 30 November 2006. Ruling affirmed on appeal: Judgment 403/2007 of the *Audiencia Provincial* (Court of Appeals) of Valencia, 6<sup>th</sup> Section, 29 June 2007. The Supreme Court reversed the ruling on cassation and held the defendant not liable because of the hosting safe harbour: Judgment 316/2010 of the Supreme Court (Civil Chamber), 18 May 2010.
- *Rankia.com*. Defamatory comments posted by a user on the website rankia.com. The court of first instance held the website's owner qualified for the hosting safe harbour and thus was held not liable: Judgment 153/2009, Court of First Instance No 42 of Madrid, 23 September 2009. The judgment was affirmed on appeal: Judgment 181/2010, *Audiencia Provincial* (Court of Appeals) of Madrid, 21<sup>st</sup> Section, 13 April 2010.
- *Chaturanga (Yahoo!)*. Defamatory comments posted on a chat-room hosted by Yahoo! The lower court held Yahoo! not liable on account of the hosting safe harbour: Judgment of the Court of First Instance No 3 of Esplugues de Llobregat, 5 March 2009. Affirmed on appeal: Judgment 98/2010, *Audiencia Provincial* (Court of Appeals) of Barcelona, 19<sup>th</sup> Section, 3 March 2010.
- *Google search results*. Lawsuit brought against Google because of links to defamatory sites shown in the search results. The lower court rejected the claim on account of the linking safe harbour: Judgment of Court of First Instance No 19 of Madrid, 13 May 2009. Affirmed on appeal: Judgment 95/2010, *Audiencia Provincial* (Court of Appeals) of Madrid, 9<sup>th</sup> Section, 19 February 2010.
- *SGAE v. Asociación of Internautas*. Hosting of a gripe website with defamatory content. The hosting provider was held liable: Judgment 126/2005, Court of First Instance No 42 of Madrid, 15 June 2005. Ruling affirmed on appeal: Judgment 50/2006, *Audiencia Provincial* (Court of Appeals) of Madrid, 19<sup>th</sup> Section, 6 February 2006. Affirmed also on cassation, holding that the provider did not qualify for the hosting safe harbour: Judgment 773/2009 of the Supreme Court, Civil Chamber, 9 December 2009.
- *Mindoniense.com*. Defamatory comments posted by users on a forum. The owner of the forum was held not liable as he qualified for the hosting safe harbour: Judgment 109/2008, *Juzgado de Primera Instancia e Instrucción* No 1 of Mondoñedo, 5 November 2008. The ruling was affirmed on appeal: Judgment 538/2009, *Audiencia Provincial* (Court of Appeals) of Lugo, 1<sup>st</sup> Section, 9 July 2009.
- *Alasbarricadas.org*. Defamatory remarks against the Spanish singer Ramoncín posted by users on a forum. The owner of the forum was held liable as the court considered that he did not qualify for the hosting safe harbour: Judgment 184/2007, Court of First Instance No 44 Madrid, 13 September 2007. Ruling affirmed on appeal: Judgment 420/2008, *Audiencia Provincial* (Court of Appeals) of Madrid, 13<sup>th</sup> Section, 22 September 2008.
- *Veloxia Network II*. Defamatory comments posted by users on an Internet forum. The forum's owner qualified for the hosting safe harbour and thus was held not liable: Judgment of the Court of First Instance No 10 of Madrid, 28 June 2007. The ruling was affirmed on appeal: Judgment 511/2008, *Audiencia Provincial* (Court of Appeals) of Madrid, 10<sup>th</sup> Section, 16 July 2008.
- *SGAE v. Merodeando.com*. Defamatory comments posted by readers on a blog. The owner of the blog was held liable: Judgment of the Court of First Instance No 55 of Madrid, 24 June 2008.
- *Relevance v. Derecho.com*. Defamatory comments on a website. The website owner was held not liable by the court of first instance, as he was not the author of the comments: Judgment of the Court of First Instance No 46 of Madrid, 22 September 2006. The ruling was partially reversed on appeal, enjoining the website owner from publishing similar comments in the future: Judgment 278/2008, *Audiencia Provincial* (Court of Appeals) of Madrid, 12<sup>th</sup> Section, 17 April 2008.
- *SGAE v. Frikipedia*. Defamatory remarks on the entry about the SGAE in a satirical wiki. The wiki

webmaster was held liable: Judgment 202/2006, Court of First Instance No 52 of Madrid, 19 December 2006. The ruling was confirmed on appeal, holding that the hosting safe harbour did not apply: Judgment 516/2007, *Audiencia Provincial* (Court of Appeals) of Madrid, 18<sup>th</sup> Section, 8 October 2007.

— *Unió Mallorquina*. Defamatory comments posted by users on a forum. The lower court held the owner of the forum not liable: Judgment of the Court of First Instance No 14 of Palma, 16 October 2006. The ruling was reversed on appeal, holding the defendant liable: Judgment 65/2007, *Audiencia Provincial* (Court of Appeals) of the Balearic Islands, 3<sup>rd</sup> Section, 22 February 2007.

— *Aprendizmason.org*. Defamatory statements on a website. The web hosting provider, iEspaña, was held not liable, as it qualified for the hosting safe harbour: Judgment of the Court of First Instance No 3 of Alcobendas, 5 May 2004. The ruling was affirmed on appeal: Judgment 835/2005, *Audiencia Provincial* (Court of Appeals) of Madrid, 14<sup>th</sup> Section, 20 December 2005.

— *Idiada Automotive Technologies*. Defamatory remarks on a website. The website owner was held not liable. The authors of the remarks were held liable: Judgment of the Court of First Instance No 6 of El Vendrell, 17 May 2004. The ruling was affirmed on appeal: Judgment 420/2005, *Audiencia Provincial* (Court of Appeals) of Tarragona, 1<sup>st</sup> Section, 10 October 2005.

## II. Criminal cases dealing with defamation

— *Elcomentario.tv*. Criminal case brought against the owner of an Internet forum on account of defamatory comments posted by an anonymous user. The case was dismissed by the examining judge, as the owner of the forum was not the author of the comments: Decision of *Juzgado de Instrucción* No 1 of Oviedo, 31 March 2009. Affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Oviedo, 18 September 2009.

— *Foro Laboral*. Criminal case brought against two individuals on account of defamatory messages posted on an Internet forum. The accused individuals – one of them the initiator of the forum – were acquitted as they were not proven to be the authors of the illegal content: Judgment of *Juzgado de Instrucción* No 17 of Madrid, 19 November 2007. Affirmed on appeal: Judgment 104/2008, *Audiencia Provincial* (Court of Appeals) of Madrid, 1<sup>st</sup> Section, 11 April 2008.

— *World Networw*. Criminal case brought against the owner of a website on account of defamatory

messages posted by users. The accused was acquitted, as he was not proven to be the author of the messages: Judgment of *Juzgado de Instrucción* No 21 of Madrid, 16 of October 2007. Affirmed on appeal: Judgment 128/2008, *Audiencia Provincial* (Court of Appeals) of Madrid, 2<sup>nd</sup> Section, 9 April 2008.

— *Mafius Blog*. The owner of a blog was convicted on account of defamatory comments sent by unidentified readers. Judgment of *Juzgado de Primera Instancia e Instrucción* No 5 of Arganda del Rey, 30 June 2006. Judgment affirmed on appeal. The court of appeals held that the hosting safe harbour did not apply: Judgment 96/2007, *Audiencia Provincial* (Court of Appeals) of Madrid, 3<sup>rd</sup> Section, 26 February 2007.

— *Veloxia Network I*. Criminal case brought against the owner of an Internet forum. On a ruling dealing with procedural matters, the court of appeals held that the hosting safe harbour applied. Decision of *Juzgado de Instrucción* No 3 of Plasencia, 10 July 2006; Decision 273/06, *Audiencia Provincial* (Court of Appeals) of Cáceres, 2<sup>nd</sup> Section, 30 October 2006.

— *Aporellos.com*. The owners of the website were held liable for damages; the hosting provider and the access provider were held not liable: Judgment of *Juzgado de Instrucción* No 3 of Murcia, 18 April 2005; Judgment 56/2006, *Audiencia Provincial* (Court of Appeals) of Murcia, 4<sup>th</sup> Section, 18 May 2006.

## III. Criminal copyright cases against sites offering download or streaming links

— *Edonkeymanía*. Criminal copyright case against a website linking to P2P downloads. Initially, the examining judge granted preliminary measures: Decision of *Juzgado de Instrucción* No 3 of Madrid, 1 August 2003. Finally the judge dismissed the case: Decision of *Juzgado de Instrucción* No 3 of Madrid, 17 June 2010.

— *Cinegratis.net*. Criminal copyright case against a website linking to P2P downloads. The case was dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 1 of Santander, 4 February 2010. Dismissal affirmed on appeal: Decision 214/10, *Audiencia Provincial* (Court of Appeals) of Cantabria, 3<sup>rd</sup> Section, 8 June 2010.

— *Divxonline*. Criminal copyright case against a website linking to P2P downloads. The case was dismissed by the examining judge, apparently on account of lack of lucrative intent: Decision of *Juzgado de Instrucción* No 3 of Mislata, 9 September 2009. The court of appeals reversed the dismissal and remanded the case to the examining judge, holding that the accused could indeed have had lucrative intent: Decision 18/2010, *Audiencia Provincial* (Court of Appeals)

of Valencia, 3<sup>rd</sup> Section, 8 January 2010. The examining judge dismissed the case again, on account that the provision of links does not constitute a criminal offense: Decision of *Juzgado de Primera Instancia e Instrucción* No 3 of Mislata, 17 May 2010. This dismissal, however, was again reversed on appeal: Decision 630/2010, *Audiencia Provincial* (Court of Appeals) of Valencia, 3<sup>rd</sup> Section, 26 October 2010.

— *CVCDGO*. Criminal copyright case against a website linking to P2P downloads. Case dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 48 of Madrid, 27 May 2009. Dismissal affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Madrid, 23<sup>rd</sup> Section, 11 May, 2010.

— *RojaDirecta.com*. Criminal copyright case against a website offering links to live streaming sporting events and to BitTorrent downloads. The case was dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 37 of Madrid, 15 July 2009. Dismissal affirmed on appeal: Decision No 364/10 of *Audiencia Provincial* (Court of Appeals) of Madrid, 1<sup>st</sup> Section, 27 April 2010.

— *IndiceDonkey.com*. Criminal copyright case against a website linking to P2P downloads. Case dismissed: Decision of *Juzgado de Instrucción* No 1 of Madrid, 19 March 2008. Case reopened to carry out new investigations and dismissed again: Decision of *Juzgado de Instrucción* No 1 of Madrid, 2 March 2010.

— *Naiadadonkey*. Criminal copyright case against a website linking to P2P downloads. Case dismissed: Decision of *Juzgado de Instrucción* No 3 of Alcoy, 17 June 2009. Dismissal affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Alicante, 2<sup>nd</sup> Section, 10 February 2010.

— *SimonFilms.tv*. Criminal copyright case against websites offering streaming films for a fee. It is not clear from the facts of the case whether the sites merely linked to, or actually hosted, the films. The accused was convicted following an agreement with the claimants and the prosecutor: Judgment of *Juzgado de lo Penal* (Criminal Court) No 2 of Vigo, 26 January 2010.

— *Ps2rip.net*. Criminal copyright case against a website linking to P2P downloads. The examining judge declined to dismiss the case and thus decided to go ahead with the procedure: Decision of *Juzgado de Instrucción* No 3 of Cerdanyola del Vallès, 7 March 2009. This decision was affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Barcelona, 3<sup>rd</sup> Section, 11 November 2009.

— *Cinetube.es*. Criminal copyright case against a website linking to P2P downloads. Case dismissed: Decision of *Juzgado de Instrucción* No 2 of Vitoria-Gasteiz, 21 October 2009.

— *Portalvcd/e-mule24horas*. Criminal copyright case against sites linking to P2P downloads. Case dismissed: Decision of *Juzgado de Instrucción* No 3 of Ponferrada, 31 October 2008. Dismissal affirmed on appeal: Decision 463/2009, *Audiencia Provincial* (Court of Appeals) of León, Secc. 3<sup>rd</sup>, 15 October 2009.

— *Infektor*. Criminal copyright case against a website linking to P2P downloads. The examining judge declined to dismiss the case and thus decided to go ahead with the procedure: Decision of *Juzgado de Instrucción* No 1 of Amurrio, 21 July 2009. That decision was affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Álava, 30 September 2009.

— *Elitedivx*. Criminal copyright case against a website linking to P2P downloads. Case dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 4 of Cartagena, 17 April 2008. Dismissal reversed on appeal, remanding the case to the examining judge: Decision of *Audiencia Provincial* (Court of Appeals) of Murcia, 5<sup>th</sup> Section, 16 September 2009.

— *Etmusica/Elitemula*. Criminal copyright case against websites linking to P2P downloads. Case dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 2 of Moguer, 13 July 2009. Dismissal affirmed on appeal: Decision of the *Audiencia Provincial* (Court of Appeals) of Huelva, 1<sup>st</sup> Section, 1 September 2010.

— *Infopsp*. Criminal copyright case against a website linking to P2P downloads. The accused was convicted after pleading guilty following an agreement with the claimants and the prosecutor: Judgment of *Juzgado de lo Penal* (Criminal Court) No 1 of Logroño, 25 November 2008.

— *Spanishshare*. Criminal copyright case against a website linking to P2P downloads. The examining judge dismissed the case: Decision of *Juzgado de Instrucción* No 4 of Madrid, 12 November 2008.

— *Tvmix*. Criminal copyright case against a website offering links to live streaming sporting events. Case dismissed by the examining judge: Decision of *Juzgado de Instrucción* No 13 of Madrid, 5 May 2008. Dismissal affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Madrid, 5<sup>th</sup> Section, 3 November 2008.

— *Todotorrente*. Criminal copyright case against a website linking to P2P downloads. The examining judge dismissed the case: Decision of *Juzgado de Primera Instancia e Instrucción* No 3 of Orihuela, 17 October 2008. Dismissal reversed on appeal: Decision 551/2010, *Audiencia Provincial* (Court of Appeals) of Alicante-Elche, 7<sup>th</sup> Section, 20 September 2010.

— *Sharemula*. Criminal copyright case against a website linking to P2P downloads. This is a seminal

case. The examining judge first denied the solicited preliminary measures: Decision of *Juzgado de Instrucción* No 4 of Madrid, 20 December of 2006. Decision affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Madrid, Section 2<sup>nd</sup> bis, 18 June 2008. After the first ruling, the examining judge dismissed the case: Decision of *Juzgado de Instrucción* No 4 of Madrid, 28 September 2007. Dismissal affirmed on appeal: Decision of *Audiencia Provincial* (Court of Appeals) of Madrid, 2<sup>nd</sup> Section, 11 September 2008.

— *Todocarátulas*. Criminal copyright case against a website linking to P2P downloads. The accused was acquitted: Judgment of *Juzgado de lo Penal* (Criminal Court) No 18 of Barcelona, 8 September 2005. Acquittal affirmed on appeal: Judgment of *Audiencia Provincial* (Court of Appeals) of Barcelona, 7<sup>th</sup> Section, 22 December 2005.

#### IV. Civil copyright cases against sites offering P2P download links

— *Indice-web*. Civil copyright case against a website linking to P2P downloads. The court denied the solicited preliminary measures: Decision 185/2009 of the Commercial Court (*Juzgado de lo Mercantil*) No 6 of Barcelona, 11 May 2009. The defendant was held not liable: Judgment 149/2010 of the Commercial Court (*Juzgado de lo Mercantil*) No 6 of Barcelona, 22 April 2010.

— *Elrincondejesus*. Civil copyright case against a website linking to P2P downloads. The court denied the solicited preliminary measures: Decision 138/2009 of the Commercial Court (*Juzgado de lo Mercantil*) No 7 of Barcelona, 2 July 2009. The defendant was held not liable: Judgment 67/2010 of the Commercial Court (*Juzgado de lo Mercantil*) No 7 of Barcelona, 9 March 2010.

— *Etmusica/Elitemula*. Civil copyright case against websites linking to P2P downloads. Initially, the court granted some preliminary measures, but eventually overruled them in Decision of the Commercial Court (*Juzgado de lo Mercantil*) of Huelva, 11 November 2009, and Decision of the Commercial Court (*Juzgado de lo Mercantil*) of Huelva, 13 November 2009.

— *Agujero.com*. Civil copyright case against a website linking to P2P downloads. Preliminary measures denied: Decision of the Commercial Court (*Juzgado de lo Mercantil*) No 3 of Barcelona, 6 May 2009.

#### V. Other cases

— *Digital+ v. Zackyfiles.com*. The website zackyfiles.com offered information about conditional access systems for pay-TV. One of the linked pages contain-

ed a key for getting unauthorized access. The webmaster was acquitted on the grounds of the information location tools safe harbour. Judgment 334/10 of the Criminal Court No 1 of Zaragoza, 20 October 2010.

— *Telecinco v. YouTube*. Civil copyright case. Telecinco, a TV company, sued YouTube and asked for a preliminary injunction to have its videos taken down from the service. The court granted the injunction *inaudita parte*, ordering the plaintiff to properly identify the infringing videos: Decision 320/2008, Commercial Court (*Juzgado de lo Mercantil*) No 7 of Madrid, 23 July 2008. Once the defendant presented its allegations against that ruling, the court confirmed the injunction, but required the plaintiff to provide the precise URLs or identification codes for the videos to be taken down: Decision 448/2008, Commercial Court (*Juzgado de lo Mercantil*) No 7 of Madrid, 21 November 2008. In its final judgment, the Court held Google not liable, as it was covered by the hosting safe harbour and met its requirements: Judgment 289/2010 of the Commercial Court (*Juzgado de lo Mercantil*) No 7 of Madrid, 20 September 2010.

— *V.D. Sistem v. Tus Profesionales*. Claim for damages and injunction against a hosting provider who hosted two sites which allegedly engaged in unfair competition. The lower court granted the injunction but held the provider not liable for damages. Judgment of the Commercial Court (*Juzgado de lo Mercantil*) No 4 of Madrid, 18 June 2007. This was affirmed on appeal, holding that the provider was protected by the hosting safe harbour as it lacked actual knowledge: Judgment 131/2009 of the *Audiencia Provincial* (Court of Appeals) of Madrid, 28<sup>th</sup> Section, 18 May 2010.

