D6.2 Annex I
The Rights on Images in Books

Clarifying the Legal Issues for Facilitating the Clearing of the Rights on Books Images and the Diligent Search for Rightholders

Legal Study

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Context and scope of the legal study: The present study is part of the Arrow Plus program which aims at creating a "*stable, sustainable infrastructure for rights information management including clearance of rights and a European registry of orphan works*". To facilitate the diligent search of rightholders that digital libraries have to conduct when they engage in the mass-digitization of books, it is necessary to have a good understanding of the rights situation concerning the images incorporated in the books. The present analysis offers a review of the legal issues (conditions of protection, scope of the rights needed for a digitization project, management of the rights for various types of books and images). Such legal analysis will help to define the guidelines that libraries and other operators which scan books and make them available online must follow when conducting the necessary diligent search.[1] The outcome of the study, ultimately, is to create an adequate rights information management system for images contained in books.

The study focuses on the legal regime for the images that are integrated in books, whether they appear in the books, including their annexes, or on the cover of the books. The study does not envisage the situation and the digitalization of "stand-alone" images for which the clearance process might have to be designed differently.

Executive summary:

- **Conditions for protection**. The images in books, whether they are photographs, graphic illustrations or other reproductions of visual works (for ex. paintings, buildings or pieces of design), in the vast majority of cases, enjoy copyright protection. In addition, photographs enjoy a related right protection in the few countries which have a dual system for protecting photographs.
  - A review of the standard for protecting images and photographs shows that courts, in particular the Court of Justice of the EU, tend to grant a copyright for photographs which show a modicum amount of originality, a light "personal touch" being sufficient to trigger the copyright protection.
  - The personal imprint can result from "free and creative choices" made (at least) at three different moments: i) the preparation phase (for ex. choices about the background and pose of the subject); ii) the snapshot moment (for ex. choices about the framing and angle of view); ii) the development of photos and/or the photo editing process.
  - Only images which are purely technical reproductions (X-rays, satellite images, simple scans of analogue images) are excluded from copyright protection.
  - In certain countries (Austria, Germany), the related right protection of simple photographs (versus works of photography) gives an additional protection for images which show a low level of creativity.
- **Scope of protection**. The libraries and other operators who engage in mass-digitization of books need to obtain an authorization from the rightholders for i) scanning and making other digital copies of the images incorporated in the books (reproduction right) and ii) for making the books and their images available online (making available right/communication

[1] A proposal of specific guidelines for the visual/photography sector is annexed to the MoU 2010, HLEG Digital Libraries: http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/orphan/appendix.pdf (second sector).

to the public right). Copies made by non-profit institutions to preserve the materials in their possession do not require the authorization from the rightholders, but the reproduction made to deliver the images online and the further communication to the public/making available of those images must be authorized (as these acts do not fall under the copyright exceptions listed in Art. 5 of the Copyright Directive). The moral rights of the creators will be respected as long as the images i) remain credited and ii) are not modified in a way that is prejudicial to the author's reputation.

- **Differentiation in the clearing process**. The guidelines that must be further defined for the digitization of images need to take into account the following aspects:
  - When the images are incorporated in ***published books***, the rights on the images have in principle already been cleared for the publication and authors are duly credited. The publishers should have obtained the necessary authorizations from the rightholders with regard to the publication of the images in the books, but an additional authorization from the rightholders might be required for the digital reproduction and the communication to the public/making available of the images.
    - For the visual authors whose rights are represented by collective management organizations (CMOs), it can be presumed that only the print version was licensed (only a limited license with no assignment of the rights).[2] Picture agencies who represent their members limit the licenses they grant in a comparable way (the right to use only covers one specified print version).
    - In other instances, the respective authors of the images need to be contacted to clear the rights.
    - In many cases, it will remain unclear whether the authorization granted for the images in the print books will cover the digital uses needed for making the books available online. For published works, the information regarding the rightholders has been communicated to, or found by, the publishers, possibly through CMOs in charge of visual works. Identifying the rightholders is thus facilitated.

  - However, some ***books*** are ***published without any credit for the authors of the visual materials they contain***. Indeed, in many cases, the authors of the images or illustrations are not known and/or are not adequately credited. The problem results from the fact that neither the publishers nor the libraries hold complete registries of images contained in books. Libraries only add the authors of visual works to the entry of a book when the work or the author is the main subject of the book (for ex. an illustrated book on the work/life of a painter). When the visual materials of the print version are licensed by the CMO, collecting societies can establish a link between the identifiers of a book (title, ISBN, publisher etc) and the name of the visual author whose works are included in the book.
  - When the images are incorporated in ***unpublished documents or self-published books***, the authors of those documents and books rarely have acquired the rights on the images. (However, they might own the rights on the day-to-day amateur, vacation or family photos integrated in those sources). Retrieving the authors of those visual materials thus appears even more complicated. Therefore, the clearance process must be designed in a different way.

[2] See annex 1 to the specific guidelines for the visual/photography sector, MoU 2010, HLEG Digital Libraries: http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/orphan/appendix.pdf (second sector).

