# Copyright for the Digital Era:
# Are We Aiming at Individuals?

Chongnang Wiputhanupong

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**ABSTRACT**

Individual persons are the most influential players in the online digital environment. Regarding their internet activities, these individual players could perform their role as either the original creator, the user, or the subsequent creator of the online digital works. When they are performing different roles, they are protected under different fundamental rights. For example, when online user borrows an online original works of the original creator to create online derivative works, two fundamental rights which are relevant are 'copyright' and 'the right to freedom of expression'.

The thesis focus on the rights of these online individual players in these two important aspects: copyright and the right to freedom of expression. Based on the inexplicable conflict between both rights, this thesis fundamentally argues that it is not as what was previously claimed that '*copyright is the engine of free expression*'. On the other hand, it is the other way around that '*free expression is an engine of copyright'*. This is following the logic of the deductive argument based on the evidence that '*free expression is an engine of creative expression*' and '*creative expression is an engine of copyright'*.

The argument above thus supports the importance of creativity in the copyright regime. It is thus certified that under the fundamental concept of copyright there lies a strong concept of system that protects and encourages the prosperity of human's creativity under the term of *authorship*. Therefore, the protection of copyright in the digital era should not be directed away from this very fundamental concept.

In terms of making online derivative works, this thesis therefore proposed that an exception of copyright infringement should be allowed for unauthorised user in so far as it encourages the prosperity of human's

creativity and does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author, as certified under Article 9 of the Berne Convention.

For this purpose, the thesis finally proposed that it is possible under the fundamental concept of copyright and the internet technology to create a distinction between the act of making adaptation and making publication of the online digital derivative works. This is, at least, to allow unauthorised making adaptation of the online digital works for prosperity of individual's creativity, without re-publishing of those derivative works online.

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# INTRODUCTION

## I. BACKGROUND

Regarding copyright protection in the online digital environment there are three main subjects to be considered: i) the persons who own and use the online copyrighted works, ii) the frequent online activities as the exclusive rights of the copyright owner, and iii) the exceptions to those unauthorised uses or activities.

As for the persons who own and use online copyrighted works, it is suggested that most of them are individual persons rather than the business entities. Regarding the frequent online activities which are the exclusive rights of the copyright owner, apart from the act of making reproduction of online digital work, the act of making adaptation is one of the online activities which are frequently performed.

For this purpose, it is therefore important to study the right of the individual persons in respect of the right of making derivative work online. This is to find whether the online individual persons, both the persons who own and use the online copyrighted works, are guaranteed a proper and balance protection under the copyright regime.

In addition, since the major player in the online digital environment, according to the thesis, is the individual person, it is important, therefore, to study the fundamental concept of human right protection in comparison with copyright protection. This is to find whether the current copyright regime has offered a protection that is compatible to the human right standard provided under the Universal Declaration of Human Rights. In this respect, it is primarily suggested in many studies[1] that copyright and human rights do conflict,

[1] M. D. Birnhack, `Acknowledging the Conflict between Copyright Law and Freedom of Expression under the Human Rights Act', [2003] Entertainment Law Review, Athina Fotini Loverdou,

particularly in terms of copyright protection and the right to freedom of expression.

The conflict between the protection of the online individual's right of making adaptation (exclusive right) under the copyright regime and the protection of their right to freedom of expression (human right) under the Universal Declaration of Human Rights thus creates a tension and difficulties on individual's using the original work in the online digital environment.

This thesis, therefore aims to clarify such conflict and identify how the right of making adaptation and the right to freedom of expression should be guaranteed in the online digital environment. It is expected that the solutions offered in this study would be beneficial mainly for the online individuals to use the online original work in order to create and stimulate the new online digital work of creation.

Fundamentally, the research conducted in study will answer five major questions:

1) What is derivative work and how the work itself is protected under the online digital environment and in the copyright regime?

2) What is the right of making derivative work of the copyright owner and how the right is protected under the online digital environment and the copyright regulations?

3) What are the rights of individual authors and users under the human right regime, how they are fundamentally protected and how do those rights conflict with copyright?

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'Copyright and Freedom of Expression: Revising the Berne Convention' (Queen Mary University of London 2006), Alexandra Couto, 'Copyright and Freedom of Expression: a Philosophical Map' in A. Gosseries, A. Marciano & A. Strowel (eds.), *Intellectual Property and Theories of Justice* (Palgrave Macmillan 2008), Christina J. Angelopoulos, 'Freedom of expression and copyright: the double balancing act', (2008) Intellectual Property Quarterly 328,

4) Whether the current exceptions and limitation under copyright mechanism sufficiently protect the benefit of both online individual authors and users?

5) In case that the current exceptions and limitation under copyright mechanism do not sufficiently protect the benefit of both online individual authors and users, what is the possible solution?

In order to answers the five questions above, this study will explore the relationship between the online individual persons and their exclusive rights and human rights protection:

- To emphasise the importance of the roles of *the individual parties* in the digital environment.
- To identify the significance of *the right of making derivative work* under the copyright regime, and particularly in the digital era.
- To clarify the *conflicts* between copyright and the right to freedom of expression under online activity context.
- To analyse the legal mechanisms of *different jurisdictions* on the protection of individuals' rights under the copyright regime.
- To criticise the *balancing of rights mechanisms* given under the international and national copyright legislations.
- To provide *alternative tools* for balancing of copyright and the right to freedom of expression for benefits of the individuals in the digital era.

For purpose of this study, some words will be used interchangeably. Those words are, for example, authors and creators, making adaptation and making derivative work, freedom of expression and free speech, and originality and creativity.

## II. OBJECTIVES AND SCOPE

The thesis will explore, first of all, the copyright protection and the exceptions to copyright infringement in both national and international levels. This is to identify how the current copyright mechanisms offer protection to the derivative work, how the right of making derivative work is guaranteed for the copyright owners, original creators, and users of the original work, and how the exceptions are applicable to the use of the users or future subsequent creators, particularly in the online digital environment.

In this aspect, the thesis will examine those protections, exclusive rights, and exceptions provided in the context of:

**1)International mechanisms** i.e. the Berne Convention, the TRIPs Agreement, The WIPO Performances and Phonograms Treaty (WPPT) and the WIPO Copyright Treaty (WCT)

**2)National and Regional mechanisms** i.e. the copyright law of the United States (the US Copyright Act of 1976 and the Digital Millennium Copyright Act (DMCA)) in comparison with the copyright law of the United Kingdom (the UK Copyright, Designs and Patents Act (CDPA) 1988) which has implemented the regional mechanism of the European Union Directives.

Since the thesis focuses mainly on the right of making derivative work as one of the exclusive rights of the copyright owner, therefore the study of moral rights and neighbouring rights (related rights) is out of the scope of this thesis.

Secondly, the thesis will profoundly analyse the relationship between copyright and the right to freedom of expression in human rights context. This is to clarify the conflict between both rights and examine the fundamental

concept of '*copyright as an engine of free expression*'[2], whether that concept is still applicable in the modern world.

In this aspect, the thesis will therefore examine the fundamental concept of copyright and freedom of expression as guaranteed in the Universal Declaration of Human Rights (UDHR), the International Covenant on Civil and Political Rights (ICCPR), and the International Covenant on Economic, Social and Cultural Rights (ICESCR).

In addition, the thesis will also explore the relevant judicial decisions and other legal and historical documents entirely in order to achieve the four main objectives of the thesis:

1) To stipulate that the copyright protection and exceptions given to the derivative works and the exclusive right of making derivative work of the copyright owner is important for the benefits of both creators and users as the online individual persons

2) To reaffirm that the individual persons (both creators and users) are the most influential player in the online environment and the rights of both parties are equally guaranteed at least under the human rights context

3) To emphasise that in the digital environment, the current copyright protection regime does not sufficiently provide a proper balance between the rights and benefits of the original creators and the users; particularly in the area of the right of making derivative work.

4) To propose a solution that is applicable in the online digital environment, which means that it might be universally applicable in international, regional and national level, and can also be efficiently performed in either developed or developing countries regardless of the political differences.

[2] *Harper & Row v. Nation Enterprises* 471 US 539 (1985)

## III. METHODOLOGY

The thesis is the qualitative research which will be conducted fundamentally on the basis or comparative methods.

First of all, the comparison will be conducted between the different national copyright laws of the US and the UK in order to identify the diversity of integral copyright protection and exception systems between jurisdictions. In fact, it would be very useful for this purpose to analyse and compare the national copyright law of the civil law systems such as France and Germany in order to emphasise such diversity, particularly in the digital environment. Nevertheless, due to the limitation of time, knowledge, and language proficiency, the author of this study could only investigate the national copyright laws of the two common law systems: the US and the UK.

In addition, the comparison will also be conducted between the different approaches of international copyright protection mechanisms (the Berne Convention and TRIPs Agreement) and the international human right protection mechanisms (the UDHR, ICESCR, and ICCPR). This is to clarify the conflicts between both concepts.

Furthermore, the comparison between the human rights and exclusive rights of the original creator, the institutional publisher, and the user or the future subsequent creator will also be administered as they are the major players in the online digital environment.

The thesis will also analyse the judicial decisions, other legal and historical documents and public resources such as websites as the tools for comparison in order to achieve its main objectives.

## IV. GENERAL OUTLINE

This thesis is divided into three parts with five chapters entirely:

***PART I: IN THEORY***

***THE TWO LAYERS OF POTENTIAL COPYRIGHT CONFLICTS***

In this part, the thesis will profoundly analyse the fundamental theory of the structures of copyright and human rights protections.

**CHAPTER I -** CONFLICT OF LAWS: US AND UK COPYRIGHT LAWS

A comparison between two common law systems: the US and the UK will be conducted in order to analyse the different legal concepts of copyright protection amongst different jurisdictions. This includes the areas of: Originality and Creativity, Fixation and Idea/Expression Dichotomy, and Limitations and Exceptions to Copyright Infringement. In this chapter, the conflict of the copyright regulations amongst different countries, particularly in the area of making derivative work in the digital environment will therefore be identified.

**CHAPTER II -** CONFLICT OF RIGHTS: COPYRIGHT AND HUMAN RIGHTS

A comparison between the fundamental theories of the two protection systems: copyright and human rights will be investigated in order to emphasise the importance of the individual parties in the digital environment and to clarify the conflicts between copyright and the right to freedom of expression under the online activity context. In this chapter, the author will mainly argue that 'copyright is *not* an engine of free expression'. On the contrary, '*free expression is an engine of copyright*'. This is due to the fact that '*free expression is an engine of creative expression*' and '*creative expression is an engine of copyright*'.

***PART II: IN PRACTICAL***

***THE INTERNET, THE INDIVIDUALS AND THE LAWS***

In the second part, the thesis will examine the exclusive rights of the individual parties as guaranteed in copyright in relation to the actual benefits those parties receive from the protection in the online digital environment.

**CHAPTER III -** COPYRIGHT AND THE RIGHTS OF THE THREE MAJOR PARTIES UNDER ONLINE ACTIVITY CONTEXT: CONFLICT OF INTERESTS

A comparison will be conducted between the exclusive rights of the individual parties as guaranteed in copyright and the actual benefits that each online party receive from the available technologies and the current copyright law in the online digital environment. In this chapter, the four types of protected digital works (literary works, musical works, audiovisual works, and images) and the conflict between the rights and benefits of each individual as guaranteed under the laws and in the online activity context will thus be identified.

**CHAPTER IV -** THE INTERNET, THE INDIVIDUALS, AND COPYRIGHT: EVERYTHING UNDER A UNIFIED CONCEPT OF 'PUBLICATION'

After all this chapter will explore the fundamental concept of the internet as a communication tool. It is argued in this chapter that, in practical, the main objective of having the internet is to publish the digital works (literary works, musical works, audiovisual works, and images) to the online users. Also, 'publication' is an important factor under copyright protection and exception mechanism. In this regards, 'publication' is the major condition of both copyright and the internet. Without 'publication' both internet and copyright protection will not function properly and will not reach their basic concept of technology and protection.

***PART III: CONCLUSION***

This is the final part of the thesis where all the conflicts as analysed in chapter I, II and III and IV will be concluded. Also the proposed solutions will be provided in order to offer a balance protection for the online individual user in the digital environment, particularly in the area of making derivative work.

**CONCLUSION AND PROPOSED SOLUTIONS**

According to the conflicts analysed in chapter I, II and III and the major argument regarding conflicts between copyright and human right as provided in chapter II that '*freedom expression (and creative expression) is an engine of copyright*', the author will then combine the ideas with the practical concept of internet and copyright as provided in chapter IV on the basis of 'publication'. It is proposed in this final chapter that in order to achieve those fundamental concepts, an exception for making derivative works online may needed to be created as an alternative tools for balancing of copyright and the right to freedom of expression for benefits of the individuals in the digital era.

# PART I

# IN THEORY: THE TWO LAYERS OF POTENTIAL COPYRIGHT CONFLICTS

# CHAPTER I

# CONFLICT OF LAWS: US AND UK COPYRIGHT LAWS

## I. INTRODUCTION: DIFFERENT APPROACHS IN US AND UK COPYRIGHT LAW

When exploring copyright conflicts it is important that the differences of copyright systems amongst countries ought to be analysed. These diversities include the areas of idea/expression dichotomy, the concept of originality, moral rights, economic right[3], limitations and exceptions and duration of protection.[4] However, for purpose of this thesis the dissimilarities analysed will be classified into four major aspects as follows;

**A. ORIGINALITY AND CREATIVITY**

**B. FIXATION AND IDEA/EXPRESSION DICHOTOMY**

**C. MORAL RIGHTS**

**D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING**

The four aspects play an important role in the area of copyright conflicts because they are the backbones of copyright protection scheme. The discussions will look at each topic based on the international and national regulations in accordance with the factual change and development occurred in the digital era.

The discussion in each topic will begin with 1) the international standard of regulations, following with 2) the differences of national regulations, mainly between the United States (the US) and the United Kingdom (the UK) jurisdictions, and briefly of some civil law countries, 3) the status of derivative

[3] Economic Rights will be discussed further in chapter III

[4] See, for example in Loverdou

work in relation to those regulations in the printing world, and 4) the shift and movement of that regulations in the digital era and how those affect copyright and derivative work.

Eventually, the discussions in each topic of this chapter are attempting to reaffirm the presumption regarding a strong relationship between these three following issues.

First of all, the existence of the international standard of protections represents an effort of establishing a uniform standard[5] amongst different countries. On the other hand, in the exploration of the context of national laws, there are some distinctive notions of copyright regulations embedded in the jurisprudence of each individual country. This inconsistency of copyright laws substantially remains amongst countries even though some achievements of harmonisation have concurrently been made.

Secondly, focusing on derivative works, those inconsistencies subsequently create a certain degree of disparity in the context derivative work in the offline world. It emphasises the difficulties and the unclear status of derivative works from its beginning in the printing technology, fundamentally, within the area of originality and creativity, fixation and idea/expression dichotomy, and limitations and exceptions of copyright infringement.

Then the third question is whether this situation is likely to change in the digital era. Generally, it is widely accepted that the copyright law was firstly come into effect after the invention of printing technology. However, after the twentieth century the world has shifted from printing to the internet age. In this case, are these international and national copyright laws and regulations still applicable to copyrighted works and derivative works in relation to the

[5] As appears in the preamble of the Berne Convention 1971 that: *'The countries of the Union, being equally animated by the desire to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works…'* and also in the preamble of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) 1995

online activity at all? This chapter will explore whether the internet technology and activities have changed the nature of originality and creativity, fixation and idea/expression dichotomy, and limitations and exceptions of copyright infringement originated in the printing age. Most importantly, is there any legal reformation needed to be made in light of these particular issues.

Finally, the study of this chapter will be regarded as the foundation for the examination of the internet activities and the rights of creators, the rights of publishers, and the rights of the internet users on the online copyrighted and derivative works discussed in subsequent chapters.

Regarding moral rights, it is a very important group of rights granted to original author of the work of creation under article 6bis of the Berne Convention. These rights are highly affected as well in the digital era. Nevertheless, since this thesis focus mainly on the rights of individual author to contribution of their creativity in order to create a subsequent work online, or in other words 'making derivative works', even though moral rights is a very important issue in the digital era it will only be mentioned very briefly in this chapter. On the other hand, the thesis will look closely on the economic rights which strongly affect the right of making derivative work such as the right of reproduction.

Furthermore, it is important to note that since the study in this chapter are focusing on the difference between the essences of originality and creativity, fixation and idea/expression dichotomy, and limitations and exceptions of copyright infringement between the US and the UK, therefore the analysis and examples in this part will be particularly directed through those notions and concepts of copyright. The fundamental of economic rights and neighbouring rights (or related rights) will be essentially discussed in the chapter III in order to clarify the role of each individual party in the online activity context.

At the beginning, in light of the concept of copyright protection, according to Sterling, (Sterling 2008) a work of author's mind could possibly be offered a copyright protection only when it achieves certain criteria. Those criteria may be named as criteria of *form*, *content* and *status*.[6] In this particular argument the discussion will be drawn only on two criteria: *form* and *content.* The criterion of *status* is, nevertheless, out of the scope of this analysis.[7]

The criterion of *form*, accordingly, could be referred as *'fixation'* which may include the expression of the creativity of the author in words in case of literary work, or action and sound in case of dramatic and musical works.[8] On the other hand, the criterion of *content* could be referred as 1) *originality* and 2) *the idea/expression dichotomy*[9]which concerns, particularly, the essence of the protected work.[10] For the purpose of this thesis, each of both criteria will be notably discussed as follows.

[6] J. A. L. Sterling, *World copyright law : protection of authors' works, performances, phonograms, films, video, broadcasts, and published editions in national, international, and regional law* (3rd edn, Sweet & Maxwell 2008) p 328

[7] Ibid p377 Criterion of status such as 1) Status of Author (Nationality) and 2) Status of Work (Place and Date of Publication)

[8] Ibid p329

[9] Ibid pp334-335

[10] Ibid p333

## A. ORIGINALITY AND CREATIVITY

### A.1. International Regulations

It is internationally accepted that copyright does not protect facts and idea.[11] According to Article 9(1)[12] of TRIPS and Article 2 of the Berne Convention, it is not explicitly stated, in the international level, that a work has to possess a certain degree of *'original and creativity'* in order to be protected under copyright law.[13] However, under Article 2(5)[14] of the Berne Convention it appears that there was a requirement for the 'collections of literary or artistic works 'to be protected when meet the criterion of *'intellectual creation'*.[15]

This context of *'intellectual creation'*, even though it was specified only for those works under Article 2(5) of the Berne Convention, could be presumed as an implicit requirement for protection of other works mentioned under Article 2 as well.[16] In this case the requirement was explicitly emphasised only for the works of collections under Article 2(5) because in many cases the *authorship* inherited in those works possibly may not be obvious comparing with those in the primary works protected under Article 2(1).[17]

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[11] Article 9 (2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) 1995 *'Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such'*

[12] TRIPs 1995, Article 9(1) *'Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of that Convention or of the rights derived therefrom.'*

[13] Sterling p337

[14] Article 2(5) of the Berne Convention 1971 *"Collections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute* ***'intellectual creations'*** *shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections"* (emphasised by author)

[15] Sterling p337 and Sam Ricketson and Jane C. Ginsburg, *International copyright and neighbouring rights : the Berne Convention and beyond* (2nd edn, Oxford University Press 2006) p448

[16] Ricketson and Ginsburg p488

[17] Ibid p488

## A.2. National Level

In the national level, definitions of *originality and creativity* have been varied in each jurisdiction according to judicial interpretation and the analysis of their intellectual writers.[18] The differences amongst jurisdictions could be generally analysed as follows;

### Common Law System: the UK and the US

In common law jurisdictions, the assessing of originality and creativity has long been relied on the main approach of 'sweat of the brow' doctrine which referred to 'the invested labour'.[19] Particularly in the UK, the 'skill, judgment and labour'[20] test has long been a basic concept of originality together with the idea that the work must not be copied from the previous author.[21] In this particular sense the concept of originality has strongly been formulated by the investment of both 'skill' and 'labour.'[22] There was, in addition, division between 'skill and judgment' on one hand, and merely 'labour' on the other. It was submitted that skill and judgment involve some personal intellectual contribution just like creativity, whereas labour does not combine this qualification.[23] Therefore, in the UK, in order to meet the

[18] Sterling p337

[19] Ibid p338, 356

[20] *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.* (1964) 1 WLR 273 (Lord Reid) *'Per Peterson J. in University of London Press Ltd. v. University Tutorial Press Ltd . And it is not disputed that, as regards compilation, originality is a matter of degree depending on the amount of skill, judgment or labour that has been involved in making the compilation.'* See Sterling p354, In the UK the terms 'skill, judgment and labour' generally include skill, labour, judgment, knowledge and experience.

[21] *University of London Press Ltd. v. University Tutorial Press Ltd.* (1916) 2 Ch 601 Peterson J. Held that *'The word "original" does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of "literary work," with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work - that it should originate from the author.'*

[22] *G A Cramp Sons Ltd v Frank Smythson Ltd* [1944] AC 329. See Sterling p748.

[23] Ibid pp337-37

criterion of originality a work need to be created upon both skill and judgment (creativity) and labour.

In the US, as of 1991 the courts have long applied the test of 'sweat of the brow' as the investment of labour or creativity in order to achieve the criterion of originality.[24]However, in *Feist Publications Inc. v Rural Telephone Service Co. Inc.*[25] the court has recently rejected just the 'sweat of the brow' (or labour) approach itself simply because the concept does not endorse originality. According to the court, it is required that an investment of a 'modicum of creativity' needs to be accomplished as well for the work to be complied with the criterion of originality.[26]

**A.3. Originality and Creativity and Derivative Works**

Apart from "literary and artistic works" under Article 2(1) and 'collections of literary or artistic works' under Article 2(5) which were already discussed above[27], there is another work under which shall be protected as original work as well. 'Derivative works' generally means those works which their creations are based on other works.[28] The work is recognised under Article 2(3) of the Berne Convention as 'derivative work' which includes but not limited to those translations, adaptations, arrangements of music, and other alterations of a literary or artistic work.[29] According to the provisions, it is required that those derivative works would be protected in Berne member countries, without prejudice to the copyright in the original work, when satisfy

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[24] Ibid pp337-376

[25] *Feist Publications, Inc. v. Rural Telephone Service Co.* 499 US 340 (1991)

[26] Sterling p357

[27] See above, A. ORIGINALITY AND CREATIVITY

[28] Sterling p279

[29] Berne 1971, Article 2 (3) *'Derivative works; Translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work.'* See also Ricketson and Ginsburg para 8.79-8.83

the criterion of originality as well. Additionally, according to the ECJ's decision in *Infopaq International A/S v Danske Dagblades Forening,* the scope of protection under article 2 of the Directive 2001/29 (the Copyright Directive) was given a broad interpretation and a strong meaning in the sense that the work which will be qualified for copyright protection is the work that contains or expresses 'the author's own intellectual creation'. Therefore, a sentence or parts of sentence, even though it comprises of only 11 consecutive words, are as well eligible for copyright protection under article 2 of the Directive 2001/29.

In the national level, protection of derivative works will be granted according to different standards and degrees of originality.

### A.3.1. Under the US jurisdiction

The copyright law of the US clearly separates the exclusive right of reproduction from the right of making derivative work.[30] The definition of derivative work is provided under Section 101.[31] Besides, it was also demonstrated in the House Report that a "derivative work" would require a process of recasting, transforming, or adapting "one or more preexisting works". For this purpose, the "preexisting work" must be consistent with the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted.[32]

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[30] 17 USC § 106 *'Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work;'*

[31] 17 USC § 101 A *'"derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".'*

[32] *Copyright Law Revision (House Report No. 94-1476)* (United States House of Representatives, 1976) at 57

In light of the subject matter of protection, the principle is advocated under Section 103.[33] Specifically under section 103(a) and 103( b), there are four major conditions for protection of a derivative work: 1) the protection does not extend to any part of the work in which another's copyrighted material has been used unlawfully 2) the protection extends only to the material contributed by the author of such work 3) the work which employs the preexisting work would not be granted protection and 4) The copyright protection granted to such work will not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material. In this regard, the House Report also adds one important factor under this provision that, even when the consent of the copyright owner had not been obtained *'the unauthorized reproduction of a work might be "lawful" under the doctrine of fair use and if so the work incorporating it could be copyrighted.'* [34]

As aforementioned, it is emphasised by the court In *Feist*[35] that a created work needs to bear a 'modicum of creativity' in order to meet the criterion of originality and thus be eligible for copyright protection. Similarly, the same standards and conditions apply to derivative works even though there remain some uncertainties. In and *L. Batlin & Son, Inc. v. Snyder*[36]and

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[33] 17 USC § 103 *'(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.'*

[34], *Copyright Law Revision (House Report No. 94-1476)* at 57-58

[35] *Feist Publications, Inc. v. Rural Telephone Service Co.* Supra note 25

[36] *L. Batlin & Son, Inc. v. Snyder* 536 F2d 486 (2nd Cir 1976) (en banc)'*This court has examined both the appellants' plastic Uncle Sam bank made under Snyder's copyright and the uncopyrighted model cast iron mechanical bank which is itself a reproduction of the original public domain Uncle Sam bank… The substance of appellee's expert's testimony on which the district judge evidently relied was that the variations found in appellants' plastic bank were merely*

*Durham Industries, Inc. v. Tomy Corp*[37] the courts denied protection on derivative works (a plastic Uncle Sam Banks and the three Disney figures) on the basis that they were merely the reproduction of the prior work of art, and therefore contained insufficiently original to support a copyright protection.

In *Anderson v Stallone*[38] upon considering whether Anderson's appropriation of the Rocky characters could be granted protection under copyright as derivative works, first of all it is stated under 17 U.S.C. Section 106(2) that the holder of a copyright has the exclusive right to prepare derivative works based upon his copyrighted work. The court then cited the decision in *Litchfield v. Spielberg*[39] that a work is derivative *"only if it would be considered an infringing work if the material which it had derived from a prior work had been taken without the consent of the copyright proprietor of the prior work."*[40], and therefore examined whether Anderson's treatment is an unauthorized derivative work. The court found on this issue that Anderson's characters in Rocky IV are not merely substantially similar to Stallone's but

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*"trivial" and that it was a reproduction of the metal bank made as simply as possible for the purposes of manufacture… [t]here were no elements of difference that amounted to significant alteration or that had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium.'* See also. Alfred Bell & Co. v. Catalda Fine Arts, Inc. 191 F2d 99 (2nd Cir 1951)

[37] *Durham Industries, Inc. v. Tomy Corp* 630 F2d 905 (2nd Cir, 1980)'*The three Tomy figures are instantly identifiable as embodiments of the Disney characters in yet another form: Mickey, Donald and Pluto are now represented as small, plastic, wind-up toys. Neither party contests the fact that Walt Disney created the three characters at issue. Tomy acknowledges Disney's ownership of copyrights on these characters4 and concedes that without a license from Disney Tomy's publication of its Disney figures would constitute infringement. That Tomy's creations are derivative works is in itself, of course, no bar to copyrightability. But this principle is subject to two important and related limitations. First, to support a copyright the original aspects of a derivative work must be more than trivial. Second, the scope of protection afforded a derivative work must reflect the degree to which it relies on preexisting material and must not in any way affect the scope of any copyright protection in that preexisting material. Thus the only aspects of Tomy's Disney figures entitled to copyright protection are the non-trivial, original features, if any, contributed by the author or creator of these derivative works… Lacking even a modest degree of originality, Tomy's Disney figures are not copyrightable.'*

[38] *Anderson v. Stallone* 11 USPQ2d 1161 (CD Cal 1989) Leslie A. Kurtz, 'The Rocky Road to Character Protection' (1990) 1 Entertainment Law Review 62

[39] *Litchfield v. Spielberg* 736 F2d 1352, 1354 (9th Cir 1984)

[40] Melville B. Nimmer and David Nimmer, *Nimmer on copyright : a treatise on the law of literary, musical and artistic property, and the protection of ideas* ([Revised edn, M. Bender 1978) § 3.01

they are literally Stallone's characters. Anderson bodily copied and appropriated the Stallone's Rocky characters in his treatment. The appropriation therefore infringes upon the protected expression of Stallone in the Rocky characters, and renders Anderson's work an unauthorized derivative work.

In the next issue where Anderson sought copyright protection for the non-infringing portions of his treatment, the plaintiff relied upon the content of 17 U.S.C. Section 103(a) and the House Report[41] as support for his position that the non-infringing parts are entitled to copyright protection.

The decision rendered in this issue was that; even though Anderson indicated that, according to the House Report, Congress intended to provide protection for the non-infringing portions of derivative works such as his case, the Court discovered that the House Report language is however ambiguous.

*'It makes a general statement that non-infringing portions of a work should be granted protection if these portions do not employ the pre-existing work. The report then provides two examples: one involving a compilation where the noninfringing portion was deemed protected, and another involving a derivative work where no part of the work could be protected. The general statement, when taken in the context of the comparison of compilations and derivative works in the section and the two examples given, is best understood as applying only to compilations. Although it is not crystal clear, it appears that the Committee assumed that in a derivative work the underlying work is "employed" throughout. … Both then appear to conclude that no part of an infringing derivative work should be granted copyright protection. Only if a derivative work is assumed to employ the infringing work throughout do these passages read coherently. … However, in dicta the court opined on what*

[41], *Copyright Law Revision (House Report No. 94-1476)* Supra note 34

*result would be warranted if the derivative work had been made without the permission of the original author. The Court cited to the aforementioned passages from Professor Nimmer's treatise and the House Report and assumed without discussion that the "derivative copyrights would be invalid, since the preexisting illustration used without permission would tend to pervade the entire work".*[42]

Therefore, the Anderson's treatment was an infringing derivative work and no part of it would be eligible for copyright protection.[43]

There appeared some other interesting cases on derivative musical works such as in *Tempo Music Inc. v Famous Music Corp.*[44] In accordance with the provisions of the 1909 Copyright Act and at its 1976 Amendment, the court had to find out whether or not the harmony and revised melody of the song 'Satin Doll', when used or performed without the lyrics, is a derivative work so that Billy Strayhorn's estate, the publisher, may or may not have the right to exploit the work after the original agreement was terminated.

In effect, the court disagreed with the assertion of the Ellington Estate arguing that a harmonic progression alone could not support a claim of copyright interest in a derivative musical work. Instead, the court relied on the standard of *Batlin*[45] test and Nimmer[46] and held that; first of all the substantially similar harmony in the 1953 recording of Satin Doll did not enter

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[42] *Anderson v. Stallone* Supra note 38 See also, *Eden Toys, Inc. v. Florelee Undergarment* Co.697 F.2d 27, 34-35 (2nd. Cir. 1982), *Gracen v. Bradford* 798 F.2d 300, 302-303 (7th Cir. 1983) and *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513 (7th Cir. 2009)

[43] In this *Anderson v. Stallone* case there are two important points to be considered: 1) the court focused only on the originality test but 2) they did not consider the fair use exceptions for purposes of granting copyright protection to derivative works.

[44] *Tempo Music v. Famous Music* 838 F Supp 162 (SDNY 1993) in Massimo Pavolini, 'Derivative musical works: protection and royalties in the balance' [1994] 5(3) Entertainment Law Review 101

[45] *L. Batlin & Son, Inc. v. Snyder* Supra note 36

[46] Nimmer § 4.05[B][2]

the public domain by reason of sales and distributions. Therefore the 1953 records did not restrain copyright protection for the elements of the subsequent works containing substance from the earlier works. Hence, the harmony performed by Strayhorn Estate still remained eligible for full copyright protection.

Secondly, regarding the second argument that the similar bars of harmony were found in the previous Ellington's works therefore the subsequent harmony was non-original and did not satisfy the criterion of originality and not qualify for copyright protection. In this particular issue Court cited *Levine*[47] and rejected this argument. In the decision the court found that there are various ways to compose the song but the author has chosen instead to perform in this particular expression. Therefore the performance is a copyrightable work because it contains various common elements so that it could impart a unique expression of harmony. Subsequently, the work does not lack creativity and could be protected under the copyright law.

Accordingly, there are two approaches [48] regarding the protection of derivative work under US jurisdiction: first, the approach in which the interpretation of originality tends to favour the derivative authors and therefore the standard and requirement of originality is somewhat low[49]; second, another approach which requires more contribution from the author of derivative work than the mere modicum degree of originality. Under the higher standard of 'non-trivial' or 'substantial originality', this approach requires that the author of derivative work applies substantial contribution in

[47] *Levine v. McDonald's Corp.* 735 F Supp 92 (SDNY 1990)

[48] Natalie Heineman, 'Computer Software Derivative Works: The Calm Before the Storm' (2008) 8 Journal of High Technology Law 235 p243

[49] For relevant cases see ibid, at footnote 33

the subsequent work so that the work was made distinguishable from the original.[50]

According to the opinion of the court in *Moore Publishing, Inc*[51]which compared the decisions in *Batlin*[52] and *Gracen*[53]*,* the confusion between the two standards has been divulged:

*"[Both cases] initially recognize that the quantum of originality required for copyright protection is modest and that the contributions [of the derivative author] need only rise above the minimal or trivial to be protected. But both opinions then continue on to require that the contributions be "substantially" different from the preexisting work. It would appear that a contribution could be more than trivial, but still not substantially different from the preexisting work. Would such a contribution be entitled to protection?"*[54]

Generally, it could be construed from the discussion above that even though the first approach may require at least a modicum degree of originality for a derivative work to be protected, at the same time the court who borrows this standard will also consider another factor regarding what has been added to the prior work. The point which is to be considered is that whether the contribution to the derivative work is sufficiently enough to enable audiences to distinguish between the derivative and the original work.[55]

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[50] For relevant cases see ibid, at footnote 34

[51] *Moore Publishing, Inc. v. Big Sky Mktg., Inc.* 756 F Supp At v1375, n2

[52] *L. Batlin & Son, Inc. v. Snyder* Supra note -

[53] *Gracen v. Bradford Exchange* 698 F2d 300 (7th Cir 1983)

[54] *Moore Publishing, Inc. v. Big Sky Mktg., Inc.*

[55] Heineman p244

This approach, however, contradicted with the idea of Nimmer which relies mainly on the standard of 'substantially difference'[56] as written in his book that: [57]

*'In general, the applicable standard in determining the necessary quantum of originality is that of a 'distinguishable variation' that is more than 'merely trivial.' Any variation will not suffice, but one that is sufficient to render the derivative work distinguishable from its prior work in any meaningful manner will be sufficient.'* [58]

### A.3.2. Under the UK jurisdiction

There is no explicit meaning of 'derivative work' provided under the UK Copyright, Designs and Patents Act 1988. But the relevant rights of the original author could be inferred from Section 16(1)(e)[59] and 21, particularly Section 21 (3)[60] of the Act.

Generally, a subsequent work which is merely a copy from the prior work will not be granted copyright protection. However, even if a following work contains substantial parts of the earlier works, that work can still be copyrightable if a sufficient and independent skill, labour and judgment have

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[56] Ibid p245

[57] Nimmer § 3.03[A], 3-12 and 3-13.

[58] Ibid

[59] Section 16 (1) of the Copyright, Designs and Patents Act (CDPA) 1988 *'The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom— (e) to make an adaptation of the work or do any of the above in relation to an adaptation' (see section 21)'*

[60] CDPA 1988, Section 21 (3) *'In this Part "adaptation"— (a)in relation to a literary work, other than a computer program or a database, or in relation to a dramatic work, means—(i)a translation of the work; (ii)a version of a dramatic work in which it is converted into a non-dramatic work or, as the case may be, of a non-dramatic work in which it is converted into a dramatic work; (iii)a version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a newspaper, magazine or similar periodical; (ab) in relation to a computer program, means an arrangement or altered version of the program or a translation of it; (ac)in relation to a database, means an arrangement or altered version of the database or a translation of it; (b)in relation to a musical work, means an arrangement or transcription of the work.'*

been exhibited.[61] According to cases there are three limitations before a work would be treated as original and therefore be protected as derivative work: *1) the labour applied to the work must be of the right kind, 2) the effort contributed must bring about a material change in the work, and 3) the change of the work must be of the right kind*, which could be discussed further as follows.[62]

The test of labour appeared in *Interlego AG v Tyco Industries Inc.* [63] when Lord Oliver stated that *'only certain kind of skill, labour and judgment confer originality'*. Furthermore in *Macmillan v Cooper*[64] the Privy Council also emphasised that a subsequent work will fail to meet the standard of originality if the material contained therein could not be distinguished from the prior work. The Privy Council therefore stated that *'To secure copyright for this product it is necessary that labour, skill and capital should have been expended sufficiently to impart to the product some quality or character which the raw material did not possess, and which differentiates the product from the raw material.'* and therefore denied copyright protection for the reduction of the *Life of Alexander*. Finally, it could be seen in *Sawkin v Hyperion*[65] that the court granted copyright protection to Sawkin's musical works providing that the effort, such as the time and labour spent on creating the new editions was sufficient and therefore meet the criterion of originality, even though those musical works were based on the works of Lalande.

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[61] H. I. L. Laddie, Peter Prescott and Mary Vitoria, *The modern law of copyright and designs* (4th edn, LexisNexis 2011) p87

[62] Lionel Bently and Brad Sherman, *Intellectual property law* (3rd ed. edn, Oxford University Press 2009) pp99-104

[63] *Interlego AG v Tyco Industries Inc* (1989) AC 217

[64] *Macmillan v. Cooper* (1924) 40 TLR 186

[65] *Sawkins v Hyperion* (2005) 1 WLR 3280

In summary, the two jurisdictions provide some degree of differences towards the concept of originality and the protection of derivative work. According to Nimmer[66] and Sherman and Bently,[67] both jurisdictions generally requires a sufficient degree of originality for a derivative work to be protected. [68] In addition it was only parts of derivative work which are distinguishable from the prior original work which will be eligible for copyright protection under both US and UK jurisdictions.

### A.3.3. In Comparison between the US and the UK

Fundamentally, a derivative work must be dependent on another prior or original work.[69] In this particular aspect the US courts have as well adopted the standard simplified that a subsequent work is derivative when it contains 'substantial' amount of components from the underlying work.[70] In such case, when a work is borrowing 'substantial amount of components' from the prior work, there might be some random circumstances where parts of those derivative works could not be easily distinguished from the original work. The situation could happen regardless of whether the author of the subsequent derivative work receives official permission from the author of the preexisting work.

In general, according to Nimmer, if the author of the subsequent work uses substantial parts of the original work with official authorisation from the original author regardless of whether those parts are distinguishable from

[66] Nimmer § 3.01

[67] Bently and Sherman p99

[68] The concept and scope of originality is different amongst both jurisdictions as discussed earlier, however.

[69] 17 USC § 101 *'A "derivative work" is a work based upon one or more preexisting works…'* There is no explicit meaning of 'derivative work' under the UK Copyright, Designs and Patents Act 1988, however. But the meaning could be inferred from those given under Article 2(3) of the Berne Convention.

[70] For relevant cases see Heineman supra note 48, at footnote 75

the original work, the author of the derivative work will be able to acquire copyright protection on the work based on the agreement of contract with the original author.[71] In this case, using parts of the prior work outside the scope of contract could constitute copyright infringement.[72]

On the contrary, the situation is different when it comes to the case when the author of the derivative work uses substantial parts of the prior copyrighted work *without permission of the original author*.

In such case the use could basically create copyright infringement and will affect the exclusive rights[73] of the copyright owner. According to Goldstein, it is emphasised in his work that in the absent of proper consent, the copyright owner would not have chance in advance to contract against the acts of the infringer that might defeat copyright protection for the prior expression.[74] From this statement it could be inferred that the unauthorised use of substantial parts of the prior work could therefore potentially create copyright infringement[75] regardless of whether those parts are distinguishable or indistinguishable from the original work.

However, at this stage where the discussions are mainly focusing on the copyright protection granted to derivative works, not the copyright infringement, it is therefore noteworthy to emphasise that the *unauthorised use* of substantial parts of preexisting work could create significant issues which are to be examined as follows.

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[71] Nimmer § 3.04 [A]

[72] Heineman at footnote 106

[73] Either Right of making adaptation, right of reproduction, or right of making derivative work as provided under US and UK copyright law

[74]Paul Goldstein, 'Derivative Rights and Derivative Works in Copyright' (1982-1983) 30 Journal, Copyright Society of the USA 209 p240 (citing *Baker v. Seldon*, 101 U.S. 99(1879))

[75] A significant issue which will be profoundly discussed in further in D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

First of all, when the infringement occurs after the use of substantial parts, there could be two important scenarios in a derivative work where the subsequently created work are *1) indistinguishable from the prior work* and *2) distinguishable from the prior work.*

In both situations, if identifiable, generally both the US and the UK will not grant copyright protection to parts of derivative works which are merely slavish copies of the earlier work.[76] One fundamental reason is because those copied parts do not meet the criteria of originality. The copies are simply violation to the right of reproduction of the original author. Also the infringer of the subsequent copied work certainly has not produced any independent expression or created the new work or the new market.[77]

Nevertheless, under those two different scenarios mentioned above, the copyright protection granted to derivative works which contain *unauthorised use* of substantial parts of prior works could be divided and analysed by categorise and jurisdictions as follows.

**(1) Derivative works which are indistinguishable from the prior work; for example, the translation of the whole novel**

| UK = protected + infringe the right of making adaptation |
|---|

From the UK standard, even though a derivative work contains unauthorised substantial parts of the prior work, it is likely that the court may allow copyright protection to the whole derivative work if a sufficient degree of skill, labour and judgment is proven.[78] In general, this fundamental applies to

[76] Nimmer § 3.06. and Laddie, Prescott and Vitoria Supra note 61

[77] Goldstein p217 (citing *Baker v. Seldon*, 101 U.S. 99(1879))

[78] Laddie, Prescott and Vitoria p87

both authorised and unauthorised parts of the prior work which are eventually used and incorporated to the subsequent derivative work.

Particularly, in some cases where those unauthorised parts are indistinguishable from the prior work; giving one example on an unauthorised translation of a novel, under the UK copyright law the unauthorised translation of the entire novel could possibly be qualified for copyright protection if in such translation a certain degree of skill, labour and judgment of the translator has been proven. The UK copyright law may grant copyright protection to the translator in such case notwithstanding that act of translating might create a dispute of copyright infringement because it violates the exclusive right of making adaptation guaranteed under section 16 (1)(e) of the UK Copyright, Designs and Patents Act 1988.

Furthermore, since the limitations and exceptions of copyright infringement under the UK copyright law are guaranteed under the scope of fair dealing which is more restricted than the fair use concept of the US,[79] it is likely that the author of derivative work in the UK might be granted copyright protection on his unauthorised translated novel, and might be charged for copyright infringement for violating the right to making an adaptation of the work[80] of the author of the original work at the same time.

| US = not protected + infringe the right of making derivative work<br>(Not the right of reproduction) |
|---|

On the contrary, according to the example given above, the translated version of the novel falls into the scope of 'derivative work'

[79] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[80] CDPA 1988, Section 16 and 21

emphasised under 17 U.S.C. § 10.[81] Also the exclusive right of making derivative work is guaranteed only for the owner of copyright under 17 USC § 106 (2).[82] Therefore, first of all, the unauthorised translation of the entire novel would implicitly be an infringement to the exclusive right of making derivative work of the original author of the preexisting work.

As for the copyright protection, Section 103(a) of the US Copyright Act 1976 explicitly states that the copyright in a compilation or derivative work *'does not extend to any part of the work in which such [pre-existing] material has been used unlawfully.'* By virtue of this provision, the US would usually deny copyright protection on the portion of derivative work which employs the original work unlawfully.[83]

Generally, under the US copyright law, the unauthorised use of parts of copyrighted work could possibly be regarded as lawful under the fair use doctrine. However, according to section 107[84], the unauthorised translation of the entire novel could not be regarded as lawful use under the doctrine of this provision.

Therefore, according to the example given above, first of all, the translation of the entire novel is an infringement of the right of making derivative work of the original author. Secondly, the author of the

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[81] *'A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".'*

[82] 17 USC § 106 *'Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (2) to prepare derivative works based upon the copyrighted work.'*

[83] Nimmer § 3.06

[84] 17 USC § 107 *'a fair use the factors to be considered shall include— (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.'*

unauthorised translated version of the full novel in the US would not be granted copyright protection unless evidence has been proven that the act of translating and incorporating the original work is lawful under the fair use doctrine.[85] In this case the translation of the entire novel is unlikely to meet the criteria of fair use. This is simply because, according to Goldstein, the sole translation of a novel from one language into another is nothing but a change of the prior expression from one into another different though equivalent form.[86] Therefore, the unauthorised translation of the full novel would not be granted copyright protection under the US law.[87]

**(2) Derivative works which are distinguishable from the prior work such as parodies and satires**

When a derivative work contains unauthorised use of substantial parts of the prior work, there are many cases where those uses could be distinguishable from the original work; for example in the work of satires[88] and parodies[89]. In such cases, the subsequent works will generally contain two parts of arts which are separable from each other; *a) the parts which contain originality of the author of the derivative works*, and *b) the substantial similarity parts which borrowed from the underlying work.*

**a) The newly created parts which contain originality of the author of the derivative works**

[85] Nimmer § 3.06 Supra note 76

[86] Goldstein p226 (citing *Baker v. Seldon*, 101 U.S. 99(1879))

[87] At the early stage judges posited that a work could not be both original and infringement. Therefore a translation would not be regarded as infringing because of *'the creative originality'* of the subsequent author contributed during the act of translation. See also Leval PN, 'Nimmer Lecture: Fair Use Rescued' [1997] 44 UCLA Law Review 1449 (1997) 1450 p1452

[88] See the meaning of satire, for example, some are monologues, some are parodies, and some are narratives, in Gilbert Highet, *The Anatomy of Satire*, (1st ed., Oxford University Press; (1962)) pp13-14

[89] See further discussion on parody in D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

| Originality – UK = protected<br>US = protected |
|---|

In cases where the creations of the author of derivative works are distinguishable from the underlying works, and where those creations suffice a condition of sufficient degrees of originality as discussed earlier[90]; in general, those separable parts is eligible for copyright protection in both US[91] and UK jurisdictions and therefore the subsequent author of those parts will be able to be granted copyright protection as well.

**b) The substantial similarity parts which borrowed from the underlying work**

| Substantial similarity parts<br>UK = not protected + infringement right of making adaptation<br>US = (1) not protected + infringement right of making derivative work<br>(2) protected + not infringement (fair use i.e. transformative or parody, satires, criticism, or comments) |
|---|

authorisation from the original author; that is the case where the copyright infringement normally takes place.

Those borrowed parts, if distinguishable from the subsequent work, is the copyright of the original author and generally will not be able to acquire copyright protection under both jurisdictions. This is because, under the UK copyright law, those unauthorised substantial parts are violation to the right

[90] See A.ORIGINALITY AND CREATIVITY AND DERIVATIVE WORKS

[91] See 17 USC § 103 (b)

of making adaptation guaranteed for the original author under section 16(1)(e)[92] of the Copyright, Designs and Patents Act 1988.

However, under the US copyright law this similar situation could be divided into two cases; *(i) the case where the substantial similarity parts will* ***not*** *be able to acquire copyright protection* because they violate the right of making derivative works of the original author, and *(ii) the case where the substantial similarity part will be able to acquire copyright protection* because they meet the conditions of lawful use under the US fair use doctrine.

**(i) the case where the substantial similarity parts will not be able to acquire copyright protection**

Primarily, according to section 103 (a)[93] of the US Copyright Act, normally the copyright protection for a derivative work employing material of the preexisting work in which copyright exists will not extend to any part of the work in which such material has been used unlawfully. This is because, fundamentally the right to use such material to create a subsequent derivative work is the exclusive right solely guaranteed for the author of the original work as certified under section 106 (2) of the Act.

Therefore, when the author of the derivative works borrows those substantial parts without authorisation, the use of such parts will basically be an infringement to the right of making derivative work of the author. Also those parts will fundamentally not be eligible for copyright protection.[94]

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[92] CDPA 1988, Section 16 *'(1)The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom— (e)to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);'*

[93] 17 USC § 103 *'(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.'*

[94] Goldstein p19 and 26

### (ii) the case where the substantial similarity part will be able to acquire copyright protection

Nevertheless, it is possible under this provision as well that the use of the pre-existing work would not be 'unlawful' even though the authorisation of the copyright owner had not been achieved. In some cases the unauthorized reproduction of a work might be 'lawful' under the doctrine of fair use. In such cases the derivative work incorporating the prior original work could be protected by copyright under US jurisdiction.[95]

According to Anthony Reese[96] whether the unauthorised substantial parts will be qualified for copyright protection, there are two main processes to be considered; first of all the act of unauthorised use of substantial parts will primarily be copyright infringement, secondly, whether such act of unauthorised use of substantial parts will be qualified for exemption under the doctrine of fair use.

When such acts comply with the doctrine of fair use, either because they are *transformative*, parody, satire, criticism or comment[97] the acts could possibly be referred as 'lawful use' and will be exempted from copyright infringement and therefore qualified for having copyright protection under section 103 (a).[98] Or otherwise, such acts will be referred as copyright infringement and will not be granted protection.

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[95], *Copyright Law Revision (House Report No. 94-1476)* Supra note 34

[96] R. Anthony Reese, 'Transformativeness and the Derivative Work Right' (2007-2008) 31 Columbia Journal of Law & the Arts 467p475, at footnote 30

[97] See the further discussion on fair use and parody in D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[98] Reese p475, at footnote 30

In addition, in some other cases an unauthorised use of the prior works could possibly be lawful if those works are available in the public domain as well.[99]

The requirement of lawful use of the original work in the US results in two following theories: the 'Pervades Standard' theory and the 'Infringement' theory.[100] The 'Pervade Standard' theory provided that, in lack of consent of the original creator, a derivative work will not be nullified unless the underlying work tended to 'pervade' it.[101] Or in other words, in lack of consent, a derivative work would be considered as 'lawful' as long as it does not pervade the prior work, as demonstrated in *Pickett v. Prince* that '*the creator of a derivative work would not require authorization if the preexisting work does not 'pervade' the derivative work.*'[102] This theory, however, has some uncertainties since it would persuade the authors of the derivative work to create a subsequent work without the permission of the original author given that that work does not pervade the original work. And that would undermine the value of the exclusive right of the original copyright owner.[103]

In light of the 'Infringement' theory, while at odds with the 'Pervades Standard' theory, it is assumed that the subsequent work would be justified as a derivative work only if that work would be considered as 'an infringement' of the prior work when lack of consent of the original author. Therefore, borrowing this approach, first of all the courts must identify

[99] Heineman p250

[100] Ibid pp250-251

[101] See, *Eden Toys Inc., v. Florelee Undergarment Co.* 697 F2d 27 (2nd Cir 1982) and *Pickett v. Prince* 52 F Supp 2d 893 (ND Ill 1999). See also Heineman N, 'Computer Software Derivative Works: The Calm Before the Storm' (2008) 8 Journal of High Technology Law 235 supra note 48 , at footnote 107

[102] *Pickett v. Prince*

[103] Nimmer § 3.06, n.22.1.

whether there are 'substantial similarities' between the original work and the subsequent work so that it would be possible to clarify the infringing. In most cases it will likely be because the derivative work needs to incorporate substantial amount of the underlying work.[104] The act of taking substantial part could, however, possibly be lawful under the doctrine of fair use.[105] Subsequently, this could lead to another problem where the protection of the rights of the two authors of the work (the author of the original work and the author of the subsequent work) conflict.[106] It could be viewed from the decision in *Steward v. Abend*[107] that '*Congress simply intended that a derivative work author may not employ a copyrighted work without the author's permission, although of course he can obtain copyright protection for his own original additions.*' Nimmer also mentions this issue his work that '*the right to claim copyright in a non-infringing derivative work arises by operation of law [section 106 and section 103(a)], not through authority from the copyright owner of the underlying work.*'[108]

Therefore, these US theories support the protection of the right of the derivative authors if their originality and creativity has been found in the subsequent work regardless of whether the consent of the original author has been achieved. If the derivative work infringes the original work, only that

[104] Ibid § 3.03[A] See also, Heineman N, 'Computer Software Derivative Works: The Calm Before the Storm' (2008) 8 Journal of High Technology Law 235 supra note 47, at footnote 75

[105] 17 USC § 107 *'The factors to be considered for fair use shall include—(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.'*

[106] Heineman p252, at footnote 117

[107] *Stewart v. Abend* 495 US 207, 232(1990)

[108] Nimmer § 3.06 , n.4. and Heineman p253

suggested protection would be removed.[109]In other words, the author of an unauthorised derivative work which incorporates the original work could possibly be granted copyright protection under the US copyright law only if a proof has been provided that the act of employing the prior work is legitimate.[110]

It is worth noting that even though the US fair use doctrine is more flexible than the standard of the UK fair dealing[111], the result in this example is virtually the same.

In conclusion, as Nimmer emphasised in his book that *'A work is not derivative unless it has **substantially** copied from a prior work,'*[112] the act of 'taking substantial parts' of the original work and making derivative work 'without authorisation' of the original author is against the exclusive right of making adaptation guaranteed under the right of preparing derivative work[113] and the right of making an adaptation of the work[114] of the original author[115], therefore it could constitute copyright infringement in both jurisdictions.

Nevertheless, generally, the author of such work (either in the US or UK) will usually acquire copyright protection on the work. The protection will be given based on two different approaches which, however, bring in two almost similar consequences.

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[109] Ibid p253

[110] See, *Gracen v. Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983); *Pickett v. Prince*, 52 F. Supp. 2d 893 – Dist. Court, ND Illinois 1999 (citing *Dynamic Solutions, Inc. v. Planning & Control*, Inc., 646 F. Supp. 1329 (S.D.N.Y 1986))

[111] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[112] Nimmer § 3.01

[113] 17 USC § 106 (2)

[114] 17 USC § 106 (1) and CDPA 1988, Section 16(1)(e) and 21 Supra note 59 and 60

[115] Nimmer § 3.01

In general there are four fundamental considerations before a subsequent work could be protected by copyright as derivative work.

(1) Such work needs to be qualified under the definition of derivative work mentioned in Article 2(3) of the Berne convention; i.e. a translation, adaptations, arrangements of music and other alterations of a literary or artistic work.

(2) Whether the author of such subsequent work receives official authorisation from the original author, or the work is adapted by the original author himself

(3) The second condition will lead to the third question of originality and creativity. According to Goldstein[116] because the copyright's underlying economic principles aim to attract private investment to the creation of original expression, therefore the structure of copyright on derivative works intentionally provides the original author with two incentives; *1) the right to use elements in the prior work to prepare derivative work* and *2) the copyright protection to the elements of derivative work which combine originality*.

If the original author copies substantial parts of his prior work to reproduce a derivative work, such act will not be infringing. On the other hand, those copied parts will lack originality and creativity and therefore not be qualified for copyright protection.

In other cases where other authors, without authorisation of the original author, copy substantial parts of the prior work and then reproduce a derivative work, such act will be a copyright infringement. According to the laws both the maker of the new version and any third-party copier will need

[116] Goldstein pp216-217

the licence of the owner of copyright in the original.[117] Primarily such infringing act will not be qualified for copyright protection unless it complies with some exceptions such as fair use.

Nevertheless, the copyright protection which could possibly be granted to a derivative work will extend only to those parts which bear the original and creativity of the subsequent authors and to those substantial similarity parts which are lawfully used by the subsequent authors.

(4) The subsequent work may need to satisfy the condition of *fixation*[118] as well.

In the UK, all parts of derivative work could potentially be copyrightable if the criteria of originality were all achieved. This means the copyright protection will be guaranteed for the author of derivative work if such parts of work meet the criterion of originality and provides sufficient degree of skill, labour and judgment. But, at the same time, the author could as well be sued for copyright infringement of the right to making adaptation of the prior work.

In the US the author of derivative work will be granted copyright protection only if a lawful act (of taking substantial parts) is proven either by contract or by the doctrine of fair use. In cases where the fair use act has not been verified those illegal parts of copied work will not be copyrighted, as certified in Nimmer's that *'when [the permission of the underlying copyright owner] is lacking, copyright protection may be forfeited in the derivative work, to the extent that the underlying work continues to enjoy copyright protection.'*[119] Accordingly, if such lawful act is proven, not only the work will

[117] Bently and Sherman p99

[118] Will be discussed further in the next topic

[119] Nimmer § 3.04[A]

be copyrighted but the author of the derivative work could possibly be exempted from copyright infringement as well.

In case of the US, the only difference from the UK is that the author may need to defend his act under the fair use doctrine so that, first of all, the work could be protected, and, secondly, he would as well be excused from copyright infringement.

In fact, this part aims mainly to discuss at the beginning the scope of copyright protection granted to various types of derivative works, including parody.[120] The other issue of copyright infringement and the limitations and exceptions on unauthorised uses of the prior copyrighted works such as *'transformativeness'* will be profoundly analysed in the latter parts of the thesis.[121]

Nevertheless, it is worth noting at this stage that even though the fair use doctrine tends to offer broader exceptions to the unauthorised use of the copyrighted work than the fair dealing concept,[122] the doctrine could at the same time create some inconsistencies in the situation of protecting derivative works under the US copyright law, as seen in some noteworthy cases such as *Rogers v Koons*[123], *Gracen v. Bradford Exchange*[124], *Eden Toys Inc., v. Florelee Undergarment Co.*[125], *Pickett v. Prince*[126], *Schrock v. Learning Curve*

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[120] See distinctions between derivative works and parody in D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[121] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[122] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[123] *Rogers v. Koons* 960 F2d 301 (2nd Cir 1992) See also *Blanch v. Koons* 467 F3d 244 (2nd Cir 2006)

[124] *Gracen v. Bradford Exchange*. See J. C. Ginsburg, 'The Concept of Authorship in Comparative Copyright Law' 52 Depaul Law Review 1063p1082

[125] *Eden Toys Inc., v. Florelee Undergarment Co.*

[126] *Pickett v. Prince* 207 F3d 402 (2000)

*International, Inc.*[127] *Lewis Galoob Toys Inc., v. Nintendo of America Inc*.[128], *Micro Star v. Formgen Inc.*[129], and also in a very recent case *Cariou v. Prince*[130].

### A.4. Originality and Creativity in The Digital Era

#### A.4.1 The Shift of Originality in the Copyrighted Works

According to Rosati[131], due to the different concepts of originality amongst countries, there have been efforts to harmonise those dissimilarities as could be viewed from the direction of the EU member states. However, the harmonised concept does not apply to all categories of copyrighted works. The EU Commission Working Paper on the Review of the EC Legal Framework in the Field of Copyright and Related Rigths[132] (the Paper) concludes that the harmonisation is required notably in the respect of technology-related categories of works; computer programs and databases.[133] Furthermore, since the lack of harmonisation of the concept of originality on other categories of works does not create any serious problems to the operating of the internal

[127] *Schrock v. Learning Curve International, Inc.* 586 F3d 513 (7th Cir 2009)

[128] *Lewis Galoob Toys Inc., v. Nintendo of America Inc.* 964 F2d 965 (9th Cir1992)

[129] *Micro Star v. Formgen Inc.* 154 F3d 1107 (1998)

[130] *Cariou V. Prince* No 11-1197-cv (2nd Cir Apr 25, 2013)

[131] Eleonora Rosati, 'Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate' [2010] International Review of Intellectual Property and Competition Law 524

[132] Commission Of The European Communities, *Commission Staff Working Paper On The Review Of The Ec Legal Framework In The Field Of Copyright And Related Rigths* (2004)"*Whether the requirement of originality should be harmonised regarding all types of works remains a debated issue. In theory, divergent requirements for the level of originality by Member States have the potential of posing barriers to intra-Community trade. In practice, however, there seems to be no convincing evidence to support this. The Community harmonisation was needed, and has been enacted, with respect to technology-related categories of works, notably computer programs and databases. However, there are no indications that the lack of harmonisation of the concept of originality would have caused any problems for the functioning of the Internal Market with respect to other categories of works, such as compositions, films or books. Therefore, legislative action does not appear necessary at this stage."*

[133] Article 1(3) of the Software Directive, Article 6 of the Term Directive with regard to photographs, and Article 3(1) of the Database Directive, which are the only provisions at the level of EC directives that specifically deal with the issue of originality, have mentioned *'originality'* as it is required *'the author's own intellectual creation'.*

market, it is, therefore, left to the member countries to determine the value of originality on other type of works based on their own standards.[134] In this case, Rosati also argues that merely the harmonisation on economic rights, the attitude to which could be presumed from the Paper, has neglected the fact that the *'entitlement to copyright protection'* is required for a work to be protected at the first place. It is emphasised in her article that in order to be protected under copyright law a work needs a qualification of being original and that is the where the economic rights are descended. Therefore, any future copyright reformation or harmonisation should be resulted from the careful analysis of the overall picture.[135]

In general, the digital environment has shifted the view of many countries towards the concept of originality and creativity. In the US, from the decision in *Sarony*[136] to *Bleistein*[137] and *Feist*[138] the meaning of originality has changed overtime and with concurrent meanings. It is observed that during this period of time the courts in those cases have provided two different approaches of originality. One doctrine is based on the merit of originality; the other relies upon the basis of market value.[139] In the UK, likewise, it is

[134] Rosati p530

[135] Ibid p531

[136] *Burrow-Giles Lithographic co. v Sarony* 111US 53(1884) The court has expanded the concept of originality to protect photograph.

[137] *Bleistein v Donaldson* 188 US 239 (1903) In this case the concept of originality was extended to protect advertisements as well.

[138] *Feist Publications, Inc. v. Rural Telephone Service Co.* On the other hand, the concept of originality was restrictively modified in this case in order to deny protection to a telephone directory. It appears in the opinion of Justice O'Connor that: *'[t]he originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i. e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, [p*359] the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. […] Such works are incapable of sustaining a valid copyright'*

[139] Rosati p535

presumed that there is no such thing as a single concept of originality under the British copyright system.[140] From the beginning of *University of London Press*[141]and *Ladbroke*[142], it is given that a work is original if it is originated from the author, not copied from another work, and incorporated the author's skill, judgment and labour. This fundamental concept of originality, however, was uncertain and later was modified in accordance with various types of works in the decisions of *Interlego,* [143] *Designers Guild* [144] and *Newspaper Licensing Agency.*[145] After the decision of the ECJ in *Infopaq*[146] it is argued that now in the UK there are two approaches towards the interpretation of originality; one is the traditional British approach, the other is the harmonised EC Directives[147] approach.[148]

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[140] Ibid p538

[141] *University of London Press Ltd. v. University Tutorial Press Ltd.* Supra note 21

[142] *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.* Supra note 20

[143] *Interlego AG v Tyco Industries Inc* Lord Oliver of Aylmerton acknowledged the deficiency of the standard of originality appeared in *University of London Press*, providing that *'Originality in the context of literary copyright has been said in several well known cases to depend upon the degree of skill, labour and judgment involved in preparing a compilation. […] Skill, labour or judgment merely in the process of copying cannot confer originality.'*

[144] *Designers Guild Ltd. v Russell Williams (Textiles) Ltd.(trading as Washington D.C.).* (2000) 1 WLR 2416 The House of Lords held that the work of the defendant has incorporated a substantial part of the plaintiff's skill, labour and judgement contributed in the copyrighted work. The decision of the Court of Appeal was therefore reversed and the House of Lords found that the works of the defendant infringed the work of the plaintiff.