— *Megakini v. Google*. Civil copyright case. The owner of a website sued Google on account of the reproduction of snippets from his site under the main link on the search results page and on account of the making available of a “cached” copy of the site by means of a “cached” link. The lower court held Google not liable: Judgment of the Commercial Court (*Juzgado de lo Mercantil*) No 5 of Barcelona, 30 March 2007. The court of appeals held the defendant not liable but on different grounds, and stated that the caching safe harbour did not apply to Google’s cache: Judgment of the *Audiencia Provincial* (Court of Appeals) of Barcelona, 15<sup>th</sup> Section, 17 September 2008.

— *Emi v. Bitmailer*. Civil copyright case. Claimants requested an injunction against an access provider so that it ceased to provide the service to an infringing website. The court denied the injunction: Decision of the Commercial Court (*Juzgado de lo Mercantil*) No 2 of Madrid, 10 November 2004.

— *Ajoderse.com*. Criminal case against a website providing links to information about hacking encoded pay-per-view television transmissions. The case was dismissed on account of the linking safe

harbour: Decision of *Juzgado de Instrucción* No 9 of Barcelona, 7 March 2003.

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- 1 **Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (“Directive on electronic commerce”)**, *Official Journal L* 178, 17 July 2000.
  - 2 See Arts. 12 through 14 of the **E-Commerce Directive**.
  - 3 See Art. 15.1 of the **E-Commerce Directive**.
  - 4 See, e.g., R. Julià-Barceló, *On-line Intermediary Liability Issues: Comparing E.U. and U.S. Legal Frameworks*, E.I.P.R., 2000 (3), pp. 105 – 119; see also M. Peguera, *The DMCA Safe Harbors and Their European Counterparts: A Comparative Analysis of Some Common Problems*, 32 COLUM. J.L. & ARTS 481 (2009).
  - 5 Title II of the DMCA amended Chapter 5 of Title 17 of the United States Code (U.S.C.), by adding a new Section 512 titled “Limitations on liability relating to material online”. See 17 U.S.C. § 512 (2000).
  - 6 See 17 U.S.C. § 512(c)(3) (2000).
  - 7 See European Commission, Report from the Commission to the European Parliament, the Council and the European Economic and Social Committee: First Report on the application of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce), Brussels, 21 November 2003, COM(2003) 702 final (hereinafter First Report on the application of Directive 2000/31/EC), p. 6 et seq.
  - 8 See the Judgment of the Court (Grand Chamber) of 23 March 2010 in Joined Cases C-236/08 to C-238/08 (*Google France*), which deals with the applicability of the hosting safe harbour of the E-Commerce Directive to an Internet referencing service provider.
  - 9 Ley 34/2002, de 11 de Julio, de servicios de la sociedad de la información y de comercio electrónico (BOE 166, 12 July 2002, p. 25388).
  - 10 See, e.g., E. Crabit, *La directive sur le commerce électronique. Le projet “Méditerranée”*, 4 REVUE DU DROIT DE L’UNION EUROPÉENNE 749 (2000), pp. 811 – 812.
  - 11 See Commission Proposal for a Directive on Certain Legal Aspects of Electronic Commerce in the Internal Market, Commentary on Individual Articles, COM (1998)586 final (Nov. 18, 1998) (hereinafter Commentary on Proposal for E-Commerce Directive), p. 29: “The exemption from liability (both as regards civil and criminal liability) cannot be granted if a service provider knows that a user of his service is undertaking illegal activity (actual knowledge). The exemption from liability, as regards claims for damages, cannot be granted if the service provider is aware of facts and circumstances from which the illegal activity is apparent.”
  - 12 See Art. 16.1.II LSSICE (unofficial translation).
  - 13 See, e.g., J. Strachan, *The Internet of Tomorrow: The New-Old Communications Tool of Control* E.I.P.R., 2004, (3), p. 123 – 136.
  - 14 The report does relate, though, to the fact that some Member States decided to provide for this limitation of liability, and it states that “[w]hilst it was not considered necessary to cover hyperlinks and search engines in the Directive, the Commission has encouraged Member States to further develop legal security for internet intermediaries. It is encouraging that recent case-law in the Member States recognizes the importance of linking and search engines to the functioning of the internet. In general, this case-law appears to be in line with the Internal Market objective to ensure the provision of basic intermediary services, which promotes the development of the internet and e-commerce. Consequently, this case-law does not appear to give rise to any Internal Market concerns”. See *First Report on the application of Directive 2000/31/EC*, p. 13.
  - 15 This is the case of the Austrian E-Commerce Gesetz that sets forth a safe harbour for search engines in § 14 (*Ausschluss der Verantwortlichkeit bei Suchmaschinen*), and a different one for links in § 17 (*Ausschluss der Verantwortlichkeit bei Links*). An English version of the E-Commerce Gesetz is available at [http://www.ris.bka.gv.at/Dokumente/Erv/ERV\\_2001\\_1\\_152/ERV\\_2001\\_1\\_152.pdf](http://www.ris.bka.gv.at/Dokumente/Erv/ERV_2001_1_152/ERV_2001_1_152.pdf) (last visited 1 November 2010).
  - 16 See the Annex to this article.
  - 17 Preliminary ruling of the Commercial Court (*Juzgado de lo Mercantil*) No 2 of Madrid, 10 November 2004.
  - 18 E-Commerce Directive, Recital 45.
  - 19 E-Commerce Directive, Art. 12.3 (“mere conduit”), 13.2 (“caching”), 14.3 (hosting).
  - 20 See, e.g., J. Massaguer, *La responsabilidad de los prestadores de servicios en línea por las infracciones al derecho de autor y los derechos conexos en el ámbito digital*, PE. I. REVISTA DE PROPIEDAD INTELECTUAL, 13 (2003) pp. 11– 48, (p. 36). See also J.J. Marín López, *La comercialización de la música a través de Internet y los derechos del productor de fonogramas: los casos “Weblisten” y “Bitmailer”*, REVISTA DE LA FACULTAD DE DERECHO DE LA UNIVERSIDAD DE GRANADA, 8 (2005) pp. 363 – 386.
  - 21 See 17 U.S.C. § 512(b) (2000).
  - 22 See the Belgian case *Copiepresse SCRL v. Google Inc. (Tribunal de Première Instance de Bruxelles*, Feb. 13, 2007, No 06/10.928/C), where the court held that the ECD caching safe harbour does not apply to Google’s cache. As to the US, the DMCA caching safe harbour was applied in *Field v. Google Inc.*, 412 F.Supp.2d 1106 (D.Nev. 2006). On this decision, see M. Peguera: *When the Cached Link is the Weakest Link: Search Engine Caches under the Digital Millennium Copyright Act*, 56 J. COPYRIGHT SOC’Y U.S.A. (2009) pp. 589 – 645, available at <http://ssrn.com/abstract=1135274> (arguing the court wrongly applied the DMCA safe harbour).
  - 23 Judgment of the Commercial Court No 5 of Barcelona, 30 March 2007; *affirmed* on different grounds by the Judgment of the *Audiencia Provincial* (Court of Appeals) of Barcelona, Section 15<sup>th</sup>, 17 September 2008.
  - 24 See Google Help Center, Google Web Search Features: “Cached” links, [http://www.google.com/intl/en/help/features\\_list.html#cached](http://www.google.com/intl/en/help/features_list.html#cached) (last visited 1 November 2010). The “Cached” links feature is also present in other main search engines, such as Yahoo! or Bing.
  - 25 Judgment of the Commercial Court No 5 of Barcelona, 30 March 2007.
  - 26 Royal Legislative Decree 1/1996, of 12 April, which enacts the *Texto Refundido de la Ley de Propiedad Intelectual* (TRLPI).
  - 27 See Art. 5.1 of the 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 (hereinafter “InfoSoc Directive”).
  - 28 Judgment of the *Audiencia Provincial* (Court of Appeals) of Barcelona, Section 15<sup>th</sup>, 17 September 2008.
  - 29 *Id.* F.J. 2.
  - 30 For a detailed discussion on this topic, see M. Peguera: *When the Cached Link is the Weakest Link: Search Engine Caches under the Digital Millennium Copyright Act*, 56 J. COPYRIGHT SOC’Y U.S.A. (2009) pp. 589 – 645, available at <http://ssrn.com/abstract=1135274> (last visited 1 November 2010) (claiming that search engine caches fall outside the caching safe harbour set forth in the U.S. Digital Millennium Copyright Act).

- 31 On the applicability of Art. 5.1 of the InfoSoc Directive to Google's cache, see S. Klein, Search engines and copyright: An analysis of the Belgian Copiepresse decision in consideration of British and German copyright law, IIC 2008, 39(4), 451 – 483.
- 32 The relevant court documents of the case are available at <http://www.internautas.org/pagweb/11.html> (last visited 1 November 2010).
- 33 Actually, the name of the registrant that appeared in the WHOIS was *Realmente Cabreados con la SGAE* ("Really Upset with SGAE").
- 34 Decision available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0953.html> (last visited 28 July 2010).
- 35 Available at <http://www.internautas.org/html/836.html> (last visited 28 July 2010).
- 36 See [http://web.archive.org/web/\\*/http://putasgae.org](http://web.archive.org/web/*/http://putasgae.org) (last visited 28 July 2010).
- 37 See, e.g., <http://web.archive.org/web/20030528203547/antisgae.internautas.org/> (last visited 28 July 2010).
- 38 The full text of the complaint can be accessed at <http://www.internautas.org/archivos/demanda-sgae.pdf> (last visited 28 July 2010).
- 39 See the Decision of the Court of First Instance No 42 of Madrid, June 15, 2005 (Fifth legal ground). Available at [http://www.internautas.org/archivos/sentencia\\_sgae.pdf](http://www.internautas.org/archivos/sentencia_sgae.pdf) (last visited 28 July 2010).
- 40 See the first legal ground of the defendant's opposition to the complaint. The text of the opposition can be found at [http://www.internautas.org/archivos/oposicion\\_demanda.pdf](http://www.internautas.org/archivos/oposicion_demanda.pdf) (last visited 28 July 2010).
- 41 See the appeal at [http://www.internautas.org/archivos/interposicion\\_casacion.pdf](http://www.internautas.org/archivos/interposicion_casacion.pdf) (last visited 28 July 2010).
- 42 Judgment 773/2009 of the Supreme Court, Civil Chamber, 9 December 2009, available at <http://www.internautas.org/archivos/pdf/sentenciasupremoputasgae.pdf> (last visited 28 July 2010).
- 43 See Art. 14(1)(a) of the E-Commerce Directive.
- 44 Judgment number 316/2010, from the Civil Chamber of the Supreme Court, dated 18 May 2010; the text in Spanish is available at [http://responsabilidadinternet.wordpress.com/resol\\_jud/otras\\_materias/sts\\_18\\_05\\_2010\\_quejasonline](http://responsabilidadinternet.wordpress.com/resol_jud/otras_materias/sts_18_05_2010_quejasonline) (last visited 28 July 2010).
- 45 Judgment of the Court of First Instance No 23 of Valencia, 30 November 2006.
- 46 Judgment 403/2007 of the Audiencia Provincial (Court of Appeals) of Valencia, Section 6<sup>th</sup>, 29 June 2007.
- 47 Judgment 316/2010 of the Supreme Court (Civil Chamber), 18 May 2010.
- 48 *Viacom Intern. Inc. v. YouTube, Inc.* 2010 WL 2532404 (S.D.N.Y. June 23, 2010).
- 49 Judgment 289/2010 of the Commercial Court No 7 of Madrid, 20 September 2010.
- 50 See <http://dockets.justia.com/docket/new-york/nysdce/1:2007cv02103/302164/> (last visited 28 July 2010).
- 51 This paragraph is based on a previous article: Peguera, M. (2008): 'I Just Know That I (Actually) Know Nothing': Actual Knowledge and Other Problems in ISP Liability Case Law in Spain, E.I.P.R. 2008, 30(7), pp. 280 - 85
- 52 Decision of *Juzgado de Instrucción* No 9 of Barcelona, 7 March 2003.
- 53 Judgment 334/10 of the Criminal Court No 1 of Zaragoza, 20 October 2010.
- 54 Judgment of Court of First Instance No 19 of Madrid, 13 May 2009.
- 55 Judgment 95/2010, *Audiencia Provincial* (Court of Appeals) of Madrid, 9<sup>th</sup> Section, 19 February 2010.
- 56 Decision of *Audiencia Provincial* (Court of Appeals) of Madrid, Section 2<sup>nd</sup>, 11 September 2008, affirming the dismissal of the case decided by the examining judge (Decision of *Juzgado de Instrucción* No 4 of Madrid, 28 September 2007). The reasoning for the dismissal is to be found in a previous ruling where the examining judge rejected the preliminary measures requested (Decision of *Juzgado de Instrucción* No 4 of Madrid, 20 December of 2006). The rulings are available in Spanish at [http://responsabilidadinternet.wordpress.com/resol\\_jud/webs\\_enlace/](http://responsabilidadinternet.wordpress.com/resol_jud/webs_enlace/) (last visited 1 November 2010).
- 57 See Art. 20.1 TRLPI.
- 58 *Infosp*, Judgment of *Juzgado de lo Penal* (Criminal Court) No 1 of Logroño, 25 November 2008; *SimonFilms.tv*, Judgment of *Juzgado de lo Penal* (Criminal Court) No 2 of Vigo, 26 January 2010.
- 59 Decision 18/2010, *Audiencia Provincial* (Court of Appeals) of Valencia, 3<sup>rd</sup> Section, 8 January 2010.
- 60 Decision of *Juzgado de Primera Instancia e Instrucción* No 3 of Mislata, 17 May 2010.
- 61 Decision 630/2010, *Audiencia Provincial* (Court of Appeals) of Valencia, 3<sup>rd</sup> Section, 26 October 2010.
- 62 Decision of *Audiencia Provincial* (Court of Appeals) of Murcia, 5<sup>th</sup> Section, 16 September 2009.
- 63 Decision 551/2010, *Audiencia Provincial* (Court of Appeals) of Alicante-Elche, 7<sup>th</sup> Section, 20 September 2010.
- 64 While the Penal Code merely requires "lucrative intent", the interpretation favoured by the *Fiscalía General del Estado* is that this lucrative intent must occur on a commercial scale. See *Circular 1/2006 sobre los delitos contra la propiedad intelectual e industrial tras la reforma de la ley orgánica 15/2003*, available at [http://aui.es/IMG/pdf\\_CIRCULAR1-2006-FISCALIA.pdf](http://aui.es/IMG/pdf_CIRCULAR1-2006-FISCALIA.pdf) (last visited 28 July 2010).
- 65 See, e.g., Judgment 67/2010 of the Commercial Court (*Juzgado de lo Mercantil*) No 7 of Barcelona, 9 March 2010.
- 66 The new regulatory scheme is laid down in the Second Final Disposition of the Bill (*Disposición Final Segunda, Proyecto de Ley de Economía Sostenible*, BOCG, No 60, 9 April 2010), available at [http://www.congreso.es/public\\_oficiales/L9/CONG/BOCG/A/A\\_060-01.PDF#page=55](http://www.congreso.es/public_oficiales/L9/CONG/BOCG/A/A_060-01.PDF#page=55) (last visited 28 July 2010).
- 67 Art. 3.2 of the Directive 2000/31/EC. See also Recital (22) of this Directive.
- 68 See Art. 3.4(a)(i) of the E-Commerce Directive.
- 69 See Art. 3.4(a)(ii)-(iii) of the E-Commerce Directive.
- 70 It must be noted in Spanish national law, "intellectual property" means exclusively copyright and neighbouring rights. This expression does not include trademarks and patents, which are normally referred to as "industrial property".
- 71 Most of the rulings are available in Spanish at the author's blog [http://responsabilidadinternet.wordpress.com/resol\\_jud/](http://responsabilidadinternet.wordpress.com/resol_jud/) (last visited 1 November 2010). Many of them are also commented there.

# The Legal Classification of ISPs

## The Czech Perspective

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**Abstract:** This Article is a comprehension of the lecture held at the International Conference on “Commons, Users, Service Providers – Internet (Self-) Regulation and Copyright” which took place in Hannover, Germany, on 17/18 March 2010 on the occasion of the launch of JIPITEC.

It summarizes the current issues concerning ISP liability in the Czech Republic.

**Keywords:** ISP liability; Czech Republic; Mere Conduit; Caching Providers; Hosting Providers;

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### A. Introduction

1 The information society service providers (ISP) represent quite a special group of subjects in the information market. In fact, all activities carried out in information networks happen through these providers. Taking the role of ISPs from the legal point of view, they can be seen as factually contributing to and consequently co-responsible for all kinds of information flow. Finding ISPs as legally co-responsible for illegal activities that take place in the information networks might seem partially unfair – ISPs have neither the technical nor the legal capacity to control the quality of information that is communicated through their services, and so they also have no possibility to prevent their users from illegal acting. On the other hand, if ISPs were totally relieved from their legal responsibilities, there would be no efficient methods for factually enforcing the law. Just as any other activities, law enforcement in information networks is also done through the ISPs; if ISPs were immune from responsibility, law enforcement agencies (police, courts, etc.) would have no means of factually recovering illegal on-line states of affairs.