- ***In sum***, there is a need to find a common legal solution for clearing the rights, but, at the same time, some types of books (for ex. when the authors of visual materials are not credited) raise more issues. This might require to design a solution with a view to the most difficult cases. Among the solutions, a legal mandate for a CMO to represent the unknown authors of visual materials could be envisaged.[3]

[3] The solution could take the form of a provision such as the following one: "*where a rightholder whose work was first published in a particular Member State has not transferred the management of his rights to a collective management organisation, the collective management organisation which manages rights of the same category in that Member State of first publication shall be presumed to manage the rights in respect of such work*". See the *MoU - Key Principles on the Digitisation and Making Available of Out-of-Commerce Works* at http://ec.europa.eu/internal_market/copyright/docs/copyright-infso/20110920-mou_en.pdf .

I. The conditions for protecting books images in the EU

The images which appear in books and on their covers are reproductions of visual works, for instance drawings, paintings, etchings, logos, etc.[4], or photographic works which depict persons, landscapes, or other objects. For copyright purposes, all these images fall under the broad category of "artistic works".

A. International and EU sources for the protection of images

1. Berne Convention. "Artistic works" can be protected by copyright under the Berne Convention (BC) for the Protection of Literary and Artistic Works (Art. 2) if they present an original form of expression. Products of photography have been considered as within the scope of the Berne Convention since its inception (in 1886) although the inclusion of "*photographic works to which are assimilated works expressed by a process analogous to photography*" in the open-ended enumeration of protected works in Article 2(1) BC was only made at the Brussels revision of the BC (in 1948).[5] Photographic works (images) thus enjoy full protection under the BC, subject to the special treatment concerning duration: the minimum term of protection is shorter than the normal rule (50 years *post mortem auctoris*) as Article 7(4) BC provides that the term "shall last at least until the end of a period of 25 years from the making of such a work".[6]

2. EU Directives. The risk of discrepancies between Member States concerning the duration of protection of photographs explains why a specific provision concerning photographic works (Art. 6) was included in the 93/98/EEC Directive Harmonizing the Term of Protection of Copyright and Certain Related Right, now codified by the Directive 2006/116/EC (hereafter: the "Term Directive"). In the EU, photographic works now enjoy the same duration of copyright protection as other works, i e. "the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public" (Art. 1 Term Directive).
The other most relevant EU source for the protection of artistic and photographic works is the 2001/29/EC Directive on Copyright and Related Rights in the Information Society (hereafter: the "Copyright Directive") which defines the rights and exceptions applicable to various works, including the images (as artistic or photographic works) integrated in books (see below the section II regarding the scope of protection).

B. Substantive conditions for the copyright protection of images

[4] Article 2(1) of the Berne Convention lists the following "artistic works" which might be reproduced in books: "*works of drawing, painting, architecture, sculpture, engraving and lithography; … works of applied art; illustrations, maps, plans, sketches … relative to geography, topography, architecture or science*". The new technologies also produce visual elements, such as graphic user interfaces of IT products, that can be reproduced as books' illustrations (for instance in computer science books and user manuals).
[5] See S. Ricketson, *International Conventions*, in Y. Gendreau, A. Nordemann and R. Oesch (eds.), *Copyright and Photography*, Kluwer Law, 1999, p. 18 and ff.
[6] The 1996 WIPO Copyright Treaty however now requires that photographic works be protected for the minimum period of the life of the author plus 50 years that is provided under Art. 7(1) BC.

1. Substantive conditions in the EU and international sources. The notion of "artistic work" of Article 2 BC is very broad and can cover images and photographs. Arguably, the notion of work in Article 2 BC (and in the EU Directives) requires the intervention of a human person. It can thus be invoked to preclude the protection of media products resulting from purely technological operations, such as photographs taken from a satellite under the sole control of a computer or images obtained through X-rays or other medical imaging techniques. The notion of work (and of originality) thus help to distinguish subject matters that copyright protects from those it clearly does not cover.

While determining the term of copyright in photographic works, the Term Directive incidentally proposes a definition of originality to be applied to photographs. According to Article 6 of the Term Directive, photographic works "are original in that they constitute *the author's own intellectual creation* [emphasis added]."[7] To be protected, photographs must not be novel. Thus, a newly-commissioned photograph of an ancient painting that is incorporated in an art book can be protected, although previous editions of this art book contain a similar image of the same painting. That no novelty requirement can be imposed is confirmed by the language of Article 6 of the Term Directive which states about photographs that "no other criteria shall be applied to determine their eligibility for protection".

2. The originality of photographs as interpreted by the CJEU. In the *Infopaq I* decision[8], the CJEU relied on the Berne Convention and on the notions of "work" and "intellectual creation" to generalize the existing definition of originality contained in some EU Directives (in particular in Art. 6 of the Term Directive). Further to *Infopaq I*, the European criterion for protecting literary works (such as press articles) and visual works/images that are not photographs (such as original sketches and illustrations) is thus the same as for photographs (included in books).

In *Painer*[9], the CJEU further applied the *Infopaq* standard to the protection of photographs (see §87). The case involves the reproduction by several newspapers of the portrait photographs of a child made by a freelance photographer and of a photo-fit version made later after the child had been abducted. The decision goes further than *Infopaq* in that it describes more into details when a photographic work is protected as the author's own intellectual creation:

> "*an intellectual creation is an author's own if it reflects the author's personality. That is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices […] As regards a portrait photograph, the photographer can make free and creative choices in several ways and at various points in its production. In the preparation phase, the photographer can choose the background, the subject's pose and the lighting. When taking a portrait photograph, he can choose the framing, the angle of view and the atmosphere created. Finally, when selecting the snapshot, the photographer may choose from a variety of developing techniques the one he wishes to adopt or, where appropriate, use computer software* » (§88-91).