[145] *Newspaper Licensing Agency Ltd v Marks & Spencer Plc* (2001) 3 WLR 290 *'the copying of certain of the ideas expressed in that design which, in their conjoined expression, had involved original artistic skill and labour, constituted the copying of a substantial part of the artistic work. […]The notion of reproduction, as demonstrated by the Designers Guild case, is sufficiently flexible to include the copying of ideas abstracted from a literary, dramatic, musical or artistic work, provided that their expression in the original work has involved sufficient of the relevant original skill and labour to attract copyright protection.'*

[146] C-5/08 Infopaq International A/S v. Danske Dagblades Forening.

[147] Article 1(3) of the Computer Program Directive (Directive 91/250/EEC), Article 6 of the EC Term Directive (Directive 2006/116/EC) and Article 3(1) of the Database Directive (Directive 96/9/EC) provide provisions related to the interpretation of 'originality' on the three categories of work: computer program, photograph and database. It is stated under these provisions that the works are original and will be protected by copyright if they confer 'the author's own intellectual creation'.

[148] Rosati pp538-542. See also Estelle Derclaye, 'Assessing the Impact and Reception of the Court of Justice of the European Union Case Law on UK Copyright Law: What Does the Future Hold?' (2014) Revue Internationale du Droit d'auteur (240) RIDA 5-117, Jonathan Griffiths,

Some scholars, however, have different view regarding this issue. For example, it is argued in the work of Rahmatian that the interpretation of the classical originality definition of UK copyright law (skill, labour and judgement) could certainly be made in a way that complies with this CJEU ruling in *Infopaq.*[149] This means that the division between the two approaches: the UK, and the harmonised EC Directive approach is not real. The decision in *Infopaq* does not bring any change to the national concept of originality and creativity in the UK and thus there is probably no such different standard.

In her article, Rosati concludes that the discussions and agreement on the concept of originality needs to be made at the EU level before going further to the harmonisation on scope of economic rights. This consideration is essential on every type of copyrighted works and not limited to technical and technological subject matter.[150]

Even though Rosati tended to argue in favour of harmonisation, she also mentioned in her article that there are cases where the concept and scope of originality are differently interpreted amongst jurisdictions in accordance with the policy towards those objectives while granting or denying copyright protection to specific categories of works. This highlights one important issue that even though the harmonisation of the concept of originality might be useful in the EU level, the use of originality as a policy tool is really a too important subject to be left out of discussions.[151]

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'Dematerialization, Pragmatism and the European Copyright Revolution' (2013) Oxford Journal of Legal Studies 767 and Mireille van Eechoud 'Along the Road to Uniformity – Diverse Reading of the Court of Justice Judgments on Copyright Work' (2012) 3 JIPITEC 1, para 60.

[149] Andreas Rahmatian 'Originality in UK Copyright Law: the Old "Skill and Labour" Doctrine Under Pressure' (2013) International Review of Intellectual Property 3

[150] Ibid p543

[151] Ibid p543

At this stage , the author of this thesis would rather argue in favour of the non-harmonisation of the concept of originality. This is mainly because outside the EU member countries, particularly in the lager scope of copyright protection under the digital and social network environment where there are numbers of online participants from various jurisdictions all over the world, the 'policy issue' regarding the interpretation of the concept of originality is an essential aspect to be considered. This is as appeared in Sterling's book that a future study will need to be explored whether a similar criterion should be adopted as the harmonised approach for other countries outside the EU and throughout the world.[152]

The analysis about the core concepts of originality and creativity as a significant substance in a work of creation, also an important factor for copyright protection for a work of creation of the original authors, will be profoundly discussed in chapter II and later in chapter III (Part II) of the thesis.

### A.4.2. The Dynamic of Originality in Derivative Works

As mentioned earlier, in order to be protected a derivative work may need a qualification of originality. The question of originality and the protection of derivative work remain unclear not only in the analogue world but also in the digital era.

It is previously accepted that the subsequent work could not be a slavish copy of the prior work,[153] and the skill, labour and judgment invested

[152] Sterling p373

[153] *Interlego AG v. Tyco Industries* [1989] AC 217, 262-263 . Lord Oliver state that *'copying per se, however much skill or labour may be devoted to the process, cannot make a work original' and 'well-executed tracing is the result of much labour and skill but remains what it is, a tracing. It takes great skill, judgment and labour to produce a good copy by painting or to produce as enlarged photograph from a positive print, but no one would reasonably contend that the copy painting or enlargement was an 'original' artistic work in which the copier is entitled to claim copyright'*

in the work must not be mechanical or automatic[154] otherwise that work would not bear a qualification of originality and therefore not qualified for copyright protection. However, some question persists in the digital era where the digitization of a work is as easy as automatic and usually does not provide significant alteration to the original work, for example, whether the digital scanning of a work or the translation from non-digital sources into digital formats could be regarded as original.[155] In this case there are some opinions which support the idea that such change of works could confer originality and is therefore qualified for copyright protection just like the protection granted in *Walter v. Lane*.[156]

In this particular section, the thesis will discuss the probable protection of digital derivative work which derived from two types of original work which are disseminated online;

**(1) The original work which was originally created in a non-digital format and later be altered to store in a digital format, or *vice versa*, either by its owner or the third party**

First of all, the digital work received after the alteration is not derivative work since it does not contain originality. The idea is here again supported by Goldstein that the transformation of a work from one format to another will likely be equivalent only to the transportation of similar expression from one into different form, and therefore does not usually convey originality.[157]

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[154] Bently and Sherman p99, See also *Macmillan v. Cooper* (1924) 40 TLR 186

[155] Ibid pp98-104

[156] Ibid p100, see also Laddie HIL, Prescott P and Vitoria M, *The modern law of copyright and designs* (4th edn, LexisNexis 2011) para.20.67 and *Walter v Lane* (1900) AC 539

[157] Goldstein p226 and Bently and Sherman at footnote 86

Furthermore, fundamentally this issue is all about the 'machine'. The subsequent work received after the alteration into digital form [by skill of a machine] would not be classified as derivative work. It is merely another form of original work which could be developed to online or digital derivative work in the future. This is not only because such digital format of work lacks originality but it is also the problem of *authorship*.[158]

The originality and *authorship* has become relevant, not only in the sense of copyright work but also in derivative works,[159] as Nimmer wrote in his work, in comparison between *Qimron v. Shanks*[160] and *Bender v. West.*[161] He concludes that copyright protection requires that a work of authorship be new to its creator, or in other words "independently created," instead of being copied from prior sources. In case of *Qimron v. Shanks,* the professor who re-arranged the ancient texts will acquire copyright protection if his work was original in the sense that it came independently from his head and not being a recapture of original texts. Otherwise such rearrangement of work will be barred from copyright protection.[162]

The idea could be applied in the digital era where the machines play an important role in making subsequent works and producing merely a copy of an original. Giving an example on the work of photograph, in *Bridgeman Art Library v. Corel Corp.,*[163] the US court held that even though it could be

[158] Discussed further in chapter III

[159] David Nimmer, 'Copyright in the Dead Sea Scrolls : Authorship and Originality' (2001-2002) 38 Houston Law Review 1*(2001-2002)* pp7-13, See also Ginsburg JC, 'The Concept of Authorship in Comparative Copyright Law' 52 Depaul Law Review 1063 pp1078-1082

[160] Ibid Chapter VI p92-93 discussed about the case *Qimron v. Shanks* (Elisha Qimron v. Hershel Shanks and 3 others (1993) 69 (iii) P.M. 10 (DistrictCourt of Jerusalem)) at footnote 186

[161] *Matthew Bender & Co. V. West Publishing Co.* 158 F3d 674 (2nd Cir 1998)

[162] Nimmer, 'Copyright in the Dead Sea Scrolls : Authorship and Originality' p193-196. See also *Feist Publications, Inc. v. Rural Telephone Service* Co. 499 US 340 (1991)

[163] *Bridgeman Art Library, Ltd. V. Corel Corp.* 36 F Supp 2d 191 (SDNY 1999)

presumed that the photographic of those public domain arts required both skill and effort, the objective of taking the photos, however, was to make exact reproduction of the preexisting works. The images therefore contain no sign of originality and thus could not be protected under the US copyright law. Another case is, for example, in *STR Indus. v. Palmer Indus.*[164]where scanning of a pre-existing work into a computer without any alteration to its content does not confer *authorship* to the person who did the scanning. The only thing received after the scanning was the *'machine-generated medium change'* but the content of the work is still the same.[165]

Most of the works transferred from non-digital to digital format will likely not meet the criteria of *authorship* and originality due to the assistance of the potential machines. When the sophisticated devices such as cameras or computers are involved it may result in the absence of creativity of their creators. (And in such cases those subsequent works may not receive copyright protection.) However, how efficiency of the machines is may not always deprive the quality of originality or *authorship* status unless it is proven that, in the creation of such subsequent works, the creativity and role of the creator was not sufficiently engaged in the digital works' form and content.[166]

Even though the issue of *authorship* and originality are highly involved in the protection of derivative work, particularly in the digital era, the definition of author[167] is still unclear in many jurisdictions. The US, for

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[164] *S.T.R. Industries v. Palmer Industries* 1999 WL 258455 (N.D. Ill. April 9, 1999), See also *Burrow-Giles Lithographic co. v Sarony* 111US 53(1884)

[165] Ginsburg p1074

[166] Ibid

[167] Discussed further in chapter III

example, has never provided any explicit meaning of 'author' or '*authorship*' whereas the UK has offered the definition in some categories of copyright work.[168] In general, the UK copyright law provides that *'Author, in relation to a work, means the person who creates it.'*[169] The person who creates works hence differs in each category of work such as in literary work, sound recording, film, broadcast, and typographical arrangement.[170] Even though the term 'author' applies separately to each work, the meaning of 'creation' has never been clearly defined. Therefore the ambiguity of 'who is the author' of a work still remains.[171]

In conclusion, in case of the original work which was created in a non-digital format and later be altered either by its owner or the third parties and then stored into a digital format, the subsequent work received after the alteration will not be qualified as derivative works unless the criteria of *authorship* and originality has been proven.

This also applies *vice versa* to the original work which was originally created in a digital format but later was altered and stored in physical material or tangible medium, either by its owner or the third parties. Unless the criteria of *authorship* and originality have been proven, those works merely transformed from digital format into tangible medium will not be qualified as derivative work.[172]

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[168] Ginsburg pp1069-1070

[169] CDPA 1988, section 9(1)

[170] CDPA 1988, section 9(2)

[171] Ginsburg p1070 The issue about 'originality and creativity and authorship' will be discussed further in chapter III

[172] See relevant example in Lizzie Plaugic, 'The story of Richard Prince and his $100,000 Instagram art' (*The Verge*, 30 May 2015) <http://www.theverge.com/2015/5/30/8691257/richard-prince-instagram-photos-copyright-law-fair-use > accessed 25 June 2015 ' and Alex Needham, 'Richard Prince v Suicide Girls in an Instagram price war' (*The Guardian*, 27 May 2015)

In such case that *authorship* and originality have been proven in the subsequent work, the protection of digital derivative work which derived from such kind of 'altered' original work will therefore fall within the general requirements of protection which has already been discussed earlier.[173]

However, it is noteworthy that, in the digital era it is not only the criteria of '*authorship* and originality' that play an important role in the copyright protection of digital derivative work, but there is another criteria of 'transformativeness' which also make a work qualified as derivative or non-derivative as well.[174]

**(2) The original work which was originally created and stored in a digital format**

As discussed earlier, the '*authorship* and originality' are the important criteria for copyright protection of derivative work in the digital era.[175] In this case even though the meaning of originality seems almost comprehensive, the definition of 'author' of digital work remains unclear in many jurisdictions.

The US, for instance, does not provide any explicit meaning of author. Not only the non-digital original work, the term 'author' remains ambiguous as well for the original work which was originally created and stored in a digital format.

The UK, on the other hands, attempts to create the scope of author to different kinds of works. As for the digitally created works such as literary, dramatic, musical or artistic work which is computer-generated, the UK

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<http://www.theguardian.com/artanddesign/2015/may/27/suicide-girls-richard-prince-copying-instagram> accessed 25 June 2015

[173] See (1)-(4) pp41-43

[174] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[175] And that does not exclude transformativeness. See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

copyright law declares that the author of such works is *'the person by whom the arrangements necessary for the creation of the work are undertaken.'*[176] Even though the term still remains unclear here is that what would be identified as 'arrangement', the UK seems to apparently agree, however, that in case of a computer-generated work, the most advocated author is neither a human nor a juridical person. But since the machines cannot be the right owner, the UK therefore applies the right to the most appropriate right owner which are either a human, a juridical person, or a corporation, depending on the proof of the invested skill, labour and judgment.[177]

Accordingly, the original work which was originally created and stored in a digital format will be protected as copyright work if it meets the criteria of *authorship* and originality as discussed above.

Thus, the protection of digital derivative work which derived from such kind of 'protected' original work will therefore have to follow the general requirements of derivative work's protection as discussed earlier.[178]

[176] CDPA 1988, Section 9(3)

[177] *Express Newspapers Plc V Liverpool Daily Post & Echo Plc And Others* [1985] 1 WLR 1089 (Ch) (decided under the previous legislation but is still applicable today) establishes that copyright can subsist in computer-generated works. However, the role of the computer was only as instrumental, as Whitford J ruled that *'The computer was no more than a tool'* and *'it would be to suggest that, if you write your work with a pen, it is the pen which is the author of the work rather than the person who drives the pen'.* The person who was the author in this case, therefore, was the programmer.
Also in *Nova Productions Ltd v Mazooma Games Ltd [2006] EWHC 24 (Ch)* it was held that the author of the composite frames was Mr. Jones who *'is the person by whom the arrangements necessary for the creation of the works were undertaken'*. The player of the game was not the author, because *'His input is not artistic in nature and he has contributed no skill or labour of an artistic kind. Nor has he undertaken any of the arrangements necessary for the creation of the frame images. All he has done is to play the game.'* Ginsburg p1070. See also Justine Pila & Andrew Christie, 'The Literary Work within Copyright Law: an Analysis of its Present and Future Status' (1999) 13 I.P.J. 133. 156

[178] See (1)-(4) pp41-43

Regarding the four points of derivative work's protection mentioned above,[179] the protection of derivative work in the digital era still remains obscured in many areas.

**1) Such work needs to be qualified under the definition of derivative work specified in Article 2(3) of the Berne convention; i.e. a translation, adaptations, arrangements of music and other alterations of a literary or artistic work.**

*Meaning of derivative work in the digital era:* The potential problems in the digital environment are, for example; 1) whether the meaning of translation, adaptations, arrangements of music, and other alterations of a literary or artistic work are constant in the digital environment? And 2) what kinds of digital and online activities would be qualified as creating a derivative work?

According to Article 2(1) of the Berne convention, there aremany types of original works which are potentially created and stored in a digital format and later developed into digital derivative works. Those works include but not limit to, for example; literary works, musical works, cinematographic works, and photography works which includes pictorial works and works of drawing and applied art. Therefore, it could be inferred that the scope of the meaning of derivative works in the digital environment involves only the alteration of these four types of work which are stored and disseminated in a digital format. These are: literary works, musical works, cinematographic works (or audiovisual works), and photography works (or images).[180]

[179] See (1)-(4) pp41-43

[180] See the discussion about these works in association with the activities of the three parties in the online digital environment in chapter III

Fundamentally, only borrowing substantial parts and making alteration of these works will not provide subsequent works with derivative work copyright protection. The use, in addition, needs to be legally borrowed under the limitation and exception of copyright infringement (transformativeness)[181] as well.

In particular, some forms of computer and internet activities in the user-generated content (UGC) [182] environment, although do not create derivative works themselves, could be considered as parts of making digital derivative works, for example:

**Browsing**[183] **–** Usually browsing a webpage for purpose of access to the online digital works (literary works, musical works, audiovisual works, and images) does not constitute making derivative works. On the other hand, the act of browsing online digital work is generally considered as making temporary reproduction of the works, which is exempted from copyright infringement under the RAM copy doctrine.[184]

**Linking** [185] **–** Ordinary linking and deep linking [186] on a webpage usually does not create derivative works. [187] On the other hand, the court

[181] *Perfect 10, Inc. v. Amazon.com, Inc.* 508 F3d 1146 (9th Cir 2007)

[182] User-Generated Content (UGC) or User-Created Content (UCC) is the digital environment that allows internet users to create and share content outside of a professional routine and organization. It emphasises the major roles of the internet users as the 'amateur creators' (see further discussion about this in chapter III)

[183] Browse: *'To examine the contents of a large data set, especially when locating and retrieving information with a search strategy that cannot be predicted at the outset, or possibly with no search strategy at all'* I. C. Pyle and Valerie Illingworth, *A Dictionary Of Computing* (4th ed. edn, Oxford University Press 1996) p54

[184] See the discussion about RAM Copy Doctrine in B. FIXATION

[185] Link: *'General term used to indicate the existence of communications facilities between two points',* Hyperlink: *'A highlighted word, phrase, or image in the display of a computer document which, when chosen, connects the user to another part of the same document or to different document (text, image, audio, video, or animation). In electronic documents, these cross references can be followed by a mouse click, and the target of the hyperlink may be on a physically distant computer connected by a network or the internet.'* McGraw-Hill, *Dictionary Of Computing & Communications* (6th edn, The McGraw-Hill Companies 2003), p213, 176

found that the act of in-line linking[188] could possibly constitute derivative works.[189] Even though the court's decisions in this filed is still unclear, the concept also apply to framing[190] where the interpretation is even more problematic.[191]

**File sharing**[192] **-** From Napster[193], Grokster[194] to BitTorrent[195], Newzbin[196] and the Pirate Bay[197],even though the persons who involve in file

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[186] Deep linking: *'is the process of pointing a visitor to a specific page in a website through the use of that page's link instead of that of the home page. When the user clicks on that link, he/she is taken directly to a page deeper into the website.'* 'Deep linking' (*Techopedia*) <http://www.techopedia.com/definition/23356/deep-linking> accessed 7 July 2015, See also *Ticketmaster v. Microsoft*, United States District Court for the Central District of California, Civil Action Number 97-3055DPP

[187] Lydia Pallas Loren, 'The Changing Nature of Derivative Works in the Face of New Technologies' (2000) 4 Journal of Small & Emerging Business Law 57 pp67-69

[188] In-line linking: *'refers to a link within a web page which causes content from another website to be automatically loaded onto the web page. To the user, the content from the other website appears to be part of the web page.'* 'In - Line Linking' (*IT Law Wiki*) <http://itlaw.wikia.com/wiki/In-line_linking> accessed 7 July 2015

[189] *Kelly v. Arriba Soft Corp.* 336 F3d 811 (9th Cir 2003) and *Perfect 10, Inc. v. Amazon.com, Inc.* See also *Svennson v. Retriever Sverige AB* (C-466/12) Although there might be a number of different definitions amongst each activity of linking in terms of creating a derivative work as provided above, it is noteworthy from the CJEU's decision in *Svensson* case that the act of 'hyperlinking' which includes every type of provision of 'linking' on a website does not constitute communication to the public. This is because there is no 'new public' or *'… a public that was not taken into account by the copyright holders when they authorised the initial communication to the public …'* However, there are some dissent opinions from legal scholars on this specific issue of 'new public' as could be found form the opinion of Jan Rosen, Silke von Lewinski, and Lionel Benlty discussed in the BLACA (The British Literary and Artistic Copyright Association) Conference on 13 November 2014 (http://the1709blog.blogspot.com/2014/11/blaca-interesting-evening-trying-to.html) accessed 19 Oct 2015 and the opinion of Jan Rosen presented at the Fordham IP Conference on 8 April 2015 (http://ipkitten.blogspot.com/2015/04/the-cjeu-new-public-criterion-national.html) accessed 19 Oct 2015. See further discussion about this issue in part VI of chapter V.

[190] Framing: *'is a technique whereby one website's pages are made to appear in a smaller window inside another website's page.' 'Framing' (IT Law Wiki) <http://itlaw.wikia.com/wiki/Framing> accessed 7 July 2015*

[191] The decision in *Futuredontics Inc. v. Applied Anagramic Inc.* 45 USPQ 2d 2005 (CD Cal 1998) which the court referred to two prior cases: *Mirage Editions, Inc v. Albuquerque ART. Company 856 F2d 1341 (9th Cir 1988)* and *Lewis Galoob Toys Inc., v. Nintendo of America Inc.* and in the end failed to ascertain whether framing is infringing the right of making derivative work of the framed site author.

[192] File sharing: *'The common use, by two or more users, of data and program files, usually located in a file server.'* McGraw-Hill, p141

[193] *A&M Records, Inc. v Napster, Inc.* 239 F3d 1004 (2001)

[194] *MGM Studios, Inc. v. Grokster, Ltd.* 545 US 913 (2005)

sharing activities via either P2P or Bittorrent technologies could be held liable for secondary copyright infringement, the act of file sharing itself does not produce any derivative works nor infringe the right of making derivative works of the original author. *Nevertheless, the files obtained from the sharing system are copies of the original works. They are materials which are available for alteration or reproduction to derivative works.*

**Uploading**[198] **and downloading**[199] **–** In general, the persons who upload and download copyrighted works without authorisation of the original author could be liable for copyright infringement due to such acts violate the exclusive rights of reproduction[200] and communication to the public[201] of the original author.[202] Nevertheless, uploading and downloading generally does not make any change to the original work. Via uploading or downloading files, therefore, neither uploaders nor downloaders are creating any derivative works. *The files obtained from downloading, on the other hands, are materials available for alteration or reproduction to derivative works.*

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[195] There are thousands of cases in the US in recent years. Ernesto, 'Judge Understands BitTorrent, Kills Mass Piracy Lawsuits' (*TorrentFreak*, 30 January 2014) <https://torrentfreak.com/judge-understands-bittorrent-kills-mass-piracy-lawsuits-140130/> accessed 7 July 2015, See, for example, *Killer Joe Nevada, LLC, v. Does 1-39* and *VPR Internationale v. Does 1-1017*

[196] *Twentieth Century Fox Film Corporation, Universal City Studios Productions LLLP, Warner Bros. Entertainment Inc., Paramount Pictures Corporation, Disney Enterprises, Inc., Columbia Pictures Industries, Inc. v Newzbin Limited* [2010] EWHC 608 (Ch)

[197] *Dramatico Entertainment Ltd and others v British Sky Broadcasting Ltd and others* [2012] EWHC 268 (Ch)

[198] Upload: *'To transfer or copy data from a smaller computer, such as a microcomputer to a large computer' McGraw-Hill* p397

[199] Download: *'To transfer a program or data file from a central computer to a remote computer or to the memory of an intelligent terminal'* ibid p111

[200] This is even though the temporary making reproduction of content for electronic transmission in a computer machine is acceptable and thus exempted from copyright infringement under Article 2 and 5 of the Directive 2001/29/EC. See. *Infopaq International A/S -v- Danske Dagblades Forening*, Case C-5/08 (Economic Rights will be discussed further in Chapter III)

[201] Economic Rights will be discussed further in Chapter III

[202] *Dramatico Entertainment Ltd and others v British Sky Broadcasting Ltd and others*

**Streaming** [203] - Unlike traditional downloading, the streaming technology allows users to view online contents in real time without having to download or copy the original files into the computer system. [204] While uploading a file for streaming may infringe the exclusive rights of reproduction and communication to the public of the original author, it is unlikely that streaming itself is an act of making derivative works. *However, the streaming platform could potentially be an available space for distribution of those recreated derivative works.*

**Screen capturing** [205] **-** In practical, screen capturing may not be considered as making derivative works because it merely creates a copy of the screen that is being exposed to the user. *Only when those screen shots are combined with some alterations that they could be qualified as a type of derivative works.* This is basically because those alterations modify the content and creativity of the original works i.e. designs of websites, advertisements, photos, games displays etc.[206]

Therefore, it could be construed that generally these common internet activities, from *browsing* to *linking*, *file sharing*, *uploading* and *downloading*, *streaming*, and *screen capturing* of the digital works do not constitute digital derivative works themselves. However, some particular

[203] Stream: *'A collection of binary digits that are transmitted in a continuous sequence, and from which extraneous data such as control information or parity bits are excluded.'* McGraw-Hill, p362 (For example, On-demand streaming and live streaming)

[204] Maurizio Borghi, 'Chasing Copyright Infringement in the Streaming Landscape' (2011) 42(3) International Review of Intellectual Property and Competition Law IIC 316, p327

[205] Screen capture or screen shot: *'A digital image or file containing all or part of what is seen on a computer display.'* McGraw-Hill p332

[206] *Micro Star v. Formgen Inc.*

activities such as *downloading*, *streaming*, *and screen capturing* are the acts which could be the basis of making subsequent derivative works.[207]

**2) Whether the author of such subsequent work receives official authorisation from the original author, or the work is adapted by the original author himself**

*Authorisation in the digital era:* As Lessig pointed out in his lecture that the new technology has changed the way people enjoy creative works. From 'free culture' to 'licensed culture' in the old copyright scheme, the digital technology has now made online licensing and authorisation of making derivative work even more complicated.[208] Thereby the Creative Commons licenses emerged.[209]

**3) Whether such works meet qualification of originality**

*Originality and authorship in the digital era:* Taking into account that the value of *authorship* and originality is highly relevant and essentially ambiguous for the non-digital derivative works developed in the analogue world, such issue is even more blurred for those derivative works created and published under the digital environment.

First of all, in the online context it is likely impossible to identify who is the real original author or the copyright owner of the works unless a specific name is clearly attributed or specified on such works. However, in many cases, such name even though deliberately provided by either authors or copyright owners could be easily vanished, modified or removed by others

[207] See the discussion about these activities in association with the four types of online digital work (literary works, musical works, audiovisual works, and images) in the online digital environment in chapter III

[208]Lawrence Lessig, 'Dunwody Distinguished Lecture in Law: The Creative Commons' (2003) 55 Florida Law Review 763 p770-772

[209] 'What is Creative Commons?' (*Creative Commons*) <http://creativecommons.org/about > accessed 29 June 2015 See further discussion about Creative Commons in D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

who are using competent digital technologies. Then again, the digital technology has now made those names, even explicitly appeared on the created works, unsatisfiable.[210]

In case of making derivative works, even though the authorisation from the original authors or copyright owners is required for not infringing the original works, seeking legal consents from the original authors in order to create and distribute derivative works in the digital environment could be inevitably problematic for the derivative works' future creators. Failing to achieve authorisation from the copyright owner could effectively force the derivative works author into risks and difficulties.

In this example Michael Yon, an American writer and photographer, has threatened the internet users who illegally used his photograph with copyright infringement.[211] Changing parts of the photo and its message, in this case, is against the will of the copyright owner. According to his attorney *'Mike's not a political guy. Mike does not want the photo used for any message. He wants it to stand alone.'*[212]

Regarding the use of the original photograph, Yon also emphasises in his own website that *'Protecting this photo has become at times a full-time*

[210] See chapter III

[211] Michael Yon's Facebook page on 18 July 2012 states that *'Illegal Use of My work: Thank you to the kind folks who continue to alert me to this. I first became aware about eight hours ago. Typically in cases such as this, the infringer goes one of several courses. The wild-eyed websites, the violent protestors for peace, typically will tell me to pound sand and that they will do what they damn well please with my work. (Like Michael Moore -- he might be big and rich, but that is a huge disadvantage in these fights; the richer they are, the worse it can get, and money and power has not saved anyone yet in these fights.) I prefer those responses the most because they put into writing that they are aware of the illegal act, and they intend to flaunt federal law and Constitutionally protected copyrights. If they stop using it, all will be fine in this case. If they get indignant, they can help fund my operation. Will forward this to the attorney. Thank you again for the heads up.'* Michael Yon, 'Illegal Use of My work' (*Facebook*, 18 July 2012) <https://www.facebook.com/photo.php?fbid=10150970071000665&set=a.235978145664.1-+%20-35781.207730000664&type=1&ref=nf> accessed 29 June 2015

[212] David Postman, 'Photographer says Iraq photo misused in Burner flier' (*The Seattle Times*, 31 October 2006) < http://blog.seattletimes.nwsource.com/davidpostman/archives/2006/10/photographer_says_iraq_photo_misused_in_burner_flier.html> accessed 29 June 2015

*job'* and that he regularly turns down those requests to use this photo if such use could earn money. He also put '© *Micheal Yon 2005'* for all rights reserved at the bottom right of the photo.[213] Nevertheless, anyone who could access his website can download the photo at will.[214] Apparently, the photo appears to be on many websites such as Flickr.[215] The rights to use the photo, however, was taken off and reposted under different names of users and different types of copyright licenses such as Creative Commons' by-nc-sa,[216] all right reserved,[217] or even misplaced under the name of another as his favourites.[218]

This example highlights the difficulties of using digital works to produce digital derivative works. In order to escape from copyright infringement issues, the future creators, which are mainly the internet users, are troubling not only on finding which exclusive rights are approved by the authors, but also seeking the proof of the genuine *authorship* and originality.[219]

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[213] Michael Yon, 'Memorial Day Weekend' (*Michael Yon Online Magazine*, 26 May 2006) <http://www.michaelyon-online.com/memorial-day-weekend.htm> accessed 29 June 2015

[214] Internet users can right-click and download the photo under the file name 0060.jpg. The owner does not enable those basic tools that prevent photos from being downloaded such as Javascript right click disable or hiding image source code. These tools, however, do not prevent photo from screen capturing.

[215]'The home for all your photos.' (*Flickr*) <http://www.flickr.com/> accessed 25 June 2015

[216] See, for example the post of a flickr user under the username of Sixsteps. Sixsteps, 'American Soldier With Child' (*Flickr*) <https://www.flickr.com/photos/sixsteps/2695066602/in/photostream/> accessed 25 June 2015

[217] See, for example the post of a flickr user under the username of mrmonkee88. Mrmonkee88, 'American Soldier With Child' (*Flickr*) <http://www.flickr.com/photos/mrmonkee88/2042757758/in/photostream/> accessed 29 June 2015 and the username of Joe Tan. Joetan, 'American Soldier With Child' (*Flickr*, 6 May 2005) <http://www.flickr.com/photos/joetan/12641294/> accessed 29 June 2015

[218]Crystal Schaefer, 'American Soldier With Child' (*Flickr*, 14 October 2013) <http://www.flickr.com/photos/edward_cullen/favorites/with/12641294/lightbox/> accessed 25 June 2015

[219] See chapter III

**4) The subsequent work may need to satisfy the condition of *fixation*[220]**

*Fixation in the digital era:* The issue of fixation in the digital environment will be discussed further in the next issue.[221]

## B. FIXATION AND IDEA/EXPRESSION DICHOTOMY

### B.1. International Regulations

In respect of '*fixation*', according to Article 9(2) of TRIPS and Article 2(2) of the Berne Convention 'works' in general or any specified categories of works shall not be protected under the law of the countries of the Union 'unless they have been fixed in some material form.'[222] On the other hand, it is not anywhere stated in the Berne Convention that, in order to be protected, a work may need a qualification of '*idea/expression dichotomy*'[223]. The concept of *idea/expression dichotomy* clearly appears later in Article 9(2) of TRIPS, which provides that '*Copyright protection shall extend to expressions*

[220] Will be discussed further in the next topic

[221] *Williams Electronics, Inc. v. Arctic International, Inc. 685 F2d 870 (3d Cir 1982)* the defendant argued that the participation of the game player results in the movable images on the video game. These images could not be granted copyright protection because they are not fixed and that the game player is the co-author of what appears on the screen. The court held that, *'The fixation requirement is met whenever the work is "sufficiently permanent or stable to permit it to be ... reproduced, or otherwise communicated" for more than a transitory period.'* Also *'there is always a repetitive sequence of a substantial portion of the sights and sounds of the game, and many aspects of the display remain constant from game to game regardless of how the player operates the controls.'* Therefore in this case the work is deemed fixed when it is embodied on the ROM.

[222] Berne 1971, Article 2(2)

[223] Sterling p249 demonstrates that *'the idea/expression concept (the so-called idea/expression dichotomy) propounds that the mere idea of the author is not protected, only the expression of the idea. …The line between unprotectable idea and protectable expression cannot be defined in precise terms, and must be judged from case to case.'*

*and not to ideas, procedures, methods of operation or mathematical concepts as such.'* [224]

Also, it is important to note that there are different standards of interpretation amongst countries regarding these issues.

**B.2. National Level**

In general, while a work may likely to satisfy the criterion of *form*at the time it is deliberately expressed, common law countries also require the work be *fixed* in order to acquire copyright protection.[225] For example in the US and the UK, the works will not be protected unless they are *fixed* in some form of material. Civil law countries, on the contrary, do not require fixation as the criterion of protection. [226] Most importantly, the concept is distinctively implemented in different countries.

**Common Law System: the US and the UK**

In the US, Section 102(a)[227] provides 'fixation' as a fundamental requirement for copyright protection whereas the scope of fixation could be found under Section 101.[228] Generally fixation applied to a work of which its embodiment is sufficiently permanent or stable, to a degree that might allow it to be perceived, reproduced, or communicated for a period of more than transitory duration.[229]

[224] Ibid p251

[225] Ibid p329

[226] Ibid p330

[227] 17 USC §102 (a) *'Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.'*

[228] Sterling p332

[229] See 17 USC §101

Furthermore, Section 102(b)[230] also recognises another condition of protection which is generally referred as *'idea expression dichotomy'*. Under this Section, there are three aspects which are excluded from copyright protection under the US law; 1) idea, concept, principle, 2) procedure process, system, method of operation, and 3) discovery.[231] The concept was early developed in 1879 in the case of *Baker v Selden*[232] where the court ruled that, since '*Charles Selden, by his books, explained and described a peculiar system of bookkeeping, and illustrated his method by means of ruled lines and blank columns… Whether the art might or might not have been patented is a question which is not before us. It was not patented, and is open and free to the use of the public. … [B]lank account books are not the subject of copyright, and that the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account books, ruled and arranged as designated by him and described and illustrated in said book*.' [233]

However, it is difficult to create a boundary between the content which merely delivered the idea and the content which may possibly be qualified as expression.[234] For this purpose, a test was proposed by the court in *Whelan v Jaslow* [235] that '*…the purpose or function of a utilitarian work*

[230] 17 USC §102 (b) *'In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.'*

[231] Sterling p250

[232] *Baker v Selden* 101 US 99 (1879)

[233] Sterling p249

[234] Ibid p250

[235] *Whelan Assocs., Inc. v. Jaslow Dental Laboratory, Inc.* 797 F2d 1222; 1240 (3d Cir 1986); 479 US 1031 (1987)

*would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea…'*[236]

In the UK, Section 3(2)[237] of Copyright, Designs and Patents Act 1988 also emphasises that copyright does not exist in a work unless it is recorded in writing or otherwise.[238] This is about *fixation*. Even though the concept has been in controversial (on the basis of common law copyright)[239] for many years from the decision of *Millar v Taylor*[240]to *Walter v Lane*[241], finally it has been confirm in the Act of 1988 that copyright exists in the work which is *fixed* in some forms.[242] In respect of *idea/expression dichotomy*, on the other hand, the concept have never been in any specific provision or context of UK copyright system until 1986, in *Plix Products v Frank M. Winstone Ltd.*[243] where Justice Pritchard J. discussed the distinction between the unprotected idea and protected expression, provided that *'So it is true to say…that copyright does extend to the protection of ideas—not to basic concepts, but to*

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[236] Sterling p250

[237] CDPA 1988, Section 3(2) *'Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise; and references in this Part to the time at which such a work is made are to the time at which it is so recorded.'*

[238] Sterling p330

[239] See discussion about common law copyright in chapter II

[240] *Millar v Taylor (1769) 4 Burr 2303; 98 ER 201* . Lord Mansfield demonstrated that *'I use the word 'copy' in the technical sense in which that name or term has been used for ages, to signify an incorporeal right to the sole printing and publishing of somewhat intellectual, communicated by letters ... The property in the copy ... is equally an incorporeal right to print a set of intellectual ideas or modes of thinking, communicated in a set of words and sentences and modes of expression. It is equally detached from the manuscript or any other physical existence whatsoever.'*

[241] *Walter v Lane [1899] 2 Ch 749; [1900] AC 539* the House of Lords confirmed that there is no copyright protection granted to Lord Rosebery on his speech due to his failure to satisfy the requirement of writing. On the other hand, the reporter could be regarded as the author of the reports and could have copyright protection because: *"A reporter's art represents more than mere transcribing or writing from dictation. To follow so as to take down the words of an ordinary speaker, and certainly of a rapid speaker, is an art requiring considerable training, and does not come within the knowledge of ordinary persons"*

[242] David J. Brennan and Andrew F. Christie, 'Spoken Words and Copyright Subsistence in Anglo-American Law' (2001) Intellectual Property Quarterly 1 pp309-349

[243] *Plix Products v Frank M. Winstone Ltd.* (1986) FSR 63 , at 92-95

*the ideas which are applied in the exercise of giving expression to basic concepts. It is equally true to say…that copyright subsists only in the form of expression and that infringement occurs only when such forms are copied.*[244]

As aforementioned it could be acknowledged that the thesis have analysed *fixation* and *idea/expression dichotomy* altogether even though they are from different protection criteria.[245] This is because both have shown some coherence in many ways. In the UK, for example, even though the *idea/expression dichotomy* is not explicitly specified in the Copyright, Designs and Patents Act 1988, the concept does show some coordination with the notion of *fixation* which is one requirement of the copyright protection and derivative works.[246]This is to say, that the *idea/ expression dichotomy,* when applied, will help identify whether or not the idea of an author has been expressed at all. And if found that it is expressed, the next question would be that whether such expression will meet the statutory requirements of *fixation*.[247] The concept applies particularly not only to the protection of copyright work, but the *idea/expression dichotomy* also plays an important role in identifying the act of copyright infringement; whether the unprotected idea or the protected expression elements was taken from the work.[248] Nevertheless, even though both *idea/expression dichotomy* and *fixation* are

[244] Sterling p251 and Uma Suthersanen, 'Exclusion to Design Protection – A New Paradigm' in Adrian Sterling (ed), *Intellectual Property and Market Freedom* (Sweet & Maxwell 1997) p48

[245] See above Introduction : in US AND UK Copyright Law.

[246] Patrick Masiyakurima, 'The futility of the idea/ expression dichotomy in UK copyright law' (2007) 38 International Review of Intellectual Property and Competition Law 548 p550-552, 558

[247] Ibid p551

[248] Ibid p554-558

involved in some aspects, the concept of *fixation* is independent and does not rely upon the notion of *idea/expression dichotomy.*[249]

### B.3. Fixation, Idea/Expression Dichotomy and Derivative Works

When it comes to derivative works, the subsequently created works which borrow some parts from the previous copyrighted work, the question here is how the concept of *fixation* and *idea/expression dichotomy* applies?

In the UK, the *idea/expression dichotomy* itself, on one hand, supports the creation of derivative expressions.[250] The concept plays a useful role in facilitating the unauthorised use of parts of the copyrighted work; the parts which are merely an idea, not expression, and thus exempted from copyright protection.[251] Therefore the concept supports the idea of 'transformative use'[252] as well.[253] This could be seen from the decision in *Jone v. London Borough of Tower Hamlets* where the court stated that *'if the idea were protected at law that would prevent any subsequent person using that idea producing a variant'*. [254]

The relationship between UK fixation and derivative work, on the other hand, originally has its root from the common law copyright but is now following the requirement under Section 3(2) of the CDPA 1988.[255] Even

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[249] Yoav Mazeh, 'Modifying Fixation : Why Fixed Works Need To Be Archived To Justify The Fixation Requirement' (2009) 6 Loyola Law and Technology Annual 109 p112

[250] Masiyakurima p558 Referred to Woodmansee M, 'On the Author Effect: Recovering Collectivity' Martha Woodmansee, 'On the Author Effect: Recovering Collectivity' in Martha Woodmansee and Peter Jaszi (ed), *The Construction of Authorship: Textual Appropriation in Law and Literature* (3rd printing edn, Duke University Press 2006)

[251] Masiyakurima p558

[252] Even though the notion of transformative use does not appears in UK copyright regime. See Andrew Gowers, *Gowers Review of Intellectual Property* (Crown copyright 2006, 2006), 68 at 4.88 and Recommendation 11. See also D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

[253] Mazeh p112

[254] *Jone v. London Borough of Tower Hamlets* [2001] RPC 407, 418-419

[255] Brennan and Christie Supra note 242

though there is no explicit provisions regarding protection of derivative works under the UK 1988 Act, but given that subsequent derivative work is qualified under Section 3(2) of the Act as a type of literary, dramatic or musical work,[256] such derivative work may need to satisfy the requirements of *fixation* before receiving copyright protection as well.

In the US, the qualification of fixation is also one of the requirements for a derivative work to be protected. This is because the contexts of section 103 (subject matter of copyright protection in derivative works) needed to be read in conjunction with the general subject matter of copyright protection under section 102. Whereas section 103(a) states that *'[t]he subject matter of copyright as specified by section 102 includes...derivative works,'* section 102(a) specifically requires the work of authorship to be *'fixed in a tangible medium'* in order to be protected.[257]

On the other hand, according to the wording of section 106(2)[258] there are some arguments that the US Copyright Act also requires a derivative work to be *fixed* in order to be infringing.[259] However, because of the confusion between the two words; *'create'*[260] which is clearly defined and used for

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[256] Some types of works such as artistic works do not require the qualification of fixation because naturally they are not created separately from the medium; instead those works are usually fixed by their authors in some forms. Mazeh p115

[257] Tyler T. Ochoa, 'Copyright, Derivative Works And Fixation: Is Galoob A Mirage, Or Does The Form(Gen) Of The Alleged Derivative Work Matter? Symposium Review: The Digital Challenge to Copyright Law' (2004) 20 Santa Clara Comptuer & High Tech LJ 991 p1000, See also at footnote 41 p1000

[258] 17 USC §106 (2) *'Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:(2) to prepare derivative works based upon the copyrighted work;'*

[259] Ochoa p1000, at footnote 42 referred to Melville B. Nimmer and David Nimmer, Nimmer on Copyright, §8.09[A], at 8-142 (2003) (*'Absent any compelling need to depart from the plain language of the statute, both doctrine and policy incline to the same result .... [Therefore,] fixation should be required to infringe the adaptation as well as the reproduction right.'*)

[260] 17 USC §101

purposes of this Act, and *'prepare'*[261] which is used in some other contexts and left undefined, it is suggested that the legislators intended to assert that the right to prepare derivative works could be infringed without agreeing on any fixation of the copyrighted work.[262]

Therefore, both *idea/expression dichotomy* and fixation are involved as conditions for protection and infringement of derivative works. The discussion here will focus mainly, however, on fixation. This is because, regarding the right of making derivative work, the *idea/expression dichotomy* plays an important role primarily at the first stage of creativity; to identify between the unprotected *idea* and the protected *expression*, whereas the fixation comes at the final stage where such *expression* is *fixed* in some tangible medium/material forms and ready to be transformed[263] or adapted[264] to subsequent derivative works. Most importantly, fixation will identify the *fixed* parts of *expression* and thus create the boundaries for the following authors on accessing and using parts of the prior works.[265] In addition, based on that instruction, fixation will enable the original authors the powers to sue the following authors for copyright infringement[266] even though in some jurisdiction infringement of right of making derivative work will not require fixation.[267]

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[261] 17 USC §106 (2)

[262] Ochoa p1000

[263] 17 USC §101

[264] CDPA 1988, Section 16 (1)

[265] There are differences between the US and the UK approaches on this issue, however. Before the third party would access the prior work, the UK requires that the work is fixed and does not focus on who is the fixer. On the contrary, the US approach focuses mainly on the identity and authority of the fixer. Mazeh pp125-126

[266] Ibid p112

[267], *Copyright Law Revision (House Report No. 94-1476)* at 62 *'The exclusive right to prepare derivative works, specified separately in clause (2) of section 106, overlaps the exclusive right of reproduction to some extent. It is broader than that right, however, in the sense that*

## B.4. Fixation and Idea/Expression Dichotomy in The Digital Era

### B.4.1 Copyrighted works

After the amendment of the US Copyright Act in 1976, the wordings of section 102 which primarily required a work be *'fixed in a tangible medium of expression'* were developed to include the meaning of *'now known or later developed'.*[268]Also the fixation is sufficient only if the work *'can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device'*, regardless of what forms, manners, or medium of the fixation would be. This is to deal with the changing of forms where the works could be *fixed* in the future.[269]

In addition, generally there are two kinds of works *fixed* according to the definition under section 101 of the US copyright law; first of all the works which, when firstly created, are primarily ***'fixed in tangible medium'.*** The two types of medium mentioned under section 101 are 'copies' and 'phonorecords'.[270] The meaning of copies and phonorecords are separately defined under section 101.[271] Secondly, the works *'…consisting of sounds, images, or both…'* which, when firstly created, are primarily ***'not fixed in tangible medium'*** but rather *'…are being transmitted.'* This type of works

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*reproduction requires fixation in copies or phonorecords, where as the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form.'*

[268] Ibid at 52

[269] *White-Smith Publishing Co. v. Apollo Co. 209 US 1 (1908)*

[270] 17 USC §101 *'A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, ...'*

[271]17 USC §101 *'"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.'*
*'"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.'*

would be regarded as *fixed* if the fixation is being made *'[in tangible medium][272]at the same time as the transmission.'*[273] The works include live broadcasts which are disseminated to the public in unfixed form but rather are concurrently recorded at the time of transmission.[274]

These standards apply, however, incoherently in the digital age, as it could be seen in the status of the work of arts stored in computer's RAM.[275] Despite the fact that the definition of 'fixation' under section 101 of the US copyright law would *'exclude from the concept purely evanescent or transient reproductions such as those projected briefly on a screen, shown electronically on a television or other cathode ray tube, or captured momentarily in the "memory" of a computer,'*[276] the decisions of *MAI,*[277] *Advanced Computer Services*[278]and *Religious Technology Center*[279] represented the different views of the courts regarding the fixation status of the work of arts stored in RAM. Nonetheless, the US Copyright Act 1988, in reversing the decision in *MAI*, has implicitly confirmed the 'RAM Copy Doctrine' that the work temporarily stored in RAM satisfies the requirement of fixation as appeared under section 117(c).[280] In 1998, the Digital Millennium Copyright Act (DMCA) enacted by

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[272] Added by author

[273], *Copyright Law Revision (House Report No. 94-1476)* at 53

[274] See Figure 1

[275] Random Access Memory (RAM): *'A computer storage device in which words may be 'written' (stored) or 'read' (recovered) in any order at random. Conventional internal memory' 'Random Access Memory ' (IT Law Wiki) <http://itlaw.wikia.com/wiki/Random_Access_Memory > accessed 7 July 2015*

[276], *Copyright Law Revision (House Report No. 94-1476)* at 52-53

[277] *MAI Systems Corp v. Peak Computer* 991 F2d 511 (9th Cir1993)

[278] *Advanced Computer Services of Michigan, Inc., v. MAI Systems Corp* 845 FSupp 356 (ED Vir1994)

[279] *Religious Technology Center v. Netcom On-Line Communication Services, Inc.,* 907 F Supp 1361 (ND Cal1995)

[280] 17 USC § 117 *'(c) Machine Maintenance or Repair.— Notwithstanding the provisions of section 106, it is not an infringement for the owner or lessee of a machine to make or authorize*

the US Congress in order to implement the WIPO Copyright Treaties[281] has also provided exceptions to ISP liabilities.[282] This again has reaffirmed the status of the RAM Copy Doctrine under the US jurisdiction.[283] Nevertheless, the subsequent decision in *Cartoon Network*[284] still reveals the dissenting view of the court regarding the fixation status of a work in RAM.

Defining digital information temporarily stored in RAM as *fixed* could lead to many controversial problems.

In the first place, the requirement of fixation created under the US law seems to serve two major purposes: first of all, it attempts to draw a distinction between the 'original works of authorship', and the tangible 'medium' in which the work is embodied.[285] Secondly, such definition, on one hand, supports the purpose of offering copyright protection to the 'work of

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*the making of a copy of a computer program if such copy is made solely by virtue of the activation of a machine that lawfully contains an authorized copy of the computer program, for purposes only of maintenance or repair of that machine, if—(1) such new copy is used in no other manner and is destroyed immediately after the maintenance or repair is completed; and(2) with respect to any computer program or part thereof that is not necessary for that machine to be activated, such program or part thereof is not accessed or used other than to make such new copy by virtue of the activation of the machine.*' Melissa A. Bogden, 'Fixing Fixation: The Ram Copy Doctrine' (2011) 43 Arizona State Law Journal 181 p197

[281] There are two treaties adopted on the last day of the WIPO Diplomatic Conference which was held in Geneva between 2 -20 December 1996: a Copyright Treaty and a Performances and Phonograms Treaty. However, there are disagreements amongst the Diplomatic Conference on a proposal to include the temporary storage of digital works in computer memory as 'the exclusive right of reproduction'. Therefore, the status of "browsing" the Internet under the copyright regime is still questionable in the international level. Bernt Hugenholtz, 'Two new treaties adopted in Geneva' (*Database on legel information relevant to the audiovisual sector in Europe*, 1997) <http://merlin.obs.coe.int/iris/1997/1/article7.en.html> accessed 29 June 2015
Nevertheless, it appears under Article 2 of DIRECTIVE 2001/29/EC that reproduction right includes *'…exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form…'* and under Article 5 Exceptions and limitations that *'Temporary acts of reproduction referred to in Article 2,which are transient or incidental [and] an integral and essential part of a technological process and whose sole purpose is to enable: (a) a transmission in a network between third parties by an intermediary, or (b) a lawful use of a work or other subject-matter to be made, and which have no independent economic significance, shall be exempted from the reproduction right provided for in Article 2.'*

[282] Digital Millennium Copyright Act (DMCA) 1998, section 512 Limitations on liability relating to material online

[283] Bogden p197

[284] *Cartoon Network LP, LLP v. CSC Holdings, Inc* 536 F3d 121 (2nd Cir 2008)

[285], *Copyright Law Revision (House Report No. 94-1476)* at 51-56

creation'.[286] On the other hand, it also frames the scope of the exclusive 'right of reproduction,'[287] 'right of distribution'[288], and 'right of display.'[289]

Therefore, in the analogue world, the relationship between works of authorship, the concept of fixation, the medium, copyright protection, and exclusive rights could broadly be drawn as follow;

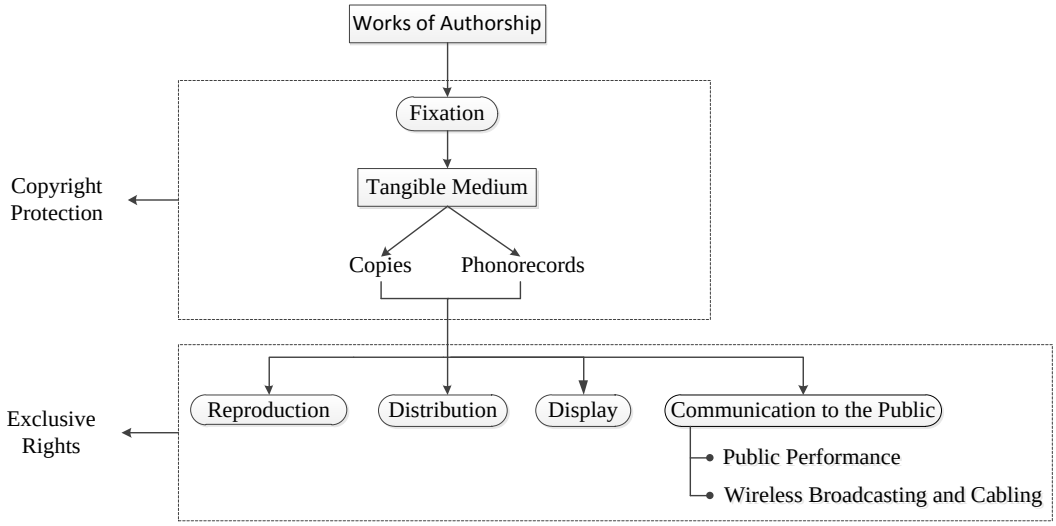



**Fig. 1** ***Relationship between works of authorship, the concept of fixation, the medium, copyright protection, and exclusive rights***

[286] 17 USC § 101 *'A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.*
*17 USC § 102 - Subject matter of copyright: In general (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.'*

[287] 17 USC § 106 *'Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords;'*

[288] 17 USC § 106 (3) *'to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;'*

[289] 17 USC § 101 *'To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.' and*
17 USC § 106 (5) *'in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly;'.* Ira L. Brandriss, 'Writing In Frost On A Window Pane: E-Mail And Chatting On Ram And Copyright Fixation' [1995] Copyright Society of the USA 237 pp239-240, and Ochoa pp996-1000

Accordingly, in the analogue world the idea of fixation is useful not only in the sense that it supports copyright protection of the works of authorship, but also preventing unauthorised: 1) ***reproduction*** (of the protected work) in a tangible medium, 2) ***distribution*** (of the tangible medium in which the work is borne within) and 3) ***display*** (of the copy of the protected work).

With regard to 4) the right of ***communication to the public***, this is the right that particularly deals with new medium technology which does not rely mainly on the protection of the use of the tangible copies of the work. Nevertheless, in order to be protected by the right a work is required to be *fixed* in some way[290] before the author could prevent others from using (public performance or broadcasting) of such recording in the presence of the public.[291]

According to figure 1 above, first of all, it should be noted that, in the analogue world, the benefit of the authors' creation relies heavily on the 'tangible medium' which is the major instrument to carry and transport the creativity of the authors. Protecting such work from unlawful ***reproduction***, ***distribution*** and ***display*** of such tangible material, theoretically, is not only about protecting the 'intangible value' of 'the authors' creation' but also protecting the economic benefits and the fruit of the labour of the original author which could be attained from such tangible property.

For example, the **Right of reproduction** prohibits making copies and phonorecords of the protected work. In fact, when the words 'copies and

[290] This type of works would be *'regarded as fixed if the fixation is being made [in tangible medium] at the same time as the transmission.'* , *Copyright Law Revision (House Report No. 94-1476)* at 53

[291] Sterling p441

phonorecords' are specified under the provision of law it emphasises an important idea that fixation is a 'requirement' for successful reproduction. Even though the fundamental idea of the provision is to prevent the work of creation from being copied by an unauthorised person, the economic profits of the author, nevertheless, lies mainly in the physical copy in which the work is *fixed* (which could be disseminated afterwards). Therefore, making copies of a work by having it *fixed* in a tangible medium (or in this case 'reproducing' it) would be infringing to the exclusive right of the author.

Secondly, the **Right of distribution** involves the right of the author to control dissemination of physical copies in which the work is purposely *fixed*. Whereas the reproduction right prevents the early step of unauthorised copying the protected work via making copies, the right of distribution prevent unauthorised dissemination of such copies (by sale or other transfer of ownership, or by rental, lease, or lending) afterwards regardless of whether the copies are made with or without authorisation. This exclusive right, again, aims at protecting the economic benefits of the author over the valued tangible properties that the works are contained within; the monetary benefit of which the author could earn from selling, transferring of ownership, or lending of such physical copies to others.

These views are true, at least, in the sense of the US law which sees copyright law as the tool to promote cultural creations and useful arts to society.[292] However, the idea may not be true in some jurisdictions where copyright law is recognised as natural rights and exclusive rights of the author. In that case, the work which is not *fixed* in tangible medium could also

[292] Brandriss p244

be offered copyright protection for purposes of protecting the value of the 'mark of the personality of the author'.[293]

Notwithstanding, when it comes to the digital age where the information temporarily stored in RAM could be deemed as *fixed* [294] for purposes of granting copyright protection, when looking at the side of exclusive right of reproduction of a use, a work does not necessarily need 'another' physical copy of RAM in order to meet the requirements of fixation and reproduction anymore. Additionally, in the digital environment it is also not the RAM as the physical property which would be distributed to public either with or without authorisation. Instead, it is the digital information that is stored within.

In fact, RAM functions as a temporary storage where digital information will be stored in a short period of time for purposes of computer operation before it gets vanished after the computer is turned off.[295] As long as the computer is on, the binary information stored in RAM will remain indefinitely. As a consequence, when the computer is operating, RAM is functioning as an important element to support the tasks of digital activities such as loading, running computer programs and browsing the internet. The digital information will be automatically and temporarily stored in RAM before a reproduction of such information will again be automatically made afterwards in order to allow the computer to perform successfully.[296]

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[293] 'Eiffel Tower', Cass. 1 civ., March 3 1992, Sterling p260

[294] At least under the US copyright law (17 USC § 101, 102 and 17 USC § 117 (c) and section 512 (a) of the DMCA 1998 on ISP's liabilities) *MAI Systems Corp v. Peak Computer* Bogden p197, See also the EU Directives (Article 5 (1) of Directive 2001/29 EC)

[295] Aaron Perzanowski, 'Fixing RAM Copies' (2010) 104 Northwestern University Law Review 1067 p1092

[296] Bogden pp189-190

Despite the fact that RAM possesses a different nature comparing to other tangible medium (copies and phonorecords) as mentioned above, it is noteworthy that RAM is now given the same meaning under the US copyright law as one type of tangible medium in which the works of authorship could be deemed *fixed*.[297] The relationship between works of authorship, the concept of fixation, the medium, copyright protection, and exclusive rights in the digital world under the US copyright system could broadly be drawn as follow;

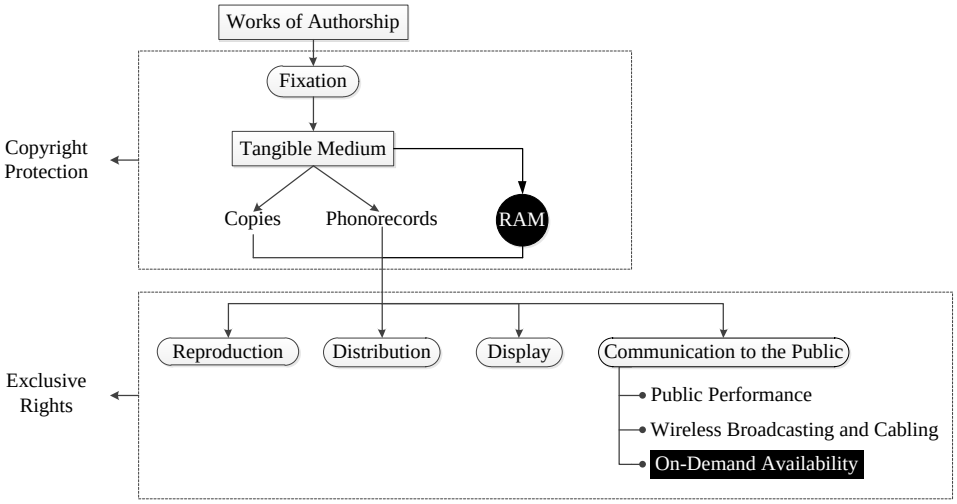



**Fig. 2** ***The relationship between works of authorship, the concept of fixation, the medium, copyright protection, and exclusive rights in the digital world***

It could be seen from figure 2 that since RAM is given a definition as a type of the tangible medium which the works could be deemed *fixed*. In this regard, the critical results in the digital environment will be as followed;

(1) Since RAM is given a definition as a type of tangible medium in which the works could be deemed *fixed,* every work of authorship that is

[297] At least under the US copyright law (17 USC § 101, 102 and 17 USC § 117 (c) and section 512 (a) of the DMCA 1998 on ISP's liabilities) *MAI Systems Corp v. Peak Computer* Bogden p197, See also the EU Directives (Article 5 (1) of Directive 2001/29 EC)

stored in RAM, even only in a limited period of time, will be eligible for copyright protection at least under the US copyright law, although it was not specified clearly under section 3(2) and section 178 of the UK copyright law.[298] In other words, every digital work (*literary works, musical works, audiovisual works, and images*) stored in RAM only for a transition period of time will be included in the scope of copyright protection; which means that those works would be protected by copyright[299] regardless of whether they would be stored longer in other kind of data storage[300] such as a hard disk.

(2) The protected works which once temporarily stored in RAM (regardless of whether they would be stored longer in other kind of data storage such as a hard disk) would be barred from any unlawful activities of other parties such as an unauthorised act of reproduction or distribution.[301] This idea is sufficiently applicable in the analogue world because of the nature of the tangible medium as the rival good, which means that an unauthorised reproduction or distribution of a tangible medium, for example a book or a CD, would affect the economic benefits of the original author upon his creation and creativity.

(3) Nevertheless, the idea is not well applicable in digital environment where the digital information of literary works, musical works, audiovisual works, and images could be 'reproduced' and 'disseminated' to

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[298] CDPA 1988, section 3(2) *'Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise; and references in this Part to the time at which such a work is made are to the time at which it is so recorded.'*
CDPA 1988, section 178 *'"writing" includes any form of notation or code, whether by hand or otherwise and regardless of the method by which, or medium in or on which, it is recorded, and "written" shall be construed accordingly'*

[299] Brandriss p239

[300] See chapter IV

[301] In the online context the right of display could be applicable as well to some type of copyright works such as literary work, motion pictures and images, but may not be useful to some works such as sound recordings and musical works. See Anthony Reese, 'The Public Display Right: The Copyright Act's Neglected Solution To The Controversy Over Ram "Copies" ', 2001 University Of Illinois Law Review1, pp86-87

public without relying on any physical property. This happens all the time when users are performing internet activities such as *browsing*, *linking*, *file sharing*, *uploading* and *downloading*, *streaming* or even *screen capturing*.[302] Therefore, every single internet activity performing by internet users, from the beginning of running a computer program until those digital works are made available to the online digital users, would likely cause copyright infringement because it is violation to the right of reproduction and right of dissemination of the original author over a work of her creation *fixed* in RAM.

(4) In such case, the laws, nonetheless, has excluded some internet activities from copyright infringement in order to allow general online systems to function properly. For example, it would not be violation of the right of reproduction if such act of making temporary reproduction in a computer system occurs solely for technology purposes, or in other words, happens mainly in order to support the computer operation system.[303] Also the US DMCA allows safe harbours for some internet intermediaries whose activities are involved under the RAM Copy Doctrine.[304] In addition, the right of distribution of the author is not guaranteed under the international copyright

[302] See chapter III

[303] Article 5 (1) of Directive 2001/29 EC. Also Recital (33) in the preamble to Directive 2001/29 provided that '*The exclusive right of reproduction should be subject to an exception to allow certain acts of temporary reproduction, which are transient or incidental reproductions, forming an integral and essential part of a technological process and carried out for the sole purpose of enabling either efficient transmission in a network between third parties by an intermediary, or a lawful use of a work or other subject-matter to be made. The acts of reproduction concerned should have no separate economic value on their own. To the extent that they meet these conditions, this exception should include acts which enable browsing as well as acts of caching to take place, including those which enable transmission systems to function efficiently, provided that the intermediary does not modify the information and does not interfere with the lawful use of technology, widely recognised and used by industry, to obtain data on the use of the information. A use should be considered lawful where it is authorised by the rightholder or not restricted by law.'* See also, Mihaly Ficsor, 'The Spring 1997 Horace S. Manges Lecture - Copyright for the Digital Era : The WIPO "Internet" Treaties' 21 Columbia-Vla Journal Of Law & The Arts 197 However, see case '*Public Relations Consultants Association Ltd v The Newspaper Licensing Agency Ltd & Ors'*[2013] UKSC 18 which was later confirmed by the Court of Justice of the European Union (CJEU) in Case C-360/13 *Public Relations Consultants Association v Newspaper Licensing Agency and Others*

[304] DMCA 1998, section 512 (a), Bogden pp197-198. See also, Articles 12-14 of the EC E-Commerce Directive

regulation. This is because the content of the right conflicts with the nature of the internet.[305]

(5) Therefore, it could be said that every work appears online is copyright protected, prevented from unauthorised use, and dependent upon at least one of these exclusive rights. Most importantly, these acts of reproduction and communication to the public could happen anytime regardless of making copies of the medium.[306]

Regarding the **right of reproduction**, basically in almost every case of online activities, it is not the medium itself which would be illegally transferred or copied, but the essence of the creative work. In such cases, only technical reproduction of the work for purpose of computer operation system is permissible and exempted from infringement under the law under the RAM Copy Doctrine.