### B. Legislation

- 2 The Czech legislation that specifically regulates the responsibility of ISPs is based on European Directive No. 31/2000/EC (further referred to in this subchapter as the Directive). The Czech legislator chose to harmonize the rules of the e-commerce directive in the form of a special act. Act No. 480/2004 Sb., on certain services of the information society and on the amendment of corresponding acts, harmonizes not just the regulatory provisions of e-commerce on the responsibility of ISPs but also the prohibitive provisions on spam and some of the administrative competences in the field of e-commerce.
- 3 The definition of ISP that is used in Act No. 480/2004 Sb. was translated almost word for word from Directive No. 98/34/EC as amended by Directive No. 98/48/EC. Article 2 of Act No. 480/2004 reads as follows:

*For the purposes of the present act*

- (a) *information society service shall mean any service provided by electronic means at the individual request of a user submitted by electronic means, normally provided for remuneration; a service shall be*

- provided by electronic means if it is sent via an electronic communication network and collected by the user from electronic equipment for the storage of data;
- (b) *electronic mail shall mean a text, voice, sound or image message sent over a public electronic communication network which may be stored in the network or in the user's terminal equipment until it is collected by the user;*
  - (c) *electronic means shall mean in particular an electronic communication network, telecommunications terminal equipment and electronic mail;*
  - (d) *service provider shall mean any natural or legal person providing an information society service;*
  - (e) *user shall mean any natural or legal person who uses an information society service, in particular for the purposes of seeking information or making it accessible;*
  - (f) *commercial communication shall mean any form of communication designed to promote, directly or indirectly, the goods, services or image of an enterprise, a natural or legal person who pursues a regulated activity or is an entrepreneur pursuing an activity that is not a regulated activity; also advertising under a special legal regulation shall be deemed to be commercial communication. Data allowing direct access to the activity of a legal or natural person, in particular a domain name or an electronic-mail address shall not be deemed to be commercial communication; further, data relating to the goods, services or image of a natural or legal person or an enterprise acquired in an independent manner by the user shall not be deemed to be commercial communication;*
  - (g) *automatic, intermediate and transient storage shall mean storage of information provided by the user that takes place for the sole purpose of carrying out the transmission in an electronic communication network, and the information is not stored for any period longer than is usual in order to carry out the transmission;*
  - (h) *automatic, intermediate and temporary storage shall mean storage of information provided by the user that is performed for the sole purpose of making more efficient the information's onward transmission upon request of other users.*
- 4 The criterion "service on individual request" represents in practice an interpretational problem, namely in the case of services that have at once the features of both individually ordered and passively consumed (broadcast) services. As there has been no case law available up until now, it remains disputable whether services such as webcast or various variants of video-on-demand fall under the scope of the legal definition of an ISP. Here we can predict that courts would examine the nature of the respective service and identify the dominant element in the process of ordering and selection of the service content – if the key element is found in active communication, the service will likely be subsumed under the definition of an ISP.
  - 5 Other definitions in Act No. 480/2004 Sb. are with almost no exceptions based on those used in the e-commerce directive. This legislative approach that is based on translations of formulations used in EC directives can also be seen in other parts of harmonized Czech law. In general, we hold the opinion that it might bring a certain level of clarity into the process of harmonization on the one hand, but on the other hand it might cause uncertainties as the translated definitions and other legislative formulations might not always fit properly into the existing system of national law.
  - 6 One of the key questions that arise from the aforementioned legislative approach is whether Act No. 480/2004 Sb. covers only private legal responsibility or whether it also affects the administrative and penal responsibilities of ISPs. Despite the fact that there is missing case law on this question, we firmly hold the opinion that the Act specifically regulates only the private legal responsibility of the ISPs. This interpretation is based on the fact that all the references that are made from Act No. 480/2004 Sb. regarding the responsibility of ISPs are made to the private law legislation (namely to the Civil Code and the Commercial Code). Out of this we might assume that it was not the intention of the lawmaker to link the provisions regarding the responsibility of ISPs to the provisions of administrative or penal law, and consequently that the existing administrative or penal legal responsibility is neither affected nor modified by Act No. 480/2004 Sb.
  - 7 Within the scope of private law, we have to also clarify the question of the applicability of Act No. 480/2004 Sb. in relation to other private legal acts and codes. In particular, there is the question of applicability of the principle *lex specialis derogat legi generali* when speaking about Act No. 480/2004 Sb. in relation to other private legal legislation. In other words, there is a need to clarify the priority in application of Act No. 480/2004 Sb. As Act No. 480/2004 Sb. applies only on specific subjects of private law – i.e., the ISPs – there is no doubt that its provisions have priority in application over the general foundations of the private legal responsibility laid down in the Civil Code and the Commercial Code. It implies that whenever the foundation of the private responsibility of ISPs is at stake, the limits laid down in Act No. 480/2004 Sb. will apply. Thus, Act No. 480/2004 Sb. is to be understood as special in relation also to the liability grounds laid down in other parts of the private legal legislation. For example, this means that in one of the most frequent cases of illegal activities on line where the Copyright Act applies – copyright infringement – ISPs are also relieved of responsibility to the extent laid down in Act No. 480/2004 Sb.
  - 8 In order to make a distinction between various types of ISPs, Act No. 480/2004 Sb. divides them analog-

ically with the e-commerce directive into three categories:

- § Mere conduit providers
- § Caching providers
- § Hosting providers

## I. Mere conduit

9 The definition of mere conduit services including the limits of the liability of their providers is laid down in Article 4 of Act No. 480/2004 Sb. that reads as follows:

- (1) *A provider of a service that consists of the transmission in an electronic communication network of information provided by a user, or the provision of access to electronic communication networks for the purpose of information transmission, shall be liable for the contents of the information transmitted only if he*
- (a) *initiates the transmission;*
  - (b) *selects the user of the information transmitted; or*
  - (c) *selects or modifies the contents of the information transmitted.*
  - (d) *The acts of transmission and provision of access under paragraph 1 shall also include automatic, intermediate and transient storage of the information transmitted.*

10 As can be seen from the wording of the above article, the mere conduit providers are defined basically as the providers of the communication links. It should be noted here that the transmission can be provided by both physical and logical means. Therefore, it is not just telecommunication companies or more general providers of connection services (including restaurants with Wi-Fi internet coverage, for example) that fall under the scope of this article, but also the providers of logical services like IP telephony, instant messaging, etc.

11 The liability of mere conduit providers is limited in a relatively broad way, and the only case when the mere conduit ISP might be held liable for illegal content remains the situation when the illegal information is accountable to the respective ISP. Whenever the ISP has not affected the content or the choice of the recipients or has not initiated the transmission of the respective information, there are no grounds for finding it liable for it.

12 There are no provisions in Act No. 480/2004 Sb. that would be parallel to Articles 12(3), 13(2), and 14(3) of the e-commerce directive that give the national legislators an opportunity to legislate takedown or removal duties for ISPs. In this regard it might be considered disputable whether the special provisions of the Czech law under which law enforcement agencies may order mere conduit providers to block

the respective service (such as those contained in the Copyright Act) should be held as valid or not. However, the absence of such an express statement in fact does not deprive the legislator from including the takedown duties in specific enforcement provisions as it has to be interpreted in the light of the above-cited provision of the e-commerce directive. Using the argument *e silentio legis*, we might conclude that the takedown enforcement duties do not fall under the scope of Act No. 480/2004 Sb. and therefore the ISPs are not exempt from any liabilities arising from the takedown enforcement provisions of either the private, administrative, or penal law. In other words, for example, when the Copyright Act lays down the duty to desist with further transmitting of unlicensed copyrighted content, the court might also order the enforcement of this duty against a mere conduit ISP that provides the telecommunication services and is in this case, however, exempt from any other remedies, namely damages.

## II. Caching Providers

13 The analogous regime to the case of mere conduit applies to the caching providers. The only difference is in one additional criterion for holding the caching ISP liable for the illegal content of the cached information, i.e., generally speaking, the objective incompliance with the technical or legal requirements for caching. The liability limitation for caching providers is laid down in Article 4 of Act No. 480/2004 Sb. It reads as follows:

- (1) *A provider of a service that consists of the transmission of information provided by a user shall be liable for the contents of automatically, intermediately and temporarily stored information only if he*
- (a) *modifies the contents of the information;*
  - (b) *fails to comply with conditions on access to the information;*
  - (c) *fails to comply with rules regarding the updating of the information that are generally recognised and used by the industry;*
  - (d) *interferes with the lawful use of technology, generally recognised and used by industry, to obtain data on the use of the information; or*
  - (e) *fails to take immediate measures resulting in a removal of or disablement of access to the information he has stored upon obtaining knowledge of the fact that the information at the initial source of the transmission has been removed from the network, or access to it has been disabled, or that a court has ordered removal of or disablement of access to such information.*

14 The above formulation implies that caching providers might be held liable for the quality of information that is communicated via their infrastructure, not just when the respective information is accoun-

table to them but also when the caching service does not run properly. This might happen in a situation when the source server has already deleted the illegal information but the mirror (or cache) did not react in a proper amount of time, and though the information was already deleted from the source server it still remains in the cache. The technical requirements, however, are considered according to the relatively vague category of industrial practices. This imposes uncertainty on one hand (as of now there is no case law that would clarify the meaning), but on the other hand it enables the courts to adopt and eventually fluently change the practice to correspond to the state of the technology development and the quality and level of development of the local information infrastructure.

### III. Hosting

- 15 From the point of view of ISP responsibility, hosting is the most complex and complicated service of the information society. Here, the ISP provides users with an infrastructure for the storage of their data and eventually makes it available on-line. It is important to note that the law does not make any distinction according to the quality or quantity of the hosted information. Thus, a hosting provider can qualify as such by providing a webhosting service that hosts terabytes of webpages or through a discussion board that in facts hosts only a couple of kilobytes of users' posts.
- 16 Czech law defines hosting providers and the limits of their private legal responsibilities in Article 5 of Act No. 480/2004 Sb. that reads as follows:
- (a) *A provider of a service that consists of the storage of information provided by a user, shall be responsible for the contents of the information stored at the request of a user only if he*
  - (b) *could, with regard to the subject of his activity and the circumstances and nature of the case, know that the contents of the information stored or action of the user are illegal; or having, in a provable manner, obtained knowledge of illegal nature of the information stored or illegal action of the user, failed to take, without delay, all measures, that could be required, to remove or disable access to such information.*
- (2) *A service provider referred to in paragraph 1 shall always be responsible for the contents of the information stored if he exerts, directly or indirectly, decisive influence on the user's activity.*
- 17 Czech law uses the concept of unconscious negligence (*culpa levis*) as the basis for the legal responsibility of hosting providers. It is enough to make the ISP liable, then, to prove that the ISP at least could have known about the illegal nature of the information and did not remove it. There is, however, neither a general monitoring obligation nor an approval for an ISP to monitor the hosted content. Consequently, it is in practice almost impossible to argue unconscious negligence because it would be too difficult to prove that the ISP actually could have known about the illegal information.
- 18 Thus, the more convenient and practical way of arguing for the liability of hosting providers is through conscious negligence (*culpa lata*). In this case, the claimant has to prove that the ISP had actual knowledge about the illegality of the stored information. In order to prove that, it is advisable to inform the ISP in a provable way about the fact that some information stored on its infrastructure is illegal. Then, the ISP is given an option either to block or delete the respective information or to be held liable for it.
- 19 It is to be stressed that the ISP has to be informed in most cases not just about the appearance of the illegal information but also about its illegality. Namely, in cases of defamation or violation of intellectual property rights, there is a need to notify the ISP not just of the fact that the information appeared on its infrastructure, but also of the reasons why the claimant considers the respective information to be illegal.
- 20 There are neither specific legislative requirements nor any case law regarding the process of the takedown that should be taken by the ISP in order to avoid being responsible for the illegal information. We hold the opinion that Czech courts are likely to follow recent German court practice on this point when the time requirements for a takedown are considered according to the nature of the service and nature of the ISP. The required reaction time will then be differentiated between, for example, the large professional webhosting servers and a private discussion board run as someone's weekend hobby.
- 21 As can be seen, the law might put ISPs between two kinds of pressure. It can be the pressure of the claimant demanding a takedown of allegedly illegal service on one side and the pressure of the customer with a valid service contract on the other. Moreover, in many cases, it is not *prima facie* clear whether the respective information is illegal or not. Out of this, certain risks for the ISP might arise:
- § If the ISP considers the allegedly illegal data to be appropriate and continues with fulfilling the terms of a service contract (in other words, if the ISP does not take the service down upon notification), the ISP might be held co-responsible if it later turns out in court that the information was illegal.
  - § If the ISP takes the service hosting the allegedly illegal data down (in other words, if the ISP takes the service down upon notification) and it

later turns out that the data was not illegal, the ISP will be responsible to the client for not fulfilling the terms of the service contract.

22 It is to be noted that any provision of the service contract might not relieve the ISP from responsibility toward third persons – such a liability limitation clause would be completely unenforceable as it is not possible under Czech law to affect the rights of third parties by a mutual agreement. It is also not possible for the ISP to avoid the responsibility by a unilateral disclaimer – if that were attempted, it would not be enforceable. Thus, the only way for the hosting provider to mitigate the risks arising from the responsibility for the user-stored information is:

- § the inclusion of a takedown clause in the service contract and/or
- § the inclusion of a promise of remuneration of damages in the service contract

23 The takedown must be formulated in a way that would give the ISP the possibility to take the service down only upon the announcement of a third party (the objective illegality would not be required). This would allow the ISP to take down the service upon notification without worrying about being in breach of the service contract if it turns out later that the respective information was not illegal.

24 The promise or remuneration of damages gives the ISP an opportunity to regressively claim the damages that the ISP had to pay to third persons in connection to the hosting service. It does not protect the ISP from responsibility for the users' data, but it gives it a possibility to claim the suffered expenses back afterward.

#### IV. Monitoring and cooperation

25 In general, ISPs of all types are not required to monitor the information communicated by their clients. This is laid down in Article 6 of the Act No. 480/2004 Sb. that reads as follows:

- 6.) *Service providers referred to in Sections 3 to 5 shall not be obliged to*
- (a) *monitor the contents of the information which they transmit or store;*
  - (b) *actively seek facts or circumstances indicating to illegal contents of information.*

26 Moreover, in certain information society services – as in the case of telecommunications or e-mail – the ISPs are even prohibited from monitoring their clients. That makes them not just relieved of the monitoring duty but even legally unable to monitor the quality of communicated information. However, if the ISP reveals for any cause user information that

reliably shows that one of the crimes specified below was or is likely to be committed, the person working for the ISP has an immediate duty (just as any other individual under Czech jurisdiction) to announce that fact to the police:

- § treason
- § subversion of the republic
- § terror
- § terrorist attack
- § sabotage
- § espionage
- § endangerment of classified information
- § infringement of duties relating to manipulation with controlled goods
- § infringement of duties relating to international trade with military equipment
- § forgery or alteration of money
- § infringement of international sanctions
- § illegal manipulation with personal data
- § participation in criminal conspiracy
- § public endangerment
- § endangerment of security of an airplane or a ship
- § dragging of an airplane to a foreign country
- § torture of entrusted person
- § murder
- § genocide
- § use of prohibited measure of warfare

27 Not fulfilling the information duty in the above cases might then lead to criminal prosecution. It is to be noted in this respect that Czech law still does not recognize corporate units as criminally liable, and therefore no fulfillment of the information duty would be recognized as the criminal act of a particular person who learned about the information.

28 As to cooperation duties, the duty to cooperate is formulated in all three types of court procedures – civil, administrative, and criminal litigation – that also apply to all ISPs. According to the respective procedural codes, everyone is obliged to cooperate on the

court procedures in the form requested by the court (in all procedures), state prosecutor (criminal procedures), or police (criminal procedures) without having a right to monetary compensation. Such cooperation might then also include the duty to reveal information or to provide the requested means of evidence (see the subchapter below).

29 The most problematic of the cooperation duties for ISPs is the general duty to cooperate with the police forces that is formulated in Article 47 of Police Act No. 283/1991 Sb. It applies to all subjects under Czech jurisdiction, including ISPs, and reads as follows (informal translation):

- (1) *In the course of fulfilling their duties, the police forces are entitled to request help in the form of documents or information from artificial persons, individuals, or state or municipal organs.*
- (2) *Organs and subjects named in paragraph 1 are obliged to provide the requested help if it is not contrary to their legal obligations.*

30 The above provisions give the police forces relatively broad competence when speaking about ISPs. As the ISPs are obliged to help the police upon request (without any further specifications), the police might ask them, for example, to block particular communication lines, to take down some webpage, or to provide information about users.

31 There are, of course, legal limits to the above-named competence, namely in the field of privacy and protection of personal data. The extent to which police forces are entitled to use the competence to require the help of ISPs is also limited by general constitutional principles. However, the limits are still relatively broad and allow the police to actively control the flow of information to a relatively large extent.

## V. Preliminary and procedural injunctions

32 In general, the procedural law makes a distinction between the preliminary injunctions and various types of procedural injunctions. While the preliminary injunctions are issued in order to preliminarily secure the rights of the parties and/or to make future decisions possible to be issued and enforced, the procedural injunctions are used in order to facilitate the procedure (i.e., to obtain evidence or to enforce the cooperation of various stakeholders). Preliminary injunctions are legislated in Articles 74(1) – 74(3) of the Code of Civil Procedure (Act No. 99/1963 Sb.) that read as follows (informal translation):

- (1) *Before the commencement of the proceedings, the chairman of the panel may order a preliminary injunction if it is necessary to regulate provisionally the relationships of the participants or if there is a dan-*

*ger that the enforcement of a judicial decision could be jeopardized.*

- (2) *Those who would be participants of the proceedings on the merits shall be the participants of the preliminary proceedings.*
- (3) *The competence to order a preliminary injunction shall be exercised by the court that is competent to hear the case unless the law provides otherwise.*

33 The preliminary injunctions can be issued only against subjects with potential passive procedural capacity, i.e., subjects that are potentially legally liable. When Act No. 480/2004 Sb. exempted mere conduit providers from responsibility, it exempted them to the same extent also from the scope of applicability of the preliminary injunctions. Thus, it is not possible to impose a preliminary injunction against an ISP in a situation when the legal exemption in Act No. 480/2004Sb. applies.

34 Procedural injunctions (or procedural orders) do not have that broad material scope of application as preliminary injunctions because they only serve the purpose of fluency of the procedure. On the other hand and unlike the preliminary injunctions, they can be issued against any subject regardless of its recent or potential procedural position. The most important of the procedural injunctions is the injunction on conservation of evidence. It is legislated for the civil procedure in Article 78 of Act No. 99/1963 Sb.) that reads as follows (informal translation):

- (1) *Before the commencement of the proceedings on the merits, it shall be possible upon a petition to conserve evidence if there is a danger that the evidence will later not be possible to carry out at all or that it will be possible to carry out only with great difficulties.*
- (2) *The conservation of evidence will be carried out by the court that would be competent to hear the merits or by the court in whose district the means of evidence is located.*
- (3) *The conservation of evidence shall be carried out by the chairman of the panel in the way prescribed for the concerned evidence. Unless there is a danger of default, the participants of the proceedings on merits shall have the right to be present at the conservation of evidence.*

35 It is to be noted that the above provisions may be used only to the extent that is necessary for the respective procedure. Thus, it is not possible, for example, for a court to confiscate for an unlimited time all the storage facilities of an ISP when just the evidence of storage of some data is to be obtained.

# Court Decisions

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# Kontent i Pravo v. Masterhost

Presidium of the Supreme Arbitration Court of the Russian Federation, Judgment of 23 December 2008, Nr. 10962/08.

## Translation and Comment

by **Stefan Labesius**, Berlin,  
M.A., Member of ifrOSS

**Abstract:** This Judgment by the Presidium of the Supreme Arbitration Court of the Russian Federation can be considered as a landmark ruling for Internet Service Provider's (ISP) liability. The Court stipulates for the first time concise principles under which circumstances an ISP shall be exempt from liability for transmitting copyright infringing content. But due to the legislation on ISP liability in the Russian Federation it depends on the type of information which rules of liability apply to ISP. As far as a violation of intellectual property rights is claimed, the principles given now by the Supreme Arbitration Court are applicable, which basically follow the liabil-

ity limitations of the so called EU E-Commerce Directive. But, furthermore, preventive measures that are provided in service provider contracts to suppress a violation through the use of services should be taken into account as well. On the other hand, as far as other information is concerned the limitations of the respective Information Law might be applicable which stipulates different liability requirements.

