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Prawo własności intelektualnej – aktualne wyzwania i problemy

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Maciej Barczewski



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Wydawnictwo Uniwersytetu Gdańskiego  
ul. Armii Krajowej 119/121, 81-824 Sopot  
tel. (+48) 58 523 11 37  
e-mail: [wydawnictwo@ug.edu.pl](mailto:wydawnictwo@ug.edu.pl)  
[wydawnictwo.ug.edu.pl](http://wydawnictwo.ug.edu.pl)

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ul. Armii Krajowej 119/121, 81-824 Sopot  
tel. (+48) 58 523 14 49

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**Begoña Ribera Blanes**

University of Alicante, Spain

bribera@ua.es

ORCID: 0000-0002-4887-9013

<https://doi.org/10.26881/gsp.2024.4.01>

## Intellectual Property in Relation to Translations from a Spanish Legal Perspective

### Introduction

Can the entirety of a short written work be incorporated into a longer work without the author's permission under the quotation limit? A recent case decided by the First Civil Chamber of the Supreme Court (TS) on 16 May 2023<sup>1</sup> invites us to reflect on these and other issues affecting translators' rights.

In this case, "Rocío"<sup>2</sup> translated from Japanese into Spanish six historical stories from the literary work of Ogai Mori, one of the two greatest prose writers in Japanese literature, along with his contemporary Soseki Natsume, who is better known in the West than the former because his work has been translated into several languages. The six stories by Ogai Mori that she translated were included in a book entitled *El barco del río Takase* published in 2000 by Luna Books under the sponsorship of The Japan Foundation. The six translated stories were: "El barco del río Takase," "El capataz Sansho," "Sakazuki," "La historia de Iori y Run," "La señora Yasui," and "Las últimas palabras." These six stories were specifically selected because they combine a richness of historical detail with fine descriptions of characters, settings, and situations, all of which help to familiarise the reader with the atmosphere of bygone times. The translator paid special attention to the barriers to understanding that the language and situations in ancient Japanese society might pose to the modern reader.<sup>3</sup>

<sup>1</sup> ECLI:ES:TS:2023:2286.

<sup>2</sup> Although the sentence indicates that the plaintiff was Rocío, it is enough to enter the name of the book *El barco del río Takase* in a search engine to find out that the translator was the Spanish philologist Elena Gallego who had already translated with great care and skill an attractive selection of historical stories by Ogai Mori, previously unpublished in Spanish, which helped to augment the still scarce number of Japanese literary works in direct translation into Spanish.

<sup>3</sup> This is clear from the review of the work found at M. Watkins, *Ogai Mori: 'El barco del río Takase'*, *Luna Books, Tokio, 2000, 141 pp.*, "Cuadernos CANELA: Revista de Literatura, Pensamiento e Historia, Metodología de la Enseñanza del Español como Lengua Extranjera y Lingüística de la Confederación Académica Nipona, Española y Latinoamericana" 1999, nº 11, p. 175 *et seq.*

Subsequently, Cátedra Ediciones (Grupo Anaya S.A.) published a book entitled *Claves y textos de la literatura japonesa*, the first edition of which dates from 2007 and the second from 2015. This book contains, among other texts, the translation of the work “La historia de Iori y Run,”<sup>4</sup> which had previously been translated and published by Rocío, without the publisher having obtained the author’s authorisation in relation to the intellectual property rights deriving from the translation.<sup>5</sup> In view of these facts, Rocío filed an ordinary lawsuit seeking a declaration of infringement of her intellectual property rights by Ediciones Cátedra and an order to cease reproduction and distribution of the book *Claves y textos de la literatura japonesa*, until Ediciones Cátedra obtained the translator’s authorisation. She also sought an order to pay compensation of €6,000 for moral damages, €6,000 plus 5 per cent of the total volume of sales of the book as compensation for damages, or, alternatively, the amount which the judge deemed appropriate in accordance with the evidence at trial. She also asked that the decision be published in a newspaper with a wide national circulation.

The Commercial Court (*Juzgado de lo Mercantil*) nº 7 in Madrid issued a judgment on 19 July 2017 and dismissed the lawsuit considering that the insertion of the *work* (italics added) “La historia de Iori y Run,” of eight pages, into a 715<sup>6</sup> page book dedicated to the analysis and study of Japanese literature, with a quote from the author of the translation, can be considered to fall within the legal limits of the right of reproduction known as the right of quotation.

The judgment at the first instance was appealed against by the plaintiff, and the Madrid District Court, in a judgment of 25 July 2019, partially upheld the appeal. The Court analysed the right of quotation, as regulated in art. 32.1 of the Spanish Copyright Act (LPI, by its acronym in Spanish)<sup>7</sup> and concluded that the reproduction of the plaintiff’s translation in the defendant’s work is not covered by this legal limit, as it is not strictly speaking a fragment, given the purpose of the work and, furthermore, it causes unjustified harm to the legitimate interests of the owner of the derivative work that the translation represents. Thus, it declared that the insertion of the story “La historia de Iori y Run,” as translated by the plaintiff, in the book *Claves y textos de la literatura japonesa* published by Grupo Anaya S.A. infringes the intellectual property

<sup>4</sup> In this story Ogai uses a historical event to show the ideal virtues of a woman from a samurai family, someone capable of enduring long hardships to defend her honour. It also shows the reward she finds.

<sup>5</sup> In Spanish jurisprudence it is common to find cases in which publishers publish translations without the translator’s permission. See SSAP Madrid de 17 de noviembre de 2004 AC 2005/87 y 23 de febrero de 2007 JUR 2007/323281.

<sup>6</sup> The figure of 715 pages is an erratum in the transcript of the judgment of the court of first instance, since in the cassation appeal it is said that the book had 141 pages, and, indeed, that length is what can be deduced from the review found in M. Watkins, *Ogai Mori: ‘El barco del río Takase’*...

<sup>7</sup> Real Decreto Legislativo 1/1996, de 12 de abril, por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia, BOE-A-1996-8930 Real Decreto Legislativo 1/1996, de 12 de abril, por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia.

rights belonging to Rocío. Accordingly, it ordered the cessation of the reproduction and distribution of the book published by the defendant until it obtained the plaintiff's authorisation. With regard to the compensation for damages, the Court dismissed the compensation for moral damages and awarded damages of €2,000, plus 2% of the profit obtained from the sale of the book *Claves y textos de la literatura japonesa*.

The appeal judgment was appealed against in cassation by Grupo Anaya S.A. on the basis of a single plea, which is the infringement and misapplication of art. 32.1 LPI and art. 40 bis LPI, as an interpretative criterion of the limits of quotation, in accordance with art. 3.1 CC and the case law that interprets it. According to the publisher, the inclusion of "La historia de Iori y Run" in *Claves y textos de la literatura japonesa* is fully justified, and the publisher gives several reasons for this. Firstly, because a 7-page story which the publisher calls a "fragment" from a 141-page work (*El barco del río Takase*) is incorporated by way of quotation into Chapter 11 of the book *Claves y textos de la literatura japonesa*, a chapter devoted to "La modernidad: Soseki y Ogai," in order for the reader to be able to assess Mori Ogai's work. Secondly, according to the appellant, it should be noted that the fragment is included with a footnote referring to the book from which the "fragment" is taken, to the author, to Rocío's translation, and to the original publisher and the year of publication, as well as giving the excerpted pages of the book. Thirdly, according to the appellant, the inclusion of the fragment falls within the scope of "fair use" because the translation had never been published in isolation, so that its use does not infringe the normal exploitation of the work and benefits the translator. Finally, the appellant argues that the work incorporating the story is of a critical, research, and teaching nature and that the text reproduced is intended to serve as a sample of the work of one of the leading figures in modern Japanese literature, illustrating his way of writing, the themes which interested him, his style, etc., and that the inclusion of the translation is, therefore, for academic reasons.

The Supreme Court dismissed the appeal lodged by the defendant publisher, stating that in the present case the full reproduction of "La historia de Iori y Run," even if it occupies only a few pages in relation to the whole of the published work, constitutes a completely independent unit that cannot be considered a fragment of another work. Moreover, the inclusion is not for the purpose of reviewing, analysing, commenting on, or criticising the text, but the reproduction is incorporated into an anthology of texts whose purpose is communication. The very title of the defendant's work (*Claves y textos de la literatura japonesa*), in which the work translated by the applicant is included, expresses the purpose of the book: an explanation of Japanese literature which is illustrated and supplemented by the transcription of texts which are considered to be highly representative. For all of the above reasons, the appeal was dismissed and the judgment of the Court of Appeal was upheld.

## 1. Translation as a work protected by intellectual property rights

First of all, it should be noted that the facts on which this dispute is based have to do with the unlawful reproduction and distribution of the translation of a short story. According to World Intellectual Property Organization (WIPO) “translation is the expression of written or oral works in a language other than that of the original version.”<sup>8</sup> It should be borne in mind that translation cannot concern any work, only those that use language as a means of expression entirely (a literary work) or in part (a film, a comic book).<sup>9</sup>

From a subjective point of view, a work is original when it is the author’s own creation on which he/she has left his/her own imprint. This criterion of subjective originality considers it sufficient to carry out an activity of a creative nature for the result (the work) to be imbued with the creator’s personal imprint and to be considered original.

In the case of translations, originality is more difficult to determine since, on the one hand, a minimum level of creativity<sup>10</sup> is required of the author of a translation while, on the other hand, a translation must be faithful to the translated work. Indeed, mechanical and literal translation is not considered to produce protected work because there is no creative contribution on the part of the translator, since anyone translating the work would arrive at the same result, so there is no translation but merely a reproduction of a pre-existing work.<sup>11</sup> The translator must have the sensitivity, preparation, and knowledge necessary to express as faithfully as possible what the author of the original work wished to convey. He or she must respect the author’s thought as much as possible and, in order to convey it, must use the necessary turns of phrase, grammatical constructions, and periphrasis.<sup>12</sup> There is no doubt that the originality of the translation also depends on the originality of the translated work,<sup>13</sup>

<sup>8</sup> WIPO Glossary of 1981, entry 253.

<sup>9</sup> This use of language as a basic (though not necessarily exclusive) means of expression is the determining factor for a piece of work to be a translation of an original work. It is not possible to translate a pictorial, sculptural, or architectural work, nor a piece of music or a perfume, since their comprehension is exhausted in the simple appreciation of the work. On the other hand, other works composed of linguistic elements (even partially), such as a film, a comic book, an audiovisual presentation, etc., may be translated, E. Olmedo Peralta, *La propiedad intelectual de las traducciones*, “Actas de Derecho Industrial y Derecho de Autor” 2013–2014, vol. 34, p. 213.

<sup>10</sup> C. López Sánchez warns that a certain level of creativity is required, which is not always easy to establish, *La transformación de la obra intelectual*, Madrid 2008, p. 69.

<sup>11</sup> As an example in which a minimum of level of creativity is not appreciated, we can see the judgment of the District Court (SAP) Madrid 28 de octubre de 2013 JUR 2014/10009.

<sup>12</sup> It is precisely in this task of having to decide between the various possibilities of expressing the pre-existing work that the translator’s creativity lies. If we were to put two translators to work on the same text, the results would be different, R. Casas Vallés, *El estatuto jurídico del traductor*, II Jornadas sobre el derecho de propiedad intelectual de los escritores en la práctica, nº 5, Madrid 1997, p. 80.

<sup>13</sup> The language used in scientific works requires literalness in translation; so any creative contribution will be limited in scope; on the other hand, artistic literary works allow a certain degree of interpretation by the translator, which implies a greater degree of participation on his or her part, E. Olmedo Peralta, *La propiedad...*, p. 214.

because translating a poem is not the same as translating a novel or a doctoral thesis, since, in this case, the translator must not only master the source and target language but also rhyme and meter. In short, in terms of originality, we can distinguish between absolutely original works and relatively original works. A translation is a relatively original work: it is original in its form of expression,<sup>14</sup> but it is limited by the duty of fidelity, which means that the translator cannot delete fragments or add others; nor can he/she change the meaning of the words or the order of the sentences. In short, the content and structure must remain intact.

The issue of the originality of translations came before the Spanish High Court on the occasion of a judgment from 29 December 1993.<sup>15</sup> In this case, the author of the Spanish translation of William Shakespeare's play entitled *Julio Cesar* sued the author of a later version of the same play which partially incorporated the translation made by the plaintiff. In this case, the Court considered that there were qualitatively and quantitatively significant similarities between the defendant's version and the author's translation, as evidenced by paraphrasing, syntactic structures, lexical and verbal similarity, and that in the defendant's translation there appeared to be no real original contribution, facts from which no other conclusion could be drawn than that the defendant, who admitted having used the plaintiff's translation for the theatrical adaptation of Shakespeare's work, reproduced, in part, the plaintiff's translation.