In fact, not every internet activity involves deliberately making reproduction. This could be seen, for example, in case of *browsing* websites and viewing a web page by an individual user. The work appears on the site is

[305] Sterling p 433. See also the Agreed Statements concerning the WIPO Copyright Treaty 1996:Articles 6 and 7: *'As used in these Articles, the expressions "copies" and "original and copies," being subject to the right of distribution and the right of rental under the said Articles, refer exclusively to fixed copies that can be put into circulation as tangible objects.'* The Agreed statement concerning Articles 2(e), 8, 9, 12, and 13 of WIPO Performances and Phonograms Treaty: *'As used in these Articles, the expressions "copies" and "original and copies," being subject to the right of distribution and the right of rental under the said Articles, refer exclusively to fixed copies that can be put into circulation as tangible objects.' Recital 29 of the EC Information Society Directive 2001/29/EC: 'The question of exhaustion does not arise in the case of services and on-line services in particular.'*

[306] See also *Svensson and others v Retriever Sverige AB* (Case C-466/12); [2014] WLR (D) 67 Regarding the protection of the right of making available to the public, the ECJ has limited the scope of this exclusive right, holding that *'the provision on a site of a clickable link to a protected work published and freely accessible on another site has the effect of making that work available to users of the first site and that it therefore constitutes a communication to the public. However, since there is no new public, the authorisation of the copyright holders is in any event not required for such a communication to the public.'*
Finally, the court rules that *'(1) Article 3(1) of 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, must be interpreted as meaning that the provision on a website of clickable links to works freely available on another website does not constitute an 'act of communication to the public', as referred to in that provision. (2) Article 3(1) of Directive 2001/29 must be interpreted as precluding a Member State from giving wider protection to copyright holders by laying down that the concept of communication to the public includes a wider range of activities than those referred to in that provision.'* See also chapter III

not intentionally 'copied' by the person viewing the page according to the meaning of the law but rather is temporary reproduced in a RAM only for purpose of exploring the site.[307] This act, therefore, could possibly fall in the scope of technical reproduction exception based on the RAM Copy Doctrine as mentioned above.

However, it is noteworthy that such exception may not be applicable to those people who *download* digital copyrighted works from a web site to a personal computer since such act is referred as a purposeful making reproduction (regardless of whether the works is being saved to the hard disk after being *downloaded* or not). In fact, the act of making reproduction of the online digital works will not be entirely complete unless the *downloaded* files are saved, in other word *fixed*, into a medium, for example in a hard drive of the users' computers. Nonetheless, such act of *downloading,* whether the works is being saved to the hard disk after being *downloaded* or not, could possibly be defended under limitations and exceptions of copyright infringement or Fair Use Doctrine.[308]

In some other online cases the work could be transferred from persons to persons instead of connecting through a unique central server (such as web server). This is called a 'peer-to-peer file-sharing' system. In order to receive files and information, the system allows individual users to connect directly to other users and share files through a linking network. There are many types of file sharing applications which function on peer-to-peer networking such as Kazaa, LimeWire, Opera and BitTorrent etc. Even though such act could possibly be defended under the doctrine of fair use,

[307] *Religious Technology Center v. Netcom On-Line Communication Services, Inc., Public Relations Consultants Association Ltd v The Newspaper Licensing Agency Ltd & Ors* [2013] UKSC 18. Or it could be qualified under the fair use doctrine.

[308] See D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

another question happens is that whether merely *downloading* and viewing literary works, musical works, audiovisual works, and images via peer-to-peer network without saving them to hard disk is qualified as technical reproduction and therefore is safe under any means of limitation?

In addition, it is still in question for some file sharing applications such as BitTorrent where only binary components of the work will be *downloaded* from different users and later constitute a copy of the work. The work *downloaded* via BitTorrent does not come from a single source or disseminated as a whole work. Even though the technology itself is safe under the law but the question is left upon the individual users who view or *download* the work constituted from those binary bits, whether they are likely making reproduction of a work.[309]

These problems are all about the transformation of the work container from physical properties to nonphysical forms. As John Perry Barlow provided in *The Economy of Ideas* that in the past, most values lies in the conveyance of the work, not in the work conveyed. Even though the information in the digital age still requires some forms of physical appearance such as the hard disk storages, but those storages are merely bottles which have no concrete form. While there is yet not any successful new legal models to protect nonphysical digital transaction, protecting that new forms of property with old methods becomes more obviously impractical, and as a consequence, very inflexible.[310]

The arguments here focus mainly on the activities of web *browsing* and *file sharing* because they include the act of *downloading* the work. The

[309] See *'Malibu Media, LLC, v. Bui Michigan Western District Court'* Case No. 1:13-cv-00162

[310] John Perry Barlow, 'The Economy of Ideas' (*Wired*, Mar 1994) <http://archive.wired.com/wired/archive/2.03/economy.ideas.html> accessed 7 July 2015

activities are important because, as mentioned earlier in '**The Dynamic of Originality in Derivative Works',**[311] the files *downloaded* from *browsing* and *sharing* are materials which are ready to be modified, altered or reproduced to create new derivative works by other users.

(6) In addition, the exclusive rights of the copyright owner in the digital era have been extended to include other specific rights such as the right of making available to the public (on-demand availability right).[312] This increases online protection for the exclusive rights of the copyright owners.

(7) Finally, giving copyright protection to every work online will also distort the real value of copyright *ownership*; that the original creator of the work is the person who commonly owns copyright in the work. Every work appears online, since it is deemed as *fixed* in computer data storage, is granted copyright protection in some ways regardless of proving whether who is the original author of the work. This results in two major problems. First, the system fails to identify the real author of the work and therefore fails to offer economic benefit to the real original creators. Second, the system fails to advise others online users of who is the real owner of the copyrighted work. These users, thus, will not be safeguarded from copyright infringement of using the work for derivative purposes.[313] This will certainly affect the idea of promoting new creations to the market.

Individual internet users are, in some cases, immune from copyright infringement of the online works based on temporary reproduction exception or fair use. In some other cases, the targets for lawsuit are often likely to be

[311] See. A. 2 The Dynamic of Originality in Derivative Works

[312] Sterling

[313] See chapter III

Internet Service Providers (ISPs) as they are the person who actually have control over the works and therefore are worth suing.[314]

### B.4.2 Derivative works

Making derivative work online fundamentally involves two important rights: 1) the right of reproduction and 2) the right of making derivative work. In the digital environment users cannot make a derivative work without making reproduction of such work beforehand. Making reproduction of a work is the first step for users to create a copy of that work (for purpose of making change later). This could happen, in every online case, by mean of *downloading*.

*Browsing* and *file sharing* are the important online activities which involve the right of making adaptation and making derivative work. Both internet activities could provide the internet users copies of many kind of copyrighted works *fixed* online (these include literary works, musical works, audiovisual works, and images), which could subsequently be recast for purposes of producing derivative works.[315] The copies of these works will be delivered to the users by mean of *downloading*,[316] and, regardless of whether they are knowledgeable, when they make any change, transformation, or adaptation to such work that means they are likely making derivative work. The act of making derivative work without receiving legitimate authorisation of the original author of the work is considered to be a copyright infringement. The act of copyright infringement is then again dependent upon some exceptions and limitations, however.

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[314] See chapter III

[315] 17 USC § 106 (2) and CDPA 1988, Section 16(1)(e) and 21

[316] At this step the user is already considered as constituting a copyright infringement according to the law but could however be defended under fair use or fair dealing.

The right of making adaptation or making derivative work was not discussed in the previous part because the nature of the right at least in the offline world is specifically different from other rights. In order to control the benefits of the use of work, the right focuses not only on the particular acts directed on the work which may involve doing something to the physical container that may affect the economic benefit of the author lies in the work and the physical copies.[317] On the other hand, it also prohibits the acts of making any alteration to the work itself; the medium which contain the work is only a subordinate objective.

In general, it is agreeable that a derivative work needs fixation in order to be protected by copyright law. However, it is controversial whether a derivative work will need fixation in order to be infringing. Reading section 106(2) of the US Copyright Act alone may suggest the users that making any adaptation to a work could be infringing of the right of making derivative work even though such work does not conform any fixation.[318]

Nevertheless, in the digital environment if it is agreed under the laws that every work stored in computer's data storage satisfies the requirement of fixation. This may result in four important questions.

*First, after making reproduction of a work from the internet, whether making change to the work on a user's computer without saving it to a hard disk is qualified as copyright infringement of the right of making derivative work of the author?*

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[317] Such as making reproduction, display and distribution

[318] See *Mirage Editions, Inc v. Albuquerque ART. Company Lewis Galoob Toys Inc., v. Nintendo of America Inc.* And *Micro Star v. Formgen Inc.* in Ochoa, See also *Copyright Law Revision (House Report No. 94-1476)* (United States House of Representatives, 1976) at 62 *'The exclusive right to prepare derivative works, specified separately in clause (2) of section 106, overlaps the exclusive right of reproduction to some extent. It is broader than that right, however, in the sense that reproduction requires fixation in copies or phonorecords, where as the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form.'*

*Second, why the exception of 'technological purposes' is applied only to the right of making reproduction of the work and not to the right of making adaptation of a work?*

*Third, since the right of reproduction and the right of making derivative work are overlapped; while the act of making temporary reproduction for technological purposes is excused from liabilities, is it possible that such exceptions be allowed for temporarily making derivative work in RAM as well?*

*Finally, in either case, whether the work is saved or not saved to hard drive, any of such acts of making derivative work is defendable under the fair dealing or fair use doctrine?*

## C. MORAL RIGHTS

Apart from the two criteria of form and content which have already been discussed above, moral rights of the author is another important aspect.

### C.1. International Regulations

Moral right is significantly different from other aspects of copyright protection in a way that the provision of Article 9(1)[319] of TRIPS has excluded substances of Article 6*bis*[320] of the Berne Convention from obligations of member countries.

Article 6*bis* (1) of the Berne Convention provides that, independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim; 1) authorship of the work and 2) to object to any distortion, mutilation or other modification of, or other

[319] TRIPs 1995, Article 9(1) *'Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of that Convention or of the rights derived therefrom.'*

[320] Berne 1971, Article 6*bis* (1*)*

derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation.

It could be assumed, from the essence of Article 6*bis,* that the provision provides protections for two types of moral rights i.e. 1) paternity right and 2) integrity right.[321]

**C.2. National Level**

Moral rights are the rights assigned to authors in order to protect his personality and the integrity of his work. Whereas economic rights[322] might have been seen recognised since the fifteenth century, moral rights have only been acknowledged at the beginning of the nineteenth century under the tradition of France and Germany.[323] Moral rights could only be accorded to an human being [324] and could generally be classified into five types; 1) divulgation right, 2) paternity right, 3) integrity right, 4) right to destruction of works and 5) retraction right.[325]

**C.2.1. Common Law System:**

Even though civil law countries allowed authors to receive protections for their reputation and integrity, yet the concept of moral rights as such has not been commenced in common law jurisdictions.[326] The US, however, as a member of the Berne Convention has an obligation to comply with the standard of protection under Article 6*bis*.[327] At that time, an opinion of the

[321] Sterling p410

[322] See chapter II

[323] Sterling p392

[324] Ibid p393

[325] Ibid pp395-398

[326] Ibid p392

[327] Ibid p408

Director General of WTO was given that the protection under Section 43(a)[328] of the Lanham Act is sufficiently qualified. Nevertheless, in 1990 the US has developed and recognised moral rights in its Visual Artists Rights Act 1990 (VARA), which later were incorporated to Section 101 and Section 106A[329] of Copyright Act, provided that the authors may have; 1) right to claim authorship of the work, 2) right to prevent false attribution of authorship, 3) right to prevent use of the author's name as the author of the work etc.[330]

In the UK, moral rights are recognised under Part I Chapter I of the Copyright, Designs and Patent Act. Generally, the law provides authors[331]; 1) the right to be identified as author or director (rights of paternity), 2) the right to object to derogatory treatment of the work (rights of integrity), 3) the right not to have a work falsely attributed and 4) the right to privacy of certain photographs and films.[332]

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[328] 15 USC § 1125 *'(a) Civil action (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.'*

[329] 17 USC § 106A *'(a) Rights of Attribution and Integrity.— Subject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—(1) shall have the right—(A) to claim authorship of that work, and (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create; (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and (3) subject to the limitations set forth in section 113 (d), shall have the right—(A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and(B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.'*

[330] Sterling p408-409

[331] See CDPA 1988, Section77, 80, 84 and 85

[332] Sterling p405

### C.2.2. Civil Law System:

Civil law countries guaranteed moral rights of the authors the same term of protection as economic rights, or sometimes even longer. Furthermore, in civil law tradition moral rights tends to prevail when they conflicts with economic rights. [333] In France, under the notion of 'droit moral'[334], the French Code provides four types of moral rights protection; 1) right of respect (paternity and integrity right), 2) right of divulgation, 3) right of reconsideration or withdrawal and 4) right to gather articles and speeches into a collection and to publish them is such from.[335]

In Germany, following Kant's essay which has developed the theory of author's right as a personality right[336], the German Law grants three types of moral rights protection; 1) right of dissemination (right of divulgation), 2) right of recognition of authorship (right of paternity) and 3) right to forbid degradation (right of integrity).[337]

## C.3. MORAL RIGHTS IN THE DIGITAL ERA:

Since moral rights do not aim at economic benefits but to protect the reputation of the author or the integrity of the work, such idea is very problematic in the digital era. First of all, when a work is published online, it is unlikely that the original author of such work could be easily identified. Second, since it is not an obligation of member countries under Article 9(1) of TRIPS and Article 6*bis* of the Berne Convention to offer protection on moral rights, the standard of moral rights protection therefore varies amongst

[333] Ibid p393

[334] Ibid p392

[335] Ibid p399

[336] Ibid p392, 61

[337] Ibid p404

countries. Third, when there is an infringement of moral rights in a specific jurisdiction, it could hardly prove whether such act is an infringing in other jurisdictions that are sharing the same internet technology platform.[338]

Nevertheless, the objective of the thesis is to study the impact of the internet technology on the economic rights of the copyrights owner, particularly on the right of making derivative work. Therefore, the profound study of moral rights' conflict is not in the scope of the study, however.

## D. LIMITATIONS AND EXCEPTIONS: FAIR USE AND FAIR DEALING

### D.1. International Regulations

Article 13[339] of TRIPS and Article 9(2)[340] of the Berne Convention provide the general standard of limitations and exceptions; the 'three step' test as the guidelines for member countries. Hence, it is important to note that there might be the cases where some limitations were allowed in some member countries, but at the same time were not permitted in others.[341] At the beginning[342], the 'three step' test was only applied to the limitations and exceptions to reproduction right[343] but later it was extended to cover 'all limitations and exceptions to exclusive rights granted by member countries'

[338] See also Ginsburg JC, 'Have Moral Rights Come of (Digital) Age in The United States?' (2001) 19 Cardozo Arts & Entertainment 9

[339] TRIPs 1995, Article 13 *'Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.'*

[340] Berne 1971 Article 9 (2) *'It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.'*

[341] Sterling p520

[342] Article 9(1) of the Stockholm Act of the Berne Convention, Stockholm Conference 1967

[343] For the details about 'reproduction right' see chapter III

according to the wording of Article 13 of TRIPS in conjunction with Article 9(2) of the Berne Convention.[344]

**Berne three - step test**

According to Article 9(2) of the Berne Convention, it is accepted that there are three conditions which needed to be achieved before the reproduction right could be limited;[345]

1) The limitation or exception can only apply *in certain special cases*;

2) The limitation or exception must *not conflict with a normal exploitation of the works*; and

3) The limitation or exception must *not unreasonably prejudice the legitimate interests of the author*.

The interpretation of each condition is, however, problematic. According to the WTO panel's discussion, the wording *'certain special cases'* appears under the first condition was interpreted in various meaning. Nevertheless, it is generally accepted that the first condition requires 1) the exception to be clearly defined 2) the exception must be limited in the scope of application 3) the exception should be sufficiently narrow in its scope and reach of all aspects. Thus, the limitation provided under this condition will need no other specific justifications such as 'special purposes' or any other normative interpretation which refers to a clear public policy. The normative inquiry is, however, postponed to the second two steps.[346]

Under the second condition, the wording '*not conflict with a normal exploitation of the works*' is interpreted, according to the WTO panel, that 1)

[344] Sterling p529

[345] Ibid p529

[346] Ricketson and Ginsburg pp763-767

the exception must not conflict with the uses that the copyright owner would ordinarily expect or seek to explore, in other words, must not conflict with the exclusive rights granted to the copyright owner 2) the uses that the copyright owner will seek to perform are generally the uses which likely generate tangible or economic benefit 3) nonetheless, in the normative sense, the uses which create non-economic benefit to the public and therefore do not enter into economic competition with the copyright owner should not be excluded from consideration under this condition. Such uses, on the other hand, are not in conflict with the normal exploitation of the copyright owner but could possibly prejudice the interests of the copyright owner as appears under the third condition 4) since those words in second condition are somewhat open-ended and ambiguous, providing an exception under this condition, a balancing consideration is needed between those two concepts of economic and non-economic (public interest) approach 5) the condition will take in to account both the present and potential future activities.[347]

As for the third condition, the wording '*does not unreasonably prejudice the legitimate interests of the author'* was interpreted in a way that 1) both economic and non-economic interests of the copyright owner will be taken into account under this condition 2) the exceptions which unreasonably prejudice the legitimate interest of the copyright owner could possibly be allowed if otherwise they satisfy the first and the second condition 3) in case that such exceptions unreasonably prejudice the legitimate interest of the copyright owner they must be at least proportionate in order to clear out the unreasonable ground 4) in addition the unreasonable action could be made reasonable by attribution or paying remuneration to the copyright owner 5)

[347] Ibid pp767-773

here again a balancing is needed between the copyright owners and the users.[348]

### D.2. National Level

#### Common Law System: the UK and the US

Under the US 1976 Act, a general standard of limitations and exceptions of exclusive rights on copyrighted works is provided under Section 107. Also there are other specific exceptions granted under other provisions.[349]

Section 107[350] provides the 'fair use' exceptions for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, providing that the use of works in these scopes is not an infringement of copyright.

Particularly, Section 107 specifies the four factors which need to be considered before judging whether a use of work is a 'fair use'. These include;

(1) The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

(2) The nature of the copyrighted work;

(3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

[348] Ibid pp773-777

[349] Sterling p546

[350] 17 USC §107 *'Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include— (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.'*

(4) The effect of the use upon the potential market for or value of the copyrighted work.

In fact, the fair use defence was originally framed at the old time when the reproduction of a work would normally be made up in the same format (or tangible medium) with the original work, for example, from one book to another book. Also usually the distribution of such reproductions at that time would directly occur in the same competing markets with the original works.[351] Therefore the judge, as in *Folsom v. Marsh,*[352] could hold decision in favour of the plaintiff without looking in any more specific rationale for market injury. Historically, section 107 derived from the decision of Justice Joseph Story in the case of *Folsom v. Marsh* which strongly influenced the American fair use up to 1976.[353]

In the US, the fair use doctrine also functions as a balancing tool between the market interest of the copyright owner and the public interest of the user of the original work.[354] It has also been described as '*[a] privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner.'* [355]

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[351] Goldstein p233

[352] *Folsom v. Marsh* 6 Hunt Mer Mag 175, 9 FCas 342 (1841) (Circuit Court, D. Massachusetts)' *look to the nature of the objects of the selections made, the quantity and value of the material used, and the degree in which the use may prejudice the sale, or diminish the profits or supersede the objects of the original work'* For a history of the development of fair use in the United States, see William F. Patry, *The fair use privilege in copyright law* (Bureau of National Affairs 1985)

[353] Barton Beebe, 'An Empirical Study Of U.S. Copyright Fair Use Opinions, 1978-2005' (2008) 156 University Ofpennsylvania Lawreview 549 p560

[354] E. Kenly Ames, 'Beyond Rogers v. Koons: A Fair Use Standard for Appropriation' (1993) 93 Columbia Law Review p1487-1488

[355] *Roosemont Enter., Inc v. Random House, Inc* 366 F2d 303, 306 (2d cIr 1966) (Cert. denied, 385 U.S. 1009 (1967)) and Willajeanne F. McLean, ' All's Not Fair in Art and War: A Look at the Fair Use Defense After Rogers v. Koons' (1993-1994) 59 Brooklyn Law Review 373 p376

In order to succeed or fail the fair use exception, it is not that an act needs to meet or fail all or at least one of the four factors. In fact, each factor will be considered and weighed altogether by the court and the decision will be rendered on a case-by-case basis.[356] According to the empirical study of the court's opinions, the legal interpretation of sub-factors of each four pillars of the US fair use doctrine which drive the outcome of the court's decision in fair use issue could be briefly explained as follows.[357]

**(1) The purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;**

This factor includes approximately four sub-factors to be considered, according to Beebe: *1) The Commerciality Inquiry 2) The Transformative Inquiry*[358] *3) The Bad Faith Inquiry*, and *4) The Preambular Purposes Inquiry*.[359] Each sub-factor plays a different role in determining the outcome of fair use decision. The empirical research of the court's opinions shows that sub-factor one does not significantly influence the outcome of the fair use decision unless it is found that the use of the defendant is otherwise for a

[356] As it was summarised in the recent case of *Authors Guild v. Hathitrust* No 11 CV 6351 (HB) (SDNY 2012) that *'A defendant need not prevail with respect to each of the four enumerated fair-use factors to succeed on a fair-use defense. NXIVM Corp. v. Ross Inst., 364 F.3d 471, 477 (2d Cir. 2004). Rather, the factors are "explored and weighed together, in light of copyright's purpose." Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 569 (1994). "The ultimate focus is the goal of copyright itself, whether 'promoting the Progress of Science and useful Arts would be better served by allowing the use than by preventing it.' " Swatch Grp. Mgmt. Servs. Ltd. v. Bloomberg L.P., No. 11 Civ. 1006, 2012 WL 1759944, at *3 (S.D.N.Y. May 17, 2012) (quoting Castle Rock Entm't, 150 F.3d at 141; U.S. Const. art, 1, § 8, cl. 8).'*

[357] Beebe pp594-621 See also Samuelson P, 'Unbundling Fair Uses' (*SSRN*, 8 January 2009) <http://ssrn.com/abstract=1323834> accessed 7 July 2015 and Matthew S, 'Predicting Fair Use' (*SSRN*, 25 February 2012) < http://ssrn.com/abstract=1769130 > accessed 7 July 2016

[358] This is an important factor for the right of making derivative work, which will be discussed further afterwards.

[359] Beebe pp597-609

*non-commercial* purpose.[360] The result of the study is the same for sub-factor three and four, which shows no significant effect to the fair use decisions.[361]

However, the study shows different result in term of sub-factor two: *The Transformative Inquiry*. It suggests that the transformative inquiry is the heart and the basis of fair use analysis, most importantly, the back bone of the fair use doctrine.[362] This sub-factor plays an important role not only on the outcome of factor one but on the overall result of fair use test. Some courts even stated that the transformativeness trumped the commercial use of the defendant when considering the purposes of the use under sub-factors of factor one.[363]

In brief, transformativeness is the concept that has long been emerged, recognised and developed under the US copyright law history. It is primarily established under the act of fair abridgement which is as well referred as the basis of the fair use system.[364]

From the decision of *Gyles v. Wilcox*[365]dealing with the abridgement of books, the court emphasised that:

*'Where books are colorably shortened only they are undoubtedly infringement…*

*But this must not be carried so far as to restrain persons from making a real and fair abridgement, for abridgements may with great propriety be*

[360] Ibid pp597-603. See *Sony Corp. of America v. Universal City Studios, Inc.* 464 US 417 (1984), *Harper & Row v. Nation Enterprises* and *Campbell v. Acuff-Rose Music* 510 US 569 (1994)

[361] Beebe pp607-609

[362] Ibid p604

[363] Ibid pp605-606

[364] Pierre N. Leval, 'Nimmer Lecture:Fair Use Rescued' [1997] 44 UCLA Law Review 1449 pp1451-1453, See also Leval PN, 'Toward A Fair Use Standard' (1990) 103 Harvard Law Review 1105 p1112

[365] *Gyles v Wilcox* (1740) 2 Atk 141; 26 ER 489 at 490

*called a new book, because … the* ***invention****,* ***learning*** *and* ***judgement of the author*** *is shown in them.*' [Emphasis added]

Nonetheless, according to Judge Leval, merely inventiveness added to the new work will not be sufficient to secure the secondary author from infringement, if, by adding such inventiveness, the secondary author have threatened to replace or substitute the original work in the same market.[366] In *Folsom v. Marsh*[367] the court indicated that:

*'No one can doubt that a reviewer may* ***fairly cite largely*** *from the original work if his design be really and truly to use the passages* ***for the purposes of fair and reasonable criticism****. On the other hand, it is as clear, that if he thus cites the most important parts of the work, with a view,* ***not to criticise****,* ***but to supersede the use of the original work, and substitute the review for it****, such a use* ***will be deemed in law a piracy****.'* [Emphasis added]

Therefore, from the two landmark cases held before the enactment of the Copyright Act 1976, it appeared historically in the courts' decisions that to quote from a previous work could possibly be acceptable as fair if such quoting complies with at least two major conditions: **1) the quotation transforms the original work and supports the different purposes of the subsequent author,** and **2) the secondary work must not supersede the original work or offer itself as a substitute of the original work.**[368] Hence, these two conditions could be presumed as the

[366] Leval p1452

[367] *Folsom v. Marsh*

[368] Leval p1452 See also Sag M, 'The Prehistory of Fair Use' (2011) 76 Brooklyn Law Review 1

basis of transformativeness before the formation of the 1976 Copyright Act. At that time the idea was referred as a 'productive use'.[369]

Since after the Copyright Act 1976, there are many cases in which the court's decisions were directed away from the historical standard of the US fair use doctrine.[370] In two major cases, *Sony v. Universal*[371]and *Harper & Row v. Nation*[372] the courts relies heavily on the commercial use presumption and market injury to the original work rather than the transformativeness and substitution of the secondary work.[373]

In 1994, the Supreme Court in *Campbell v. Acuff Rose*[374] has restored the historical meaning of the fair use doctrine and reemphasised the two fundamental concepts of transformativeness and substitution.[375] Attempting to fix the variation in previous cases on commercial use presumption, the court in *Campbell* ruled that:

*'[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."*[376]

Also, regarding the market injury, the court held that:

*'[W]hen a commercial use amounts to mere duplication of the entirety of an original, it clearly "supersede[s] the objects, … But when, on the*

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[369] Ibid p1456

[370] *'…90.2% of the 92 opinions preceding Campbell failed to reference it (either under the rubric of transformativeness or, as it was sometimes called, "productive use".)'* Beebe p604

[371] *Sony Corp. of America v. Universal City Studios, Inc.*

[372] *Harper & Row v. Nation Enterprises*

[373] Leval pp1454-1460

[374] *Campbell v. Acuff-Rose Music*

[375] Leval p1464

[376] *Campbell v. Acuff-Rose Music* at 579

*contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred.'*[377]

Therefore, according to the decision in *Campbell,* the court has reinterpreted the notion of fair use and transformativeness, given factor three for judges' consideration that; **3) the factor of transformativeness should be weighted in higher importance than the factor of commercial use and market injury.** The lower importance of the market effect could be seen in the case where the quoting from the original work has been done in a manner that makes it seem absurd. In such case, the new work could seriously harm the market for the original work. But that probably would not be considered as copyright infringement because the market injury was not obviously a direct result of offering the copy as a market substitute.[378]

Meanwhile, if the situation was like what Judge Leval and other scholars have argued in their works,[379] the basis of *transformativeness* consideration therefore predominantly consists of three major conditions:

*1) Whether the quotation transforms*[380] *the original work and supports the different purposes of the subsequent author*

*2) Whether the secondary work supersedes the original work or offers itself as a substitute of the original work*

*3) The factors of transformativeness should be weighted in higher importance than the factor of commercial use and market injury*

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[377] Ibid at 591

[378] Leval p1460

[379] Pierre N. Leval, 'Nimmer Lecture:Fair Use Rescued' [1997] 44 UCLA Law Review 1449 and Pierre N. Leval, 'Toward A Fair Use Standard' (1990) 103 Harvard Law Review 1105, See also Ames EK, 'Beyond Rogers v. Koons: A Fair Use Standard for Appropriation' (1993) 93 Columbia Law Review pp1516-1518

[380] 17 USC § 107 *'…for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research…'*

Particularly, in term of the meaning of 'transformativeness' the court in a recent case *Cariou v. Prince*[381]specified an important remark that it needs not restrictively follow the wordings given in the preamble of section 107 of the US copyright Act.[382] The court clarified that the preamble only provides some examples of transformativeness. Rather, in order to satisfy the fair use test, the secondary work at least has to provide the original work with some *"new expression, meaning, or message"* as it could be seen in the decision that:

*'The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute. … Instead, … , to qualify as a fair use, a new work generally must alter the original with "new expression, meaning, or message."'*

**(2) The nature of the copyrighted work;**

This factor consists of approximately two sub-factors: 1) *The Creative/ Factual Work Inquiry* and *2) The Published/Unpublished Work Inquiry*[383]*.* Generally, according to the empirical study of the court's opinions, consideration of these two sub-factors has little influence on the outcome of the fair use test. However, in this scenario, it is the first sub-factor that shows a little more effect on the finding of the fair use rather than the latter.[384]

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[381] *Cariou V. Prince*

[382] 17 USC § 107 *'…for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research…'*

[383] Discussed further in chapter IV

[384] Beebe pp610-615

Nevertheless, it is proposed in this study that the consideration on the second sub-factor would likely play an important role and provide a significant effect in the area of finding fair use for making online digital derivative works. The issue will be discussed further in chapter IV.

**(3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole;**

This factor significantly affects the overall result of the fair use tests, particularly the outcome of factor one and four. According to the court's opinions, the less the defendant takes of the plaintiff's work, the more opportunity that the act of the defendant will satisfy factor one and factor four, and thus will be qualified as fair use.[385]

**(4) The effect of the use upon the potential market for or value of the copyrighted work.**

This is regarded as the most influential factor on the overall result of the fair use tests. The study shows that the court will integrate their analyses of the previous three factors and then come out with the result not only in the scope of the fourth factor, but in respect of the overall test.[386]

In the UK, the limitation and exception of copyright infringement also follows the standard of TRIPs three- step test but could be viewed from a different approach.[387]

Not general as the doctrine of fair use, the UK fair dealing offers specific defences to the infringer under Chapter III of the Copyright, Designs

[385] Ibid pp615-616

[386] Ibid pp616-621

[387] Bently and Sherman p201

and Patents Act 1988. From section 28 to 76 in Chapter III of the Act, there are about 18 types of specific defences applied on many different issues.[388]

The specific fair dealing exceptions for the purpose of caricature, parody or pastiche are provided under Section 30A that:

(1) Fair dealing with a work for the purposes of caricature, parody or pastiche does not infringe copyright in the work.

(2) To the extent that a term of a contract purports to prevent or restrict the doing of any act which, by virtue of this section, would not infringe copyright, that term is unenforceable.[389]

The general exceptions are provided under section 29 and 30 that a person will not be liable if such infringement is:[390]

(1) A fair dealing for the purposes of research or private study;[391] or

(2) A fair dealing for the purposes of criticism or review;[392] or

(3) A fair dealing for the purpose of reporting current event[393]

For purpose of this thesis, the most important defence to be considered is the fair dealing for the purposes of criticism or review which are highly relevant to the right of the secondary user to create derivative work based on the original work of the prior author.

According to the decision in *Ashdown v. Telegraph,*[394] the UK court acknowledged the conflicts between the right to freedom of expression as

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[388] Ibid pp207-238

[389] The Copyright and Rights in Performances (Quotation and Parody) Regulations 2014, http://www.legislation.gov.uk/uksi/2014/2356/regulation/5/made accessed 5 May 2016

[390] Ibid p202

[391] CDPA 1988, section 29(1) and (1C)

[392] CDPA 1988, section 30(1)

[393] CDPA 1988, section 30(2)

[394] *Ashdown v. Telegraph* EWCA Civ 1142; [2001] 4 All ER 666; [2001] 3 WLR 1368

guaranteed under Article 10 of the European Convention on Human Rights - ECHR (and later under Article 12 of the UK Human Right Act 1998), and the copyrights of the copyright owner. When considering UK fair dealing options, in order to find a balance between the rights of the owner and the rights of the user, it is suggested that the right to freedom of expression should be taken into account.[395] Nevertheless the freedom of expression will not trump the copyright of the right owner and should be invoked in two cases: for purposes of public interest and granting remedies to the copyright owner.[396]

Even though the concept of the UK fair dealing recognises both public interest and freedom of expression as copyright infringement defences, the idea of *transformativeness* for purpose of creating a new meaning, new value, and new market to a secondary work is, however, not anywhere specified in the 1976 Act.[397]

Whereas the defences under section 30(1); '*a fair dealing for the purposes of criticism or review*' is not sufficient to cope with this issue[398] and the exceptions of *transformativeness* is not allowed under the Directive 2001/29/EC (Information Society Directive), the Gowers Review recommends that the UK government seeks to amend the Directive to permit the exceptions in international level for *transformativeness* and amend the national copyright law to allow exceptions as well for parody.[399]

[395] Ibid (para. 45)

[396] Ibid (para. 46 and 58-59)

[397] Gowers 4.85 p66

[398] Bently and Sherman pp212-213

[399] Gowers 4.88 Recommendation 11 and 12 p68

### D.3. Limitations/Exceptions and Derivative Works

According to the discussion in Section A: the originality and creativity of the copyright work and Section B: fixation and idea/expression dichotomy, a derivative work created by an author, if meet all the qualification require by the law, is protected by copyright under Article 2(3) of the Berne Convention and Article 9 of the TRIPs Agreement against any unlawful uses by others under copyright regime.

When a work is protected, only the copyright owner possesses the exclusive rights over the work. Those rights, according to the Berne Convention, include the rights of translation (Article 8), the rights of making reproduction (Article 9), the rights of public performance (Article 11), the rights of wireless broadcasting and cable retransmission (Article 11*bis*), and, particularly, the rights of making adaptation (Article 12).

Hence, under Article 12 of the Berne Convention, *'the right of making derivative work'* is therefore guaranteed under international regulation as one of the exclusive rights of the copyright owner. The use of a protected work to prepare an adaptation of a work without authorisation of the copyright owner will be considered a copyright infringement.

Nevertheless, in some jurisdictions the use of a protected work to create a subsequent work (preparing/creating derivative works) without authorisation of the copyright owner may not be infringing if such acts satisfy the requirements of limitations and exceptions of copyright infringement. This happens clearly in the US jurisdiction where the fair use doctrine opens some doors for the unauthorised subsequent creators. In the UK, however, the fair dealing concept is very restricted that the subsequent creators hardly succeed their defences under the exception regimes.

### D.3.1. In the US Jurisdiction

The fundamental concept of transformativeness under the fair use doctrine is the most important part that is relevant to the right of making derivative work of the copyright owner.[400] The analysis of transformativeness is very useful in attempting to identify whether such act of subsequent use of work would be infringing the rights of making derivative work of the copyright owner, and afterwards whether the newly created work would therefore be qualified for copyright protection.[401]

It is important to note that the US limitation and exception of copyright infringement provides advantages on derivative work in at least four aspects:

***Firstly***, the right of making derivative work without authorisation of the copyright owner has long been confirmed. This could be presumed under the transformativeness concept. The idea of transformativeness is not new. According to Paul Goldstein, in *Burnett v. Chetwood* [402] and *Giles v. Wilcox* [403] the courts held that unauthorised translation and 'real and fair' abridgement is not prohibited under the English law and therefore is not an infringement of the exclusive rights of the copyright owner. In making decisions the court in both cases relied on the value of supporting the creation of the new work even though at that time the objective of balancing of rights was not yet recognised in the decision.[404]

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[400] Beebe p604 (See sub-factor two of factor one at supra note 358)

[401] See A. ORIGINALITY AND CREATIVITY AND DERIVATIVE WORKS

[402] *Burnett v. Chetwood* 35 Eng Rep 1008—09 (Ch 1720)

[403] *Gyles v Wilcox*

[404] Goldstein pp211-212

At that time the American courts tended to follow the rationale of the English courts' decisions which highly value the new creation and give less value to the market injury. The exclusive right of making derivative work of the original author was firstly guaranteed under the law in the Copyright Act 1870 upon nondramatic or literary works. Until the 1976 Act, the right of making derivative work was then expanded to include all forms of copyrighted work.[405]

***Secondly***, in respect of making derivative works, following transformativeness exception could possibly prevent the unauthorised subsequent author from infringing of the right of making derivative work of the copyright owner. This is when the subsequent creation of the derivative work meets the conditions of transformativeness under sub-factor two of factor one of the fair use doctrine, which includes three main conditions: 1) the transformation of the original work, and 2) the non-substitution qualification of the new work on the original work, and 3) the non-commercial use of the works.[406]

In addition, such creation of derivative work also needs to conform with other fair use factors and sub factors so that the author of such work will be exempted from infringing the right of making derivative work of the copyright owner.[407] However, this is not the absolute presumption of the law. In order to succeed the fair use argument the subsequent authors will have to defend their acts in the court.

***Thirdly***, it is very important to emphasise that derivative work and transformative work are distinguished. According to section 101 of the US

[405] Ibid pp213-215

[406] Supra note 377

[407] See supra note 356

Copyright Act, a 'derivative work' is a work based upon one or more preexisting works. Also the right of making derivative work of the copyright owner is guaranteed under section 106 (2). In such case the third party who prepares derivative work without authorisation of the copyright owner could be considered as infringing the right of making derivative work unless such act of creating a subsequent work falls under the scope of fair use under section 107. Section 107 offers the fair use doctrine, which, under factor one, has included 'transformativeness' as one of the considerations for exception from copyright infringement.

Therefore, making derivative works which could be protected by copyright and which is guaranteed as one of the exclusive rights of the copyright owner is one thing. Making derivative work which combines a transformativeness quality which could be exempted from copyright infringement (and could possibly be protected by copyright afterwards as specified in section A.) is another thing. This could be said, in other words, that there are generally two types of derivative works:

**1) Derivative work which is not transformative.** This type of derivative work, if created with lawful authorisation of the copyright owner, will certainly be protected under copyright law by any means. But if the authorisation of the copyright owner was not found, the work would likely be infringing and thus could not enjoy copyright protection. This is, particularly, when the creation of such work does not satisfy other requirements of fair use factors (section 107(2)-(4)). One of these types of derivative work is satire, for example.[408]

[408] *Campbell v. Acuff-Rose Music* at 580-*581 'If… the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger. Parody needs to mimic an original to make its*

However, satire which does not comment the original work (and thus not sufficiently transformative) could possibly be considered fair use if, for instance, it is not viewed by consumers as a commercial substitute of the original work (section 107(4)), or if only a small amount of the copyrighted work was used (section 107(3)).[409]

Apart from satire, other cases where the courts found the subsequent creation of derivative work is not transformative and also fails the fair use tests such as in *Micro Star v. Formgen Inc.*.[410] In *Mulcahy v. Cheetah Learning LLC*.,[411] the court, however, ruled that the plaintiff's work is derivative work but it was not use unlawfully therefore it satisfies the fair use tests. In this case, the court never mentioned the issue of transformative use in the decision.[412]

**2) Derivative work which is transformative.**[413] This type of derivative work would likely satisfy the fair use factors (since the transformativeness is regarded as the back bone of the fair use doctrine).[414] Therefore, this type of derivative work, if created with lawful authorisation of the copyright owner, will certainly be protected under copyright law by any means. But if the authorisation of the copyright owner was not found, still, this type of derivative work would likely not be infringing and could possibly

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*point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.'*

[409] Ibid at n14

[410] *Micro Star v. Formgen Inc.*

[411] *Mulcahy v. Cheetah Learning LLC* 386 F3d 849 (8th Cir 2004)

[412] Reese p475

[413] The three main conditions of transformativeness: 1) the transformation of the original work, and 2) the non-substitution qualification of the new work on the original work, and 3) the non-commercial use of the works. See supra note 377

[414] Supra note 360

enjoy copyright protection. This is particularly when the creation of such work satisfies other requirements of the fair use factors. One of these types of derivative work is parody, for example.

**Parody**

In respect of the different limitations and exceptions of copyright infringement regulations amongst jurisdictions, parody is another issue amongst those dissimilarities which is currently being controversial. Generally, parodies could be categorised as a kind of 'derivative works'[415] which is eligible for protection under Article 2(4) of the Berne Convention.[416] On the other hand, they also propose some kinds of characteristic which establish a unique category of copyright infringements.[417] According to Hutcheon[418] and Rose[419], the nature of parody involves the displacement, the *'imitation with critical irony'* and the *'comic incongruity'*, which distinguishes it from other kinds of derivative works or works borrowing from existing works such as plagiarism.[420] Above all, parody works, in any occasion, might contain parts of the copyrighted works in which the unauthorised adaptations of those works might possibly create copyright infringements.[421] Therefore, those rules of limitations and exceptions of exclusive rights need to be applied to this specific matter.[422]

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[415] Sterling p641

[416] See A. ORIGINALITY AND CREATIVITY AND DERIVATIVE WORKS

[417] Sterling p641

[418] Linda Hutcheon, *A theory of parody : the teachings of twentieth-century art forms* (Methuen 1985) p6

[419] Margaret A. Rose, *Parody : ancient, modern, and post-modern* (Cambridge University Press 1993) p52

[420] Ellen Gredley and Spyros Maniatis, 'Parody: a fatal attraction? Part 1: The nature of parody and its treatment in copyright' (1997) 19 European Intellectual Property Review 339 p340

[421] Sterling p641

[422] Ibid p641

Different jurisdictions provide different approaches towards parody.[423] Parody is usually allowed under specific provisions in civil law system such as France, Belgium and Spain.[424] On the contrary, in common law system the limitations and exceptions for parody rely mainly on the general standard of 'fair use' such as in the US[425] or 'fair dealing' such as in the UK[426]

The court firstly recognised a parody defence in *Berlin v. E.C Publications, Inc.*[427] In this case, the court emphasised that '*…parody and satire **are** deserving of substantial freedom — both as entertainment and as a form of social and literary criticism.'*[428] Furthermore, Congress also guarded parody as a type of work which is qualified for exemption under the scope of fair use.[429]

Parody is considered transformative and is likely to be fair use because it comments on the original work and therefore does not offer itself as a market substitution.[430]In general, parody could be defined by its three

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[423] Ibid pp641-647

[424] Ibid pp641-642

[425] See Robert J. Bernstein, 'US Supreme Court rules on parody and fair use' (1994) 5 Entertainment Law Review 95

[426] See Recommendation 12 of Ian Hargreaves, *Digital Opportunity: A Review of Intellectual Property and Growth* (2011) and Sterling p642 and The Copyright and Rights in Performances (Quotation and Parody) Regulations 2014, <http://www.legislation.gov.uk/uksi/2014/2356/regulation/5/made> accessed 5 May 2016

[427] Ames p1494

[428] *Berlin v. E.C. Publications, Inc.* 329 F2d 541 (2d Cir 1964) at 545

[429], *Copyright Law Revision (House Report No. 94-1476)* at 65 See also Ames EK, 'Beyond Rogers v. Koons: A Fair Use Standard for Appropriation' (1993) 93 Columbia Law Review p1494

[430] *Campbell v. Acuff-Rose Music* at 579-580 *'parody [is] a "literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule," or as a "composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear ridiculous." For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works.'* See also *Ty, ISnc v Publications International* Ltd 292 F3d 512, 516, 519, 522–23 (7th Cir 2002) at 517 *'copying that is complementary to the copyrighted work (in the sense that nails are complements of hammers) is*

main qualifications: *first* is that the parody needs to be in a form of criticism or comment. That means the parody must target the work it parodies; *second*, the parody must borrow or take some necessary parts of the original work in order to conjure up the work it parodies. That means the parody could not take so much amounts of the original work that it may offer itself as substitution for that work; *third*, the parody may use the original work to create a new expression. Therefore it is not required that parody always have to make fun, ridicule, or criticise the original work.[431]

In *Roger v. Koons,* holding that the work of the plaintiff was not a parody, the court defined that parody needs not only comment on the original work which is an object of the parody but also *'makes ridiculous the style and expression of the original.'*[432] Thus, it may be assumed from the court's decision that parody has to acquire a qualification of being funny. However the court in *Campbell* later confirmed that making ridiculous is one of the general qualifications of parody but not a specific requirement.[433]

In addition, at the regional level the recent decision of the ECJ in *Deckmyn v Vandersteen (C-201/13)* confirmed that the interpretation of parody under article 5(3)(k) of the Directive 2001/29/EC or the InfoSoc Directive must be autonomous amongst EU member countries. In this regard, the Court also defined the two characteristic of parody that: a parody is a work that *'first, to evoke an existing work, while being noticeably different from it, and secondly, to constitute an expression of humour or mockery.'* In

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*fair use, but copying that is a substitute for the copyrighted work (in the sense that nails are substitutes for pegs or screws)… is not fair use*'

[431] Richard A. Posner, 'When Is Parody Fair Use?' (1992) 21 The Journal of Legal Studies pp70-71

[432] Ibid and *Rogers v. Koons* at 309-310, see also Ames EK, 'Beyond Rogers v. Koons: A Fair Use Standard for Appropriation' (1993) 93 Columbia Law Review p1502-1507

[433] *Campbell v. Acuff-Rose Music* at 579-580

particular, this application of the exception of parody under article 5(3)(k) of the Directive *'must strike a fair balance between … the interests and rights of [the copyright holder], and … the freedom of expression of the user of a protected work who is relying on the exception for parody.'*

***Finally,*** limitations and exceptions of copyright infringement could as well be conditions for protection of parts of derivative works. As discussed earlier in section A. about originality and creativity as one of the criteria of copyright protection, substantial similarity parts of the derivative work which borrowed from the original work without authorisation of the copyright owner could be protected by copyright if the borrowing is 'lawful' under the fair use factors.[434]

Nevertheless, when there is an unauthorised use of the original work, in many cases the US courts tend to apply a strict interpretation of fair use doctrine which later affects the possibility of copyright protection given to the latter developed derivative works. For example in *Rogers v Koons* the court found that the work of the defendant unsatisfied the fair use tests and thus was *'unworthy of protection.'* The court, nonetheless, did not consider the unauthorised derivative work of the defendant whether it fall in any other scope of social commentary and might be worth protecting.[435] On the other hands, in *Eden Toys Inc., v. Florelee Undergarment Co.,* Eden received lawful permission from the author of the original work (Paddington) therefore it was granted copyright protection on the derivative work.[436]

In conclusion even though the existing fair use doctrine offers some rooms in supporting the unauthorised creation of derivative works, it does

[434] See A. ORIGINALITY AND CREATIVITY

[435] Ames p1506

[436] *Eden Toys Inc., v. Florelee Undergarment Co.*

not, however, sufficiently handle all types of derivative work equally. Fair use tests seem to be adversarial to some particular type of unauthorised derivative work such as satire, whereas the beneficial standards offered is still unsteady in case of parody. Therefore, it could be presumed that the available fair use doctrine does not effectively allow sufficient opportunity for creation in both categories of derivative work. In the digital age, the problems are even significantly magnified. The issue will be discussed later in the next section.

### D.3.2. In the UK Jurisdiction

According to the discussion in section A, there is no explicit protection given to derivative work under the UK Copyright Law. However, if a derivative work is created with sufficient skill, labour and judgment of the creator, it would be qualified for copyright protection. The exclusive rights of the original author on making derivative work could be inferred from Section 16(1) (e)[437] and 21, particularly Section 21 (3)[438] of the Act, which, nevertheless, is considered to be narrower than the right of making derivative work provided under the US copyright law.[439]

When looking on the side of the limitation and exception, the UK standard seems to be very strict and provide less advantage on derivative work. The situation could be analysed as follows:

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[437] CDPA 1988, section 16 (1) *'The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom— (e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21)'*

[438] CDPA 1988, section 21 (3) *'In this Part "adaptation"— (a)in relation to a literary work, other than a computer program or a database, or in relation to a dramatic work, means—(i)a translation of the work; (ii)a version of a dramatic work in which it is converted into a non-dramatic work or, as the case may be, of a non-dramatic work in which it is converted into a dramatic work; (iii)a version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a newspaper, magazine or similar periodical; (ab) in relation to a computer program, means an arrangement or altered version of the program or a translation of it; (ac)in relation to a database, means an arrangement or altered version of the database or a translation of it; (b)in relation to a musical work, means an arrangement or transcription of the work.'*

[439] Bently and Sherman p152

***Firstly***, on the protection aspect, according to discussion in section A., it is not likely, under the UK copyright law, that an unauthorised created derivative work will acquire copyright protection unless a sufficient degree of skill, labour and judgment is proven. This means that the limitations and exceptions given under the fair dealing concept play no role/offer no support on granting copyright protection to the unauthorised derivative work. In other words, whether the unauthorised derivative work is infringing or not is irrelevant to and has neither positive nor negative effect on the copyright protection granting to the work. The protection relies mainly on the notion of skill, labour and judgment. This scenario is unlike what happens under the fair use doctrine of the US copyright law.

***Second***, in addition, limitations and exceptions given under the UK fair dealing do not provide enough support for an unauthorised author who would like to develop a derivative work. The unauthorised authors could not efficiently escape from copyright infringement unless their particular acts fall within a specific scope of fair dealings, particularly, the UK fair dealing for the purposes of criticism or review. In some cases where there is a proof of sufficient skill, labour and judgment on the unauthorised derivative work, the unauthorised author of such work could even be sued for copyright infringement even though the work itself is qualified for copyright protection.[440]

***Third***, in light of parody and satire, limitations and exceptions given under the UK fair dealing provide no support on the creation of those particular types of derivative work. Even though the idea of parody has long been recognised in the UK courts' decision in *Glyn v. Weston Feature*

[440] See A. ORIGINALITY AND CREATIVITY

*Film Co.* [441] and *Joy Music Ltd v Sunday Pictorial Newspapers* [442] that an unauthorised parody could be freed from copyright infringement if it does not threaten the economic benefit the original work and if there is a sufficient investment of labour added to the work.

However, the change has come in the decision of *Twentieth Century Fox Film Corp v. Anglo-Amalgamated Film Distributors*[443], *Schweppes Ltd. and Others v. Wellingtons Ltd.*[444]and *Williamson Music Ltd. v. Pearson Partnership Ltd.*[445]where the courts emphasised that when substantial parts were taken from the original work, regardless of whether the labour of the author was added to the subsequent work or not, thereby the copyright infringement could possibly occur.

This turning point then brings at least two main difficulties to the UK standard on protecting parody. According to Bently and Sherman the first issue is that the interpretation of the terms 'criticism or review' is restrictive that it is difficult to know when the work would fall in the scope of parody. Second, the strict requirement of 'sufficient acknowledgement' to the author of the original work could be an impediment to the application of the exceptions.[446]

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[441] *Glyn v.Weston Feature Film Co.* [1916] 1 Ch 261 *'… it is well known that a burlesque is usually the best possible advertisement of the original and has often made famous a work which would otherwise have remained in obscurity. More probably, however, the reason is to be found… in the principle that no infringement of the plaintiff's rights takes place where a defendant has bestowed such mental labour upon what he has taken and has subjected it to such revision and alteration as to produce an original result.'*

[442] *Joy Music Ltd v. Sunday Pictorial Newspapers* (1920) Ltd [1960] 2 QB 60*'If one had to direct a jury on this question [parody] … one would clearly tell them of the various tests that have been suggested as guiding tests, and it would be proper to emphasise to them this test which Younger J. suggested as to whether the defendant had bestowed such mental labour on what he had taken and subjected it to such revision and alteration as to produce an original work.'*

[443] *Twentieth Century Fox Film Corp v. Anglo-Amalgamated Film Distributors* [1965] 109 SJ 107

[444] *Schweppes Ltd v Wellingtons Ltd* [1984] FSR 210

[445] *Williamson Music Ltd v. The Pearson Partnership Ltd* (1987) FSR210

[446] Bently and Sherman pp212-213

The Gowers Review [447] and the Hargreaves Report [448] have recommended the UK government to amend these standards to raise protection for parody but until recently there is yet no amendment to the laws.[449]

### D.4. Limitations and Exceptions in The Digital Era:

#### D.4.1. Copyrighted works

At the international level, the limitations and exceptions allowed under Berne and TRIPs have not been changed over time. The member countries of the WTO have been relying on Article 13 of TRIPS and Article 9(2) of the Berne Convention as the general standard of limitations and exceptions for their national copyright laws for years.

It is likely that the first step to deal with the internet technology at the international level was the negotiation and administration of the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT) in 1996 (also known as the 'internet treaties'). Furthermore according to the contexts of Article 10 of WCT and Article 16 (2) of WPPT,[450] the internet treaties even refer back to the general three-step test under Article 9 (2) of the Berne Convention, not the specific exceptions under

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[447] Gowers, Recommendation 12

[448] Hargreaves pp49-51

[449] See also Ronan Deazley, 'Copyright and Parody: Taking Backward the Gowers Review' (2011) 73 Modern Law Review 785

[450] WIPO Copyright Treaty (WCT) 1996, article 10 *'(1) Contracting Parties may, in their national legislation, provide for limitations of or exceptions to the rights granted to authors of literary and artistic works under this Treaty in certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author. (2) Contracting Parties shall, when applying the Berne Convention, confine any limitations of or exceptions to rights provided for therein to certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author.',* See also footnote 8 of the Treaty
WIPO Performances and Phonograms Treaty (WPPT) (1996), article 16 *'(2)Contracting Parties shall confine any limitations of or exceptions to rights provided for in this Treaty to certain special cases which do not conflict with a normal exploitation of the performance or phonogram and do not unreasonably prejudice the legitimate interests of the performer or of the producer of the phonogram',* see also footnote 9 of the Treaty

Articles 10 and 10*bis.* Most importantly, the internet treaties do not have a status as hard law. They offer permission to contracting state to apply their own national standard of limitations and exceptions which are suitable for the digital era.

In addition, regarding the exception on transient copies which allow temporary reproduction for technological purposes, the concept has been immensely discussed at the 1996 Diplomatic Conference but there is yet neither general agreement nor resolution been achieved at the international level.[451] Therefore, even though the treaties offer standard for limitations and exceptions in the digital environment, the idea is still at the beginning. The instability of limitations on some exclusive rights in the internet environment could be seen as well from the decision of the ECJ in *Svenssons*[452] case.

Accordingly, in the digital environment, the same old standards of limitations and exceptions are applied to protect the users from the act of infringing. Meanwhile, the rights of the copyright owner are guaranteed under the four main exclusive rights: the right of reproduction, the right of, the right of distribution, the right to display and the right of communication to the public. Particularly, the right of communication to the public which later was extended to include the right of making available to the public or on-demand availability right, and the right of reproduction are the most important and problematic rights in the internet scheme.[453] Eventually, the internet users have not been provided any new international exceptions for their uses of

[451] This is even though the idea has been adopted by article 5 (1) of Directive 2001/29 EC and Recital (33) of the Directive, and section 512 (a) of the US DMCA 1998

[452] *Svensson and others v Retriever Sverige AB*

[453] See also Sterling pp534-535

digital works under online environment.[454] The exceptions have not been provided even on the right of making derivative work which will be discussed further below.

### D.4.2. Derivative works

Since the beginning in the offline environment, the right of making derivative work of the copyright owner is guaranteed under the international agreement: Article 12 of the Berne Convention and Article 9 (1) of TRIPs. When the technology has come to change, the right is continued to be protected as well in the online world. In this regard, the uncertainty of the standard of protection given to the work[455] and the right[456] makes the limitations and exceptions offered to the users/subsequent creators of the derivative works very problematic. This is particularly when the limitations and exceptions applied to the right are still based on what is guaranteed under Article 13 of the Berne Convention, which aims, mainly, at the activities happen under the offline environment.

#### Protection and *authorship* of a work [457]

It is presumed, under the current legal instruments that every work published online, since they must be created and *fixed* in data storage by someone in some way, satisfies the requirement of sufficient degree of originality and creativity[458] and fixation[459]. Thus it is regarded that every online digital works are protected by copyright. There is, therefore, a

[454] Even though the act of some internet intermediaries are protected under section 512 of the US DMCA 1998 and articles 12-14 of the EC E-Commerce Directive, for example

[455] See A. ORIGINALITY AND CREATIVITY

[456] See B. FIXATION AND IDEA/EXPRESSION DICHOTOMY

[457] See A. The Dynamic of Originality in Derivative Works

[458] See A. ORIGINALITY AND CREATIVITY

[459] See B. FIXATION AND IDEA/EXPRESSION DICHOTOMY

copyright owner of every online digital works who could always exercise their exclusive rights at any time.

In that scenario, when it comes to derivative work, there are at least three problems according to the present laws. *First of all*, although every work stored in data storage and published online might anyway satisfy the requirement of fixation, it is unlikely for internet users to identify whether those works satisfy another requirement of originality and creativity and therefore qualified for copyright protection. In other words, it is only by the presumption of laws that every online digital works are copyright protected because they satisfy both originality and creativity and fixation requirements. In fact, it is difficult to prove originality and creativity in a work of creation as discussed earlier in section A.[460]

*Second*, drawing a line between online original works and derivative works is not easy. In the situation where all online digital works are deemed or presumed to be protected by copyright unless proven otherwise, whereas originality and the original owners of these work could not be clearly identified, the right of making derivative work of the copyright owner is however explicitly and formerly guaranteed by the laws. These scenarios provide uncertainties and difficulties to the users/subsequent creator of the online works to borrow subsequent parts of those works lawfully.

*Third*, when the online users or subsequent creators are trying to applying the limitations and exceptions of copyright infringement to their activities, there is no such clear or explicit exception to this issue even though the original author or the copyright owner of the work has yet been specifically identified.

**Internet Meme**

[460] See also chapter III

In the online world, internet meme is a kind of derivative work which could possibly be a subset of parody if it offers the nature of criticism on the original work as required in parody. Or otherwise it could be a subset of satire if it uses the original work as a tool to comment on others. In either case, since internet meme is a type of derivative work the possible lawful unauthorised creation of it is as well based on the fair use and *transformativeness* concept at least in the US jurisdiction.

In fact, in the offline world, the dichotomy between satire and parody is not easy to apply. Even in the US jurisdiction, in many cases such as in *SunTrust Bank v. Houghton Mifflin*[461], *Dr.Seuss Enters., L.P. v. Penguin Books USA, Inc.*[462], *MasterCard Int'l Inc. v. Nader 2000 Primary Comm.,*[463] it is unclear whether a work could be identified as parody or satire and therefore is seen as transformative and allowable for the exceptions. The problem exists in the offline environment but when it occurs to internet meme in which its content is somewhat overlapped between both satire and parody, the application of limitations and exceptions on copyright infringement for the unauthorised subsequent authors is even more controversial.

**Types of original online copyrighted works**

As discussed earlier in section A. that derivative works is the work that borrows substantial parts from the original work. When considering the nature of the internet technology as medium for communication [464], particularly in the age of user-generated content (UGC)[465], the original works

[461] *Suntrust Bank v. Houghton Mifflin Co.* 268 F3d 1257 (11th Cir 2001)

[462] *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.* 109 F3d 1394 (9th Cir 1997)

[463] *MasterCard Int'l Inc. v. Nader 2000 Primary Comm., Inc.* 2004 US Dist Lexis 3644 (SDNY 2004)

[464] See chapter IV

[465] See also Mary W.S. Wong, '"Transformative'' User-Generated Content in Copyright Law: Infringing Derivative Works or Fair Use' (2008-2009) 11 Vand J Ent & Tech L 1075

which are qualified for copyright protection when they are *fixed* and disseminated online are mainly including but not limited to authors' works.[466]

According to Article 2(1) and (3) of the Berne Convention, these works may principally refer to the work of music and other literary or artistic work, such as a work which is expressed in writing or printing, musical work, photographic work (aka two-dimensional work), and cinematographic work, which are digitally published and their substantial parts are stored in digital format and ready to be 'taken' from the internet for future purposes of translation, adaptation or alteration.

In other words, in the online digital environment there are only four types of original online digital works which could be the substance of derivative works. These are literary works, musical works, cinematographic works (audiovisual works), and photography works (images).[467]

Some types of work are not protected online unless they are transferred into a digital form and thus become another type of work. Hence the substantial parts of these types of works are not available on the internet in a digital format for purposes of adaptation, for example choreographic works, architectural works, sculptural works and other three-dimensional works.

The case is also different when users take some part of an offline work and then 'publish' such work online, an infringement could occur to many types of copyrighted works protected offline, including the works that

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[466] See types of authors' works in Sterling, *World copyright law : protection of authors' works, performances, phonograms, films, video, broadcasts, and published editions in national, international, and regional law at* 6.02-6.16

[467] See chapter III

are protected by related rights.[468] But in cases where users take substantial parts of those works published online, their acts could infringe only some particular types of copyrighted works digitally published on the internet, as mentioned above. And thereby the limitations and exceptions of copyright infringement could be applied in those specific cases.

**Creative Commons**

In order to provide solutions for both copyright owners and users of the online works, a non-profit organisation known as Creative Commons (CC) offers a set of copyright licenses (Creative Commons licenses) to the internet participants. These licences, launched in 2002 with a free of charge, are based upon copyright. They offer some flexible tools for copyright owners and users of online copyrighted works, providing an alternative way for online negotiations. The licences allow a useful middle ground between full copyright control and the unprotected public domain.[469]

Aiming at helping others realise the full potential of the internet[470], CC licences consist of four major terms of licences: 1) Attribution (BY) - requiring attribution to the original author, 2) Share Alike (SA) - allowing derivative works to be published under the same licence, 3) Non-Commercial (NC) - prohibiting commercial uses of works, and 4) No Derivative

[468] See types of works which are protected by related rights in Sterling 6.38-6.43 and see also *Lenz v. Universal Music Corp*. 2013 WL 271673 (N.D. Cal. Jan. 24, 2013) although this case does not directly involve the right of making derivative work online.

[469] Hal Plotkin, 'All Hail Creative Commons / Stanford professor and author Lawrence Lessig plans a legal insurrection' (*Special to SF Gate*, 11 February 2002) <http://www.sfgate.com/news/article/All-Hail-Creative-Commons-Stanford-professor-2874018.php> accessed 29 June 2015

[470] 'What is Creative Commons and what do you do?' (*Creative Commons*) <https://wiki.creativecommons.org/wiki/Frequently_Asked_Questions#What_is_Creative_Commons_and_what_do_you_do.3F> accessed 29 June 2015

Works (ND) - prohibiting sharing of derivatives of the original works.[471] Each of these particular terms could be combined into six major licences:

- Attribution (CC BY)
- Attribution Share Alike (CC BY-SA)
- Attribution No Derivatives (CC BY-ND)
- Attribution Non-Commercial (CC BY-NC)
- Attribution Non-Commercial Share Alike (CC BY-NC-SA)
- Attribution Non-Commercial No Derivatives (CC BY-NC-ND)

It is very simple how the licences are used. The copyright owners of the online works could apply one of these combination terms of licences as suitable on their online copyrighted works in order to announce their permission. The future users would therefore know the conditions and scope of their rights under the licences before using the works for their purposes. This could happen without any person-to-person negotiation between both parties.