This article gives a translation of the Supreme Arbitration Court's decision as well as a comment on its key rulings with respect to the legal framework and on possible consequences for practice.

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### Key Rulings:

1. An Internet service provider (here: hosting provider) shall not be liable for transmitted information if such provider does not initiate its transmission, select the recipient of the information, (and) affect the integrity of the transmitted information.
2. In this connection, preventive measures that are provided by contracts concluded between the provider and its customers to suppress a viola-

tion through the use of services granted by the provider should be taken into account.

Federal Law of the Russian Federation of 9.7.1993 (No. 5351-1)1 "On Copyright and Neighboring Rights" Articles 48, 492

Presidium of the Supreme Arbitration Court of the Russian Federation, Judgment of 23 December 2008, Nr. 10962/083 – Kontent i Pravo v. Masterhost

## A. Judgment

(excerpt)

(...)

The Presidium of the Supreme Arbitration Court of the Russian Federation heard the motion of the Closed Joint Stock Company “Masterhost” on reviewing judgments of the Ninth Arbitration Appellate Court of 5.02.2008 and of the Federal Arbitration Court of the Moscow Circuit of 13.05.2008 (No. A40-644/07-5-68).

(...)

With a motion to the Supreme Arbitration Court of the Russian Federation on reviewing the decisions of the appellate and cassational instances in the procedure of supervision, the company “Masterhost” requests that these be overruled, referring to an unlawful application of Articles 48, 49 of the Law of the Russian Federation from 09/07/1993 (No. 5353-1) “On Copyright and Neighboring Rights” (hereinafter Copyright Act) by the courts, and that the decision of first instance be remain in force.

(...)

Upon examination of the validity of the evidences presented with the motion, the opinion on them, and the speeches of representatives of the parties being present at the oral hearings were considered, the Presidium takes the view that all such judgments are subject to overruling for the following reasons.

The company “Kontent i pravo” as the owner of the exclusive rights for using on the Internet the music works “Krylatye kacheli”, “Kaby ne bylo zimy”, “Prekrasnoe daleko” (author: E.P. Krylatov), “Aleksandra” (author: C.Ya. Nikitin) (exclusive rights for use of these works were acquired by the plaintiff through contracts dated 30.05.2005, No 0014/05/A (with its subsequent approval on 31.08.2006) and 13.07.2005, No. 0030/05/A (with its subsequent approval on 31.08.2006)), “Rano ili pozdno”, “Polchasa”, “Stranye tancy” (rights acquired from former rights holder - the limited liability company “Izdatel'stvo Dzhem” - on the basis of the contract dated 31.3.2005, No. 0001/05/A) sought protection of its rights because of illegal use by means of reproduction and making available for general knowledge<sup>4</sup> of the said works on the Internet via the web site at <http://www.zaycev.net>.

(...)

The court of first instance denied satisfaction of the rights holder’s request for protection of its exclusive rights to the musical works of E.P. Krylatov and C.Ya. Nikitin from unlawful copying and making available

for general knowledge by means of placement on the web site [www.zaycev.net](http://www.zaycev.net) by recognizing: the company “Masterhost” represents a network operator that provides data transmission services in a network of public communication in the Moscow City area, and it cannot be responsible for the content of its customer’s stored and disseminated information. The court, however, though it mentioned that the plaintiff had rejected any claims against the other defendants, did not finish the process at this stage and did not refuse the suit against them.

The court of appellate instance did not concur with the conclusions of the court of first instance and considered the company “Masterhost” – a hosting provider, on its server the web site [www.zaycev.net](http://www.zaycev.net) was hosted – using musical works without permission of the rights owner, to be an infringer of the exclusive rights of the company “Kontent i pravo”, and had to pay 140,000 rubles in damages.

The court of appellate instance rejected evidence presented by the company “Masterhost” on the ownership of the site in question to a third person, and decided that the company did not prove the fact of placing the web site on its server by a third person, but not by itself. The court of cassational instance agreed with the findings of the court of appellate instance.

However, the courts of appellate and cassational instance did not determine whether the company “Masterhost” knew or could have known about the unlawful dissemination of the named works, therefore, they unlawfully laid the burden of proof for the absence of the fact of use of these works on the company.

The fact of unauthorized use of the works by means of making them available for general knowledge, i.e. placing of works on the Internet by the company “Masterhost”, has to be proven by the rights holder that claims protection of its exclusive rights.

The materials of the case confirm that the company “Masterhost” is a company that offers services in connection with providing Internet web sites on its own servers or of stationing client’s hardware in its own site.

According to the contract dated 19.12.2004 Nr. 0413-c/04c and its Annex Nr. 2, the company “Masterhost” was obliged toward the company “MetKom” (customer) to grant services of placing hardware (servers, hardware for telecommunication and other means) at a technical site in the data center, i.e., for the purpose of providing Internet access to informational resources of the company “MetKom” its hardware was placed in the rooms of the company “Masterhost’s” data center, which was obliged

to ensure twenty-four-hour technical support, monitoring and availability of this hardware.

An analysis of the contract concluded between the company “Masterhost” and the company “MetKom” shows: the company “Masterhost” is a hosting provider that solely carries out a technical function – the placement of hardware for a customer and technical support (given service, to be understood as the placement of servers at an Internet provider’s site commonly is named with the term “co-location”). By granting of such type of service, the provider generally has no access to the customer’s hardware. Therefore, in the named contract (clause 5.4), it is stipulated that the customer is fully responsible for compliance of the stored information on the hardware with the applicable legislation. In the event of obtaining grounded complaints or reliable information by a third person concerning a violation of a law or contract due to the fact of storing any information by the customer in connection with the use of services, the company “Masterhost” is entitled to suspend the rendering of the respective services for the customer.

Thus, a provider shall not be responsible for information transmitted if it does not initiate its transmission, select the recipient of the information, affect the integrity of the transmitted information. In this connection, preventive measures that are provided by contracts concluded between the provider and its customers to suppress a violation through the use of services granted by the provider should be taken into account.

Such circumstance was to evaluate by the Court that the rights holder did not appeal to the hosting provider with a complaint to suspend the rendering of services for the customer due to the unauthorized use of the above-mentioned works on the Internet, as well as such, that the company “Masterhost” took measures to reveal the person who had placed the disputed music works on the computer network, and reported on that on the first complaint, whereas the company “Kontent i pravo”, notwithstanding the information given by the provider, did not lay a claim on protection of copyrights to that person.

As well, the company “Masterhost” is not the owner of the IP address under which the website with the musical works was available in September 2006. In the materials of the case, there is discrepant information found about the ownership of this address at the time of the reviewed infringement. The courts did not examine the question about the owner of the site and the coincidence of it with the owner of the domain name.

The courts of appellate and cassational instance unreasonably rejected the contracts presented by the company “Masterhost”, which give evidence that the

company rendered services for the company “MetKom”, on whose site, possibly, the mentioned musical works were made available.

Due to the circumstances listed above, there has to be recognized: notwithstanding the requirements of Article 48 Copyright Law, a person (company “Masterhost”) was recognized as an infringer of copyrights which itself did not carry out actions concerning the use of the objects of copyright; in relation to the other defendants the dispute was not reviewed, however the process in relation to them was not finished within the established procedure.

Thus, the decision of the court of first instance and the decisions of the courts of the appellate and cassational instance are subject to repeal for violating the uniformity of interpretation and application by the Arbitration Courts according to Article 304 para. 1 Arbitration Process Code of the Russian Federation. The case is remanded to the court of first instance for new review.

(...)

## B. Comment

### I. Introduction

- 1 The cited judgment<sup>5</sup> given by the Presidium of the Supreme Arbitration Court of the Russian Federation<sup>6</sup> can be considered a landmark ruling for the framework of an Internet Service Provider’s (ISP) liability. With this decision as one of the first resolved cases regarding the liability of ISPs for copyright infringements, the court has taken a standpoint that is founded on the classical situation of rights infringements on the Internet concerning web hosting. A web host provides its own web servers or its data center for setting up servers for its customers. On these servers, copyright-infringing content is made available via the Internet, and now the rights owner wants to make a claim against the web host. In the present case, the defendant did not provide its own web space, but it allowed a customer to store its hardware in the defendant’s data center and only ensured maintenance and operation services for the customer’s hardware and technical access to public communication networks (called co-location).
- 2 But obviously important technical questions remained unanswered when the courts of lower instance assessed the technical assignment of the disputed web site. Hence, considering the evidence submitted, the Supreme Arbitration Court asserted that it was not even clear whether the defendant was the owner of the IP address in question under which the relevant content was made available on the In-

ternet. Furthermore, the lower courts should have addressed which person was the actual owner of the site and whether this person was identical with the owner of the Internet domain.

## II. Findings of the Court

- 3 In the beginning of its decision, the Court deals with the question of burden of proof for the alleged infringement and states that such an infringement has to be proven by the rights holder. This was of fundamental importance for this decision because only copyright damages were claimed by the plaintiff, and these require a corresponding guilt for the alleged violation. The Court states that the lower instance courts did not resolve whether the defendant knew or could have known about the illegal making available and dissemination of copyright-protected content. Because this question was left open, the Supreme Arbitration Court ruled that the defendant incorrectly had to bear the burden of proof that the defendant did not use the works.
- 4 This statement of the Supreme Arbitration Court is unclear in two aspects. First, based on the fact that the lower courts did not examine the requirement of guilt, the conclusion cannot be mandatorily drawn that a party facing a claim has to bear the burden of proof if the courts fail to assess such a requirement. Second, the conclusion of the Court seems to stand in contradiction to the statutory burden of proof rule pursuant to Article 401 para. 2 CC RF. According to this rule, a person accused of a violation of obligations has to prove the absence of his guilt (intention or negligence).<sup>7</sup> The answer given by the Supreme Arbitration Court can therefore probably be interpreted to the effect that, because of a lacking allocation of the infringer's IP address, a violation of obligation of the defendant toward copyright could not have been proven in the first place.
- 5 In the following section, the Court comments on the distribution of responsibility according to the hosting contract between the defendant as the web host and its customer. Here it points to the customer's contractual obligation to comply with the laws and the customer's complete legal responsibility for the content on its web servers according to the contract. Despite the defendant's contractual obligation to ensure server hosting and access to communication networks, the Court allows the defendant to disconnect or interrupt its services to its customer if the web host obtains grounded claims of rights infringement by its customer. Therefore, the Court basically seems to favor a "notice-and-take-down" approach. However, it remains unclear why the Presidium only considers an entitlement rather than an obligation to (temporarily) interrupt such a connection or to suspend services in case of rights infringements and what requirements need to be fulfilled for such a notification of the ISP. For instance, a clearer "notice-and-take-down" approach is favored by the Presidential Administration. The Council at the President of the Russian Federation for Codification and Development of Civil Law in its interpretation of existing laws assumes that providers are already obliged to respond if they are informed of copyright infringements by the rights holder.<sup>8</sup>
- 6 In the course of the judgment, the Court names fundamental requirements which in principle oppose claims against an ISP. A provider shall not be liable for transferred information if it does not initiate its transmission, select the recipient of the information (and) affect the integrity of the transmitted information.<sup>9</sup> First, an ISP shall not initiate the transmission of information. A definition of the term "initiation" is not given by the Court. A mere provision of access to a public communication network as it was also stipulated in the hosting contract cannot be seen as an act of initiation by any means. In this respect, an access provider should fall under this exception as well. Second, selection of information shall not be carried out by the provider. Such a selection could be, for instance, technical filtering of information with regard to the transmitted content. And finally, an ISP is not allowed to affect the integrity of the information during transmission. This is the case if the provider carries out any modification or rearrangement of transmitted information. But it remains open whether these prerequisites need to be laid down on a technical or on a legal – e.g., contractual – basis. Therefore, it is might be recommendable that providers stipulate contractually that such actions are not carried out during transmission.
- 7 Accordingly, the Court also takes a look at the contractual relations between the ISP and its customer as the alleged rights infringer. Hence, in estimating how a claim can be drawn on an ISP, preventive measures that are provided by contracts concluded with a provider's customers to suppress a violation through the use of services granted by the provider should also be taken into account. From the rights holder's point of view, this seems disadvantageous, because in general the rights holder has neither insight in nor influence on the liability stipulations and contractual measures within the hosting provider contract. But considering the contractual situation between the customer and provider, it is notable that the Court refers to the fact that the provider is not granted access to the hardware of its customer. In addition, it remarks that the rights holder has to inform the ISP about the alleged infringement, which in turn is entitled to provide information about the (alleged) infringer and to interrupt the continued violation of rights. However, the Court suggests that an ISP's liability for compensation comes into question only if the provider does not comply with its obligation to reveal the identity of the infringer.

### III. Legal Classification

- 8 Classifying the cited decision with respect to copyright obligations toward ISPs necessitates keeping in mind that the question of liability for copyright infringements was based on the former Copyright Law. In its Articles 48 and 49, a liability for compensation of damages was stated only in the case of guilt, but without any cease-and-desist obligation in the absence of guilt. Such an obligation is now stipulated in Article 1250 para. 3 CC RF for infringement of intellectual property rights, which orders a strict duty of elimination in case of a continuing violation.
- 9 Furthermore, it should be noted that indeed the Russian legislation provides a regulation for the limitation of ISP liability. Such limitations for intermediaries are stated in Article 17 para 3 of Federal Law on Information, Information Technologies and Protection of Information.<sup>10</sup> According to this – and similar to the legislation of other countries<sup>11</sup> – if the distribution of certain information is limited or prohibited by federal laws, a person who renders the following services shall be exempt from civil liability: first, transmission of information received from another person, provided that this transmission does not involve modification and correction of the information; or second, storage of information and facilitating access thereto, provided that the person was not aware and could not have been aware of the illegal character of distributing such information.<sup>12</sup> These requirements, therefore, are applicable for any type of ISP services such as hosting-, accessing- or other providing services.
- 10 But these limitations explicitly do not apply to rights of so-called results of intellectual activity and measures of individualization,<sup>13</sup> thus intellectual property including copyright-protected works.<sup>14</sup> As a result of this exception, the type of information determines which rules of liability apply to ISPs. If a violation of intellectual property rights is claimed, the principles given now by the Supreme Arbitration Court are applicable; otherwise, the limitations of the Information Law apply. This raises the question whether there are differentiations between the requirements of limiting the ISP's liability. Considering the principles given by the Court that a liability is excluded if the ISP does not initiate its transmission, select the recipient of the information, and affect the integrity of the transmitted information, this rule obviously follows the first alternative of Article 17 para. 3 Information Law. But additionally, the Supreme Arbitration Court introduces the requirement of the absence of any type of initiating the information transmission and the requirement of selecting the recipient that both in principle follow those requirements provided in Article 12 para. 1 of Directive 2000/31/EC.
- 11 In addition, the Court considers the contractual situation between an ISP and its customer, and the factual situation of accessibility of the infringing content for the provider. There it points toward a full responsibility of the customer for its content according to the service provider contract and the inaccessibility of this content for the ISP. Hence, compared with the limitations of liability for other information according to the Information Law, the principles given by the Court in general ease the liability for ISPs due to additional limitation requirements.

### IV. Conclusion

- 12 The decision of the Supreme Arbitration Court deserves credit for identifying for the first time the type and scope of ISP liability for avoiding claims for the infringement of its customers. However, this judgment raises more questions than it answers. The issue of burden of proof is joined by the question to what extent the principles given by the Supreme Arbitration Court apply to the liability of ISPs in general. Besides that, the relation of different approaches for establishing a limitation of liability – liability for intellectual property rights infringements on the one hand and liability for distribution of information on the other hand – needs to be clarified. In practice, therefore, it should be very carefully assessed whether information is protected by intellectual property rights as well. In connection with the assessment of the actual infringer, the Court itself pointed to the necessity of determining the assignment of IP address and domain name and their respective owner.
- 13 On the other hand, the limitation of ISP liability is – in principle – geared to the principles of the EU E-Commerce Directive, and the cited decision gives rough guidelines for a limitation of ISP liability in cases of intellectual property rights infringements. On a contractual basis between the provider and its customer, it should be stipulated that the customer is legally responsible for information and that, in case of an infringement based on grounded facts, the provider is entitled to give information that will enable the customer's identification. Therefore, a rights holder can only draw claims against a provider if the provider does not in turn contribute to the identification of its customer.
- 14 In the near future the Court will have the opportunity to answer these questions again. After the initial case was referred back to the trial court, the plaintiff appealed to the Supreme Arbitration Court, whose decision of 7 June 2010<sup>15</sup> rejected to entrust the Presidium of the Court once again with the case referring to the rulings of the said decision. It might not be unlikely that the Supreme Arbitration Court will follow the interpretation of the Council to the Pres-

ident of the Russian Federation on the Codification and Development of Civil Legislation and clearly establish a “notice-and-take-down” approach.

