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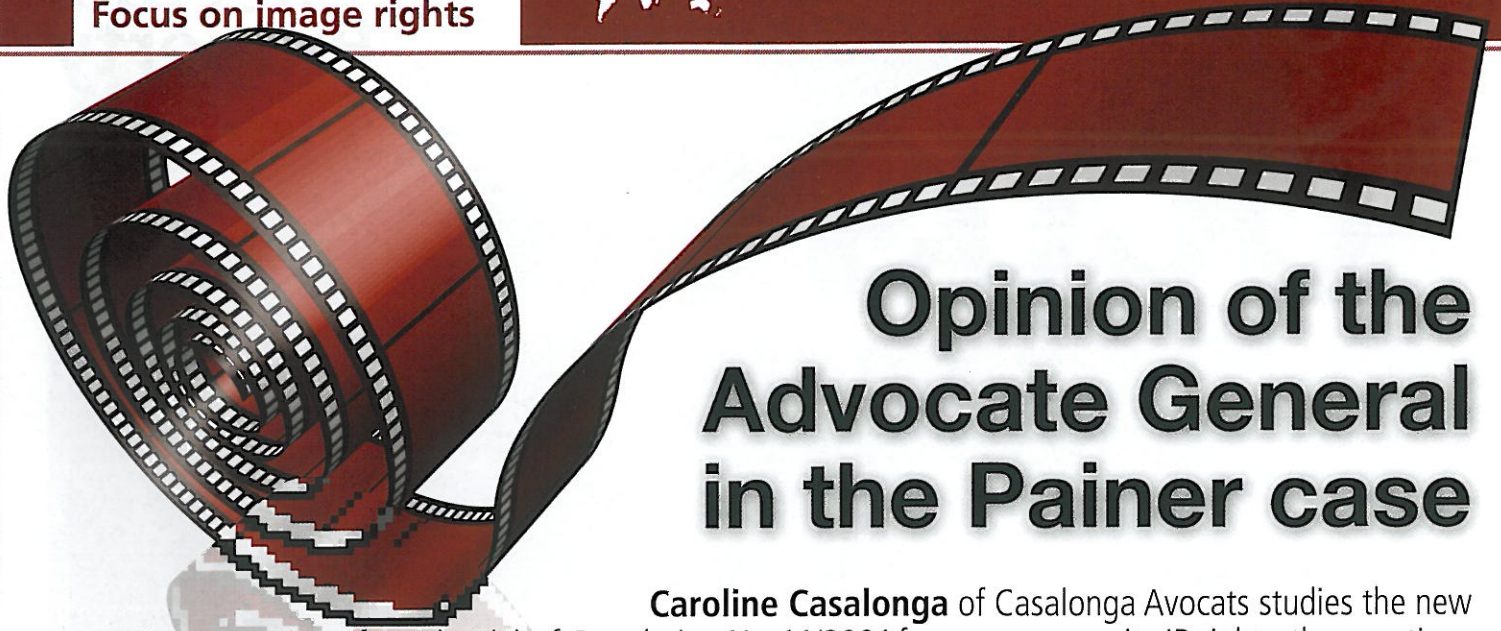
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## Images and IP

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# Opinion of the Advocate General in the Painer case

Caroline Casalonga of Casalonga Avocats studies the new interpretation of Article 6(1) of *Regulation No 44/2001* for non-community IP rights, the questions relating to copyright protection of photos and the exception of quotations

**O**n 12 April 2011, Advocate General Verica Trstenjak issued her opinion in the case *Painer v Axel Springer and others*.

Eva-Maria Painer is a photographer and has taken pictures of children in nurseries and day homes. She took portrait photos of an Austrian national, Natascha K ("the contested photos").

Natascha K was abducted in 1998, at the age of ten. The competent security authorities launched a search appeal in which the contested photos were used. Those photos were the only photos of Natascha K. In 2006, Natascha K escaped from her abductor but there were no current photos of her.

The defendants, different Austrian and German newspapers and magazines published the contested photos without crediting the author. The magazines and newspapers also published a photo-fit that was produced by a graphic artist using a computer program and based on one of the contested photos, ("the contested photo-fit"). The contested photo-fit was intended to show the presumed current appearance of Natascha K.