The originality of a photograph can thus result from choices made (at least) at three different moments: i) the preparation phase involving choices about the background and surrounding objects, the pose of the subject (this aspect of originality is present in the case of portrait and

[7] This European definition of originality also appears in Article 1 of the Software Directive and in Article 3 of the Database Directive.

[8] CJEU, 16 July 2009, C-5/08 (*Infopaq International v. DDF*).

[9] CJEU, 1 Dec. 2011, C-145/10 (*Eva-Maria Painer v. Standard VerlagsGmbH*).

school class photographs, but arguably it will not be present for photos made on the spot); ii) the snapshot moment involving choices, sometimes made in a fraction of second, concerning the framing and angle of view (this aspect of originality is present for most photographs, including news photographs and other photographs taken on the spot); ii) the development of non-digital photos and/or the photo editing process, using Photoshop or a similar software, involving various choices to retouch, crop, slice, etc. the photographs.
In *Painer*, the CJEU concludes that:

> *"By making those various choices, the author of a portrait photograph can stamp the work created with his 'personal touch'"* (§92).

The requirement that the creation be "the author's own" thus imposes the showing that the work bears the imprint of the author's personality. The Term Directive suggests such an interpretation when, in the "whereas" clause 17 of its preamble, it states that "a photographic work . . . is to be considered original if it is the author's own intellectual creation *reflecting his personality* [emphasis added]."
Moreover, the Court clearly rejects the view that the scope ("étendue" in French) of copyright protection should depend on "*the possible differences in the degree of creative freedom in the production of various categories of works*" (§ 97). This means that the same rights should be granted to all categories of works independently of the varying levels of creativity that might be needed to produce them. This argument of the CJEU, however, cannot be interpreted to challenge the approach adopted in certain countries (see below under D) which distinguish between photographic works (protected by copyright) and simple or non-original photographs protected by a related right.[10]The reasoning of the Court with regard to photographs is also valid for other illustrations contained in books. In general, to establish the originality of a drawing or of another illustration will be much easier as the room for expressing the personality of the author is wider than for photographs which, in principle, have to reproduce reality.
3. The national views on the substantive conditions for protecting photographs. The view of originality as requiring the imprint of a personality has dominated in traditional legal doctrine on the Continent, in particular in France and Belgium.

In **France**, the enumeration of the types of works in the 1957 Copyright Act only listed "photographic works of an artistic or documentary character". This led to a rather confusing case law as courts attempted to define what "an artistic or documentary character" means. The requirement of an artistic character had the effect that some judges did take into consideration the (artistic) merit of the work in deciding about the protection of pictures, although the French law in principle considers that protection should be granted independently from the merit of the work. With the 1985 revision of the copyright law, this special requirement was deleted. Article L. 112-2 of the Intellectual Property Code (IPC) now lists "*photographic works and other works produced by techniques analogous to photography*". The standard requirement of originality is now the sole criterion for protection, an original work being one in which the imprint of the author is visible. Creative choice sufficient to protect photographs have been found for instance i) in the selection of shots to optimize their impact[11], ii) in the adjustment of the camera angles and lighting to produce desired effects and iii) in the creation of a background (décor) to be shot. But the 1985 revision has

[10] Contra: V. L. Benabou, *Arrêt "Painer": la protection par le droit d'auteur d'une photographie de portrait utilisée à des fins de recherche d'une personne disparue*, *J.D.E.*, 5/2012, n° 189, p. 147.
[11] Cass. civ., I, 12 Jan. 1994, RIDA, 1994, n° 162, p. 427.

not solved all issues: protection is not commonly granted to photographs that merely reproduce reality, e.g., a series of photographs taken by a paparazzi[12] or a picture of a painting that merely renders the painting as is (on this last issue, see below under C). Photographs that are automatically made, such as the identity photos taken by a photomaton, are usually not protected. Also, courts are reluctant to grant protection to photographs which only reveal a technical know-how, such as aerial photos[13] or photographs of a composition of fishes on a plate[14]

In **Belgium**, since a 1989 decision of the Supreme Court,[15] the courts have abandoned the requirement that a photograph must possess an artistic or aesthetic character before it is protected as an artistic work.[16] For instance, photographs of various manufactured products (such as bullets, clamping rings and other tools) can enjoy copyright: "*it is necessary but sufficient [that a creation be] the expression of the intellectual effort of the one who realized it, which is an indispensable condition to confer to the work the individual character without which there would be no creation*".[17] In practice, the case law puts the threshold of protection quite low, and most photographs are protected.[18]

In the **United Kingdom**, the condition of originality or intellectual creation is "*satisfied by the very skill involved in the taking of any photography. Under this approach, the simple holiday snap or documentary is treated on a par with the creations of the high art photographer*".[19] The law expressly clarifies that the protection subsists "irrespective of artistic quality" (art. 4(1)(a) of the 1988 Copyright, Design and Patent Act). This provision reinforces the test usually applied in the UK, that is that there is sufficient "skill and labor".[20] The 1988 Act further defines photographs as "*a recording of lights or other radiation on a medium on which an image is produced or from which an image may by any means be produced, and which is not part of a film*". Although this definition suggest that some process using the effect of lights must be used, the definition is broad enough to include digital photographs. The definition also implies that "individual frames from a film are not treated as photographs".[21]