- 1 Rossiiskaya Gazeta, Nr. 147 of 3.8.1994.
- 2 See now Article 1250-1253, 1301, 1302 of the Civil Code of the Russian Federation (hereinafter CC RF).
- 3 Judgment of the Supreme Arbitration Court of the Russian Federation of 23.12.2008, (Nr. 10962/08), (Postanovlenie Prezidiuma Vysshego Arbitrazhnogo Suda RF ot 23.12.2008, Nr. 10962/08) (VAS), Vestnik VAS RF, 2009, Nr. 5.
- 4 Note: See for legal definition of the right of making available for general knowledge now Article 1270 para 2 Nr. 11 CC RF.
- 5 This judgment as well as the lower courts' decisions can be found at: [http://www.arbitr.ru/index.asp?id\\_sec=386&id\\_ac=1&s=0&a=1&id=1a1ec4d8-e984-474c-94f4-7e105e9917e1](http://www.arbitr.ru/index.asp?id_sec=386&id_ac=1&s=0&a=1&id=1a1ec4d8-e984-474c-94f4-7e105e9917e1) (Last visited: 7.12.2010).
- 6 Notwithstanding the name, Arbitration Courts act as state courts and not as bodies of alternative dispute resolution. They predominantly deal with economic disputes.
- 7 Within the liability for damages in connection with copyright infringements pursuant to the respective Articles 1250-1253 CC RF, Article 401 CC RF is now applicable; see Joint Resolution of the Plenum of the Supreme Court and the Plenum of the Supreme Arbitration Court of the Russian Federation “On some questions raised in connection with the introduction of the Fourth Part of the Civil Code of the Russian Federation” (Nr. 5/29), Nr. 23 para. 2, (Postanovlenie Plenuma Verchovnogo Suda RF i Plenuma Vysshego Arbitrazhnogo Suda RF ot 26.3.2009 „O nekotorych voprosach, vznikshich v svyazi s vvedeniem v deistvie chasti tchetvertoj Grazhdanskogo kodeksa Rossiiskoy Federacii), Vestnik VAS RF, 2009, Nr. 6.
- 8 See “Concept for Developing the Civil Law Legislation of the Russian Federation” by the Council at the President of the Russian Federation for the Codification and Development of Civil Law (Konceptiya Razvitiya Grazhdanskogo Zakonodatel'stva Rossiiskoy Federacii, Sovet pri Prezidente RF po Kodifikacii i Sovershenstvovaniyu grazhdanskogo zakonodatel'stva), Vestnik VAS RF, Nr. 11, 2009, pp. 6 et seq, Nr. 2.5.
- 9 Obviously these requirements basically follow those of the limitation of liability pursuant to Article 12 para. 1 of Regulation Nr. 2000/31/EC of the European Union (so called E-Commerce Regulation).
- 10 Federal Law of 27.7.2006 (Nr. 149-FZ) “On Information, Information Technologies and Protection of Information” (Federal'nyi Zakon ot 27.7.2006 (N 149-FZ) “Ob informacii, informacionnykh tehnologiyach i o zashtshite informacii”). hereinafter: Information Law.
- 11 For instance: Articles 12-15 Directive 2000/31/EC, §§ 7-10 Telemediengesetz (Germany) or U.S.C. 17, Chapter 5, § 512 (USA).
- 12 See as well: Article 14 para. 2000/31/EC.
- 13 See Article 1 para. 2 Information Law.
- 14 See Article 1225 para. 1 CC RF. In this connection it is notable that also so called Know-How, i.e. commercial secrets (see Articles 1465 CC RF et seq.) are also governed by the rules on intellectual property.
- 15 VAS, Decision of 7.6.2010 (Nr. VAS-10962/08).

# Telecino v. YouTube

COMMERCIAL COURT NO. 7 MADRID, SPAIN  
JUDGMENT NO. 289 /2010, 23 July 2008

## Proceedings:

ORDINARY PROCEEDINGS 150 /2008 SECTION:  
Concerning OTHER MATTERS  
Of Mr./Ms. GESTEVISION TELECINCO SA, TELECINCO CINEMA SAU

## Versus

Mr./Ms. YOUTUBE LLC

## I. FACTS

**ONE.** This Court was assigned a claim in ordinary proceedings concerning the violation of intellectual property rights, filed by the Court Procedural Representative Mr. Manuel Sánchez-Puelles, on behalf of GESTEVISION TELECINCO S.A. and TELECINCO CINEMA S.A.U., against YOUTUBE LLC, with Court Procedural Representative Mr. Ramón Rodríguez Nogueira, in which, after stating the facts and legal grounds appearing therein, it requested that a judgment be delivered in accordance with its petitions, with an express order for costs against the defendant.

**TWO.-** The claim having been admitted for consideration, it was decided to summon the defendants, who within the statutory period duly appeared and presented a defense opposing the petitions in the claim in accordance with the facts and legal grounds stated in its written submission.

**THREE.-** It was decided to call the parties to the preliminary hearing, which was held on the day set. At the above-mentioned hearing, after trying to reach a settlement, the plaintiff ratified its claim and the defendant ratified its defense. The procedural issues that could hinder the continuance of the proceedings having been resolved, and all other measures envisaged by law having been carried out, the facts on which a dispute exists were established and the parties were granted the possibility to propose evidence: the plaintiff proposed the examination of the defendant, public documents, private documents, experts' opinion, and judicial inspection and testimony; whereas the defendant proposed documentary evidence, further documentary evidence, witnesses' testimony and expert evidence, a date then

being set for the trial at which the evidence admitted would be taken.

**FOUR.-** The trial was held on the date set and the parties appearing attended. Upon commencement the evidence was taken in order, with the result shown in the record of the proceedings. The Judge ordered an adjournment of the hearing to be resumed on April 9, 2010, at which the parties were given the opportunity to verbally state their closing arguments, which they did in the manner documented in the record of the proceedings, after which the proceedings were concluded for the delivery of judgment.

**FIVE.-** In the hearing of these proceedings the statutory requirements have been observed.

## II. LEGAL GROUNDS

**ONE.-** Given the peculiar nature of the subject matter of the dispute, it is advisable to systematically arrange the parties' claims in well-defined blocks of subjects which, in the development of their arguments, unify without homogenizing them, both factually and on the legal grounds that make up the core of the dispute.

The plaintiff, formed by two companies of the Telecino Group, files several actions for alleged violation of intellectual property rights against the company Youtube LLC on the grounds that the transmission through the defendant's website of various audiovisual recordings owned by the plaintiff constitutes a violation of the intellectual property rights of Telecino, which has caused it a huge loss and damages, the exact quantification of which must be established in a subsequent procedure.

The defendant's opposition lies on a harmonized group of exceptions that concern both the nature of the activity carried on and the legislation and case law applicable, and which directly refer us to the collection of issues identified below.

It is necessary, first of all, to clarify the nature of the activity carried on by the defendant in relation to the recordings transmitted, and, in particular, whether it is limited to providing intermediary services for the users of its website or whether it provides and creates content, in relation to which it must be held liable according to the general terms of the intellectual property law.

Next, it is necessary to define precisely the scope of the defendant's liability as a mere information service provider in relation to the content circulated on its platform by third parties.

The last of the blocks of controversial arguments concerns the damages claimed by the plaintiff. Due to its nature, this is subject to the analysis of the preceding issues.

#### **TWO.- YOUTUBE'S ACTIVITY. PROVISION OF INTERMEDIARY SERVICES VS. PROVISION OF CONTENT.**

Given the focus of the litigation, the nature of the defendant's activity constitutes one of the core issues on which the proceedings depend. This is because both the group of obligations and rights and the liability system differ completely depending on whether we accept the plaintiff's theory, which claims that despite appearances, the defendant's web page does not merely serve as a platform so that third parties may circulate its content, but rather YouTube is directly or indirectly involved in creating it; or on the contrary, following the defendant's arguments, we consider its activity to be limited to what the Information Society Services Law calls intermediary services.

In order to analyze such a substantial issue, we will follow the scheme as a line of argument prepared by the plaintiff in its claim. We will do so for systematic reasons, because precisely the argument concerning the elements or parameters that, according to the plaintiff, distort the nature of YouTube's activity as a mere provider of services will allow us to investigate the essence of that activity and reach a sufficiently verified opinion in relation to it.

According to the theory put forward in the claim, YouTube holds itself out as a mere intermediary service provider, when in reality it acts as a content provider. For this purpose, it uses a language with community and common ideals tone, artificially giving prominence to the users, camouflaging its editorial work by technical and automatic presentation of the selection processes, etc. ... and all of this for the pur-

pose of violating the intellectual property rights of third parties who have not granted their consent to the transmission of the recordings.

The plaintiff highlights certain peculiar features which, in its opinion, would allow YouTube to be classified as a content provider. We will analyze them below.

It is claimed in the statement of claim that YouTube commercially exploits the videos for its own benefit as a licensee of the users; otherwise, the defendant would not need any license from rights holders for the operation of the web site. The request for a license included in the so-called Terms of Use allegedly proves, it claims, that the defendant does not merely provide intermediary services.

However, the truth is that the request for a license from the users who upload content is not incompatible with the existence of an intermediary service that admits several variants; for example, the so-called hosting Web 2.0 – which, unlike pure hosting, has as its purpose the upload by the participating users of materials for circulation and the sharing of them with other users – is precisely the service provided by YouTube and is a situation where the service provider is often a licensee of the user.

The second of the characteristic features that allegedly proves the plaintiff's theory is that the defendant performs what it calls "editorial work" in a process of selection and monitoring of the content displayed on the webpage. This allegedly happens with the so-called "featured videos," which appear in a special section and are chosen by YouTube's employees. This is also allegedly proven by the supervision and discrimination of certain videos which, without being unlawful, are incompatible with the editorial policy advocated by the defendant.

Regardless of the legal scope of this allegation, the fact is that the evidence produced does not prove, even to a minimum extent, the theory put forward in the claim.

As has been stated by the witness Victoria Grand at the hearing, it is physically impossible to supervise all the videos made available to the users because, at present, there are over 500 million videos. The content, whatever it is, is always identified in advance by the users who flag it and point it out so that YouTube can remove it.

Nor is any editorial work performed when certain videos are selected for the "featured videos" section. Those videos are identified on the basis of a series of parameters of a more or less objective nature, such as the popularity of the video among users. In any event, the selection of certain videos according to certain criteria previously defined by the users does

not involve any editorial work of creation or provision of content.

Nor does the access to the videos made available by the defendant to its users through a webpage designed by YouTube and distinguished by its trademark seem to contradict the nature of the provision of intermediary services.

The plaintiff also claims that the defendant commercially exploits its website for gain, but one fails to understand the relation between this fact and the nature of the provision of the intermediary service, because precisely the Information Society Services Law considers that any service provided under it will normally be for consideration. This is also the theory confirmed in a recent judgment of the European Union Court of Justice when it points out that “the mere fact that the referencing service is remunerated, that Google establishes the forms of remuneration, or even that it is general information for its customers, cannot mean that Google is excluded from the exemption from liability provided by Directive 2000/31” (ECJ judgment of March 23, 2010).

It is appropriate next to describe in detail both the process of providing the hosting services and the search engine offered by the defendant, and the system it has established to verify the content or, more precisely, to detect unlawful content, because this is extremely important both to establish and specify the nature of the defendant’s activity and to define the scope of its liability.

At the hearing, Mr. Javier Arias provided a detailed account of the process which, in general terms, can be described as follows: the process starts when the user, who must be previously registered and have opened an account, makes the decision to upload a video on YouTube’s website. The user must assign a title to it and also some key words called tags to allow the video to be located. It should be pointed out that it is precisely the user who makes the decision regarding the use of the video and who is also responsible for its content.

Next, YouTube processes the video through its Flash format by means of a totally automatic conversion process and it is stored in YouTube’s servers. From that moment any person with Internet access can view the videos that other users have uploaded to the website. Again, the decision is entirely up to the user.

It must also be pointed out that the defendant does not offer or supply any kind of tool to the users to allow the downloading of the videos. It is true that through other platforms said download can be carried out, but these are services that are completely unrelated to those provided by the defendant.

Next it is appropriate to describe, though briefly, the procedures that the defendant has installed for the notification and take-down of unlawful content.

Rights holders who are considered prejudiced by the broadcast of any recording can request the removal of unlawful content by identifying the complete URL of the reproduction page, together with an explanation and proof of their right. Once that notification has been received, the video is automatically removed from YouTube’s site. That notification is subsequently sent to the user, who may issue what is called a counter-notification.

The content is verified by means of a program called Video ID, which requires the cooperation of the rights holder to provide YouTube with the so-called reference files of each video owned by him or her that he or she wishes to remove. Once the video has been identified, the owner may opt to automatically block that recording so that it will not be published on YouTube’s website, to monitor it, or to try to generate revenue by inserting advertising associated with the video.

The fact is that the system of detection, notification, and verification installed by the defendant was effective on each occasion when Telecinco requested the removal of content from YouTube’s website. On February 14, 2007, the plaintiff asked the defendant to remove certain unlawful content in relation to several videos associated with series such as *Los Serrano* or *Médico de Familia*. On the same day, YouTube proceeded to remove the aforementioned videos. Likewise, in March 2007, the plaintiff asked the defendant to remove an episode of the series *Los Serrano* and the video was immediately removed from the webpage. This proves that when the content has been identified through the URL, the system of protection of property installed by the defendant has been effective. Therefore, it does not seem reasonable to claim that they are bureaucratic and complicated pretexts, excuses, or systems of camouflage that cannot be carried out.

This proves that the defendant provides an intermediary service in the terms defined by the Information Society Services Law as “a service of the information society whereby the provision or use of other services of the information society or access to information is facilitated.”

Thus, YouTube’s system of liability for the provision of information services is established in Articles 14 to 17 of the Information Society Services Law. These provisions establish a system of partial exemption from liability for the service providers regarding content hosted on websites.

From this perspective, it is clear that in accordance with the Electronic Commerce Directive of June 8,

2000, and the content of the Spanish law transposing it, the Information Society Services Law, it is not possible to impose on any intermediary service provider a general obligation to supervise the data transmitted or hosted, and much less still to carry out active searches for facts or circumstances of unlawful activities.

YouTube is not a content provider and therefore is not obliged to supervise in advance the lawfulness of such content hosted on its website; its only obligation is to cooperate precisely with the rights holders in proceeding to remove the content immediately when an infringement has been identified. That duty to cooperate is also contained in the Preamble of the Information Society Services Law and has been duly fulfilled by the defendant by means of the systems of detection, notification, and verification established.

### **THREE.- LIABILITY OF SERVICE PROVIDERS. ACTUAL KNOWLEDGE.**

The plaintiff files a second group of actions linked to the status of YouTube as an intermediary service provider.

Having admitted that the reproduction of the videos on the YouTube website does not include any activity typical of the creation of content but rather of the provision of a technical service, it is claimed even so in the statement of claim that the defendant would have incurred liability in accordance with the general system established in the Information Society Services Law of July 11, 2002.

Article 13.2 of the above-mentioned law provides an exception to the system of general liability for intermediary services by providing that “in order to determine the liability of the service providers for the conduct of intermediary activities, the provisions of the following articles shall be observed.”

Thus, under the heading of “Liability of hosting service providers,” Article 16 of the Information Society Services Law, incorporating the content of Article 14 of the Electronic Commerce Directive, exempts hosting service providers from liability provided that: “a) they have no actual knowledge that the activity or the information which they store or to which they refer is illegal or it violates a third party rights liable for indemnity, b) if they do so, they act diligently to remove the data or prevent access to it.”

As proven by the text quoted, the exemption from liability for intermediary service providers rests on a legal concept that is difficult to define, as is the concept of “actual knowledge.”

The Spanish law seems to opt for a restricted and limited concept of actual knowledge of illegal activity by demanding that it be declared by a competent

body that has ordered the removal of the information or which disables access to same. According to the Information Society Services Law, a “competent body” shall mean any judicial or administrative body that acts in the exercise of powers conferred by law. In fact, the only bodies competent to decide the lawfulness or unlawfulness of the information are the courts, as there is no administrative body with specific powers in this area.

A strict and orthodox interpretation of the legislation would require that, in order for YouTube to have “actual knowledge” of the unlawful nature of the content hosted on its website and for it to be considered liable for it, said unlawfulness should have been declared in advance by a court. (In this regard there is a judgment of the Provincial Court of Madrid of February 19, 2010.)

The plaintiff proposes a more flexible interpretation of that concept which allows the actual knowledge to be derived from a non-judicial “competent body” or through other sources of knowledge in accordance with the criteria established in the judgment on which it relies of the Supreme Court of December 9, 2009.

The first thing that must be noted is that the above-mentioned judgment refers to a rather different scenario in which the registered domain name was clearly defamatory, but this does not apply in the case under consideration here.

Probably the most correct interpretation is one that is less strict than an orthodox interpretation – which would restrict the concept so as to render it equivalent to a judicial ruling – and complies with the principles that underlie both the Directive and the Information Society Services Law, which quite clearly prohibit imposing a general control obligation on those who provide intermediary services.

This means that actual knowledge must be proven in detail; mere suspicion or rational indicia are not sufficient to prove it. That definition of actual knowledge undoubtedly requires the cooperation of the injured party. This is rightly held by the judgment of the TGI of Paris of April 15, 2008, which states that “actual knowledge of the clearly unlawful nature of a violation of the property or moral rights of authors or producers does not imply any prior knowledge and requires the cooperation of the victims of the infringement, who must inform the company which hosts the internet users’ sites of what rights they consider affected.”

In this specific case, this means that on the basis of the firmly established general principle that the defendant has no obligation to monitor or supervise in advance the content hosted on its website, it is up to the plaintiff to actually inform YouTube of the con-

tent that may harm or infringe the ownership of its intellectual property rights. It must do so not in a mass scale or unconditionally, but rather on an individual or specific basis, because, as the defendant rightly states, many of the videos that users have uploaded on YouTube's website may be fragments of information not protected by the intellectual property law or mere parodies of programs belonging to Telecinco that do not enjoy that protection either.

For this purpose, the defendant has established a system of detection and verification as we saw earlier that allows supervision by third parties affected by a potential violation of their intellectual property rights. It is true that we must agree that it is not a handy and easy procedure for the plaintiff, particularly because it bears the hard task of tracing and checking the content hosted on the defendant's website. However, this is due precisely to the order of priorities that both the Community and the national legislator have established.

We know that there is an area of intersection, plagued by latent tension, between the intellectual property rights holders and the Internet intermediary service providers who host third parties' content that may sometimes infringe on those rights. However, the epicenter of that tension is not situated in possible fissures in the legislation. The law only answers, like a far echo, the sound heard to the strain of the rhythm of social change that occurs in the deep layers of the economic structure.

There is probably a lot of rhetoric and epic declamation in the defendant's repeated reliance on that principle, declared sacred, of freedom of expression, and the supposed function that it claims to carry out in that context. The fact is that beyond that wild enthusiasm, there is evidence that we cannot ignore and of which these proceedings are a shining example: the value of information has become the most valuable merchandise in a digitalized world. The challenge for entrepreneurs in the new economic order does not consist so much of protecting vested rights as it does of creating value in the transmission of that content, because the passage of time shows the uselessness of any artificial frontier.

#### FOUR.- THE DIRECT ACTION FOR CESSATION AGAINST THE INFORMATION SERVICE PROVIDER.

Finally, the companies of the Telecinco Group file an action for cessation against the defendant as intermediary service provider under the provisions of Articles 138 and 139 of the Intellectual Property Law, amended by Law 19/2006 of June 5 and Law 23/2006 of July 7.

The plaintiff claims that according to the reform carried out in Article 138 of the Intellectual Property Law, it is quite possible to bring an action against

the intermediaries or service providers even where the acts of these intermediaries do not constitute an infringement per se.

This assertion is only partially true because both provisions, when providing for actions for cessation, establish an exception in their final paragraph by providing that "without prejudice to the provisions of Law 34/2002, of July 11, governing Information Society Services and Electronic Commerce." Therefore, it is blindingly obvious that the exception established by means of the expression "without prejudice" completely eliminates the possibility of bringing the action against service intermediaries and, in this respect, the Intellectual Property Law adds nothing to the exception envisaged in the Information Society Services Law.