The most authoritative legal doctrine considers that the status of a work of translation can derive simply from art. 10.1 LPI, which covers "all original literary, artistic or scientific creations expressed by any means or medium," but in the event of any doubts,<sup>16</sup> art. 11 LPI expressly refers to translations by establishing that "without prejudice to the copyright on the original work,<sup>17</sup> the following are also subject to intellectual property rights: 1) Translations and adaptations." The provision is consistent with art. 2.3 of the Berne Convention of 1886 (Paris revision 1971), according to which, "Translations, adaptations, musical arrangements and other transformations of a literary or artistic work shall be protected as original works, without prejudice to the copyright of the original work." Again, it can be seen that the legislative text is incorrect because both kinds of work are original, although some are absolutely original and others relatively original. Thus, derivative works are relatively original.<sup>18</sup>

A translation will be a work if it is original, it being irrelevant whether the translation is good or bad, whether the source or target language is easy or difficult, whether the degree of usefulness is high or low, and even whether it has been fixed in a medium or not. Hence oral translations, even if they are simultaneous and therefore more

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<sup>14</sup> See, among others, J. Carbajo González, *La nueva regulación española en materia de Propiedad Intelectual (II)*, "Actualidad Civil" 1989, nº 3, pp. 3046–3047.

<sup>15</sup> RJ 1993/10161.

<sup>16</sup> R. Casas Vallés, *El estatuto jurídico...*, p. 80.

<sup>17</sup> It would have been better to say pre-existing work or translated work because in reality both translated works and translations are original, even if the former are absolutely original works and the latter are relatively original works as noted above.

<sup>18</sup> C. López Sánchez, *La transformación...*, p. 70.

spontaneous, can perfectly well be works. Even if the translation is original, it can be deprived of the status of work when there is an overriding interest in facilitating as much as possible the public's access to the information contained in the translation. Such is the case of art. 13 LPI, according to which, "Legal or regulatory provisions and their corresponding drafts, the resolutions of jurisdictional bodies and the acts, agreements, deliberations and opinions of public bodies, as well as the official translations of all the above texts,<sup>19</sup> are not subject to copyright." According to this provision, official translations of the aforementioned texts will not be protected as works, but it should be noted that the removal of protection only affects translations made by public bodies, because the private translation of an official document is protected as a work.

In the case discussed here, what is reproduced and inserted in an anthology of texts is a short story written in Japanese that has been translated into Spanish by Ms. Rocío; therefore, the translation relates to a literary work. In the proceedings, none of the parties raised the issue that the translation might not be a work protected by intellectual property rights. In fact, it was assumed that the translation was a work and that the author's (translator's) reproduction and distribution rights might have been infringed. However, it is settled case law of the Court of Justice of the European Union (CJEU) that in the event of any possible infringement of intellectual property rights, the first thing to be ascertained, as a preliminary step, is whether the facts relate to an intellectual creation worthy of protection.<sup>20</sup> For a piece of creation to be classified as a work, two requirements must be met simultaneously. On the one hand, it must be original, in the sense of being the author's own creation, although to be more precise, and taking into account what has been said above about derivative works, it is sufficient for the work to be relatively original because of the service relationship that must exist between a translated work and a translation and, on the other hand, because qualification as a work is reserved for the elements that express this original creation, in this case, language as a vehicle of expression. The SC (TS) assumed that the translation was original and, consequently, that it was protected as intellectual property rights. It did not consider whether it was original or not, whether it was of high quality, or whether the source language was difficult (which it undoubtedly is). From our point of view, the translation was original, since it is a historical story that

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<sup>19</sup> R. Casas Vallés, discusses the exact meaning of the term "official translation." According to this author, it is clear that any translation of non-protected material carried out by a private individual or company on their own initiative falls outside this concept. This would be the case of many laws and verdicts translated from Spanish into Catalan by private initiative. The problem arises more with translations sponsored or commissioned by public entities. Are they all official? Certainly not. Only those translations that are recognized, by a competent authority, as having the proper effectiveness of the translated text can be considered official, *El estatuto jurídico...*, p. 82.

<sup>20</sup> Sentences of 16 July 2009, Infopaq International A/S v. Danske Dagblades Forening (Case C-5/08); 1 December 2011, Eva-María Painer v. Standard Verlags GmbH and others (Case C-145/10); 7 August 2018, Land Nordrhein-Westfalen v. Dirk Renckhoff (Case C-161/17); November, 13, 2018, Levola Hengelo BV v. Smilde Foods BV (Case C-320/17).

uses archaic language and is set in a Japanese society that has little to do with today's society.

## **2. The right to translate as the exclusive right of the author of a pre-existing work**

According to art. 21.1 LPI, "the transformation of a work includes its translation, adaptation and any other modification in its form from which a different work is derived." Translation is a form of the exclusive right of transformation. It is, together with adaptation, the most classical and traditional form of transformation of a pre-existing work. Although it is often referred to as the "right of translation," it is in fact a modality or faculty of the right of transformation. It is the author of the pre-existing work who has the exclusive right to translate the work him/herself or to authorise a third party to translate it. This understanding of the right is consistent with art. 8 of the Berne Convention and art. V.1 of the Universal Copyright Convention of Geneva of 6 September 1952.

As this is a form of an exclusive right, only the author can authorise the translation of his or her work. For a long time it was thought that being translated was an honour and that it was not necessary to ask the author's permission.<sup>21</sup> Today, there is no doubt that the author's permission is necessary. It can only be dispensed with if the translator only wants to make a private translation of the pre-existing work for his or her own personal use.<sup>22</sup> Such a private translation may not be disclosed without the consent of the author of the translated work. Nor is the author's consent required if the work to be translated is in the public domain, since in that case the work may be freely translated by anyone, provided that the authorship and integrity of the work is respected.<sup>23</sup> However, the most common situation is that the translation is of a work whose copyright is still in force (during the author's life plus seventy years after his/her death according to art. 26 LPI) and that the aim of the translation is not merely to make a personal use of the work, but to disseminate the translation to third parties. In this case, the author of the pre-existing work must authorise the translation. The

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<sup>21</sup> Both in the Law of 5 August 1823, and in the Law of 10 June 1847, translation is free, that is to say, no general right of translation is recognized for the author. It was not until the promulgation of the Law of 10 January 1879 that the author's permission was required to translate his/her work.

<sup>22</sup> The author cannot prevent others from transforming his/her work, including translating it without the purpose of exploiting or disseminating the translation: freedom of expression and research prevails over the monopoly of the rights holder, which does not extend to private uses. The rights holder cannot prevent a person from translating another person's work; what he/she can prevent is its collective or commercial use, J.M. Rodríguez Tapia, *Artículo 21* [in:] *Comentarios a la Ley de Propiedad Intelectual*, Madrid 2007, pp. 178 y 179.

<sup>23</sup> Any translation of a work, even if that work has fallen into the public domain, involves an intellectual effort on the part of the translator, which gives rise to a new creation worthy of intellectual protection, E. Olmedo Peralta, *La propiedad...*, p. 217.



same work may be translated by different persons provided that they all have the authorisation of the author of the pre-existing work.<sup>24</sup>

An author can directly authorise a translator to translate and exploit his/her work, but more commonly the author authorises a publisher to translate his/her work into certain languages and it is the publisher who finds the translators and concludes contracts with them. Once such authorisation is obtained and the translation is carried out, there are two works in play: the pre-existing work and the translation, both protected by copyright and whose rights must be made compatible.<sup>25</sup> Article 21.2º LPI refers to this issue, according to which, "The intellectual property rights of the work resulting from the transformation correspond to the author of the latter, without prejudice to the right of the author of the pre-existing work to authorise, during the whole term of protection of his rights over it, the exploitation of these results in any form and in particular by means of its reproduction, distribution, public communication or new transformation." It can be inferred from this provision that the author who is authorised to translate will have the copyright to the translation, provided that it meets the standard of originality, but the specific forms of exploitation of the translation must have been previously authorised by the author of the translated work and the latter must participate in the results of the exploitation of the translation in a previously agreed proportion. In the event that the translation is made and exploited without the authorisation of the author of the pre-existing work or without considering the author's rights as the author of the work, this constitutes an infringement of copyright with regard to the pre-existing work, which may give rise to the author or his/her heirs being able to take action for injunctions against the commercial exploitation of the translated work and to claim compensation for damages suffered in accordance with art. 138 to 141 LPI.

It is clear from the case on which this judgment is based that it was not Ogai Mori who translated the disputed story from Japanese into Spanish, but the applicant Rocío. Therefore, the author did not exercise the right to translate his own work, at least as far as the Spanish version of this story is concerned. The author died in 1922 and the copyright law in force in that year was the Japanese Copyright Law of 1899, which established a term of copyright protection of thirty years from the date of the author's death. Therefore, Ogai Mori's work entered the public domain in 1952. From that date onwards, no authorisation was required from Ogai Mori's successors for his work to be translated. His work could be translated by anyone as long as the moral rights of the integrity and paternity of the work were respected. It was in 2000 when Luna Books published the book *El barco del río Takase* which included Ogai Mori's short story "La historia de Iori y Run" translated from Japanese into Spanish by Rocío. We do not know whether it was the publisher Luna Books that took the initiative to select and hire Rocío to translate the story and then to exploit the translation by publishing

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<sup>24</sup> See Judgment of the District Court (SAP) Madrid de 18 de mayo de 2000 JUR 2000/279272.

<sup>25</sup> The most characteristic feature of translation is the presence of two authors (the translator and the translated).



the book (via a translation contract) or whether it was Rocío who took the initiative to translate and exploit the translation (via a publishing contract). In any case, the authorship of the translation of the story is not disputed and is attributed exclusively to the plaintiff Rocío.

### **3. The translator as author**

The author is the natural person who creates the derivative work that constitutes the translation and acquires the copyright by the mere fact of the creation of the work, according to art. 5.1 LPI. The person who appears as such in the work through their name, signature, or identifying sign is presumed to be the author, unless proven otherwise. The translator has the right to disclose the translation anonymously or under a pseudonym, without losing his or her copyright to the translation (art. 6.2º LPI). Occasionally, a publisher introduces modifications to the translation with which the translator does not agree. Although this circumstance is an infringement of the translator's right to the integrity of the work, it is quite common for this to occur and for the translator to decide to publish the translation anonymously or under a pseudonym.

Once the translation has been made, the law grants the translator all the rights that are granted to authors: moral rights (for example, the translator may choose to withdraw from the market an old translation that he/she no longer likes by paying compensation, or he/she may request access to a single copy of the translation if he/she did not keep a copy of it when he/she gave the original to the publisher), economic rights, and simple remuneration rights. The translation is a work independent and autonomous from the translated work; so it will enjoy its own term of protection, which, according to art. 26 LPI, covers the life of the author plus seventy years after his/her death or the declaration of his/her death. Therefore, the period of protection of the translated work cannot be associated with that of its translation, since the translated work may be in the public domain, but the translation of the same work may be protected. Therefore, a new translation of the translated work may be made without asking the author's consent because it is in the public domain, but the translation of the same work may not be used if it has rights in force without asking the translator's authorisation, unless the intended use of the translation is covered by some limit.

In the case under discussion, there is no doubt that it was Rocío who undertook the translation and the copyright to the translation must be attributed to her. The original Japanese version of the story is in the public domain, which means that it can be freely translated by anyone as long as the authorship and integrity of the work is respected. Rocío did not need the author's permission to translate his work. While the translated work is in the public domain (the original Japanese version of the story), the Spanish translation is protected, as the translator is still alive and art. 26 LPI applies, which establishes a term of protection of the author's life plus seventy years from his or her death or the declaration of his or her death. Even if the translated work is in the public

domain, the translator's rights must be respected for as long as the protection is in force. Translators are attributed the same rights as authors; therefore, Rocío has moral rights, economic rights, and simple remuneration rights over the translation. If the publisher Ediciones Cátedra wanted to use the Spanish version of the story "La historia de lori y Run," it should have asked Rocío for permission and paid her for the use of her work. However, it decided, without her permission, to include the full Spanish version of the story in an anthology of texts, which was a clear infringement of both the right of reproduction and the right of distribution attributed to the translator.

## 4. The quotation limit

### 4.1. Current regulation

Right of quotation is one of the exceptions or limits to copyright that is most widespread from a global perspective, which has made its presence clearly apparent in the articles of all the laws that regulate copyright within different legal systems. It is not for nothing that Claude Colombet describe it as "a classic exception,"<sup>26</sup> unlike other exceptions that only appear in certain laws. However, in every legislation the regulation is different and, although it is based on a common denominator, the requirements that accompany the limit in the legislation of each country are not fully coincident.<sup>27</sup>

According to art. 32.1 LPI, "It is lawful to include in one's own work fragments of other works of a written, sound or audiovisual nature, as well as isolated works of a plastic or figurative photographic nature, provided that they are already published and their inclusion is made by way of quotation or for their analysis, commentary or critical judgment. Such use may only be made for teaching or research purposes, to the extent justified by the purpose of such incorporation and indicating the source and the name of the author of the work used."