In **Germany** and **Austria**, the originality requirement has traditionally been interpreted more stringently, which implies that only those photographs of a more professional or skilled character will qualify for protection. To protect simple photographs, those countries have opted for a related right-style of protection (see below under D) which is not governed by the international

[12] Paris, 5 Dec. 2007, RIDA, 2008, n° 216, p. 499.
[13] TGI Paris, 6 Oct. 2009, RIDA, 2010, n° 226, p. 506, Note P. Sirinelli (aerial photographs).
[14] Cass., Ch. Civ., 20 Oct. 2011 (n° 10-21251) available on www.legifrance.gouv.fr .
[15] Cass., 27 April 1989, Pas., 1989, I, 908. See also A. Strowel and N. Ide, *Belgium*, in Y. Gendreau, A. Nordemann and R. Oesch (eds.), *Copyright and Photography*, Kluwer Law, 1999, p. 79 and ff.
[16] *See* Trib. Brussels, 21 Sept. 1990, T.B.B.R., 1991/3, 292; Brussels, 29 Sept. 1991, R.W., 1991-92, 814; Trib. Brussels, 10 Jan. 1992, T.B.B.R., 1993/2, 184. *See also* Trib. Brussels, 12 Nov. 1993, J.L.M.B., 1995, 918 (pictures of plants); Brussels, 2 May 1996, A&M, 1996, 416 (pictures illustrating a quiz in multimedia game); Antwerp, 23 June 2003 (Molenbad c. SOFAM), I.R.D.I., 2004, 38-40 (advertising pictures).
[17] Cass., 27 April 1989, Pas., 1989, I, 908.
[18] See D. Voorhoof, *Auteursrecht of fotos's, R. W.*, 1991-1992p. 818; L. Van Bunnen, *Examen de jurisprudence (1973-1977) Droit d'auteur et dessins et modèles, R.C.J.B.*, 1978, p. 529.
[19] S. Ricketson, *op. cit.*, p. 24.
[20] Y. Gendreau, *United Kingdom*, in Y. Gendreau, A. Nordemann and R. Oesch (eds.), *Copyright and Photography*, Kluwer Law, 1999, p. 286.
[21] See: L. Bently and B. Sherman, *Intellectual Property Law*, Oxford U.P., 2009, 3d ed., p. 75 which rely on *Spelling Goldberg Productions v. BPC Publishing* [1981] RPC 283, 288, 297, 298, 300.

conventions and the EU Directives (the EU Directives do not grant any related right to protect non-original photographs). The Term Directive (Art. 6) expressly allows Member States "to provide for the protection of other photographs" (other than those which are protected as original works). It appears that the standard for protecting photographic works has been lowered by the Courts, at least in Austria, following the harmonization of the originality criterion by the Term Directive.[22]

C. Special issues for photographs of artistic works, performances and portraits

When the subject matter of the photograph is itself protected as an original work or when the photographs are taken during a performance or when the picture depicts an identifiable person, the rights relating to the subject matter of the photograph raise some particular issues.
As illustrated below, the case law of the EU Member States shows some divergences in the treatment of those particular issues. The issues and decisions reviewed below are just examples of those differences; they do not provide an exhaustive review of all the differences between Member States. Those differences clearly add to the complexity of the rights information management for images in books.

1. The photographs of art works

a) Protection. When the Berne Convention was adopted in 1886, "*the only photographs required to be protected by Berne Union countries were those which were authorized photographs of 'protected works of arts', for example a photograph of a painting, drawing, sculpture or the like*".[23] Their protection was akin to the protection accorded to other forms of derivative works (such as the translation of a literary work). The obvious originality of the depicted work of art thus influenced the protection of its reproduction by the photograph. Today, courts are sometimes reluctant to grant copyright protection to photographs of artistic works.

In **France**, some judges found enough originality in the photograph of a painting, even if it is a faithful reproduction of the original.[24] Similarly, the photograph of an artistic mobile was considered original.[25]

In **Belgium**, courts are sometimes reluctant to grant protection when the photograph is a faithful reproduction of the original and only shows some technical expertise. In a case involving photographs of paintings that were used to illustrate an exhibition catalog, the Supreme Court refused to grant protection to the photographs, suggesting that the photos are merely informative

[22] Comp. Austrian Supreme Court, 12 Oct. 1993, 4 Ob 121/93 – *Landschaft mit Radfahrern*, refusing to protect a "common" photograph of a landscape with bikers, and Austrian Supreme Court, 16 Dec. 2003, 4 Ob 221/03h – *Weinatlas*, recognizing that simple images of different grape varieties are protected by copyright.
[23] See S. Ricketson, *op. cit.*, p. 19.
[24] See: Dijon, 7 May 1996, D., 1998, somm. 189, obs. Colombet (photograph of a painting can be protected by virtue of creative choices).
[25] Paris, 5 May 2000, RIDA, 2001, n° 188, p. 352.

and lack some further aesthetic element where the photograph merely copies a work of art[26]. This approach is questionable as it reintroduces a merit requirement which, in principle, is alien to copyright[27]. The decision illustrates the hesitation of some courts to grant the protection where the room for creative choices of the photographer seems very narrow.