Two out of the five magazines and newspapers published the contested photos only in Germany. The others published them in Austria or both in Austria and Germany.

Painer sued the news companies for copyright infringement before the Vienna Commercial Court, seeking a prohibitory injunction relating to the reproduction of the contested photos and the contested photo-fit without her consent and without crediting her as author and payment of royalties and damages.

## The questions

The Vienna court asked the Court of Justice of the European Union (CJEU) for guidance on the following questions:

1) Whether jurisdiction for related actions under Article 6(1) of Regulation No 44/2001 [on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters] may apply in respect of copyright infringement acts committed by different parties in different member states.

2) Questions relating to the quotation copyright exception in light of Articles 5(3) and 5(5) of Directive 2001/29 [on the harmonisation of certain aspects of copyright and related rights in the information society]:

- Does the quotation exception apply when the work quoted is included in a document that is not protected by copyright, such as a press report?
- Quotation exception in the interests of criminal justice: does it require that the quotation be officially ordered for search purposes? In the negative, is the media allowed to rely on that exception to decide, of their own volition, whether the images should be published 'in the interests of public security'? In the affirmative, does the media have to specifically indicate in the publication that the quotation is published to assist in the search of an investigation to a criminal offence?

3) Questions on the conditions of copyright protection granted to photos:

Is Article 1(1) of Directive 2001/29 in conjunction with Article 5(5) thereof and Article 12 of the Berne Convention, particularly in the light of Article 1 of the First Additional Protocol to the ECHR and Article 17 of the Charter of Fundamental Rights of the European Union, to be interpreted as meaning that photographic works and/or photographs, particularly portrait photos, are afforded 'weaker' copyright protection or no copyright protection at all against adaptations because, in view

of their 'realistic image', the degree of creative freedom is too minor?

Does article 6(1) of Council Regulation 44/2001 apply to non-community IP rights infringement acts committed by different parties in different member states: the notion of "close connection"?

In this matter, the same contested photo was published in different magazines and newspapers, some of which were sold both in Austria and in Germany and others only in Germany, or only in Austria.

The Austrian court had jurisdiction against the Austrian magazines as the court of the domicile of the defendant and against the German magazines that published the photo in Austria.

The question is whether, under Article 6(1) of Council Regulation 44/2001, does the Austrian court have jurisdiction for the same acts committed by the German magazines that published the photo only in Germany?

The protection of photographs is the subject of different regimes in the member states. Therefore, there is a certain level of harmonisation on the terms of protection and the condition of protection of photographic works, but the copyright national laws are not fully harmonised.

## Article 6(1)

In her opinion, the Advocate General concluded that the notion of 'close connection' under Article 6(1) of Council Regulation ... 44/2001 ... is to be interpreted as requiring a single factual situation and a sufficient legal connection, between the claim against the defendant who is domiciled in the place where the court is based (anchor claim) and the other claim.

### a) One single factual situation

The first requirement for the existence of a close connection between the anchor claim and

another claim is that the claims arise in the context of a single factual situation. The Advocate General is of the opinion that there is no such single factual situation in this matter, as the defendants do not appear to have had concerted parallel conducts.

### **b) Sufficiently close legal connection**

The second requirement for the existence of a close connection is a sufficient legal connection. In cases where comparable claims are made and the laws are comparable, the Advocate General suggested to apply Article 6(1) of the Regulation in order to avoid inconsistencies that could result from a different interpretation of the facts by the two courts.

She concluded that a sufficient legal connection may exist even if there exists different national laws which are not fully harmonised.

### **c) The aim of Article 6(1) is to avoid inconsistencies: criticisms of the Roche decision**

The Advocate General criticised the Roche decision in which the court rejected the application of Article 6(1) of the Brussels Convention, in the absence of one same factual situation, in a case where a European patent had been allegedly infringed by companies belonging to the same group, but in different member states.

The Advocate General suggested to apply Article 6(1) of the Regulation in cases involving a single factual situation, where the applicable laws are "essentially comparable". Patent national laws can be described as "essentially comparable". This would also apply to national rights, such as national trademarks in different EU countries.