Even though CC licences are beneficial to both copyright owners and users, most importantly on their rights of making derivative work, the licenses themselves are non-exclusive and not revocable. This means that the licences will not be terminated unless there has been a breach of the conditions. However, the copyright owners can enter into additional or different licensing conditions for the same works at any time.[472] This provides some uncertainties to the prospective users of the works in which the licences applied.

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[471] 'What are Creative Commons licenses?' (*Creative Commons*) <https://wiki.creativecommons.org/wiki/Frequently_Asked_Questions#What_is_Creative_Commons_and_what_do_you_do.3F> accessed 29 June 2015

[472] 'How do CC licenses operate?' (*Creative Commons*) <https://wiki.creativecommons.org/wiki/Frequently_Asked_Questions#What_is_Creative_Commons_and_what_do_you_do.3F> accessed 29 June 2015

## II. CONCLUSION

In conclusion, this chapter attempts to clarify that even though there are some efforts in the international level to create a general acceptable standard on many criteria, the differences and conflicts between national laws in each jurisdiction still remain in many aspects.

*Firstly*, all the differences deepen in the fundamental concept of originality and creativity result in the different standard of copyright protection offered to derivative works as appeared in the US and the UK jurisdictions. Section A. not only confirms the importance of originality and creativity as a fundamental substance for copyright protection for both copyrighted and derivative works. It also emphasises that there are some links between originality and creativity and the *authorship* of the original creator over a work of creation. In this case, it is introduced in section A. that originality and creativity and *authorship* are the basic foundation of economic rights of the original creator granted under copyright regime. [473] Nonetheless, the interpretation of the meaning of originality and creativity in the internet era is not yet internationally agreed.

*Secondly*, in the area of fixation, it is certified that the meaning of *fixed* work of creation has been changed recently. The chapter emphasises the importance of RAM Copy Doctrine which has just been raised in the digital era. When the works that are temporarily stored in RAM could possibly be deemed *fixed* as specified in the RAM Copy Doctrine, on the other hand, it is noteworthy that some internet activity such as unauthorised temporary making reproduction for technological purposes or *browsing* a webpage have been excluded from copyright infringement. Nevertheless, there is no such exception for other popular unauthorised online activities such as *downloading*, *streaming*, *and screen capturing*. Most importantly, these

[473] The issue which will be discussed and confirmed afterwards in chapter III

activities (*downloading*, *streaming*, *and screen capturing*) are important substances for making subsequent online derivative works of those copyrighted literary works, musical works, audiovisual works, and images.[474] In addition, the meaning of RAM copy doctrine in the digital era is still controversial.

*Finally,* the study points out that apart from the first side of copyright which offers protection to the copyright owners (originality and creativity and fixation), there is another main part of copyright that allow some rooms for the subsequent users. That is the limitations and exceptions for copyright infringement. Under the concept of fair use and 'transformativeness' the subsequent user is allowed unauthorised borrowing substantial parts to create derivative works. However, the concept of fair use and 'transformativeness' in the digital environment has yet been internationally agreed.

The study in this chapter emphasises that, from the protection to the exception, each fundamental concept of copyright regime could not easily be agreed or harmonised amongst countries. Furthermore these various standards create unequal benefits between the copyright owners and the users of copyrighted works, particularly in the digital era. It is likely that the copyright owners could draw more benefits than the users under the current copyright scheme. Therefore, a well-balance of the regulations is needed to be formulated in order to increase the opportunity for the users in the internet era.[475]

The next chapters of this study will attempt to find a new possible standard and solutions for the right of online subsequent users of copyrighted work. It will look whether there is any possibility to create a solution in any part of the

[474] See chapter III and IV

[475] See chapter II

back bone of copyright scheme, whether that is the originality and creativity, fixation, or limitation and exception of copyright infringement.

# CHAPTER II

# CONFLICT OF RIGHTS: COPYRIGHT AND HUMAN RIGHTS

## I. WHY INDIVIDUALS?

### A. INDIVIDAULS AS THE MOST INFLUENTIAL PLAYERS IN THE DIGITAL ENVIRONMENT

Individual is the most influential players in the online environment. According to the statistics from the United Nations International Telecommunications Union (ITU) launched on 5th May 2014[476], the Internet Society's Global Internet Reports 2014 [477] and the figure shown on www.internetlivestats.com[478], the number of internet users is rising up rapidly each year. From 2004 to 2014 or within ten years, the number of internet users increases significantly from less than one billion to more than two billion. It is also expected that the number of individual internet users will hit 3 billion by the end of 2014, according to the ITU report.

Particularly in the mobile-broadband businesses, the statistics show that it holds the fastest growing market segment in comparison to those mobile-cellular and fixed telephone line subscriptions. Whereas the growth rates of mobile-cellular markets have reached their lowest-ever level of 2.6% globally, indicating their saturation levels, the mobile-broadband subscriptions, on the other hand, are continuing with a double-digit growth rates and will reach 2.3 billion in 2014.

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[476] 'Key ICT indicators for developed and developing countries and the world (totals and penetration rates)' (*ITU*, 10 July 2014) <http://www.itu.int/en/ITU-D/Statistics/Documents/statistics/2014/ITU_Key_2005-2014_ICT_data.xls> accessed 01 July 2015

[477] 'Internet Society Global Internet Report 2014' (*Internet Society*, 10 July 2014) <http://www.internetsociety.org/sites/default/files/Global_Internet_Report_2014_0.pdf> accessed 1 July 2015

[478] 'Internet Users' (*Internet Live Stats*, 10 July 2014) <http://www.internetlivestats.com/internet-users/#trend > accessed 1 July 2015

It is noteworthy that the number of mobile-broadband subscription as specified here is much higher than the number of fixed (or wired)-broadband subscriptions, which are shown as approximately only 0.7 billion globally. This data apparently suggests that in the very near future each individual person (with at least a mobile-broadband in their hands) will be the most potential players over the inter-connected networks and will also be vigorous participants on those contents delivered all over the internet.

For example, it is indicated in the Internet Society's report that in 2013 the video contents have reached up 50 per cent of all the internet traffic. With the significantly increasing numbers of mobile-broadband subscriptions, these popular video contents could vastly be disseminated to each of individual audiences who will be able to access to the technology regardless of their age, gender, language, religion, disability, economic status or ethnic background.

As discussed earlier in Chapter I, these individual users themselves could potentially act as either *pure user* or *subsequent creator* of a copyrighted work. As Manuel Castells demonstrates in *The Internet Galaxy* that individuals are the most influential player on the internet. Here come the idea of 'networked individualism' which formulated that each individual are eligible to use the internet as a platform to create their self-identity. The internet is now the 'me-centered networks' that provide unlimited opportunities for each individual to either produce or consume. Individuals now become the networks themselves and networked individualism becomes the new social pattern.[479]

Additionally, Matia Bakardjieva indicates in her work, *Internet Society: The Internet in Everyday Life,* that, these individual users more likely participate in

[479] David Bell, *Cyberculture Theorists : Manuel Castells And Donna Haraway* (Routledge 2007) pp467-468

the network as part of the on-going production instead of merely use what are provided by the technology. They could potentially be creative producers of new uses, new meaning and new content. Therefore, these internet participants are categorised by Bakardjieva as 'users' rather than 'consumers' in order to separate and emphasise between the activity of production and consumption.[480]

Therefore, for the purpose of this thesis, the most important role of those users is when they act as producers or subsequent creators and create a derivative work which could affect the benefits of the original author of the copyrighted work. At the same time, those derivative works created by these massive users could as well be copyrightable and provide them some profits. Thus, these potential users/creators are the most influential players in the digital environment.

## B. THE FUNDAMENTAL RIGHTS OF AUTHOR/CREATOR

Generally, in field of copyright law when an individual performs as a *pure user* of the copyrighted works and such act likely infringes the rights of the copyright owner, the regulations on copyright infringement will be applied. In this case that user could either be sued or escaped from being convicted by referring to the standard of limitations and exceptions of copyright infringement. It is argued, by many legal scholars[481] that, in this scenario the users are exercising their right of freedom of expression or the right to free speech which is guaranteed under Article 19[482] of the Universal Declaration of

[480] Ibid p41

[481] See Paul Torremans, *Intellectual Property And Human Rights* (Enhanced ed. of Copyright and human rights. edn, Kluwer Law International ; Biggleswade : Turpin Distribution Services 2008)

[482] The Universal Declaration of Human Rights (UDHR), article 19'*Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without*

Human Rights (UDHR) and is accompanied under the internal mechanism of limitations and exceptions of copyright infringement.[483]

However, the situation becomes more complex when that user acts as both the user of the copyrighted work and the author or creator of the subsequent work at the same time, particularly under the online environment.

In that respect, first of all article 19 of UDHR offers protection to the right to freedom of expression of both user and creator in the sense that they are free to impart information through the internet regardless of frontiers. In addition, these specific authors or creators of the literary and artistic work are also qualified for copyright protection under Article 3 of the Berne Convention and Article 9 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Furthermore, as the author or creator, it is argued that they are qualified for protection on some other rights such as the right to property under Article 17[484] and the right to share and protection of their literary or artistic production under Article 27[485] of UDHR as well.

These Articles of UDHR, Berne and TRIPs regulations highlight a very problematic situation when a man himself could either be both user and creator at the same time because at least there are four layers of the protections of their rights that are overlapped. These are the right to freedom

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*interference and to seek, receive and impart information and ideas through any media and regardless of frontiers.'*

[483] Michael D. Birnhack, 'Acknowledging the Conflict Between Copyright Law and Freedom of Expression Under the Human Rights Act' [2003] Entertainment Law Review Available at SSRN: http://ssrn.com/abstract=368961

[484] UDHR 1948, article 17 (1) *'Everyone has the right to own property alone as well as in association with others. (2) No one shall be arbitrarily deprived of his property.'*

[485] UDHR 1948, article 27 (1) *'Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits. (2) Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.'*

of expression, the right to property, the right to receive intellectual property protection, and copyright.

It is also huge problem when trying to identify who is the real author of the created work. But once one is presumably an author, the four areas of the right will always be associated. For purpose of this chapter, the discussion will be focused mainly on the three main types of the human rights of author and user. The detailed discussion about the relationship between copyright and *authorship* will be provided later in chapter III.

## C. THE RIGHTS OF MAKING DERIVATIVE WORKS

This is a very important right under the Berne Convention and TRIPs that provides the original author a specific right to make a derivative work or make adaptation of the original work. It is a very strong right of the original creator of the artistic work as discussed in Chapter I and is one form of economic rights of the author as guaranteed by copyright protocols.

In this particular sense, it is a problem when user of a work also acts as a subsequent creator. This means that parts of the original work would be borrowed by that user either with or without authorisation of the original author. Therefore it is an important question whether or how the right of such user is guaranteed, since that user is not even the original creator of the work but merely a subsequent creator.

So it is an important question whether or how a subsequent creator is protected under the UDHR and the copyright regime. Do they have any legitimate rights to borrow and create a new work? A study in this chapter on the nature of the rights of an individual user who is as well qualified to be a subsequent creator is very significant in the sense that it could identify the substances of the four rights which are overlapped and conflicted. A

discussion specifically on derivative right as one of the exclusive rights under the copyright regime, will be analysed further in chapter III.

## II. COPYRIGHT AND HUMAN RIGHTS CONFLICTS

First of all, the discussion in this chapter will be conducted fundamentally based on a comparison between the natures of these four rights: copyright, the right to property, the right to intellectual property right protection, and the right to freedom of expression. The right to internet access which is the new term of right will also be added afterwards since the purpose of this thesis is to look at the activity of the online user in the internet era. The main purpose of this Chapter, however, is to identify and understand the fundamental concept of each right and their conflicts for purposes of future discussion (see chapter III).

It has been argued that copyright is not only regarded as 1) a kind of intellectual property rights but it is also characterised 2) as property right. Property right is regarded as a kind of human right according to the UDHR. On the other hand, it is controversial whether intellectual property right (or the right to receive intellectual property protection, aka *'the right to the protection of moral and material interests in intellectual creation'*[486]) could be recognised as human right[487] even though the term of such right is obviously guaranteed under the UDHR.

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[486] Peter K. Yu, 'Challenges to the Development of a Human-Rights Framework for Intellectual Property ' in Paul Torremans (ed), *Intellectual Property And Human Rights (2008)* (Enhanced ed. of Copyright and human rights. edn, Kluwer Law International ; Biggleswade : Turpin Distribution Services 2008) p79

[487] See Yu PK, 'Challenges to the Development of a Human-Rights Framework for Intellectual Property ' in Torremans P (ed), *Intellectual Property And Human Rights (2008)* (Enhanced ed. of Copyright and human rights. edn, Kluwer Law International ; Biggleswade : Turpin Distribution Services 2008) p79 and Torremans P, 'Copyright (and Other Intellectual Property Rights) as a Human Right ' in Torremans P (ed), *Intellectual Property And Human Rights (2008)* (Enhanced ed. of Copyright and human rights. edn, Kluwer Law International ; Biggleswade : Turpin Distribution Services 2008) p203

Nonetheless, that argument is beyond the study of this thesis. For the purpose of the study, this thesis will leave out the argument on the human right status of the right to intellectual property which are still questionable. On the contrary, the discussion will be directed mainly based on a presumption that the right to intellectual property is a kind of human right. Therefore, from that presumption, under the term of copyright lies the two major doctrines of human right which are important for protection of the right of an author: property right and the right to intellectual property. The right to freedom of expression, however, is another area of right which could stifle, support, or balance the function of that copyright protection regime, the answer of which will come at the conclusion of this chapter.

The discussion in this topic will particularly analyse the two major layers of copyright: 1) nature of copyright right as intellectual property right and 2) nature of copyright as property right under the UDHR. These two important layers apparently provide a certain degree of conflicts in the past decades.

Furthermore, there are also another two aspects which create serious tensions under the copyright regime: 1) the overlapping between the concept of copyright and the right to freedom of expression and 2) the overlapping between the concept of copyright and the right to internet access, which are increasingly discussed in the digital ages.

Generally, there are both international and regional level mechanisms which relate the value of intellectual property right protection to human rights. As for the international level, the human rights values were recognised under the Universal Declaration of Human Rights 1948 (UDHR)[488] with a

[488] UDHR 1948, article 27(1) *'Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits. (2)*

binding commitments under the International Covenant on Economic Social and Cultural Rights 1996 (ICESCR).[489] For regional level, according to Helfe[490], the value of intellectual property as human right is suggested under Article 1 of Protocol 1 of the European Convention for the Protection of Human Rights and Fundamental Freedoms 1950 (ECHR).[491] This is even though it appears under the term of property right, not in a separate form of the right to intellectual property right protection.

Regarding the right of freedom of expression, it is recognised in the international level, both under the UDHR and the International Covenant on Civil and Political Rights 1996 (ICCPR) which has a binding commitment[492], and Article 10 of the ECHR.[493]

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*Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.'*

[489] ICESCR 1996, article 15. 1. *'The States Parties to the present Covenant recognize the right of everyone: (a) To take part in cultural life; (b) To enjoy the benefits of scientific progress and its applications; (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.'*

[490] Laurence R. Helfe, 'The New Innovation Frontier? Intellectual Property and the European Court of Human Rights' in Paul Torremans (ed), *Intellectual Property And Human Rights (2008)* (Enhanced ed. of Copyright and human rights. edn, Kluwer Law International ; Biggleswade : Turpin Distribution Services 2008) p26

[491] ECHR 1950, article 1 *'Protection of property: Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.'*

[492] ICCPR 1996, article 19. 1. *'Everyone shall have the right to hold opinions without interference. 2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice. 3. The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary: (a) For respect of the rights or reputations of others; (b) For the protection of national security or of public order (ordre public), or of public health or morals.'*

[493] ECHR 1950, article 10. 1. *'Everyone has the right to freedom of expression. this right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises. 2.The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or the rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.'*

## A. THE UNIVERSAL CHARACTERISTICS

The universal characteristic means the nature of copyright which is generally recognised and confirmed in most parts of the world. It might not be literally universal but this is the characteristic which bears a standard which is widely accepted in most jurisdictions.

### A.1. Copyright as Intellectual Property Right

First of all, what is intellectual property? The term *intellectual property* is found in 1845 in the case of *Davoll et al. v. Brown.*, in which Justice Charles L. Woodbury mentioned that *"…and only in this way can we protect **intellectual property**, the labors of the mind, productions and interests as much a man's own, and as much the fruit of his honest industry, as the wheat he cultivates, or the flocks he rears."*[494]

According to the WIPO, the term 'intellectual property' refers to *creations of the mind*: inventions; literary and artistic works; and symbols, names and images used in commerce. Intellectual property is divided into two categories: Industrial Property and Copyright.[495] Therefore, according to the WTO, 'intellectual property rights' are the rights given to persons over *the creations of their minds*. They usually give an exclusive right to the creators over the use of their creation for a certain period of time.[496] According to the WIPO, again, intellectual property rights are just like other property right. They allow creators, or owners, of the industrial property or copyright to benefit from the protection of their own work or investment in a creation as

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[494] *Davoll V. Brownc. C. Mass.* [1845] Case No 3,662, 1 Woodb & M 53; 2 Robb, Pat Cas 303; 3 West Law J 151; Merw Pat Inv 414

[495] 'What is Intellectual Property?' (*WIPO*) <http://www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf> accessed 1 July 2015

[496] 'What are intellectual property rights?' (*World Trade Organization*) <https://www.wto.org/english/tratop_e/trips_e/intel1_e.htm> accessed 1 July 2015

outlined in Article 27 of the 1948 UDHR.[497] Also the right is advocated in Article 15 of the ICESCR, though not in the regional level (ECHR).

The UDHR does not require any international obligation to the members. The ICESCR, on the other hand, has a binding legal commitment that requires all parties to ''*take steps... to the maximum of its available resources, with a view to achieving progressively the full realization of the rights recognized in the present Covenant.''*[498]

Apart from those international human right standards, the right to intellectual property right is also protected under the international trade agreement, The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) which requires the member states an obligation to provide protections to both copyright and industrial property. Regarding copyright, the member states also have to comply with those Articles in the Berne Convention.[499]

Nevertheless, although it is stated under the WTO and WIPO documents about the intellectual property right protection, historically, the definition of 'intellectual property' under the human right genre is still unclear. According to Audrey Chapman, there are *'relatively weak claims for intellectual property as a human right.'*[500] Most of the discussions in the drafting sessions over article 27 of the UDHR and article 15 of the ICESCR never provide a conceptual foundation on the scope and boundaries of the right. They *'focused primarily on whether an intellectual property provision*

[497], 'What is Intellectual Property?'

[498] ICESCR 1996, article 2

[499] TRIPs 1995, article 9

[500] Audrey R. Chapman and Sage Russell, *Core obligations : building a framework for economic, social and cultural rights* (Intersentia 2002) at 314

*should be included, rather than on its interpretation.'*[501] Thus the definition of intellectual property as human right remains controversial. It even appears in the General Comment No. 17 that *'It is therefore important not to equate intellectual property rights with the human right recognized in article 15, paragraph 1 (c).'*[502]

Notwithstanding, even though intellectual property right was not confirmed as human right under this article, article 15 (c) of the ICESCR still provides protection to *'the human right to benefit from the protection of the moral and material interests resulting from one's scientific, literary and artistic productions'* which *'safeguards the personal link between authors and their creations'* and *'which are necessary to enable authors to enjoy an adequate standard of living'.*[503]

Therefore, according to the UDHR, ICESCR, it is certified that *'the right to the protection of interests in intellectual creations'*[504] or in this thesis it is called 'the right to receive intellectual property protection' must be guaranteed at least under the laws of those countries which participate in both international human right instruments. That is the right for the creators to the protections of the *moral interests* and *material interests* over the use of their intellectual creation.[505]

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[501] Ibid, at 305, 315

[502] Economic and Social Council United Nations, *General Comment No.17 (2005)* (Committee on Economic, Social and Cultural Rights, Thirty-fifth session, Geneva, 7 - 25 November 2005, 2006) at I.3 available at http://tbinternet.ohchr.org/_layouts/treatybodyexternal/Download.aspx?symbolno=E%2fC.12%2fGC%2f17&Lang=en

[503] Ibid at I.2

[504] Peter K. Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 UC Davis Law Review 1039 p1045

[505] UDHR 1948, article 27 (2) and ICESCR 1996, article 15. 1 (c)

Whereas the protection of *moral interests* is to *"safeguards the personal link between authors and their creations and between peoples, communities, or other groups and their collective cultural heritage"*[506] and protection of *material interests* is to *"enable[s] authors [and inventors] to enjoy an adequate standard of living"*[507], it is suggested that these human right values of the rights of creators has not been affiliated in the international intellectual property system. There is no other reference to this 'human rights value' represented in multilateral intellectual property treaties such as the Berne Convention, Paris Convention, Rome Conventions, and the TRIPS Agreement. The principal of the right to receive intellectual property protection as certified under those international agreements are grounded not on the basis of the inherent needs of human beings, but arise from the efforts to certify mainly the economic benefits of intellectual property products, using the terms *"rights," "private rights,"* and *"exclusive rights."*[508]

Notwithstanding, the protection of *moral interests* offers the idea to protect the benefits of the authors *"in addition to just remuneration for [the authors'] labour," namely the protection of "a moral right on their work and/or discovery which shall not disappear, even after such a work or discovery shall have become the common property of mankind."*[509] It also *'include[s] the right of authors to be recognized as the creators of their scientific, literary and artistic productions and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, such productions,*

[506] United Nations *General Comment No.17 (2005)* at I.2

[507] Ibid at I.2

[508] Laurence R. Helfer, 'Toward a Human Rights Framework for Intellectual Property' (2007) 40 UC Davis Law Review 973 pp979-980, In comparison, see also the discussion about 'material interests' in this chapter

[509] United Nations *General Comment No.17 (2005)*at I.12

*which would be prejudicial to their honour and reputation'.*[510] When appear under the intellectual property regime, this basis is considered the 'moral rights' of author which is the most similar to human right.[511] The TRIPs agreement, however, provides the exception on an obligation to the protection of 'moral rights'.[512] The right has long been controversial between the US and the civil law countries since the time of the Berne Convention.[513] The UK, however, adopted Article 6bis of the Berne Convention in 1928 and has recognised the protection of moral right in the Copyright, Designs and Patents Act 1988 (CDPA).

Regarding the protection for *'material interests',* the phrase seems to cover all forms of economic interests in intellectual creations of the author. It *'reflects the close linkage of this provision with the right to own property, as recognized in article 17 of the Universal Declaration of Human Rights and in regional human rights instruments, as well as with the right of any worker to adequate remuneration (art. 7 (a)).'*[514] This economic interest in intellectual creations of the author, on the other hand, is often correlated by commentators and the intellectual property industries to the protection of

[510] Ibid at I.13

[511] See Yu PK, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 UC Davis Law Review p1081

[512] TRIPs 1995, article 9 (1)

[513] At the beginning of joining, the U.S. took a narrow interpretation of the moral rights requirements in the Berne Convention. This leads to the questions whether the U.S. is in fact complying with the Convention. However, eventually, moral rights are arguably protected in the US under various federal and state laws including the Visual Artists Rights Act 1990 ("VARA"). See also Robert C. Bird and Lucille M. Ponte, 'Protecting Moral Rights in the United States and the United Kingdom: Challenges and Opportunities under the U.K.'s New Performances Regulations' (2006), Boston University International Law Journal [Vol. 24:213 2006]

[514] United Nations *General Comment No.17 (2005)*at I.15

human right on 'private property'.[515] As two scholars on strong property rights protection stated:

> *"IP protection has long been recognized as a basic human right, and the tension between the rights of the creators and the rights of consumers has been successfully resolved by the development and modification of intellectual property protections over the years. Those who want to weaken IP protections are really tapping into a failed and discredited economic theory that the public doesn't benefit from privately owned goods. However, expropriation of others' property not only undermines creation and invention, it also undermines economies and societies. It is, ironically, one of the most "anti-human rights" actions governments could take."* [516]

Reflecting their socialist interests and the dynamics of the Cold War, the USSR and the Eastern alliances, however, strongly disagreed with the idea to incorporate the provision on intellectual property into the ICESCR. They argued that the right of authors and creators to benefit from science should not be mixed up with property rights. The socialist alliances' opposition had played an important role in the decision of the Covenant's drafting committee

[515] See Yu PK, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 UC Davis Law Review p1084

[516] Tom Giovanetti and Merrill Matthews, 'Intellectual Property Rights and Human Rights' (*Institute for Policy Innovation*, September 2005) <http://www.ipi.org/docLib/IPandHumanRights.pdf-OpenElement.pdf> accessed 1 July 2015, See also Robert L. Ostergard J, 'Intellectual Property: A Universal Human Right?' [1999] Human Rights Quarterly 211 156 p175 argued that even though *'[t]he Universal Declaration of Human Rights recognizes IP as a universal human right… other issues that relate to physical well-being must take priority over the guarantee of IP as a universal human right'*

to withhold the text of article 17 of the UDHR recognizing the right to tangible forms of property in the 1966 Covenant.[517]

In the fifteenth century, at the beginning of the protection of intellectual property right, the laws on intellectual property right probably originated in the system of royal privilege-giving which seems to have operated in most of medieval Europe. After that, around the nineteenth century, the concept turned to the principle of territoriality in which the intellectual property rights would not be extended beyond the territory of the sovereign state which has granted the rights in the first place. This emphasised the intimate connections between sovereignty, property rights and territory. During that time the intellectual property right protection grew along the colonial pathways outside of Europe, before the 1994 TRIPS Agreement would mark the beginnings of property globalization.[518] Eventually, even with its early historical background on monopoly and privilege and the objections of those socialist alliances, the concept of economic rights as property right (and exclusive right) of authors and creators to prevent others from using or altering their creations has now made its objective to support the promotion of technological innovation, to the mutual advantage of producers and users amongst all 158 countries of the WTO member.[519]

These international mechanisms of protection of *moral interests* and *material interests* or the protection of intellectual property rights of the authors may or may not be universal according to Drahos. Even though

[517] Audrey R. Chapman, 'Towards an Understanding of the Right to Enjoy the Benefits of Scientific Progress and Its Applications' (2009) 8 Journal of Human Rights 1 p6

[518] Peter Drahos, 'The Universality of Intellectual Property Rights: Origins and Development' (Intellectual Property and Human Rights, World Intellectual Property Organization, A Panel Discussion to commemorate the 50th Anniversary of the Universal Declaration of Human Rights, Geneva, 9 November 1998) p13-41

[519] TRIPs 1995, article 9

intellectual property rights are universally recognized, it could be argued that they may not be regarded as 'the universal norms' or as human rights. This is because, for moral realists, human rights exist outside the framework of recognition in positive law. Also for non-moral realists, only this recognition of rights may not satisfy a claim that something has the universal status of human right. Intellectual property could neither be easily identified as natural right[520] nor fundamental right.[521] Even if the protection on *material interests* which protects the property rights of the creators could somehow be justified as a natural right, one question is whether intellectual property rights are natural property rights. This is because the protection of intellectual property rights will exist only for a limited period of time. That special qualification of intellectual property rights protection is very different from other natural rights such as the right to life and liberty.[522]

Likewise viewing the status of the protection on *moral interests* as a fundamental right or human right might be also problematic. As mentioned earlier, according to Peter K. Yu, the protection of moral interest could be regarded as the protection of 'moral rights' of the creators. However, since not all intellectual property rights provide protection to personality or moral right of their creators, even if the protection of personality or moral right could be categorised as a type of human rights, there will be very few intellectual property rights that could make it into the human right category. [523] In other words, even though intellectual property rights are

[520] Such as the right to life, liberty, and property, See John Locke, *Two Treatises of Government / John Locke ; A Critical Edition With An Introduction And Apparatus Criticus* (Peter Laslett ed, London, Cambridge University Press 1967)

[521] Such as human rights

[522] Drahos

[523] Ibid pp20-22

universally recognised under international human right mechanisms, it is unlikely that they are naturally human rights per se.

In this regard, the 'right to receive intellectual property protection' or *'the right to the protection of interests in intellectual creations'*[524] could be regarded as a 'universal' only because, first of all, it is plausibly be regarded as human right, and human rights exist independently of the recognition, regulation or approval of particular states or legal systems. The right to receive intellectual property protection therefore, from this particular point of view, exists regardless of the protection offered by current intellectual property laws and treaties. In addition, the existing national intellectual property laws, the Paris and Berne Conventions, TRIPS, the World Intellectual Property Organization (WIPO) Internet Treaties, and other international, regional, and bilateral agreements serve merely as points of reference.[525]

**Conflicts:** Focusing on copyright as a kind of intellectual property right, the standard of copyright protection is presumably not much different amongst countries according to the Berne Convention and TRIPs. Copyright offers minimum standard of protections to the interests in intellectual creations of the authors. This likely confirms the universality of copyright as the right that protects the interests in intellectual creations of the authors. Or in other words, copyright offers protection to 'intellectual property' of the creators. In this respect, it provides 'the right to receive intellectual property protection' to the authors as certified under UDHR and ICESCR.

However, viewing copyright itself as a universal human right may provide some conflicts. Regarding the two types of interest: *moral interests*

[524] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1045

[525] See Yu PK, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 UC Davis Law Review 1039 pp1080-1081 and footnote 154

and *material interests* of the creator, copyright offers the protection on *moral interests* through the system of 'moral rights', and provides the protection of '*material interests*' through the notion of 'economic rights'. Moral right grants protection to *'the right of authors to be recognized as the creators of their scientific, literary and artistic productions and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, such productions, which would be prejudicial to their honour and reputation."*[526]The right is important to human dignity because it *"safeguards the personal link between authors and their creations."*[527]

*Material interests* or economic rights of the author, on the other hand, offer protections similarly to the right to private property. However, it is suggested that the phrase *'material interests'* should not be interpreted broadly to cover all forms of economic rights but rather in a limited range to cover only the remunerations for 'intellectual labour' of the creators, thus narrower than the general term of private property and does not include the right to own property.[528] Under copyright regime, according to Peter K. Yu and Chapman, this economic right protection contains no human rights basis especially when it provides safeguard to the economic investments of institutional authors or the corporate holders.[529] Thus, because of the lack of human rights basis, none of these economic rights of the corporate holders would qualify as human rights. As Green noted with respect to the ICESCR,

[526] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1082 footnote 161 referred to Comm. on Econ., Soc. & Cultural Rights [CESCR], United Nations *General Comment No.17 (2005)*

[527] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework'p1081 footnote 157 referred to Comm. on Econ., Soc. & Cultural Rights [CESCR], United Nations *General Comment No.17 (2005)*

[528] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1085, 1088

[529] Ibid p1080

that *'[T]he drafters do not seem to have been thinking in terms of the corporation-held patent, or the situation where the creator is simply an employee of the entity that holds the patent or the copyright.'* [530] Also the General Comment No. 17 emphasised that since the corporate entities remain outside the scope of human rights protection, *'their entitlements . . . are not protected at the level of human rights.'* [531] This conceptual analysis leads to the further discussions in chapter III specifically on how the business entities could draw higher economic benefits from the current copyright protection system rather than the individual authors/creators, even though their rights are not guaranteed at the human right level.

In sum, the discussion above suggests that, in the situation where the human right value of intellectual property right protection is emphasised, the economic rights of the corporate right holders tend to be excluded due to the lack of their human right basis. Applying such argument into the copyright context, this system will encourage the development of an author-centred regime, rather than the publisher-centred environment. [532] However, the current copyright protection system in co-ordination with the powerful internet technology is organising some unexpected opposite results. The issue could be found from the detailed discussion in chapter III.

In other words, as human beings, the individual creators receive copyright or human right protections for both *moral interests* and *material interests* in their intellectual creation. They are fundamentally protected under both terms. But these human rights level of protections do not extend to the

[530] Ibid pp1128-1129 referred to Maria Green, Int'l Anti-Poverty L. Ctr., Drafting History of the Article 15(1)(c) of the International Covenant, ¶ 45, U.N. Doc. E/C.12/2000/15 (Oct. 9, 2000)

[531] Ibid p1129 referred to Comm. on Econ., Soc. & Cultural Rights [CESCR] and United Nations *General Comment No.17 (2005)*

[532] See Yu PK, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 UC Davis Law Review 1039 p1131

corporate entities. The institutional authors could not receive moral right protection for their *moral interests* as well as the human right level of property right protection for their *material interests*, nevertheless. Therefore they could not have *authorship* over a work of creation as suggested in chapter III. The only thing they could have is the 'human rights'-like protections through national legislations of the states.[533]

This represents the conflict of rights between the individual authors and institutional copyright holders in the sense that the individual creators receive stronger protection than the business entities under the copyright regime. Most importantly, that protection is more or less universal. In addition, this status of individual creators also plays an important role in relevant to their '*authorship*' prominence as will be discussed further in chapter III. On the contrary, the discussion in chapter III on the comparison between the online interests of the individual authors, publishers, and individual may suggest an opposite result.

### A.2. Copyright as Property Right

The right to property is guaranteed under Article 17 of the UDHR as a kind of fundamental human right.[534] The broad language of this Article applies to property ownership in both individual and collective forms[535] but does not include the protection for the right to private property.[536] Furthermore, the right is not recognised under the international covenants, neither the International Covenants on Economic, Social and Cultural Rights (ICESCR) nor

[533] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1130

[534] UDHR 1948, article 17 (1) *'Everyone has the right to own property alone as well as in association with others. (2) No one shall be arbitrarily deprived of his property.'*

[535] Catarina Krause and Gudmundur Alfredsson, in *The Universal Declaration of Human Rights : A Common Standard Of Achievement* (The Hague ; London ; Kluwer 1999) p364

[536] Lars Adam Reholf, in *The Universal Declaration of Human Rights : A Common Standard Of Achievement* (The Hague ; London ; Kluwer 1999) p252 at footnote 3

the International Covenant on Civil and Political Rights (ICCPR). This is due to the disagreement in the formulation of the right during the drafting process, such as the scope of property, conformity with State laws, expropriation and possible limitations.[537] Both covenants impose legal binding obligation on the member states, but the UDHR does not. Failing to be included into the ICESCR and ICCPR, however, does not exclude 'the right to property' from the universal human rights protection scheme.[538]

At the regional level, nonetheless, the right is acknowledged under Protocol 1, Article 1 of the European Convention on Human Rights.[539]

According to WIPO, *'intellectual property'* refers to *'the creation of human mind'*. This includes the creations such as the inventions, literary and artistic works, symbols, names and images used in commerce.[540]*'Intellectual property **rights**'*, in this particular aspect, are similar to other property rights. They protect the interests of creators by providing them property rights over their creations.[541] Applying that statement to the framework of Jeremy Waldron (which will be discussed afterwards), it is likely that intellectual property right offers a property right (ownership) over *'the creations of the human mind'* in the sense that the creators could determine how that

[537] Alfredsson pp366-367

[538] Ibid p365

[539] ECHR 1950, article 1 *'Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.*
*The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.'*

[540], 'What is Intellectual Property?' p2

[541] 'Understanding Copyright And Related Rights' (*WIPO*) <http://www.wipo.int/edocs/pubdocs/en/intproperty/909/wipo_pub_909.pdf> accessed 1 July 2015 p3

creations would be used, and that the decision of the creators is final.[542] The property right (ownership) over *'the creations of the human mind'* is different, to a certain degree, with the property right (ownership) over the material objects, however.[543]

According to Peter K. Yu, in light of the UDHR and the ICESCR, even though the ICESCR does not include a protection on the right to own property, the phrase 'material interests' recognised under Article 27 (2) of the UDHR and Article 15(c) of the ICESCR, nevertheless, provide the creator with some type of economic interest protection although that protection is seen as narrower than those usually provided under the right to private property.[544]Therefore, Intellectual property right protection contains a degree of protection which is, to some extent, similar to the protection of property right. This right to property, or property right, is universally guaranteed under the Article 17 of the UDHR.

Additionally, apart from the basis of property right, according to Peter K. Yu, the protection of economic interests (or material interest) in intellectual creations - the intellectual property right protection - is often equated by scholars and the intellectual property industries with the protection of private property.[545] Although Article 17 of the UDHR covers the right to own property as mentioned earlier, it does not protect the right to own private property, however.[546]

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[542] Jeremy Waldron, *The right to private property* (Clarendon 1988) p47, 60

[543] Ibid p30, 34, See also Waldron J, 'From Authors to Copiers: Individual Rights and Social Values in Intellectual Property' (1992) 68 Chicago-Kent Law Review 841 pp847-849

[544] See Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1085

[545] Ibid p1084

[546] Ibid p1086

### The Concept of Private Property

The concept of private property, according to Jeremy Waldron, is the system where the owner of material resources is the individual. That specific individual whose name is attached to the material object is the person who will determine how the object will be used. This general concept of private property differs from the other concepts of another two types of property, namely the collective property and the common property.[547] Nonetheless, though there are generally three types of property system, these concepts are difficult to apply in the real world. Waldron argued, with regard to Max Weber, that *'none of these ideal types … is usually to be found in historical cases in "pure" form'.* There are likely compromises amongst these three theories in both socialist and capitalist economic systems.[548]

Also, even though these three distinguished systems of property are different in terms of material allocation[549], they share one important similarity in the 'concept of ownership'.[550] This means that, although 'the conceptions of ownership' may differ amongst Western and other economic societies; 'the concept of ownership', however, appears in every society not only in the private property system.[551]

As mentioned earlier, in view of WIPO, intellectual property, unlike material property, are incorporeal property. From this rationale therefore the discussion regarding ownership over intellectual property or incorporeal property is left aside in Waldron's framework on private property discussion.

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[547] Waldron pp38-42

[548] Ibid p44

[549] Ibid pp38-42

[550] Ibid pp47-59

[551] Ibid pp47-59

However, in his following work, Waldron also argues in favour of the notion of intellectual property right as the right to private property, taken from the individualist perspective. But then again, when looking at the social perspective or social interests, he emphasises that the idea seems to be declined.[552]

Therefore, according to the discussion above, even though the status of intellectual property right as the right to private property is still controversial, taken the statement of WIPO that intellectual property right is similar to property right, the recognition of property right in the international human right instrument, and the compromises between various economic systems on the concept of property and ownership, it could be argued, particularly, in this respect that the notion of intellectual property right as property right possess a fundamental universality qualification. The right may not be universal and natural, however, in the sense that *'the individual concerned are born with them'*.[553] Rather it is universal and natural, as Waldron refers to Locke's view in his book, in the sense that *'anyone **might** have them; no one is ruled out of the domain of these rights a priori."*[554]

The universality of intellectual property right as property right remains even though there are different standards between the UK court, which recognised the *'common-law right of literary property and the principle of perpetual copyright'*[555] in *Millar v. Taylor*[556] (the idea was confirmed later in

[552] Jeremy Waldron, 'From Authors to Copiers: Individual Rights and Social Values in Intellectual Property' (1992) 68 Chicago-Kent Law Review 841 pp845-846

[553] Waldron, *The right to private property* p19

[554] Ibid p20

[555] Mark Rose, 'The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship' (1988) 23 University of California Press 85 p53

[556] *Millar v Taylor*

*Donaldson v Becket*[557]though the idea of 'perpetuity' has been reversed*),* and the Russian Copyright Act 1928, which limited authors' property interests by *'plac[ing] them within the broader context of a non-property theory of authorship.'*[558]

From this particular point of view, the disagreement between national copyright laws does not decline the universal qualification of intellectual property right as the right to property.

**Conflicts:** Regardless of the right to private property, since the concept of property right is universally recognised, and part of intellectual property right is regarded as the right to property, the thesis will now focus on copyright as intellectual property right and the right to property.

As mentioned earlier, the right to property involves one important and unavoidable aspect; 'the concept of ownership'. Since copyright is regarded as the right to property, it is presumably that the creators of the work would have ownership over the works they have created, so called literary and artistic works. Applying Waldron's framework, such ownership would allow the creators to determine how those literary and artistic works would be used, and their decision would be final.

The idea of property right in literary works stem from John Locke's principle that an individual's person was his own property, and when a creation is made through the exercise of his own labour, a man will receive a property right over that creation, as described in his work, the *Two Treatises of Government,* that;

[557] *Donaldson v. Becket* (1774) Hansard, 1st ser, 17 (1774): 953-1003

[558] Mira T. Sundara Rajan, 'Copyright and Free Speech in Transition: The Russian Experience' in Suthersanen Uma Griffiths Jonathan (ed), *Copyright and free speech : comparative and international analyses* (Oxford : Oxford University Press 2005)

> *''Though the Earth, and all inferior Creatures be common to all Men, yet every Man has a Property in his own Person. This no Body has any Right to but himself. The Labour of his Body, and the Work of his Hands, we may say, are properly his. Whatsoever then he removes out of the State that Nature hath provided, and left it in, he hath mixed his Labour with, and joyned to it something that is his own, and thereby makes it his Property.''*[559]

Long before Locke's idea of property right was elaborated, copyright originated under the English law, for purpose of censorship, as a publisher's right, *'a right which functioned in the interest of the publisher, with no concern for the author.'*[560] When the Licensing Act 1662 has come to an end, Locke complained about the monopoly of the stationers and proposed that the property right of the stationers (who purchase copies from authors) should be limited to a certain number of years after the death of the author.[561] However, not until the enactment of the Statute of Anne 1709 and after the cases of *Millar v. Taylor* and *Donaldson v Becket* that the author's right to be regarded as the proprietor of the work has been framed.[562]

Even though it is recognised that the authors possess a common-law copyright and therefore, according to Locke, they are proprietor of the literary work, the important question raised in the eighteenth-century was that: though the authors have property right over the physical manuscript that they

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[559] John Locke, *Two Treatises of Government / John Locke ; A Critical Edition With An Introduction And Apparatus Criticus* (Peter Laslett ed, London, Cambridge University Press 1967) pp305-306

[560] L. Ray Patterson, *Copyright in historical perspective* (Vanderbilt University Press 1968) pp8-13

[561] Ronan Deazley, *On The Origin Of The Right To Copy : Charting The Movement Of Copyright Law In Eighteenth- Century Britain (1695-1775)* (Hart 2004) p4

[562] Rose, 'The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship' pp51-54

had written, how could they be said to have a property right in the words they had written. *'Since an object of property must be something capable of istinct separate possession.'*[563] As Justice Joseph Yates stated in *Millar v. Taylor* that;

> *'But the property here claimed is all ideal; a set of ideas which have no bounds or marks whatever, nothing that is capable of a visible possession, nothing that can sustain any one of the qualities or incidents of property. Their whole existence is in the mind alone; incapable of any other modes of acquisition or enjoyment, than by mental possession or apprehension; safe and invulnerable, from their own immateriality: no trespass can reach them; no tort affect them; no fraud or violence diminish or damage them. Yet these are the phantoms which the author would grasp and confine to himself: and these are what the defendant is charged with having robbed the plaintiff of.'*[564]

However, according to Mark Rose and Rona Deazley, what Blackstone found and identified as "style" is very essential for this question:

> *'Style and sentiment are the essentials of a literary composition. These alone constitute its identity. The paper and print are merely accidents, which serve as vehicles to convey that style and sentiment to a distance. Every duplicate therefore of a work, whether ten or ten thousand, if it conveys the same style and sentiment, is the same*

[563] Ibid p60

[564] *Millar v. Taylor English Reports, 98:233* at Rose, 'The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship'p60

*identical work, which was produced by the author's invention and labour.'*[565]

From that idea, Blackstone has created a distinction between *''the book', 'the ideas conveyed in that book, and 'those words in which an author has clothed his idea.''*[566] Then again, the concept of distinction between a personal right and an object of property was emphasised and reaffirmed by Joseph Yates, denying that *'anything incorporeal should be treated as property in the same sense as a house or land.'*[567]

Therefore, according to Mark Rose, there is a twin birth, simultaneously, in the emergence of the law of the proprietary author and the literary work. *'The two concepts are bound to each other. To assert one is to imply the other, and together, like the twin suns of a binary star locked in orbit about each other, they define the center of the modern literary system.'*[568]

Accordingly, this thesis will argue that this is how the idea of 'ownership over property' and '*authorship* over the creation of the mind' has arisen, met and interacted in the area of copyright protection. Moreover, it will be further emphasised in chapter III that an individual author could possess either ownership or *authorship* over their work of creation, although this fundamental concept may not apply as well to the corporate holders.

Therefore, according to the discussion above, when focusing on copyright protection as the right to property, there are two strong concepts lie

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[565] *Tonson v. Collins English Reports, 96: 189* at Rose, 'The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship'p63

[566] Deazley p160

[567] Rose, 'The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship' p65

[568] Ibid p65

beneath which needed to be discussed profoundly; the concept of ownership and the concept of *authorship*. The two concepts apply differently to individual authors/creators and business entities as will be discussed further in chapter III.

In this regard, it could be inferred, generally, that the institutions possess ownership in copyright, with exclusive rights, as the copyright holders, but they have no *authorship* over the works of creation. The individual creators, on the other hand, possess ownership in copyright, with exclusive rights, as the copyright holders, and also possess *authorship* over the creations of their mind. This concept of '*authorship* over the creation of their mind'[569] which arises from the substance of the right to property is relatively different from the 'moral interest' and 'moral rights' which have been discussed earlier. In this respect, the concept is more relevant to the economic rights of the author in the sense that they could have decision over the uses of their creations. This concept of *authorship* provides the individual authors with a higher/stronger copyright protection status than the business entities because it strongly confines a universal characteristic of human right. Nevertheless, the discussion in chapter III, although it may confirm this higher status of the individual authors, also portrays a different result in practical when these individuals are trying to draw benefits from copyright protection in the online digital environment.

Additionally, the individuals are further protected by the right to freedom of expression which will be discussed further in the next section.

[569] '*…the author's natural right to a property in his creation.'* at ibid p65

## B. THE CULTURAL CHARACTERISTICS

### B.1. Copyright and the Right to Freedom of Expression

It is certified under Article 19 of the Universal Declaration of Human Rights that *'Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers.'* Also, the right is guaranteed under Article 19 of the International Covenant on Civil and Political Rights (ICCPR).[570] Unlike Article 19 of the UDHR, Article 19 of the ICCPR also provides some possible restrictions and legal binding obligation on the member states. It is suggested that the right has its root in the English history during the 17th century and was later expanded by the United States Bill of Rights which was added to the Constitution in 1791 and the French Declaration of the Rights of Man and The Citizen 1789.[571]

As for regional level, the right is certified under article 10 of the European Convention on Human Rights (ECHR) 1950[572] with some noteworthy differences to article 19 of the ICCPR. The Convention has legal binding

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[570] ICCPR 1996, article 19 1. *'Everyone shall have the right to hold opinions without interference. 2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice. 3. The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary: (a) For respect of the rights or reputations of others; (b) For the protection of national security or of public order (ordre public), or of public health or morals.'*

[571] Lauri Hannikainen Juhani Kortteinen, Kristian Myntti in *The Universal Declaration of Human Rights : A Common Standard Of Achievement* (The Hague ; London ; Kluwer 1999) p393

[572] ECHR 1950, article 10 *'1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises. 2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.'*

obligation over the 47 countries of all the European member states. Any citizen whose rights have been violated under the Convention by a state party can bring a case to the European Court of Human Rights (ECtHR).

In the sense that the right to freedom of expression is *'a civil liberty depends upon the right of citizens to function as public communicators'* which is entitled to a special legal protection against arbitrary sanctions by the government,[573] the right is often referred as a *civil right* and a *negative right* under the ICCPR.

There are many arguments about the free speech principle. According to Schauer[574] and Barendt[575], the four arguments include 1) the argument from truth 2) the argument from democracy 3) the argument for individual's self-fulfilment and 4) the suspicion of government. In summary, both Schauer and Barendt see the argument from truth supported by John Stuart Mill and the 'marketplace of ideas' theory from the judgment of Judge Holmes not appealing. Those concepts come with some major flaws. The same idea applies to the argument for individual self-fulfilment of Ronald Dworkin and 'the Millian Principle' of Thomas Scanlon. The two prominent free speech commentators, however, appear to be more interested in the argument from democracy by Alexander Meiklejohn.[576]

Relying on the argument from democracy, the principle proposes that the purpose of speech protection is to serve democracy. In terms of the constitutional conception of democracy, political institutions must respect the

[573] Thomas L. Tedford and Dale Herbeck, *Freedom of speech in the United States* (Franklyn Saul Haiman ed, 5th ed. edn, Strata Pub., Inc. 2005) p5

[574] Frederick Schauer, *Free Speech : A Philosophical Enquiry* (Cambridge University Press 1982) pp15-86

[575] E. M. Barendt, *Freedom of speech* (2nd ed. edn, Oxford University Press 2005) pp7-23

[576] Schauer p20

right of every citizen, including those members of minority groups, to be treated with equal respect and concern.[577] Therefore, under this free speech principle, everyone in a democratic society is guaranteed with an equal right to participate through their exercise of the right to freedom of expression. The idea thus emphasises the commitment of the democratic government.[578]

In addition, the principle of the argument consists of two important elements. First, it emphasises the necessity of making all relevant information available to the citizens so that they will be able to decide and exercise their sovereign power. Second, it emphasises the way that citizens could communicate their wants to the government. The government, as a servant rather than rulers under the democratic political system, will therefore have to respond to the demands of their population. In this particular sense, a censorship of speech by the government would be atypical.[579]

According to Barendt, the argument from democracy does not protect speech for benefits of any particular group. Rather, it focuses on the interest of all major participants in the market. This includes the *speaker*, the *audience*, and the *public*. The speech or expression of these members is protected against the restriction of the government for purposes of supporting the function of democratic system as discussed earlier. However, the interest of *a publisher* or *distributor* (as a kind of *speaker*), particularly when it comes with economic motive, could plausibly be protected at a lower level comparing to the interest of the individual writer or creator.[580]

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[577] Barendt p19

[578] Ibid p20

[579] Schauer pp38-39

[580] Barendt pp24-28 See also, the discussion in chapter III which demonstrates the opposite results in the online digital environment.

It is important to note that the scope of free speech protection covers any kind of communication regardless of its content, either linguistic communication or other medium of communication such as photographs, drawings, paintings, charts, graphs or diagrams, which intend to communicate particular ideas, information or relationship.[581] The 'speech', as Schauer discussed, *'could be defined as the communication of ideas, information, and artistic sentiment through means that are either linguistic, pictorial, or traditionally artistic.'*[582]Therefore the scope of free speech protection does not include *'freedom of thought'* even though freedom of thought justifies a principle of free speech. *'It is the speech [communication]* [583] *that needs protection, although freedom of thought may provide the justification.'*[584] In these two particular senses, the protection of freedom of expression does show some correlation with copyright protection. Most importantly, looking at 'speech' as 'communication' also supports the accountability of the government through criticism and examination of their acts under 'the argument from democracy' as provided above.[585]

In conclusion, if it is agreed that the Principle of Free Speech stems from the argument of democracy, thus, the protection of the rights to freedom of expression will be granted relatively to the three groups of citizen against government suppression under the democratic system. This includes the *speaker*, the *audience*, and the *public*. In this sense 'expression' or 'speech' covers any type of 'communication'. Also, amongst these communications

[581] Schauer pp96-97,101

[582] Ibid p91

[583] Added by author

[584] Schauer p94

[585] Ibid p95

there are some particular types of communication which are granted protection under the copyright regime. These include the literary works, musical works, audiovisual works, and images, as provided later in chapter III.

Since the importance of freedom of expression lies fundamentally in the concept of democracy, the protection of the right therefore would possibly be granted explicitly under the provisions of constitution of each country which agrees on the democratic administration. However, it is noteworthy that, even though the right is guaranteed under the binding ICCPR and ECHR, there is no clear general concept or fundamental protection of the right agreeable either in the international or regional level. One reason is probably because the substance of the right contributes so much political value to the government rather than the economic effect. This emphasises the very political and cultural characteristic of the right. Despite amongst the so-called liberal countries, it is acknowledged that the degree of protection of the right to freedom of expression is highly varied.[586]

**Conflicts:** It is discussed earlier that the right to freedom of expression protects the *'expression'* or *'communication'* right of the *speaker*, the *audience*, and the *public* regardless of the way of their communication. The *publisher*, on the other hand, is protected in somewhat a lower degree than these groups of individuals. This emphasises the high importance of the individuals under the fundamental of the right to freedom of expression although the results from the discussion in chapter III may show otherwise.

When the right to freedom of expression meets with copyright, it is widely argued, under the US jurisdiction, that '*copyright is the engine of free*

[586] Barendt pp39-73

*expression'* [587] in the sense that *'copyright's idea/ expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression."',*[588] as Nimmer provided that *'Copyright laws are not restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed'.*[589]

From the above fundamental, it is suggested that there are two forms of concept regarding relationship between copyright and free speech accepted under the US jurisdiction. First, there is no conflict between copyright and free speech at all *'because of the constitutional co-existence of both the First Amendment and copyright law.'*[590] Copyright and the right to freedom of expression as guaranteed under the First Amendment *'share the same goal, namely the promotion of knowledge and the maintenance of a robust public sphere, but divided the area of responsibility as to the achievement of goal.'*[591] Second, if the problem between copyright and free speech is raised, such as in *Harper & Row v. Nation Enterprises*, it is suggested that the copyright mechanisms such as the fair use defences and the idea-expression dichotomy is viewed as sufficient tools to solve the conflict.[592] This is a particular view of *'internal conflict'* between copyright and the right to

[587] *Harper & Row v. Nation Enterprises* at 558

[588] Ibid at 556 (quoting appellate decision at 723 F. 2d, at 203.(1983)

[589] Ibid at 556 referred to 1 Nimmer § 1.10[B][2]

[590] Michael D. Birnhack, 'Copyright Speech: A Trans-Atlantic View' in Paul Torremans (ed), *Copyright And Human Rights : Freedom Of Expression, Intellectual Property, Privacy* (Kluwer Law International 2004) pp37-62

[591] Ibid pp37-62

[592] Ibid pp37-62

freedom of expression. From this view of the *'internal conflict'*, copyright is, to some extent, immune from free speech scrutiny under the US jurisdiction.[593]

The idea may be true, to some degree. However, this study will argue on the contrary that copyright and freedom of expression do conflict. Furthermore, that conflict could not be easily resolved by the internal copyright mechanism such as fair use and the idea-expression dichotomy. The reason is because, first of all, copyright is not merely an engine of free expression. There is something more under the idea of copyright protection rather than just the concept of 'expression'. Second, since copyright is not merely an engine of free expression, therefore there is no *'shared-goal argument'*.[594] The two doctrines really do conflict and the conflict is not 'internal'. Rather it is likely 'external' and therefore fair use and the idea-expression dichotomy might not be the final solution.

**(i) Copyright is not merely an engine of free expression**

When the court in *Harper & Row v. Nation Enterprises* discussed about relationship between copyright and freedom of expression, it explicitly stated that *'…it should not be forgotten that the Framers intended copyright itself to be the engine of free expression.'*[595] Furthermore, referring to the statement of Judge Fuld in *Estate of Hemingway v. Random House, Inc,;*[596] the court in *Harper& Row* also emphasised that *'In view of the First Amendment protections already embodied in the Copyright Act's distinction*

[593] Barendt pp248-252

[594] Birnhack, 'Copyright Speech: A Trans-Atlantic View'

[595] *Harper & Row v. Nation Enterprises* at 558

[596] *Estate of Hemingway v. Random House* Inc, 23 N Y 2d 341, 348, 244 N E 2d 250, 255 (1968)*'The essential thrust of the First Amendment is to prohibit improper restraints on the voluntary public expression of ideas; it shields the man who wants to speak or publish when others wish him to be quiet. There is necessarily, and within suitably defined areas, a concomitant freedom not to speak publicly, one which serves the same ultimate end as freedom of speech in its affirmative aspect.'*

*between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use."*[597]

Based on the decision of the court in *Harper& Row,* the concept of copyright as 'an engine of free expression' has been widely accepted in many scholarly works. For example, Neil W. Netanel, argued, based on the historical perspective of the Framers' intent *'to promote the progress of science',* that *'copyright indeed serves as an engine of free expression.'* This is due to the three major functions of copyright. First of all, copyright has the 'production function' which provides some economic incentives for the creation and dissemination of original expression. Second, it has the 'structural function' which supports the benefits of authors and publishers rather than the government. Finally, it has the 'expressive function' which encourages authors to produce some new and original contributions to the public.[598]These three functions therefore serve the role of copyright as an engine of free expression.

However, the above conclusion may not be absolute. The argument on another side of the concept of copyright as an engine of free expression here will be directed based on two aspects**: 1) the objective of copyright protection comparing with free speech protection** and **2) the flaw of the idea/expression dichotomy argument.**

**1) The objective of copyright protection comparing with free speech protection**

In short, as discussed earlier form the democratic argument, the principle of free speech protects the rights of the *speaker*, the *audience*, and the *public* against government restriction regardless of the way of their 'expression' or communication.

[597] *Harper & Row v. Nation Enterprises* at 560

[598] Neil Netanel, *Copyright's paradox* (Oxford University Press 2008) pp81-108

Thus, when the US court in *Harper& Row*[599]gave rise to the Framers' intent and emphasised that *'copyright is an engine of free expression',* an important question must be raised*:* Does copyright offer similar value of protection to the free speech principle?

The most important and relevant keyword here is the 'expression', the word in which, when focused, slightly connects the principle of free speech and copyright altogether and gives rise that both concepts may have the same value and thus, no conflict.

In fact, before the court in *Harper& Row* has come to the conclusion that *'copyright is an engine of free expression'*, there are some valuable opinions and discussions of the court that have long been overlooked.

First, referred to the decision in *Twentieth Century Music Corp. v. Aiken,* saying that:

> *'The rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for* ***their labors****.'*[600]

Second, referred to Article I, Section 8, of the Constitution: *'The Congress shall have Power . . . to Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.'* and the decision in *Sony Corp. of America v. Universal City Studios, Inc.* , the court emphasised that:

> *'As we noted last Term: "[This] limited grant is a means by which an important public purpose may be achieved. It is intended to* ***motivate the creative activity*** *of authors and*

[599] See also *Eldred v. Ashcroft* 537 US 186 (2003)

[600] *Harper & Row v. Nation Enterprises* at 546 referred to *Twentieth Century Music Corp. v. Aiken,422 U. S. 151, 156 (1975)* (emphasis added)

*inventors by the provision of a special reward, and to allow the public access to* ***the products of their genius*** *after the limited period of exclusive control has expired."'* [601]

Third, the court in *Harper& Row* then indicated that:

*'In preparing the book, Mr. Ford drafted essays and word portraits of public figures and participated in hundreds of taped interviews that were later distilled to chronicle his personal viewpoint. It is evident that the monopoly granted by copyright actively served its intended purpose of inducing* ***the creation of new material*** *of potential historical value.'* [602]

Fourth, then again referring to Section 102 of the Copyright Act, the court in *Harper& Row* reaffirmed that:

*'In addition, no author may copyright facts or ideas. § 102. The copyright is limited to those aspects of the work — termed* ***"expression"*** *— that display the stamp of* ***the author's originality.'*** [603]

Fifth, the court even further restated that:

'*Creation of a nonfiction work, even a compilation of pure fact,* ***entails originality.*** *See, e. g., Schroeder v. William Morrow & Co., 566 F. 2d 3 (CA7 1977) (copyright in gardening directory); cf. Burrow-Giles Lithographic Co. v. Sarony, 111 U. S. 53, 58 (1884) (originator of a photograph may claim copyright in his work).'*

[601] Ibid at 546 referred to *Sony Corp. of America v. Universal City Studios, Inc., 464 U. S. 417, 429 (1984)* (emphasis added)

[602] Ibid at 546 (emphasis added)

[603] Ibid at 547 (emphasis added)

and,

*'Yet copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not* ***original****…'*[604]

In this case, it is accepted that:

*'The Nation has admitted to lifting verbatim quotes of the* ***author's original*** *language totaling between 300 and 400 words and constituting some 13% of The Nation article.'*[605]

Finally, the court emphasised the benefits of the author that:

*'The author's control of first public distribution implicates not only his* ***personal interest in creative control*** *but his property interest in exploitation of prepublication rights, which are valuable in themselves and serve as a valuable adjunct to publicity and marketing. See Belushi v. Woodward, 598 F. Supp. 36 (DC 1984).'*[606]

and,

*'Where an author and publisher have* ***invested extensive resources in creating an original work*** *and are poised to release it to the public, no legitimate aim is served by pre-empting the right of first publication.'*[607]

The above discussions represent the six major arguments before the court in *Harper & Row* would come to the very famous statement that *'the*

[604] Ibid at 548 (emphasis added)

[605] Ibid at 548 (emphasis added)

[606] Ibid at 555 (emphasis added)

[607] Ibid at 557 (emphasis added)

*Framers intended copyright itself to be the engine of **free expression**'.*[608] After that famous statement, the court also clarified further that: *'By establishing a marketable right to the use of **one's expression**, copyright supplies the economic **incentive to create** and disseminate ideas.'*[609]

From those six major opinions of the court, it could be construed that the court in *Harper& Row* has a very clear views towards the concept of copyright protection that; subject matter of copyright protection is 'expression'. But most importantly, such 'expression' will also need to satisfy all the protection criteria. One important criterion which is profoundly and clearly discussed by the court in this case is the criterion of content: 'originality and creativity'.[610]

Comparing the concept of copyright protection with the concept of free speech, the free speech principle, on the contrary, protects the 'expression' of the *speaker*, the *audience*, and the *public.* 'Expression' in the scope of free speech, as Shauer analysed, *'could be defined as the communication of ideas, information, and artistic sentiment through means that are either linguistic, pictorial, or traditionally artistic.'*[611]

In more details, Shauer clarified that:

> *'If it is communication that is to be protected, then linguistic communication, spoken and written words (generally formed into sentences) comprises the largest proportion of what we are protecting.'*[612]

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[608] Ibid at 558 (emphasis added)

[609] Ibid at 558 (emphasis added)

[610] Sterling pp333-377 (See also chapter I)

[611] Schauer p91

[612] Ibid p96

Most importantly, according to Shauer,

> *'A similar conclusion is mandated where pictures are the medium of communication, as with, for example, photographs, drawings, paintings, charts, graphs or diagrams. Where the intent is to communicate particular ideas, information or relationships (excluding for the moment artistic depiction), these methods of communication are indistinguishable from linguistic speech… [N]o meaningful distinction can be drawn between pictorial representation and linguistic representation.'*[613]

From the idea of Shauer, *speaker, audience and public* could communicate in both linguistic and non-linguistic symbols in order to convey a message. In such case *'Communication is a joint enterprise, and only that joint enterprise triggers the principle of free speech. Without communicative intent, a communicated message, and a recipient of the communication there is no complete communicative act, and no occasion to talk about freedom of speech.'*[614]

Free speech principle therefore *'include[s] any method of communication even remotely capable of transmitting a message.'*[615] The free speech protection thus focuses primarily based on the *'communicative intent'* of the expression regardless of the method of communication (either linguistic or non-linguistic). Most importantly, no such concept as 'originality and creativity' is required under the protection of the free speech principle.