As a starting point, it should be noted that our legislator does not define what is meant by quotation, although legal doctrine understands it as the reproduction of extracts of another's work in order to include them in one's own work,<sup>28</sup> on the assumption that such foreign contents are protected by intellectual property rights.

<sup>26</sup> *Grandes principios del derecho de autor y los derechos conexos en el mundo*, Madrid 1997, p. 70.

<sup>27</sup> The regulation of this limit in national laws has followed different trends. While the continental countries of Europe, members of the Berne Convention, have adopted the method of establishing precise rules for the exercise of the citation exception, British law has made extensive use of the notion of fair dealing to judge the situations in which this right may be exercised, H. Wistrand, *Les exceptions apportées aux droits de l'auteur sur ses œuvres*, Paris 1968, p. 150. Even among continental countries, the differences are significant. German law has at that time conceived of citation much more broadly than French law, B. Ribera Blanes, *El derecho de reproducción en la propiedad intelectual*, Madrid 2002, p. 252.

<sup>28</sup> See S. López Maza, *Artículo 32* [in:] *Comentarios a la Ley de Propiedad Intelectual*, ed. R. Bercovitz Rodríguez-Cano, Madrid 2017, p. 623; C. Saiz García, *Artículo 32. Citas y reseñas de ilustración con fines educativos o de investigación* [in:] *Comentarios a la Ley de Propiedad Intelectual*, eds. F. Palau, G. Palao, Valencia 2017, p. 525.

If we observe this precept, we see that the legislator focuses, in its first words, on determining the nature of the works that can be cited (literary works, musical works, audiovisual works, works of plastic art) and establishes a different treatment of what can be quoted according to the type of work (fragments in some cases and isolated works in others), and then establishes certain requirements for quotations to be lawful (they must be published works, by way of quotation or for analysis, commentary, or critical judgment for teaching or research purposes, and the source and the name of the author must be indicated).

#### **4.2. Nature of works that can be quoted and the permissible length of the quotation. The concept of a fragment**

Regarding the first issue, it is important to point out that, unlike the 1879 LPI, which limits the quotation exception to printed works, the current provision allows the quotation of any type of work. It lists the most common types of works (literary, musical, audiovisual, plastic, and photographic works), which does not mean that only the works it mentions can be quoted, since it must be understood that it is not an exhaustive or *numerus clausus* enumeration, but an exemplary or *numerus apertus* enumeration. What is not determined is the nature of the work that incorporates the quotation; therefore, it must be understood that any type of work may contain quotations of works of any nature.<sup>29</sup> In the case under discussion, what is reproduced is a story; so the story falls within the concept of “work of a written nature.” It is a literary work, which in this case was also expressed in writing, which applies both to the translated work and to the subsequent translation prepared by the plaintiff.

Precisely this question of the *quantum* of what can be quoted was the subject of debate during the parliamentary *iter* of the provision. The draft legislation read as follows: “It is lawful to include in one’s own work the whole or part of another work already published by way of quotation or for analysis, commentary or critical judgment, for teaching or research purposes, to the extent justified by the purpose of such incorporation and indicating the source and the name of the author of the work used.”

Some amendments were proposed in order to eliminate the term “totality” from the legal text, since its presence could validate the inclusion of complete works, which would conflict with the very purpose of defining the term “quotation.”<sup>30</sup> The literal

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<sup>29</sup> F. Lledó Yagüe, *Comentario al art. 31 LPI* [in:] *Comentarios a la Ley de Propiedad Intelectual*, ed. R. Bercovitz Rodríguez-Cano, Madrid 1989, p. 512.

<sup>30</sup> What may be allowed to be admitted when criticising or commenting on an artistic work (which is the reproduction of the work of another in its entirety), would always be disproportionate and out of all acceptable use in the case of a literary work; the text of this art. 32 of the draft legislation, by not establishing any distinction, seems to allow it if the reproduction of the work in its entirety is intended for commentary or critical judgment and is made for teaching or research purposes. It would be detrimental to the author’s rights to legally authorise the reproduction of the whole of a literary work, without his/her authorization, even by way of quotation or commentary, H. Baylos Corroza, *Acotaciones al nuevo Proyecto de Ley de Propiedad Intelectual*, “Revista General de Legislación y Jurisprudencia” 1986, nº 261, p. 539.

interpretation of this provision could result in serious infringements of the legitimate rights of the authors of the works quoted. However, the elimination of the term “totality” would mean that all works would have to be quoted in the form of fragments, which would pose significant problems in the context of artistic works, since partial reproduction of these would not be able to convey a complete view of the work and could damage its integrity.

Ultimately, it was decided to delete the term “in its totality” and to reformulate the text in order to establish a distinction as to the manner of quoting works of third parties; allowing quotation in fragmentary form in some cases and in its entirety in others, depending on the nature of the work in question. Literary, audio, or audiovisual works may not be quoted in their entirety; however, artistic or photographic works may be reproduced in their entirety.

Thus, in the case of works of a written, audio, or audiovisual nature, only the inclusion of parts or fragments is allowed. This condition has been endorsed by Spanish case law since the entry into force of the rule, as can be seen in the resolution of a case in which students of the University of Zaragoza had acquired photocopies of entire works that had been reproduced without the consent of the authors.<sup>31</sup> The Court warned that the quotation limit, as regulated in art. 32.1º LPI, could not be applied for several reasons: there was no teaching or research purpose on the part of the students; the quantitative limit established by the provision had been breached, since the precept only allows the inclusion in one’s own work of fragments of other’s works, not the inclusion of an entire copy of the same, and, finally, the requirement to incorporate the fragments of another’s work in one’s own work failed, since the latter did not exist.

The number of extracts that may be quoted is not indicated in the provision and must depend to a large extent on the nature of the work and the purpose to be achieved. There are certain types of works that require a greater number of quotations than others. Let us think, for example, of a doctoral thesis, a historical work, a biography, or any scientific/scholarly work. This type of work needs to provide the opinions, data, and theories that have already been expressed on certain issues that constitute the starting point of the second work.

In the case under discussion here, the translation from Japanese into Spanish of “La historia de Iori y Run” is reproduced in its entirety. It is a short story or tale that occupies only a few pages (8) within the book in which it is included (175), but this does not prevent it from being a work that constitutes an autonomous and independent unit and, as such, one that deserves to be protected by intellectual property rights. In the judgment passed by the courts of first instance, it is striking that, despite qualifying the reproduced story as a “work” and not as a “fragment,” importance is nevertheless given to its small size in relation to the whole of the publisher’s work in order to consider that the insertion can be included within the limit of quotation. This argument is to be strongly criticized. It is not acceptable to consider that an autonomous and independent work (such as this short story), being short, can be reproduced in its

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<sup>31</sup> Judgment of the District Court (SAP) Zaragoza 2 de diciembre de 1998 BDA 2303.

entirety by a third party without the translator's permission and that it be covered by the quotation limit. This aspect is refuted by the judgment of the District Court. It emphasizes that "the insertion of the story in the defendant's work was not of a part but of the whole, which is hardly compatible with the literal meaning of the term fragment" and "that the story is presented as an autonomous and differentiated work with its own substantivity;" so it does not consider that the insertion is covered by the limit of quotation contemplated in art. 32.1 of the LPI.

In the appeal, the publisher insists, in order to justify its actions and to be able to protect those actions under the legal limit of quotation, that what it used is a fragment. It recurrently uses this term to try to convince the judge of what it knows it is not. The publisher mentions that "this quotation constitutes a fragment of 7 pages," that "the quotation of this fragment is made in chapter 11 of the book," that "the inclusion of this fragment is made in order to evaluate Mori Ogai's work," that "the inclusion of the fragment is made with a footnote referring to the book from which the fragment is taken," that "the inclusion of this excerpt is within the meaning of fair use," that "the excerpt 'La historia de lori y Run' has never been published in isolation," that "the work in which the excerpt is included has a critical, research and teaching character," and, in conclusion, that "it is an excerpt and an honest use has been made that does not harm the plaintiff, but, on the contrary, benefits her." We fail to see in what sense it can be understood that seeing your work copied and distributed without your permission can be a benefit. The only beneficiary is the publisher, since it reproduces and distributes someone else's work without having asked permission, and therefore without having paid any corresponding remuneration to the author of the translation.

Before responding to the argument that what was used is a fragment, the SC (TS) recalls that it is going to take as a starting point the facts considered proven in the relevant instance: that a story that had been translated by Rocío has been reproduced and that it is she who holds the intellectual property rights over the translation. In an attempt to address the merits of the case, the Court reviews some issues that have already been dealt with here: it recalls that the translation is a derivative work that also generates copyright; that the translator holds in particular the right of reproduction (the Court forgets to mention the right of distribution, which is also affected by the publisher's actions); and that the reproduction should have been made with the translator's authorization, unless the limit of quotation of art. 32.1 applies, also provided for in art. 5.3d) of the Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (DDASI) and in art. 10.1 of the Berne Convention.

From there, the Court admits that the first controversial issue revolves around whether what is reproduced by the publisher is a fragment. In order to examine the question more closely, and taking as a starting point the text of art. 32.1<sup>o</sup> LPI itself, it states that "the term fragment is used by the law as opposed to the whole of a work" and that "the inclusion of the whole of a written work, within another, falls outside the notion of quotation." The Court then considers that the purpose of the reproduction

also helps to interpret in each case what is meant by fragment. According to the Court, a “fragment is not the whole. Of course it is not a fragment when that text has been published as such, in its entirety and independently [...] In the present case, the reproduction of another’s written work is a reproduction of a text (in its entirety) that occupies several pages and has a unity and independence with respect to the rest, it is a narrative or short story.”

However, the Court understands that what is to be considered a fragment may be determined by the purpose of the reproduction, so that it creates a kind of link between the two requirements of the limit: the length and the purpose of what is quoted. As admissible purpose, it cites “in addition to the mere quotation in the strict sense (a brief and concise review), the analysis, commentary or criticism of the text.” What the High Court means is that the length of the quoted text may not be so important if the reproduction is justified by the purpose that the reproducer intends to achieve. Next, the Court itself warns, anticipating its own conclusion that “in no case is this reproduction justified when the text is incorporated into an anthology of texts, since then it is clear that the purpose is not its analysis, commentary or criticism, but its communication.” The Court goes deeper into this issue and warns that it is necessary to distinguish what is more important: whether the purpose is to reproduce another’s work to illustrate an idea or to transcribe a text to comment on it. Without going into the issue of the purpose of the limit, which will be dealt with later, what interests us here is that the Court concludes that “in this case the complete reproduction of ‘La historia de Iori y Run,’ although it occupies a few pages in relation to the whole of the published work, as it constitutes a totally independent unit, is not properly a fragment of another work.”

### **4.3. Requirements for quotations to be lawful.**

#### **The relevance of purpose as a key element in these**

Once the nature of the works that may be quoted and the *quantum* of what may be cited according to the type of work have been determined, art. 32.1º LPI establishes the following requirements for quotations to be lawful: 1) the works cited must have been disclosed; 2) the inclusion must be made by way of quotation or for analysis, comment, or critical judgment; 3) the use may only be made for teaching or research purposes; 4) the use must be made to the extent justified by the purpose of such incorporation; and 5) the source and the author’s name must be indicated.

First, the rule requires that the quoted works have been previously disclosed. This condition is not expressly required in art. 7.1 LPI of 1879. According to art. 4 LPI, disclosure of a work means any expression of the work that, with the author’s consent, makes it accessible to the public for the first time in any form. This condition is the same as that imposed by art. 10 of the Berne Convention, which has led many countries to enshrine in their legal texts this requirement of disclosure for quotations.

The requirement of prior disclosure is based on the moral right of the author, since the right of disclosure is one of the moral attributes that the LPI grants exclusively to

the author of an intellectual work (art. 14.1º LPI). The disclosure of a work is a decision that belongs exclusively to the author, so that the person who quotes another's work cannot replace the author of the quoted work in his/her will to disclose the work, not even in the form of extracts. The moral right of disclosure includes the power to decide on the disclosure and the form in which it should be made. In no case is it required that the work that cites be disclosed in the same way as the quoted work. It is perfectly possible for the author to have disclosed his/her work orally and for the quotation to be included in a written work. The quotation will be lawful if the other requirements of the rule are met.