In *Bridgeman Art Library Ltd v. Correll Corp.*[28], a US court applying **English law** (the 1988 Copyright Patent and Design Act) held that no copyright subsisted in photographs of paintings on the ground that such photographs were slavish copies and would thus be insufficiently original. Relying on some precedents, the US court held that « "a distinguishable variation" – something beyond technical skill – will render the reproduction original (…) The requisite "distinguishable variation", moreover, is not supplied by a change of medium, as "production of a work of art in a different medium cannot by itself constitute the originality required for copyright protection" ».[29] In this decision, the US court also relied on a standard commentary under English law which considers that: "*Under the 1988 Act the author is the person who made the original contribution and it will be evident that this person need not be he who pressed the trigger, who might be a mere assistant. Originality presupposes the exercise of substantial independent skill, labour, judgment and so forth. For this reason it is submitted that a person who makes a photograph merely by placing a drawing or painting on the glass of a photocopying machine and pressing the button gets no copyright at all; but he might get a copyright if he employed skill and labour in assembling the thing to be photocopied, as where he made a montage*"[30]. English judges remain divided on the possibility to protect photographs of works of art. In *Antiquesportfolio.com v. Fitch*[31], a UK judge held "*that copyright did subsist in photographs of static three-dimensional objects, and appeared to lean in favour of the view that the same would be true of photographs of paintings if sufficient skill and labour were exercised*".[32] Sufficient labour and skill might reside in the choosen angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques, etc.

b) Need to obtain an authorization from the author of the depicted work of art. The author of the photograph must take into account the author's rights on the depicted object, such as a painting or any other work of art. In a case involving pictures which contained the images of several pieces of furniture designed by Le Corbusier, the French Supreme Court[33] confirmed the ruling of the Court of appeal that the non-profit organization (Fondation Le Corbusier) and the heirs of Le Corbusier could enjoin the reproduction of those pieces of furniture in photographs, even if the company Cassina had been granted the right to manufacture those pieces of furniture. A license of the right to reproduce a work in 3-D products (chairs, etc.) does not cover the authorization to reproduce a work in a 2-D photograph. Therefore, an image databank, such as Getty Images France, must obtain the consent of the authors/heirs of the reproduced object for incorporating those objects in photographs (which, in this case, were used by third parties for advertising purpose). (However, if

[26] See: Cass., 10 Dec. 1998, A&M, 1999, p. 355, *affirming* J. Paix, Antwerp, 31 Jan. 1995, A&M, 1999, p. 356, note N. Ide and A. Strowel.
[27] See N. Ide and A. Strowel, *La protection des photographies selon la Cour de cassation: un revirement de jurisprudence?*, Note under Cass., 10 Dec. 1998, A&M, 1999, p. 355.
[28] 25 Fed. Supp. 2d 421 (S.D.N.Y.) (1998), 36 F. Supp. 2d 191.
[29] Text before footnotes 36 and 38.
[30] Hugh Laddie, Peter Prescott, & Mary Vitoria, *The Modern Law of Copyright and Design*, 3.56, at 238 (1995).
[31] [2001] F.S.R. 23.
[32] R. Arnold Q.C., *Copyright in Photographs: A Case for Reform*, *E.I.P.R.*, 2005, p. 303.
[33] Cass., 12 June 2012 (n° 695 – 11-10.923)
http://courdecassation.fr/jurisprudence_2/premiere_chambre_civile_568/695_12_23550.html.

the reproduced work of design is completely incidental and secondary in the photograph, and not identifiable as a Le Corbusier piece of furniture, then no authorization is required.)

c) Exception for photographs of works of art i) in a publicly accessible place or ii) which are only incidentally included in the picture. According to the law of some Member States, such as Belgium (Art. 22(1)(2) of the 1994 Copyright Act), Germany (Art. 59 of the 1965 Copyright Act), the Netherlands (Art. 18 of the 1912 Copyright Act), and the UK (Art. 31(1) of the 1988 Copyright Act), when the photographs reproduce a work of art that is placed in a public space, such as a fountain or a monumental sculpture or an architectural work, no authorization from the author of the work of art is required. The law of these countries provide for an exception to copyright in those circumstances, but under varying conditions. Article 5(3)(h) of the Copyright Directive permits, but does not impose[34], Member States to include an exception for the « *(h) use of works, such as works of architecture or sculpture, made to be located permanently in public places* ». The requirement of a « permanent location » has sometimes been narrowly interpreted. In Germany, the Federal Court of Justice ruled that the wrapping-up of the Reichstag building by the well-known artist Christo could not be considered as « permanently located » in a public space, so that photographs could not be made without the need to require any authorisation[35].
Several copyright laws in the EU Member States, for example the Copyright Acts of Belgium, the Netherlands and the UK (and the case law in France[36]), provide for an exception when the reproduced work is incidentally included in a photograph. Such an exception is allowed under Article 5(3)(i) of the Copyright Directive (which permits, but does not impose, an exception for the « *(i) incidental inclusion of a work or other subject-matter in other material* »).