[613] Ibid p97

[614] Ibid p98

[615] Ibid p98

On the other hand, copyright protection will not be granted merely to an 'expression' unless such expression satisfies the requirement of 'originality and creativity'. In other words, such expression must bear 'the author's own intellectual creation'.[616] The notion is confirmed in many prominent cases such as *Feist v. Rural,*[617] *Bridgeman Art Library v. Corel Corp*[618] and *Football Dataco v Sportradar.*[619] It is noteworthy that regardless of whether such protection would be given to copyright or derivative work; both require originality and creativity as an important criterion of protection.[620]

Put it simple, this means that, for example, in case that there is any reader who agrees or disagrees with this thesis's arguments, such reader may express her idea in a linguistic way such as *'I agree/disagree with this thesis.'* or in a non-linguistic way such as :-) or :-(. These are considered 'expression' of idea which are protected and thus could be freely expressed in the area of free speech principle.

However, those expressions, no matter whether they are linguistic or non-linguistic, or are protected or not protected by the free speech, may not be copyrightable unless they would be written lengthily, as an article, for example, to convey such person's own intellectual creation regarding the issue.

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[616] Sterling pp338-377 (See also chapter I)

[617] *Feist Publications, Inc. v. Rural Telephone Service Co.'copyright protection could only be granted to "works of authorship" that possess "at least some minimal degree of creativity". As such, mere labor ("sweat of the brow") is not sufficient to establish a copyright claim.'*

[618] *Bridgeman Art Library, Ltd. V. Corel Corp.'exact or "slavish" reproductions of two-dimensional works such as paintings and photographs that were already in the public domain could not be considered original enough for protection under U.S. law, "a photograph which is no more than a copy of a work of another as exact as science and technology permits lacks originality. That is not to say that such a feat is trivial, simply not original"'*

[619] *Football Dataco v Sportradar* [2002] (C-173/11) *'A football fixture list cannot be protected by copyright when its compilation is dictated by rules or constraints which leave no room for creative freedom,'*

[620] See more discussion about 'originality and creativity' in chapter I

Most importantly, it is likely possible for an expression which is protected by free speech principle to receive copyright protection if there is a proof of 'the author's own intellectual creation'. However, if such expression is not protected by free speech, it is likely not possible for them to receive copyright protection even if 'the author's own intellectual creation' has been found within. On the other hand, copyright protection granted to an expression will not prevent such expression from the sanctions of government if that expression violates the free speech principle of the nation.[621] Therefore there might be some doubts when considering the concept of copyright 'as an engine of free expression'. In this case, is it more straightforward to say that 'free expression is an engine of copyright protection'?

In sum, this thesis would argue that the free speech principle is a human right granted to individuals before they could retain a status as author or creator. Without copyright, each individual already has a right to produce any expression freely under the principle of freedom of expression. But when copyright notion is applied, only expression '*which contains 'originality and creativity' of the author'* will be granted protection and thus economic incentives will be prospered.

Thereby under the free speech principle those people who merely produce expression are called *speaker* rather than *creator*. It is the argument of this thesis that the decision of the court in *Harper& Row* does not merely provide that copyright is an engine of free expression. Rather, the court in *Harper& Row* strongly emphasises the fundamental that **'free expression *plus* creative expression is an engine of copyright.'**

[621] See Seong Choul Hong, 'Copyright Protection V. Public Morality: The Copyright Protection Dilemma Of Pornography In A Global Context' (2013) 8 Asian J WTO & Int'l Health L & Pol'y 303

This argument that *'free expression is an engine of creative expression'* and *'creative expression is an engine of copyright'* strongly supports what Lawrence Lessig provided in his work that not all creators create a work for business. Some may *'create for the love of what they create and not for the money.'* [622] These people could as well be regarded as *creator*. [623] Accordingly, it is important to note that, even though these creators are not creating for money at the first place, in the end the 'originality and creativity' contributed to their creative expression will be an engine that brings them copyright protection with an amount of economic values in the end.[624]

**2) The flaw of the idea/expression dichotomy argument**

When the US jurisdiction focuses on the internal conflict between copyright and free speech, it is often argued, according to Nimmer, that '*copyright does not protect an author's "ideas"*'[625] and '*while copyright may not be claimed in an idea, it may be claimed in "the expression of the idea."*'[626] These particular opinions were expressed clearly in *Harper& Row*, as have already been discussed above. Nevertheless it has long been overlooked that in his work Professor Nimmer also mentioned emphatically about *'[t]he economic motivation of creation which underlies copyright'*.[627] According to

[622] Lawrence Lessig, 'Getting Our Values around Copyright Right' [2010] Educause Review 28 p29

[623] Ibid

[624] The idea is contradiction with the view of Neil Turkewitz in Neil Turkexitz, 'Inside View : Copyright and The Public Interest: Not Necessarily Competing Forces' (*Intellectual Property Watch*, 07 July 2015) <http://www.ip-watch.org/2015/07/07/copyright-and-the-public-interest-not-necessarily-competing-forces/> accessed 14 July 2015 providing that *'…copyright …, … remains by far the most powerful tool for fostering creativity…'*

[625] Melville B. Nimmer, 'Does Copyright Abridge The First Amendment Guarantees Of Free Speech And Press?' (1970) 17 UCLA Law Review 1180 p1189

[626] Ibid p1189

[627] Ibid p1189

Nimmer, it is not only the exact words used by an author which will be protected by copyright; otherwise *'the economic motivation of creation which underlies copyright'* will be devalued. Most importantly, he also refers to the opinion of Judge Learned Hand that copyright *'cannot be limited literally to the text'.* However, from this particular argument he also observes that it is difficult to draw the line to separate *'non-protectible ideas'* from the *'protectible ''expression of ideas'''*. Thus, in this case he accepts a test called *'abstractions test'.*[628]

Even with these difficulties Nimmer finally defends in the end that the idea/expression dichotomy *('which ideas per se fall on the free speech side of the line, while the statement of an idea in specific form, as well as the selection and arrangement of ideas fall on the copyright side of the line'*) is *'de facto a definitional balance'* between copyright and freedom of expression.[629] In other words this is to say that the people with free speech protection are free to copy or use anything which is not protected by copyright of the author (so called 'the idea') therefore a balance of rights is created between people who is exercising their free speech right and people who is exercising their copyright. The problem is whether this is always an accurate argument?

To answer that question, it is noteworthy to analyse that:

First of all, it is very interesting that Nimmer gives prominence mainly on the idea/expression dichotomy even if he has mentioned clearly about copyright as the motivation of creation. To find a balance between copyright and free speech, the argument that copyright protects speech and does not protect ideas is highlighted and emphasised by a numbers of copyright

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[628] Ibid p1189

[629] Ibid p1190

scholars through the argument of Nimmer and as if there is no other core values lies beneath the fundamental of copyright protection. One prominent concept which is missing and often ignored here is the notion of 'originality and creativity.' This is notably what Nimmer discussed in his work that *'It is the particular selection and arrangement of ideas, as well as a given specificity in the form of their expression which warrants protection under the law of copyright…'*[630] and *'[u]nderlying such protection is the requirement that the author's work be "original" with him, i.e., that he has not copied it from any other source…'*.[631]

The first analysis which admire the essence of originality and creativity is very important because, secondly, the idea/expression dichotomy itself does not involve only the protection of copyright but also relevant to copyright infringement liability. The basic idea is that in order to be protected by copyright, a work is required to be an expression, not merely fact or idea. At the same time, people would be liable for copyright infringement if they copy the expression of the author, not fact or idea appears in the work. This idea is fundamental and absolute. But there is something more, however.

In practical, as Nimmer provided, it is difficult to identify which part of the work is non-protectable idea and which part is protectable expression. Thus people who use the protected work in many cases may end up copying the expression of idea rather than the idea itself (because expression is what exposed to the public and to the acknowledgment of people). This could happen either with or without intention. The question is, in this case, will those people always be liable for copyright infringement? The answer, to

[630] Ibid p1190

[631] Ibid p1190 at footnote 31

some, is referring to the 'fair use' exception which would play an important role in these circumstances.

However, there are some particular cases where fair use has never come into play. In these cases people other than the author herself can use the expression of the work without being convicted of copyright infringement. In *Bridgeman Art Library v. Corel Corp.*[632] the US court held that while the plaintiff merely *'create "slavish copies" of public domain works of art'* such work thus contains no originality and therefore not copyrightable. In addition, the court also indicates that the plaintiff's claim for copyright protection in the works will not succeed under the UK copyright law.[633] Finally, the summary judgment was granted for the defendant who sells of the CD-ROM which contained digital images of the unprotected works.

In making decision, the court in *Bridgeman Art Library* also refers to the opinion in *L. Batlin & Son, Inc. v. Snyder*[634]in which the Appellate Court in that case *'affirmed a district court order compelling the defendants to cancel a recordation of copyright in the plastic reproduction on the ground that the reproduction was not "original"'.* [635] The preliminary injunction was thus granted against the defendant who has previously registered for copyright protection in the work.

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[632] *Bridgeman Art Library, Ltd. V. Corel Corp.*

[633] Ibid in referring to *Graves' Case (1869) LR 4 QB 715* the court in *Bridgeman Art Library* identified that *'This analysis is quite pertinent in this case. Most photographs are "original" in one if not more of the three respects set out in the treatise and therefore are copyrightable. Plaintiff's problem here is that it seeks protection for the exception that proves the rule: photographs of existing two-dimensional articles (in this case works of art), each of which reproduces the article in the photographic medium as precisely as technology permits. Its transparencies stand in the same relation to the original works of art as a photocopy stands to a page of typescript, a doodle, or a Michelangelo drawing'* and finally reached to the conclusion that *'For all of the foregoing reasons, the Court is persuaded that its original that Bridgeman's transparencies are not copyrightable under British law was correct.'* Finally, *'the facts pertinent to the issue of originality are undisputed. The Court has held as a matter of law, and reiterates, that plaintiff's works are not original under either British or United State'*

[634] *L. Batlin & Son, Inc. v. Snyder*

[635] Quoted from *Bridgeman Art Library, Ltd. V. Corel Corp* 36 F Supp 2d 191 (SDNY 1999)

Following is the decision in *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*[636] which was reaffirmed in the court's decision that *'not every work of authorship, let alone every aspect of every work of authorship, is protectable in copyright;* ***only original expressions are protected****. This constitutional and statutory principle seeks to strike a delicate balance – rewarding (and thus encouraging) those who* ***contribute something new*** *to society, while also allowing (and thus stimulating) others to build upon, add to, and develop those creations.'* Therefore, the copyright protection could not be granted to the digital, wire-frame models of vehicles which are no more than the depiction of those vehicles. Discussing and referring to the decision in *Ets-Hokin v. Skyy Spirits, Inc.*[637]the court in this case also indicates a very important point that *'Facts and ideas are the public's domain and open to exploitation to ensure the progress of science and the useful arts. Only original expressions of those facts or ideas are copyrightable…'*[638]

In the UK, the court in *Interlego v Tyco Industries*[639] also emphasised the importance of 'originality' in the created works as a fundamental requirement for copyright protection. Without originality, even though labour and skill may have been added to the worked, such work created by the author will not be protected by copyright. Therefore there will not be the case

[636] *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.* 528 F3d 1258 (10th Cir 2008)

[637] *Ets-Hokin v. Skyy Spirits, Inc.* 323 F3d 763, 765 (9th Cir 2003)

[638] *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*

[639] *Interlego AG v. Tyco Industries 'In their Lordships' view, Lego's claim for infringement of copyright in their post-1972 drawings fails as regards such of those drawings as were copied either from drawings made prior to 1973 or from other drawings in respect of which no infringement has been claimed. It is not sufficient to confer originality upon them that labour and skill were employed in the process of copying them or in the addition to them of fresh written manufacturing instructions.'* In discussions, the court also referred to the opinion in *British Northrop Ltd. v. Texteam Blackburn Ltd*. [1974] R.P.C. 57, 68 that *'Copyright is concerned not with any originality of ideas but with their form of expression, and it is in that expression that originality is requisite. That expression need not be original or novel in form, but it must originate with the author and not be copied from another work ... A drawing which is simply traced from another drawing is not an original artistic work: a drawing which is made without any copying from anything originates with the artist.'*

of copyright infringement using those unprotected expressions without lawful authorisation of the author.

In addition, given the examples this thesis provided above, when a reader writes that *'I agree/disagree with this thesis.'* or provides non-linguistic symbols as :-) or :-(, there are two questions remains in this case. One is, whether these sentences and symbols are considered as merely 'idea or fact'. Second is, or whether these sentences and symbols could be considered as 'expression', to some extent. Under copyright law regime, some may choose to rely on the first position that these subjects could not be considered as expression since they provide only facts and ideas of the writer. On the other hand, some may choose another side of position and treat these subjects as linguistic and non-linguistic expressions which were made visible to the perception of others rather than the abstract facts or ideas. Nonetheless, neither view of those would qualify these subjects for copyright protection. In other words, it is agreed that no copyright protection would be granted to the sentence *'I agree/disagree with this thesis.'* and the symbol :-) or :-(. This is not because the question of idea/expression dichotomy has been righteously answered earlier, however. Rather it is because of the notion that there is no sufficient degree of 'originality and creativity' of the writer represented in these particular subjects.

The problem in creating a clear line between non-protected idea and protected expression also appears in the computer program case of *Computer Associates International, Inc. v. Altai, Inc.*[640] The court in this case accepted that it is a very difficult task to draw a clear line between those non-

[640] *Computer Associates International, Inc. v. Altai, Inc.* 982 F2d 693 (2d Cir 1992)

protectable idea and protectable expression.[641] Finally, the court adopted a test called *'the abstraction - filtration - comparison test'* to identify whether non-literal elements of the computer program have been copied.[642]

Accordingly, it could be concluded that people who has free speech protection will be free to copy or use anything which is not protected by copyright of the author, which is what Nimmer identified at the beginning as fact or idea. However, one difficulty still remains in the question, as Nimmer also provided and as appeared in many cases that, what could be identify as idea and what could be identify as expression.

However, according to the first analysis, 'originality and creativity' has played an important role in copyright protection aspect in the sense that it is not merely an expression but the expression with originality and creativity that could be protected by copyright. In addition, on the infringement aspect, it is not the expression that contains originality and creativity which will be available for other to use without authorisation of the author, but the expression with contains no originality and creativity. The problem of what would satisfy the minimum degree of originality and creativity, however, is another question. In general, it is accepted that it is what that represents the *'author's own intellectual creation.'*[643]

Finally, the thesis will argue, in particular, that copyright protects only expression -'which contains originality and creativity'. In other words, this is to say that copyright offers protections not to what is purely

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[641] Ibid *'Drawing the line between idea and expression is a tricky business. Judge Learned Hand noted that "nobody has ever been able to fix that boundary, and nobody ever can.' Nichols, 45 F.2d at121. Thirty years later his convictions remained firm. "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression,'" Judge Hand concluded. "Decisions must therefore inevitably be ad hoc." Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).'*

[642] Also, see the discussion about idea/expression dichotomy in relation to fixation in chapter I

[643] See discussion about originality and creativity in chapter I

'expression' but to 'creation' (expression *plus* creativity). Therefore only the idea/expression dichotomy is not an absolute tool that creates a balance between free speech and copyright. It is not wrong to say that only expression is protected by copyright. And that according to the idea/expression dichotomy, the users are free to copy fact or idea which is not qualified for copyright protection. But it would be even more accurate to add that this is not limited only to fact or idea. Copyright, on the other hand, does not grant any protection to the expression of idea which contains no originality and creativity either. Hence such expressions of idea which contains no originality are also available for others to use freely, apart from those unprotected fact or idea apprehensible in the public domain.

Given it more precisely, a tool that could create a balance between free speech and copyright, if any, would not definitely be the idea/expression dichotomy. On the contrary, it would more likely be the concept of 'originality and creativity' which underlines the concept of copyright protection in the expression of idea. The fundamental concept of this rule allows the user to freely copy or use either 1) non-expressions or 2) expressions that contains no 'originality and creativity' of the author without being liable for copyright infringement.

**(ii) The external conflict between copyright and the right to freedom of expression**

If copyright protects only expression which contains originality and creativity, then the real situation would not be like what Birnhack described in his work about the coordination between *'shared-goal argument'* and the *'division of labour argument'* that *'copyright creates speech, and then the First*

*Amendment protects speech from abridgements.'*[644] On the contrary, it would plausibly be the other way around that *'the First Amendment creates speech, and then copyright protects speech from abridgements.'*

Following that logic, it is also that the idea/expression dichotomy may not be a definite mechanism that creates a balance between copyright and freedom speech. Rather it is more likely the concept of 'originality and creativity' that divides and creates a balance between what is free and what is protected by copyright. And when such division is applied, it has then created an unavoidable *'external conflict'* [645] between copyright and freedom of expression.

In this thesis, the relationship between free speech and copyright could thus be explained as follow:

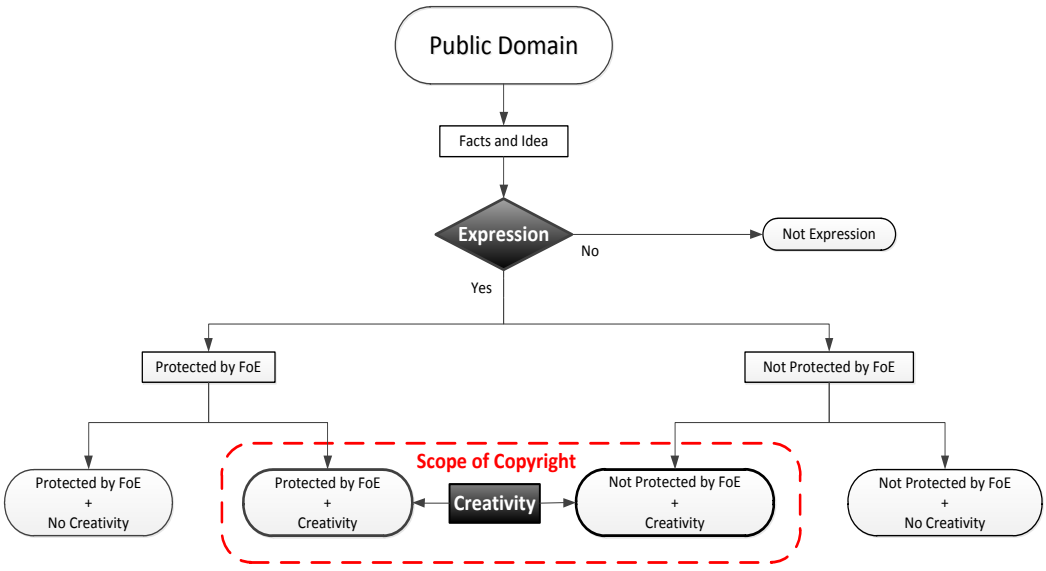



**Fig.3** ***The relationship between free speech and copyright***

It could be identified from the figure above that:

1) Not every expression is protected by freedom of expression

[644] Birnhack, 'Copyright Speech: A Trans-Atlantic View' pp37-62

[645] Ibid pp37-62

2) Amongst those expressions which are or are not protected by freedom of expression, not every of them contain originality and creativity

3) Only expression which contains originality and creativity will be qualified for copyright protection

4) After all, not every expression which contains originality and creativity and thus qualified for copyright protection would be protected by freedom of expression.

This again confirms the idea that 'copyright is not an engine of free expression' but 'freedom of expression is an engine of creative expression' and 'creative expression is an engine of copyright.'[646] There are two main ideas which could be construed from this issue.

Firstly, it means that, in the area where the right to freedom of expression is prospered it is likely that the value of copyright protection would be well-served. This is because there are more materials and resources that could encourage originality and creativity. However, the copyright protection is likely to be distorted in the area where freedom of expression is suppressed. One example could be found in Russia during the 1970s while the Soviet Union was reluctant to join the Universal Copyright Convention due to the fear of losing ideological control and manipulation of authors.[647] Even after participation in the UCC, the copyright law of the Soviet Union at that time still allow the Soviet government *'to suppress the publication of an unpublished work that was ''in contradiction to the interests of socialist society'''*.[648]

[646] Therefore 'free expression is an engine of copyright.'

[647] Rajan p339

[648] Ibid p341

Secondly, amongst all the expression which is protected by freedom of expression, only expression which contains originality and creativity will allow its creator a copyright protection. In other words it is the 'originality and creativity' that provides the creator moral right, ownership, and *authorship* (under copyright regime) over the expression produced. In fact, 'originality and creativity' is the core factor that defines and determines whether a creator would have moral right, ownership, or *authorship* over such an expression.[649] This issue will be reemphasised later in chapter III. Most importantly, without a proof of 'originality and creativity' that expression would rather fall in the public domain and thus the creator could not enjoy a benefit of monopoly and exclusive rights granted by copyright over that expression.

The problem then arises when people is seeking to exercise their right to freedom of expression in the areas which are governed by copyright protection. This is where the free speech principle (which protects the communications between the *speaker*, the *audience*, and the *public* against government suppression) contests with the monopoly right of the creator. In other words when copyright restricts 'creative expressions' exclusively for the benefits of the creators, this is where the *'external conflict'*[650] between the two separate legal regimes: copyright and freedom of expression exists.

[649] See also Nimmer D, 'Copyright in the Dead Sea Scrolls : Authorship and Originality' (2001-2002) 38 Houston Law Review 1

[650] '***External*** *conflict addresses the relationship between copyright and free speech on a constitutional level, as two separate areas of law'* Birnhack, 'Copyrighting Speech: A Trans-Atlantic View'pp37-62

To some extent, when the tension between free speech and copyright is viewed as *'internal conflict'*[651], in order to solve that problem some refers to the fair use exceptions as an *'internal mechanism.'*[652]

Unlike the three-step test in Article 9(2) of the Berne Convention which set up a standard of exceptions allowed only to reproduction right[653], the exceptions under fair use doctrine includes *'such use by reproduction … or by any other means'.*[654] This is similar to the three-step test under Article 13 of the TRIPs Agreement which has extended exceptions and limitation to cover all types of economic rights.[655] The three-step test consists of three elements which are cumulative and need to be satisfied before an exception could be allowed:(1) such exceptions are confined to 'certain special cases' and (2) such exceptions 'do not conflict with a normal exploitation of a work' and (3) such exceptions 'do not unreasonably prejudice the legitimate interests of the right holder'.

Taking into account the essences of the three-step test under Berne and TRIPs, if fair use exceptions is referred an effective *internal mechanism* that could solve the *internal conflict* between freedom of expression and copyright, then the concept of the fair dealing exceptions which relies on the same foundation would also serve the same purposes.

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[651] '***[I]nternal*** *conflict is… the tension between copyright's goal to promote the "progress of science" and the rights it creates in order to achieve this goal.'* ibid pp37-62

[652] Ibid pp37-62

[653] Berne 1971, article 9 (2) *'It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.'*

[654] 17 USC § 107

[655] TRIPs 1995, article 13 *'Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder'*

In *Ashdown v Telegraph*, the UK court of first instance, in making decision, relied on the *internal conflict* proposition that:

> *'The balance between the rights of the owner of the copyright and those of the public has been struck by the legislative organ of the democratic state itself, in the legislation it has enacted. There is no room for any further defences outside the code which establishes the particular species of intellectual property in question."*[656]

However, upon recognition of the *internal conflict* and the function of fair dealing as *internal mechanism*[657]*,* the Appellate Court has emphasised the inefficiency of fair dealing exceptions as a solution to conflict between copyright and freedom of expression in some specific cases, stating that:

> *'Where the subject matter of the information is a current event, s.30(2) of the Copyright Act may permit publication of the words used. But it is possible to conceive of information of the greatest public interest relating not to a current event, but to a document produced in the past. We are not aware of any provision of the Copyright Act which would permit publication in such circumstances, unless the mere fact of*

[656] *Ashdown v. Telegraph*

[657] Ibid at 32-33 *'The Vice-Chancellor, at p.973, drew attention to the fact that it is possible to identify 42 circumstances in which copying material does not infringe copyright. He concluded that each of these reflected circumstances in which freedom of expression was recognised and confirmed. In effect they were circumstances where freedom of expression trumped copyright protection. Two of these call for particular consideration in the circumstances of this case. The first is the defence of fair dealing that is provided by s.30 of the Copyright Act. So far as material, that section provides:*
*"Criticism, review and news reporting. 30(1) Fair dealing with a work for the purpose of criticism or review, of that or another work or of a performance of a work, does not infringe any copyright in the work….*
*"(2) Fair dealing with a work (other than a photograph) for the purpose of reporting current events does not infringe any copyright in the work…."*
*We agree that these provisions reflect freedom of expression in that, in the specific circumstances set out and provided that there is 'fair dealing', freedom of expression displaces the protection that would otherwise be afforded to copyright.'*

> *publication, and any controversy created by the disclosure, is sufficient to make them 'current events'. This will often be a 'bootstraps' argument of little merit, but on other occasions (such as disclosure by the Public Record Office under the 30-year rule) it may have a more solid basis.'*[658]

Most importantly, it appears in this case that the court has now acknowledged the possible *external conflict* between copyright and freedom of expression, emphasising that:

> *'For these reasons, we have reached the conclusion that rare circumstances can arise where the right of freedom of expression will come into conflict with the protection afforded by the Copyright Act, notwithstanding the express exceptions to be found in the Act. In these circumstances, we consider that the court is bound, insofar as it is able, to apply the Act in a manner that accommodates the right of freedom of expression. This will make it necessary for the Court to look closely at the facts of individual cases (as indeed it must whenever a 'fair dealing' defence is raised).'* [659]

In these circumstances where there is *external conflict,* the fair dealing which stems from the three-step test (which differs from the idea/expression dichotomy in the sense that it allows exceptions for others to use 'expression' or even 'creative expression' of author legitimately), though may lessen the conflict, may not be sufficient.[660]

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[658] Ibid at 44

[659] Ibid at 45

[660] See also. Birnhack MD, 'Acknowledging the Conflict Between Copyright Law and Freedom of Expression Under the Human Rights Act' [2003] Entertainment Law Review

Importantly, it is even argued further that the function of the three-step test under TRIPs[661], since the dispute settlement of the WTO panel on the Section 110(5)(B) of the U.S. Copyright Act, was disproportionately interpreted in a way that guard mainly the 'economic value' of the exclusive rights of the right holder of copyright. The rights of the original authors and performers, subsequent right holders, third party, and public interest, on the other hand, have eventually been ignored in relation to the interpretation of the wording of the three-step test.[662] In this particular sense, it is worth noting that the right holders of copyright in many cases may not be the original creators of the work. They could be, for example, the companies. It is remarkable that the wording of the third step was added *'as if media companies exploiting works of authors always have interests coextensive with those of authors'*.[663] In this respect, the comparison between the benefits of individual creators and business entities on the online digital copyrighted works could be found in chapter III.

It is proposed, therefore, that the three-step test should be re-interpreted in a way that gives balance to the protection of interests of the original authors and subsequent right holders. At the same time that interpretation should allow some rooms for public interest.[664] This is to

[661] Notice the difference between the three-step test allowed under Article 9(2) of Berne Convention and Article 13 of TRIPs in the third condition that: Article 9(2) of Berne provides that such 'reproduction' does not unreasonably prejudice the legitimate interests of 'the author', whereas Article 13 of TRIPs provides that such 'limitations or exceptions to exclusive rights' do not unreasonably prejudice the legitimate interests of 'the right holder'. (emphasis added)

[662] Daniel Gervais Christophe Geiger, Martin Senftleben, 'The Three-Step Test Revisited: How To Use The Test's Flexibility In National Copyright Law' (2014) 29 AM U INT'L L REV 581 p596 and Jonathan Griffiths Christophe Geiger , Reto M. Hilty, 'Towards a balanced interpretation of the "three-step test" in copyright law' (2008) 30 European Intellectual Property Review 489 p492

[663] Christophe Geiger p587

[664] Christophe Geiger Jonathan Griffiths , Reto M. Hilty, 'Declaration on A Balanced Interpretation Of The "Three-Step Test" In Copyright Law' (2008) 39 J Int'l Prop Info Tech & E-Commerce L 707 See also Max Planck Institute for Innovation and Competition, 'A Balanced Interpretation of the "Three-Step Test" in Copyright Law' Published on September 1, 2008 at the ATRIP Conference in

confirm the idea that creative expression is an engine of copyright. Without a contribution of creative expressions, the *creator*, *third party* and the *public*[665] may not be able to receive copyright protection over their expressions. This is regardless of whether the interests derived afterwards from such protection (moral rights and economic rights) would be benefits for individuals or institutions as the copyright holders.

### B.2. Copyright and the Right to Internet Access

While copyright is certified as human right under Article 27(2) of the UDHR and it is an obligation of the state to protect the interests of the author under Article 15 (c) of the ICESCR, the right to internet access, on the other hand, has never been guaranteed as human right under those international human right instruments.

Due to the influence of the internet technology and unsuccessful attempts on internet regulation amongst nations, in 1988 the International Telecommunications Union (ITU) has called for the need of the cooperation on the internet regulation at the higher level. Following this request, the General Assembly of the United Nations agreed to convene the World Summit on the Information Society (WSIS) from 10-12 December 2003 in Geneva, and 16-18 November 2005 in Tunis.[666] After all, the Declaration of Principles[667] was adopted in the 2003 reaffirm the significance of *'the universality, indivisibility, interdependence and interrelation of all human rights and fundamental*

Munich Available at http://www.ip.mpg.de/en/news/declaration_on_the_three_step_test.html accessed 7 July 2015

[665] This is in relation to the free speech principle of democracy which protects the rights of the *speaker*, the *audience*, and the *public* against government suppression. Also free expression 'is an engine of copyright protection' as discussed earlier.

[666] Andrew Murray, *Information technology law : the law and society* (Oxford University Press 2010) pp75-76

[667] 'Declaration of Principles Building the Information Society: a global challenge in the new Millennium' (*World Summit On The Information Society*, 12 December 2003) <http://www.itu.int/wsis/docs/geneva/official/dop.html> accessed 2 July 2015

*freedoms'*[668]*, 'respect for human rights and fundamental freedoms'*[669]*,* and particularly reaffirm the essence of the right to freedom of expression under article 19 of the UDHR.[670]

In 2011, a report was submitted to the UN Human Rights Council by Frank La Rue, the UN Special Rapporteur on the Promotion and Protection of the Right to Freedom of Opinion and Expression.[671] In terms of human right issue, it is important to note that the report:

1) Emphasises that internet *'[u]nlike any other medium of communication, such as radio, television and printed publications based on one-way transmission of information'* is an interactive medium.[672]

2) Reinforces the important of individual players that *'individuals are no longer passive recipients, but also active publishers of information.'*[673]

3) Reaffirms that *'Internet has become a key means by which individuals can exercise their right to freedom of opinion and expression'* as guaranteed by article 19 of the UDHR and the ICCPR.'[674]

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[668] Ibid at A.3.

[669] Ibid at A.3.

[670] Ibid at A.4.'*…Communication is a fundamental social process, a basic human need and the foundation of all social organization. It is central to the Information Society. Everyone, everywhere should have the opportunity to participate and no one should be excluded from the benefits the Information Society offers.'*

[671] Frank La Rue, 'Report of the Special Rapporteur on the promotion and protection of the right to freedom of opinion and expression' (*United Nations A/HRC/17/27 ,General Assembly*, 16 May 2011) <http://www2.ohchr.org/english/bodies/hrcouncil/docs/17session/A.HRC.17.27_en.pdf access 3 Oct 2014> accessed 2 July 2011

[672] Ibid at III.19

[673] Ibid at III.19

[674] Ibid at III.20

4) Underlines that any restriction to the right to freedom of expression of individuals to communicate via the Internet, *'from technical measures to prevent access to certain content … to inadequate guarantees of the right to privacy and protection of personal data'* must meet the criteria set forth in article 19, paragraph 3 of the ICCPR.[675]

5) Advocates that entirely cutting off individual users from internet access on the ground of their intellectual property rights violations '*to be disproportionate and thus a violation'* of article 19, paragraph 3, of the ICCPR.'[676]

6) Confirms that *'[t]he Internet, as a medium by which the right to freedom of expression can be exercised, can only serve its purpose if States assume their commitment to develop effective policies to attain universal access to the Internet.'*[677]

It is pointed out, as well, in this report that at that time there are some countries such as Estonia and France which have recognised internet access as a right.[678]

In 2012, the UN Human Rights Council, on its twentieth session, has adopted a Resolution on the Promotion, Protection and Enjoyment of Human Rights on the Internet. The resolution, upon recognition of the global and

[675] Ibid at III.24 and IV.28.

[676]Ibid at VI.4.78.

[677] Ibid at V.60.

[678] Ibid at V.65.

open nature of the internet, also affirms that the right to freedom of expression of individual must also be protected online as well as offline.[679]

In 2014, taken into account the UN Resolution of 2012 and the Report of the Special Rapporteur of 2011, the UN Human Rights Council has adopted another Resolution on the Promotion, Protection and Enjoyment of Human Rights on the Internet. The resolution then again *'affirms that the same rights that people have offline must also be protected online, in particular freedom of expression.'*[680] Also it *'calls upon all states to address security concerns on the internet in accordance with their international human rights obligations to ensure protection of freedom of expression, freedom of association, privacy, and other human rights online.'*[681]

According to the Report of the UN Special Rapporteur and the Resolutions of the UN Human Right Council, it is not internationally agreed that 'internet access' would enjoy protection separately as a special kind of human right. However, the UN Special Rapporteur, upon clarification that entirely blocking internet access could violate article 19 paragraph 3 of the ICCPR, thus, confirms that 'internet access' could enjoy protection as function of the right to freedom of expression enshrined under article 19 of UDHR and ICCPR. In *Yildirim v. Turkey*[682], for example, the European Court of Human

[679] United Nations General Assembly, *Promotion And Protection Of All Human Rights, Civil,Political, Economic, Social And Cultural Rights,Including The Right To Developmen [A/HRC/20/L.13]* (Human Rights Council, Twentieth session, Agenda item 3, 2012) at 1. and 2

[680] United Nations General Assembly, *Promotion and Protection of All Human Rights, Civil, Political, Economic, Social And Cultural Rights, Including The Right To Development [A/HRC/26/L.24]* (Human Rights Council Twenty-Sixth Session Agenda Item 3 2014) at 1

[681] Ibid at 5.

[682] *Ahmet Yildirim v. Turkey* (2012-2013) (Application no3111/10) at 68-69

Rights found that the wholesale blocking of all the websites is a violation of Article 10[683] of the European Convention on Human Rights.

Since the right to freedom of expression is a political right which has a very cultural characteristic as discussed earlier, therefore internet access, as part of the right to freedom of expression, contains a very cultural characteristic as well. This could be drawn from a different point of views of the states towards the openness of the internet. While most countries offer some forms of filtering or blocking access to contents on the internet, it appears that some may provide stricter standards comparing to others. This could be seen from the restriction of internet access in the case of China State Firewall and Saudi Arabia.[684]

Even though the various degrees of internet openness reflect a different standard, and offer a cultural characteristic of internet access and control amongst countries, it is remarkable that all the blocking and filtering tools are design on one unified attempt and objective; that is to prevent people's access to the internet contents and infrastructures. Thus, from this point of view, the internet contents and infrastructures are two main components which are of internet global and universal qualification.

**Conflicts:** If it is agreed, first of all, that *free expression is an engine of creative expression*; second, *creative expression is an engine of copyright*;

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[683] ECHR 1950, article 10 *'1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises. 2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.'*

[684] Murray pp73-75, see also at footnote 63. According to the OpenNet Initiative, substantial filtering also found in Bahrain, Burma, China, Ethiopia, Iran, Libya, Oman, Pakistan, South Korea, Saudi Arabia, Sudan, Syria, Thailand, Tunisia, UAE, Uzbekistan, Vietnam and Yemen. The interactive Global Internet Filtering Map could be viewed from the website of the OpenNet Initiative at http://map.opennet.net/filtering-IT.html

third, *copyright protection conflicts with free speech*; and finally, *internet access advocates free speech protection*, it is thus fair to say that 'copyright protection also conflicts with internet access.'

This is because, first of all, according to article 15(c) of the ICESCR the authors will enjoy benefit from the protection of moral interest and material interest resulting from their creations. These moral and material interests, or in other words moral rights and economic rights which derived from the authors' creation, both are the interests of the authors over their intangible property. It is agreed that the authors have an ownership over their intangible property. That intangible property which belongs to the authors is a very special thing called the '*authorship* over the creation of the mind'.[685] The issue of '*authorship* over the creation of the mind' as intangible property of the authors/creators and 'ownership' will again be reemphasised in chapter III.

Therefore, copyright is the protection of the interests of the authors over an intangible property called the 'the author's creation of the mind'.

That concept works with fewer problems in an offline environment where the work which contains the intangible property of the author comes in a tangible format or medium such as books or CDs. This tangible medium has a characteristic of 'rival good'. However, in the online environment where the internet plays an important role, the intangible property of the author now comes in a work which is digitised and thus could be transferrable without any need of tangible medium. These works include *literary works, musical works, audiovisual works*, and *images* as provided later in chapter III. Such works

[685] As previously discussed in section II of this chapter

now attain a new status as 'non-rival good'. This non-rival good is, more or less, intangible.[686] The problems occurred under these circumstances are:

1) Internet technology allows free (almost at no cost) access to any digital works online. Those works which could naturally be digitised, stored and published online include the work which is expressed in writing or printing, musical work, photographic work (aka two-dimensional work), and cinematographic work**. It does not include, however,** choreographic works, architectural works, sculptural works and other three-dimensional works.[687] These works, carried and delivered over the internet in a digital or format, could possibly be protected by copyright in one way or another. If internet is a tool that advocates freedom of expression, it is then again on the internet that the right of the people who want to exercise their freedom in communication (the *speaker*, the *audience*, and the *public*) will be restricted by the exclusive rights of the copyright owner (either individuals or institutions). See further discussion about this issue in chapter III.

2) Internet offers the works in digital format for benefit of people to access and use. These digitised works are non-rival goods which are at the same time intangible. Copyright, similarly, offers protection to intangible property of the author: the '*authorship* over the creation of the mind'. Therefore, when the protection of copyright was applied to the works published on the internet, it is nearly abstract in the sense that it offers protection to 'the intangible property of the author' which is incorporated in the works that are 'non –rival and intangible' property. This makes the application of copyright in the digital environment very problematic.

[686] Murray pp9-13

[687] See Chapter I.D. LIMITATIONS AND EXCEPTIONS IN THE DIGITAL ERA

## III. COPYRIGHT AND HUMAN RIGHTS: THE CONFLICTS OF RIGHTS IN THE DIGITAL ENVIRONMENT

Based on the fundamental of copyright under the human right aspect that: 1) copyright is intellectual property right *of creator*, 2) copyright is property right *of creator*, and 3) creative expression (originality and creativity) is an engine of copyright. It confirms that copyright's main purposes cannot be firmly achieved without an internal function that encourages a development and prosperity of creative expressions. And by giving protection to the interests derived from such creative expressions, in this scenario the person who plays the most important role is the individual *creator.*

When copyright is applied to internet technology, copyright protects 'the intangible property of the author' embedded in the digital works which are 'non –rival and intangible' disseminated over the internet, whereas the internet, on the other hand, encourage the right to freedom of expression of the *speaker*, the *audience*, and the *public*.

Therefore, in order to serve every fundamental concept of human right, copyright protection and the internet access, this thesis proposes that copyright protection in the digital era should be directed towards the main and principal objectives of all that:

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of**

> **expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

The importance of balancing between copyright and freedom of expression reflects in the decision of *Neij and Sunde Kolmisoppi v. Sweden*[688] where the European Court of Human Rights held that sharing or allowing others to share files on the internet, even those shared files are copyright-protected and the act of sharing is for profit-making purposes, was covered by article 10 of the European Convention of Human Rights on the right to freedom of expression. However, restriction to such right for purpose of copyright protection is also valid and necessary in a democratic society. In *Ashby Donald and others v. France*[689] the European Court of Human Rights also found that the publication of photographs on a website either in free of charge or with payment required falls within the scope of the right to freedom of expression article 10 of the European Convention of Human Rights. The restriction of such right could not be applicable unless it was prescribed by law and is necessary in a democratic society. However, in this case the Court ruled that the interference to the right to freedom of expression of the applicant was prescribed by law and is proportionated and necessary in a democratic society. Therefore it does not violate article 10 of the European Convention of Human Rights.

Nonetheless, according to the statement above, it might create some question that: so, what are the rights of the institutions or the right holders (who are not original individual creators) under the copyright and internet regime?

In the offline world, even though copyright's aim is to protect the moral and material interests of the creator as the person who has ownership and

[688] *Neij and Sunde Kolmisoppi v. Sweden* [2013] , (application no 40397/12)

[689] *Ashby Donald and others v. France* Application no 36769/08 at 34-45 (European Court Of Human Rights) at 34-45

*authorship* over the created work, from the discussion above it is certified that other parties who are not the original creator of the work (thus could not have *authorship* over the work) could possibly have ownership over that 'creation of the mind' as well. This includes the institutions, companies and other individuals as the copyright holders. First of all they could have an ownership over the 'creation of the author's mind' and retain a status as a copyright holder through a copyright transfer agreement. Secondly, in case that such creation is the work made for hire there are exceptions for example under section 201 (b) of the US Copyright Act 1976 that the employer 'is considered the author'[690] whereas section 11 (2) of the UK Copyright, Designs and Patents Act 1988 states that the employer 'is the first owner' of any copyright in the work.[691]

Since the institutions and other individuals could possibly be considered as either the author or the copyright holder according to the laws, it brings more difficulties for us to identify the real author or copyright owner of those writings, printings, musical works, photographic works and cinematographic works published online. A user of an online work, without a lawful permission, is taking risk in both ways: whether that use is likely infringing a copyright of an individual author or a big company.[692]

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[690] 17 USC § 201 (b) *'In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.'*

[691] CDPA 1988, section 11 (2) *'Where a literary, dramatic, musical or artistic work **[**or a film,**]** is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to any agreement to the contrary.'*

[692] See also Williams M, 'Premier League warns about posting goal videos online' (*Newsbeat Reporter*, 15 August 2014) <http://www.bbc.co.uk/newsbeat/article/28796590/premier-league-warns-about-posting-goal-videos-online> accessed 2 July 2015, the director of communications at the Premier League stated that *"You can understand that fans see something, they can capture it, they can share it, but ultimately it is against the law."* And *"I know it sounds as if we're killjoys but we have to protect our intellectual property."*

These problems about ownership and *authorship* of individual creators and business entities and their interests in the online digital environment will be analysed further in chapter III.

## IV. CONCLUSION

From the discussion above it could be concluded that when focusing on copyright protection as human right in the digital environment, from a universal perspective the individual creators are protected by two kinds of human right. These are 1) the 'right to receive intellectual property protection' or '*the right to the protection of interests in intellectual creations*'[693], as a fundamental human right, and 2) the right to property as the owner of the creation of the mind, which belongs to the creator as her incorporeal property. In this respect, the institutions or publishers do not receive 'human right level' protection for their *moral interests* and *material interests* in intellectual creations. They could only have the 'human rights'-like protections through national legislations of the states.

Furthermore, from the cultural perspective, the individual creators are guaranteed the *right to freedom of expression* protection. As for the right to internet access, even though the protection is still in question which makes this right a very cultural characteristic, the internet 'technology' is, however, universal.

On the other hand the individual who is non-creator is guaranteed only the *right to freedom of expression* protection as long as they do not produce any creative expression. In this respect the non-creator individual will be protected with less benefit comparing with the individual creator.

[693] Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' p1045

However, when these people are participating and communicating online, both creator and non-creator are equally possible subsequent creators due to the function of the internet and technology. From the discussion above, it is confirmed as well that in these scenarios the protection of the copyright of the creator and the free speech of the public (or non-creators who are as well the possible subsequent creators) could create an external conflict between copyright and the right to freedom of expression.

Accordingly, from the universal characteristic of copyright and property right and the cultural characteristic of *freedom of expression* and the right to internet access, the solutions to the conflict cannot come under the free speech instrument (cultural) but need to come within 1) the internet technology and 2) intellectual property/copyright instrument (universal).

Most importantly, the solutions must be organised to support the fundamental objectives of copyright and freedom of expression that *'free expression (and creative expression) is an engine of copyright'* and to solve the external conflict between both rights. Also they must provide a balance between benefits of the creator and the public in the online environment based on the proposed concept that:

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

Moral rights, economic rights and *authorship* which are closely related to the *ownership* of the creator will be profoundly discussed in the next chapter.

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# PART II

# IN PRACTICAL: THE INTERNET, THE INDIVIDUALS AND THE LAWS

# CHAPTER III

# COPYRIGHT AND THE RIGHTS OF THE THREE MAJOR PARTIES UNDER ONLINE ACTIVITY CONTEXT: CONFLICT OF INTERESTS

## I. INTRODUCTION

As discussed earlier in chapter I and II that the current copyright protection scheme potentially creates conflicts of laws and conflicts of rights. Chapter I analyses the differences between the protection and exceptions of copyright and derivative work mainly in the US and the UK, and some other civil law countries. It could be presumed from the discussion in chapter I that under the present copyright regulations, the right of making derivative work which is one important exclusive right of the 'copyright owners' (individual or company) is highly affected in the digital environment. More importantly, the right of the 'subsequent users' of the work is also not sufficiently guaranteed, neither via the limitations and exceptions of copyright infringement or other possible copyright instruments. This is highly problematic in the digital era where internet technology allows people to widely and conveniently connect to each other and at the same time could easily make change to the contents. Internet is the revolution of the way people access to, disseminate, and share information.[694]

In addition, chapter II confirms the significance of individual persons under the online digital environment. It also highlights the fundamental concepts and conflicts of these individuals' rights as both 'creators' and 'users' of the copyrighted works under the human right context. Most importantly, it is proposed in chapter II that:

[694] See chapter IV

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

In chapter III, it will then be reaffirmed that the individual is the most important player in the online copyright environment. They are the persons who contribute their originality and creativity and thus possess a stronger protection so called '*authorship'* over the work of creation, whereas the institutional publishers could earn merely *ownership* over copyright.

Nevertheless, it appears in the latter parts of the discussion in chapter III that even though the individual is the most important player, the recent copyright regulations does not provide a proper balance between the interests of the individual creators and users, and the rights of the institutional publishers. In the online digital environment, it is the institutional publishers that could reap more benefits from the copyright protection system rather than the individual creators and users.

## A. THE THREE MAJOR PARTIES IN COPYRIGHT LAW

First of all, in order to efficiently analyse the interests of both individual creator and institutional publishers, it is important that the role of each parties involved in the copyright activities must be identified.

### A.1. Historical Development of Publisher's Rights and Author's Rights

Around 1450 after the invention of Gutenburg's printing technology, the legal protection instruments firstly introduced by the states were the censorship and privilege systems which generally granted protection to the 'printers and publishers'. From the beginning, the state authority solely held the right of printing in order to control what can be printed and who can print. In this case, 'the right to print' would be offered by the state through the licensing system to the privileged identities.[695]

Likewise, the local printing industries also created a protection system amongst themselves that, only the associated members can have the right to act as printers and publishers. For example, the England Stationers' Company which was established and granted a Royal Charter in 1556. Occasionally, the printing privilege will be provided to original authors of the works. However, generally printers and publishers are the main persons who took advantages of the right to print and sell of publications. The situation happened in the European States such as England, Italy and France.[696]

The turning point of history eventually arrived in the seventeenth century when the establishment of author's right has been discussed. Without any specific legislation, the author's right of reproduction and controlling the copying of their works has been mentioned in written in England, France and Germany.[697]One reason of the shift in England was because of the failure of the Stationers' Company to recover their rights in the eyes of Parliament.

[695] Sterling chapter 1

[696] Ibid

[697] Ibid

After the evolution of a party system, there was a wide opposition on monopoly and censorship over book publications. Also the Parliament was looking for some new instruments to increase the opportunity of a free press for purposes of public debate and distribution of propaganda.[698] In 1710 the Statue of Anne, the first British Copyright Act, was established with impetus of distinguished authors such as Defoe and Locke. The Act guaranteed authors 'the sole right' of printing their books in which could be administered to the publishers only via assignment in a limited period of time.[699]

At the beginning, in the UK when the writings of authors started to become commodities and the situation has shifted from the time *'the authors were supported by 'the especial patronage of the great' '* to the new age where *'the public had become 'the patrons of learning' '*, the authors needed to rely more on the profits derived from the circulation of their copies[700] and thus the question about 'literary-property' has been long and widely debated. One proposition is from the proponents of perpetual copyright stating that the author needs to be rewarded. Another side of opinion is from the opponents of perpetual copyright claiming that 'genuine authors do not write for money'.[701]

However, after the enactment of the *Statute of Anne (1710)* following with the decision of *Donaldson v Beckett*[702]it is confirmed that the authors

[698] Melissa De Zwart, 'A historical analysis of the birth of fair dealing and fair use: lessons for the digital age' [2007] Intellectual Property Quarterly 60 p68

[699] Sterling

[700] Deazley p152

[701] Mark Rose, *Authors and owners : the invention of copyright* (Harvard University Press 1993) p104

[702] *Donaldson v. Becket*

have a limited, though not perpetual, term of *property right* over their creations[703]. As Blackstone, relied on Locke's, stated that:

> *'When a man by the exertion of his rational powers has produced an original work as he pleases … any attempt to take it from him, or vary the disposition he has made of it, is as invasion of his right of property.'*[704]

Given the *property right* to the original work of creations of an author, the law has therefore secured the booksellers and publishers a *property right* over their purchased works. With a literary *property right* protection, though it is limited, the publishers could have confidence to buy and sell those works in which they have purchased from the authors. This is where the histories of publishing and *authorship* reunited.[705]

In the meantime the US and France also provided authors with protections. The first author's right principle was accepted in Connecticut in 1783 following with the Copyright Act 1790 which guaranteed authors and their successors 'the sole right and liberty' of printing their works. In France, the French Revolution has brought significant changes to its system. After 1789, the former privilege and licensing system were abolished and substituted with the author's right of performance and distribution.[706]

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[703] Blackstone also created a distinction between the book, the doctrine contained therein, and the expression of that doctrine, suggesting that *'A book, could be conceived of as both a doctrinal composition, and a mechanical composition. The doctrinal composition could be further divided into the ideas it contained, and the language of the author in conveying those ideas. … Ideas common to the public could be confined within the private language of the individual author. … The **mechanical** part, that is the writing or printing, is, with respect to the author, only the **mean** for promulgating the doctrinal part, which is the **end.**'* Deazley p160

[704] Ibid p158

[705] John Feather, 'The Significance of Copyright History for Publishing History and Historians' in Kretschmer Martin Deazley Ronan , Bently Lionel (ed), *Privilege And Property : Essays On The History Of Copyright* (OpenBook 2010) p364

[706] Sterling pp11-13

Therefore, around the beginning of the eighteenth century, it is likely that the idea that an author should have a protection for their creative works has firmly shaped.[707] During the nineteenth century, the European States have adopted the principles that granted authors with the right to control printing and performance of their works.[708]

Also, it is noteworthy that during the eighteenth century it is the booksellers or publishers who argued for the perpetual literary property on the writings of the author. However, when it came to the nineteenth century it now turned to the authors themselves who argued for the perpetual copyright protection on their works.[709]

### A.2. Publisher's Rights, Author's Rights and Public User's Rights under International Regulations

#### 1) Berne Convention 1971

##### (i) Publisher's Rights and Author's Rights

Until the middle of the nineteenth century, generally there were two different systems of protection for authors; the *copyright system* and the *author's right system*. The *copyright system* which emerged in the UK and the US primarily granted economic and commercial rights to authors of the original works. Also they accept corporate *authorship,* for example, in the US work for hire principle which provides that the *authorship* in the work made for hire belongs not to the individual person who creates it but the individual or the legal entity who paid to have that work created.[710]

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[707] W. R. Cornish, David Llewelyn and Tanya Frances Aplin, *Intellectual property : patents, copyright, trade marks and allied rights* (7th edn, Sweet & Maxwell 2010) p399

[708] Sterling pp14-15

[709] Rose, *Authors and owners : the invention of copyright* pp111-112

[710] 17 USC § 201 (b)

The *author's right system* which was found in France and Germany offered authors with both economic and non-commercial and non-transferable moral rights as dual protection. In this case, even though both systems provided protection for authors, the approaches were dissimilarly enforced under two distinct concepts of 'originality'.[711]

The International Literary and Artistic Association (ALAI) or *L'Association Littéraire et Artistique Internationale* which was formed in Paris in 1878 on the proposal of Victor Hugo represented an effort of the French to attain a general international agreement on the rights of authors. The meeting eventually led to an international agreement on the Berne Convention for the Protection of Literary and Artistic Works which was first signed by the member countries in 1886 and latest revised in 1971.[712] The Convention provided the protection of author's rights on three main categories of works; literary, scientific and artistic domain.[713] The persons who are eligible for an automatic copyright protection are the authors of those created works.

In addition, the Convention also incorporated moral rights protection for authors.[714] The provision was strongly supported by the civil law countries such as France, Poland, Italy, Romania and Belgium. [715] However this approach is one of the obstacles for the US to join the Convention.

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[711] Sterling pp16-17

[712] Ibid Chapter 18

[713] Berne 1971, article 1 and 2

[714] Berne 1971, article 6*bis* adopted at the Revision Conference of Rome in 1928 See also International Copyright Union, *Proceedings Of The Conference Held At Rome From May 7 to June 2, 1928* (Pierre Tisseyre tr, [Berne] : International Union for the Protection of Literary and Artistic Works 1928)

[715] Gerald Dworkin, 'Moral rights and the common law countries' (1994) 19 Columbia-Vla Journal of Law & The Arts 229 p231

When the idea of moral rights protection was firstly introduced at the Rome Conferences in 1928 the common law countries were not yet familiar with the concept as such.[716] The theoretical development of the US copyright law was influenced by the British Statute of Anne 1710.[717] At that time the UK had generally offered some specific and limited moral rights protection for authors in some other forms. Also the US granted moral rights protection for authors through contract which is the simplest and most effective way.[718] From these approaches it is argued that the common law copyright system accorded more fairness, flexibility and balancing between authors and public users, whereas the civil law moral rights, particularly the right of integrity, offered stricter protection mainly for benefits of authors.[719]

**(ii) The Birth of the Rights for Public Users**

Meanwhile it is agreed that the author has *property right* over her creation and thereby entitled to the exclusive rights over such creation. According to the *Statute of Anne* (1710) the author of the work (if not transferred) is the only person who has the sole right to print or reprint the work, as stated that:

> *'the Author of any Book or Books already Printed, who hath not Transferred to any other the Copy or Copies of such Book or Books, Share or Shares thereof, or the Bookseller or Booksellers, Printer or Printers, or other Person or Persons,*

[716] Ibid

[717] Sterling p64

[718] Dworkin pp232-233

[719] Adolf Dietz, 'Moral rights and the civil law countries' (1994) 19 Columbis-Vla Journal Of Law & The Arts 199, Richard A. Posner William M. Landes, 'An Economic Analysis of Copyright Law' (1989) 18 Journal of Legal Studies 325 and Martin R.F. Senftleben P. Bernt Hugenholtz, *Fair Use in Europe . In search of Flexibilities* (Institute for Information Law (IViR), University of Amsterdam and Vrije Universiteit, Amsterdam, 2011) p7

> *who hath or have Purchased or Acquired the Copy or Copies of any Book or Books, in order to Print or Reprint the same, shall have the sole Right and Liberty of Printing such Book and Books for the Term of One and twenty Years, …'* [720]
>
> And,
>
> *'the Author of any Book or Books already Composed and not Printed and Published, or that shall hereafter be Composed, and his Assignee, or Assigns, shall have the sole Liberty of Printing and Reprinting such Book and Books for the Term of fourteen Years…'*[721]

The infringement occurs when other persons than the author, such as the booksellers and printers, shall print, reprint, sell, publish, expose to sale or cause to be sold without consent of the author:

> *'And that if any other Bookseller, Printer, or other Person whatsoever, from and after the Tenth Day of April, One thousand seven hundred and ten, within the times Granted and Limited by this Act, as aforesaid, shall Print, Reprint, or Import, or cause to be Printed, Reprinted, or Imported any such Book or Books, without the Consent of the Proprietor or Proprietors thereof first had and obtained in Writing, Signed in the Presence of Two or more Credible Witnesses; or knowing the same to be so Printed or Reprinted, without the Consent of the Proprietors, shall Sell, Publish, or Expose to*

[720] Annae Reginae Anno Octavo, 'The Statute of Anne 1710' (*The History of Copyright: A Critical Overview With Source Texts in Five Languages (a forthcoming book by Karl-Erik Tallmo)*) <http://www.copyrighthistory.com/anne.html> accessed 2 July 2015

[721] Ibid

> *Sale, or cause to be Sold, Published, or Exposed to Sale, any such Book or Books, without such Consent first had and obtained, as aforesaid, Then such Offender or Offenders shall Forfeit such Book or Books, and all and every Sheet or Sheets, being part of such Book or Books, to the Proprietor or Proprietors of the Copy thereof, who shall forthwith Damask and make Waste-Paper of them:'*[722]

According to the text of the *Statute of Anne* and after the decision in *Donaldson v. Becket*[723]there is certainly one way that the public users or any other persons than the author and their assignees can legally use the copyrighted work without authorisation of the author. That is to wait until the two of fourteen-year terms (for the new books), or the twenty-one year term (for the books published before the enactment of the Statute) has expired.

However, this represented a significance change in the objective of the *Statute of Anne.* Even though at the beginning the law was firstly drafted as a mean to protect the literary property of the author and to regulate the activities of the book trade, the content of the draft has been transformed after it was presented to the parliament. It came out that the parliament now focused on the Act as a mean to encourage learning of the society.[724] This confirms the fundamental concept of freedom of expression and creativity (or creative expression) as an engine of copyright as previously discussed in chapter II. As it appears in the beginning of the Statute that this is *'An Act for*

[722] Ibid p2

[723] *Donaldson v. Becket*

[724] Deazley p164

*the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned."*[725]

While the *Statute of Anne (1710)* is trying to draw a balance between the interests of the booksellers and the public, the following law which was drafted in 1935 has further moved away the benefits from the booksellers to the readers, and still left the benefits of the authors on the side.[726] Therefore, from the preamble of the *Statue of Anne* and relevant cases[727] it appeared that the UK criteria at this stage had embraced the idea of copyright protection and use of copyright materials in a fair manner on the basis that they promoted the development of public good.[728] The UK copyright law has recognised the public interest by restricting the exclusive rights of the author to a limited period of time.[729] Hence, during the eighteenth century the public users of the copyrighted work could draw benefits from the limited period of protection, or in other words, the recognition of the concept of 'public domain' which was then created by the *Statute of Anne.*[730]

In addition, before the copyright protection is expired, or during the time when all the exclusive rights of the copyright owner is still valid, there are still some possibilities that the public users or any other persons than the

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[725] Anno Octavo

[726] Deazley p165

[727] See *Millar v Taylor (1769) 4 Burr 2303; 98 ER 201, Gyles v Wilcox(1740) 2 Atk. 141; 26 E.R. 489., Tonson v Walker(1752) 3 Swans. 672; 36 E.R. 1017., Saunders v Smith(1838) 3 My. & Cr. 711; 40 E.R. 1100., Sweet v Benning (1855) 16 C.B. 459; 139 E.R. 838., Dickens v Lee(1844) 8 Jurist 183., Dodsley v Kinnersley(1761) Amb. 403; 27 E.R. 270., Macklin v Richardson(1770) Amb. 694;27 E.R. 451. , Whittingham v Wooler(1817) 2 Swans. 428; 36 E.R. 679., See also Mawman v Tegg (1826) 2 Russ. 383;38 E.R. 380.*

[728] Zwart p74

[729] Benjamin Kaplan, *An Unhurried View Of Copyright* (Columbia University Press 2008)

[730]Mark Rose, 'The Public Sphere And The Emergence Of Copyright: Areopagitica, The Stationers' Company, And The Statute Of Anne' in Kretschmer Martin Deazley Ronan , Bently Lionel (ed), *Privilege And Property : Essays On The History Of Copyright* (OpenBook 2010) p84.

author and their assignees can legally use the copyrighted work without authorisation of the author.