In our case, Rocío's translation was published in the book *El barco del río Takase* in 2000. Therefore, the work allegedly quoted had been previously disclosed by its author so that this first requirement of the precept must be understood as fulfilled. It is fulfilled given the circumstance that the work incorporating the alleged quotation had also been disclosed in the same way as the cited work, that is, through the publication of a book entitled *Claves y textos de la literatura japonesa*, whose first edition dates from 2007 and of which a second edition dates from 2015. The SC (TS) itself in the second legal basis for the judgment (point 4 of the judgment) recalls that the reproduced work must be disclosed and that this is a requirement "whose fulfillment is not disputed" in this case.

The second condition for the lawfulness of the limit of quotation under Spanish law is that the inclusion is made "by way of quotation or for its analysis, commentary or critical judgment." This means that the legislator allows quotation, analysis, commentary, and critical judgment as independent categories, understanding that quotation is the mere literal reproduction of content in a work,<sup>32</sup> without the incorporator having to make any personal contribution.<sup>33</sup> Although it is quite common for the inclusion of another's work to be accompanied by such contribution, the legislator does not require it.

It has to be pointed out that the District Court of Madrid stresses the importance of the purpose of the insertion of the alleged fragment and analyzes this requirement exhaustively to ascertain whether the fragment is indeed included to be analyzed, commented on, or judged in compliance with the provisions of art. 32.1º LPI. In this context, the Court observes that the book *Claves y textos de la literatura japonesa* has two clearly differentiated parts, as the title itself implies. The first part is a study of Japanese literature based on ten keys (geography, history, language, religion, society, literary theory, aesthetics, verse, prose, and theater). The second part is an anthology of several works by different Japanese writers, preceded by a presentation of the author, thus offering some contextualization. For the Court of Appeal, it is important to note that the term "anthology" is used several times throughout the book and that the author calls himself a "compiler" in reference to this second part of the work. It is

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<sup>32</sup> S. López Maza, *Artículo 32...*, p. 629.

<sup>33</sup> P. Mariscal Garrido-Falla, *El límite de cita a la luz de la directiva 2001/29 y de la Ley de propiedad intelectual. Evolución jurisprudencial* [in:] *Estudios sobre la Ley de propiedad intelectual: últimas reformas y materias pendientes*, Madrid 2016, p. 420.



in Chapter 11 of that second part of the book that the story “La historia de Iori y Run” is inserted. The chapter is entitled “Modernidad: Natsume Soseki y Mori Ogai.” In the first sections reference is made to these two authors; in the third section there is a text by Tarsilla; and in the fourth section the disputed story is inserted, preceded by some brief comments regarding its subject matter.

Based on these considerations, the Court of Appeal argues that the story is inserted in the second part of the work and, therefore, the insertion is not made with the intention of issuing a critical judgment on Japanese literature, a purpose that is more proper to the first part. The inclusion of stories in the second part was not essential to achieve the purpose of the first part of the work and is actually presented as a distinct complement to that first part. The purpose of the story is to form part of an anthology of texts that allows the reader a direct approach to certain significant examples of Japanese literature. Therefore, the Court does not consider that “the insertion of the story is covered by the limit of the right of quotation contemplated in art. 32.1º LPI.” Furthermore, it adds that the anthology is a collection of other people’s works that by virtue of art. 12 LPI do not lose their autonomous protection by the fact of being included in the compiled work.

The Supreme Court refers to this second requirement of art. 32 LPI in point 3 of the second legal basis of the judgment, stating that “this inclusion of a fragment of another’s work must respond, if it is not a mere review, to a purpose of analysis, commentary or critical judgment.” From there, it analyzes the requirement and warns in point 4 of the same legal basis for judgment that the purpose of the reproduction clearly exceeds mere review, and that the question revolves around whether it responds to the purpose of analysis, commentary, or critical judgment, which may be considered in accordance with fair use.

In point 6, the Supreme Court states that the purpose of the reproduction may be “mere quotation in the strict sense (a brief and concise review), analysis, commentary or criticism of the text.” Before analyzing the case, it gives a warning that connects with its subsequent solution: “In no case is this reproduction justified when the text is incorporated into an anthology of texts, since it is then clear that the purpose is not its analysis, commentary or criticism, but its communication.” Following this reflection, the SC (TS) recognizes that some publications may contain features of both academic studies and anthologies, in the sense that texts can be incorporated for analysis and also in order to illustrate something. But in these cases it is necessary to see what takes precedence: the purpose of illustrating or the purpose of analyzing. The SC (TS) implies that the purpose of illustration is not the one required by law in order to be covered by the right of quotation, but that requirement is that the purpose be one of analysis, comment, or critical judgment.

Once these reflections have been made, the SC (TS) returns to the case to affirm that the reproduction of the story is not a mere review and that the compilation element prevails over analysis, commentary, or critical judgment of the text itself. The SC (TS) concludes that honest uses are marked by the purpose pursued, but that here the reproduction of another’s work does not conform to fair use because there is no



evidence of the existence of a critical study of the work reproduced, but rather the book (which is not an academic or scholarly study), after explaining what Japanese literature is, seeks to reproduce a text that serves to illustrate the essential characteristics of the literary work of its author and, to that end, proceeds to transcribe the Spanish version of one of Ogai Mori's most representative stories. In short, the purpose is not to analyze but to illustrate or to compile.

The third condition incorporated in art. 32.1 LPI is that the use covered by the quotation limit may only be made for teaching or research purposes. Although neither art. 10 of the Berne Convention nor art. 5.3(d) of the DDASI require the achievement of specific purposes when regulating the limit of quotation, however, the Spanish legislator requires that the purpose of the quotation must be teaching or research. As legal doctrine has had occasion to point out, this is due to the fact that the Spanish legislator of 1987 confused the limits provided for in art. 10.1 and 2 of the Berne Convention and incorporated in a single provision the two limitations: quotation and illustration,<sup>34</sup> requiring in both cases the same purposes. The terms used by the legislator should not be understood in a broad sense to cover other types of purposes, such as informative purposes, since when the legislator has wanted to cover this purpose in an exception, it has expressly mentioned it and, furthermore, we must not forget that we are dealing with a limit to the exclusive right of the author and, as with any rule that establishes an exception, interpretation must be restrictive. It is taken for granted that the need for the quotation to pursue teaching and research purposes excludes the obtaining of any kind of profit, without the need for the legislator to have expressly excluded it.<sup>35</sup> In this sense, the term "teaching" should be understood as the action of teaching and "research" as any action aimed at broadening scholarly knowledge.

Regarding this requirement, the judgment of the Court of Appeal warns that the purpose of the use of the fragment must be focused on teaching or research. For the Court, more than the length of the quotation, its purpose is important, since it gives importance to the teleological element (art. 3.1° CC) when interpreting art. 32.1° LPI, that is, the reason for the existence of the quotation limit. In its arguments, it considers that "the educational purpose of the work did not make the inclusion of the story essential," so that the Court does not question the educational nature of the anthology published by the publisher. In the cassation appeal filed by the publisher, it is mentioned that the work *Claves y textos de la literatura japonesa* has a critical, research and teaching character as an argument for this requirement to be understood as having been met, and that the inclusion can be protected by the quotation limit. Although the SC (TS) does not raise doubts about the educational nature of anthologies, it understands that in this case the purpose of compilation is more important than the academic one.

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<sup>34</sup> N. Martínez Martínez, *Los fines educativos y de investigación como límite al derecho de autor*, Madrid 2018, p. 253.

<sup>35</sup> S. López Maza, *Artículo 32...*, p. 633.

In addition, the last words of art. 32.1º LPI refer to the obligation to indicate “the source and the name of the author of the quoted work.” This obligation is based on the moral right regulated in art. 14.3 of the LPI, that is, in “demanding recognition of their status as author of the work.” It must be kept in mind that in this case the legislator expressly requires compliance with this requirement, unlike what happens in art. 7.1 of the Intellectual Property Law of 1879, which does not mention this condition. In spite of this, legal doctrine has always considered that the quoted text must be accompanied by a mention of the author and the source. Such a requirement is also provided for in art. 10.3 of the Berne Convention, according to which “The quotations and uses referred to in the preceding paragraphs must mention the source and the name of the author, if this name appears in the source.” The reference to this requirement in the Berne Convention has led to this requirement being incorporated into the regulation of the quotation exception in all copyright legislation, although this requirement is not totally uniform; so for example, it is worth noting that Italy legislation is more demanding than Spanish legislation. Article 70.3 of the Italian Law for the Protection of Copyright and Neighbouring Rights incorporates the obligation to cite the name of the publisher and translator when quotations are taken from translated works, provided that these indications appear in the reproduced work.

Therefore, the precept in force in Spanish law requires that the person who quotes must indicate the source from which he/she has extracted the cited content and the name of the author of the work used. It is striking that the EU legislator, both when regulating the limit of quotation (art. 5.3(d) DDASI) and when referring to illustration (5.3(a) DDASI), states that the source and the name of the author must be included, unless it is impossible. And yet, the Spanish legislator, when dealing with quotation, simply establishes that the source and author of the work used must be indicated, without considering the possibility that this indication is impossible, which is something that it does incorporate in the national regulation of the limit of illustration.<sup>36</sup>

The purpose of this requirement is to enable the reader to recognize the author of the quoted fragments and, thus, easily access the original work to verify the accuracy of the quotation, expand his or her knowledge of the author of the work, and learn more about the main subject, etc. The aim is to respect the paternity or authorship of quoted works, thus preventing the reader from confusing what is the author’s own with what is not his/her own, and the quoted work with the one that incorporates the quotation. In this way, the quotation serves to pay homage to the author, a purpose that would not be possible to achieve if this condition were not met.

Most copyright laws that impose compliance with the requirement for the quotation limit do not establish specific legal guidelines that exhaustively determine

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<sup>36</sup> However, the difference in treatment should not be interpreted to mean that the one who cites must include the source and the name of the author in every case, nor that there is a greater relaxation of the fulfilment of the duty to respect the authorship of the work in the field of illustration, but this difference is rather due to the fact that, in the case of an illustration, art. 5.3(a) of the DDASI has been literally transposed, and, in the case of quotation, the regulation has not been modified to adapt to art. 5.3(d) of the DDASI.

how it should be complied with. Legal doctrine has highlighted some criteria that are usually used in practice. In the case of literary works and as regards the name, it is desirable that the full name of the cited author be included both in a footnote and in a bibliography at the end of the quoting text. If the work is anonymous, the source alone may be cited. Mentioning the author's name presents fewer doubts and inconveniences. In the case of the source, it should also be noted both in a footnote and in a bibliography at the end of the text<sup>37</sup> with reference to the title of the work, the name of the publisher, the place and year of publication, and the specific page from which the fragment is taken. In any case, it should be required that the way of indicating the name and source be uniform for all quotations contained in the same work.<sup>38</sup> In general, it should be accepted that the indication of name and source is valid, regardless of the style code followed, provided that the reader is given as complete information as possible, so that he/she is not in doubt as to whom the fragment belongs.

Having made these clarifications, we must analyze whether the requirement is met in this case. The judgment at the first instance noted that the insertion of the story was made "with a quote from the author of the translation," without specifying anything else in this regard. When the publisher filed the appeal, it argued that "the inclusion of the fragment is made with a footnote referring to the book from which the fragment is taken, the author and Rocío's translation, the publisher and the year of publication, as well as the pages of the book." On its part, the Supreme Court, in ruling on the appeal, admitted that the moral right of paternity of the translator has been respected and, therefore, the Court considered this requirement to be fulfilled.<sup>39</sup>

Finally, we must consider whether the application of the limit to this case complies with the three-step test (art. 40 bis LPI), that is, that the use of the publisher is a specific case, that it does not affect the normal exploitation of the work, and that it does not unreasonably prejudice the legitimate interests of the rights holder. The judgment of the District Court expressly admits that the reproduction of the plaintiff's translation "unjustifiably prejudices the legitimate interests of the owner of the derivative work that the translation represents and that this limit is insurmountable as established in art. 40 bis LPI."

There is no doubt that by reproducing the story translated by Rocío in its entirety, the use made by the publisher affects the normal exploitation of the work, meaning the current or potential market for it, and the legitimate interests of the author, because

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<sup>37</sup> Some authors have considered that it is not sufficient to include the work cited in the bibliography at the end of the work, L. Bochorberg, *Le droit de citation*, París 1994, p. 93. It is important to avoid the reader having to make an excessive effort, so the source should also be noted at the bottom of the page, B. Ribera Blanes, *El derecho de reproducción...*, p. 268.

<sup>38</sup> M. Cárcaba Fernández, *Vulneración de los derechos de autor en la creación jurídica: obras protegidas, citas y fotocopias*, "Revista Crítica de Derecho Inmobiliario" 2001, nº 663, p. 58.