In conclusion, on the basis of the arguments stated above, the claim must be dismissed.

**FIVE.-** In accordance with the provisions of Article 394 of the Civil Procedure Law, the plaintiff must be required to pay the costs.

### III. RULING

I dismiss in full all the claims contained in the statement of claim, ordering the plaintiff to pay the costs incurred in these proceedings.

[...]

# Google Images

## Bundesgerichtshof

### (German Federal Court)

Entscheidung vom 29.04.2010, I ZR 69/08

(Vorschaubilder)

With an English Introduction

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## A. Introduction

1 The long-awaited verdict by the German Federal Court of Justice towards Google image search has drawn much attention to the problem of copyright infringement by search engines on the Internet. In the past years the question has arisen whether the listing itself in a search engine like Google can be an infringement of copyright. The decision is widely seen as one of the most important of the last years. With significant amount of effort, the German Federal Court tried to balance the interests of the right holders and those of the digital reality.

### I. Case

2 The defendant, Google, provides Internet user with an image search engine with the ability to search pictures on the basis of text string. In order to speed up the search the Google searchbot indexes pages and stores the pictures in the Google cache. The site presents thumbnail views of the indexed pictures. The search site provides a link to the web page where the picture is stored. The applicant is a German artist who shows samples of her art on her own web-page. In February 2005 a couple of her works were available via the Google image search engine. The applicant demanded to stop indexing her web page and to stop showing thumbnails of her pictures.

## II. Decision

### a.) Copying

3 Due to the Federal Court the use of thumbnails on Google Imagesearch is an act of copying within the meaning of German Copyright Law. The resizing does not open the purview of § 24 UrhG (free use), while § 23 UrhG (adaptations) requires the copyright owner's consent. Nevertheless the court dismissed the claims. Since the pictures are stored on servers in the US, the principle of territoriality inhibits the applicability of German Copyright Law.

### b.) Making available to the public

4 Due to the German Federal Court the use of pictures infringe the applicant's right to make a work available to the public (§19a UrhG). The important point here is that Google not only provides the user with the technology to find web-pages with certain pictures but stores the pictures on own servers and gives the users the opportunity to access the pictures regardless of time and location. This constitutes an infringement of the right to make a work available to the public. The court dismissed Google's argument that the act of making the work available to the public is covered from copyright limitations such as the right of citation (§ 51 UrhG) and the limitation for

transient copies which are an integral and essential part of a technological process (§ 44a UrhG).

### c.) Justification

- 5 Google argued that by putting the pictures on the Internet the applicant had given a license for making the work available. The Federal Court dismissed this argument in accordance with earlier statements by the previous instances. Since the licensing is a disposition of a right in rem, the strict requirements of such a disposition must be met. This means in particular that from an objective point of view it has to be clear that the copyright holder wants to license the use of the work. Such a disposition cannot be seen in the mere act of putting pictures on a website. And much less, if the applicant has used a copyright notice<sup>1</sup> on the works.
- 6 Instead the Federal Court referred to an exculpatory consent. The mere exculpatory consent differs from the licensing, since it gives no enforceable title or contract to the defendant, but only justifies the use. Therefore, the requirements of the declaration are not as strict as in the case of a license. Especially, no explicit declaration of intent is needed; an implied declaration by behavior can be adequate. By making the work available over the Internet and not using the available technologies to prevent the Googlebot from indexing the page and storing the pictures in the cache, the applicant has given her implied consent.
- 7 The consent was also not withdrawn, when the applicant informed Google about her opposition to the listing of her pictures. Since the essential declaration was the act of putting the pictures on the internet without protection and this declaration is directed at the general public, the act of withdrawing this declaration would have to be in the same way. A declaration of withdraw just addressed to Google would constitute an act against the principle of equity and good faith (protestatio facto contraria). The court stressed the fact that the applicant could defend herself against unsolicited copying and linking of her pictures by technical means. Therefore the Federal Court dismissed the applicant's claims.

### III. No liability for Google (Obiter Dictum)

- 8 The Federal Court states in an obiter dictum that even if the works would have been put on the internet without the consent of the right holder, the Search Engine Operator would not be liable before it is notified of such an infringement. As a host provider the Search Engine Operator is privileged un-

der Art 14 Directive 2000/31/EG as long as the act of supply is purely technical, automatic and passive event and the Search Engine Operator has no knowledge or control over the material.

## B. Decision

### I. Leitsätze

UrhG §§ 19a, 51 Abs. 1 Satz 1, § 97

**a) Der Betreiber einer Suchmaschine, der Abbildungen von Werken, die Dritte ins Internet eingestellt haben, als Vorschaubilder (sog. Thumbnails) in der Trefferliste seiner Suchmaschine auflistet, macht die abgebildeten Werke nach § 19a UrhG öffentlich zugänglich.**

**b) Die Verwertung eines geschützten Werks als Zitat setzt nach wie vor einen Zitzweck im Sinne einer Verbindung zwischen dem verwendeten fremden Werk oder Werkteil und den eigenen Gedanken des Zitierenden voraus.**

**c) Ein rechtswidriger Eingriff in urheberrechtliche Befugnisse ist nicht nur dann zu verneinen, wenn der Berechtigte rechtsgeschäftlich entweder durch Einräumung entsprechender Nutzungsrechte über sein Recht verfügt oder dem Nutzer die entsprechende Werknutzung schuldrechtlich gestattet hat. Vielmehr ist die Rechtswidrigkeit eines Eingriffs in ein ausschließliches Verwertungsrecht auch dann ausgeschlossen, wenn der Berechtigte in die rechtsverletzende Handlung eingewilligt hat. Eine solche Einwilligung setzt keine auf den Eintritt dieser Rechtsfolge gerichtete rechtsgeschäftliche Willenserklärung voraus.**

[...]

Die Revision gegen das Urteil des 2. Zivilsenats des Thüringischen Oberlandesgerichts in Jena vom 27. Februar 2008 wird auf Kosten der Klägerin zurückgewiesen.

### II. Tatbestand:

- 1 Die Klägerin ist bildende Künstlerin. Sie unterhält seit 2003 unter der Internetadresse m\*\*\*.de eine Internetseite, auf der Abbildungen ihrer Kunstwerke eingestellt sind. Auf einzelnen Seiten befindet sich ein Copyright Hinweis mit dem Namen der Klägerin.
- 2 Die Beklagte betreibt die Internetsuchmaschine google, die über eine textgesteuerte Bildsuchfunktion verfügt. Mit ihr kann ein Nutzer durch Ein-

gabe von Suchbegriffen nach Abbildungen suchen, die Dritte im Zusammenhang mit dem eingegebenen Suchwort ins Internet eingestellt haben. Die von der Suchmaschine aufgefundenen Bilder werden in der Trefferliste als verkleinerte und in ihrer Pixellanzahl gegenüber den auf den Originalseiten vorgehaltenen Abbildungen reduzierte Vorschaubilder gezeigt (sogenannte Thumbnails). Die Vorschaubilder enthalten einen elektronischen Verweis (Link), mit dem man über einen weiteren Verweis zu der Internetseite gelangen kann, die die entsprechende Abbildung enthält. Die für den Suchvorgang erforderlichen Informationen gewinnt die Suchmaschine durch den Einsatz von Computerprogrammen (sogenannte "robots" oder "crawler"), die das Internet in Intervallen regelmäßig durchsuchen. Die dabei aufgefundenen Abbildungen werden als Vorschaubilder durch Speicherung auf Servern der Beklagten in den USA vorgehalten, um bei Eingabe eines Suchworts den Suchvorgang und die Anzeige der entsprechenden Vorschaubilder in der Trefferliste zu beschleunigen.

- 3 Im Februar 2005 wurden bei Eingabe des Namens der Klägerin als Suchwort in der Trefferliste Abbildungen von Kunstwerken gezeigt, die die Klägerin ins Internet eingestellt hatte.
- 4 Die Klägerin hat die Darstellung ihrer Kunstwerke als Vorschaubilder in der Suchmaschine der Beklagten als Urheberrechtsverletzung beanstandet und zuletzt beantragt, es der Beklagten unter Androhung näher bezeichneter Ordnungsmittel zu untersagen,
 

*Abbildungen von Kunstwerken der Klägerin zu vervielfältigen und/oder vervielfältigen zu lassen und/oder über das Internet zugänglich zu machen und/oder zu bearbeiten oder umzugestalten, wie es in Form sogenannter thumbnails im Rahmen der Bildersuchmaschine der Beklagten geschehen ist.*
- 5 Die Beklagte ist der Klage entgegengetreten. Sie sei schon nicht Werknutzerin. Eine Urheberrechtsverletzung scheidet ferner deshalb aus, weil die gesetzlichen Schrankenregelungen eingriffen. Jedenfalls liege eine konkludente Einwilligung der Klägerin vor, weil sie ihre Bilder frei zugänglich ins Internet eingestellt habe.
- 6 Das Landgericht hat die Klage abgewiesen. Die Berufung der Klägerin ist erfolglos geblieben (OLG Jena GRUR-RR 2008, 223).
- 7 Mit ihrer (vom Berufungsgericht) zugelassenen Revision verfolgt die Klägerin ihren Klageantrag weiter. Die Beklagte beantragt, die Revision zurückzuweisen.

### III. Entscheidungsgründe:

- 8 I. Das Berufungsgericht hat die Klage für unbegründet erachtet, weil die Geltendmachung des Unterlassungsanspruchs, der der Klägerin aus § 97 Abs. 1

UrhG zustehe, rechtsmissbräuchlich sei (§ 242 BGB). Dazu hat es ausgeführt:

- 9 Die auf Leinwand gemalten oder mit anderen Techniken hergestellten Bilder der Klägerin seien schutzfähige Werke der bildenden Kunst i.S. von § 2 Abs. 1 Nr. 4 UrhG. Dieser Urheberrechtsschutz gehe nicht dadurch verloren, dass die Klägerin selbst Abbildungen dieser Werke in digitalisierter Form ins Internet eingestellt habe. Es könne dahinstehen, ob die Beklagte bei der Anzeige der Vorschaubilder in der Trefferliste ihrer Suchmaschine in das Recht der Klägerin auf öffentliche Zugänglichmachung aus § 19a UrhG eingegriffen habe. Die Vorschaubilder seien jedenfalls sonstige Umgestaltungen der Werke der Klägerin i.S. von § 23 UrhG. Bei deren Anzeige in der Trefferliste der Suchmaschine handele es sich um eine Nutzung, die von den dem Urheber vorbehaltenen Rechten nach § 15 Abs. 2 UrhG erfasst werde. Die Beklagte sei insoweit auch urheberrechtlich verantwortlicher Werknutzer und stelle nicht nur technische Hilfsmittel zur Verfügung.
- 10 Gesetzliche Schrankenregelungen griffen nicht ein. Die Bestimmung des § 44a UrhG sei nicht einschlägig. Die Anzeige der Vorschaubilder sei keine lediglich flüchtige oder begleitende Vervielfältigungshandlung ohne eigenständige wirtschaftliche Bedeutung. Die Anzeige erfolge vielmehr dauerhaft und biete dem Verwerter eine Vielzahl von Einnahmemöglichkeiten, insbesondere durch Werbung. Die Beklagte sei auch nicht Veranstalter einer Ausstellung der Klägerin i.S. von § 58 Abs. 1 UrhG. Vorschaubilder seien ferner keine nach § 53 UrhG zulässigen Privatkopien, da sie (auch) erwerbswirtschaftlichen Zwecken dienten. § 51 UrhG greife nicht ein, weil es jedenfalls an einem berechtigten Zitatzzweck fehle.
- 11 Die Nutzungshandlungen der Beklagten seien nicht aufgrund einer Einwilligung der Klägerin gerechtfertigt. Eine ausdrückliche Einwilligungserklärung liege nicht vor. Aus dem Umstand, dass die Klägerin ihre Bilder ins Internet eingestellt habe, ohne technisch mögliche Schutzmaßnahmen zu ergreifen, ergebe sich auch keine stillschweigende Einwilligung.
- 12 Die Geltendmachung des Unterlassungsanspruchs aus § 97 Abs. 1 UrhG durch die Klägerin sei jedoch rechtsmissbräuchlich (§ 242 BGB). Die Klägerin verhalte sich widersprüchlich, wenn sie einerseits Suchmaschinen den Zugriff auf ihre Internetseite durch Gestaltung des Quellcodes erleichtere und damit zu erkennen gebe, insgesamt am Zugriff durch Suchmaschinen interessiert zu sein, sich andererseits aber gegen das bei der Bildersuche durch Suchmaschinen übliche Verfahren der Umgestaltung von Abbildungen in Vorschaubilder wende.
- 13 II. Die gegen diese Beurteilung gerichteten Angriffe der Revision haben keinen Erfolg. Das Berufungsgericht hat Unterlassungsansprüche der Klägerin nach

§ 97 Abs. 1 Satz 1 UrhG wegen Verletzung ihrer urheberrechtlichen Verwertungsrechte im Ergebnis zu Recht verneint.

- 14 **1.** Das Berufungsgericht ist zutreffend davon ausgegangen, dass die Klägerin mit ihrer Klage nur im Inland begangene Verletzungshandlungen hinsichtlich der ihr im Inland zustehenden Urheberrechte an den in der Klageschrift benannten Kunstwerken geltend gemacht hat (vgl. BGH, Urt. v. 8.7.2004 - I ZR 25/02, GRUR 2004, 855, 856 = WRP 2004, 1293 - Hundefigur; Urt. v. 24.5.2007 - I ZR 42/04, GRUR 2007, 691 Tz. 18 f. = WRP 2007, 996 - Staatsgeschenk) und deshalb nach § 32 ZPO die - auch unter der Geltung des § 545 Abs. 2 ZPO in der Revisionsinstanz von Amts wegen zu prüfende - internationale Zuständigkeit deutscher Gerichte gegeben ist. Die Abbildungen der Kunstwerke der Klägerin sind als Vorschabilder in der Suchmaschine der Beklagten bestimmungsgemäß (auch) in Deutschland zu sehen (vgl. BGHZ 167, 91 Tz. 21 - Arzneimittelwerbung im Internet, m.w.N.). Da Gegenstand der Klage allein die Verletzung urheberrechtlicher Verwertungsrechte ist, für die die Klägerin im Inland Schutz beansprucht, ist im Streitfall, wie auch das Berufungsgericht angenommen hat, deutsches Urheberrecht anzuwenden (vgl. BGH GRUR 2007, 691 Tz. 22 - Staatsgeschenk, m.w.N.).
- 15 **2.** Das Berufungsgericht ist zu Recht davon ausgegangen, dass der Klägerin der geltend gemachte Unterlassungsanspruch nicht deshalb zusteht, weil die Beklagte in das ausschließliche Recht der Klägerin eingegriffen hat, ihre Werke in körperlicher Form zu verwerten (§ 15 Abs. 1 UrhG).
- 16 **a)** Bei den von der Klägerin auf Leinwand gemalten oder mit anderen Techniken geschaffenen Bildern handelt es sich, wovon auch das Berufungsgericht mit Recht ausgegangen ist, um unter Urheberrechtsschutz stehende Werke der bildenden Kunst i.S. von § 2 Abs. 1 Nr. 4 UrhG. Die von der Klägerin auf ihrer Internetseite eingestellten Abbildungen dieser Kunstwerke sind körperliche Festlegungen dieser Werke in entsprechenden Speichermedien dieser Internetseite und damit Vervielfältigungen i.S. von § 16 Abs. 2 UrhG.
- 17 **b)** Da die Vorschabilder der Bildersuchmaschine der Beklagten die Werke der Klägerin nach den Feststellungen des Berufungsgerichts lediglich verkleinert, ansonsten aber ohne wesentliche Veränderungen identisch in ihren schöpferischen Zügen gut erkennbar wiedergeben, handelt es sich bei ihnen - unabhängig davon, ob sie als Bearbeitungen oder Umgestaltungen unter § 23 UrhG fallen - gleichfalls um Vervielfältigungen i.S. von § 16 Abs. 2 UrhG. Vom Vervielfältigungsrecht des Urhebers werden auch solche - sogar in einem weite-ren Abstand vom Original liegende - Werkumgestaltungen erfasst, die über keine eigene schöpferische Ausdruckskraft verfügen und sich daher trotz einer vorgenommenen Umgestaltung noch im Schutzbereich des Originals befinden, weil dessen Eigenart in der Nachbildung erhalten bleibt und ein übereinstimmender Gesamteindruck besteht (BGH, Urt. v. 10.12.1987 - I ZR 198/85, GRUR 1988, 533, 535 - Vorentwurf II, m.w.N.). Nach den von der Revision nicht angegriffenen weiteren Feststellungen des Berufungsgerichts erfolgt die den Vorschabildern zugrunde liegende körperliche Festlegung jedoch auf in den USA gelegenen Speichermedien. Etwaige Verletzungshandlungen in den USA sind aber, wie dargelegt, nicht Gegenstand des vorliegenden Verfahrens. Sonstige Vervielfältigungshandlungen der Beklagten oder ihr zurechenbare Vervielfältigungshandlungen Dritter, die im Inland begangen worden wären, sind nicht ersichtlich. Das Berufungsgericht hat einen Unterlassungsanspruch der Klägerin, soweit er auf die Untersagung von Vervielfältigungen gerichtet ist, schon deshalb mit Recht verneint.
- 18 **3.** Einen Unterlassungsanspruch der Klägerin wegen Verletzung des urheberrechtlichen Verwertungsrechts der Klägerin, ihre Werke in unkörperlicher Form öffentlich wiederzugeben (§ 15 Abs. 2 UrhG), hat das Berufungsgericht im Ergebnis gleichfalls zu Recht verneint. Die Beklagte hat zwar dadurch, dass bei Eingabe des Namens der Klägerin als Suchwort deren Kunstwerke in den Vorschabildern der Bildersuchmaschine der Beklagten abgebildet wurden, das Recht der Klägerin auf öffentliches Zugänglichmachen ihrer Kunstwerke verletzt (§ 15 Abs. 2 Satz 2 Nr. 2, § 19a UrhG). Entgegen der Auffassung des Berufungsgerichts hat die Beklagte dabei jedoch nicht rechtswidrig gehandelt, weil sie aufgrund einer Einwilligung der Klägerin zu der beanstandeten Nutzung der Werke in den Vorschabildern berechtigt war.
- 19 **a)** Das dem Urheber nach § 15 Abs. 2 Satz 1 und 2 Nr. 2 UrhG vorbehaltene Recht der öffentlichen Zugänglichmachung (§ 19a UrhG) ist das Recht, das Werk der Öffentlichkeit in einer Weise zugänglich zu machen, dass es Mitgliedern der Öffentlichkeit von Orten und zu Zeiten ihrer Wahl zugänglich ist. Ein Zugänglichmachen im Sinne dieser Vorschrift setzt nur voraus, dass Dritten der Zugriff auf das sich in der Zugriffssphäre des Vorhaltenden befindende geschützte Werk eröffnet wird (vgl. BGH, Urt. v. 22.4.2009 - I ZR 216/06, GRUR 2009, 845 Tz. 27 = WRP 2009, 1001 - Internet-Videorecorder; Urt. v. 20.5.2009 - I ZR 239/06, GRUR 2009, 864 Tz. 16 = WRP 2009, 1143 - CAD-Software; Dreier in Dreier/Schulze, UrhG, 3. Aufl., § 19a Rdn. 6; Schrickler/v. UngernSternberg, Urheberrecht, 3. Aufl., § 19a UrhG Rdn. 43).
- 20 Durch die Anzeige in Vorschabildern der Trefferliste einer Suchmaschine macht der Suchmaschinenbetreiber, der diese Vorschabilder auf einem eigenen Rechner vorhält, die abgebildeten Werke öffentlich zugänglich (Gey, Das Recht der öffentlichen Zugänglichmachung i.S. des § 19a UrhG, 2009,