In the eighteenth century when copyright offers a limited term of protection to the work of the author, the law focus mainly on the labour that the author put into the work. Thus the law provided protection only against literal copying, but did not offer protection against adaptation or translation. This is because adaptation and translation usually include 'additional labour' of the subsequent author.[731]

When Dr. Thomas Burnet's Latin work *Archaeologiae Philosophicae,* which was protected under the Statute until 1731, was translated into English by the defendant in 1720. The Chancery held that the Statute *'could be intended only to restrain the mechanical art of printing,'* but a translation *'in some respects may be called a different book, and the translator may be said to be the author, in as much as some skill in language is requisite thereto, and not barely a mechanic art, as in the case of reprinting in the same language.'* This means that at that time a translation is included in the scope of the Statute's objectives on the side of learning encouragement rather than in printing prohibition.[732]

Twenty years later, in *Gyles v Wilcox*[733] Lord Hardwicke indicated that some forms of 'fair' abridgements could be permissible under the Copyright Act. This was because the Act did not precisely grant a monopoly right to authors in order to prevent or obstruct the creation of new and useful works

[731] Ibid p86

[732] Kaplan p10

[733] *Gyles v Wilcox*

to the public.[734] On the contrary, the Act merely limited the rights *'as some recompence for their pains and labour in such works as may be of use to the learned world*.'[735]

'Fair abridgment' as discussed in copyright infringement cases in the mid-18th century may refer to a summary of a longer original work which usually incorporated instances of the original work's form or expression. Mostly, the abridgement would provide the same information with the original work in a more unified and efficient style.[736] According to the opinion of Justice Willes in *Millar v Taylor*[737] the abridgement, *'…in respect of the property, may be considered as new works…'*

Furthermore, in *Dodsley v. Kinnersley*[738]there is a dispute over the abstract of *Rasselas* of Samuel Johnson, which was firstly printed in the *London Chronicle* by the plaintiff, and was later reprinted in the *Grand Magazine of Magazines* by the defendant. In this case, Sir Thomas Clarke has dismissed the bill giving the business reasoning that *"the defendants had not interfered unduly with the sale of the book."* [739] Also in *Sayre v. Moore*[740]*,* Lord Mansfield has emphasised in a popular quote that *'we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be*

[734] Zwart p75

[735] *Gyles v Wilcox*

[736] Alexandra Sims, 'Appellations of piracy: fair dealing's prehistory' [2011] Intellectual Property Quarterly 3 p4, Cited David Vaver, 'Abridgments and Abstracts' [1995] European Intellectual Property Review 225

[737] *Millar v Taylor*

[738] *Dodsley v. Kinnersley* Amb403, 27 Eng Rep 270 (Ch 1761)

[739] Kaplan p11

[740] *Sayre v. Moore 1 East 361 n, 102 Eng Rep 139 n (KB 1785)*

*deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded."*[741]

Hence, whereas the discussion in chapter II reaffirms the fundamental concept of freedom of expression and creative expression as an engine of copyright, the 'fair abridgement' exceptions and the consideration on economic interest as appears in *Dodsley v. Kinnersley* was generally considered as the earliest UK 'fair dealing' limitation and exception for copyright infringement during the premodern era of copyright law.[742] It did play an important role in the dissemination and communication of scientific, technical, and cultural knowledge. As Ronan Deazley indicated that, *"periodical publication throughout the eighteenth century was an appropriative affair in both substance and method."*[743] From that original William F. Patry argued in his book that the UK had since *'developed a relatively cohesive set of principles governing the use of a first author's work by a subsequent author without the former's consent*.'[744]

Notwithstanding, even though abridgements were accepted as legal in the 18th century, they could be treated as infringements in today's copyright laws.[745] Because, according to William F. Patry, those abridgements are the

[741] Kaplan p17

[742] Sims p8, See also An Unhurried View of Copyright, Benjamin Kaplan (2008) , Columbia University Press p21

[743] Matthew Sag, 'The Prehistory of Fair Use' (2011) 76 Brooklyn Law Review 1 p14-15 Cited Ronan Deazley, 'Commentary on Gyles v. Wilcox (1741)' *(Primary Sources on Copyright (1450-1900), eds L. Bently & M. Kretschmer, 2008)*<www.copyrighthistory.org> accessed 29 June 2015

[744] Patry

[745] Sims p7

'*use of a first author's work by a subsequent author without the former's consent.*'[746]

In case of the US, according to a mid- nineteenth century case *Folsom v. Marsh,*[747] Justice Joseph Story has formed in his decision some general principles of 'fair use' which remained as the fundamental doctrine of 'fair use' in the US this day. Here again Patry also indicated that the US doctrine of fair use is rooted from those origin of the UK doctrine of fair dealing.[748]

On the contrary, while the 'rules of fairness' was firmly established in the common law jurisprudence, particularly in the US Copyright Act, in the civil law approaches the rules were almost disappeared from the doctrine of the *droit d'auteur* systems. One possible reason was that; under the author's rights paradigm the systems relied mainly on the fairness of protecting natural rights of authors. The authors would be treated as the major owners of the rights. And therefore, in the end, the limitations to those rights of authors would exist just as the very limited 'exceptions'. And the interpretation of those copyright limitations under the decisions of the courts in *droit d'auteur* system has precisely developed in a restrictive manner.[749]

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[746] Patry

[747] *Folsom v. Marsh* Justice Joseph Story stated that:*'...no one can doubt that a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism. … So, it has been decided that a fair and bonbona fide abridgment of an original work, is not a piracy of the copyright of the author. ..... But, then, what constitutes a fair and bonbona fide abridgment, in the sense of the law, is one of the most difficult points, under particular circumstances, which can well arise for judicial discussion. It is clear, that a mere selection, or different arrangement of parts of the original work, so as to bring the work into a smaller compass, will not be held to be such an abridgment. There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work. ...'*

[748] Zwart p73

[749] Martin R.F. Senftleben and P. Bernt Hugenholtz p7

Ideally, these limitations and exceptions embedded in the copyright principles are significant and essential balancing instruments. This core value of the limitations and exceptions has been previously discussed in chapter I and then again be reemphasised in chapter II. The criteria allow sufficient freedoms for public users in order to appropriately interact with copyright works without unjustifiably undermining the value of copyright's rationales.[750]

The idea was confirmed by the statement of Justice O'Connor in *Feist* that:

> *'The primary objective of copyright is not to reward the labour of authors but "to promote the progress of science and useful arts". To this end copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. … This result … is the means by which copyright advances the progress of science and art.'*[751]

Nevertheless, after the Stockholm Revision in 1967[752] the Berne Convention eventually provided some limitations and exceptions on exclusive rights for benefits of public users under the notion of 'fair practice' of Article 10[753] which is possibly more popular in common law than in the continental

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[750] Ibid p6

[751] *Feist Publications, Inc. v. Rural Telephone Service Co.*

[752] , *Guide to The Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971)* (WIPO Publication No. 615 (E) edn, World Intellectual Property Organization, Geneva 1978) p58

[753] Berne 1971, article 10 (1) *'It shall be permissible to make quotations from a work which has already been lawfully made available to the public, provided that their making is compatible with fair practice, and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries.(2) It shall be a matter for legislation in the countries of the Union, and for special agreements existing or to be concluded between them, to permit the utilization, to the extent justified by the purpose, of literary or artistic works by way of illustration in publications, broadcasts or sound or visual recordings for teaching, provided such utilization is compatible with fair practice.'*

European,[754] and the general exception of "three-step test" under Article 9(2) which later was incorporated and modified to Article 13 of Trade-Related Aspects of Intellectual Property Rights (TRIPs).[755] Also the idea appeared in some other Articles such as the Limitations on Protection (Article 2(4)(8), and Article 2*bis*(1)), Exceptions to Protection (Article 10(1)(2), Article 10*bis*(1)(2), Articles 2*bis*(2), Article 14*bis*(2)(b), Article 14*bis* (3)), Compulsory Licenses (Article 13(1), Article 11*bis*(1)(2)), Others and Implied Exceptions (Article 11(1), Articles 9(2), 10 and 10*bis*, Article 17).[756]

**2) Trade-Related Aspects of Intellectual Property Rights (TRIPs) 1994**

After the international achievement of the Berne Convention in 1971, there was another successful international agreement which suggested international standards for member countries; the Trade Related Aspects of Intellectual Property Rights 1994 (TRIPs Agreement).

The impacts of new communication technologies such as satellite transmission, computer programs and computer databases plus significant growth of international piracy in sound recordings, film and book industries during the 1970s have brought important developments to copyright protection regime. From the original of the Berne Convention 1886 to Universal Copyright Convention 1952, Rome Convention 1961 and Record

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[754] Sam Ricketson, *WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment* (Standing Committee on Copyright and Related Rights, Ninth Session, Geneva, June 23-27, 2003) p13

[755] Berne 1971, article 9(2) *'It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.'* See also ibid p9

[756] Ibid p10-39

Piracy and the Phonograms Convention 1971[757], these instruments did not offer any specific provisions dealing with computers and new communication technology as such. Furthermore, the conventions only required the contracting states to grant protection to some certain rights but did not oblige them on providing any enforcement measures. The situation has raised high awareness amongst countries which were the major owner of copyright products in the sense that it would affect their gross benefits in international trade and exports.[758]

For this purposes, before the TRIPs Agreement the copyright protection framework has long been discussed and mentioned earlier in the international trade level.[759] For example, the General Agreement on Tariffs and Trade 1947 (GATT) provided that the contracting parties may adopt or enforce measures on protection of copyrights.[760] When GATT was updated to GATT 1994 after the Uruguay round negotiation, it then established the World Trade Organization (WTO) and the TRIPs Agreement. The TRIPs Agreement and WTO were adopted in Marrakesh in 1994 and it was a compulsory requirement for all WTO member countries to ratify TRIPs.[761]

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[757] See Sterling pp20-26

[758] Sterling chapter 22

[759] Daniel J. Gervais, *The TRIPS agreement : drafting history and analysis* (3rd edn, Sweet & Maxwell 2008)

[760] Article XX(d) of The General Agreement on Tariffs and Trade (GATT) 1947 '*…nothing in this Agreement shall be construed to prevent the adoption or enforcement by any contracting party of measures: (d) necessary to secure compliance with laws or regulations which are not inconsistent with the provisions of this Agreement, including those relating to customs enforcement, the enforcement of monopolies…, the protection of patents, trade marks and* ***copyrights****, and the prevention of deceptive practices…'* [Emphasis added]

[761] Gervais

### (i) Publisher's Rights and Author's Rights

The TRIPs Agreement is the international agreement which obliged member countries to provide some certain and minimum protections for authors in accordance with the protection given under Article 1-21 of the Berne Convention. This was clearly stated under Article 9(1)[762] of the Agreement. The moral rights of authors, however, were excluded from this provision.[763]

In case of publishers, the protection for publishers' rights was not clearly stated or internationally recognised under the Agreement. However, J.A.L Sterling argued that performers, phonogram and film producers, broadcasting organisations, and publishers may be granted protection under the same notion of 'related rights', since the concept of the rights referred to '*persons who present creative works to the public, but are not regarded as creators in their own right.'*[764] It is noteworthy that fundamentally these publishers would be protected at a lower level comparing with the individual authors as previously certified in chapter II. Nevertheless, for these purposes, the publishers' rights protection was mentioned in a number of national laws; such as Germany's, and in regional level as appeared in Article 4 of EC Term Directive. [765] The real benefits of these publishers in the online digital environment will be discussed further in the latter part of this chapter.

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[762] TRIPs 1995, article 9(1*) 'Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of that Convention or of the rights derived therefrom.'*

[763] Sterling p855

[764] Ibid p77 See also 'Understanding Copyright And Related Rights' *(WIPO)*<http://www.wipo.int/edocs/pubdocs/en/intproperty/909/wipo_pub_909.pdf> accessed 1 July 2015

[765] Ibid p77-79, 84 and Directive 2006/116/EC Article 4'*Any person who, after the expiry of copyright protection, for the first time lawfully publishes or lawfully communicates to the public a previously unpublished work, shall benefit from a protection equivalent to the economic rights of the author. The term of protection of such rights shall be 25 years from the time when the work was first lawfully published or lawfully communicated to the public.'*

### (ii) Rights for Public Users

The TRIPs Agreement also provided limitations and exceptions for public users. Those wording of Article 13[766] of TRIPs resembles the language of 'three-step test' in Article 9(2)[767] of the Berne Convention. Therefore, all WTO members are required to apply the 'three-step test' to all limitations and exceptions they are allowed to make under the Berne[768] and TRIPs.[769]

## A.3. The Shift of Publisher's Rights, Author's Rights and Public User's Rights in the Digital Era: WIPO Copyright Treaty (WCT) and WIPO Performances and Phonograms Treaty 2002 (WPPT)

The rapid growth of new communication technology from 1980s to early 1990s required some up-to-date instruments to deal with the issues. WIPO Copyright Treaty (WCT) adopted by the member states of the World Intellectual Property Organization (WIPO) in the Diplomatic Conference in Geneva 1996 and came into force in 2002. It provided protections to 'authors of literary and artistic works' as already mentioned in Article 2 of the Berne Convention. Most importantly, the meaning of 'literary works' was extended to include 'computer programs' as appear in Article 4[770] of the Treaty. Also for authors of 'compilations of data (databases)' their rights were protected under

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[766] TRIPs 1995, article 13 *'Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.'*

[767] Berne 1971, article 9(2) '*It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.'*

[768] See supra note 762

[769] Such as Article 11 (Rental Right), Article 14(1)-(3) (Performance on Phonogram, Producers on Phonogram and Broadcasting organizations), and Article 14(4) (Computer Program)

[770] WCT 1996, article *4 'Computer programs are protected as literary works within the meaning of Article 2 of the Berne Convention. Such protection applies to computer programs, whatever may be the mode or form of their expression.'*

Article 5.[771] As for public users, Article 10[772] of the Treaty granted limitations and exceptions under the same notion of 'three-step test' as Article 13 of the TRIPs Agreement.[773]

Furthermore, WIPO Performances and Phonograms Treaty (WPPT) which was also adopted in Geneva in 1996 and came into force in 2002 also provided neighbouring rights protection for performers and producers of phonogram.[774] The limitations and exceptions for public users were also guaranteed under Article 16[775] of the Treaty and to be conformed to the concept of 'three-step test' under TRIPs.[776]

## B. AN INTERTWINED RELATIONSHIP BETWEEN THE THREE PARTIES

From the beginning of publisher's right to the original of author's right and the right of public user, it could be presumed that generally there are three major parties involved in the modern copyright activities: the *creators*

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[771] WCT 1996, article 5 *'Compilations of data or other material, in any form, which by reason of the selection or arrangement of their contents constitute intellectual creations, are protected as such. This protection does not extend to the data or the material itself and is without prejudice to any copyright subsisting in the data or material contained in the compilation'*

[772] WCT 1996, article 10*'(1) Contracting Parties may, in their national legislation, provide for limitations of or exceptions to the rights granted to authors of literary and artistic works under this Treaty in certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author. (2) Contracting Parties shall, when applying the Berne Convention, confine any limitations of or exceptions to rights provided for therein to certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author.'*

[773]Sterling chapter 23

[774] WPPT 1996, article *2 "For the purposes of this Treaty: (a) "performers" are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret, or otherwise perform literary or artistic works or expressions of folklore;(b) "phonogram" means the fixation of the sounds of a performance or of other sounds, or of a representation of sounds, other than in the form of a fixation incorporated in a cinematographic or other audiovisual work."*

[775] WPPT 1996, article *16 "(1) Contracting Parties may, in their national legislation, provide for the same kinds of limitations or exceptions with regard to the protection of performers and producers of phonograms as they provide for, in their national legislation, in connection with the protection of copyright in literary and artistic works. (2) Contracting Parties shall confine any limitations of or exceptions to rights provided for in this Treaty to certain special cases which do not conflict with a normal exploitation of the performance or phonogram and do not unreasonably prejudice the legitimate interests of the performer or of the producer of the phonogram."*

[776] Sterling chapter24

or the *authors*, the *publishers*, and the *audience* or the *public users*.[777] Also their interactive activities could create some conflicts of interests amongst these three relevant parties. The relationship between each party and their rights and benefits could be analysed as follows.

### B.1. Authors and *Authorship*

Authors are the individual who produce works with their own creativity. They are regarded as the primary owner of the initial beneficiary of copyright.[778] Fundamentally, the individual are protected under the right to freedom of expression. Also free expression is an engine of creative expression and creative expression is an engine of copyright as previously certified in chapter II.

In the eighteenth century after the enforcement of the *Statute of Anne*, even though the perpetual copyright protection has been denied, the author, however, was guaranteed a natural right over their creation[779] as the fruit of their mind and labour.[780] The author could have *property right* (occupancy) over their creation due to the labour they contributed to the work. According to Warburton, that right does not extend to the physical manuscript of the creation (the book). Also, Blackstone has drawn a separation between the doctrinal and mechanical composition contained in a book. The mechanical of a book as the 'visible permanent characters on paper'

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[777] Christian Engström and Rick Falkvinge , *The Case for Copyright Reform* (2012) p48 which referred to Rick Falkvinge 'There Are Three Partiesd To Copyright'*(Falkvinge&Co. On Infopolicy,* 20 January 2011*)* <http://falkvinge.net/2011/01/21/there-are-three-parties-to-copyright/> accessed 3 July 2015 See also Paul Nijhoff Asser, 'Publishing, Copyright, and the Public Good' (1992) 8 Publishing Research Quarterly 5

[778] Sterling p207

[779] Rose, *Authors and owners : the invention of copyright* p110

[780] Deazley p157

and the idea that contained within are the parts that free for the reader to use:[781]

> *'[F]or he who obtaineth my copy may appropriate my stock of ideas, and by opposing my sentiments, may give birth to a new doctrine; or he may coincide with my notions, and by employing different illustrations, may place my doctrine in another point of view: and in either case he aquireth an exclusive title to his copy, without invading my property: for though he may be said to build on my foundation, yet he rears a different superstructure.'*

Accordingly, the *Statute of Anne* which was ground on the above concepts eventually granted protection not to the book (the tangible property) itself but the doctrine that contained in it, which includes the words, the text, or the writing (the intangible property) in which the author has clothed the ideas.[782] By means of this, 'the author' refers to *'an **individual** who is the sole creator of unique "works" the **originality** of which warrants their protection under laws of intellectual property known as "copyright" or "author's rights".'*[783] In chapter II it is certified that an author who contribute her originality and creativity to a creation will gain 1) intellectual property right protection as 'the right to receive intellectual property protection' and 2) property right protection (*authorship*) over the creation of her mind. Both of the rights of which contain the human right value.

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[781] Warburton, Blackstone and Locke in ibid pp158-161

[782] Ibid p220

[783] Woodmanseep15

According to Martha Woodmansee, at the beginning, in the eighteenth century the author was regarded; *firstly*, as a craftsman of the rules that was preserved and handed down to him; or *secondly*, as a person inspired by God so that she could achieve something higher than merely craftsmanship. Later on, the concept of craftsmanship has been minimised and it is the 'inspiration' which came from within the writer himself that the theorists in the eighteenth century favoured and used to separate *original genius* from the general craftsman.[784] For example, in case of the poem *The Seasons* written by James Thomson, which appropriated the British landscape with the imprint of the authors' personality, Mark Rose, referring to the opinion of Justice Aston in *Millar v. Taylor,*[785] indicated that: it is *'the product of this imprinting of the author's personality on the common stock of the world was a "work of* ***original authorship****." The basis of literary property, in other words, was not just labor but "personality," and this revealed itself in "****originality****."'*[786] Most importantly, 'originality' is the fundamental factor for a copyright protection to be grant to a work of creation of the author as previously specified in chapter II.

Since the writer's own genius is highly credited in the eighteenth century, the *writer* in this age has been transformed from merely a vehicle of the pre-commanded truths by some higher agency, to the *author,* which embraced the Latin meaning of originator, founder or creator.[787] This is

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[784] Martha Woodmansee, 'The Genius And The Copyright: Economic And Legal Conditions Of The Emergence Of The 'Author'' (1984) 17 The Johns Hopkins Unversity Press ,Eighteenth-Century Studies 425 pp426-427

[785] *Millar v Taylor*

[786] Rose, *Authors and owners : the invention of copyright* pp113-114

[787] Woodmansee, 'The Genius And The Copyright: Economic And Legal Conditions Of The Emergence Of The 'Author'' p429

emphasised in the treatise of Edward Young, *Conjectures on Original Composition in a Letter to the Author of Sir Charles Grandison,* that in order to receive a *property right* or *ownership* over her writing, a writer must not be compelled by the previous great authors but must contribute her own efforts and studies so that she could earn a honorific status of 'author'[788]:

> *'Let not great examples, or authorities, browbeat thy reason into too great a diffidence of thyself: thyself so reverence, as to prefer the native growth of thy own mind to the richest import from abroad; such borrowed riches make us poor. The man who thus reverences himself, will soon find the world's reverence to follow his own. His works will stand distinguished; his the sole property of them; which property alone can confer the noble title of an author; that is, of one who (to speak accurately) thinks and composes; while other invaders of the press, how voluminous and learned soever, (with due respect be it spoken) only read and write.'*[789]

Here, Young has added the notion of original genius into the traditional discourse of *authorship* so that the author in that era could earn an honorific status as the founder of authenticity and originality.[790]

This is the concept of Romantic author-*authorship* in the UK in the eighteenth century which relies firmly on the originality and creativity of the author that the imitative writer such as Ben Johnson and Alexander Pope were

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[788] Ibid p430, see also Rose, *Authors and owners : the invention of copyright* (Harvard University Press 1993) p117

[789] Edward Young, 'Conjectures on Original Composition in a Letter to the Author of Sir Charles Grandison' in Edmund D. Jones (ed), *English Critical Essays Sixteenth, Seventeenth, And Eighteenth Centuries* (London, Oxford University Press 1975) p289

[790] Rose, *Authors and owners : the invention of copyright* pp118-121

devalued.[791] In the civil law system, for example in Germany, the writing was firstly in the public domain. Everyone is free to reproduce the knowledge in the book which is public unless the laws said otherwise. Until later, when the physical foundation of the book is distinguished from the emanation of intellect of the author, the printed paper is separated from the content, as provided in Fichte's Essay, *Proof of the Illegality of Reprinting: A Rationale and Parable (1793),* that there are *'the **material** aspect, the content of the book, the ideas it presents; and … the **form** of these ideas, the way in which, the combination in which, the phrasing and wording in which they are presented',* the concept of '*authorship*' is hereby grounded that the writer could now claim *ownership* over the *form* of the work as long as such *form* contains originality and that she is the originator and creator *(Urheber)*.[792]

> *'… Now, since pure ideas without sensible images cannot be thought, much less are they capable of representation to others. Hence each writer must give his thoughts a certain form, and he can give them no other form than his own because he has no other. But neither can he be willing to hand over this form in making his thoughts public, for no one can appropriate his thoughts without thereby altering their form. This latter thus remains forever his exclusive property.'*[793]

[791] Ibid p122

[792] Woodmansee, 'The Genius And The Copyright: Economic And Legal Conditions Of The Emergence Of The 'Author'' pp431-445

[793] Johann G. Fichte *Proof of the Illegality of Reprinting: A Rationale and Parable (1793)* quoted in ibid p445

Therefore, the relationship between *author* and *authorship* in the eighteenth century has been that *authorship* will belong to the individual author who creates a work which contains their originality and creativity. This is the by-product of the Romantic notion of *authorship* in relation to the word 'original'.[794] After the eighteenth century, it appears later that in the civil law system the meaning of 'authors' is restricted to the 'persons' who are the creator of the work although in some specific cases the legal entities could possess the rights of the authors, whereas in common law system, the term is expanded to a wider sense to include both individual and legal persons who held responsibility for the creation of the works.[795]

In the nineteenth century, however, the meaning of author-*authorship* has been changed, particularly, in these two areas:

**(i) Derivative Work**

In the eighteenth century '*authorship*' and 'genius' are correlated in the sense that originality and creativity are the important factors to define *authorship* of an individual author. Therefore it is held by the court during this period that subsequent works which contain new components and is not an identical imitation of the previous works is not an infringement.[796] This refers to the case of fair abridgement and translation. But the court's decisions in the nineteenth century had reversal opinions. In *Rogers v. Koon* [797] and

[794] Woodmansee, 'On the Author Effect: Recovering Collectivity' p16

[795] Sterling p207

[796]Peter Jaszi, 'Toward A Theory Of Copyright: The Metamorphoses Of "Authorship"' (1991) 1991 Duke Law Journal 455 p472 Referred to *Gyles v Wilcox* (1740) 2 Atk 141; 26 ER 489 and Newberry's Case, Lofft 775, 98 Eng. Rep. 913 (Ch. 1773) as discussed by Kaplan B, *An Unhurried View Of Copyright* (Columbia University Press 2008), that *'[W]e can say that the infringement problem was being answered … by looking not so much as what the defendant had taken as to what he had added or contributed.'*

[797] *Rogers v. Koons*

*Sheldon v. Metro-Goldwyn Pictures Corp.*[798] the originality that the new author contributed to the subsequent work could not save her from being an infringer.[799] The objective of the exclusive right of making adaptation is now focusing mainly on the work created by the original author of the previous work. Such right could only be assigned to the person who receives the author's permission.[800] In addition the 'substantial similarity' test which is rooted on the concept of Romantic '*authorship*' also forbids unauthorised borrowing of the identical expression from the previous work of the original author even though such expression may be in the public domain, as appears in *Roger v. Koons*.[801]

That was the movement in the eighteenth and nineteenth century. In current situation, the issue about the 'substantial similarity parts' and 'originality and creativity' of subsequent author of derivative work is considered moving. This creates a different standard of copyright protection for derivative work, for example in comparison between US and UK jurisdictions, which could be found in chapter I.

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[798] *Sheldon v. Metro-Goldwyn Pictures Corp. 81 F2d 49, 56 (2d Cir 1936)*

[799] Jaszi pp472-473

[800] Peter Jaszi, 'On the Author Effect: Contemporary Copyright and Collective Creativity' in Martha Woodmansee and Peter Jaszi (ed), *The Construction of Authorship: Textual Appropriation in Law and Literature* (3rd printing edn, Duke University Press 2006) p 40. See also Rose, *Authors and owners : the invention of copyright* p132-133 *'… for the early rulings under the Statute of Anne focused on the author's labor and limited the property closely to the actual text at issue. Thus Lord Chancellor Macclesfield stated in Burnett v. Chetwood (1720) that a translation might be regarded as a new work (ER 35:1009), and in Gyles v. Wilcox (1740) Lord Chancellor Hardwicke stated that an abridgement would also qualify as new (ER26:490). In the nineteenth century, however, the emphasis in litigation shifted to the abstract "work," which now came to be understood as equivalent, in the words of Drone on Copyright, the standard U.S. treatise of the period, to the "essence and value of a literary composition" rather than limited to the literal language of the text.'*

[801] Ibid pp40-48

### (ii) Works Made for Hire

In the American copyright law, *authorship* in the work made for hire belongs not to the individual person who creates it but the individual or the legal entity who paid to have that work created. The employer or legal entity possesses the right not by the assignment from their employee but rather by the law which grants the right directly to the employer under the Romantic conception of *authorship*.[802] Thus, in many cases the authors of the copyright works are rarely also their owners.[803] These corporate entities, as copyright owners, are seeking to control the non-paid enjoyment of those copyrighted works without considering the role and presence of their individual authors. This overlooks the copyright's role on facilitating creativity.[804]

Finally, for purpose of searching for an author, Jane C. Ginsberg has proposed the six relevant principles that: *1) Authorship places mind over muscle, 2) Authorship vaunts mind over machine, 3) "Originality" is synonymous with authorship, 4) The author need not be creative, so long as she perspire, 5) Intent to be an author, and 6) Money talks; maybe it also writes, composes, paints etc.* as appears in the US copyright law in case of the works made for hire.[805]

In the new technological age there could be conflicts amongst authors on their views towards the technologies. Some authors may favour extensive rights protection and object new technologies which deter their control over the works. Whereas some may favour the ability to copy offered

[802] Jaszi, 'Toward A Theory Of Copyright: The Metamorphoses Of "Authorship"' pp485-486. See also 17 USC § 201(b)

[803] Alan Story, '"Balanced" copyright: not a magic solving word' [2012] European Intellectual Property Review 493 p494

[804] Ginsburg pp1067-1068

[805] Ibid pp1072-1091

by technologies that they could manage to re-create and vigorously publish their works to audiences.[806]

In conclusion, the argument here has demonstrated and emphasised a close link between '*authorship*' and the author's genius which are the major substances of 'originality and creativity' in a work of creation, and the 'exclusive rights' granted by copyright to the authors following their '*authorship*' over their creations. The conclusion here is correlated with the discussion in chapter II which highlights the importance of originality and creativity as a major substance for an individual author to receive 1) intellectual property right and 2) property right protection over the creation of her mind.

### B.2. Publishers and *Ownership*

Naturally, publisher is the persons who act as intermediaries between authors or creators of the copyright work and their audiences or public users. In music industries they may also act as recorders, transmitters or embellishers.[807] In general cases, the rights of publishers under copyright regime could either be derived from the rights of authors as the licensees or assignees, or be as authors, as initial owners of copyright, as 'successors in interest' of authors, or as sharers both of 'the legitimate interests of authors'. Sometimes the publishers may also need separate protections. [808] Nevertheless, unless it is discovered that the publisher has contributed their 'genius' or 'originality or creativity' to such work of creation, the publisher

[806] William Patry, *How to Fix Copyright* (Oxford University Press 2011) p9

[807] Paul Nijhoff Asser, 'Publishing, Copyright, and the Public Good' (1992) 8 Publishing Research Quarterly 5 p5

[808] Charles Clark, 'Copyright and the Publisher in a Market Economy' (1992) 8 Publishing Research Quarterly 79

could never earn '*authorship*' or *property right* over the work of creation. Only they can possess '*ownership*' over the copyright in the work which will be granted to them subject to the agreements and contracts.

In addition, it has been clarified in chapter II that the publishers may not be able to receive a human right level of protection over a work of creation. This means that they will not be able to receive protection for their moral interest and *authorship*. The only things the publishers could receive are the protection for their material interest as their economic rights. This is because they possess ownership over the copyright of the works.

There are also disputes between authors and publishers/distributors over royalty payments, reversionary rights and distribution of works over the new media.[809] It is important to note that in the modern era publishers are growing as ever bigger entities. Their basic rights often endorsed a large area of rights. When entering into contracts with publishers, authors often had less market forces comparing with those media giants. The situation is that all markets and rights belonged to those giant's empire and therefore there was not enough transparency to acquire public criticism over pricing, accessibility, or certain use of authors' works. This problem then turned into the arguments regarding consumer protection and then was balanced through the concept of collecting societies, even though, through that mean, the collective societies still possessed nothing but the rights to offer.[810]

[809] Patry, *How to Fix Copyright* p9

[810] Gunnar W.G. Karnell, 'The Berne Convention between authors rights and copyright economics - an international dilemma' [1995] International Review of Intellectual Property and Competition Law 193 p196

According to Sterling, publishers do not receive any specific rights granted under the Berne Convention[811], nevertheless they could possibly benefit from: **1) Authors' Rights**, when they invest their creativity in such a level that contribute production of the creative works, **2) Publishers' Rights**, under the notion of 'neighbouring rights/related rights' as guaranteed by the laws of civil law jurisdictions, or under the term of 'copyright' under common law system, **3) Publishing Rights**, by 'assignment' that the publishers would stand in the shoes of authors, or **4) *Sui Generis* Rights** such as the 'database maker's rights'[812] appear under EC Database Directive.[813] Therefore, it could be said in the beginning that publishers are only the middlemen who dealt with the rapidly changing markets.[814] The roles of the publishers are developing when it comes to the new technological age, which will be discussed further afterwards.

In conclusion, the thesis is emphasising that, with such a close link between an author and her 'genius' and 'originality and creativity', no other person than an author who contributes her 'genius' and 'originality and creativity' could possess '*authorship*' over a creation. Unless they provide their 'genius' and 'originality and creativity' to the work, the publishers who help encourage an economic value to a work of creation could, at best, earn only

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[811] Sterling p388

[812] Directive 96/9/EC article 7 (1) *'Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database.'*

[813] Sterling p241

[814] Chris Holifield, 'The Writer/Publisher Financial Relationship' (*Writers Services*, 2006) <http://www.writersservices.com/resources/writerpublisher-financial-relationship-inside-publishing> accessed 3 July 2015

'*ownership*' over the copyright of the work. This is also subject to the agreement between the author and publisher.

### B.3. Public Users and *Freedom of Expression*

With regard to the purpose of copyright to encourage creativity or *creative expression*, the discussion in chapter II has demonstrated that the *creative expression* arises from the protection of the right to *freedom of expression* of the *speaker*, the *audience*, and the *public*. Or in other words *'free expression (and creative expression) is an engine of copyright'.*[815]

The works protected by copyright will be guarded against unauthorised uses by other parties than the authors, the copyright owners, and their assignees. Public users can use parts of the works without authorisation of the copyright owners only if their activities comply with some specific exceptions. These exceptions include:

1) The use of the facts or idea of the works, either *non-expression* or *non-creative expression* parts that contain no originality and creativity of an individual author and is not protected by copyright[816]

2) The use of *creative expression* which is not protected and is therefore in the public domain due to the expiration of the period of copyright protection

3) The use of *creative expression* under the scope of limitations and exceptions of copyright infringement as provided in the *three-step test*[817]

In many cases authors can also be parts of public users when they are making derivative works from the original copyrighted work of other

[815] See chapter II Copyright and the Right to Freedom of Expression

[816] See chapter II The External Conflict between Copyright and the Right to Freedom of Expression

[817] See chapter I

authors. Their use of the works in such meaning may in some way affect the rights of the previous authors.[818] This creates a serious tension between the original authors and the public users or the future subsequent creators, particularly in the online environment, as discussed earlier in chapter I.

Also public users and authors are having some conflicts over availability of works, pricing, personal use and the scope of rights.[819] From the position of the original authors, there are two strategies that they can claim benefits from those users of their copyrighted works. *First* is to interpret provisions on limitations and exceptions such as fair use, fair dealing, private use, or personal use very narrowly. Then, *secondly* the original authors could rely on the module of collective societies which allow them dependable compensations from users whose activities do not fall under those exceptional provisions.[820] These collective societies were developed in early nineteenth century in order to manage pricing and access to copyrighted work between publishers/producers, authors and public consumers/users.[821]

In conclusion, the thesis is emphasising that, even though a public users has yet possessed '*authorship*' or '*ownership*' over a work of creation, they still possess a right called *'freedom of expression'*. This right is the origin of 'genius' and 'creativity' which are the substances of '*authorship*' of the authors over the works of creation.

Finally, it could be construed that, fundamentally, there are three main parties whose rights would be protected under copyright law. The first

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[818] Patry, *How to Fix Copyright* p132

[819] Ibid p9

[820] Clark

[821] See also chapter IV and Gunnar W.G. Karnell, 'The Berne Convention between authors rights and copyright economics - an international dilemma' [1995] International Review of Intellectual Property and Competition Law 193

person is the *original author* of the creative work whom will be granted protection under author's rights or copyright regime. This original author could as well have *authorship* over the work of their creation which means that they will receive human right level of protection on both their moral and material interest.

Secondly, the *publisher* and other persons who took part in presenting the work to the public but were not the authors themselves whom would possibly be protected under the concept of neighbouring rights ore related right. These persons may include performers, phonogram producers, broadcasters, film producers and publishers of graphic or electronic editions and other materials.[822] In case that the publishers are the business entities they will not be able to have *authorship* over the work of creation. Only they can gain ownership over copyright of the work of creation which will bring them the protection for their material interests.

Finally, the *public user* who are protected at a human right level by the right to freedom of expression and could possibly be allowed some use of protected work under the limitations and exceptions of copyright infringement. This person can also be a subsequent creator who contributes their originality and creativity to a derivative work and gain a new *authorship* over the subsequent work, which will be discussed further afterwards.

The roles and benefits of each party in the online digital environment will be discussed further in section II.A of this chapter which will profoundly clarify a strong relationship between these three parties in relation to their online activities (*uploading*, *downloading*, *streaming*, and *screen capturing* – see chapter I for definition of each activity) and the four major types of the

[822] Sterling pp77-84

online digital work of creation (*literary works, musical works, audiovisual works,* and *images*).

## C. THE ARRIVAL OF INTERNET TECHNOLOGY AND THE INTERMEDIARIES

In the analogue world there are three main parties who possessed specific rights and protections under copyright regime; authors, publishers and public users. However, after the emergence of internet technology there was another group of important parties who strongly involved in the copyright activity.

### C.1. Internet

The first proposed network link between computers had been successfully constructed in 1969 as ARPANET (Advanced Research Projects Agency Network). The interconnected network was basically designed for purpose of sharing resources, software and idea between different kinds and models of computers.[823] Since then the formation of connections between 'computational devices' has created a new way of communication between various kinds of digital devices which later been called as 'cyberspace'.[824] The term refers to the space where many computer devices are connected together in some way or another.[825]

### C.2. Internet Intermediaries and their Responsibility under Copyright Law

[823] Lelia Green, *The internet : an introduction to new media* (English edn, Berg 2010) pp20-22

[824] Bell p1, cited Sherry Turkle, 'Who Am We?' (*Wired*, January 1996) <http://archive.wired.com/wired/archive/4.01/turkle.html> accessed 14 July 2015

[825] Bell

Internet intermediaries are neither publishers nor creators and therefore possess no rights over the content published on the internet. Nevertheless, they are the intermediaries who play an important role on publication of digital content. According to the US Digital Millennium Copyright Act (DMCA) there are four main types of internet intermediaries: 1) mere transmission[826] 2) system caching[827] 3) storage[828] and 4) information location tools[829]. Also under the EC E-Commerce Directive, the type of internet intermediaries is divided into three main categories: 1) mere caching[830] 2) caching[831] and 3) hosting[832].

Each type of internet intermediaries held different degree of liability regarding the publications of contents which are considered copyright infringement. The general principle is that the service providers will not be liable unless they have knowledge of the publication of such alleged infringement. This is based on the concept of 'Not shooting the messenger'.

### C.3. Notice and Take Down Concept

The limitation of liability of the internet intermediaries lies in the concept of the take down notice. 'Take down notice' is the notice handed to the internet service providers by the copyright owner. The notice may state the details of the infringement and a request an act of the internet service

[826] DMCA 1998, section 512 (a)

[827] DMCA 1998, section 512 (b)

[828] DMCA 1998, section 512 (c)

[829] DMCA 1998, section 512 (d)

[830] EC E-Commerce Directive (Directive 2000/31/EC) article 12

[831] EC E-Commerce Directive (Directive 2000/31/EC) article 13

[832] EC E-Commerce Directive (Directive 2000/31/EC) article 14

providers to remove or block access to such infringing contents.[833] Under Section 512 (c) of the DMCA, the service providers will not be liable for copyright infringement if *'upon notification of claimed infringement … responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.'* Also under Article 14 (b) of the EC E-Commerce Directive provided that the service providers will not be liable if *'the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information'.*

The 'notice and take down' concept is a very effective tool that both original authors and publishers can exercise to prevent access and use of the protected online copyright works by unauthorised parties, apart from their other technological measures.[834] This appears, for example in the popular case of *Lenz v. Universal.*[835]

Internet intermediaries are the very important persons who could allow or not allow access to online digital contents. Nevertheless, since the internet intermediaries generally do not possess any right (*authorship* or *ownership*) over the artistic works or contents published on the internet (unless they held their position as author or publishers according to copyright law), therefore the detail analysis of the roles and rights of the internet intermediaries are out of the scope of this study.

[833] Sterling p670

[834] See the discussion about this in Part II of this chapter

[835] See also *Lenz v. Universal Music Corp.*, WL 271673 (N.D. Cal. Jan. 24, 2013)

## II. THE EXCLUSIVE RIGHTS

According to the previous discussion, there are three main parties involved in the copyright context and activities: the *author*, the *publisher* and the *public user*.

According to discussion in chapter II and III, the author, with a contribution of their genius and 'originality and creativity', will be eligible to hold *authorship* over a work of their creation. This *authorship* will administer the author with the universal characteristic of protection under the terms 'intellectual property right' and 'property right'.

For the publisher, they will not be eligible to hold *authorship* over a work of creation unless it is proven that they have contributed their 'originality and creativity' such as in case of the work made for hire. When 'originality and creativity' in a work could not be identified, the publisher could only have '*ownership*' over copyright in a work of creation.

In case of public user, it is identified in chapter II that they are guarded by the cultural characteristic of protection of the right to *freedom of expression.* Also these public users might be protected by the right to internet access if they are performing the online internet activities.

However, when looking particularly in the copyright area, regardless of whether such persons are the individual authors or the corporate entities, and regardless of whether they gain *authorship* or *ownership* over the copyrighted work, under copyright regime the individual authors and the corporate entities will enjoy at least one of these exclusive economic rights: 1) right of reproduction 2) right of distribution 3) right of display and 4) right of communication to the public as provided in Fig. 1 of this study. Also the right

of making adaptation or the right of making derivative work is another important right which is the main purpose of this thesis.

According to Fig. 2 of this study, in the online activity context, there is another right called 'the right of on-demand availability' which is internationally guaranteed under article 8 of the WIPO Copyright Treaty and article 10 and 14 of the WIPO Performances and Phonograms Treaty.

However, with regard to the right of display, since it focuses mainly on the act of showing copies which are 'material objects in which a work is fixed by any method'. Even though the right may include the act of 'indirect' showing of copies of copyrighted work such as *'the projection of an image on a screen or other surface by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus connected with any sort of information storage and retrieval system'*[836] the right may not be applicable to every type of copyrighted works appear online as discussed by Anthony Reese in his work. Furthermore, the right is not guaranteed in any regional or international instruments for purposes of online activity.

As for the right of distribution, according to Agreed Statements concerning Articles 6 and 7 the WIPO Copyright Treaty 1996, the Agreed statement concerning Articles 2(e), 8, 9, 12, and 13 of the WIPO Performances and Phonograms Treaty, and Recital 29 of the EC Information Society Directive 2001/29/EC, this right of distribution may not apply to the act of disseminating contents (literary, image, motion picture, music) all over the internet.

[836] 17 USC § 101

Therefore, in this section, the discussion will focus mainly on the two main rights involve dissemination of contents over the internet: 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand' which is part of the right of communication to the public.

Also, the contents disseminated online are limited to some type of copyrighted works that could be digitalised and stored in RAM. These works include literary works, musical works, audiovisual works and images.

Accordingly, the discussion in this section will focus mainly on the right of reproduction and the on-demand availability right of the *authors* and *publishers* in accordance with the four major types of copyrighted work: 1) literary works 2) musical works 3) audiovisual works and 4) images, which are frequently distributed online.

The right of online *public users* will also be analysed concurrently in order to find a balance or imbalance between the intellectual property and property right of individual authors and publishers (who either gain *authorship* or *ownership* over the copyrighted works), and the right to *freedom of expression* of public users.

## A. COPYRIGHT AND THE EXCLUSIVE RIGHTS OF AUTHORS AND PUBLISHERS, AND THE RIGHT OF PUBLIC USERS UNDER ONLINE ACTIVITY CONTEXT

### A.1. Literary Works

Literary works published online includes but not limited to news, comments, opinions, columns, journals, magazines, short stories, novels, etc. All of them may be published on a website or weblogs or in an e-book format

by mean of *uploading*. When these literary works are published o*r uploaded* online via these tools it is suggested that they meet the requirement of *originality* and *creativity* and *fixation*, and therefore are protected as *property* of either author or publishers.

**(i) Authors**

When authors have *intellectual property right*, *property right* and *authorship* over their *fixed* literary works due to the contribution of their *creativity*, they receive the exclusive economic rights over those literary works.

In the analogue world when the works are published in the form of paper the exclusive rights of authors may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public, which could frequently happen offline.

However, when focusing on the online activity in the digital environment, the exclusive rights of the author of the literary works which are made to be appeared online in a digital format by mean of *uploading* such as news, comments, opinions, columns, journals, magazines, short stories, novels, etc., are protected against some of the unauthorised acts that could be done online due to the common nature of digital works and the online activity environment. These include 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

On the other hand, the act of distribution and display of the digital works could be performed offline as well but it is out of the scope of this thesis.

### (ii) Publishers

In the offline world corporate entities or publishers have *property right* and *ownership*[837]over the *fixed* literary works subject to the laws[838] and contract[839]. The exclusive rights offered to the publishers of offline literary works may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public.

In the online environment the exclusive rights of the publishers of literary works which are made to be appeared online in a digital format by mean of *uploading* are limited as well to the two main acts which could be performed online. These are 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'. This is due to the common nature of digital works and online activity environment.

In order to prevent the unauthorised acts of reproduction and authorising the communication to the public 'on-demand', the publishers or corporate entities who own *property right* over literary works published online have come up with some measures. In case of Amazon, one of the biggest online bookstores, some restrictions have been provided in the Term of Use in the Agreement[840] between Amazon and its users of the Kindle Content[841]. First

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[837] See the discussion about *intellectual property right* of the corporate holders in chapter II and III

[838] In case of works made for hire as appear in 17 USC § 201 (b) and section 11 of the CDPA 1988

[839] See the sample of book publishing agreement at 'Book Publishing Agreement' <http://associationmediaandpublishing.org/Images/Interior/2011%20annual%20meeting%20handouts/sample%20book%20publishing%20agreement.pdf> accessed 3 July 2015 and 'Publishing Agreement' <http://www.maine.edu/pdf/PublishingAgreementStandard.pdf> accessed 3 July 2015

[840] 'Kindle Store Terms of Use' (*Amazon*, 6 September 2012) <http://www.writersservices.com/resources/writerpublisher-financial-relationship-inside-publishing> accessed 3 July 2015

of all it grants the users *'a non-exclusive right to view, use, and display such Kindle Content an unlimited number of times'*.[842] This is solely for the users' personal and non-commercial use. In addition Kindle Content is licensed, not sold, to the users by the Content Provider. The Kindle users *'may not sell, rent, lease, distribute, broadcast, sublicense, or otherwise assign any rights to the Kindle Content or any portion of it to any third party'*[843] and *'may not remove or modify any proprietary notices or labels on the Kindle Content.'*[844] Also the users *'may not bypass, modify, defeat, or circumvent security features that protect the Kindle Content.'*[845]

**(iii) Users**

In the analogue world where the literary works which contain *originality and creativity* of authors are *fixed* in tangible media, the users may purchase those media in which the works are stored within. After that the users receive *property right* over that tangible medium but not over the literary works contained within. The users are therefore barred from those unauthorised acts which may occur after purchasing of such medium and literary works. These include the act of unauthorised 1) reproduction 2) distribution 3) display and 4) communication to the public of the literary work through any kind of medium.

In the digital environment, literary works are made to be appeared online in digital formats; therefore there is no *property right* for users over

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[841] "Kindle Content" means digitized electronic content obtained through the Kindle Store, such as books, newspapers, magazines, journals, blogs, RSS feeds, games, and other static and interactive electronic content. Ibid

[842] Ibid

[843] Ibid

[844] Ibid

[845] Ibid

any tangible medium. In this environment, the users of online literary works are barred from unauthorised 1) reproduction and 2) authorising the communication to the public 'on-demand' of such digital literary works. These acts are limited to online activity only due to the common nature of the work and the aspect of online activities environment. Although, the users of online literary work are still prohibited from unauthorised distribution and display of online literary work to the offline world.

For example, in case of Amazon Kindle, the Kindle Content is licensed, not sold, by the Content Provider to the users. Furthermore, the Kindle Content is protected with DRM[846] encryption therefore the users of Kindle Content are allowed only to view, use, and display such Kindle Content. They are forbidden from selling, renting, leasing, distributing, broadcasting, sublicensing, and are prohibited from bypassing, modifying, defeating, or circumventing security features that protect the Kindle Content.

Since these literary works are stored not in a tangible medium but in a digital format, these digital data of literary works would not be transferred to the third party via the tangible materials but through RAM[847]. The users therefore have no *property right* over any tangible material that contains the work. Every time of viewing Kindle Content as allowed under the Agreement, the users are only making reproduction of such digital contents which are licensed by the Content Provider. Users can also making copies of the licensed

[846] Digital Rights Management – The digital means of 1) Controlling access to and copying of reproduction, and 2) administering information relating to the exercise of rights. Sterling p202

[847] See discussion about RAM in chapter I

work on the supportive programs and media.[848] Again, this all has been done under the DRM restriction.

As for literary works appear not on e-readers but on websites, it is much more difficult to prevent unauthorised reproduction. Normally when *browsing* a website the users are making temporary reproduction of the literary works in RAM. This act is permissible under copyright law for technological purposes.[849] However, in practical it is likely that the users may also, at any time, copy those literary works into their hard disks or to publish on other sites or documents. This is not permissible under copyright law since the right of reproduction and authorising the communication to the public 'on-demand' belong only to the authors or publishers, as discussed earlier. In this case there are many ways that authors and publishers can use to prevent such acts of copying, such as to disable Right-Click or using HTML Protection Software.[850]

However, it is important to note that the users of literary work, either published on e-book readers or websites are also protected by the *right to freedom of expression.* Under *the argument from democracy*, the individual users are protected against the restriction of government for purposes of supporting the function of democratic system. This means that under *the argument from democracy* and the *right to freedom of expression* the users are guaranteed a right to communicate their '*ideas, information and artistic sentiment through means that are either linguistic, pictorial, or traditional*

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[848] 'Sync Across Fire & Kindle Devices and Apps' (*Amazon*) <http://www.amazon.com/gp/help/customer/display.html?nodeId=200911660> accessed 3 July 2015

[849] See discussion about RAM in chapter I

[850] Howard Richman, 'How to Protect Your Digital Content from Being Stolen' (*Stop Web Pirates - Online Copyright Infringement Solutions*) <http://www.stopwebpirates.com/articles/protect-website-content> accessed 3 July 2015

*artistic'* freely.[851] In this aspect, users may be protected at a higher level than the publishers.[852]

After all, *copyright* of authors and publishers and the *right to freedom of expression* of public users are conflicted as discussed earlier in chapter II.

### A.2. Musical Works

Musical works published online are fixed in various types of audio formats. One example is the popular .MP3 file. This type of format removes unnecessary elements of a recording that a human ear cannot detect and allows a good quality of compression of digital audio data. The audio files stored in this format are widely used on websites and internet communications.[853] They are delivered online either by way of *streaming* or *downloading* via *file sharing* technology.[854]

#### (i) Authors

In the analogue world, the authors have *intellectual property right*, *property right* and *authorship* over their *fixed* musical works due to the contribution of their *creativity.* Therefore they receive the exclusive economic rights over these works. The Berne Convention, the TRIPs agreement and the US copyright law[855] do not provide the definition of the author of the musical works. The UK Copyright, Designs and Patents Act 1988, however, specifies that the author of the musical work (not a sound recording) is *'the person by whom the arrangements necessary for the creation of the work are*

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[851] Schauer p91

[852] See discussion about 'Freedom of Expression' in chapter II

[853] David Bell, *Cyberculture : The Key Concepts* (Routledge 2004) p134

[854] See discussion about streaming, downloading and file sharing in chapter I

[855] 17 USC § 201 (a) *'Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.'*

*undertaken.'*[856] Therefore, generally the authors of a musical work could possibly be the composer and the lyricist, if there are lyrics.

In the old time when the musical works are published *(fixed)* in the form of paper, the interpretation of copyright protection on 'books' in the Copyright Act of 1790 was extended to also cover sheet music. In 1831 the US Congress amended the copyright act to include printed music composition under separate protection. This protection, however, intended to protect music which is *fixed* only on the print media. In 1897 the Copyright Act was amended again to grant 'the performance right' to the right holders of the musical works *fixed* on the print media. However, it is still very difficult to enforce such right even in the offline world due to the various types and venues of public performance.[857]

In 1908, in the case of *White-Smith v. Apollo*[858] the Supreme Court of the United States ruled that the manufacturers of music rolls which could be used in connection with piano players and player pianos did not have to pay royalties to the composers. This is because the piano rolls are parts of the machine and therefore they are not copyrightable. According to the opinion of the court *'[t]he manufacture of such instruments and the use of such musical rolls has developed rapidly in recent years in this country and abroad. The record discloses that in the year 1902 from seventy to seventy-five thousand of such instruments were in use in the United States, and that from one*

[856] CDPA 1988, section 9(3)

[857] Joanna Teresa Demers, *Steal This Music : How Intellectual Property Law Affects Musical Creativity* (University of Georgia Press ; [London : Eurospan, distributor] 2006) p19

[858] *White-Smith Publishing Co. v. Apollo Co.*

*million to one million and a half of such perforated musical rolls, to be more fully described hereafter, were made in this country in that year."*[859]

According to Demers[860] piano rolls is the first medium that allows reproduction of music via machine. It is the ancestor of vinyl record and compact disc in which the music could be *fixed* or recorded alternatively apart from sheet music. At the time when piano rolls were invented the law did not protect music authors and right holders against unauthorised public performance via machines. They are only guarded against unauthorised public performance by human. It is in the 1909 Copyright Act that Congress allowed authors and copyright holders the royalty fees for recordings of musical work, reprints, and live performances.

Hence, in the analogue world the exclusive rights of authors may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public of those musical works *fixed* in those tangible media, which could normally be performed offline.

In the internet environment, musical works are stored not in a tangible medium as sheet music or vinyl but in the digital formats that could be disseminated online by means of *streaming* or *downloading* through *file sharing* technology. Current popular music *streaming* and *downloading* services are, for example, Spotify[861], Soundcloud[862] and iTune[863]. In either service, generally there are two types of musical work published online. First

[859] Ibid at 9

[860] Demers p20

[861] 'Spotify' (*Spotify*) <https://www.spotify.com/int/why-not-available/> accessed 3 July 2015

[862] 'Soundcloud, Creators of Music and Audio' (*Soundcloud*) <https://soundcloud.com/> accessed 3 July 2015

[863] 'Apple' (*Apple Itunes*) <https://www.apple.com/itunes/> accessed 3 July 2015

of all, there are music composition recorded by companies and are later published online for commercial purposes. This would be called a 'sound recording'. Secondly, some musical works may be created by individual composers and lyricists and then are self-published online, either for commercial or personal purposes, without being recorded with the companies beforehand. And when the files are published, in both cases it is very difficult to identify the real 'original author' of the work after publication.

When focusing on the online activity environment, due to the common nature of the digital works, therefore, the exclusive rights of the original authors of the musical works published online are protected against some of the unauthorised acts that could be performed online. These include 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

**(ii) Publishers**

Music publisher is *'any individual, partnership, association or corporation … engaged in the business of publishing musical works in printed or other form.'*[864] In the offline world musical works could be *fixed* either on papers as sheet music, or cassette, vinyl or compact disc (also known as *'phonogram'*[865], *'phonorecord'*[866] or *'sound recording'*[867]). The corporate

[864] According to the information provided for the membership of the US Music Publishers Association at 'Membership' (*Music Publisher Association Of The United States (MPA)*) <http://www.mpa.org/content/membership> accessed 3 July 2015. In the UK, although the individual membership are not accepted to the Music Publishers Association, the role of the music publisher has been specified here at 'Music Publishing' (*Music Publishers Association*) <http://www.mpaonline.org.uk/music_publishing> accessed 3 July 2015

[865] WPPT 1996, article 2(b) '*"phonogram" means the fixation of the sounds of a performance or of other sounds, or of a representation of sounds, other than in the form of a fixation incorporated in a cinematographic or other audiovisual work*'

[866] 17 USC § 101 '*"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.'*

entities or publishers could have *property right* and *ownership*[868]over these *fixed* musical works subject to the laws[869] and contract[870]. Also, Article 14.2 of TRIPs agreement provided that *'Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.*[871] Therefore, the exclusive rights of the publishers of offline musical works may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public.

In the online environment, most of the music might be *fixed* in tangible medium before published online in digital formats. The corporate entities that are the publishers of these musical works may publish these works online for sale so that customers can buy and *download* the files. Or they may allow customers to listen to those songs on demand via *streaming* technology.

The exclusive rights of the publishers of musical works which are made to be appeared online in a digital format are therefore limited to the two main acts which could be performed online due to the common nature of digital works and online activity environment. These include 1) the right of

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[867] CDPA 1988, section 5a(1) *'In this Part "sound recording" means—(a) a recording of sounds, from which the sounds may be reproduced, or (b) a recording of the whole or any part of a literary, dramatic or musical work, from which sounds reproducing the work or part may be produced, regardless of the medium on which the recording is made or the method by which the sounds are reproduced or produced.'*

[868] See the discussion about *intellectual property right* of the corporate holders in chapter II and III

[869] In case of works made for hire as appear in 17 USC § 201 (b) and section 11 of the CDPA 1988

[870] See the sample of music publishing agreement at *'Publishing Agreement'* (Music Publishers Association) <http://www.vocalist.org.uk/publishing_agreement.html> accessed 3 July 2015

[871] TRIPs 1995, article 14 .2 *'Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.'*

reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

Music files published online by music publishers may be protected by DRM in order to prevent those unauthorised acts. For example, the digital files of music sold for download on iTunes Store were previously protected by FairPlay, the digital rights management (DRM) technology created by Apple Inc.[872] However, on February 6, 2007 Steve Jobs, the CEO of Apple Inc. at that time, has published an open letter entitled '*Thoughts on Music*'[873] calling for music with DRM-free. After all, in January 6, 2009, Apple Inc. announced that from now on all songs will be sold on iTunes Store with Apple's DRM-free iTunes Plus format.[874] Nevertheless, the Apple's DRM-free iTunes Plus format does not cover other types of works such as e-books, movies, TV shows, audiobooks and apps. These contents sold on iTunes still continue to be protected by DRM.

Apart from *downloading*, *streaming* is another internet technology that is applicable to music. For example, Spotify is the platform that uses on-demand *streaming* music technology[875] to allow its customers to listen to music either online or offline (if the customers paid for 'Premium' subscription[876]). The music offered on Spotify is DRM-protected. The users

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[872] See also 'Fairplay DRM Media and How to Bypass Fairplay DRM' *(DRM Remove)*<http://www.remove-drm.com/topics/fairplay-drm-removal.html> accessed 3 July 2015

[873] 'Thoughts on Music' (*Apple*) <http://www.apple.com/kr/hotnews/thoughtsonmusic/> accessed 3 July 2015

[874] 'Apple Press Info - Changes Coming to the iTunes Store' (*Apple*) <http://www.apple.com/pr/library/2009/01/06Changes-Coming-to-the-iTunes-Store.html > accessed 3 July 2015

[875] Fredrik Niemelä Gunnar Kreitz, 'Spotify – Large Scale, Low Latency, P2P Music-on-Demand Streaming' (The 10th IEEE International Conference on Peer-to-Peer Computing (IEEE P2P'10) from August 25-27, 2010 in Delft, the Netherlands)

[876] 'Spotify - Premium' (*Spotify*) <https://www.spotify.com/us/#premium> accessed 9 July 2015

who register to use Spotify Service [877] are forbidden from *'copying, reproducing, "ripping", recording, or making available to the public any part of the Spotify Services or content', 'reverse-engineering, decompiling, disassembling, modification or creating derivative works based on the Spotify Services'* or *'circumventing any technology used by Spotify, its licensors, or any third party to protect content accessible through the Service.'*[878]

**(iii) Users**

In the analogue world where the musical works which contain *originality and creativity* of authors are *fixed* in tangible media such as papers, vinyl records, cassettes, and compact discs, the users may purchase those media in which the works are stored within. The users then receive *property right* over tangible media but not over the musical works themselves. Therefore the users are barred from unauthorised acts which may occur after purchasing of such media that contain musical works. These include the act of unauthorised 1) reproduction 2) distribution 3) display and 4) communication to the public of musical work through any kind of medium.

In the digital environment, musical works are made to be available online in digital formats; therefore there is no *property right* for users over any tangible medium. In this environment, the users of online musical works are barred from unauthorised 1) reproduction and 2) authorising the communication to the public 'on-demand' of such digital musical works. These acts are limited to online activity only due to the common nature of the work

[877] **3.1 Subscriptions** Spotify account holders may access the Spotify Service by any of our several Subscriptions: **Free Service**: an ad-based, free-of-charge service; **Unlimited Service**: a subscription fee-based service**; Premium Service**: an ad-free, subscription fee-based service which enables you to listen to music while not connected to the internet, among other features; or **Mobile Service**: via a supported mobile handset. 'Spotify Terms and Conditions of Use' (*Spotify*) <https://www.spotify.com/us/legal/end-user-agreement/> accessed 3 July 2015

[878] **8. User Guidelines** ibid

and the aspect of online activities environment. Nevertheless, the users of online musical work are still prohibited from unauthorised distribution and display of such online work to the offline world.

For example, in case of iTunes Store, the music available for purchasing on iTunes Plus (although without DRM protection) is licensed, not sold, to the users.[879] Under Apple's Terms and Conditions, users who purchase music (or iTunes Plus Products that are not protected by DRM) from iTunes Store are allowed only to copy, store, and burn iTunes Plus Products as reasonably necessary for personal and non-commercial use.[880]

Technically, the users who purchase music from iTunes will be able to share their purchased music online. However, since in the digital environment these musical works are stored not in a tangible medium but in a digital format, there will be no *property right* for the users over any tangible material that contains the work. Also the users who purchase that musical work do not 'own' the music itself. The digital data of these works, however, would be transferred online to the third party not via the tangible materials but through RAM[881]. This is also referred as making 'reproduction' of musical work.[882]

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[879] This is because Apple do not own any of the music offered for users to purchase on iTunes Store. Those music files belong to the music publishers and were licensed to Apple through agreement. See. *F.B.T. Productions, LLC, et al. v. Aftermath Records, et al.* 621 F.3d 958 (2010*)* The Court of Appeals, 9th Circuit held that *'Aftermath did not dispute that it entered into agreements that permitted iTunes, cellular phone carriers, and other third parties to use its sound recordings to produce and sell permanent downloads and mastertones. Those agreements therefore qualify as licenses under Aftermath's own proposed construction of the term. … Aftermath did not "sell" anything to the download distributors. The download distributors did not obtain title to the digital files. The ownership of those files remained with Aftermath, Aftermath reserved the right to regain possession of the files at any time, and Aftermath obtained recurring benefits in the form of payments based on the volume of downloads.'*

[880] Usage Rules (vi) 'Legal - Terms And Conditions' (*Apple*) <http://www.apple.com/legal/internet-services/itunes/us/terms.html> accessed 3 July 2015

[881] See discussion about RAM in chapter I

[882] See also *Capitol Records, LLC v. ReDigi Inc.* (2013) 934 F.Supp.2d 640 The US Southern District of New York held that *'It is simply impossible that the same "material object" can be transferred over the Internet. Thus, logically, the court in London-Sire noted that the Internet transfer of a file results in a material object being "created elsewhere at its finish." Id. at 173.*

As for musical works appear online for on-demand *streaming* such as Spotify, it is much more difficult for the users to make an unauthorised reproduction. Normally when musical files are digitally *steaming* they are temporarily reproduced in RAM, which is permissible under copyright law for technological purposes.[883] The users who pay for this kind of service (Spotify Service) will be granted a *'limited, non-exclusive, revocable licence to make personal, non-commercial … use of the Spotify Service and to receive the media content made available through the Spotify Service'*[884] based on the subscriptions or trials that the users have selected.[885] The licence will be effective for a period of twenty years unless terminated by the users or Spotify.[886] Most importantly *'The Spotify Service and the content provided through it are the property of Spotify or Spotify's licensors.'*[887] Therefore the users do not own any parts of the digital music *streaming* on Spotify Service.

Even though the music is not available for *download* but is *steaming* on-demand, in practical it is likely that the users may also, at any time, try to copy or download these musical works into their hard disks or to publish on other sites using any applicable software[888]. In 2009 Spotify once allowed

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*Because the reproduction right is necessarily implicated when a copyrighted work is embodied in a new material object, and because digital music files must be embodied in a new material object following their transfer over the Internet, the Court determines that the embodiment of a digital music file on a new hard disk is a reproduction within the meaning of the Copyright Act.'* Therefore the Court found that *'absent the existence of an affirmative defense, the sale of digital music files on ReDigi's website infringes Capitol's exclusive right of reproduction.'*

[883] See discussion about RAM in chapter I

[884] 4. Licence and assignment , 'Spotify Terms and Conditions of Use'

[885] Ibid at 3.1 Subscriptions and 3.3 Trials

[886] Ibid at 4.Licence and assignment

[887] Ibid at 4.Licence and assignment

[888] See, for example, Videoorchard, 'Download Music from Spotify for Free ' *(Youtube, 8 August 2014)* <https://www.youtube.com/watch?v=kFMMMURpNI8> accessed 9 July 2015, Mario Aguilar, 'You Can Download Any Spotify Song as an MP3 With This Chrome Extension' (*Gizmodo*, 5 July 2013) <http://gizmodo.com/you-can-download-any-spotify-song-as-an-mp3-with-this-c-

users to download the songs legitimately through their service[889] but this feature was later removed.[890] Therefore, until now, technically users will only be able to listen to music on Spotify via *streaming* technology but not be able to *download* music unless they try to circumvent that technology by using some other available software. This is not permissible under copyright law since the right of reproduction belong only to the authors or publishers, as discussed earlier.

However, it is important to note that the users of musical works, either published online for *downloading* or *streaming* are also protected by the *right to freedom of expression.* Under *the argument from democracy*, the individual users are protected against the restriction of government for purposes of supporting the function of democratic system. This means that individual users are guaranteed a right to communicate their '*ideas, information and artistic sentiment through means that are either linguistic, pictorial, or traditional artistic'* freely.[891] It is also noteworthy that, in this aspect users may be guaranteed a higher level of protection than the publishers.[892]

Also, *copyright* of authors and publishers and the *right to freedom of expression* of public users are conflicted as analysed earlier in chapter II.