<sup>39</sup> This requirement is frequently violated by publishers, as can be seen in judgments of the District Courts (SAP) Barcelona de 31 de marzo de 2006 JUR 2006/272980, Madrid de 5 de mayo de 2014 JUR 2014/164000 y Barcelona 3 junio 2021 JUR 2021/250343.

the publisher obtains a commercial benefit from a work the intellectual property rights to which do not belong to the publisher.

## Conclusions

In view of the study of the judgment of the Supreme Court of 16 May 2023, it can be affirmed that through this judgment the High Court values the rights of translators, even if the translated work is of a short length as it is with the short story in this case. Translators are also authors and are protected by intellectual property rights. In this case, a translation was reproduced and distributed without permission, so the publisher's conduct infringed the translator's intellectual property rights, unless the publisher could be protected by some legal limit. The publisher attempted to justify its conduct by invoking the legal limit of quotation regulated in art. 32.1º LPI. However, this limit only allows the inclusion of fragments in the case of literary works, but here the translation of the story is reproduced in its entirety. More than the extent of what is reproduced, it is important to take into account the purpose that the reproduced text fulfilled in the work itself. The SC (TS) reminds us that the qualification of fragment is determined by the purpose of the incorporation, which must be the mere review, commentary, analysis, or criticism of the text. In this case, the translated work is reproduced in its entirety, and although it is a translation of a short story that occupies only a few pages in relation to the length of the work that incorporates it, it must still be considered an autonomous and independent work susceptible of protection, and one that is not incorporated to fulfill the purposes that the legal limit of quotation must entail, but rather forms part of an anthology of texts to communicate and illustrate an idea. Consequently, the translator's reproduction and distribution rights have been infringed. The publisher should not publish the translation of the story to illustrate the essential features of Ogai Mori's literary work without the translator's permission.

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## Summary

**Begoña Ribera Blanes**

### Intellectual Property in Relation to Translations from a Spanish Legal Perspective

In Spain, it is quite common for translators to see their intellectual property rights infringed by publishers without the infringement reaching the courts, let alone the high court, our Supreme Court. In the case discussed here, a publisher incorporated the complete translation of a short story into an anthology of Japanese literature without the author's permission; such use is not covered as an example of quotation or by any of the exceptions to copyright provided for in current Spanish legislation. The incorporation of another's copyrighted work, however brief it may be, and its subsequent publication in an anthology of texts without the author's permission constitute an infringement of the copyright on the translation.

**Keywords:** translation of a work, anthology of texts, right of reproduction, limit of quotation, difference between excerpt and complete reproduction.

## Streszczenie

*Begoña Ribera Blanes*

### **Własność intelektualna w odniesieniu do tłumaczeń z perspektywy prawa hiszpańskiego**

Dość często zdarza się, że wydawcy naruszają prawa własności intelektualnej tłumaczy, a sprawa dotycząca naruszenia nie trafia do sądu. W omawianym przypadku wydawca włączył kompletne tłumaczenie opowiadania do antologii literatury japońskiej bez zgody autora, co oznacza, że jego postępowanie nie może być chronione ani przez cytat, ani przez żaden z wyjątków od praw autorskich przewidzianych w obowiązujących normach. Włączenie cudzego utworu chronionego prawem autorskim, niezależnie od tego, jak krótki by on nie był, a następnie opublikowanie go w antologii tekstów bez zgody autora stanowi naruszenie praw autorskich do tłumaczenia.

**Słowa kluczowe:** tłumaczenie utworu, antologia tekstów, prawo do zwielokrotniania, granica cytatu, różnica między fragmentem a pełnym zwielokrotnieniem.

**Anna Bober-Kotarbińska**

WSB Merito University in Gdańsk, Poland

anna.bober-kotarbinska@gdansk.merito.pl

ORCID: 0000-0003-0499-8253

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# The Justification for Establishing Exceptions and Limitations to Copyright for Programs based on Artificial Intelligence

## Introduction

The issue of artificial intelligence (AI) in the context of intellectual property law, including copyright, enjoys constant interest. Continuous innovation brings new challenges, and the stunning progress we have seen in this field in recent years, and especially over the past year, in AI systems and their rapid expansion of capabilities are attracting significant media and public attention. Among many AI models, one type of AI known as generative AI (GenAI) technology is particularly capable of generating output such as text, images, video and audio (including human voice emulation) using output in the form of copyrighted works. The adoption and use of GenAI systems have sparked widespread public debate about what these systems mean, raising important questions for the copyright system. In the wake of these questions, copyright holders have filed infringement lawsuits against AI companies, alleging copyright infringement AI training processes and results obtained from GenAI systems.<sup>1</sup> These lawsuits raise justified concerns about the unauthorised use of copyrighted materials to create new creative content. However, at the same time, they may significantly slow down work on the development of AI, which, in addition to threats, brings many valuable solutions. In light of these challenges, a comprehensive and holistic approach is needed to address AI-related copyright issues, considering both the inputs and outputs of AI systems. Based on discussions, normative work, consultations, and guidance from experienced commentators (including Daniel Gervais, who noted that there is a broad spectrum of current regulatory issues for GenAI<sup>2</sup>), this article identifies one of the broad spectrum of copyright policy issues arising from on the development and use of AI regarding the

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<sup>1</sup> For example: *Getty Images (US), Inc. v. Stability AI, Inc.*, No. 1:23-cv-135, ECF No. 13 (D. Del. Mar. 29, 2023) (alleging infringement based on the use of copyrighted images to train a generative AI model and on the possibility of that model generating images “highly similar to and derivative of” copyrighted images).

<sup>2</sup> D. Gervais, *Generative AI & IP: Gervais’ checklist of issues*, <https://www.linkedin.com/pulse/generative-ai-ip-gervais-checklist-issues-daniel-gervais/> [accessed: 2023.10.31].

legality of using copyrighted works for training AI models. The question posed is about the advisability of establishing a new system of copyright exceptions and limitations dedicated to AI systems. At the same time, the impact of existing limitations resulting from copyright exceptions and limitations on the development of AI is analysed.

To answer this question, this article examines the difference between AI and GenAI and describes their essential operation. Then, selected national legislation and normative responses of selected countries and draft acts dedicated to copyright in the context of AI are examined. Because of the developing concepts of establishing appropriate provisions of national law, attention is directed to the draft normative act unveiled in the autumn of 2023 in France. The next part presents a concept that denies the validity of a licensing system in favour of establishing a uniform, international copyright exception for using AI systems.

## **1. Introduction to technology – what are AGI, AI and GenAI, and how do they work?**

Some time ago, there were serious discussions about the definition of AI (with a complete lack of understanding of the role and function of definition in practical logic, patterns from formal logic were then followed). Although no clear legal definition has been established to date, the concept of artificial general intelligence (AGI) has been developed as a computer program that will reach the level of human intelligence in all aspects of human thinking (and in many cases exceed it due to its significant computing potential greater than that of humans). AGI should be distinguished from AI systems (so-called specialised AI systems) that perform specific, limited tasks that require intelligence when performed by humans. These are usually very specialised tasks, but the quality of their performance often exceeds human capabilities. Currently, GenAI plays an essential role in the world of copyright law. GenAI uses generative models (i.e. for creating new content) based primarily on artificial neural networks, enabling the creation of new digital content, such as text, images, music, and film. Currently, the most famous and widespread tool based on GenAI systems is ChatGPT.<sup>3</sup> GPT is the abbreviation of generative pre-trained transformer, which describes the essential features of the design of this computer program. This tool produces texts using a computational technique called a transformer neural network, the network parameters of which are established by previously training it on examples from a huge text database. Generally, as input, the program receives a fragment of text in natural language, for example, a query, and its task is to generate another sensible, grammatically correct text that is most suitable as a continuation of the given fragment. Fitness is determined by the text database on which the program was trained. On a very general level, the process usually consists of two stages: extracting

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<sup>3</sup> ChatGPT is a language model created by OpenAI, an IT company based in San Francisco, California, USA.



information regarding the intention of the question (the intention to achieve some result) contained in the instruction indicated by a human user of the program and generating content consistent with the extracted intentions.<sup>4</sup> Thus, instead of linking to content previously posted on the Internet, GenAI draws on existing content to create new content. New content can appear in formats that include all the symbolic elements representing the premises inherent in human thinking: texts written in natural language, images, videos, music and even software code. The GenAI in GTP is trained with data collected from websites, social media conversations and other online media. The program generates the most likely continuation of the text based on the texts in the database by statistically analysing the distribution of words, pixels or other data elements it has absorbed and identifying and repeating typical patterns. As of Fall 2023, ChatGPT will soon support voice and image prompts (for paid users). Other entities, such as Spotify, launched GenAI that can translate and copy podcasts into other languages that match the speaker's voice/tone, and Getty Images launched a "commercially safe" AI image generator trained on licensed images.

As seen from the above, the development of AI-based programs implies the need to gain access to vast data pools, and the larger the pool, the more accurate the system becomes. From a copyright perspective, it is essential that while some data may include works that are in the public domain and can be freely used, others may be copyrighted works, especially those related to cutting-edge science and technology. Therefore, in order to develop, AI systems must perform activities on copyrighted works, e.g. reproduction, text and data mining (TDM) and the creation of derivative works,<sup>5</sup> and undertake activities related to copyrighted content that require at least reproduction, and sometimes even adaptation work that is within the exclusive control of the copyright owner. Thus, the conclusion that can be drawn is that when AI models are trained on data, there is a risk of copyright infringement in some, if not most, countries. Therefore, without the express permission from the copyright holder (such as a license), any reproduction, adaptation or other action, unless it falls within the list of permissible legal exceptions, may violate this right. For example, an AI system developed to discover new cancer treatments would need to process many copyrighted articles in the medical sciences by accessing, reading and copying (reproducing). Retrieving data from the Internet essentially involves creating a first copy that is needed for processing in order to access the data contained in its content and is a necessary step for further processing. There will undoubtedly be other steps to

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<sup>4</sup> Y. Cao, S. Li, Y. Liu, Z. Yan, Y. Dai, P. Yu, L. Sun, *A Comprehensive Survey of AI-Generated Content (AIGC): A history of Generative AI from GAN to ChatGPT*, "Journal of the ACM" 2018, vol. 37, no. 4, <https://arxiv.org/pdf/2303.04226.pdf> [accessed: 2023.10.31].

<sup>5</sup> In copyright law, a derivative work is a work based on one or more pre-existing works, such as a translation, adaptation, sequel, or a work based in some way on another work. A derivative work is considered to be a new work while retaining certain characteristics of the original work. A work may serve a transformative purpose even if it does not change the content of the original work. See R. Reese, *Transformativeness and the Derivative Work Right*, "Columbia Journal of Law & the Arts" 2008, vol. 31, iss. 4, p. 4.

prepare this data for use in training, but this first raw copy is a copy. In addition, these works would have to be adapted or compiled into new works or formats (derivative works). Therefore, to operate legally, the creators of an AI system would be required to obtain consent from authors.

## 2. Legislative concepts

### 2.1. Current legislative concepts

The universal copyright system does not contain established, uniform exceptions allowing data processing by electronic devices. Nevertheless, in international treaties and conventions, international copyright law allows and leaves room for states to establish their own exceptions and limitations, as long as they do not conflict with the so-called three-step test as described in art. 9 section 2 of the Berne Convention for the Protection of Literary and Artistic Works<sup>6</sup> (concerning only the right of reproduction), art. 13 of the TRIPS Agreement<sup>7</sup> (including any exclusive rights) or art. 10 of the WIPO Copyright Treaty<sup>8</sup> (referring to “the rights granted to authors of literary and artistic works under this Treaty”).

Before the AI boom, national legal systems were moderately enthusiastic about establishing exceptions for using data resources by computer systems known as TDM processes.<sup>9</sup> Among the most well-known national exceptions allowing data mining for computer processing purposes was the world’s first exception for computer-based TDM established in Japan in 2009. The Japanese Copyright Act<sup>10</sup> art. 30-4 allows access to copyrighted works for extraction, comparison, classification or other statistical analysis of language, sound or image data or other elements of which a large number of works or a large volume of data is composed and computer data processing. Article 47-4 exempts making incidental electronic copies of works from copyright infringement. Finally, art. 47-5 allows the use of copyrighted content for data verification purposes connected to research. Thus, Japan allows the flexible exception for purposes other than entertainment.

On the European continent, other countries followed Japan, including the United Kingdom in 2014, by establishing in CDPA:<sup>11</sup> 29A “Copies for text and data analysis for non-commercial research (1) The making of a copy of a work by a person who

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<sup>6</sup> Act of Paris of the Berne Convention on the protection of literary and artistic works, Paris, 24/7/1971.

<sup>7</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, signed in Marrakesh, Morocco, 15/4/1994.

<sup>8</sup> WIPO Copyright Treaty (WCT), Geneva, 20/12/1996.

<sup>9</sup> Text and data mining (TDM) is a broad term used to describe any advanced techniques for computer analysis of large amounts of any type of data (numbers, text, images, etc.). It is a key tool in many areas of research, especially in the field of AI.