However, in order to avoid a contradiction with article 22(4) of Council Regulation 44/2001 such interpretation would have to be limited to proceedings in which the validity of the IP right registration is not discussed.

Article 22(4) of Council Regulation states as follows:

The following courts shall have exclusive jurisdiction, regardless of domicile: (...) 4 in proceedings concerned with the registration or validity of patents, trademarks, designs, or other similar rights required to be deposited or registered, the courts of the member state in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each member state shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned

with the registration or validity of any European patent granted for that state.

If the Advocate General opinion is followed by the court, it may result in a complete change of the European non-community IP rights litigation procedures in the EU, where one single anchor court will have jurisdiction over all infringement acts by the same or related parties in any country of the EU. However, as above mentioned, unless there is no counterclaim contesting the validity of the IP right registration claimed, the court of the anchor national patent of trademark office should have exclusive jurisdiction according to article 22(4) of Council Regulation 44/2001.

### **The quotation exception to copyright protection Conditions for the quotation exception to apply**

The Advocate General was of the opinion that under Articles 5(3) and 5(5) of Directive 2001/29, the quotation of a work may be authorised without the author's consent even where the press report quoting the work is not itself protected by copyright. Accordingly, the quotation exception may apply to a press report.

The Advocate General reminded that the quotation exception is subject to the indication of the name of the author unless this turns out to be impossible. Indicating the author's name does not turn out to be impossible where the person making the quotation has not taken all reasonable measures to identify the author.

### **Specific conditions for quotation exception in the interests of criminal justice**

The Advocate General was of the opinion that in the case of a search appeal which pursues a purpose of public security, the reproduction of copyrighted photos by the media may be authorised even without the author's consent, if the purposes pursued by the search have not been fulfilled and the reproduction is objectively capable of pursuing such purposes.

Is it required that the quotation be officially ordered (imposed?) for search purposes? In the negative, is the media permitted to rely on that exception to decide, of their own volition, whether the images should be published 'in the interests of public security'? In the affirmative, does the media have to specifically indicate in the publication that the quotation is published to assist in the search of an investigation to a criminal offence?

However, the media may not rely directly on such provision without an official search appeal "criminal investigation".

### **Conditions for copyright protection of portraits photos and photo-fit**

The Advocate General reminded that under the Directives (article 6 of Council Directive 93/98/

EEC, harmonising the terms of protection of copyright and certain related rights and of Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights), a portrait photo is afforded copyright protection if it is an original intellectual creation of the photographer, which requires the photographer to have left his mark by using the available formative freedom. This opinion follows the principles of the Berne Convention.

Case after case, the CJEU is shaping and harmonising national copyright laws, by defining the scope of original intellectual creation for each type of work.

The Advocate General was of the opinion that the publication of a photo-fit based on a copyright portrait photo would constitute a reproduction within the meaning of Article 2(a) of Directive 2001/29, where the elements comprising the original intellectual creation of the template are also embodied in the photo-fit. Accordingly, a photo-fit based on a copyrighted portrait photo could constitute copyright infringement.

### **Summary**

The Advocate General suggested to apply Article 6(1) of the regulation in cases involving a single factual situation where the applicable laws are "essentially comparable". Patent and trademark national laws can be described as "essentially comparable" within all member states. However, it might be difficult to argue that there is such harmonization in copyright laws.

The opinion of the Advocate General is in contradiction with the principle that national rights and national laws should coexist with community rights.

It is also in contradiction with article 22(4) of Council Regulation 44/2001, under which the national court of the place of the national patent or trademark office has exclusive jurisdiction in all cases involving the validity of the IP right titles granted by that national office.

National rights should be applied by each national courts to acts conducted in their jurisdiction only. Deciding the contrary may result in legal uncertainty.

### **Author**



Caroline Casalonga has been practising intellectual property law since 1993. She is the founder of Casalonga Avocats, the IP litigation boutique of Casalonga & Josse. She has significant experience in IP litigation, and focuses on trademark, design, copyright and patent litigation matters.