S. 169; Nolte, Informationsmehrwertdienste und Urheberrecht, 2009, S. 246; Dreier in Dreier/Schulze aaO § 19a Rdn. 6; ders., Festschrift für Krämer, 2009, S. 225, 227; Dustmann in Fromm/Nordemann, Urheberrecht, 10. Aufl., § 19a UrhG Rdn. 22; Schricke/v. Ungern-Sternberg aaO § 19a UrhG Rdn. 46; v. Ungern-Sternberg, GRUR 2009, 369, 372; Leistner/Stang, CR 2008, 499, 502; Ott, ZUM 2009, 345; Roggenkamp, K&R 2007, 328; Schack, MMR 2008, 414 f.). Da die Beklagte die Vorschaubilder auf ihrem Rechner - und damit unabhängig von der ursprünglichen Quelle - vorhält, erfüllt sie den Tatbestand des § 19a UrhG durch eine eigene Nutzungshandlung. Sie stellt nicht lediglich die technischen Mittel zur Verfügung, sondern übt, indem sie die Vorschaubilder durch ihre "crawler" aufsucht und auf ihren Rechnern vorhält, die Kontrolle über die Bereithaltung der Werke aus. Der Umstand, dass erst der einzelne Internetnutzer durch Eingabe eines entsprechenden Suchworts bewirkt, dass die von der Beklagten vorgehaltenen Vorschaubilder abgerufen werden, berührt die Eigenschaft der Beklagten als Werknutzer i.S. von § 19a UrhG nicht. Die Nutzungshandlung des § 19a UrhG liegt in dem Zugänglichmachen, das die Beklagte kontrolliert.

21 **b)** Das Berufungsgericht hat rechtsfehlerfrei angenommen, dass sich die Beklagte nicht darauf berufen kann, das Recht der Klägerin auf Zugänglichmachung ihrer Werke (§ 19a UrhG) sei im Streitfall durch das Eingreifen einer Schrankenbestimmung des Urheberrechtsgesetzes begrenzt.

22 **aa)** Die Beklagte ist nicht schon deshalb zur Nutzung der Werke der Klägerin als Vorschaubilder ihrer Bildersuchmaschine berechtigt, weil es sich dabei um das - auch ohne Einwilligung des Urhebers zulässige - Herstellen von Bearbeitungen oder anderen Umgestaltungen der betreffenden Werke der Klägerin i.S. von § 23 Satz 1 UrhG handelt. Auf ein solches (gesetzliches) Nutzungsrecht kann sich die Beklagte schon deshalb nicht berufen, weil sie die Werke der Klägerin i.S. von § 19a UrhG zugänglich gemacht hat und ihr Eingriff in deren Urheberrecht damit über das (nach § 23 Satz 1 UrhG allenfalls zustimmungsfreie) bloße Herstellen hinausgeht. Bei den Vorschaubildern handelt es sich im Übrigen entgegen der Auffassung des Berufungsgerichts auch nicht um Bearbeitungen oder sonstige Umgestaltungen der Werke der Klägerin i.S. von § 23 UrhG. Nach den Feststellungen des Berufungsgerichts geben die Vorschaubilder die Werke der Klägerin lediglich verkleinert, ansonsten aber identisch wieder. Eine Abbildung, die ein Werk zwar verkleinert darstellt, aber in seinen wesentlichen schöpferischen Zügen genauso gut erkennen lässt wie das Original, ist keine Umgestaltung i.S. von § 23 UrhG (vgl. Dreier, Festschrift für Krämer, S. 225, 227; Schack, MMR 2008, 415; a.A. Roggenkamp, jurisPR-ITR 14/2008 Anm. 2; Schrader/Rautenstrauch, UFITA 2007, 761, 763). Erst recht scheidet die Annahme einer freien Benutzung

i.S. von § 24 Abs. 1 UrhG aus, weil durch die verkleinerte Darstellung in Form eines Vorschaubildes kein von dem Originalwerk unabhängiges selbstständiges Werk entsteht.

23 **bb)** Es kann dahingestellt bleiben, ob der Vorschrift des § 12 Abs. 2 UrhG im Wege des Umkehrschlusses eine Schrankenregelung des Inhalts entnommen werden kann, dass nach der Veröffentlichung eines Werks eine Inhaltsbeschreibung zulässig ist. Da die Vorschaubilder die betreffenden Werke der Klägerin vollständig wiedergeben, stellen sie nicht lediglich eine öffentliche Mitteilung oder Beschreibung ihres Inhalts i.S. von § 12 Abs. 2 UrhG dar. Vielmehr ermöglichen sie bereits den Werkgenuss. Auch wenn die Werke der Klägerin bereits mit ihrer Zustimmung veröffentlicht worden sind, können daher Abbildungen dieser Werke schon aus diesem Grund nicht im Wege eines Umkehrschlusses aus § 12 Abs. 2 UrhG als zulässig beurteilt werden (vgl. Nolte aaO S. 252 f.; ferner Leistner/Stang, CR 2008, 499, 503 f.).

24 **cc)** Die Schrankenregelung des § 44a UrhG, nach der bestimmte vorübergehende Vervielfältigungshandlungen zulässig sind, greift schon deshalb nicht ein, weil sie lediglich die Verwertung des Werks in körperlicher Form betrifft (§ 15 Abs. 1, § 16 Abs. 1 und 2 UrhG); hier geht es dagegen um einen Eingriff in das Recht der Klägerin auf Zugänglichmachung (§ 19a UrhG). Eine entsprechende Anwendung der Schrankenbestimmung des § 44a UrhG auf das Recht der Zugänglichmachung nach § 19a UrhG kommt nicht in Betracht, weil die gesetzlichen Schrankenbestimmungen das Ergebnis einer vom Gesetzgeber vorgenommenen, grundsätzlich abschließenden Güterabwägung darstellen (BGHZ 150, 6, 8 - Verhüllter Reichstag, m.w.N.). Im Übrigen fehlt es für das Eingreifen der Schrankenbestimmung des § 44a UrhG auch an der Voraussetzung, dass die Verwertungshandlung keine eigenständige wirtschaftliche Bedeutung haben darf. Die Anzeige der Werke der Klägerin als Vorschaubilder in der Bildersuchmaschine der Beklagten stellt, wie das Berufungsgericht zu Recht angenommen hat, eine eigenständige Nutzungsmöglichkeit mit wirtschaftlicher Bedeutung dar.

25 **dd)** Das Berufungsgericht hat zutreffend angenommen, dass die Nutzungshandlung der Beklagten nicht als zulässiges Zitat nach § 51 UrhG anzusehen ist, und zwar weder nach der Fassung, in der diese Bestimmung nach dem Zweiten Gesetz zur Regelung des Urheberrechts in der Informationsgesellschaft (Gesetz v. 26.10.2007, BGBl. I S. 2513; im Folgenden: neue Fassung) gilt, noch nach der im Zeitpunkt der Vornahme der Verletzungshandlung Anfang 2005 geltenden Fassung (im Folgenden: alte Fassung). Nach dieser Schrankenbestimmung sind Vervielfältigung, Verbreitung und öffentliche Wiedergabe eines veröffentlichten Werkes zum Zwecke des Zitats in dem durch diesen Zweck gebotenen

Umfang zulässig. Unabhängig davon, ob die Zulässigkeit des Zitats nach § 51 Satz 1 UrhG n.F. keine Übernahme in ein als solches geschütztes Werk mehr erfordert (so Dreier in Dreier/Schulze aaO § 51 Rdn. 24; ders., Festschrift für Krämer, 2009, S. 225, 232 f.; a.A. Dreyer in HK-UrhR, 2. Aufl., § 51 UrhG Rdn. 9; Lüft in Wandtke/Bullinger, Urheberrecht, 3. Aufl., § 51 UrhG Rdn. 8; Schack, MMR 2008, 414, 415; Schmid/Wirth in Schmid/Wirth/Seifert, Urheberrechtsgesetz, 2. Aufl., § 51 Rdn. 3), hat die Neufassung dieser Schrankenbestimmung nichts daran geändert, dass die nunmehr in § 51 Abs. 1 Satz 1 UrhG n.F. genannten Verwertungshandlungen nur insoweit zulässig sind, als sie zum Zweck des Zitats vorgenommen werden.

- 26 Für den Zitatzzweck ist es erforderlich, dass eine innere Verbindung zwischen den verwendeten fremden Werken oder Werkteilen und den eigenen Gedanken des Zitierenden hergestellt wird (BGHZ 175, 135 Tz. 42 - TV Total, m.w.N.). Zitate sollen als Belegstelle oder Erörterungsgrundlage für selbstständige Ausführungen des Zitierenden der Erleichterung der geistigen Auseinandersetzung dienen (BGH, Urt. v. 23.5.1985 - I ZR 28/83, GRUR 1986, 59, 60 - Geistchristentum). Es genügt daher nicht, wenn die Verwendung des fremden Werks nur zum Ziel hat, dieses dem Endnutzer leichter zugänglich zu machen oder sich selbst eigene Ausführungen zu ersparen (vgl. Dreier in Dreier/Schulze aaO § 51 Rdn. 3 a.E.).
- 27 Das Berufungsgericht hat zu Recht angenommen, dass diese Voraussetzungen der Schrankenbestimmung des § 51 UrhG im Streitfall nicht vorliegen. Die Darstellung der Vorschaubilder in der Trefferliste der Bildersuchmaschine der Beklagten dient dazu, das Werk um seiner selbst willen als Vorschaubild der Allgemeinheit zur Kenntnis zu bringen. Vorschaubilder werden in einem automatisierten Verfahren in die Trefferliste eingefügt, ohne dass dieser Vorgang als solcher der geistigen Auseinandersetzung mit dem übernommenen Werk dienen soll. Die von der Suchmaschine generierte Trefferliste ist lediglich Hilfsmittel zum möglichen Auffinden von Inhalten im Internet. Die Anzeige der Vorschaubilder erschöpft sich demnach in dem bloßen Nachweis der von der Suchmaschine aufgefundenen Abbildungen. Auch nach der Neufassung der Schrankenbestimmung des § 51 UrhG genügt dies für die Annahme eines Zitat zwecks nicht (vgl. Leistner/Stang, CR 2008, 499, 502; Schack, MMR 2008, 414, 415; a.A. Dreier in Dreier/Schulze aaO § 51 Rdn. 24; ders., Festschrift für Krämer, S. 225, 234 ff.). Dies gilt umso mehr, als die auf der Sozialbindung des geistigen Eigentums beruhenden Schrankenbestimmungen der §§ 45 ff. UrhG generell eng auszulegen sind, um den Urheber an der wirtschaftlichen Nutzung seiner Werke tunlichst angemessen zu beteiligen und daher die ihm hinsichtlich der Werkverwertung zustehenden Ausschließlichkeitsrechte nicht übermäßig zu beschränken (BGHZ 150, 6, 8 - Verhüllter Reichstag; 151, 300, 310 - Elektronischer Pressespiegel). Eine über den Zitatzzweck hinausgehende erweiternde Auslegung des § 51 UrhG ist weder aufgrund der technischen Fortentwicklung im Zusammenhang mit der Informationsvermittlung im Internet noch mit Blick auf die durch diese Schrankenbestimmung grundsätzlich geschützten Interessen der daran Beteiligten geboten. Weder die Informationsfreiheit anderer Internetnutzer noch die Kommunikationsfreiheit oder die Gewerbefreiheit der Suchmaschinenbetreiber erfordern eine solche erweiternde Auslegung. Für eine allgemeine Güter- und Interessenabwägung außerhalb der urheberrechtlichen Verwertungsbe fugnisse sowie der Schrankenbestimmungen der §§ 45 ff. UrhG ist grundsätzlich kein Raum (BGHZ 154, 260, 266 - Gies-Adler).
- 28 c) Ein Eingriff in ein urheberrechtliches Verwertungsrecht scheidet ferner aus, wenn der Urheber oder der Berechtigte dem Handelnden durch ein urheberrechtliches Verfügungsgeschäft das Recht eingeräumt hat, das Werk auf die betreffende Art und Weise zu nutzen (§ 31 Abs. 1 bis 3 UrhG). Das Berufungsgericht hat rechtsfehlerfrei angenommen, dass die Klägerin der Beklagten weder ausdrücklich noch konkludent ein entsprechendes Nutzungsrecht i.S. von § 31 UrhG eingeräumt hat und ein Eingriff der Beklagten in das der Klägerin zustehende Recht, ihre Werke öffentlich zugänglich zu machen, daher nicht schon aus diesem Grund zu verneinen ist.
- 29 aa) Ein entsprechendes Nutzungsrecht hat die Klägerin der Beklagten nicht ausdrücklich eingeräumt. Das Recht, ein Werk auf eine bestimmte Art und Weise zu nutzen (§ 31 Abs. 1 Satz 1 und 2 UrhG), kann einem Dritten allerdings auch durch eine konkludente Erklärung des Urhebers eingeräumt werden (vgl. BGH, Urt. v. 20.11.1970 - I ZR 50/69, GRUR 1971, 362, 363 - Kandinsky II, m.w.N.). Da die (ausdrückliche oder konkludente) Überlassung eines urheberrechtlichen (einfachen oder ausschließlichen) Nutzungsrechts dinglichen Charakter hat (vgl. BGHZ 180, 344 Tz. 20 - Reifen Progressiv, m.w.N.), muss die (konkludente) Willenserklärung, mit der der Urheber einem Dritten ein Nutzungsrecht einräumt, den Anforderungen an (dingliche) Verfügungen über Rechte genügen. Die betreffende Willenserklärung setzt demnach insbesondere voraus, dass unter Berücksichtigung der gesamten Begleitumstände nach dem objektiven Inhalt der Erklärung unzweideutig zum Ausdruck gekommen ist, der Erklärende wolle über sein Urheberrecht in der Weise verfügen, dass er einem Dritten daran ein bestimmtes Nutzungsrecht einräume (vgl. BGH GRUR 1971, 362, 363 - Kandinsky II, m.w.N.).
- 30 bb) Die Auffassung des Berufungsgerichts, die Klägerin habe der Beklagten nicht durch konkludente Erklärung ein Recht zur Nutzung ihrer Werke als Vorschaubilder im Rahmen der Bildersuchmaschine der Beklagten eingeräumt, lässt keinen Rechtsfehler er-

kennen. Das Berufungsgericht hat den Umstand dass die Klägerin im Zusammenhang mit dem Einstellen von Abbildungen ihrer Werke ins Internet einen Urhebervermerk angebracht hat, rechtsfehlerfrei dahin gewürdigt, dem lasse sich keine Erklärung der Klägerin entnehmen, sie wolle damit Nutzungshandlungen in Bezug auf diese Abbildungen gestatten. Vielmehr kommt in dem Anbringen des Urhebervermerks gerade der Wille der Klägerin zum Ausdruck, im Hinblick auf ihre ins Internet gestellten Werke ihre urheberrechtlichen Befugnisse für sich behalten und grundsätzlich gegenüber Dritten geltend machen zu wollen. Diese Würdigung steht ferner in Übereinstimmung mit der allgemeinen Auslegungsregel, dass die urheberrechtlichen Befugnisse die Tendenz haben, soweit wie möglich beim Urheber zu verbleiben, damit dieser an den Erträgen seines Werks in angemessener Weise beteiligt wird (vgl. BGH, Urt. v. 22.4.2004 - I ZR 174/01, GRUR 2004, 939 f. = WRP 2004, 1497 - Comic-Übersetzungen III).

- 31 Nach den rechtlich einwandfreien Feststellungen des Berufungsgerichts kann auch den sonstigen Begleitumständen der für die konkludente Einräumung eines Nutzungsrechts erforderliche Übertragungswille der Klägerin nichtunzweideutig entnommen werden. Im bloßen Einstellen von Abbildungen urheberrechtlich geschützter Werke ins Internet kommt, wie das Berufungsgericht rechtsfehlerfrei angenommen hat, lediglich der Wille zum Ausdruck, dass diese Abbildungen von anderen Internetnutzern angesehen werden können. Der Umstand, dass Internetnutzern allgemein der Einsatz von Suchmaschinen bekannt ist und die Klägerin im vorliegenden Fall nach den Feststellungen des Berufungsgerichts sogar durch Aufnahme bestimmter Wortlisten in den Quellcode ihrer Internetseite Suchmaschinen den Zugriff auf ihre Seite erleichtert hat, genügt, wie das Berufungsgericht weiter rechtlich unbedenklich angenommen hat, gleichfalls nicht für die Annahme, darin liege notwendig der objektiv erkennbare Erklärungswille der Klägerin, der Beklagten gerade auch ein Recht zur Nutzung der Werke der Klägerin im Wege von Vorschaubildern der Suchmaschine der Beklagten (unentgeltlich) einzuräumen. Dass bestimmte Texte oder Wörter von der Suchmaschine gefunden werden sollen, bringt nicht unzweideutig den Willen zum Ausdruck, dass dem Suchmaschinenbetreiber das Recht übertragen werden soll, auch Abbildungen, die im Zusammenhang mit diesen Wörtern von der Suchmaschine auf der Internetseite aufgefunden werden, im Wege von Vorschaubildern verkleinert anzuzeigen. Es lässt daher keinen Rechtsverstöß erkennen, wenn das Berufungsgericht zu dem Schluss gelangt ist, dass sich eine Übertragung von Nutzungsrechten auf die Beklagte nicht mit der erforderlichen Klarheit feststellen lasse.
- 32 d) Eine (bloß) schuldrechtliche Gestattung der Werknutzung setzt gleichfalls den Abschluss eines Rechtsgeschäfts und damit die Abgabe einer rechts-

geschäftlichen Willenserklärung der Klägerin des Inhalts voraus, dass der Beklagten ein entsprechender (schuldrechtlicher) Anspruch auf Vornahme der betreffenden Nutzungshandlung eingeräumt werden soll. Von einem solchen (schuldrechtlichen) Rechtsbindungswillen der Klägerin kann aus den soeben dargelegten Gründen ebenfalls nicht ausgegangen werden.