<sup>10</sup> Japanese Copyright Act no. 48 of May 6th, 1970, as amended by Act No. 72 of July 13th, 2018.

<sup>11</sup> Section 29A of the UK Copyright, Designs and Patent Act 1988.

has lawful access to the work does not infringe copyright in work provided that – (a) the copy is made so that a person who has lawful access to the work may carry out a computational analysis of anything recorded in the work for the sole purpose of research for a non-commercial purpose, and (b) the copy is accompanied by a sufficient acknowledgment (unless this would be impossible for reasons of practicality or otherwise).” This exception was relatively broad in nature, allowing anyone (a person) to copy copyrighted works for the purpose of performing text and data analysis (computational analysis in the wording of the exception), although it requires that person to have lawful access to the materials, and at the same time that the analysis is exclusively for research and non-commercial.

Other countries, such as Singapore, adopted similar rules in 2021 guided by the desire to exist in the technology industry and to exploit the opportunities related to it. Section 8 and Art. Sections 243 and 244 of the Singapore Copyright Act 2021<sup>12</sup> provide that a permitted use is to make a copy of a work or recording of a protected work for computational analysis purposes, which includes “(a) using a computer program to identify, extract and analyse information or data from the work or recording; and (b) using the work or recording as an example of a type of information or data to improve the functioning of a computer program concerning that type of information or data.”

In the American legal system, the most famous section is art. 107 of the Copyright Act. For some time, according to researchers,<sup>13</sup> it could be an answer similar to modern exceptions proposed in Asian countries or in the European legal system. It provides a legal framework for determining whether something is a permitted use and identifies certain types of uses such as criticism, commentary, news reporting, teaching, and scholarship and research as examples of activities that may qualify as a permitted use. The American doctrine of fair use has a very wide-ranging exception and for many years it has actually been the answer to many issues related to the use of works for education, transformation into available formats<sup>14</sup> or entertainment.<sup>15</sup>

In the regional system of European law frames like this exception are provided by art. 3 and art. 4 EU Directive 2019/790 of the European Parliament and the Council of 17 April 2019 on copyright and related rights in the Digital Single Market.<sup>16</sup> During the development stages of Directive 2019/790 (CDSM), the European Commission considered that a new mandatory exception or limitation on the use of TDM technologies in the field of scientific research would be beneficial in the development

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<sup>12</sup> Singapore Copyright Act 2021 (No. 22 of 2021), Art. 244.

<sup>13</sup> S. Flynn, L. Schirru, M. Palmedo, A. Izquierdo, *Research Exceptions in Comparative Copyright*, PIJIP/TLS Research Paper Series no. 75, 2022; N. Scharf, *Digital Rights Management and Fair Use*, “European Journal of Law and Technology” 2010, vol. 1, iss. 2.

<sup>14</sup> Authors Guild, Inc. v. HathiTrust, 755 F.3d 87, June 10, Intervenor Defendants-Appellees. Yeah. 12-4547.

<sup>15</sup> Sony Corporation of America v. Universal City Studios Inc, 464 US 417, 455, n 40 (1984).

<sup>16</sup> Directive 2019/790 of the European Parliament and the Council of April 17th, 2019, on copyright and related rights in the Digital Single Market, OJ L 130, 17.5.2019, pp. 92–125.

of AI. Article 3 establishes a broad and specific TDM exception for nonprofit scientific research. In contrast, art. 4 provides a more general but narrower TDM exception, subject to certain limitations related primarily to the purpose of use. The fundamental difference between the above-mentioned norms applies to both the subjective and objective spheres – the key point is that scientific entities and non-profit activities (art. 3) have been given a wider opportunity to operate than commercial entities that meet the conditions for operating under art. 4. The same, the EU introduced significantly shallower versions of the exception for enterprises with a significant caveat that it may be overridden by the right to opt out, a concession to rights holders introduced during the very last stage of the Copyright Directive's adoption process. This is fraught with practical difficulties. It can also be argued that, unlike the US, the EU takes a protectionist stance and has established a degree of scientific responsibility for using training data. As pointed out by Nicola Lucchi,<sup>17</sup> under this provision, individuals such as commercial AI system developers and educators may make copies of works or databases to extract information from text and data. They may retain these copies for as long as they are needed for the AI training process.<sup>18</sup> However, Nicola Lucchi also asserts that "rights holders have the option to exclude TDM exemptions from their contracts in order to safeguard their commercial interests."<sup>19</sup> This particular provision has been criticised for "providing a copyright exception that is perceived as being too restrictive. In contrast to the traditional understanding of copyright, which generally focuses on protecting original expression, this provision appears to include factual information and data, and this aspect has drawn much criticism."<sup>20</sup> However, how this opt out option can be implemented and the extent to which AI developers will adhere to it are yet to be determined. It is important to underscore that the 2019 CDSM Directive allows training AI algorithms on other people's data sets. In the case of research and educational entities, it is virtually unlimited (art. 3 of the Directive). In relation to entities operating commercially, authorized entities have the opportunity to prohibit such use (the right to opt out), at least in the absence of determination of due compensation (art. 4 of the Directive). During the work on the directive until its entry into force in 2019, knowledge about the phenomenon and possibilities of GenAI did not extend beyond a narrow group of technology giants; thus, neither the text of the directive, nor the accompanying documents contain any phrases referring to this type of GenAI.

As seen from the above, all the exceptions in question have in common the purpose of essentially non-commercial use and the intention to process works for TDM purposes. Despite this, they cannot be considered sufficient for use in AI processing. The only permitted acts are to make a copy, storing, retaining and to communicate

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<sup>17</sup> N. Lucchi, *ChatGPT: A case study on Copyright Challenges for Generative Artificial Intelligence Systems*, "European Journal of Risk Regulation" August 2023.

<sup>18</sup> *Ibid.*; art. 4(1) CDSM.

<sup>19</sup> Article 4(3) CDSM.

<sup>20</sup> T. Margoni, M. Kretschmer, *A Deeper Look into the EU Text and Data Mining Exceptions: Harmonization, Data Ownership, and the Future of Technology*, "GRUR International" 2022, vol. 71, iss. 8.

the work, and all references to computation data analysis itself are descriptive of the purposes for which the acts mentioned above are undertaken. While it is possible to over-generalise what is encompassed in the practical development of AI models, the operations generally undertook to include processing data to execute training, and my cautious observation is that there may be nuances and exceptions and that the steps to train AI include processing data into a form that can be used to train an AI model. The straightforward question in copyright is whether such processing to extract the data points is re-rendering the raw data into a form that can be used for analysis (e.g., comparable, even, to translation), or whether it is merely extracting ideas from expression. The answer may even be both, neither or something in between, but it is worth noting that on the only-translating side of the analysis, if the conversion of the copyright works into a format for training amounts to a form of adaptation, then those steps are a separately copyright-protected act, and adaptation it is not an act (or a verb) that appears to be permitted under the computation data analysis provisions. On the only-extracting-ideas-from-expression side of the analysis, there is an open question as to whether copyright is even engaged at all. If we land somewhere in between, would we have a transformation of the work such as to engage the fair use defence, which then is a segue to comparative reviews on transformative use under US copyright law, and even discussions on fair learning.<sup>21</sup> Despite the regulations established above, the copyright industry does not share the idea that the current activities of AI providers should fall within the established exceptions and limitations of national law. Regardless of the critical voices of the doctrine and literature, this is particularly illustrated by the legal situation developing in the USA, where defendants based on copyright claims include, among others, the legal case of Tremblay v. OpenAI Inc.<sup>22</sup> The plaintiffs assert that OpenAI employed their copyrighted books without obtaining proper authorisation in order to train ChatGPT. It is claimed that ChatGPT could effectively condense the content of literary works, meaning that the chatbot comprehensively interacted with and assimilated the information contained in these literary works. In the case of Silverman et al. v. OpenAI Inc.,<sup>23</sup> the claims assert that OpenAI engaged in unauthorised utilisation of copyrighted work for the purpose of training ChatGPT. Similar claims were made by Getty Images Inc. vs. AI Stability,<sup>24</sup> which disputes that their AI tool generated a file bearing the plaintiff's watermark for "the purpose of promoting, facilitating or concealing infringement of Getty's copyright Images." The resolution of all of these suits are pending and how they will be resolved remains uncertain at this time, but these cases clearly indicate that the long-popular Section 107 exception will no longer address AI issues.

Interestingly, the problem of the lack of exceptions is also being noted in China. Yudong Chen points out that although Chinese intellectual property laws exist very

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<sup>21</sup> M. Lemley, B. Casey, *Fair Learning*, "Texas Law Review" 2021, vol. 99, iss. 4, <https://texaslawreview.org/fair-learning/> [accessed: 2023.10.31].

<sup>22</sup> Tremblay et al. v. OpenAI, Inc. et al., no. 4:2023-cv-03223 (ND Cal. Jul. 7, 2023).

<sup>23</sup> Silverman et al. v. OpenAI, Inc. et al., no. 4:23-cv-03416 (ND Cal. Jul. 7, 2023).

<sup>24</sup> Getty Images (US), Inc. v. Stability AI, Inc., No. 1:23-cv-00135-GBW (D. Del. Mar. 29, 2023).

close to the four-component premise exception from § 107 of the Copyright Act of the USA, based on opinions of the Supreme People's Court of China they are broadly consistent with the four factors of the US fair use statute, and the 13 additional exceptions (in Chinese Copyright Law) do not cover AI issues. In Chen's opinion, the laws of both countries need to be further clarified and amended on this issue.<sup>25</sup>

## 2.2. New Legislative Concepts

Aware of the risks but also the benefits related to the use of AI in the areas of using works protected by copyright, some countries are trying to establish new provisions in their national law systems by modifying existing standards to include new technological trends. These include, among others, France, where on 12 September 2023 a proposal for a law was presented to reform certain norms in existing copyright law. To summarise the content, it should be noted that the preamble specifies the purpose of the act, which is "to protect authors and artists of works and interpretations based on the humanistic principle, in legal compliance with the Intellectual Property Code." From the perspective of the issue under analysis here, proposed art. 1 is important since it adds a paragraph at the end of art. L131-3 of the French Intellectual Property Act concerns the transfer of copyright: "the integration by artificial intelligence software of intellectual works protected by copyright into its system and a fortiori their exploitation is subject to the general provisions of this code and therefore to authorization from the authors or rights holders"<sup>26</sup> and thus their use is subject to the general provisions of this Code and therefore requires the authorisation of the authors or rights holders. As Andres Guadamuz rightly points out, adding such content is superfluous concerning the regulations, but adding this content emphasises the importance of authors' rights. Article 2 modifies existing art. L321-2, which concerns collective management organisations. Article 3 amends art. L121-2, obliging to mark the work generated in the program as a work generated by AI and to enter the authors' names of the works that led to the creation of such a work.<sup>27</sup> Article 4 of the proposed act deals with taxation issues.<sup>28</sup> However, the proposed content does not refer to establishing exceptions or limitations under copyright law.

<sup>25</sup> Y. Chen, *The Legality of Artificial Intelligence's Unauthorized Use of Copyrighted Materials Under China and US Law*, "The Intellectual Property Law Review" 2023, vol. 63, iss. 2, pp. 241–279.

<sup>26</sup> Proposition of art. L131-3 French Intellectual Property Act in original version: "l'intégration par un logiciel d'intelligence artificielle d'œuvres de l'esprit protégées par le droit d'auteur dans son système et a fortiori leur exploitation est soumise aux dispositions générales du présent code et donc à autorisation des auteurs ou ayants droit," the version in quote is author's own translation, <https://www.lexing.law/avocats/proposition-de-loi-intelligence-artificielle-et-droit-d-auteur/2023/11/23/> [accessed: 2024.09.19].

<sup>27</sup> According to A. Guadamuz (*idem*, *French lawmakers propose new copyright about generative AI*, 24/09/2023, <https://www.technollama.co.uk/french-lawmakers-propose-new-copyright-law-about-generative-ai> [accessed: 2023.10.31]) the main controversy on this subject concerns art. 2, namely the fact that the above assumes that AI works are subject to copyright.