2. The photographs of films scenes or of moments of an art happening

a) Protection. In **France**, courts have not always recognized that photographs of film scenes or sets are original. The decisive factor seems to be whether the photographer just acted as a technician reproducing the scenes as close as possible to reality or whether the photographer showed some creativity in taking the pictures[37]. More generally, the sole know-how or technical knowledge of the operator is not sufficient. In an October 2001 decision, the French Supreme Court denied protection for photographs because "the photograph at issue did not reveal, in its various constituent elements, any esthetic pursuit and that it was merely the result of know-how underlying a technical service".[38]

[34] The French legislature decided not to incorporate this exception.
[35] BGH, 24 Jan. 2002 [2003] E.C.D.R. 7, p. 69 (*Wrapped Reichstag*).
[36] See the decision of Cass., 1ère civ., 12 May 2011, RIDA, 3/2011, p. 457; JCP G 2011, 814 and the comments of A. Lucas, H.J. Lucas and A. Lucas-Schloetter, *Traité de la propriété littéraire et artistique*, LexisNexis, 4th ed., 2012, p. 302 and 419.
[37] Cass. civ., I, 12 Jan. 1994, RIDA, 1994, n° 162, p. 427 (copyright protection for the photographs of scenes of a highly suggestive film); Cass. civ., I, 1 March 1988, RIDA, 1988, n° 137, p. 103 (refusing protection for shots of a technician providing reference points during the shooting of a film); Paris, 13 Oct. 2003, P.I., 2004, n° 10, p. 539, observations A. Lucas (finding some photographs of a film set protected, others not); Paris, 14 Sept. 2001, Juris-Data n° 156061 (protecting a photograph where the photographer asked the actors to take a pose which did not correspond to any scene in the film).
[38] Cass civ., 20 Oct. 2011 (n° 10-21.251) : available at: http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000024702385&fastReqId=1220224171&fastPos=1

In **Germany**, the Court of appeal of Düsseldorf ruled that a series of photographs which were taken during an art performance by Joseph Beuys ('Aktion-Kunst") and which documented some moments of this performance should not be considered as independent works, which can freely reuse other works (under Art. 24 of the Copyright Act), but as adaptations requiring an authorization from the rightholders on the Beuys' work (under Art. 23 of the Copyright Act).[39]

b) Right of the actors and of the persons represented. When the photograph depicts persons, whether they act as performers or whether they only appear without playing any role, some additional authorization might be required from those persons. However, the fact that they agreed to participate to the film/art happening might imply they consented to the pictures made during the performance. The consent of persons to be filmed/photographed is usually narrowly interpreted, thus giving the consent for the use of one's image in certain circumstances (for a film including its promotion, etc.) does not imply that the consent has been given for other uses of the image (for instance in a book reproducing scenes of the film).

3. The portrait photographs and the right on one's image

Contrary than photographs of artistic works, the protection of portrait photographs does not present particular difficulties. Photographs of people raise the issue of consent by the person whose features are sufficiently reproduced to make him/her identifiable. Pictures of people gathered in streets or other public space usually will not require any authorization so long as no individual can be recognized. The right on one's image exists in all EU Member States; however, the legal grounds for this right differ substantially. In certain countries, the right to control one's image relies on a specific provision incorporated in the Copyright Act (for ex. Art. 10 of the Belgian Copyright Act). In other countries, the right of privacy will allow a person to oppose the reproduction of his/her physical features. When the agreement of the depicted person is obtained, it should always be interpreted narrowly. Thus a further dissemination of a photograph, after it has been digitized, might be opposed, even if the original publication was allowed by the person appearing on the photograph.

D. National regimes protecting photographs by a related right

A few EU countries have a related right to protect certain types of photographs, on top of the copyright protection of images.

In **Germany** and **Austria** the Copyright Acts distinguish works of photography (*Lichtbildwerke*) and simple photographs (*Lichtbilder*).

Under those laws, "works produced by a photographic process or a process analogous to photography" are works of photography (*Lichtbildkunst*) (Austria, Art. 3(1); Germany, Art. 2(5)); those works are deemed to be artistic works (Austria, Art. 3(1); Germany Art 2(1)) and are treated likewise, meaning, for instance, they need to be original to be protected. All other photographs,

[39] OLG Düsseldorf, 30.12.2011, I-20 U 171/10, available at:
http://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2011/I_20_U_171_10_Urteil_20111230.html

lacking originality, resulting from a photographic process or any similar technical process, are protected as simple photographs (Austria, Art. 73-75; Germany, Art 72).[40] The person who takes a photograph (the maker) in principle owns the exclusive rights to reproduce, distribute, publicly present by means of optical devices and broadcast the photograph. In the case of photographs commercially made by employees (for ex. of a newspaper publisher), the related right vests in the owner of the enterprise who is deemed to be the maker under Austrian law (Art. 74(1)). whereas, in Germany, there is ample jurisdiction regarding the extend of the implicit rights transfer to the employer to the result that the employer may use the work without restrictions in the regular course of his business. The economic rights granted to the owner of the related right on simple photographs are the same as those enjoyed by the author of a photographic work, and the copyright exceptions similarly apply to the related right (Austria, Art. 74(7); Germany, Art 72 (1)).[41] However, the moral rights of the maker of a simple photograph are, compared with those of the author of a photographic work, substantially reduced. The related right protection terminates 50 years after the photographs were taken or, where the photograph is made public before the expiry of that term, 50 years after publication (Austria, Art. 74(6); Germany, Art 72 (3)).

II. The scope of the protection of books images in the EU

A. Economic rights enjoyed by the copyright owner

When protected by copyright, images benefit from the full panoply of rights granted by copyright law, in particular by the EU Copyright Directive which provides for:

a) a reproduction right which allows "*to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part*" (Art. 2);
b) a communication to the public right which allows "*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*" (Art. 3);
c) a distribution right which allows "*to authorise or prohibit any form of distribution to the public by sale or otherwise*" (Art. 4).