- 33 e) Der Eingriff der Beklagten in das Recht der Klägerin auf Zugänglichmachung ihre Werke (§ 19a UrhG) ist jedoch nicht rechtswidrig, weil nach den Feststellungen des Berufungsgerichts von einer die Rechtswidrigkeit ausschließenden (schlichten) Einwilligung der Klägerin in die Nutzungshandlung der Beklagten auszugehen ist. Die gegenteilige Beurteilung des Berufungsgerichts beruht auf seiner unzutreffenden Ansicht, eine die Rechtswidrigkeit der Verletzungshandlung ausschließende Einwilligung des Urhebers könne nur angenommen werden, wenn die Einwilligung den Erfordernissen genüge, die nach den allgemeinen Grundsätzen der Rechtsgeschäftslehre unter Berücksichtigung der Besonderheiten des urheberrechtlichen Übertragungszweckgedankens an die Einräumung eines entsprechenden Nutzungsrechts zu stellen seien. Der Klägerin steht der geltend gemachte Unterlassungsanspruch vielmehr auch dann nicht zu, wenn sie zwar, wie oben ausgeführt, der Beklagten kein entsprechendes Nutzungsrecht eingeräumt und ihr die Werknutzung auch nicht schuldrechtlich gestattet hat, ihrem (schlüssigen) Verhalten aber die objektive Erklärung entnommen werden kann, sie sei mit der Nutzung ihrer Werke durch die Bildersuchmaschine der Beklagten einverstanden. Auf der Grundlage der vom Berufungsgericht getroffenen Feststellungen sind die Voraussetzungen einer solchen (schlichten) Einwilligung der Klägerin in die beanstandete Rechtsverletzung gegeben.
- 34 aa) Das Berufungsgericht hat nicht hinreichend berücksichtigt, dass ein rechtswidriger Eingriff in die urheberrechtlichen Befugnisse nicht nur dann zu verneinen ist, wenn der Berechtigte durch Abgabe von rechtsgeschäftlichen Erklärungen durch Einräumung entsprechender Nutzungsrechte über sein Recht verfügt oder dem Nutzer die entsprechende Werknutzung schuldrechtlich gestattet hat. Daneben besteht vielmehr auch die Möglichkeit, dass die Rechtswidrigkeit eines Eingriffs in ein ausschließliches Verwertungsrecht wegen Vorliegens einer schlichten Einwilligung des Berechtigten ausgeschlossen ist (vgl. Haberstumpf in Büscher/Dittmer/Schiwy, Gewerblicher Rechtsschutz Urheberrecht Medienrecht, § 31 UrhG Rdn. 1; J. B. Nordemann in Fromm/Nordemann aaO § 97 UrhG Rdn. 24 f.; Schricker/Schricker aaO Vor §§ 28 ff. UrhG Rdn. 27, § 31 UrhG Rdn. 1a; v. Ungern-Sternberg, GRUR 2009, 369, 371; vgl. ferner Ohly, "Volenti non fit iniuria" - Die Einwilligung im Privatrecht, 2002, S. 276 f.). Die schlichte Einwilligung in die Urheberrechts-

verletzung unterscheidet sich von der (dinglichen) Übertragung von Nutzungsrechten und der schuldrechtlichen Gestattung dadurch, dass sie zwar als Erlaubnis zur Rechtmäßigkeit der Handlung führt, der Einwilligungsempfänger aber weder ein dingliches Recht noch einen schuldrechtlichen Anspruch oder ein sonstiges gegen den Willen des Rechtsinhabers durchsetzbares Recht erwirbt (vgl. Ohly aaO S. 144). Sie erfordert daher auch keine auf den Eintritt einer solchen Rechtsfolge gerichtete rechtsgeschäftliche Willenserklärung.

- 35 Dabei kommt es nicht darauf an, ob die Einwilligung als eine (bloß) rechtsgeschäftsähnliche Handlung anzusehen ist, die allerdings im Wesentlichen den für Willenserklärungen geltenden Regeln unterliegt (vgl. Wandtke/Grunert in Wandtke/Bullinger aaO § 31 UrhG Rdn. 37; v. Ungern-Sternberg, GRUR 2009, 369, 370; Schricker/Schricker aaO Vor §§ 28 ff. UrhG Rdn. 27 m.w.N.; allgemein zur Einwilligung in die Verletzung eines absolut geschützten Rechts oder Rechtsguts vgl. BGHZ 29, 33, 36; 105, 45, 47 f.; Ahrens in Prütting/Wegen/Weinreich, BGB, 3. Aufl., Vor §§ 116 ff. Rdn. 8; Schaub in Prütting/Wegen/Weinreich aaO § 823 Rdn. 16; Erman/Schiemann, BGB, 12. Aufl., § 823 Rdn. 147), oder ob man sie als eine Willenserklärung mit Besonderheiten einordnen will (vgl. etwa Ohly aaO S. 201 ff. m.w.N.). Unabhängig von dieser rechtlichen Einordnung bleibt bei der Auslegung zu beachten, dass die (schlichte) Einwilligung keinen Rechtsfolgewillen dahingehend zum Ausdruck bringen muss, der Erklärende ziele auf die Begründung, inhaltliche Änderung oder Beendigung eines privaten Rechtsverhältnisses in dem Sinne ab, dass er dem Erklärungsempfänger ein dingliches Recht oder zumindest einen schuldrechtlichen Anspruch auf Vornahme der (erlaubten) Handlung einräume (vgl. auch v. Ungern-Sternberg, GRUR 2009, 369, 372). Die Erklärung muss also im Streitfall entgegen der Auffassung des Berufungsgerichts nicht darauf gerichtet sein, dass die Klägerin der Beklagten ein entsprechendes Nutzungsrecht einräumen oder ihr die Nutzung (schuldrechtlich) gestatten wollte.
- 36 **bb)** Das Berufungsgericht ist in anderem Zusammenhang - bei der Prüfung, ob sich die Klägerin rechtsmissbräuchlich verhält - rechtsfehlerfrei davon ausgegangen, dass die textgestützte Bildersuche mit der Anzeige der gefundenen Abbildungen in Vorschaubildern ein übliches Verfahren von Bildersuchmaschinen ist. Es hat ferner angenommen, dass die Klägerin sich entweder mit ihrem Unterlassungsbegehren zu ihrem früheren Verhalten, durch Gestaltung ihrer Internetseite den Einsatz von Suchmaschinen zu erleichtern, in einen unlösbaren Widerspruch setzt oder durch die "Suchmaschinenoptimierung" bei der Beklagten ein schutzwürdiges Vertrauen dahingehend geweckt hat, es könne erwartet werden, dass die Klägerin, wenn sie eine Bildersuche nicht wolle, eine mögliche Blockierung der Suchmaschinenindexierungen von Bil-

dern auch vornehme. Daraus ergibt sich ohne weiteres, dass das Verhalten der Klägerin, den Inhalt ihrer Internetseite für den Zugriff durch Suchmaschinen zugänglich zu machen, ohne von technischen Möglichkeiten Gebrauch zu machen, um die Abbildungen ihrer Werke von der Suche und der Anzeige durch Bildersuchmaschinen in Form von Vorschaubildern auszunehmen, aus der Sicht der Beklagten als Betreiberin einer Suchmaschine objektiv als Einverständnis damit verstanden werden konnte, dass Abbildungen der Werke der Klägerin in dem bei der Bildersuche üblichen Umfang genutzt werden dürfen. Ein Berechtigter, der Texte oder Bilder im Internet ohne Einschränkungen frei zugänglich macht, muss mit den nach den Umständen üblichen Nutzungshandlungen rechnen (vgl. BGH, Urt. v. 6.12.2007 - I ZR 94/05, GRUR 2008, 245 Tz. 27 = WRP 2008, 367 - Drucker und Plotter). Da es auf den objektiven Erklärungsinhalt aus der Sicht des Erklärungsempfängers ankommt, ist es ohne Bedeutung, ob die Klägerin gewusst hat, welche Nutzungshandlungen im Einzelnen mit der üblichen Bildersuche durch eine Bildersuchmaschine verbunden sind (im Ergebnis wie hier Gey aaO S. 172; Nolte aaO S. 250; Berberich, MMR 2005, 145, 147 f.; Leistner/Stang, CR 2008, 499, 504 f.; Meyer, K&R 2007, 177, 182 f.; ders., K&R 2008, 201, 207; Ott, ZUM 2007, 119, 126 f.; ders., ZUM 2009, 345, 346 f.; v. Ungern-Sternberg, GRUR 2009, 369, 372; a.A. Roggenkamp, K&R 2007, 325, 329; Schack, MMR 2008, 414, 415 f.; Schrader/Rautenstrauch, UFITA 2007, 761, 776 ff.). Danach hat sich die Klägerin mit dem Einstellen der Abbildungen ihrer Werke in das Internet, ohne diese gegen das Auffinden durch Suchmaschinen zu sichern, mit der Wiedergabe ihrer Werke in Vorschaubildern der Suchmaschine der Beklagten einverstanden erklärt.

- 37 **cc)** Der Klägerin steht der geltend gemachte Unterlassungsanspruch auch nicht deshalb zu, weil sie der beanstandeten Nutzung ihrer Werke in Vorschaubildern der Suchmaschine der Beklagten jedenfalls für die Zukunft widersprochen hat, nachdem sie Anfang Februar 2005 davon erfahren hatte. Eine Einwilligung kann zwar mit Wirkung für die Zukunft widerrufen werden (vgl. § 183 Satz 1 BGB). Da die Einwilligung mit dem Einstellen der Abbildungen der entsprechenden Werke in das Internet ohne hinreichende Sicherungen gegen das Auffinden durch Bildersuchmaschinen erklärt wird, bedarf es für einen rechtlich beachtlichen Widerruf jedoch grundsätzlich eines gegenläufigen Verhaltens, also der Vornahme der entsprechenden Sicherungen gegen das Auffinden der eingestellten Bilder durch Bildersuchmaschinen. Setzt der Berechtigte dagegen seine Werke weiterhin ungesichert dem Zugriff durch Bildersuchmaschinen aus, obwohl er von deren Anzeige in Vorschaubildern Kenntnis erlangt hat, bleibt der Erklärungsgehalt seines Verhaltens unverändert. Der lediglich gegenüber dem Betreiber einer einzelnen Bildersuchmaschine (hier: der Beklagten) geäußerte Widerspruch, mit dem Auf-

finden der Bilder durch dessen Bildersuchmaschine nicht einverstanden zu sein, ist für die Auslegung der Einwilligungserklärung, die durch Einstellen der Bilder ins Internet ohne hinreichende Sicherungen gegen das Auffinden durch Bildersuchmaschinen abgegeben wird, schon deshalb ohne Bedeutung, weil diese Einwilligungserklärung als solche an einen unbestimmten Personenkreis gerichtet ist. Bei ihrer Auslegung können daher nur allgemein erkennbare Umstände berücksichtigt werden; bloß einzelnen Beteiligten bekannte oder erkennbare Umstände haben dagegen außer Betracht zu bleiben (vgl. BGHZ 28, 259, 264 f.; 53, 304, 307; Palandt/Ellenberger, BGB, 69. Aufl., § 133 Rdn. 12). Ist der an die Allgemeinheit gerichteten Erklärung demnach weiterhin eine Einwilligung in die Vornahme der mit dem Betrieb von Bildersuchmaschinen üblicherweise verbundenen Nutzungs- handlungen zu entnehmen, ist die gegen- teilige Verwahrung gegenüber der Beklagten dem- zufolge auch unter dem Gesichtspunkt einer pro- testatio facto contraria unbeachtlich (vgl. BGHZ 21, 319, 334 f.; 23, 175, 177 f.; 95, 393, 399). Der Klägerin ist es ohne weiteres zuzumuten, hinreichende Siche- rungsmaßnahmen gegen das Auffinden ihrer Werke durch Bildersuchmaschinen allgemein oder gerade durch die Bildersuchmaschine der Beklagten vorzu- nehmen wenn sie derartige Nutzungshandlungen verhindern will. Dagegen müsste die Beklagte für jede Abbildung, die ihre Suchmaschine technisch in Vorschaubildern erfassen kann, jeweils gesondert prüfen, ob unabhängig von der Vornahme techni- scher Sicherungen ein Berechtigter gegebenenfalls auf andere Art und Weise einen beachtlichen Wider- spruch gegen die betreffende Nutzungshandlung er- hoben hat. Eine solche Überprüfung im Einzelfall ist für den Betreiber einer auf die Vorhaltung einer un- übersehbaren Menge von Bildern ausgerichteten Bil- dersuchmaschine nicht zumutbar.

- 38 **dd)** Die die Rechtswidrigkeit ausschließende Wir- kung der schlichten Einwilligung der Klägerin ist auch nicht insoweit entfallen, als sie geltend ge- macht hat, dass in der Trefferliste der Bildersuch- maschine der Beklagten auch Vorschaubilder ihrer Werke gezeigt worden seien, die sie von ihrer Inter- netseite bereits entfernt gehabt habe. Die Einwilli- gung bezieht sich darauf, dass der Betreiber der Bil- dersuchmaschine die bei der Bildersuche üblichen Nutzungshandlungen vornehmen darf. Die Beklagte hat dem Vorbringen der Klägerin, sie habe Abbildun- gen ihrer Werke von ihrer Website genommen, also den Link zwi- schen dem Speicherplatz des betreffen- den Bildes und der Website gelöscht, entgegenge- halten, daraus ergebe sich nicht ohne weiteres, dass das Bild nicht noch am ursprünglichen Speicherort oder an anderen technisch bedingten Zwischenspei- cherorten vorhanden sei und dort von der Suchma- schine aufgefunden werden könne. Außerdem führ- ten die eingesetzte Technik ihrer "crawler" und das intervallmäßige Durchsuchen dazu, dass vollständig entfernte Bilder schnellstmöglich nicht mehr aufge-

funden und dann auch nicht mehr in Trefferlisten angezeigt würden. Das Berufungsgericht hat rechts- fehlerfrei angenommen, dass die Beklagte nach die- sem Vortrag, dem die Klägerin nicht substantiiert entgegengetreten ist, das zur Zeit technisch Mögli- che zur Aktualisierung ihrer Suchergebnisse unter- nimmt und die Einwilligung daher auch nicht insow- weit wirkungslos geworden ist, als nach dem Vortrag der Klägerin einzelne, von den Vorschaubildern bei der Bildersuche noch angezeigte Abbildungen be- reits von ihrer Internetseite entfernt worden waren.

- 39 **4.** Soweit Vorschaubilder von Bildersuchmaschi- nen Abbildungen von Werken erfassen, die - wie im Streitfall - von dem betreffenden Urheber oder mit seiner Zustimmung in das Internet eingestellt wor- den sind, wird damit dem allgemeinen Interesse an der Tätigkeit von Bildersuchmaschinen in dem ge- botenen Maße bei der Auslegung der Erklärungen Rechnung getragen, die im Zusammenhang mit dem Einstellen solcher Abbildungen auf den jeweiligen Internetseiten der Allgemeinheit gegenüber abge- geben werden. In dem - hier nicht zu entscheiden - Fall, dass Bilder von dazu nicht berechtigten Personen eingestellt werden, kann der Betreiber der Bildersuchmaschine zwar aus deren Verhalten keine Berechtigung für einen Eingriff in Urheberrechte Dritter herleiten. In einem solchen Fall kommt je- doch in Betracht, dass die Haftung des Betreibers der Suchmaschine auf solche Verstöße beschränkt ist, die begangen werden, nachdem er auf eine klare Rechtsverletzung hingewiesen worden ist (vgl. BGHZ 158, 236, 252 - Internet-Versteigerung I; 173, 188 Tz. 42 - Jugendgefährdende Medien bei eBay; BGH, Urt. v. 19.4.2007 - I ZR 35/04, GRUR 2007, 708 Tz. 45 = WRP 2007, 964 - Internet-Versteigerung II; Urt. v. 30.4.2008 - I ZR 73/05, GRUR 2008, 702 Tz. 51 = WRP 2008, 1104 - Internet-Versteigerung III). Die Mög- lichkeit einer solchen Haftungsbeschränkung bei der Bereitstellung von Informationen in Suchma- schinen für den Zugriff durch Dritte folgt aus Art. 14 Abs. 1 der Richtlinie 2000/31/EG über den elekt- ronischen Rechtsverkehr. Art. 14 Abs. 1 der Richtli- nie 2000/31/EG ist auf die Bereitstellung der Dienst- leistungen von Suchmaschinen anwendbar, wenn die betreffende Tätigkeit des Suchmaschinenbetrei- bers rein technischer, automatischer und passiver Art ist und er weder Kenntnis noch Kontrolle über die von ihm gespeicherte oder weitergeleitete Infor- mation besitzt (EuGH, Urt. v. 23.3.2010 - C-236/08 bis C-238/08 Tz. 114 - Google France/Louis Vuitton). Lie- gen diese Voraussetzungen vor, deren - dem nation- alen Gericht obliegender (EuGH aaO Tz. 119 Google France/Louis Vuitton) - Feststellung es im Streit- fall für die Bildersuche der Beklagten mangels Ent- scheidungserheblichkeit nicht bedarf, kommt eine Haftung des Suchmaschinenbetreibers erst in Be- tracht, nachdem er von der Rechtswidrigkeit der gespeicherten Information Kenntnis erlangt hat (EuGH aaO Tz. 109 - Google France/Louis Vuitton). Ein solcher die Haftung auslösen der Hinweis auf

eine Urheberrechtsverletzung muss ihm auch über die urheberrechtliche Berechtigung der Beteiligten hinreichende Klarheit verschaffen.

- 40 **III.** Die Revision der Klägerin ist danach mit der Kostenfolge aus § 97 Abs. 1 ZPO zurückzuweisen.



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