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494493386> accessed 9 July 2015 or 'How to Download Music From Spotify' *(Spotify)*<http://spotifydownloader.net/> accessed 9 July 2015

[889] 'Expanded "Buy From" feature and a Spanish translation' (*Spotify*) <https://news.spotify.com/us/2009/03/31/expanded-buy-from-feature-and-a-spanish-translation/> accessed 3 July 2015

[890] 'Download Store' (*Spotify*) <https://support.spotify.com/uk/learn-more/faq/#!/article/Download-store/?in=search> accessed 3 July 2015 and 'Spotify stopped selling download credits' (*Spotify*) <https://community.spotify.com/t5/Help-Accounts-and-Subscriptions/Spotify-stopped-selling-download-credits/td-p/230812> accessed 3 July 2015

[891] Schauer p91

[892] See discussion about 'Freedom of Expression' in chapter II

### A.3. Audiovisual Works

Audiovisual works published online includes but not limited to movies, TV shows, music videos, and video games[893] etc., which are the works that consist of moving images either with or without sound.[894] These works are published online in various types of digital formats such as .mov, .flv, .avi, and .wmv. The audiovisual files stored in these formats are widely used on popular websites and internet communications such as YouTube [895] or 4shared [896] for purpose of *streaming* or *downloading* via *file sharing* technology.[897]

#### (i) Authors

In the analogue world, the authors have *intellectual property right*, *property right* and *authorship* over their *fixed* audiovisual works due to the contribution of their *creativity* and later receive the exclusive economic rights over these works. The Berne Convention, TRIPs agreement and agreement and the US copyright law[898]do not provide the definition of the author of the audiovisual works. Only Article 14bis (1) of the Berne Convention provides

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[893] According to WIPO, video games contain at least two main parts that are protectable under Article 2 of the Berne Convention: audiovisual elements and software 'Video Game' (*Wipo*) <http://www.wipo.int/copyright/en/activities/video_games.html> accessed 9 July 2015, see also Laura López Andy Ramos, Anxo Rodríguez, Tim Meng and Stan Abrams, *The Legal Status of Video Games: Comparative Analysis in National Approaches* (WIPO, 2013)

[894] Directive 2010/13/EU (Audiovisual Media Services Directive (AVMSD)) *'(23) For the purposes of this Directive, the term 'audiovisual' should refer to moving images with or without sound, thus including silent films but not covering audio transmission or radio services.'* And 17 U.S. Code § 101 *'"Audiovisual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines, or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.'*

[895] 'Supported YouTube File Formats' (*Youtube*) <https://support.google.com/youtube/troubleshooter/2888402?hl=en> accessed 3 July 2015

[896] 'Make Your Video Popular At 4shared' (*4SHARED*) <http://blog.4shared.com/make-your-video-popular-at-4shared/> accessed 3 July 2015

[897] See discussion about streaming, downloading and file sharing in chapter I

[898] 17 USC § 201 (a) *'Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.'*

that *'The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work'.*[899]

Nevertheless, the EC Rental and Lending Rights Directive specifies that *'the principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors.'* whereas others will be considered as its co-authors.[900] The UK Copyright, Designs and Patents Act 1988 also provides that the author of the film is the producer and the principal director.[901] Therefore, generally the author of a film could either be the producer or the principal director.

In the analogue world the audiovisual works such as movies and TV shows will be *fixed* in tangible media (film, video tape recorder (VTR), Videocassette recorder (VCR), Video CD (VCD), digital video disc (DVD) and Blu-ray Disc (BD)) and later displayed to public by means of screening. After that they will be sent to distributor in order to find a release date for home or theatre viewing. In this matter the exclusive rights of authors may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public of those audiovisual works *fixed* in tangible media, which are normally happened offline.

However, when focusing on the online activity in the digital environment where digital technology allows any individual or company to 'record' a video (in other words, to create an audiovisual work) and 'disseminate' such work on the internet by means of *streaming* or *downloading* through *file sharing* technology (without having previously *fixed* in any tangible medium but RAM), the exclusive rights of the author of the

[899] Berne 1971, article 14bis (1)

[900] Directive 92/100/EEC, article 2.2

[901] CDPA 1988, Section 9(2)(ab)

audiovisual works which are made to be appeared online in a digital format are protected against some of the unauthorised acts that could be performed online due to the common nature of digital works and the online activity environment. These include 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

Current popular music *streaming* and *downloading* services are such as YouTube[902] and 4shared[903]. In either service, generally there are two types of published audiovisual works. First of all, there are works created by companies and are later published online for commercial purposes. Secondly, some audiovisual works may be created by individual and then are self-published online, either for commercial or personal purposes, without being recorded with the companies beforehand. However, when these works are to be found online, in both cases it is very difficult to identify the real 'original author' of the work after publication.

On the other hand, it is also noteworthy that the act of distribution and display of the digital works could be performed offline as well but it is out of the scope of this thesis.

**(ii) Publishers**

In case of audiovisual works which are works that originated from contributions of creativity, technique, and organization before they will be *fixed* and published to the public, the legal protection will be given mainly to the real contributors, which, on the other hands, could hardly been

[902] 'Youtube - Streaming And Downloading Services ' (*Youtube*) <https://www.youtube.com/> accessed 3 July 2015

[903] '4shared - Streaming And Downloading Services' (*4SHARED*) <http://www.4shared.com/> accessed 3 July 2015

distinguished. For this purpose, the creative contributions of audiovisual works will be given 'author's right' protection which is similar to the protection granted to other categories of literary and artistic works, whereas 'related right' will be given for technical and organizational contributions.[904]

Generally 'publishers' may refer to '*persons who present creative works to the public, but are not regarded as creators in their own right.*'[905]In that meaning, in case of audiovisual works it may involve the 'film distributor' as '*the legal entity, a person or a corporation, that has the right to generate revenue from the copyright by releasing the film to the public or licensing the rights to subDistributors who will release to the public in their defined territory, language and medium.*'[906] For this purpose, 'film distributors' will be licensed the rights to distribute or to present the film to their audiences. Such rights will be granted through The Distribution Agreement which is a rights transaction which is part of the Chain of Title documentation.[907] The persons who could grant those rights to the distributors are the person who own copyright in the film. This could either be the principal director and other creative distributors who are protected by 'author's right' (creative contributions)[908], or the film producers who are protected by 'related right'

[904] Sterling p304

[905] Ibid p77

[906] Rob H. Aft, *From Script to Screen : The Importance of Copyright in The Distribution of Films*, vol 6 of Creative Industries (WIPO Publication 2011) , p13

[907] Ibid p23

[908] Sterling p311

(technical and organizational contributions)[909] which usually are companies or business institutions.[910]

Therefore, in the analogue world, the exclusive rights of the publishers or distributors of audiovisual works may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public.

However, in the online environment, most of the music might be *fixed* in tangible medium such as film, video tape recorder (VTR), Videocassette recorder (VCR), Video CD (VCD),digital video disc (DVD) and Blu-ray Disc (BD) before published online in digital formats such as .mov, .flv, .avi, and .wmv. The corporate entities that are the distributors of these audiovisual works may publish these works online for sale so that customers can buy and *download* the files.[911] Or they may allow customers to watch the films on demand via *streaming* technology.[912] These files published on the internet are DRM-protected.

As for *live streaming* the broadcasters who own copyright in those audiovisual works and other items transmitted on television broadcasts also have copyright over such audiovisual works and other items retransmitted (by

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[909] Ibid p311

[910] See sample of required agreement for film distribution in Rob H. Aft, *From Script to Screen : The Importance of Copyright in The Distribution of Films*, vol 6 of Creative Industries (WIPO Publication 2011), pp 58-85

[911] See. 'Frequently Asked Questions (FAQ) For Purchased Movies' (*Apple*) <https://support.apple.com/en-us/HT204370 > accessed 3 July 2015

[912] 'Youtube - Films' (*Youtube*) <http://www.youtube.com/movies > accessed 3 July 2015 and 'Youtube Help : Purchase process' (*Youtube*) <https://support.google.com/youtube/answer/1231720?hl=en> accessed 3 July 2015

themselves or another organisation) via an internet stream to the internet subscribers.[913]

The exclusive rights of the publishers of audiovisual works which are made to be appeared online in a digital format are therefore limited to the two main acts which could be performed online due to the common nature of digital works and online activity environment. These include 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

In addition, audiovisual files published on the internet by film distributors may be protected by DRM in order to prevent these unauthorised acts. For example, the digital files of movies sold for *download* on iTunes Store are protected by FairPlay, the digital rights management (DRM) technology created by Apple Inc.[914] Even though Apple Inc. announced that from January 6, 2009, all songs sold on iTunes Store will be free from Apple's DRM protection,[915] the Apple's DRM-free format does not cover other types of works such as e-books, movies, TV shows, audiobooks and apps. Therefore the movies and TV-shows sold on iTunes still continue to be protected by DRM.

Apart from *downloading*, *streaming* is another internet technology that is applicable to audiovisual works. For example, YouTube is the platform that allows its customers to watch movies and TV-shows on their computers

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[913] See '*ITV Broadcasting Ltd v TVCatchup Ltd'* (C-607/11) [2013] Bus. L.R. 1020 (ECJ (4th Chamber))

[914] See also 'Fairplay DRM Media and How to Bypass Fairplay DRM' (*DAM Remove*) <http://www.remove-drm.com/topics/fairplay-drm-removal.html> accessed 3 July 2015

[915], 'Apple Press Info - Changes Coming to the iTunes Store'

and devices via on-demand *streaming* technology after some payment.[916] Movies offered for *streaming* on YouTube are also DRM-protected. On January 27, 2015 Richard Leider, Engineering Manager at YouTube wrote a blog announced that the service will now default to HTML5 video. This new technology uses Encrypted Media Extensions and Common Encryption to allow playback of those DRM-protected contents on web browsers.[917]

**(iii) Users**

In the analogue world where the audiovisual works which contain *originality and creativity* of authors are *fixed* in tangible media such as film, video tape recorder (VTR), Videocassette recorder (VCR), Video CD (VCD),digital video disc (DVD) and Blu-ray Disc (BD), the users may purchase those media in which the works are stored within and later enjoy the work by means of screening. The users then receive *property right* over tangible media that contain audiovisual works but not over the audiovisual works themselves. Therefore the users are barred from unauthorised acts which may occur after purchasing of such media. These include the act of unauthorised 1) reproduction 2) distribution 3) display and 4) communication to the public of audiovisual work through any kind of medium.

In the digital environment, audiovisual works are made to be available online in digital formats (for *downloading* or *streaming*); therefore

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[916] 'Youtube - Watching movies and TV shows in HD' (*Youtube*) <https://support.google.com/youtube/answer/3306741?hl=en&ref_topic=1316015> accessed 3 July 2015 and 'Youtube -Watching movies and TV shows on devices' (*Youtube*) <https://support.google.com/youtube/topic/3243994?hl=en&ref_topic=1316015> accessed 3 July 2015

[917] 'Youtube - YouTube now defaults to HTML5 <video>' (*Youtube*) <http://youtube-eng.blogspot.com/2015/01/youtube-now-defaults-to-html5_27.html > accessed 3 July 2015 See also. Glyn Moody, 'Encrypted Media Extensions' *(W3C Working Draft, 15 March 2015)*<http://www.w3.org/TR/encrypted-media/> accessed 3 July 2015 and 'DRM In HTML5: What Is Tim Berners-Lee Thinking?' *(Techdirt, 16 October)* <https://www.techdirt.com/articles/20131016/06583824895/drm-html5-what-is-tim-berners-lee-thinking.shtml>accessed 3 July 2015

there is no *property right* for users over any tangible medium. In this environment, the users of online audiovisual works are barred from unauthorised 1) reproduction and 2) authorising the communication to the public 'on-demand' of such audiovisual works. These acts are limited to online activity only due to the common nature of the work and the aspect of online activities environment. Nevertheless, the users of online audiovisual works are still prohibited from unauthorised distribution and display of such online work to the offline world.

For example, in case of Vine[918], the video sharing service that allows users to record and edit five to six-second-long looping video clips. Under Vine's Terms and Conditions, users who submit, post or display content on or through Vine *'grant [Vine] a worldwide, non-exclusive, royalty-free license (with the right to sublicense) to use, copy, reproduce, process, adapt, modify, publish, transmit, display and distribute such Content in any and all media or distribution methods (now known or later developed)'*.[919]

The case is, the users of Vine services may record some copyright protected contents such as the instant goals in the Premier League, then upload and share their recorded videos online.[920] This is against the rights of the copyright owner, since the users who upload those videos do not 'own' copyright in these audiovisual works themselves. When uploaded, nevertheless, the digital data of these works could be easily transferred online to the third party not via the tangible materials but through RAM[921]. This is

[918] 'Vine Website' (*VINE*) <https://vine.co/ > accessed 3 July 2015

[919] 'Vine - Terms Of Service' (*VINE*) <https://vine.co/terms > accessed 3 July 2015

[920] Mark Tran, 'Premier League warns fans not to post Vine videos of goals online' (*The Guardian*, 15 August 2015) <http://www.theguardian.com/media/2014/aug/15/premier-league-warns-fans-vine-videos-goals> accessed 3 July 2015

[921] See discussion about RAM in chapter I

also referred as making 'reproduction'[922] and 'authorising the communication to the public 'on-demand'' of the audiovisual works.

In many cases when the audiovisual works are not available for *download* but are *steaming* on-demand, in practical it is likely that the users may also, at any time, try to copy or download these audiovisual works into their hard disks or to publish on other sites using any applicable software.[923] This is not permissible under copyright law since the right of reproduction belong only to the authors or publishers, as discussed earlier.

However, it is important to note that the users of audiovisual works, either published online for *downloading* or *streaming* are also protected by the *right to freedom of expression.* Under *the argument from democracy*, the individual users are protected against the restriction of government for purposes of supporting the function of democratic system. This means that individual users are guaranteed a right to communicate their '*ideas, information and artistic sentiment through means that are either linguistic, pictorial, or traditional artistic'* freely.[924] It is also noteworthy that, in this aspect users may be guaranteed a higher level of protection than the publishers.[925]

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[922] See also. *'Capitol Records, LLC v. ReDigi Inc.'* (2013) 934 F.Supp.2d 640 The US Southern District of New York held that *'It is simply impossible that the same "material object" can be transferred over the Internet. Thus, logically, the court in London-Sire noted that the Internet transfer of a file results in a material object being "created elsewhere at its finish." Id. at 173. Because the reproduction right is necessarily implicated when a copyrighted work is embodied in a new material object, and because digital music files must be embodied in a new material object following their transfer over the Internet, the Court determines that the embodiment of a digital music file on a new hard disk is a reproduction within the meaning of the Copyright Act.'* Therefore the Court found that *'absent the existence of an affirmative defense, the sale of digital music files on ReDigi's website infringes Capitol's exclusive right of reproduction.'*

[923] See for example 'full free video drm remove (46 programs)' *(Softonic)*<http://en.softonic.com/s/full-free-video-drm-remove> accessed 3 July 2015

[924] Schauer p91

[925] See discussion about 'Freedom of Expression' in chapter II

Also, *copyright* of authors and publishers and the *right to freedom of expression* of public users are conflicted as analysed earlier in chapter II.

### A.4. Images

Images published online may appear solely or as parts of various contents such as in news, comments, columns, journals, magazines, short stories, novels, etc. Some of them may be published on websites, weblogs or may be included as parts of many e-book contents. There are also free platforms particularly for image publications, either on mobile applications or websites, such as Instagram [926] and Flickr [927] . Some sites such as Shutterstock[928] allow publication of images for sale. When these images are published online via these tools it is suggested that they meet the requirement of *originality* and *creativity* and *fixation*, and therefore are protected as *property* of either author or publishers.

#### (i) Authors

The authors of images published either online or offline will have *intellectual property right*, *property right* and *authorship* over their *fixed* images due to the contribution of their *creativity*. Therefore they receive the exclusive economic rights over those images.

For purposes of this thesis the word 'images' is used in a broader sense to include any two-dimensional works such as maps, graphs, pie charts, or paintings. In the analogue world where images are published or *fixed* in the form of paper or on other tangible materials such as woods or textiles, the

[926] 'Instagram - Image Publications' (*Instagram*) <https://instagram.com/> accessed 3 July 2015

[927] Flickr, 'The home for all your photos.'

[928] 'Shutterstock - Stock Photos, Vectors, Videos, and Music Tracks' (*Shutterstock* ) <http://www.shutterstock.com/> accessed 3 July 2015

exclusive rights of authors who contribute their *originality* and *creativity*[929] to such images may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public of those works, which could frequently be performed offline.

However, when focusing on the online activity in the digital environment, the exclusive rights of the author of the images which are made to be appeared online in a digital format such as .jpg, .png, .tiff, .gif, .bmp, .pdf, etc. are protected against some of the unauthorised acts that could be done online due to the common nature of digital works and the online activity environment. These include 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'.

The act of unauthorised distribution and display of 'digital images' to the public, which could be performed offline, is forbidden as well but it is out of the scope of this thesis.

In the digital environment, the invention of *digital camera* and *screenshot*[930] or *screen capture* technology allows the two-dimensional works to be published and transferred online very easily (*screen capturing* – as provided earlier in chapter I). When images are published online in either format, it is very easy for online internet user to *download* images just by right-clicking on the photos and selecting 'save image'. After the images are saved to hard disk it is ready for an unauthorised re-publication at anytime. Thus it is almost impossible to identify the real original author of such images.

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[929] Sterling p312 at 6.68-6.72

[930] 'An Image Of The Data Displayed On The Screen Of A Computer Or Mobile Device' (*Oxford Dictionaries*) < http://www.oxforddictionaries.com/definition/english/screenshot > accessed 3 July 2015

To prevent these unauthorised acts, some authors of the images published online may protect their *property* by disabling right-clicking function or adding watermarks to those images.

**(ii) Publishers**

Images or photos are different from other copyright protected artistic works such as literary works, musical works, or audiovisual works in the sense that, apart from the contribution of *originality and creativity* of the original authors or photographers, mostly the images which are *fixed* and published to the public require almost no role of the middlemen such as publishers. In the old time, in *Nottage v. Jackson*[931] the persons who owned the company which employed photographic artists were not the owner of the photographs taken by their employees even though they have registered themselves as the proprietors and authors of the photograph under the Copyright Act 1862. However, nowadays the photographic agencies or publishers of photography could have *property right* and *ownership*[932]over the *fixed* images subject to the laws[933] and contract[934].

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[931] *Nottage v. Jackson* (11 Q.B.D. 627 (1883)) at 628-629 *'It is impossible to draw any analogy between a photograph and a picture or a book. The latter is the creation of the author's mind or brain. You cannot in that sense create a photograph. Photography is a mechanical operation. There is no definition of "author" in the Act, but the "author" of a photograph, in case similar to the present, is the person who conceives the idea and sends his materials and men to take it, the ultimate result being the manipulation of many hands. Further, copyright is given in the photograph, not in the negative from which the photographs are printed. It is the printed copy which comes before the public in which the right of authorship subsists. Then the "author" must be the person who finds all the materials and is the common employer of all the artists and assistants who carry out the mechanical operations which result in the ultimate production of the printed copy sold to the public…, for the respondent. The artist employed by the plaintiff to take the negative is the author. The plaintiffs are not photographers.'*

[932] See the discussion about *intellectual property right* of the corporate holders in chapter II and III

[933] For example, in case of works made for hire as appear in 17 USC § 201 (b) and section 11 of the CDPA 1988

[934] See 'Sample Contract: Publishing Contract for Book of Photography' (Columbia Law School) <http://web.law.columbia.edu/keep-your-copyrights/contracts/samples/14>accessed 3 July 2015

In the analogue world, the exclusive rights offered to the publishers of offline published images may include 1) the right of reproduction 2) the right of distribution 3) the right of display and 4) the right of communication to the public.

In the online environment the exclusive rights of the publishers of images which are made to be appeared online in a digital format are limited as well to the two main acts which could be performed online. These are 1) the right of reproduction and 2) the on-demand availability right or the right to authorise the communication to the public 'on-demand'. This is due to the common nature of digital works and online activity environment.

Nevertheless, many free online photo sharing platforms such as Instagram and Flickr, even though they perform their role similarly to the publishers of those digital images, do not have *ownership* over the photos posted on the sites. *Ownership* belongs to the person who deliberately took and published photographs. The owners or photographers of these images only granted the sites some licenses to use their digital photo contents.[935]

On the other hand, the site that allows photographers to sell their photos such as Shutterstock does not own any rights over the digital images as well. Nevertheless, it is affirmed in their Terms of Service that *'Shutterstock's contributors have granted Shutterstock all necessary rights in and to the Visual Content to grant the rights set forth in Part I as*

[935] *'Instagram does not claim ownership of any Content that you post on or through the Service. Instead, you hereby grant to Instagram a non-exclusive, fully paid and royalty-free, transferable, sub-licensable, worldwide license to use the Content that you post on or through the Service, subject to the Service's Privacy Policy'* at 'Instagram - Help Service' (*Instagram*) <https://help.instagram.com/478745558852511> accessed 9 July 2015 and *'Flickr user photos are owned by the users (the photographers) and not by Flickr.'* at 'Flickr APIs Terms of Use' (*Flickr*) <https://www.flickr.com/services/api/tos/> accessed 9 July 2015

*applicable.'*[936] Whereas the rights in Part I include *'a non-exclusive, non-transferable right to use, modify and reproduce Visual Content worldwide, in perpetuity, as expressly permitted by the applicable license and subject to the limitations set forth therein.'*[937]

### (iii) Users

In the analogue world where the images which contain *originality and creativity* of authors are *fixed* in tangible media, the users may purchase those media in which the works are stored within. After that the users receive *property right* over that tangible medium but not over the works contained within. The users are therefore barred from those unauthorised acts which may occur after purchasing of the media that contain the images. These include the act of unauthorised 1) reproduction 2) distribution 3) display and 4) communication to the public of the images through any kind of medium.

In the digital environment, images are made to be appeared online in digital formats; therefore there is no *property right* for users over any tangible medium. In this environment, the users of online digital images are barred from unauthorised 1) reproduction and 2) authorising the communication to the public 'on-demand' of such digital works. These acts are limited to online activity only due to the common nature of the work and the aspect of online activities environment. However, the users of online digital images are still prohibited from unauthorised distribution and display of online digital images to the offline world.

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[936] 'Terms of Service Shutterstock License Agreement(s)' (*ShutterStock*, 30 March 2015) <http://www.shutterstock.com/license > accessed 3 July 2015 at Part II Warranties And Representations

[937] Ibid at Part I Visual Content Licenses

Since the digital images are stored not in a tangible medium but in a digital format, those digital data of the works would not be transferred to the third party via the tangible materials but through RAM[938]. The users therefore have no *property right* over any tangible material that contains the work.

Nevertheless, it is much more difficult to prevent unauthorised reproduction of images appear on websites. Normally when *browsing* a website the users are making temporary reproduction of the images in RAM. This act is permissible under copyright law for technological purposes.[939] However, in practical it is likely that the users may also, at any time, copy those images into their hard disks or to publish on other sites or documents via screenshot technology (*screen capturing*). This is not permissible under copyright law since the right of reproduction and authorising the communication to the public 'on-demand' belong only to the authors or publishers, as discussed earlier. As long as screenshot technology (*screen capturing*) is still available on the computers and devices it is unlikely that authors and publishers can prevent such acts of copying, even if they have disabled Right-Click function or added watermarks to their photos.

However, it is important to note that the users of online digital images are also protected by the *right to freedom of expression.* Under *the argument from democracy*, the individual users are protected against the restriction of government for purposes of supporting the function of democratic system. This means that under *the argument from democracy* and the *right to freedom of expression* the users are guaranteed a right to communicate their '*ideas, information and artistic sentiment through means*

[938] See discussion about RAM in chapter I

[939] See discussion about RAM in chapter I

*that are either linguistic, pictorial, or traditional artistic'* freely.[940] In this aspect, users may be protected at a higher level than the publishers.[941]

After all, *copyright* of authors and publishers and the *right to freedom of expression* of public users are conflicted as discussed earlier in chapter II.

## B. OTHER RIGHTS OF ONLINE PUBLIC USERS: THE RIGHT OF MAKING DERIVATIVE WORKS

Derivative work is the work based on the previous work. Some examples of derivative works such as translations, adaptations, arrangements of music, other alterations of a literary or artistic work and collections of literary or artistic works. These works are protected as original works without prejudice to the copyright in the original work.[942]

The right of making derivative work is granted as 'the right of adaptation' which is the exclusive right of 'the authors' only.[943]Also in the online activity environment, the artistic works that are available for making derivative works are those of literary works, musical works, audiovisual works, and images, which have already been discussed and analysed earlier. Since the only persons who possess the rights of making adaptation of the online digital literary works, musical works, audiovisual works, and images, are the authors of these works, respectively, every other unauthorised persons who make adaptation of these online artistic works could potentially be the copyright infringers.

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[940] Schauer p91

[941] See discussion about 'Freedom of Expression' in chapter II

[942] Berne 1971, article 2(3), (5)

[943] Berne 1971, article 12

### B.1. Users as Subsequent Creators

In the online environment and the time of user-generated content (UGC) or user-created content (UCC), internet users are creating and sharing content outside of a professional routine and organization. This emphasises the major roles of the internet users as the 'amateur creators', not the 'professionals' even though some online contents maybe provided to users by commercial or professional entities.[944]

According to the OECD, UCC activity has three main important characteristics: *1) Publication requirement, 2) Creative effort,* and *3) Creation outside of professional routines and practices.*[945] This means that, regardless of professional expertise, the users of internet technology who are referred as 'amateur creator' will contribute at least *'a certain amount of creative effort'*[946] and *'a publication'*[947] in order to create an online content. In addition, *'a certain amount of creative effort'* and *'a publication'*, these two factors also play an important role in the copyright area.[948]

Regarding the previous discussion, in order to receive copyright protection or *authorship* over a created work, one thing that is required for an individual author is the 'the author's own genius'[949]. 'The author's own genius' or 'originality and creativity' is the important factor that links the author to their own created works and also defines '*authorship*' under copyright law.

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[944] Organisation for Economic Co-operation and Development (OECD), *The Report of the OECD Directorate for Science, Technology and Industry Committee for Information, Computer and Communications Policy* (Presented to the Working Party on the Information Economy (WPIE) as part of the WPIE work on Digital Content in December 2006, 2006) p9

[945] Ibid p8

[946] Ibid p8

[947] Ibid p8

[948] See discussion about publication in chapter IV

[949] See chapter III

However, in the nineteenth century the concept has been modified, particularly in the area of 'derivative works'. The right of making adaptation or the right to create a derivative work based on the previous work is now guaranteed only for the original author of the original work. Therefore, basically the act of 'unauthorised making derivative work' or 'making derivative work without permission of the author of the previous work' is considered a copyright infringement, although that might depend on some exceptions.

In the era of UCC or online digital environment, each internet users are 'taking' at least some kinds of online digital creative works[950] and, while adding *'a certain amount of creative effort'*[951], they are 're-creating' a subsequent work at anytime. The concept of UCC, therefore, emphasises that these users are not merely the pure users but they are also creators at the same time.

Nevertheless, since the online users create a subsequent or derivative works (text, photo and images, music and audio, video and film) based on the original digital work available online, these users, therefore, is considered the infringers of 'the right of making derivative work' of the original author of such online digital work every time they made a creation of a new work based on an original online digital work without authorisation from the original author as well. This is even though *'a certain amount of creative effort'*[952] of the creators (users) has been added to such subsequent works, unless that

[950] Text, photo and images, music and audio, video and film, (OECD) pp16-17

[951] Ibid p8

[952] Ibid p8

'*certain amount of creative effort*' is considered as transformative under the exceptions of copyright infringement.[953]

### B.2. Originality and Creativity

Under the copyright regime 'originality and creativity' is one of the important criteria for copyright protection. This means that in order to be qualified for copyright protection, such work will need to demonstrate at least 'a minimum degree of creativity' of the original author.[954]

This results in the protection of copyright granted to those online digital works. It is noteworthy that although not every online digital work published in the internet environment may contain 'originality and creativity' and thus qualified for copyright protection, the degree of originality and creativity required for copyright protection is very low that almost every artistic work (text, photo and images, music and audio, video and film) appeared online are protected by copyright.

The requirement of 'originality and creativity' for copyright protection applies equally to both original works and derivative works which are published online.[955] Moreover, the concept of 'transformativeness' which applied to exceptions of copyright infringement also plays an important role in this specific case.[956]However, when looking at these online digital works, it is difficult and almost impossible to identify or prove 'originality and creativity' and 'transformativeness', and thus distinguish derivative works from the original works.

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[953] See discussion about 'transformativeness' in chapter I

[954] See discussion about 'originality and creativity' in chapter I

[955] See discussion about 'originality and creativity' and copyright protection of derivative work in chapter I

[956] See discussion about 'transformativeness' in chapter I

According to the OECD, the UCC internet environment allows internet users to publish online digital works with *'a certain amount of creative effort'.* The scenario is that when an original work (text, photo and images, music and audio, video and film) is published online with *'a certain amount of creative effort'*, a number of internet users can take that original work at anytime (mostly without authorisation of the original author), then add *'a certain amount of creative effort'* and re-publish to the internet. After such work is published, then again a number of the next internet users can take such re-published work at anytime (mostly without authorisation of the second author), then add another *'a certain amount of creative effort'* and make another re-publication. This scenario is continuing and repeating endlessly all over the internet.

**B.3. Fixation**

Fixation is another 'criterion of form' which is required for copyright protection.[957] In the analogue world, the original works are firstly created and *fixed* in tangible medium by the author. Likewise the act of making *reproduction* or making *adaptation* of such original works (which are overlapped) would occur when the works are *fixed* in tangible medium as well.[958]

In the offline world, copyright prohibits unauthorised making *reproduction* of a work in tangible medium since that would affect the economic benefits of the original author lie in 'the work' and 'the physical copies that contain the work'.[959] As for the right of making *adaptation*,

[957] See discussion about 'fixation' in chapter I

[958] Though not in US, see chapter I

[959] See discussion about 'fixation' in chapter I

copyright prohibits the act of unauthorised making any alteration to the work of the author. In other words, the author is the only person that contributes her 'genius' and therefore possesses '*authorship*' over the work that she could make any adaptation.[960]

But for online digital contents, the works are *fixed* not in tangible medium but they are stored in computer's data storage in a digital format.[961] Or sometimes these digital formats of the works may be stored temporarily in RAM.[962] Therefore, there is still 'the work' but there is no more 'the physical copies that contain the work'. The online users will make *reproduction* and *adaptation* of the work either in their RAM or their computer data storage. Then,under UCC environment, they may publish such work on those online publicly accessible sites according to the OECD's *Publication Requirement.*[963]

That is;

1) When the online users 'view' a digital work (text, photo and images, music and audio, video and film) on the internet they are making *reproduction* of such work because the work is *fixed* in RAM. Without authorisation of the original author, that act is infringing the right of reproduction, but may be subject to the exception of 'technological purposes'.[964]

2) When the online users 'download' or 'save' a digital work (text, photo and images, music and audio, video and film) to their hard disk, they are making *reproduction* of such work because the work is *fixed* in computer

[960] See discussion about 'fixation' in chapter I and 'authorship' in chapter II and III

[961] See chapter IV

[962] See discussion about 'fixation' in chapter I

[963] (OECD) p8

[964] See discussion about 'fixation' in chapter I

data storage. Without authorisation of the original author, that act is infringing the right of reproduction. This may not comply with the exception of 'technological purposes' but possibly be defendable under the three-step test and the fair use or fair dealing doctrine.[965]

3) When the online users 'alter' a digital work (text, photo and images, music and audio, video and film) with *'a certain amount of creative effort'*, they are making *adaptation* of such work because the work is *fixed* either in RAM or computer data storage. Without authorisation of the original author, that act is infringing the right of making adaptation. This may not comply with the exception of 'technological purposes'. But possibly be defendable under the three-step test and the fair use or fair dealing doctrine of 'transformativeness'.[966]

4) When the online users 'publish' an altered digital work (text, photo and images, music and audio, video and film) on the internet, they are making *available on demand* of such work because the work is *fixed* in RAM and computer data storage. Without authorisation of the original author, that act is infringing the right of making available on demand. This may not comply with the exception of 'technological purposes'. But possibly be defended under the three-step test and the fair use or fair dealing doctrine.[967]

5) This all happens all the time and endlessly even though there is only digital 'work' but no 'the physical copies that contain the work'.

[965] See discussion about 'three-step test' and 'fair use and fair dealing' in chapter I

[966] See discussion about 'three-step test' and 'fair use and fair dealing' in chapter I

[967] See discussion about 'three-step test' and 'fair use and fair dealing' in chapter I

### B.4. Infringement

According to the discussion above, online copyright infringement of the right of reproduction, the right of making derivative work, and the right of making available on-demand, could happen anytime the users view, download, save, alter and publish the work on the internet. However, when looking at the individual internet users as the major player[968] of the network and their frequent active roles, this thesis focuses mainly on the right of making derivative work from the side of the users.

First of all, the right of making reproduction and the right of making derivative work are overlapped. As Nimmer provided that *'A work is not derivative unless it has substantially copied from a prior work.'*[969] This concept does apply as well to the online digital environment. Nevertheless, for the act of unauthorised making reproduction online, there is an exception for copyright infringement in case that reproduction is done 'for technological purposes'. This exception is not provided for the act of unauthorised making adaptation or making derivative work online, however.

The only exception allowed for the act of unauthorised making adaptation or making derivative work online is under the concept of 'three-step test' and 'transformativeness'. However, with *'a certain amount of creative effort'* contributed to the subsequent work under UCC environment, not every work could meet the qualification of transformativeness so that they can be exempted from infringement. Furthermore, it is very difficult to prove these qualifications even before the court or in the offline world.[970] Therefore,

[968] See statistic in chapter II

[969] Nimmer, *Nimmer on copyright : a treatise on the law of literary, musical and artistic property, and the protection of ideas* §3.01

[970] See discussion about 'three-step test' and 'fair use and fair dealing' in chapter I

in the online digital UCC environment, the users who create a subsequent digital work based on the previous work, then add *'a certain amount of creative effort'* and *publish* to the internet, is likely infringing the right of making adaptation of the original author from the first moment they are preparing a derivative work of such digital work and not yet publish to the public.

However, when focusing on the fundamental concept of copyright protection, it recognises the importance of 'genius' and 'originality and creativity' of the author as the most necessary components for any creation. 'Originality and creativity' of the author are the factors that determine the '*authorship* over the creation of the mind'.[971] 'Genius' and 'originality and creativity' of the author, are the major factors that define '*authorship*' of the author since the eighteenth century.[972] Whereas the business institutions who do not contribute their 'genius' and 'originality and creativity' to the work could only earn '*ownership*' over copyright as the copyright holder, it is suggested that the fundamental concept of copyright favours '*authorship* in a work of creation' rather than '*ownership* of copyright'.

In addition, the fundamental concept of copyright in the digital era also cherishes the right to freedom of expression of the *speaker*, the *audience* and the *public* in the internet environment, as provided in chapter II that:

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression**

[971] See chapter II

[972] See chapter III

> (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

This is in concordance with the decision in *Ashby Donald and Others v. France*[973] in which the European Court of Human Rights ruled that even though the unauthorised publication of fashion photos on the website (for commercial purposes) infringed the exclusive rights of the fashion designers, such act of online publication of the photo, at the same time, fell under the scope of the right to freedom of expression under Article 10 of the ECHR.

In UCC environment where the online users, at the same time, could as well potentially be the copyright creators and copyright infringers, it is, however, noteworthy that 'genius', 'originality and creativity' and '*freedom of expression'* of individual users are the main important factors for creation. This is as what the thesis argues and emphasises in particular in chapter II that 'It is not that copyright is the engine of *freedom of expression*, but *freedom of expression* is the engine of copyright, and copyright is the engine of *creative expression*'.[974]

## III. CONCLUSION

This chapter emphasises the importance of the three major parties and their major roles under the online activity context. Also it clarifies the exclusive rights possessed by each party. First of all, the discussion identifies the strong relationship between the author and their genius and 'originality and creativity' and *authorship*. This is the fundamental concept of copyright

[973] *Ashby Donald and others v. France*

[974] See chapter II

protection since the first time it originated in the eighteenth century, that is, to remunerate the 'intellectual labour'[975] of the original author of the work of creation.

Genius and 'originality and creativity' are the major substances that define *authorship*. The following discussion in this chapter confirms the concept of 'copyright as *property right*' and 'copyright as *intellectual property right*' in relation to the *authorship* of the author. It is also re-emphasised in chapter III that, from the human right (as previously discussed in chapter II) and copyright perspective, the individual author are protected at a higher level than the corporate holders. This could be seen from the '*authorship*' and '*ownership*' axioms. Even though that was from the old time theory, the approach has never been confuted or proven otherwise. And thus the idea still plays an important role in the digital era.

Nevertheless, when focusing on the practical activities in the online environment, the study founds that the corporate entities, which normally held the position as publishers (or sometimes, as employers, they could as well be authors) in the online activity and could hold '*ownership*' over copyright, are able to draw higher profits from the copyright protection system than the individual authors who are eligible for '*authorship*'. This is due to the available laws[976] and applicable technologies such as the notice and takedown concept and DRMs, and their economic competence through their well-prepared publishing contracts.

The problem happens particularly in terms of the creation of derivative works. From the current system of copyright protection, it could possibly be accounted that a strong protection of copyright has been granted to almost

[975] See chapter II
[976] See, in particular, TRIPs 1995, article 13

every single digital literary and artistic works appear online (literary works, musical works, audiovisual works, and images). This, on one hand, is beneficial for the exclusive rights of the original authors.

However, as aforementioned, since the corporate entities and publishers are the major persons who could draw benefits from the copyright protection and prevent the unauthorised uses of online copyrighted works, the opportunity of the individual authors and possible subsequent creators who, with their right to *freedom of expression*, would like to contribute their genius and originality and creativity which are the substances for '*authorship*' in order to produce the creative works for the online communities, is highly affected.

This problem needs to be resolved in the next chapter in order to create a room for these users so that they can 1) exercise their right to *freedom of expression* online, and 2) contribute their genius and 'originality and creativity' to create and own *'authorship'* over an online digital work of creation.

Most importantly, this is to comply with the fundamental concept of copyright proposed in chapter II: to 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

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# CHAPTER IV

# THE INTERNET, THE INDIVIDUALS, AND COPYRIGHT: EVERYTHING UNDER A UNIFIED CONCEPT OF 'PUBLICATION'

## I. THE INTERNET

### A. FUNCTION AND NATURE OF THE INTERNET

From the beginning era of computers usage around the end of 1950, the device was known only to a limited group of people. The programmers are the person who wrote the programs in numerical instructions and allowed the computers to calculate them. After a program was run on a computer, the process is uninterruptable until it reached to the result of the calculation. Moreover, due to the limited capability of the CPU (Central Processing Unit) technology, each standalone computer, at that time, does not support effective communication amongst programmers.[977]

'Time-sharing' processing system was therefore developed to solve the problem. The technology allows multiple programmers (or users) to run program, connect and communicate independently and simultaneously via multiple computers at the same time. This is thus called the 'interactive' communication.[978]

From the late 1960s to 1970s the Advanced Research Project Agency (ARPA) under the US Defense Ministry has been particularly interested in the interconnected computer networks. This is due to the problem of separate and unconnected networks in the organisation. The situation is, even though

[977] Patrice Flichy, *The Internet Imaginaire* (MIT 2007) p36

[978] Ibid p36

multiple computers are connected as a network, each network is not connected to each other.[979]

The ARPA project aims to interconnect each network together using Local Area Networks (LANs) or Wide Area Networks (WANs). This is known as 'internetwork' which later was abbreviated and become known as 'internet'.[980] Internet is, therefore, functioned as a communication tool amongst multiple individuals since then.

## B. BENEFIT OF SHARING

From the beginning of the development of internet, the ARPANET is a very important system. It was often called the *backbone* network because it allows all the researchers to be linked together using the central WAN. Each researcher had a computer connected to the ARPANET and communicate with each other via WAN. Also they can add more computers at their sites using additional connection.[981]

However, the use of the interconnected network at that time was still limited. The system was difficult to use for anyone other than the network designers. Also the researchers in the computer teams were reluctant to allow the outsiders to use their machines.[982]

In the late 1970s, after an ARPANET community was formed as a closed community, people in ARPA started to realise that they were now holding a new medium that can change the way of communication in all sectors of

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[979] Douglas E. Comer, *The Internet Book : Everything You Need To Know About Computer Networking And How The Internet Works* (2nd edn, Prentice Hall ,Englewood Cliffs, New Jersey August 1997) p54

[980] Ibid p54

[981] Ibid p55

[982] Flichy p45

society.[983] While computer vendors at that time were trying to keep their communication private and closed so that they could restrict other companies from using the same technologies, in order to encourage the use of the internet amongst new and different vendors, ARPANET decided to create an *open* system that allows functions of compatible technology. For ARPANET the Internet is an open system that all specifications are publically available via the establishment of TCP/IP (Transmission Control Protocol/Internet Protocol) software.[984] [985]

In summary, the openness of the internet system is important to interconnect and build up communications between computers. This is before the introduction of the World Wide Web (WWW), HyperText Markup Language (HTML), HyperText Transfer Protocol (HTTP) and the Uniform Resource Locator (URL).[986] This is as the Federal Communications Commission (FCC) provides in the Final Rule on Protecting and Promoting the Open Internet in 2015 that:

> *'[T]he Internet's openness promotes innovation, investment, competition, free expression, and other national broadband goals. … [T]he Internet's openness is critical to its ability to serve as a platform for speech and civic engagement, and that it can help close the digital divide by facilitating the development of diverse content, applications, and services. … [T]he Internet's openness continues to enable a "virtuous [cycle] of innovation in which new uses of the network—*

[983] Ibid p47

[984] Comer pp56-57

[985] Flichy pp57-58

[986] Ibid p62

> *including new content, applications, services, and devices—lead to increased end-user demand for broadband, which drives network improvements, which in turn lead to further innovative network uses. … [It] increased consumer choice, freedom of expression, and innovation."*[987]

The above FCC Rule is mainly focusing on the internet infrastructure and software technology. However, the rule is in accordance with the concept of copyright protection in the internet era as proposed by this study in chapter II that:

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

For these particular purposes, the internet therefore allows the concurrent operation of various useful online activities, as discussed previously in chapter I, such as *linking*, *file sharing*, *uploading and downloading*, *streaming*, *and screen capturing*.

[987] Federal Communications Commission, 'Protecting And Promoting The Open Internet - A Rule By The Federal Communications Commission' (*Federal Register*, 13 April 2015) <https://www.federalregister.gov/articles/2015/04/13/2015-07841/protecting-and-promoting-the-open-internet> accessed 6 July 2015

## II. INTERNET AND COPYRIGHT: A UNIFIED CONCEPT OF 'PUBLICATION'

Internet and copyright resembles in many ways. One important scale is that they both are built up under a purpose of supporting 'freedom of expression'. Since 'freedom of expression is an engine of copyright' as provided in chapter II, therefore, promoting and supporting freedom of expression that comes with the openness of the internet, as provided in FCC Rule, is one way to achieve the fundamental concept of copyright protection for 'creative expression'.

Another scale that internet and copyright resembles, this study argues, is that, they are both built up on a strong element of 'publication'. Since both are profoundly related to communication activities, internet thus provides channels for 'publication' of expressions of authors, whereas copyright requires 'publication' as a fundamental tool for the principle to function effectively in order to protect *moral interest* and *material interest* of *creator,* which will be discussed further as follows.

### A. 'PUBLICATION' IN THE CONTEXT OF COPYRIGHT

#### A.1. Publication and Copyright Protection

Publication is an important criterion that determines copyright protection granted to a work of creation. According to article 3 (1)(a) of the Berne Convention, copyright protection will be granted to both *published* and *unpublished* literary and artistic work of the authors who are nationals of the member countries.[988] However, for the authors who are *not* nationals of the member countries their literary and artistic work will be protected by

[988] Berne 1971, article 3(1) *'The protection of this Convention shall apply to: (a) authors who are nationals of one of the countries of the Union, for their works, whether published or not'*

copyright only if those works are first *published* in one of the member countries, or simultaneously in non-member and a member country.[989]

In addition, the Berne Convention also specifies that the *published* literary and artistic work is the work that published with the consent of their authors, regardless of the means of manufacture of the copies. Also the availability of such copies may have to satisfy the reasonable requirements of the public. For this purpose, '*The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.*'[990]

It is noteworthy that the Berne Convention does not provide a definition of 'copies'. However, when focusing on the term 'manufacture' that accompanies, it could be inferred that the term 'copies' may refer to the tangible copies that contain the literary and artistic work.

### (i) Publication and Copyright Protection in the US

In the US, the *unpublished* work is protected by copyright from the time of its creation, for the life of the author and another 70 years after the author's death.[991] The *unpublished* anonymous and pseudonymous work and the unpublished works that the death date of the author is not known are protected for a term of 120 years from the year of its creation.[992]

For the *published* anonymous and pseudonymous work, copyright protection will last for a term of 95 years from the year of its first

[989] Berne 1971, article 3(1) *(b)*

[990] Berne 1971, article 3(3)

[991] 17 USC § 302(a)

[992] 17 USC § 302(c)

publication.[993] The work created on or after January 1, 1978 which is *published* first time in the US will be granted copyright protection generally from the time of its creation, for the life of the author and another 70 years after the author's death.[994]

As for the work created and *published* first time in the US before January 1, 1978 the term of protection is varied.[995] Nevertheless, for this purpose, the distribution of a phonorecord before January 1, 1978 will not be considered a *publication* of any musical work, dramatic work, or literary work contained therein.[996]

### (ii) Publication and Copyright Protection in the UK

In the UK, according to schedule 1 to the Copyright, Designs and Patents Act 1988 the work which is *unpublished* at the author's death and remained so until 1 August 1989 will enjoy copyright protection until 31 December 2039.[997] Any *unpublished* work created on or after 1 August 1989 will be protected by copyright until at least 31 December 2059. This is because the Copyright, Designs and Patents Act 1988 provides that copyright will expires 70 years from the end of the calendar year in which the work was

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[993] 17 USC § 302(c)

[994] 17 USC § 302(a)

[995] See Peter B. Hirtle 'Copyright Term and the Public Domain in the United States'(*The Creative Commons*, 1 January 2015) <https://copyright.cornell.edu/resources/publicdomain.cfm> accessed 6 July 2015

[996] 17 USC § 303(b)

[997] CDPA 1988, section 170 and the 'Schedule 1, Copyright, Designs and Patents Act 1988' (*Legislation.gov.uk*) <http://www.legislation.gov.uk/ukpga/1988/48/schedule/1> accessed 6 July 2015, see also 'Consultation on Reducing the duration of copyright in unpublished ("2039") works in accordance with section 170(2) of the Copyright, Designs and Patents Act 1988', *(Intellectual Property Office, December 2014)* <https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/368811/consultation-on-unpublished-works.pdf> accessed 6 July 2015, and 'Government response to the consultation on reducing the duration of copyright in certain unpublished works' *(Intellectual Property Office, 2015)* <https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/399171/973_-_Governement_Response_-_copyright_in_certain_unpublished_works.pdf> accessed 6 July 2015

created (in case of unknown authorship) or from the end of the calendar year in which the author dies.[998]

Also for the work which is created and *published* first time in the UK after 1 August 1989 copyright will expire 70 years from the end of the calendar year in which the author dies.[999]

### A.2. Publication and the Exclusive rights

Following the concept of 'common law copyright'[1000] which could be possibly referred as 'the right of first publication'[1001], the decision in *Donaldson v Beckett*[1002] in 1774 held that that even though the author of an *unpublished* work may have perpetual 'common law copyright' to control the first publication of the work, the work which was *published*, however, is subject to a limited period of protection as provided by the Statute of Anne.

The idea from this decision creates a dual protection system between *published* and *unpublished* work under the terms of 'statutory protection' and 'common law copyright'.[1003] In the Copyright Act of 1911, the UK has abolished that dual system, providing that: *'Subject to the provisions of this Act, copyright shall subsist … for the term hereinafter mentioned in every original literary dramatic musical and artistic work, if—(a) in the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid; and (b) in the case of an unpublished work, the author was at the date of the making of the work a British subject or resident*

[998] CDPA 1988, section 12(2)(3)

[999] CDPA 1988, section 12(2)

[1000] Kaplan p84

[1001] Melville B. Nimmer, 'Copyright Publication' (1956) 56 Columbia Law Review 185 p185

[1002] *Donaldson v. Becket*

[1003] Nimmer, 'Copyright Publication' p185 See also Laurence N. Walker, 'Publication and the Copyright Law Revision' (1962) 50 California Law Review

*within such parts of His Majesty's dominions as aforesaid'.*[1004] Also in the US, the Copyright Act of 1976 has eliminated such dual system, providing that: *'On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright …, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State'.*[1005]

Before the time of those amendments, even though 'publication' was an important factor for a work whether to be protected perpetually under 'common law copyright' or within a limited of time under 'statutory protection', there is no such clear definition of 'publication' under the law.[1006] According to Nimmer, it is suggested that *'publication occurs when by consent of the copyright owner, the original, or* ***tangible copies****, of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.'*[1007]

The lack of clear meaning of publication raised a big problem in its interpretation. In *Ferris v. Frohman* [1008]the plaintiff who held a 'common law copyright' in an English play which has previously been performed in England sued the defendant to prevent the producing of the adaptation of the play in the US. The contention was that due to previous public performance of the

[1004] Section 1(1) of the 'Copyright Act 1911 ' (*Legislation.gov.uk*, 16 December 1911) <http://www.legislation.gov.uk/ukpga/Geo5/1-2/46/enacted> accessed 6 July 2015

[1005] 17 USC § 301(a)

[1006] Nimmer, 'Copyright Publication' pp185-186

[1007] Ibid p187 [emphasis added]

[1008] *Ferris v. Frohman* 223 US 424 (1912)

original play in London, the owners thus did not attain 'common-law right' but only the 'statutory protection' which has already been expired. The Supreme Court held that *'performing right was not within the provisions of [the Statute of Anne], which gave to authors the sole liberty of* ***printing*** *their books'*[1009] and '*[t]here was no statute here by virtue of which the common-law right was lost through the performance of the* ***unpublished*** *play.'*[1010] Thus the public performance of a dramatic work, which was not printed and published, did not destroy the 'common law copyright' of the owner.[1011]

The decision of the Court in *Ferris v. Frohman* reflects that the term 'publication' has been interpreted narrowly by the Court to include 1) only *printing materials* but not in the sense of 'communicating to the public'.[1012] Also 2) the term 'copies' which appears in the suggested definition of publication above confines only the *tangible objects* so that the performance of the work in public is excluded and thus does not constitute publication.[1013]

After the abandonment of such dual protection system, publication is not any more the condition of giving up 'common law copyright' to 'statutory protection'. Both *published* and *unpublished* works are protected under a limited period of time as previously discussed.

Nevertheless, after such work is protected by copyright, 'the right of first publication' is granted to the copyright owner as one of their exclusive

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[1009] Ibid at 432 [emphasis added]

[1010] Ibid at 434 [emphasis added]

[1011] Ibid at 435

[1012] Laurence N. Walker, 'Publication and the Copyright Law Revision' (1962) 50 California Law Review p675 and footnote 19

[1013] Nimmer, 'Copyright Publication' Article VI '*"Publication", as used in this Convention, means the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.'*

rights[1014] under Section 106 of the US Copyright Act of 1976 *'to distribute **copies** or **phonorecords** of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending'*[1015], insofar as the term 'publication' is given a new meaning as *'the distribution of **copies** or **phonorecords** of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute **copies** or **phonorecords** to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.'*[1016]

In the UK, on the other hand, whereas 'publication' is defined as it *'includes **any communication to the public**, in particular— (a)the issue of copies to the public; (b)making the work available by means of an electronic retrieval system; (c)the rental or lending of copies of the work to the public; (d)the performance, exhibition or showing of the work in public; or (e)broadcasting the work or including it in a cable programme service'*[1017]for purpose of granting a property right (equivalent to copyright) to the person who publish an *unpublished* work for the first time[1018], the right is also applicable to the copyright owner as well by virtue of section 17 (1).[1019]

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[1014] *Salinger v. Random House, Inc.* 811 F2d 90 (2d Cir 1987)

[1015] 17 USC § 106 - Exclusive rights in copyrighted works

[1016] 17 USC § 101 – Definitions

[1017] The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC Section 16(1)

[1018] The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC Section 16

[1019] The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC Section 17.—(1) The substantive provisions of Part I relating to copyright (but not moral rights in copyright works), that is, the relevant provisions of— Chapter II (rights of copyright owner), Chapter III (acts permitted in relation to copyright works), Chapter V (dealings with rights in copyright works), Chapter VI (remedies for infringement), and Chapter VII (copyright licensing), apply in relation to publication right as in relation to copyright, subject to the following exceptions and modifications.

### A.3. Publication and Copyright Infringement

According to section 405 of the US Copyright Act 1976, a work which was *published* in the US before 1976 will enter in the public domain if such publication did not conform with the formalities, such as a proper copyright notice.[1020] In this particular issue, the distinction between limited and general publication plays an important role in the public domain context.[1021] It creates a distinction between the work which is protected by copyright and the work which is available for others to use freely without being accused of copyright infringement.

In addition, publication also plays an important role in fair use context in the area of the protected work.

According to Barton Beebe in An Empirical Study of U.S. Copyright Fair Use Opinions 1978-2005, publication status of a work demonstrates some effects on the outcome of the fair use test under factor two: Nature of the Copyrighted Work. It represents that the fact that the plaintiff's work was *published* caused a strong effect in favour of fair use, whereas the *unpublished* status of the work shows no significant effect.[1022] The chance that the defendant would succeed in fair use defence increases from 27.4% to 57.8% if the plaintiff's work went from *not-published* to *published*.[1023]

This, to some degrees, is in correspondence with section 107 of the US Copyright Act 1976, which provides that '*The fact that a work is*

[1020] Deborah R. Gerhardt, 'Copyright Publication: An Empirical Study' (2011) 87 Notre Dame Law Review 135 p177

[1021] Ibid pp176-177

[1022] Beebe p613

[1023] Ibid p614

*unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors."*[1024]

In the UK, the Copyright, Designs and Patents Act 1988 allows the inclusion of a short passage from a *published* work in a collection for purpose of educational use[1025], reprographic copying from *published* works by educational establishments[1026], copying parts of *published* works by librarians[1027], copying certain *unpublished* works by librarians or archivists[1028], public reading or recitation from a *published* work with a sufficient acknowledgement[1029], without infringing copyright of the right owner.[1030]

## B. 'PUBLICATION' IN THE CONTEXT OF INTERNET AND ONLINE ACTIVITY

The internet is communicated via an ISO (International Standards Organisation) standard of network communications. This is called the Open Systems Interconnection (OSI) model which was firstly introduced in 1970s. **Open system** is the protocol that allows communication between any two different systems regardless of their underlying architecture. The OSI is not a protocol but a model of flexible network architecture that was designed to

[1024] 17 USC § 107 - Limitations on exclusive rights: Fair use

[1025] CDPA 1988, section 33

[1026] CDPA 1988, section 36

[1027] CDPA 1988, section 39 and 41

[1028] CDPA 1988, section 43

[1029] CDPA 1988, section 59

[1030] CDPA 1988, section 28

facilitate communication between all types of computer systems with no requirement of changes in their logic of hardware or software.[1031]

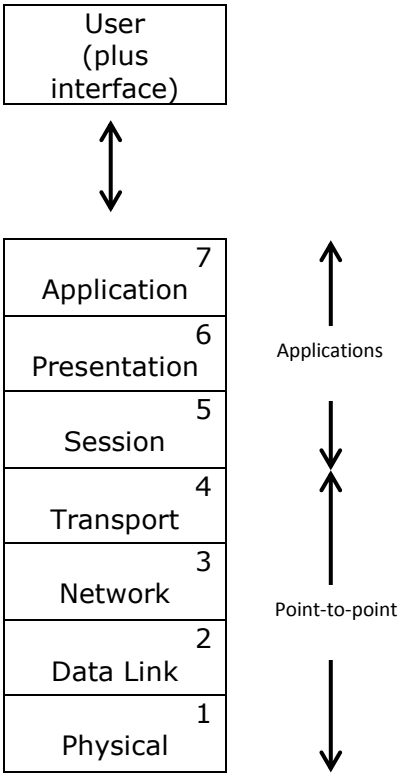



***Fig.4 The seven layers of the OSI/RM.***[1032]

In brief, the OSI model consists of seven ordered layers as provided in figure 4 above. At the end of the process, user interface will allow user to access all the features of the application environment.[1033] The application layer is the layer that the user can interact with the system and it is where the application software is operated. From the lower layers to the physical layer are the

[1031]Behrouz A. Forouzan and Sophia Chung Fegan, *Data Communications And Networking* (4th ed. / Behrouz A. Forouzan with Sophia Chung Fegan. edn, McGraw-Hill Higher Education 2007) , p 29

[1032] Colin Smythe, *Internetworking : Designing The Right Architectures* (Addison-Wesley 1995) p47

[1033] Ibid p52

layers where logical information is converted into signals and then transported through the physical media.[1034]

Some of these seven layers are closely tied together that the decisions about one layer often drive the decisions about another layer, for example is case of data link layer and physical layer. Therefore, some people group these two layers together and call them 'hardware layers'. In case of transport layer and network layer, they are grouped and called 'internetwork layer'. The application layer, presentation layer, and session layer are grouped and called 'application layer'.[1035] This could be seen in Table 1 below.

<table>
<tr><th>OSI Model</th><th>Internet Model</th><th>Groups of Layers</th><th>Examples</th></tr>
<tr><td>7. Application Layer</td><td rowspan="3">5. Application Layer</td><td rowspan="3">Application Layer</td><td rowspan="3">Internet Explorer and Web pages</td></tr>
<tr><td>6. Presentation Layer</td></tr>
<tr><td>5. Session Layer</td></tr>
<tr><td>4. Transport Layer</td><td>4. Transport Layer</td><td rowspan="2">Internetwork Layer</td><td rowspan="2">TCP/IP Software</td></tr>
<tr><td>3. Network Layer</td><td>3. Network Layer</td></tr>
<tr><td>2. Data Link Layer</td><td>2. Data Link Layer</td><td rowspan="2">Hardware Layer</td><td rowspan="2">Ethernet port, Ethernet cables, And Ethernet software drivers</td></tr>
<tr><td>1. Physical Layer</td><td>1. Physical Layer</td></tr>
</table>

***Table 1 Network models. OSI = Open System Interconnection Reference***[1036]

According to Table 1 above, the most important layer to be discussed for purpose of this study is the application layer. The application layer is the

[1034] Larry E.Jordan and Bruce Churchill, *Communications And Networking For The PC* (5th ed. edn, New Riders 1994) p89

[1035] Jerry Fitz Gerald and Alan Dennis, *Business Data Communications* (10th ed. edn, John Wiley & Son (Asia) 2010) p19

[1036] Ibid p17

software that enables internet users to perform those useful online activities. The application layer is the reason for having the network and it is where the business value is incorporated.[1037] One reason is because users use those various types of network application software when they use the network and *'the only reason for having network is to enable these applications.'*[1038]

Generally, there are four types of fundamental application architecture for the functions of the application layer software: host-based architectures, client-based architectures, client-server architectures, and peer-to-peer architectures.[1039]

World Wide Web is an example of the two-tier client-server architecture. The communication occurs between the Web browser and Web server. In this architecture, the users make requests using the Internet Uniform Resource Locator (URL) for the pages they want, or they may click on a link that provides URL on the Web server[1040]. The client software then accepts the requests and performs the application logic of the database requests which will be transmitted to the servers. The requests must be in a standard protocol called Hypertext Transfer Protocol (HTTP) for the Web server to understand. After the server software accepts the database requests, the data access logic will be performed and the result will be sent to the client as an HTTP Response. The client software then accepts the results and presents them to the users in the form of the requested page or an error message.[1041]

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[1037] Ibid p39

[1038] Ibid p40

[1039] Ibid pp40-49

[1040] Such as Internet Explorer, Firefox, Safari or Google Chrome

[1041] Dennis p43, 49-50

This continuing process happens on every file transferred between the client and the server.[1042] Most importantly, this is technically and logically how the digital works are *published*[1043] online and made available *'to the public … in such a way that members of the public may access these works from a place and at a time individually chosen by them.'*[1044]

## C. PUBLICATION AND REPRODUCTION: ARE THEY DISTINGUISHABLE?

The above discussions confirm the importance of 'publication' in both internet and copyright scheme. It is the factor that defines copyright protection of a work, exclusive rights of the copyright owner, and exception to the acts that may cause copyright infringement. In other words, the publication (or not) status of a work could possibly open or restrict an opportunity for others to use those literary and artistic works freely or with a risk of copyright infringement. This is a very interesting characteristic of 'publication' in the copyright scheme.

When looking at the function and nature of the internet, publication also plays an important role for the network to function effectively. Without the function that allows 'publication' of those digital literary and artistic works on the internet, it is unlikely that the network will achieve its major purposes of being an open communication tool.

Since the purpose of this thesis is to find a room for the online individuals which could either be users and subsequent creators at the same time. It

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[1042] Ibid p50

[1043] This is the more general interpretation of the meaning of 'publication' for purpose of finding whether a copyright protection has been granted to a work, not in a narrower sense for the purpose of finding whether there is a violation of the right of first publication (distribution right). The difference between both cases has been discussed extensively in: Deborah R Gerhardt, 'Copyright Publication: An Empirical Study' (2011) 87 Notre Dame Law Review 135 pp152-154

[1044] WCT 1996, article 8 and WPPT 1996, article 10 and article 14

observed the objective of the online copyright protection for the benefits of individuals in the sense that the online copyright protection should 1) encouraging development of **creative expression** (originality and creativity) of the creator in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.' Also it seeks for a possible opportunity for those online individuals in the area of copyright law in order to achieve those purposes. The role and concept of 'publication' in the area of limitations and exceptions of copyright infringement is therefore an important and compulsory issue for the study.

In addition, the concept of 'reproduction' is another factor that causes significant affects in the angle of exception of copyright infringement. Principally, reproduction is one of the exclusive rights of the copyright owner. The unauthorised reproduction of a work by any person other than the copyright owner is forbidden and will be considered as copyright infringement. Nevertheless, reproduction is the first exclusive right that is officially permitted to be performed by others, if it was done lawfully, under article 9(2) of the Berne Convention. The other exclusive rights were allowed later under article 13 of TRIPs Agreement.

Article 9(2) of the Berne Convention, which is widely known as 'the three-step test', permits the reproduction of the works 1) in certain special cases, 2) provided that such reproduction does not conflict with a normal exploitation of the work, and 3) does not unreasonably prejudice the legitimate interests of the author. Article 13 of the TRIPs Agreement, however, applies such test to any of the exclusive rights of the right holder.

From the discussion above, since the 'right of first publication' is one of the exclusive rights of the copyright owner, it is, therefore, within the scope and

condition of the three-step test as well by virtue of Article 13 of the TRIPs Agreement.

Focusing on the online activity environment and the rights of the individual users as subsequent creators, it is important to fine a scope of the two acts that could be performed online: reproduction and publication. The distinction created between the two, if any, would be beneficial in order to draw a clear line between the two different types of the online activities of individuals. Most importantly, this is for purposes of applying the three-step test exceptions effectively in order to 1) encouraging development of **creative expression** (originality and creativity) of the creator in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'.

Whereas the three-step test exception is binding upon the copyright laws of member countries of WTO by virtue of article 13 of the TRIPs Agreement, each country, however, provides different system of limitations and exceptions under the scope of the three-step test.

For example, the exceptions of copyright infringement under the US copyright law came under the concept of Fair Use Doctrine[1045] while the UK permits various acts under the fair dealing exception. The following discussions will analyse the concept of publication and reproduction in relation to the different system of limitations and exceptions of copyright infringement provided in each country. Also it will look at the concept of publication and reproduction in the context of the internet.