<sup>28</sup> More: *ibid.*

It is worth emphasizing that, at the regional level, in December 2023 the European Commission, the Council and Parliament reached a provisional agreement on the AIA,<sup>29</sup> which is a comprehensive legal act on the creation and operation of intelligent algorithms defined in the Act as AI. Although discussions and more or less advanced work on similar regulations are underway in countries around the world, the EU AIA is currently the most comprehensive regulation of this type. It is assumed that this will be an important landmark for similar legal acts in other places around the world and especially in the US. The AIA introduces limited exceptions for TDM, recognizing the importance of balancing copyright protection with promoting innovation and research. Recital 109 recognizes the need for proportionality of compliance requirements, particularly for small and medium-sized enterprises and start-ups. This provision aims to facilitate non-commercial research activities while ensuring adequate protection of the interests of rights holders. Recital 105 highlights the importance of obtaining permission from rights holders for any use of copyrighted content in AI training models unless appropriate copyright exceptions and limitations apply. Attention is drawn to the provisions of Directive (EU) 2019/790, which introduced exceptions and limitations allowing, under certain conditions, the reproduction and downloading of works for the purposes of TDM. However, it clarifies that rights holders may reserve their rights to prevent TDM (the right to opt out), unless it is for the purpose of scientific research. Furthermore, Recital 105 explicitly links the use of copyrighted works for training AI models with the TDM exception in art. 4 of the CDSM Directive. This link aims to put an end to disputes over the application of this exception to AI model training and confirms that even if the legislature did not expressly provide for such uses when discussing exceptions under TDM, the AIA recognizes that art. 4 of the CDSM Directive applies to such applications. GenAI was noted at the final stage of work on the AAI. Based on this regulation, providers of models capable of generating content will be obliged to provide information on how they train their models, and the data sets used as training substrate. They will also be obliged to create policies to respect copyright provisions (AI policy).

### 3. Establishing a harmonized exception

The impact of AI and GenAI is significant for global economies, especially in the areas of customer service, marketing, software engineering and research and development. In developed countries, AI and GenAI are also used in the banking, advanced information technology and insurance sectors, where employee work automation processes have been significantly improved. At the same time, AI is used in developing countries and countries with a significant degree of digital exclusion to improve education and

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<sup>29</sup> Proposal for a Regulation of the European Parliament and of the council laying down harmonized rules on artificial intelligence (Artificial Intelligence Act) and amending certain Union legislative acts COM/2021/206 final, Document 52021PC0206.



teaching processes where the primary problem is the lack of books. As access to data becomes more and more essential for the economic development of countries and for the digital opportunities of individuals, those countries and people who do not have access or cannot afford data remain in a situation of data poverty.<sup>30</sup>

Since, like it or not, AI technologies exist and the direction of future development for science and technology depend on them,<sup>31</sup> it is necessary to include AI's unauthorised use of copyrighted materials in the scope of fair use as much as possible. Continuing to remain in a legal situation in which the legal system does not respond to real problems related to developing the technology of the future not only constitutes a weakness of law as an instrument responding to actual needs, but it is also a real blow to the development of technology.

With this goal in mind, the literature considers several strategies for establishing a legal security framework, the most popular of which includes entering into explicit data-sharing agreements with data providers.<sup>32</sup> I am, however, sceptical about this concept as this solution has several fundamental drawbacks. The first is the fact that copyrights are sometimes separated from authors, and training AI on transformed works would require making decisions that fall within the sphere of the creator's personal rights. Significantly, the copyright holder usually does not have the legal rights to make decisions that infringe the sphere of personal copyright rights. Second, it should be pointed out that there are potential, although significant, difficulties in concluding the contract in question. Assuming that the license agreement covers all works that are not in the public domain, it would be necessary to conclude appropriate agreements with copyright holders. This would imply the need to identify, locate and contact the authorised entity, which, in view of the standards governing the protection of personal data, could constitute a significant obstacle in the process of concluding a contract. Regardless of the standards governing the protection of personal data, it sometimes happens that even if the author's personal data is known, contacting them may be difficult or impossible. The issues in question constitute the basis for the existence of the doctrine dealing with orphan works, the authors of which cannot be identified or located. Even if such a position were accepted as justified, it could lead to the biased treatment of orphan works and to a distortion of

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<sup>30</sup> T. Marawala, *Artificial Intelligence, Game Theory and Mechanism Design in Politics*, London 2023, pp. 41–58.

<sup>31</sup> M. Kop, *AI & Intellectual Property: Towards an Articulated Public Domain*, "Texas Intellectual Property Law Journal" 2020, vol. 28, no. 1.

<sup>32</sup> In this way, among others M. Kop, *The right to process data for machine learning purposes in the EU*, "Harvard Journal of Law & Technology" 2021, vol. 34; M. Senftleben, *Generative AI and Author Remuneration*, "International Review of Intellectual Property and Competition Law" 2023, vol. 54; proposing to introduce remuneration mechanisms that ensure the payment of compensation for the use of generative AI systems in the literary and artistic field); *idem*, *A Tax on Machines for the Purpose of Giving a Bounty to the Dethroned Human Author – Towards an AI Levy for the Substitution of Human Literary and Artistic Works*, SSRN, January 2022; G. Frosio, *Should We Ban Generative AI, Incentivise It or Make It a Medium for Inclusive Creativity?* [in:] *A Research Agenda for EU Copyright Law*, eds. E. Bonadio, C. Sganga, Cheltenham 2023.



the principles set out in the Directive on specific permitted uses of orphan works.<sup>33</sup> It is difficult, if not impossible, for the creator of AI to determine in advance in what fields of use the AI system will use the work. As mentioned earlier, AI systems require input (text, data, etc.) to create output, i.e. to learn. P. Bernt Hugenholtz goes so far as to suggest that “much of current and future AI development depends on TDM.”<sup>34</sup> Given the current state and development of technology, it is impossible to clearly determine whether, within a few months, the sphere of use of the work will not include completely new, hitherto unknown fields of exploitation. Third, there is no doubt that the current trend and development of AI systems applies not only to the so-called “big players” and international IT corporations but also to small developing companies. The investment system for entities just starting out on the market is completely different from that of huge corporations with significant financial resources at their disposal. It seems that establishing a system of highly licensed exceptions could limit access to the technology market for entities with fewer financial resources. Fourth, viewing the use of AI in the context of society’s access to a broad information framework is both an argument against the licensing system and an encouragement for a broad exception. The use of narrow data resources, limited to sets covered by license agreements, may result in the generation of limited and biased results by AI. The antidote to such algorithmic limitations would be a system of broad exceptions and restrictions on AI, allowing access to a broader pool of data unrestricted by the barriers to licensing identified above.

## Conclusions

The rapid democratisation and emergence of GenAI has shed greater light on the reality that developing and refining AI is data-intensive. The more data, the better its quality, and therefore, the more robust and accurate AI. However, the development of AI encounters legal limitations and legal uncertainty, namely, the use of literary and artistic works and other materials protected by copyright and related rights, including computer programs and databases, by AI systems is still subject to objections from copyright holders.

This article examines copyright issues related to GenAI in general. Current legal frameworks, such as those in Japan, China, Singapore and fair use in the US and the TDM exemption in the EU, provide some guidance on using copyrighted material to train AI models. However, this framework may need to fully address the complexities inherent in GenAI. This is evidenced by new legislative actions taking place in France,

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<sup>33</sup> Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works, OJ L 299, 27.10.2012, pp. 5–12.

<sup>34</sup> P.B. Hugenholtz, *The New Copyright Directive: Text and Data Mining (Articles 3 and 4)*, 2019, <http://copyrightblog.kluweriplaw.com/2019/07/24/the-new-copyright-directive-text-and-data-mining-articles-3-and-4/> [accessed: 2023.10.31].

among other countries, but also by budding court disputes regarding the use of copyright content by OpenAI USA programs.

The analysis conducted supports the idea that establishing a new, appropriate and technologically evolving exception dedicated to AI in the field of copyright may provide many benefits. This concept, based on previous experience, is expected to have a positive impact on the industry. Clear rules and legal certainty can send a positive signal to the market and help avoid protests related to the development of AI. Legislative chaos does not inspire confidence in either program users or investors, and the sense of legal certainty and security is one of the fundamental principles of economic development. Certainly, regulating this issue would be consistent with the concept of promoting a culture of the rule of law that follows and adapts to the new information society. A situation in which the law does not offer a broad exception to the widespread development of AI-enabled technology is similar to one in which we would not have a fair use exception in the copyright system in the form of quotation rights. As evidenced by observations of the everyday world, the lack of proper calibration of a system of exceptions and limitations in copyright law does not hinder the development of technology, and what is more, it creates an image of law as an inflexible tool that is not adapted to a changing world.

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## Summary

**Anna Bober-Kotarbińska**

### **The Justification for Establishing Exceptions and Limitations to Copyright for Programs based on Artificial Intelligence**

The issue of artificial intelligence ('AI') in the context of intellectual property law, including copyright law, has attracted continued interest. Progressive innovation brings new challenges, and the advances we have seen in recent years - particularly in the development of generative artificial intelligence ('GenAI') systems - are attracting media and public attention. The adoption and use of generative artificial intelligence systems has sparked widespread debate about their relevance to the copyright system. In the wake of emerging questions, copyright holders have begun to file copyright infringement lawsuits against artificial intelligence companies targeting the process of training artificial intelligence with the results obtained from generative artificial intelligence systems. As a result of these questions, copyright holders have begun filing copyright infringement lawsuits against owners of programs trained on the basis of data protected by copyright and data protection law. Drawing on analysed discussions, normative proposals, consultations and recommendations from experienced practitioners, this article identifies one of the broad questions of contemporary copyright policy towards artificial intelligence, concerning the legality of using copyrighted works to train artificial intelligence models. It also poses the question of the desirability of establishing a new system of copyright exceptions and limitations dedicated to artificial intelligence systems, while analysing the impact of existing limitations under copyright exceptions and limitations on the development of artificial intelligence.

**Keywords:** copyright, exceptions and limitations, artificial intelligence, generative artificial intelligence.

## Streszczenie

*Anna Bober-Kotarbińska*

### Zasadność ustanowienia wyjątków i ograniczeń prawa autorskiego dla programów bazujących na sztucznej inteligencji

Problematyka sztucznej inteligencji (AI) w kontekście prawa własności intelektualnej, w tym prawa autorskiego, cieszy się niesłabnącym zainteresowaniem. Postępujące innowacje niosą ze sobą nowe wyzwania, a postępy, które obserwowaliśmy w ostatnich latach – zwłaszcza w zakresie rozwoju systemów generatywnej sztucznej inteligencji (GenAI) – przyciągają uwagę mediów i opinii publicznej. Przyjęcie i wykorzystanie generatywnych systemów sztucznej inteligencji wywołało szeroko zakrojoną debatę na temat ich znaczenia dla systemu praw autorskich. W następstwie pojawiających się pytań posiadacze praw autorskich zaczęli kierować pozwy o naruszenie praw autorskich przeciwko właścicielom programów trenowanych na podstawie danych chronionych przepisami prawa autorskiego i prawa o ochronie danych osobowych. W świetle tych nakreślonych w nich wyzwań konieczne staje się kompleksowe i holistyczne podejście do kwestii praw autorskich związanych ze sztuczną inteligencją, uwzględniające zarówno legalność korzystania z danych wejściowych, jak i wyjściowych. Opierając się na przeanalizowanych dyskusjach, propozycjach normatywnych, konsultacjach i zaleceniach doświadczonych praktyków, niniejszy artykuł identyfikuje jedno z szerokiego spektrum pytań współczesnej polityki praw autorskich wobec sztucznej inteligencji, dotyczących legalności wykorzystywania utworów chronionych prawem autorskim do szkolenia modeli sztucznej inteligencji. Stawia się w nim również pytanie o celowość ustanowienia nowego systemu wyjątków i ograniczeń prawa autorskiego odnoszącego się do systemów sztucznej inteligencji, analizując jednocześnie wpływ istniejących ograniczeń wynikających z wyjątków i ograniczeń prawa autorskiego na rozwój sztucznej inteligencji.

**Słowa kluczowe:** prawo autorskie, wyjątki i ograniczenia, sztuczna inteligencja, generatywna sztuczna inteligencja.

**Nadia Maccabiani**

University of Brescia, Italy  
nadia.maccabiani@unibs.it  
ORCID: 0000-0003-1183-0854

**Anna Podolska**

University of Gdańsk, Poland  
anna.podolska@ug.edu.pl  
ORCID: 0000-0002-5380-9570

**Ewelina Szatkowska**

University of Gdańsk, Poland  
ewelina.szatkowska@prawo.ug.edu.pl  
ORCID: 0000-0001-6449-4204

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## How Artificial Intelligence Learns: Legal Aspects of Using Data in Machine Learning

### Introduction

“AI is a collection of technologies that combine data, algorithms and computing power.”<sup>1</sup> A subset of artificial intelligence (AI) is machine learning, which uses large data sets (personal and non-personal) to find patterns and correlations from which it makes predictions and decisions. In this model (which also includes generative AI such as Chat GPT or Midjourney), AI must be properly trained. Training consists primarily of feeding the system through appropriate datasets, i.e. datasets that are sufficiently diverse, relevant, and representative (also in terms of gender, ethnicity, or age), free of errors, complete in view of the intended purpose of the system, and able to be used legally. Due to the implications of the deployment of data in the creation and use of new technologies, not only does the technical concept of data quality or the legal protection of personal data and intellectual property come into play, but also the more comprehensive concept of data justice.