1. Reproduction

With regard to the digitization of images contained in books, the right of reproduction is relevant as it obviously covers the scanning of the content of books, as well as other technical copies that could be made in the data capture process. The decisions of the CJEU in *Infopaq I and II* confirm that *"an act occurring during a data capture process, which consists of storing an extract of a protected work […], is such as to come within the concept of reproduction in part within the meaning of Article 2 of Directive 2001/29 if […] the elements thus reproduced are the expression of the intellectual creation of their author*" (§22). The agreed statement appended to the WIPO Copyright Treaty of 1996 also confirms that "the storage of a protected work in digital form in an electronic medium" is to be considered as a reproduction.

[40] See M. Walter, *Austria*, in Y. Gendreau, A. Nordemann and R. Oesch (eds.), *Copyright and Photography*, Kluwer Law, 1999, p. 50.
[41] M. Walter, *op. cit.*, p. 66 and 71.

2. Communication to the public

The further making available to the public of the digitized books and their images, for instance through a platform such as Europeana or Google Books, involves the communication to the public right. While the reproduction right always involves a copy on a tangible medium, the communication to the public right covers various forms of making a work accessible by technical means, such as wire transmission, broadcasting through airwaves, or cable retransmission. In several recent decisions[42], the CJEU has listed the conditions for a communication to the public of works: such communication involves a transmission to a « public not present at the place where the communication originates » and it takes place when the work is made available to « a new/additional public »; it is also relevant whether the communication is « of a profit-making nature ». For the application of Article 3 of the 2001/29 Directive, "the private or public nature of the place where the communication takes place is immaterial."[43]

B. Exceptions to the economic rights

Only two exceptions listed in Article 5 of the Copyright Directive, which contains a closed enumeration of the sole exceptions that Member States are allowed to introduce in their national copyright laws, can apply to the use of the digitized images contemplated in a mass-digitization project.

1. Exception for non-commercial reproductions by public libraries and archives

The most relevant exception is that in Art. 5(2)(c) of the Copyright Directive, which provides that Member States may except acts of reproduction "*made by publicly accessible libraries, educational establishments or museums, or by archives, which are not for direct or indirect economic or commercial advantage.*" Some digital libraries cannot be considered as public libraries or archives, and the exception would then not apply as the reproduction clearly is for economic or commercial advantage. Recital 40 of the Copyright Directive makes it clear that this exception is only for the benefit of non-profit making establishments (and should not cover uses made in the context of online delivery of protected works).

In the UK, the scope of the exception for copies for research and private study was amended to implement this aspect of the Copyright Directive and ensure that copies supplied by librarians to users may only be used for non-commercial research or private study (Section 38(2) Copyright, Designs and Patents Act 1988). For books, the librarians cannot copy more than a reasonable portion. Librarians are also allowed to make a copy to supply another non-profit library or to replace or preserve some materials in a collecting (section 41 and 42). Article 5(2)(c) mainly concerns the case of preservation copies, but is likely to apply to other reproductions by non-profit institutions.

In Belgium, Article 22, §1, 8° of the 1994 Copyright Act provides for a restrictive exception allowing "*the reproduction limited to a number of copies according to and justified by the objective of preserving the cultural and scientific heritage, done by libraries accessible to the public, by musea or by archives which do not seek any commercial or economic advantage, directly or indirectly, as long as this does not prejudice the normal exploitation of the work nor prejudices the legitimate interests of the author*". The requirement that the exempted acts do not provide any commercial or

[42] CJEU, 13 Oct 2011, C-431/09 and C-432/09 (*Airfield*); 24 Nov. 2011, C-283/10 (*Globus Circus*); 15 March 2012, C-135/10 (*Consorzio Fonografici v. Del Corso*); 15 March 2012, C-162/10 (*Phonographic Performance Ltd*).

[43] ECJ, 7 Dec. 2006, C-306/05 (*SGAE v. Rafael Hoteles*), § 50.

economic benefit will clearly make it impossible for commercial operators of online libraries to rely on this exception.
The scanning of book images could possibly fall under this exception depending on its objective. However, "*in respect of acts of reproduction made in the context of online delivery, recital 40 (sentence 3) explicitly excludes them from the exception and, in its last sentence, favours licensing contracts that, given the cultural and educational tasks of these institutions, should not create imbalances and should favour the disseminative purposes of the institutions*".[44]

2. Exception for communication to the public and making available on dedicated terminals
Art. 5(2)(c) of the Copyright Directive provides that Member States may except "*use by communication or making available, for the purpose of research or private study, to individual members of the public by dedicated terminals on the premises of establishments*" of non-profit libraries and archives. Such an exception therefore does not allow the library to make the images and books available to the general public, such as through an online portal. The exception is reserved for the use made by individual members of the public at dedicated terminals located in the premises of the non-profit institutions. The drafting of the provision suggests that the privileged uses should be comparable to traditional, analogue uses of books on the spot. The communication to the public of the digitized version of the books images therefore cannot be exempted under that provision.