[1045] Chapter I

### C.1. Publication and Reproduction in the Context of Copyright

The limitations and exceptions under section 107 of the US copyright law provide that *'the fact that a work is **unpublished** shall not itself bar a finding of fair use if such finding is made upon consideration of…' '… (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.'*

The UK, however, allows the inclusion of a short passage from a *published* work in a collection for purpose of educational use[1046], reprographic copying from *published* works by educational establishments[1047], copying parts of *published* works by librarians[1048], copying certain *unpublished* works by librarians or archivists[1049], public reading or recitation from a *published* work with a sufficient acknowledgement[1050], without infringing copyright of the right owner.[1051]

#### (i) Publication

Under section 101 of the US copyright law, it is provided that 'publication' means *'the distribution of **copies or phonorecords** of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute **copies or phonorecords** to a group of*

[1046] CDPA 1988, section 33

[1047] CDPA 1988, section 36

[1048] CDPA 1988, section 39 and 41

[1049] CDPA 1988, section 43

[1050] CDPA 1988, section 59

[1051] CDPA 1988, section 28

*persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.'*

Section 106(3) provides that the exclusive rights of the right owner include the right *'to distribute* ***copies or phonorecords*** *of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending'.* Therefore the distribution right under this section is sometimes referred to as 'the right of first publication' of the copyright owner.[1052]

First of all, it could be seen from the above meaning given under the Act that the meaning of 'publication' under the US copyright law is tied strictly to the distribution of the 'tangible medium' that contains the work. This is related to what Nimmer provided in his work that 'that *'publication occurs when by consent of the copyright owner, the original, or* ***tangible copies****, of a work are sold…'*[1053] Therefore, the dissemination of a work via intangible medium such as making available to the public on a network may not considered publication and therefore does not violate the right of distribution (the right of first publication) of the right owner.[1054]

Furthermore under factor two[1055] of the Fair Use doctrine, 'publication' status of a work is one factor that court should consider before finding fair use, in order to find a balance on *'public's interest in the dissemination of information'*.[1056]

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[1052] *Salinger v. Random House, Inc.*

[1053] Nimmer, 'Copyright Publication' p187 (emphasis added)

[1054] *Perfect 10, Inc. v. Amazon.com, Inc.*, see also *'Nat'l Car Rental sys., Inc. v. Computer Assocs. Int'l, Inc.'* 991 F.2d 426, 434 (8th Cir. 1993), and *'Atl. Recording Corp. v. Howell'* 554 F Supp. 2d 976, 983 (D. Ariz. 2008)

[1055] 17 USC § 107 (2) the nature of the copyrighted work

[1056] Beebe p612 referred to Brett M. Frischmann and Mark A. Lemley, 'Spillovers' (2007) 107 Columbia Law Review 257 pp286-290

It appears from the study above that the fact that a work of the copyright owner has been *published* has increased the chance of the defendants to succeed in fair use defences.[1057]

For the *unpublished* work only, the results found in Barton Beebe's study are in correspondence with what was proposed in a previous study by Pierre N. Leval that, in finding fair use, the fact that the original work was *unpublished* should be of small relevance, unless such work was created for or on its way to publication. From the copyright owner's side, according to Judge Leval, the second factor of fair use should be interpreted in a way that protect the works of the copyright owner which are intended for publication rather than the private memo that the owner do not intend to share with public.[1058]

When considering factor two for purpose of finding fair use, the court tends to look mostly on the publication from the copyright owner's side rather than form the defendant's such as in *Harper & Row*[1059] and *Salinger*[1060]. However, it is noteworthy that, in order to succeed in a copyright infringement case, the copyright owners also have to prove that *'1) a work is protected by copyright,* ***2) another party violated one of the exclusive rights granted by copyright laws,*** *and 3) no defence, such as fair use, protects the defendant conduct.'*[1061]

In light of the right of first publication, in proving the second element, sometimes the court will look at the defendant's side in order to decide whether such acts constitute an unauthorised publication. In determining that

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[1057] Ibid p614

[1058] Leval, 'Toward A Fair Use Standard' pp1117-1119

[1059] *Harper & Row v. Nation Enterprises*

[1060] *Salinger v. Random House, Inc.*

[1061] Gerhardt p152 (emphasis added by author)

issue the court will focus on the defendants' conducts whether those acts constitute actual dissemination or publication of the work. The interpretation of the meaning of 'publication' in this case is narrow that sometimes if a defendant just offered to publish a work but not yet really published it, that will not be considered as publication, and therefore does not violate the distribution right or the right of first publication of the copyright owner.[1062]

Applying the reasoning above to the online activity context, it is therefore suggested that, under the US copyright law the meaning of publication is tied strictly with the actual distribution of the *tangible medium* that contains the work. However, there is a room for interpretation the meaning of publication in the online activity environment in the ways that 1) *protect the works of the copyright owner which are intended for publication rather than the private memo or unpublished work that the owner do not intend to share with public* and *2)focus on the defendants' conducts whether those acts constitute actual dissemination or publication of the work rather than on the copyright owner's side whether such work has already been published.* This is even though the meaning of publication provided under section 101 and 106 (3) may not cover the act of 'making available to the public on demand'.[1063]

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[1062] Ibid pp153-154 at footnote 100 and 102 which referred to *Atlantic Recording Corp. v. Howell* 554 F.Supp.2d 976 at 985,987

[1063] WCT 1996, article 8, WPPT 1996, article 10 and 14. See also Jane C. Ginsburg , 'Re: Comments of Professor Jane C. Ginsburg - Study on The Right of Making Available Docket No. 2014–2' *(7 April 2014)*<http://copyright.gov/docs/making_available/comments/docket2014_2/Jane_Ginsburg.pdf > accessed 6 July 2015 and Jane C. Ginsburg , 'Re: Comments of Professor Jane C. Ginsburg – Study on the Right of Making Available; Request for Additional Comments Docket No. 2014–2' *(3 September 2014)*<http://copyright.gov/docs/making_available/comments/docket2014_2/reply/Ginsburg_Jane.pdf> accessed 6 July 2015

In the UK copyright law, on the other hand, since the European Union has adopted article 8[1064] of the WIPO Copyright Treaty to article 3(1)[1065] of the 2001 Information Society Directive, and the UK has also implemented the European Directive 93/98/EEC to its copyright law, it is therefore provided under the UK copyright law that publication *'includes **any communication to the public**, in particular— (a)the issue of copies to the public; (b)making the work available by means of an electronic retrieval system; (c)the rental or lending of copies of the work to the public; (d)the performance, exhibition or showing of the work in public; or (e)broadcasting the work or including it in a cable programme service'*[1066]. The right is also applicable to the copyright owner as well by virtue of section 17 (1).[1067]

According to the discussion above, in could be inferred from the standard of both the US and the UK copyright law that, firstly, in light of the meaning of publication, under the US copyright law publication means only the distribution of tangible medium that contains the work, whereas, in the UK, publication includes any mean of communication to the public.

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[1064] WCT 1996, article 8 *'Without prejudice to the provisions of Articles 11(1) (ii), 11bis(1)(i) and (ii), 11ter(1) (ii), 14(1)(ii) and 14bis(1) of the Berne Convention, authors of literary and artistic works shall enjoy the exclusive right of authorising any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them'*

[1065] WCT 1996, article 3 *'Right of communication to the public of works and right of making available to the public other subject-matter 1. Member States shall provide authors with the exclusive right to authorise or prohibit any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them.'*

[1066] Section 16(1) of The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC

[1067] Section 17 (1) of The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC — The substantive provisions of Part I relating to copyright (but not moral rights in copyright works), that is, the relevant provisions of— Chapter II (rights of copyright owner), Chapter III (acts permitted in relation to copyright works), Chapter V (dealings with rights in copyright works), Chapter VI (remedies for infringement), and Chapter VII (copyright licensing), apply in relation to publication right as in relation to copyright, subject to the following exceptions and modifications.

Secondly, under the US copyright law it is possible to interpret the meaning of publication in the ways that 1) *protect the works of the copyright owner which are intended for publication rather than the private memo or unpublished work that the owner do not intend to share with public* and *2)focus on the defendants' conducts whether those acts constitute actual dissemination or publication of the work rather than on the copyright owner's side whether such work has already been published.*

**(ii) Reproduction**

While 'publication' under section 101 of the US copyright law means 'selling, transferring of ownership, rental, lease, or lending the **copies or phonorecords** of a work to the public', section 106 provides that the owner of copyright has the exclusive rights to *'reproduce the copyrighted work **in copies or phonorecords**'*[1068]and *to 'distribute **copies or phonorecords** of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending'*[1069]

Also section 107 allows the fair use of a copyrighted work, including such use by **reproduction in copies or phonorecords** if it is proven that such use complied with all the four factors which are *'(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work;(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.'*

Thereby, under the US copyright law, a distinction has been created between 'reproducing a work in copies or phonorecords' and 'distributing

[1068] 17 USC § 106 (1)

[1069] 17 USC § 106 (3)

copies or phonorecord that contains the copyrighted work'. Or in other words, there is a distinction between 'the act of reproduction' and 'the act of publication' under the US copyright law. Most importantly, both activities are tied strictly with the act that directly affects the tangible medium that contains the work.

Under the UK copyright law, publication means *'**any communication to the public**, in particular— (a) the issue of copies to the public; (b)making the work available by means of an electronic retrieval system; (c)the rental or lending of copies of the work to the public; (d)the performance, exhibition or showing of the work in public; or (e)broadcasting the work or including it in a cable programme service'*[1070].

The meaning of publication above complies with section 18 to 20 of the UK copyright law, which provide the exclusive right of issuing of copies to the public[1071], rental or lending of work to the public[1072], performance, showing or playing of work in public[1073], and communication to the public[1074].

The exclusive right of copying, however, is provided under section 17 which covers the relevant acts under the online activity context which are: 1) reproducing the work in any material form[1075], 2) storing the work in any

[1070] Section 16(1) of The Copyright and Related Rights Regulations 1996 which implemented the European Directive 93/98/EEC

[1071] CDPA 1988, section 18

[1072] CDPA 1988, section 18A

[1073] CDPA 1988, section 19

[1074] CDPA 1988, section 20

[1075] CDPA 1988, section 17(2)

medium by electronic means[1076] , and 3) making a photograph of the whole or any substantial part of any image forming part of the film or broadcast[1077].

Accordingly, it could be inferred from the above discussion that the UK copyright law offers a separation between the act of reproduction and publication, whereas the act of 'publication' includes any act of communication to the public, either via dissemination of tangible medium that contains the work or broadcasting or making the work available by electronic means.

The act of reproduction, on the other hand, covers any act of making copies of the work, either in material form or by electronic means.

Applying the UK standard to the online activity environment, a distinction has therefore been created between the act of making reproduction of a work in RAM[1078] and making publication of the work online by means of communication to the public[1079] or making available on demand[1080].

### C.2. Publication and Reproduction in the Context of the Internet

As discussed earlier, there is a separation between the act of reproduction and publication under the copyright laws of both the US and the UK. One difference is that under the US copyright law, both acts are tied strongly with the tangible medium that contains the work, whereas under the UK, both acts include the act of communication to the public via electronic means.

[1076] CDPA 1988, section 17(2)

[1077] CDPA 1988, section 17(4)

[1078] Article 2 of the Directive 2001/29/EC

[1079] Article 3 of the Directive 2001/29/EC

[1080] Article 3 of the Directive 2001/29/EC

The study will emphasise that such distinction appears not only in the mechanism of the law itself, but also within the structure of the internet technology, which would be discussed in details as follows:

**(i) Reproduction**

According to previous discussions, the communication on most websites functions on the model of 'client-server architecture'[1081]. This model contains, first, the client microcomputer which performs presentation logic[1082], and second, the server microcomputer or mainframe which is responsible for data access logic[1083] and data storage[1084]. The application logic[1085] could either be located on the client or the server.

There are also many sites which communicate via the peer-to-peer architecture. In this model, all computers are both a client and a server and perform all four functions of the application program: presentation logic, application logic, data access logic, and data storage.[1086]

By this process, the act of reproduction occurs whenever a work is introduced into a computer memory[1087]. For this purpose, 'memory' means any type of computer data storage, whether it is *'volatile (disappears when*

[1081] Dennis p49

[1082] *'The Presentation Of Information To The User And The Acceptance Of The User's Commands'* ibid p40

[1083] *'The Processing Required To Access Data, Which Often Means Database Queries In SQL (Structured Query Language)'* ibid p40

[1084] *'The Data Which Is To Be Stored And Retrieved Whether A Small File Or A Large Database'* ibid p40

[1085] *'Could either be simple or complex, depending on the application'* ibid p40

[1086] Ibid p47

[1087] *Final Report of the National Commission on New Technology Uses of Copyrighted Works (CONTU)* (Library of Congress, Washington, DC, 1979) p40

*the computer is shut down, for example RAM) or not (remains after shut-down, for example a hard disk).'*[1088]

**(ii) Publication**

A work which is introduced to the computer data storage will later be represented to the user on the client computer. The client computer will need to install the application layer software called 'Web browser'. The 'Web browser' will communicate with the application layer software called 'Web server' on the server computer using the HTTP standard protocol. If the communication functions properly, the work stored in the data storage will be represented on the requested page.[1089] This is where the act of 'publication', or in other words the 'communication to the public'[1090], occurs.

## D. REPRODUCTION AND MAKING ADAPTATION: THE OVERLAPPING ACTIVITIES

According to the discussion above, to draw a separation between 'reproduction' and 'publication' in the online activity is important because it will help create a distinction between the act of 'making adaptation' and the act of 'publication' of the derivative works online as well. From the previous discussion in chapter I, it is certified that the act of reproduction and making adaptation are overlapped. This is as Nimmer provided that *'A work is not derivative unless it has substantially copied from a prior work'*.[1091] That overlapping status creates one important issue in the online environment in

[1088] Niels Schaumann, 'Copyright Infringement and Peer-to-Peer Technology' (2002) 28 William Mitchell Law Review 1001at footnote 93

[1089] Dennis p50

[1090] WCT 1996, article 8

[1091] Nimmer, *Nimmer on copyright : a treatise on the law of literary, musical and artistic property, and the protection of ideas* § 3.01

the sense that the online users will not be able to produce a derivative work without making reproduction of an online digital work beforehand. Making reproduction of a digital work is the first step that users will create a copy of such work for purpose of making adaptation afterwards.[1092]

Other important issues from chapter I are the four unanswered important questions, which are:

1) After making reproduction of a work from the internet, whether making change to the work on a user's computer without saving it to a hard disk is qualified as copyright infringement of the right of making derivative work of the author?

2) Why the exception of 'technological purposes' is applied only to the right of making reproduction of the work and not to the right of making adaptation of a work?

3) Since the right of reproduction and the right of making derivative work are overlapped; while the act of making temporary reproduction for technological purposes is excused from liabilities, is it possible that such exceptions be allowed for temporarily making derivative work in RAM as well?

4) In either case, whether the work is saved or not saved to hard drive, any of such acts of making derivative work is defendable under the fair dealing or fair use doctrine?

The discussion in this section attempt to answer all the four questions above based on the nature of the four major types of works which could be digitised and disseminated on the internet which were previously discussed in chapter III: literary works, musical works, audiovisual works, and images. These works are made available online by various means such as *web browsing, file sharing, uploading and downloading, linking,* and *streaming.*

[1092] See chapter I

### D.1. Reproduction and Making Adaptation

#### (i) Temporary Reproduction

First of all, literary works, musical works, audiovisual works, and images will appear to the hearing and the vision of the internet users via the first step of *web browsing. Web browsing* is the first channel every of those aforementioned works will be temporarily reproduced or *fixed* in RAM for the specific purpose of making the works available to the acknowledgement of individual internet users.

For some specific types of work such as musical and audiovisual works, the technology of *streaming* is also required after *browsing* the website so that finally the works could be successfully delivered to the users. In this latter case, RAM is an important function for musical and audiovisual works to be temporarily stored in order to be further *streaming.* As discussed earlier, these all processes are *'the only reason for having network'*[1093]*.*

Therefore, based on the RAM Copy Doctrine which specified that the work temporarily stored in RAM is *fixed,* an exception to copyright infringement is created in order to allow such 'temporary reproduction for technological purpose' to be able to function without being copyright infringement.[1094]

### D.2. Other General Reproduction

After *browsing* and *streaming*, some of the internet users may make another reproduction of those literary works, musical works, audiovisual works, and images by means of *downloading.* Generally, there are several important points to be mentioned about the mean of *downloading*:

[1093] Dennis

[1094] Article 5(1) of Directive 2001/29/EC and Recital(33) of the Directive, see also section 512 (a) of US DMCA and article 12-14 of EC E-commerce Directive and Bogden pp197-198

First of all, as discussed in chapter III, the users will be able to *download* almost every online digital literary works, musical works, audiovisual works, and images that are not protected by DRM technology. Most literary and audiovisual works published online by publishers are DRM protected whereas some which are published by individual authors may be not. It is only the musical works that most of them are DRM-free and the images which some are protected by means of disabling of Right-Click function. In either case the users could anyway find a way to circumvent such technologies and start their way of *downloading* as discussed in chapter III.

Secondly, some *downloads* include payments to the right owner and some do not. Most of literary works, musical works, audiovisual works, and images which are available for *download* with payment to the right owner are not *sold* but *licensed* to the users and subject to contract as discussed in chapter III. For these kinds of work, even though the users legally *download* the works, they still do not have any *ownership* over any of those digital works.

Thirdly, as for the *downloads* that do not include payment to the right owner, it is very likely that the users are making reproduction of those digital literary works, musical works, audiovisual works, and images without authorisation of the right owner. They will also never be able to have any *ownership* over those digital works.

Fourthly, as for some specific works which are *streaming* online such as musical and audiovisual works, as discussed in chapter III, technically these works could not be *downloaded*. However, the users could make reproduction of those musical or audiovisual works by means of *recording.* Or they may reproduce those images appear online or in audiovisual works by mean of *screen capturing*. The act of *recording* and *screen capturing* mostly

constitutes reproduction without authorisation of the right owners and therefore could be considered as unlawful making reproduction.

Finally, in case of *download,* the act of reproduction was done successfully when those literary works, musical works, audiovisual works, and images are temporarily *fixed* in RAM at the time they are *downloaded* regardless of whether they are saved to the users' hard disks or not. In case of *recording* and *screen capturing*, technically the works are automatically saved to the users' hard disk and therefore they are automatically *fixed.* That also automatically constitutes making reproduction.

Therefore, it could be summarised that the act of making reproduction occurs every time the users *download, record,* or *screen capture* those online digital literary works, musical works, audiovisual works, and images. This is regardless of whether such *downloading, recording,* or *screen capturing* offer payment (*licensed*) to the right owner or not and whether such *downloading, recording,* or *screen capturing* happen via *browsing*, *streaming,* or *file sharing* technology.

One important thing is that those *downloading, recording,* and *screen capturing* which offer payment (*licensed*) to the right owner will likely be considered 'lawful' making reproductions. But if such *downloading, recording,* or *screen capturing* do not include payment to the right owner it is likely that they will constitute an 'unlawful' making reproduction due to the lack of consent of the right owners.

In either case the users that *download, record,* or *screen capture* the online digital literary works, musical works, audiovisual works, and images do not have any *ownership* over the works *downloaded*, *recorded,* or *screen captured*. And most importantly, this act of unauthorised or 'unlawful' making reproduction by means of *downloading, recording,* and *screen capturing* are

not covered by the exception of the RAM Copy Doctrine and therefore are not exempted from copyright infringement.

### D.3. Making Adaptation

The act of making adaptation and making reproduction are overlapped, as discussed earlier in chapter I. First of all, one important requirement for a subsequently created work to be satisfied as derivative work is that it needs to borrow substantial parts from the original work. That is the act of reproduction. Generally, from chapter I there are two types of derivative work: 1) Derivative works which are indistinguishable from the prior work, and 2) Derivative works which are distinguishable from the prior works. It is important to note that regardless of whether they are distinguishable from the prior works, one thing that every derivative work need is the reproduction of the original work. If there is no reproduction of an original work, it is not likely that a work will be considered as derivative work.

The nature of the reproduction of the original work is also an important factor that defines copyright protection granted to derivative works. If such reproduction or use of substantial parts of the original work receives official consent from the right owner of the original work, it is suggested that the copyright protection could be granted to that derivative work subject to the agreement between the right owner and the subsequent creator.[1095]

However, in case of unauthorised reproduction or unauthorised use of substantial parts of the original work, in both the US and UK jurisdiction, copyright protection will not be granted to those parts of derivative work which are solely reproduction of the original work and thus do not contain any

[1095] See chapter I

originality or creativity of the subsequent creator. The only parts that could be granted copyright protection are the newly created parts.[1096]

Most importantly, it is also noteworthy that if such making adaptation of a work occurs without authorisation of the right owner that will be infringing of 'the exclusive right of making adaptation of the copyright owner'. *In this scenario, an act of unauthorised reproduction or unauthorised borrowing of substantial parts of the original work is the fundamental factor that defines an unauthorised making adaptation of the work.* In the UK, if there is such unauthorised reproduction or unauthorised borrowing of substantial parts, that act of making derivative work will be considered as infringement of 'the exclusive right of making adaptation of the copyright owner' and will not be possible to be granted copyright protection.

Under the US jurisdiction, unless an unauthorised borrowing of substantial parts of the original work is 'lawful' under the fair use doctrine, that act of making derivative work will likely be considered as infringement of 'the exclusive right of making adaptation of the copyright owner' and thus will not be possible to be granted copyright protection.

**Making Adaptation under Online Environment**

Under online activity environment a reproduction of digital literary works, musical works, audiovisual works, and images could be made, first of all, from the act of *browsing* which is a reproduction for technological purpose and thus could possibly be exempted from copyright infringement based on the RAM Copy Doctrine.

Nevertheless, since RAM is a temporary storage in which the digital information will be stored only in a short period of time primarily for the computer to function, those information stored in RAM will all disappear after

[1096] See chapter I

the computer is turned off. Therefore there is no reproduction of digital literary works, musical works, audiovisual works, and images left long enough for making adaptation later, unless these works are made to be stored longer in other kind of data storage such as a hard disk.

In order to make digital information be stored longer in data storage such as hard disk that requires making reproduction of such information by means of *downloading, recording,* and *screen capturing*. Then the information is required to be saved to hard disk so that they could be made to be reappeared later even after the computer is turned off. It is suggested in chapter I that these acts of *downloading, recording,* and *screen capturing* are not mainly for purpose of the functioning of the computer therefore they could not benefit from the exceptions of the RAM Copy Doctrine.

Most of online reproduction of literary works, musical works, audiovisual works, and images by means of *downloading, recording,* and *screen capturing* happen without authorisation of the right owner as suggested in chapter I. This is due to the nature of the internet activity. And since these acts are not exempted from infringement based on the RAM Copy Doctrine therefore they would all likely be considered as copyright infringement unless they are falling under the scope of the fair use doctrine.

Making adaptation online requires making reproduction or borrowing substantial parts of digital literary works, musical works, audiovisual works, and images by means of *downloading, recording,* and *screen capturing.* Whereas these acts of making reproduction or borrowing substantial parts by means of *downloading, recording,* and *screen capturing* mostly happen without authorisation of the right owner and are not exempted from copyright infringement, the act of making adaptation afterwards thus also happen without authorisation of the right owner, and that will be considered as

infringing 'the exclusive right of making adaptation of the copyright owner' as well without any exception, as discussed earlier.

These basically answer the three questions mentioned above as follows:

**a. After making reproduction of a work from the internet, whether making change to the work on a user's computer without saving it to a hard disk is qualified as copyright infringement of the right of making derivative work of the author?**

**Yes.** This is because generally there are two types of making reproduction: first, the making reproduction for technological purpose by mean of *browsing* which the work is temporarily *fixed* in RAM under the RAM Copy Doctrine which is exempted from copyright infringement. Second is the making reproduction of work by mean of *downloading, recording,* and *screen capturing* which allow the reproduction of the work to stay longer in computer data storage.[1097] These acts of reproduction do not occur for technological purpose and are not exempted from copyright infringement thus they will constitute copyright infringement if they are performed without authorisation of the right owner.

**Making change to the work on a user's computer without saving it to a hard disk** also requires making reproduction of work by mean of *downloading, recording,* and *screen capturing.* These acts of reproduction do not occur for technological purpose and are not exempted from copyright infringement therefore they will constitute copyright infringement if they are performed without authorisation of the right owner. In case that the act of making reproduction is infringement, the act of making derivative work will

[1097] In case of *downloading* the reproduction will be entirely complete only when the work is saved (*fixed*) into the hard disk. See chapter I.B.

also be infringement of 'the exclusive right of making adaptation of the copyright owner' regardless of whether that derivative work is save to the hard disk or not.

**2) Why the exception of 'technological purposes' is applied only to the right of making reproduction of the work and *not* to the right of making adaptation of a work?**

The study suggests that **the exception of 'technological purposes' is applied only to the right of making reproduction of the work and *not* to the right of making adaptation of a work** because according to the current internet and computer technology, the act of making adaptation of online digital work is not the act that directly involve the function of the computer. This is similar to other type of making reproduction of work such as *downloading, recording,* and *screen capturing* which are not exempted from copyright infringement as well. This is due to the fact that these kinds of reproduction do not directly involve the function of the computer as *browsing*. This is even though these acts are frequently performed by internet users as parts of reaching to those online digital works.

**3) Since the right of reproduction and the right of making derivative work are overlapped; while the act of making temporary reproduction for technological purposes is excused from liabilities, is it possible that such exceptions be allowed for temporarily making derivative work in RAM as well?**

**No.** Because, in fact, the online digital literary works, musical works, audiovisual works, and images will need to be reproduced by means of *downloading, recording,* and *screen capturing* before they could be modified on a computer as derivative works. It is not possible that merely *browsing*

those works in RAM could create a reproduction of such works that last long enough for modification.

Accordingly, when the exception of temporary reproduction for technological purposes is applicable to only unauthorised *browsing* but not for unauthorised *downloading, recording,* and *screen capturing*, it is thus not applicable to unauthorised making derivative work as well whether or not that derivative work is stored only in RAM.

From the discussion above, it is suggested that an unauthorised making adaptation of online digital work will create copyright infringement of 'the exclusive right of making adaptation of the copyright owner' every time the works are unauthorised *downloading, recording,* and *screen capturing* and then made change without authorisation of the right owner. There is no other exception than the three-step test applicable in this case.

The next question remains unanswered is **'in either case, whether the work is saved or not saved to hard drive, any of such acts of making derivative work is defendable under the fair dealing or fair use doctrine?'**

Under the UK jurisdiction, it appears from the discussion in chapter I that an unauthorised borrowing of substantial parts of the original work by means of *downloading, recording,* and *screen capturing* which later constitutes an unauthorised making adaptation of the work will likely be considered as infringement of the 'the exclusive right of making adaptation of the copyright owner'. The major exceptions under the fair dealing concept (which follows the standard of TRIPs three-step test) such as 1) a fair dealing for the purposes of research or private study, 2) a fair dealing for the purposes of criticism or review, and 3) a fair dealing for the purposes of reporting current event, could not be applied to such act. Therefore, under the

UK jurisdiction such acts of unauthorised making derivative work is *not* defendable under the fair dealing concept.[1098]

Under the US jurisdiction, it appears that the unauthorised borrowing of substantial parts of the original work which later constitutes an unauthorised making adaptation of the work could be defendable under the fair use doctrine. If such unauthorised borrowing of substantial parts is 'lawful' under the fair use doctrine it is possible that such unauthorised making adaptation of the work will be exempted from copyright infringement of 'the exclusive right of making adaptation of the copyright owner'.[1099] For this purpose, one factor which plays an important role to allow 'unauthorised borrowing of substantial parts of the original work' and 'unauthorised making adaptation of the work' is the concept of 'transformativeness'.[1100]

Under the four fundamental factors of the fair use doctrine[1101] 'transformativeness' is one sub-factor of factor (1); the purpose and character of the use, for the court to be considered. According to the study in chapter I it is likely that the 'transformativeness' sub-factor should be weighted in higher importance than the factor of commercial use and market injury under factor 4).[1102]

However, even though the sub-factor of 'transformativeness' should be weighted in higher importance than the sub-factor of commercial use, the

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[1098] See chapter I A. and D.

[1099] See chapter I A. and D.

[1100] See chapter I A. and D.

[1101] 17 USC § 107 '*1) The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purpose; 2) The nature of the copyrighted work; 3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and 4) The effect of the use upon the potential market for or value of the copyrighted work.'*

[1102] See chapter I D.

circumstance whether a derivative work is 'transformative' is, in fact, difficult to prove. There are still another two important aspects in respect of 'transformativeness' that needed to be considered by the court: 1) whether such quotation transforms the original work and support the different purposes of the subsequent author, 2) such secondary work must not supersede the original work or offer itself as a substitute of the original work. These two aspects, at least, result in the exclusion of some type of derivative works which are seen as not 'transformative' enough such as *satire* and provide some uncertainty in case of *parody* and *internet meme*.[1103]

Therefore it could be primarily answer that**, whether the work is saved or not saved to hard drive, the acts of unauthorised making derivative work by making unauthorised *downloading, recording,* and *screen capturing* online is possibly defendable under the concept of 'transformativeness' of the fair use doctrine.** This is a kind of 'lawful use' which is allowed under the fair use doctrine of the US copyright law. Nevertheless, the two general characteristics of 'transformativeness' as specified above is yet difficult to prove for many kinds of online digital derivative works in order to meet such qualification of 'lawful use' so that they could be exempted from copyright infringement.

Since at present only the concept of 'transformativeness' under factor (1) of the fair use doctrine alone could not effectively allow sufficient opportunity for creations in the online digital environment as discussed earlier[1104], it is therefore required for this study to consider the other two factors of the fair use doctrine in order to find some better answers for the

[1103] See chapter I D.

[1104] See chapter I D.

above question. These two factors have often been ignored although they could as well create a significant impact to the exception of copyright infringement. These factors are: factor (2) the nature of the copyrighted work, and factor (4) the effect of the use upon the potential market for or value of the copyrighted work.

First of all, factor 2) consists of approximately two sub-factors: 1) The Creative/Factual Work Inquiry and 2) The Published/Unpublished Work Inquiry.[1105] According to this study, it is the sub-factor 2) of factor 2): *'The Published/Unpublished Work Inquiry'* which is relevant and therefore important to be considered in light of making adaptation of digital works in the online digital environment context. This sub-factor will lead to the discussion about the 'publication' of online digital original and derivative works in the online digital environment as follows in the next issue.

### D.4. Publication

It has been discussed earlier that the publication of the online digital work, whether they are literary works, musical works, audiovisual works, or images, occurs at the final stage of the application layer.[1106] Technically, this is the purpose and reason of having the network.[1107]This means that under online activity environment all the prior technical processes will not be successful and completed without the final process of 'publication' of the online digital literary works, musical works, audiovisual works, and images to the reach of the users. This is called the act of 'making available to the public'

[1105] See chapter I D.

[1106] See Figure 4 and Table 1

[1107] Dennis p40

which lies within the concept of 'communication to the public' under the WIPO Copyright Treaty.[1108]

Nevertheless, the study in previous sections discusses in particular about the process of making reproduction and making adaptation under the online activity environment but have not yet mentioned about publication. This is because publication is a separate concept and process as certified above.

Whereas the process of making reproduction and making adaptation under online activity environment is overlapped by means of *downloading*, *recording*, and *screen capturing*, publication of online digital literary works, musical works, audiovisual works, and images, however, could be done by means of *uploading* whether or not via *streaming* or *file sharing* technology*. Linking,* on the other hand*,* does not constitute publication or 'making available to the public' because it is not *'directed at a new public'* according to the ECJ decision in *Svensson*[1109].

While the original authors or creators of the work own *'authorship',* and the publishers possess *'ownership'* over the work of creation, the study in chapter III suggests that they also hold the exclusive right of publication or 'making available to the public'. This is due to the fact that the creators and the publishers are the only persons who can make publication of those online digital literary works, musical works, audiovisual works, and images by means of *uploading* or *streaming.*

The online users, however, do not have such right of publication.

[1108] WCT 1996, article 8

[1109] *Svensson and others v Retriever Sverige AB*

However, since the internet technology now offers the communication under of user-generated content (UGC) or user-created content (UCC) environment it is likely that every internet user are making publication all the time.[1110] Those digital literary works, musical works, audiovisual works, or images which are published online via internet users by means of *uploading* or *streaming* could either be the works which are a) newly created or b) obtained online by mean of *downloading*, *recording*, or *screen capturing* whether with or without authorisation of the original creators or publishers. Most *downloading*, *recording*, or *screen capturing* without authorisation of the original creators or publishers constitute unauthorised reproduction. If such digital works are modified, then the modification will constitute unauthorised making adaptation.

In light of making adaptation of these digital works, the question remains unanswered is that **'in either case, whether the work is saved or not saved to hard drive, any of such acts of making derivative work is defendable under the fair dealing or fair use doctrine?'**

Although 'transformativeness' under factor (1) of fair use doctrine might be one of the answer as discussed earlier, it is yet not an effective tool.

In fact, in light of making adaptation of the digital works in the user-generated content (UGC) or user-created content (UCC) environment the question that '**whether the work is saved or not saved to hard drive'** might not be the right question. The question that should rather be asked for the benefit of online users in the UGC-UCC environment is that **'if yet those modified works are not published online by means of *uploading* or *streaming*, will such act of making adaptation constitute infringement to any of the exclusive rights of the copyright owners.'**

[1110] See chapter III

Hence, this is where sub-factor 2) of factor (2) *(The Published/Unpublished Work Inquiry)* and factor (4) *(The effect of the use upon the potential market for or value of the copyrighted work)* of the US fair use doctrine are reunited when considering copyright infringement in light of making adaptation of an online digital work.

First of all, if such unauthorised reproduction and adaptation of digital literary works, musical works, audiovisual works, or images occur without any publication of the work to the public by means of *uploading* or *streaming*, there is possibility under *'The Published/Unpublished Work Inquiry'* to interpret the meaning of 'publication' in a narrow sense that sometimes if a defendant just offered to publish a work but not yet really published it, that will not be considered as publication, and therefore does not violate the distribution right or the right of first publication of the copyright owner. This is the interpretation of the meaning of publication which *focus on the defendants' conducts whether those acts constitute actual dissemination or publication of the work rather than on the copyright owner's side whether such work has already been published*, as discussed earlier in this chapter.[1111]

Secondly, in the scenario that the modified works has yet been published, also they have yet been reached to the accessibility of the public and thus do not constitute any infringement of the exclusive right of 'making available to the public' of the original authors and publishers (as the copyright owners), in this case factor (4) *(The effect of the use upon the potential market for or value of the copyrighted work)* will come to play an important role.

[1111] Gerhardt pp153-154 at footnote 100 and 102 which referred to *Atl. Recording Corp. v. Howell* 554 F Supp. 2d at 985, 987 (see supra note 1062)

It could be inferred in this case that since the modified work has yet been making available to the public therefore there is no infringement of the exclusive right of 'making available to the public' of the copyright owners. Thus, if there is no infringement of the exclusive right of 'making available to the public' of the copyright owners, there is very little effect on the use upon the potential market for or value of the copyrighted work upon making unauthorised reproduction and adaptation of the digital of literary works, musical works, audiovisual works, or images without making any publication.

According to the study, it is this factor (4) that provides significant effect on the outcome of the overall fair use test.[1112]

Therefore, considering all the four factors of the fair use doctrine altogether, **whether the work is saved or not saved to hard drive, the acts of unauthorised making derivative work by making unauthorised *downloading, recording,* and *screen capturing* online is possibly defendable, not only under the concept of factor (1), the 'transformativeness'[1113] of the fair use doctrine, but also under sub-factor of factor (2), 'the published/unpublished work inquiry', and factor (4) the effect of the use upon the potential market for or value of the copyrighted work.** This is based on the fundamental idea that such adaptations of works are not made available to the public by means of *uploading* or *streaming* for the accessibility of the online public users.

[1112] Beebe pp616-621 and Chapter I

[1113] *'1) Whether such quotation transforms the original work and support the different purposes of the subsequent author and 2) such secondary work must not supersede the original work or offer itself as a substitute of the original work'* See Supra note 1103

## III. ONLINE CREATORS AND USERS: THE TWO PERSONS WHICH ARE INDISTINGUISHABLE

According to the discussion in chapter III, it emphasised that the original authors or creators of a work are the persons who have an *'authorship',* and the publishers are the persons who possess an *'ownership'* over the work of creation. In fact, there are differences between the two concepts under the copyright regime. *'Authorship'* is solely for the persons who contribute their 'genius' or their 'originality and creativity' to the creation of the work and thus they can have the exclusive rights over such creation. These are the authors or creators. On the other hand, *'ownership'* is conferred to the persons or legal entities who contribute to making such works of creation available to the public. These legal entities or persons may own copyright over the work of creation and have exclusive rights as a 'copyright-like property right'[1114] while they are acting as publishers.[1115]

In chapter II, it is emphasised that these individuals who are capable of contributing their originality and creativity to the work of creation are the major players in the online environment.[1116] Furthermore, it is also reaffirmed in chapter III that, under the user-generated content (UGC) or user-created content (UCC) environment it is not the publishers but the individual users who play an important role on the creation of online digital literary works, musical works, audiovisual works, and images by contribution of their *'certain amount of creative effort'*[1117]. When such *'a certain amount of creative effort'* is contributed to a work it could possibly transfer the status of such internet

[1114], 'Understanding Copyright And Related Rights'

[1115] See chapter III

[1116] See chapter II

[1117] See chapter III

users from the 'pure' user of a work to a 'mere' author or creator. Particularly in case of making adaptation of digital works online, the process that occurs in the UGC or UCC environment could be summarised step-by-step as follows:

## A. THE ONLINE AUTHOR OR CREATOR

### (i) Publication

First of all, as discussed earlier in chapter III, the online author or creator may publish the digital files of literary works, musical works, audiovisual works and images created by them by means of *uploading* or *streaming*. These digital files of the works will be available online for the reach of those online internet users. This act of *uploading* or *streaming* is guaranteed as the exclusive right of making available to the public of the online author or creator.

### (ii) Reproduction

In addition, it is the exclusive right of the online author or creator to make reproduction of their creations. Therefore those online authors or creators of the digital files of literary works, musical works, audiovisual works and images may make reproduction of those online digital works created and made available online (*uploaded* or *streamed)* by them by means of *downloading*, *recording*, or *screen capturing*. It is important to note that this act is limited to only those works created and made available online (*uploaded* or *streamed)* by themselves. If otherwise, in case they are using the work of others that will fall under the scope of the discussion in section B.(i).

### (iii) Making adaptation

Also, it is the exclusive right of the online author or creator to make adaptation of their creations. Therefore after making reproduction by means of *downloading*, *recording*, or *screen capturing,* those online authors or

creators of the digital files of literary works, musical works, audiovisual works and images may make adaptation of those online digital works created and made available online (*uploaded* or *streamed)* by them. It is also important to note that this act is limited to only those works created and made available online (*uploaded* or *streamed)* by themselves. If otherwise, in case they are using the work of others that will fall under the scope of the discussion in section B. (ii).

After making adaptation such online author or creator may again publish or make available those work adapted or modified by themselves to the public. When those digital files of the adaptation of literary works, musical works, audiovisual works and images are made available online (*uploaded* or *streamed)* by their original authors or creators, they are ready for any online users to make reproduction by means of *downloading*, *recording*, or *screen capturing* unless the files are protected by DRM.

## B. THE ONLINE USER AND SUBSEQUENT CREATOR

### (i) Reproduction

As discussed earlier, at the time those digital files of literary works, musical works, audiovisual works and images are made available online (*uploaded* or *streamed)* by their original authors or creators, they are ready for any online users to make reproduction by means of *downloading*, *recording*, or *screen capturing* unless the files are protected by DRM or by other means.

### (ii) Making adaptation

After making reproduction by means of *downloading*, *recording*, or *screen capturing,* those online users may make adaptation of those digital files of literary works, musical works, audiovisual works and images. This is

the process of adding *'a certain amount of creative effort'*[1118] which may result in the contribution of 'originality and creativity' which could allow the users a copyright protection as discussed earlier in chapter I. When *'a certain amount of creative effort'* or 'originality and creativity' were added to a work, it could possibly change the status of the online internet users from the pure users to the online subsequent creators. When users are subsequent creators it would allow them to possess '*authorship*' over the work of their creations.

**(iii) Publication**

After making adaptation, the online subsequent creators may publish or make available those works adapted or modified by them to the public. Those digital files of literary works, musical works, audiovisual works and images which have been modified will be again ready for any other online users to make reproduction by means of *downloading*, *recording*, or *screen capturing* unless the files are protected by DRM or making adaption afterwards.

It could be seen from this discussion above that, from the beginning of the process of making the works available to the public, those digital files of literary works, musical works, audiovisual works and images are in the status that ready for other online internet users to make reproduction, adaption and re-publication. It is impossible to separate between the original authors, users, and subsequent creators in the online activity environment unless there is a measure that could absolutely prevent the online users from *downloading*, *recording*, *screen capturing, making adaptation* and *publishing* the digital works created by other online original creators.

Technically, it not possible to prevent the online users from *downloading*, *recording*, *screen capturing, making adaptation* and *publishing* the digital

[1118] See chapter III

works created by other online original creators. Also that prevention is not allowable, because, as discussed previously in chapter II that these individual internet users, although at the status of pure users they do not have any '*authorship*' or 'ownership' over the work of creations, they are protected by 'the right to freedom of expression' advocated by the internet technology.

## IV. CURRENT SOLUTIONS

Since it is not possible to prevent the internet users from unauthorised using the online digital works created by others as mentioned earlier, there are attempts mostly to reduce the impact that these unauthorised uses would affect the benefits of the original authors.

### A. DIGITAL RIGHT MANAGEMENT

As discussed earlier in chapter III, the DRM or Digital Right Management is one popular way of protecting the unauthorised reproduction of the work of creation of the copyright owners. Nevertheless, this measure does not seem to work well in the digital environment. Some digital works, such as music, are *licensed* for users to *download* without DRM protection, for example in case of the songs made available by Apple Inc. on iTunes Store. Some other works such as literary works and audiovisual works are still protected by DRM but the users could find many available tools to circumvent that technology and make unauthorised reproductions of such work by means of *downloading*, *recording* and *screen capturing* at anytime.

### B. COLLECTIVE RIGHTS MANAGEMENT

Collective management organisation is another way to protect the benefits of the original authors. The idea was firstly originated in France at the

end of the 18th century. The *Bureau de législation dramatique* in 1777 and *Société des auteurs et compositeurs dramatiques* (SACD) and other early French collective management organisation are the model for a network of authors' societies around the world.[1119]

Basically, collective management organisations will administer, monitor, collect and distribute royalty payments for benefits of original authors and the right holders. As for users, the collective management organisations will help reducing transaction costs and processes on acquiring licenses to use the works.[1120]

The collective management organisations also play an important role in the online activity environment. The EU Collective Rights Management Directive (Directive 2014/26) which was adopted by the European Union on the 20th of February 2014 and came into force on 10 April 2014 offers a set of measures to support the function of the online digital market. Most importantly, the Directive will make it easier for users to receive a license to use online contents. Nevertheless, it is criticised that by making the licensing system easier the Directive focuses mainly on the benefits of the giant service providers rather than the individual users. Also the right holders will highly benefit from the Directive in the sense that they could earn more accurate royalty payments.[1121]

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[1119] Christoph B. Graber, 'Collective Rights Management, Competition Policy and Cultural Diversity: EU Lawmaking at a Crossroads' (2012) 4 The WIPO Journal 35 p36

[1120] Ibid p36

[1121] Sylvie Nerisson and others, 'Legislative Comment: Comments of The Max Planck Institute for Intellectual Property and Competition Law on The Proposal for A Directive of The European Parliament and of The Council on Collective Management of Copyright and Related Rights and Multi-Territorial Licensing of Rights In Musical Works for Online Uses in The Internal Market COM (2012)372' (*Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 13-04*, 16 Junuary 2013) <http://ssrn.com/abstract=2208971 > accessed 14 July 2015 pp322-350 and Alexander Ross, 'The New Regulatory Regime For Collective Rights Management - The Government Consults On How To Implement' (2015) 26 Entertainment Law Review pp130-133

### C. CREATIVE COMMONS

The two above measures aim to protect mainly the benefits of the right owners. However, as discussed earlier in chapter I, Creative Commons licenses allow some flexibility for both copyright owners and users to use online copyrighted works. First of all the copyright owners can apply those licenses in advance on the digital works they publish or make available online. The individual users can later learn from the licenses and conditions provided in advance on a work and use the work according to such licenses and conditions. This is very beneficial for the users. Nevertheless, Creative Commons licenses still have some weakness in the sense that they could be removed or amended by the copyright owners (and any other online internet users) at anytime without notification to the users after such works are made available online.

## V. CONCLUSION

This chapter analyses the major concept of 'publication' which plays an important role in the online activity environment. First of all, it emphasises that, in terms of technology, 'publication' is the major objective of having the interconnected network and online communication.

Secondly, in terms of copyright, 'publication' also defines every significant part of the regime. It affects every single part of copyright from the beginning of protection to exclusive rights and the limitations and exceptions of copyright infringement.

Finally, in terms of online activity, 'publication' is the most important activity for every online internet user in the UCC or UGC environment, no matter whether they are copyright owners (individuals or companies), users, or subsequent creators, as discussed earlier in chapter III.

However, it is important to note that under both the US and the UK copyright laws the act of 'publication' could be distinguished from the act of 'making reproduction'.

Although it is agreed in chapter I that the act of 'making reproduction' and 'making adaptation' might be overlapped, both of them could, however, be separable from the act of 'publication'. To single out 'publication' from 'making reproduction' and 'making adaptation' is beneficial for the internet users for purposes of making derivative works, particularly in the online activity environment.

The current situation is that, without separation, the act of unauthorised making derivative works online is infringing the exclusive right of the making adaptation of the original authors regardless of whether the works are made available to the pubic online or not. This is because the users or subsequent creators of the derivative works will have to digitally reproduce (*download, record,* or *screen capture)* the original works before they could make adaptation to those works. If the making reproduction was done unlawfully, the making adaptation would as well be deemed as unlawful and thus be copyright infringement anyway unless it is proven as 'transformative', as suggested in chapter I. This blocks the creativity of the future subsequent creators for their new creations. Currently there is no effective tool (either Digital Right Management, Collective Rights Management, or Creative Commons) or any other limitations and exceptions such as the fair use doctrine and fair dealing to deal with this issue.

Therefore, this thesis is proposing that to separate unauthorised 'making reproduction' and unauthorised 'making adaptation' from making 'publication', or in other words, to allow unauthorised 'making reproduction' (*downloading, recording,* and *screen capturing)* and unauthorised 'making adaptation'

without making 'publication' (*uploading* and *streaming),* relying on the overall fair use doctrine mechanism instead of merely the concept of 'transformativeness', may be one of the answers. This is to encourage 'creative expressions' and *authorship* and guarantee the '*freedom of expression*' of internet users and subsequent creators as provided earlier in chapter II.

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# PART III

# CONCLUSION AND PROPOSED SOLUTIONS

# CHAPTER V

# CONCLUSION AND PROPOSED SOLUTIONS

## I. COPYRIGHT PROTECTION AND INFRINGEMENT: CREATIVITY

First of all, it is noteworthy that the significance of 'creativity' has been reaffirmed in this study. In fact, it is difficult to clarify or provide a clear definition to the question of 'what is creativity'. Nevertheless, it is very possible to analyse how 'creativity' is important to the back bone of copyright scheme, how 'creativity' drives the new creations, how 'creativity' prospers *authorship* of an individual author, and how 'creativity' is significant for the exceptions of copyright infringement at least in terms of 'transformativeness' which stipulates the two main considerations that: 1) whether such quotation transforms the original work and support the different purposes of the subsequent author and 2) such work must not supersede the original work. These considerations, however, must as well include another important aspect of non-commercial use.

Emphatically, it is thus certified from the discussion in chapter I and III of the thesis that 'creativity', regardless of what the real meaning it is, is a vital substance for every major aspect of copyright in every jurisdiction.

## II. CREATIVITY AND HUMAN RIGHTS

The study also found that under the human right regime, 'creativity' is also important for every individual. It is reaffirmed distinctively in chapter II that, with the contribution of their 'creativity', both the *moral interest* and *material interest* of the individuals will be protected by the mechanism of intellectual property right and property right under a universal standard of human rights protection. In this aspect, it is noteworthy that the institutions or publishers

will not be able to receive such human right standard of protection although they may be eligible for some protections for their *material interest* if a contribution of their 'creativity' has been found.

Furthermore, it is reaffirmed that under the human right regime the individuals are also protected by the right to freedom of expression and the right to internet access. As specified in chapter II, due to the fact that the criterion of protection could be varied amongst countries, these measures are seen as the cultural standard of protection. This is even though it is reaffirmed in chapter II and IV that the internet technology is a universal medium of communication.

Most importantly, these cultural standards of human right protection not only safeguard but also prosper 'creativity'. As it is clearly emphasised in chapter II that it is not that '*copyright is the engine of free expression*' but '*free expression is an engine of creative expression*' and '*creative expression is an engine of copyright*'. Thus, '*free expression is an engine of copyright.'*

The above summary will lead to the forthcoming solution which supports the enrichment of *free expression* and *creativity* of individuals. *Free expression* and *creativity* of individuals will be an encouragement of copyright which will later guard the *moral interest* and *material interest* of the creators and finally bring the economic benefits to the community.

## III. THE INDIVIDUALS

Individuals are the most influential player in the online digital environment. In terms of individuals, they could either be the *original creators* of the online digital works, the *users* of such works, or the *subsequent creators* of the online digital works at the same time. In either case, a contribution of their 'creativity' to the work of their creation will give these individuals a status of

'an author' as specified in chapter II and III. When an individual holds a status of an author they will therefore possess an *authorship* over the work of their creation. This *authorship* is an important factor that defines *moral interest* and *material interest* protection under the intellectual property right and property right regime.

On the contrary, in case of the business entities, although their contribution of 'creativity' may not allow them a status of 'an author', an *authorship*, or a human right level of protection, they could, however, receive economic rights protection for their *material interest* as the copyright *owners (ownership)*.

This again confirms the importance and a close link between the individuals and their creativity, human right, *authorship,* and copyright protection for *moral interest* and *material interest* as purposely submitted in chapter II that:

> 'In the digital era, copyright, as the *intellectual property right* and *property right* of *creator*, will grant protection to the *moral* and *material interests* of *creator*, for purposes of 1) *encouraging* development of **creative expression** (*originality and creativity*) of the *creator* in the intangible digital works, and 2) sustaining **the right to freedom of expression** of the *speaker*, the *audience*, and the *public* advocated by the internet technology.'

## IV. THE INDIVIDUALS: ONLINE ACTIVITIES AND MAKING DERIVATIVE WORKS

Derivative work is the subsequently created work based on the original work. Generally, derivative work could be protected by copyright based on the four major considerations:

1) Such work needs to be qualified under the definition of derivative work specified in Article 2(3) of the Berne convention; i.e. a translation, adaptations, arrangements of music and other alterations of a literary or artistic work.

2) Whether the author of such subsequent work receives official authorisation from the original author, or the work is adapted by the original author himself

3) Whether such works meet qualification of originality

4) The subsequent work may need to satisfy the condition of *fixation*

In the online digital environment, the right of making adaptation or the right of making derivative work is generally one of the exclusive rights of the copyright owner which are frequently performed. Since the individuals are the most influential player in the online digital environment they are the major people who carry out the act of making adaptation or making derivative work online, either with or without authorisation of the copyright owners.

Focusing on the act of making adaptation of online digital work without authorisation of the copyright owners, the act will anyway consist of an act of making reproduction of these particular online digital works: *literary works*, *musical works*, *audiovisual works* and *images*. In sum, the act of making online derivative works will consist of the four-step of activities as follows

**A. Browsing** the webpage of the online digital works (*literary works*, *musical works*, *audiovisual works* and *images*)

**B. Reproduction** of those works by means of *downloading, recording, or screen capturing*

**C. Making Adaptation** to the original works received from reproduction

**D. Publication or Making Available to the Public** by means of *uploading* or *streaming*

## V. MAKING DERIVATIVE WORKS: THE INDIVIDUALS' CREATIVITY AND THE LAWS

At present, it is proven in chapter I that there is no explicit exception and limitation for unauthorised making derivative work either in the international or regional level. However, the copyright law of some countries, for example, the current national copyright law of the US, has allowed some room for unauthorised making online digital derivative work. This could be found under the term 'transformativeness' which comes under the four pillars of the fair use doctrine. The UK fair dealing, however, offers some more restricted measure that is not beneficial for unauthorised making derivative works.

Nonetheless, the US 'transformativeness' exception still offers a very limited opportunity to the users or the future subsequent creators of the online digital derivative works. This is because the fundamental qualification of 'transformativeness' is very difficult to prove even to the court and also the clear meaning of 'transformativeness' is not yet internationally agreed.

Also some other non-legal mechanisms such as Digital Right Management, Collective Rights Management, or Creative Commons also do not provide any more opportunity to these users in order to create a derivative work online.

In summary, the overall current copyright mechanisms are seen as a blockage to the prosperity of 'creativity' of the online individual persons in terms of making derivative works.

## VI. PUBLICATION: THE PROPOSED SOLUTIONS

Whereas 'transformativeness' and other non-legal mechanism do not seem to function to encourage 'creativity' of the online individual creators in terms of making online derivative works, which is part of the overall fundamental objective of the copyright law, the study will therefore need to look for some other solutions.

Since it appears in chapter I and IV of the thesis that the US fair use doctrine clearly offers some exceptions of copyright infringement to the act of unauthorised making derivative work, it is therefore reasonable to focus on this mechanism as a possible solution.

Generally, fair use consists of four factor which must be considered altogether: (1) The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) The nature of the copyrighted work; (3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) The effect of the use upon the potential market for or value of the copyrighted work.

In this aspect, it appears that 'transformativeness' is a sub-factor of factor one which should be considered in higher importance than the sub-factor of commercial/non-commercial use , whereas, under factor two, it is suggested that the *published/unpublished* status of a work is also an important sub-factor to be considered.

For this purpose, 'publication', therefore, has shown an important role in the online digital activity environment, not only as one of the exclusive rights of the copyright owner, but also as one of the limitations and exceptions of copyright infringement and the only objective of having the interconnected network as certified in chapter IV.

Accordingly, considering 'publication' as a one of the limitations and exceptions of copyright infringement, after an unauthorised making adaptation of a work, it is making an unauthorised publication of a digital work to the public online by means of *uploading* or *streaming*[1122] that would certainly affect the potential market of the copyright owners, as suggested in factor four of the fair use doctrine.

In this scenario, an unauthorised making adaptation of the online digital work without publication or making available to the public would likely *not* affect the potential market of the copyright owners. This is because the digital work has not yet made available for others to use online by means of *uploading* or *streaming.* However, this may not include the cases where the unauthorised making reproduction (*downloading*, *recording*, or *screen capturing)* which occurs before the adaptation has been made unlawfully; for example, some cases of downloading big data with a hi-speed file transfer software which are not covered by the fair use doctrine.

Therefore, with regard to the exception for temporary making reproduction of online digital work for technological purpose based on the RAM Copy Doctrine which could possibly be applicable in case of *Browsing*, this thesis propose that there could possibly be an exceptions for 'making adaptation of the online digital work without publication or making available to the public' as well. This 'making adaptation of the online digital work without publication or making available to the public' is solely for purpose of personal use, encouraging 'creative expression' of the future subsequent users, and opening an opportunity for future copyright protection on the work of *authorship*. From that standard, this exception is as well compatible with the three-step test

[1122] See previous page

provided under article 9 of the Berne Convention, article 13 of the TRIPs Agreement, and article 10 of WCT[1123].

Whereas the act of making reproduction and making adaptation are overlapped, the proposed exception could possibly be as follows:

> *'It is not an infringement of the right of making adaptation for the owner or lessee of a machine to create a derivative work based on the online original work if 1) such derivative work is based on the online original work which is lawfully obtained, reproduced, or copied into the computer storage, and 2) such making derivative work is made solely for purpose of personal use, developing 'creative expression', and without publication or making available to the public of such newly created derivative work.*
>
> *If such newly created derivative work is published or made available to the public, then the general three-step test or the fair use doctrine would be applied.'*

It is noteworthy that in respect of *'…the original work which is lawfully obtained, reproduced, or copied into the computer storage…'*, this thesis is attempting to prevent some unauthorised reproduction of big data by means of hi-speed file transfer software which somehow could not be covered by the fair use doctrine.

The above proposed solution could plausibly be applicable in the recent cases, briefly, for example:

[1123] See Daniel Gervais Christophe Geiger, Martin Senftleben, 'The Three-Step Test Revisited: How To Use The Test's Flexibility In National Copyright Law' (2014) 29 AM U INT'L L REV 581 p591 *"Article 10 of the WCT can be seen as a guideline for the future extension of existing E&Ls, and also as enabling new exemptions in the digital environment (Article 10 "should be understood to permit Contracting Parties to devise new exceptions and limitations that are appropriate in the digital network environment")"*

1) In *Lenz v. Universal* [1124] Lenz's argument was that *'her video was "self-evident" fair use and that Universal must have known it constituted fair use when it sent the Takedown Notice.'*[1125] It appears here in this case that at least in Lenz's views the fair use exceptions have been considered earlier at the time she made unauthorised 'publication' of the alleged video (derivative work) on YouTube and before the case went to the court.

This is clearly concurrence with the above proposed solution. According to the above proposed solution, as long as Lenz legitimately obtained the song 'Let's Go Crazy' she is free to make a derivative work of it unless she has published such video to the public then a fair use exceptions must be considered in terms of both making derivative work and making available to the public.

2) In *Ashby v. France* [1126] the case involves three photographers made unauthorised publication of the photographs taken in a fashion show on their website. This constitutes infringement of the copyright of the fashion houses. Whereas the court held that the 'publication' of those photos is guarded by the right to freedom of expression, it still infringes the exclusive rights of the right owners.

Although this case does not directly involve making adaptation, it is concurrence with the above purposed solution in the sense that there is no fair use exceptions that could be applicable in such case of unauthorised reproduction and 'publication' (or making available to the

[1124] Lenz v. Universal Music Corp., 5:07-CV-03783-JF, 2013 WL 271673 (N.D. Cal. Jan. 24, 2013)

[1125] Lenz v. Universal Music Corp., 5:07-CV-03783-JF, 2013 WL 271673 (N.D. Cal. Jan. 24, 2013) at foot note 4

[1126] *Ashby Donald and others v. France* Application no 36769/08 (European Court Of Human Rights)

public) of the photographs which incorporate the copyright of the fashion houses although those photos might be lawfully taken in the first place.

3) In the situation of *'Richard Prince and his $100,000 Instagram art'* [1127] it appears that Prince has made unauthorised alterations, publications, and sale of the photos of instagram users that contain the inclusion of his own comments or captions. These photos were previously published on an application called 'Instagram'[1128] by the online users.

According to the above proposed solution, Prince is free to copy, alter, or modify those online published photos even without authorisation of the right owners. This is to encourage and prosper his *freedom of expression* and *creativity*. However, when he is making 'publication' of those works, either via tangible or intangible medium, whether offline or online, he will have to carefully consider whether his acts fall under the four factors (and sub-factors) exceptions of the Fair Use Doctrine.

4) In *Svensson v. Retriever Sverige* [1129] the court ruled that *'the provision on a website of clickable links to works freely available on another website does not constitute an 'act of communication to the public".* Although this case may not directly involve the act of making online digital derivative work, it could plausibly be inferred that, according to the above proposed solution, the act of '*provision on a website of clickable links to works freely available on another website*'[1130] may not constitute online 'publication' of the digital work as well.

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[1127] Plaugic L, 'The story of Richard Prince and his $100,000 Instagram art' (*The Verge*, 30 May 2015) <http://www.theverge.com/2015/5/30/8691257/richard-prince-instagram-photos-copyright-law-fair-use> accessed 25 June 2015

[1128] See chapter III

[1129] *Svensson and others v Retriever Sverige AB* (Case C-466/12); [2014] WLR (D) 67

[1130] Ibid

This is regardless of whether there are inconsistent opinions regarding the CJEU's decision on the issue of the 'new public' or '*… a public that was not taken into account by the copyright holders when they authorised the initial communication to the public …*'[1131] as specified above in chapter I.

## VII. CONCLUSION

According to the discussion above, this thesis concludes that the current copyright law apparently does not function to support the benefit of the individuals in the digital era. It is discovered that the individual creators could somehow gain higher benefits than the individual users or subsequent creators of the online digital derivative works. This is due to the presumption of 'originality and creativity' and 'fixation' that applies to all the digital works appeared online which bring copyright protection to every work of the creator. This obstructs the opportunity of the individual users or subsequent creators in borrowing that original works to create derivative works.

Nevertheless, to lessen copyright protection granted to those original works of the original creators might not be a good answer because copyright protection brings economic values to those works. The solutions could be drawn in the area of limitation and exception of copyright infringement in order to allow some rooms for the prosperity of individual's creativity. In the end, the author's expectation is that the proposed solution in this chapter could help reinforce the fundamental right of the individual authors and users on creating a new work, sustaining the right to freedom of expression of the *speaker*, the

[1131] See some dissent opinions from legal scholars on this specific issue of 'new public' as could be found form the opinion of Jan Rosen, Silke von Lewinski, and Lionel Benlty discussed in the BLACA (The British Literary and Artistic Copyright Association) Conference on 13 November 2014 (http://the1709blog.blogspot.com/2014/11/blaca-interesting-evening-trying-to.html) accessed 19 Oct 2015 and the opinion of Jan Rosen presented at the Fordham IP Conference on 8 April 2015 (http://ipkitten.blogspot.com/2015/04/the-cjeu-new-public-criterion-national.html) accessed 19 Oct 2015. See further discussion about 'linking' and its meaning in chapter I

*audience*, and the *public* advocated by the internet technology, encouraging development of creative expression of the creator in the intangible digital works and most importantly strengthening the fundamental concept of copyright protection.

Finally, in order to support the above proposed solution, the future works which needed to be conducted are, *firstly*, about the possibility of creating a clear separation between the act of making reproduction and the act of making adaptation of the original work.

*Secondly*, it is only an idea proposed by the author in this study that under the copyright doctrine and mechanism there is a possibility to separate the act of publication from the act of making reproduction and making adaptation. It is primarily suggested by the author that making reproduction or making adaptation *without* publication does *not* affect the use upon the potential market for or value of the copyrighted work as provided under factor four of the fair use doctrine and article 9 of the Berne Convention. It is also presumed that such separation would be useful for purpose of encouraging *freedom of expression* and *creative expression* of the users and possible future authors of the work of creation.

Thus, in order to prove that presumption, it would be very beneficial to revisit and profoundly excavate the concept of 'publication' in copyright law and in other relevant aspects in order to establish the doctrine of publication and thus reemphasise the possibility of creating a distinction between 'making reproduction and/or making adaptation *without* publication' and 'making reproduction and/or making adaptation *with* publication' of the work of creation, both in the analogue and the digital world.

*Finally*, the profound study of 'transformativeness' and particularly factor four of the fair use doctrine is required in order confirm that presumption.

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