C. Moral rights

The EU Directives do not confer moral rights, but Article 6bis of the BC grant basic moral rights of attribution and integrity, with the requirements that those rights subsist "independently of the author's economic rights" and that they last until at least 50 years after the death of the author. Several EU Member States (but not the UK) have more robust moral rights[45] that do not necessarily require to establish the prejudice to the honor or reputation of the author.[46] In addition to the moral rights of attribution and integrity, some countries such as France, Germany and Belgium, provide for a right of divulgation/disclosure which allows the author to control when and under which conditions his/her work is made available to the public.
Digitization of photographs brings some challenges:

a) **For the images contained in published books**, only the moral rights of attribution and integrity, in theory, could create some issues. The digitization of images must ensure that the credits for the scanned images remain in the digital version of the books. The digitization process must also avoid that images are substantially modified. The images scanned in the digitization process could be modified with a minimum of efforts. It might be presumed that libraries will not engage in an unlawuful manipulation of the scanned images. However, third parties having access to the digitized files might try to alter the images. This risk requires to put in place an adequate procedure so as to avoid that the files are leaked to third parties and that the images are subsequently altered;

[44] M. Walter and S. Van Lewinski (eds), *European Copyright Law*, Oxford U.P., 2010, p. 1038.
[45] See the comparative study for the European Commission conducted by A. Strowel, M. Salokanel and E. Derclaye at http://ec.europa.eu/internal_market/copyright/studies/index_en.htm .
[46] Article 6bis BC only permits the author "to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation".

b) **For the images contained in unpublished materials,** the right of divulgation/disclosure of the photographs, in principle, would allow the author to oppose the communication to the public/making available of the scanned documents (but scanning the materials and their images would not be objectionable on the basis of the divulgation right). The fact that the unpublished materials have been transmitted to a library does not mean that the divulgation right has been exercised as the owner of the delivered materials is not necessarily the copyright owner regarding the visual materials. In the case of unpublished materials, the photographs, most of the time, will not be directly integrated in the materials (for instance, the "shoe box" delivered to the library might contain some unpublished letters and separate photographs.) The definition of the diligent search for making available such unpublished materials/photos would have to take into account the possible issue triggered by the moral right of divulgation. However, such a problem will not be frequent, and should not be overstated.

III. Clearing the rights: special issues

Clearing the rights on photographs might raise some special issues depending on the categories of books/images and the circumstances.

A. The digitization of photographs of art books

In several countries, courts tend to be reluctant to recognize that photographs of art works, in case of slavish copying, are protected by copyright (see above under II, C). To analyze the clearing issues for the digitization of photographs of art works, we assume that the photographs are protected by copyright.

Let's consider a library which scans a book with a work of a deceased artist, for example Magritte. The photo is a protected work as well as the Magritte painting. Magritte is well-known and it is easy to identify and contact the person/CMO who can authorize the scanning and the making available of reproductions of the Magritte paintings.
Regarding the photographs, things are more complex as the paintings of Magritte have been photographed many times and a dozen photo agencies offer the clichés.
Several situations are possible: i) the name of the photographer and/or of the photo agency appears under the image in the book: in this case, the library can contact the photo agency or the photographer to clear the rights on the photograph; ii) neither the name of the photographer nor the name of the photo agency appears under the image in the book: there is thus no easy way to know who owns the right. The library should benefit from a legal exception or be covered by a blanket authorization from a CMO.

B. The digitization of single works (for ex. a postcard)

Let's assume that an old postcard found on a flea market with a photo of a town is scanned and digitized by a picture library. A photographer is credited but cannot be located. The picture agency makes the picture available to the public under the agency's name. Is the agency a right holder on the picture? No, the simple operation of putting online an existing photograph after its scanning is not protected as long as it only requires some technical expertise and does not lead to any

substantial modification of the photograph (going beyond the minor modifications dictated by the use of digital technologies).

C. The digitization of images in books on photography

Such images are clearly protected as they are likely to emanate from photographers who made highly original shots and substantially contributed to the art of photography, by encapsulating special scenes of life, atmospheres or facial expressions. The clearing of the rights on the images reproduced in those books, however, might create some practical issues. Indeed many photographers only manage their primary rights either alone, through a picture agency or through a CMO. Therefore, some search is needed to identify the right person who should grant the authorization for digitizing such books (it might be the heirs of the deceased photographer, his/her agency or a CMO). For facilitating the rights clearance, it would be helpful if photo agencies and CMOs for visual arts collaborate to collect the relevant information for their respective members and maintain joint updated databases with the relevant information.

D. The digitization of images in scientific publications

1) In the field of STM publications, illustrations usually are selected and even made by the author of the scientific or technical text (possibly with the help of a technical assistant). Therefore, the publishing contract will in principle address the rights issues on the text and on the accompanying illustrations. Obtaining the authorization for scanning and making available the book will in principle allow the similar use of the images in the books. There is thus no specific treatment of the images versus the rest of the book.

2) The documentary aspect of a photograph does not preclude protection by copyright, because originality can also result from the choice and the presentation of the subject matter. In a case involving a collection of photographs of plants for a journal published by the Ministry of Agriculture, a Belgian court considered that the necessary originality was present in the selection and arrangement of the flowers.[47] Collections of photographs are sometimes considered as compilations or databases, and thus enjoy the copyright (and the sui generis right) protection granted by the 1996/9/EC Database Directive.

[47] Civ. Brussels, 12 Nov. 1993, J.L.M.B., 1995, p. 918, Note by Evrard (the selection was based on the botanical knowledge of the photographer and the presentation was didactical).