Questions of data justice have been dealt with by social scientists, from the seminal work of Jeffrey Alan Johnson on open data and information justice<sup>2</sup> to the framework for data justice advocated by Linnet Taylor<sup>3</sup> and other distinct strands of

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<sup>1</sup> White Paper on Artificial Intelligence – A European approach to excellence and trust, COM/2020/65 final. For an explication of Artificial Intelligence systems and Machine Learning models, when “a computer observes some data, builds a model based on the data, and uses the model as both a hypothesis about the world and a piece of software that can solve problems,” see S. Russel, P. Norvig, *Artificial intelligence – A Modern Approach*, Hoboken 2021, p. 651.

<sup>2</sup> J.A. Johnson, *From open data to information justice*, “Ethics and Information Technology” 2014, vol. 16, no. 4, p. 263 *et seq.*

<sup>3</sup> L. Taylor, *What is data justice? The case for connecting digital rights and freedoms globally*, “Data & Society” 2017, vol. 4, no. 2, p. 1 *et seq.*

research.<sup>4</sup> Our goal is not to provide an overview of the various approaches to data justice among social scientists and philosophers. Instead, our objective is to take stock of this ongoing debate in order to highlight certain legal issues that involve aspects encompassed within the multifaceted concept of data justice. More specifically, our focus will be placed on the legal aspects that have recently been addressed by different pieces of EU legislation or EU initiatives. In this regard, the EU legislator has demonstrated an awareness of and an attempt to address concerns related to data ownership, data openness, data re-use, fair data collection and processing, data quality, and non-discrimination: all issues that are explored by researchers in the field of data justice. The EU legislator has done so through various initiatives, ranging from the individual perspective of the GDPR<sup>5</sup> and intellectual property provisions, to more recent and collective approaches, in the EU Strategy on Data and the EU Directive on Open Data,<sup>6</sup> the EU Regulation on Data Governance,<sup>7</sup> the Data Act,<sup>8</sup> the Digital Services and Market Acts,<sup>9</sup> and the Artificial Intelligence Act (AIA).<sup>10</sup> In these acts, the approach taken has predominantly followed a techno-procedural path, while a looser approach

<sup>4</sup> For an overview of the different approaches to data justice, see L. Dencik, J. Sanchez-Montero, *Data Justice*, "Internet Policy Review" 2022, vol. 11, no. 1, p. 1 *et seq.*

<sup>5</sup> Provisions about data protection have formally evolved from a directive (Directive 95/46/CE) to the Regulation of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC, OJ L 119, 4.5.2016, pp. 1–88 (Regulation EU 679/2016).

<sup>6</sup> A European Strategy for Data, COM(2020) 66 final, p. 1; Directive (EU) 2019/1024 of the European Parliament and of the Council of 20 June 2019 on open data and the re-use of public sector information (recast), OJ L 172, 26.6.2019, pp. 56–83, par. 13, sets out that "Public sector information or information collected, produced, reproduced, and disseminated within the exercise of a public task or a service of general interest, is an important primary material for digital content products and services and will become an even more important content resource with the development of advanced digital technologies, such as artificial intelligence, distributed ledger technologies and the internet of things. Broad, cross-border geographical coverage will also be essential in that context. Increased possibilities of re-using such information is expected, inter alia, to allow all Union businesses, including microenterprises and SMEs, as well as civil society, to exploit its potential and contribute to economic development and high-quality job creation and protection, especially for the benefit of local communities, and to important societal goals such as accountability and transparency."

<sup>7</sup> Regulation (EU) 2022/868 of the European Parliament and of the Council of 30 May 2022 on European data governance and amending Regulation (EU) 2018/1724 (Data Governance Act), OJ L 152, 3.6.2022, pp. 1–44.

<sup>8</sup> Regulation (EU) 2023/2854 of the European Parliament and of the Council of 13 December 2023 on harmonised rules on fair access to and use of data and amending Regulation (EU) 2017/2394 and Directive (EU) 2020/1828 (Data Act).

<sup>9</sup> Regulation (EU) 2022/1925 of the European Parliament and of the Council of 14 September 2022 on contestable and fair markets in the digital sector and amending Directives (EU) 2019/1937 and (EU) 2020/1828 (Digital Markets Act), OJ L 265, 12.10.2022, pp. 1–66.

<sup>10</sup> Regulation (EU) 2024/1689 of the European Parliament and of the Council of 13 June 2024 laying down harmonised rules on artificial intelligence and amending Regulations (EC) No 300/2008, (EU) No 167/2013, (EU) No 168/2013, (EU) 2018/858, (EU) 2018/1139 and (EU) 2019/2144 and Directives 2014/90/EU, (EU) 2016/797 and (EU) 2020/1828 (Artificial Intelligence Act) (Text with EEA relevance), OJ L, 2024/1689, 12.7.2024, ELI: <http://data.europa.eu/eli/reg/2024/1689/oj> (Artificial Intelligence Act – AIA).

has been adopted in listing forbidden purposes in the context of artificial intelligence systems. However, the purposes addressed by means of different practices based on big data analytics (artificial intelligence included, and more specifically machine learning methods and foundation models) are likewise relevant for data justice, and in particular for the “instrumental” approach to data justice.<sup>11</sup> In light of this, our argument calls for a re-assessment of the permissible and forbidden purposes within artificial intelligence systems, in order to redefine the boundaries between the legal implications of data justice, on the one hand, and the freedom to conduct a business or the control exerted by public authorities over citizens, on the other. In addition, a comprehensive approach to data justice also underlies in-depth consideration of and respect for data ownership when it goes hand in hand with intellectual property rights, in order to strike a fair balance among openness, sharing, re-use of data, and IP.

However, we suggest that the techno-procedural approach adopted by the EU initiatives is insufficient in respect of all the multifaceted implications of data justice.

## 1. Establishing data justice as a legal priority

### 1.1. Data as a two-faced Janus: technical but legal requirements

“Data are commonly understood as measures of the world and the building blocks from which information, knowledge and value are produced. There is a long history of governments, businesses, academia and citizens producing and utilising data in order to monitor, regulate, profit from, and make sense of the world [...] Data have lost none of their value, but in other respect their production and nature has been transformed through a set of disruptive innovations, including networked digital infrastructures, pervasive ubiquitous computing, cloud services and open government. Indeed, there has been a profound datification of everyday life as evermore phenomena are captured as data, and these data in turn are used to shape social and economic systems.”<sup>12</sup> This is part of the opening address in Rob Kitchin’s *The Data Revolution*. The statement clearly sets out the features and framework of a “data-driven society,” nowadays, one where the classical life cycle of information is essentially dominated by gathering, processing, and extracting value from data as well as data re-use.<sup>13</sup> Within this framework, data lie

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<sup>11</sup> R. Heeks, J. Renken, *Data Justice for development: What would it mean?*, Development Informatics Working Paper Series, No. 63, 2016, p. 4, remind us that “instrumental data justice means fair use of data; it therefore focuses on the outcome of use of data [...]. From this perspective, there is no justice inherent to the data domain; instead justice is defined outwith that domain. For example, this would argue that there is no inherent justice or injustice about who owns data in developing countries or in development projects; concerns about justice only relate to the impact of the use of that data.”

<sup>12</sup> R. Kitchin, *The Data Revolution – A critical Analysis of Big Data, Open Data & Data infrastructures*, London 2022, p. 3.

<sup>13</sup> This precautionary approach underlies comprehensive awareness of the risks involved in current reality, since “There has never been a state, monarchy, kingdom, empire, government, or corporation in history that has had command over such granular, immediate, varied, and detailed data about

at the centre of a circle; most current social, economic, and political processes revolve around it.<sup>14</sup>

As a result, data are not merely a technical component; rather, they stand at the root of increasing legal implications, not only of an individual nature but also of a collective one. From an individual standpoint, it is a question of protecting personal and, moreover, sensitive data, as well as of protecting intellectual property rights. However, if we broaden our perspective to adopt a more collective approach, it is essential to ensure data quality,<sup>15</sup> make data publicly available for reasons of transparency and accountability, and enable data sharing to extract further economic and socio-political value.<sup>16</sup> This undoubtedly implies avoiding the confinement of data within silos that can bolster oligopolistic positions. Instead, it suggests opening them to broader utilization by other public or private entities, with the aim of enhancing the delivery of public services, fostering growth, and boosting innovation.<sup>17</sup> In addition, this opening process necessitates ensuring the interoperability of formats and protocols governing IT systems where data are uploaded and made accessible, in order to facilitate readability and exchange with other entities.<sup>18</sup> However, these activities cannot violate the rights of data creators, including intellectual property rights, the essence of which is to support creativity and human creation.

It is within this context that the increasing focus of the European legislator on data processing, circulation, and the intertwined issue of data quality is paramount. Not only the well-known and settled normative discipline about the protection of personal data and intellectual property, but also the European Data Strategy document and consequent initiatives like the Open Data Directive, the Data Governance Act and the

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subjects and objects that concern them;" thus "data has become a major object of economic, political and social investment for governing subjects," E. Ruppert, E. Isin, D. Bigo, *Data Politics*, "Big Data & Society" 2017, vol. 2, no. 5, p. 2.

<sup>14</sup> L. Floridi, *The fourth Revolution. How the infosphere is Reshaping Human Reality*, Oxford, 2014, p. 6 *et seq.*

<sup>15</sup> For an in-depth overview of the issues involved in data processing, beyond personal data protection, and referring rather to their accessibility, their coverage and granularity, their quality (implying how clean data are, in terms of error and how gap free; how untainted they are, in terms of bias; how consistent and complete they are, in terms of discrepancies), their veracity (referring to the authenticity, accuracy, and fidelity of the data), see R. Kitchin, *The Data Revolution...*, p. 187 *et seq.*

<sup>16</sup> As shown by A. Ross, *The Industries of the Future*, New York 2016, p. 153, "Land was the raw material of the agricultural age. Iron is the raw material of the industrial age. Data is the raw material of the information age."

<sup>17</sup> A European Strategy for Data..., p. 1.

<sup>18</sup> For the concept of data integration and interoperability, see R. Kitchin, *The Data Revolution...*, pp. 196–198. The European Strategy for data (p. 6), in order to support cross-border interoperability, provides for the creation of a European data space to be accompanied by the development of sectoral data spaces in strategic areas such as manufacturing, agriculture, health, and mobility. As for the public sector, a European Interoperability Framework (EIF) – COM(2017) 134 final, was set out, as well as a Regulation (EU) 2024/903 of the European Parliament and of the Council of 13 March 2024 laying down measures for a high level of public sector interoperability across the Union (Interoperable Europe Act), and a Proposal for a European Interoperability Framework for Smart Cities and Communities (EIF4SCC), were adopted by the EU.



forthcoming Data Act come into account. Further initiatives that lay down the technical requirements for data openness and data sharing by means of an interoperable structural framework that allows cross-borders data exchange<sup>19</sup> are also significant. In addition, the Digital Market Act provides obligations for gatekeepers in respect of fair data use, data access, and portability; likewise the Digital Services Act upholds transparency, fairness, and accountability of service providers. Finally, the draft AIA is aimed at regulating systems primarily fed with data, with a particular focus on machine learning as a subset of these AI systems, and the consequent need to implement a data governance process that aims to achieve data quality.

Briefly, in the above-mentioned pieces of legislation and initiatives the EU is trying to cope with the main legal implications of a data driven-society. They involve mutually intertwined aspects, since making data more accessible and available is a necessary “prerequisite for seizing the opportunities presented by the digital age we live in;”<sup>20</sup> in turn, this process needs to be supplemented by provisions about data quality and IP safeguards, with specific regard to the case of data massive deployment by machine learning systems. Consequently, throughout the above-mentioned initiatives the EU has made technical, organizational, and managerial aspects of data processing (beyond personal data being involved), legally relevant and binding.

However, the EU has not laid down strict or rigid legal requisites and requirements, since it has rather set out some principles and general clauses, delegating their specification to following technical standards.<sup>21</sup> Likewise, the EU has not yet adopted a specific approach to IP rights in the face of the massive deployment of free accessible online data. This path of action gives evidence of the difficult compromise pursued by the legislator: the necessity to protect fundamental rights, according to a human-centred approach, while neither stifling innovation nor hindering competition in the EU market.<sup>22</sup> As a consequence, technical and procedural requirements leave open a significant scope for manoeuvre to entities that deal with data; this is the reason why such requirements surely integrate necessary and pivotal aspects for the sake of data justice, but they are not enough comprehensively to safeguard this.

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<sup>19</sup> As stated by the European Strategy for Data..., p. 7: “The application of standard and shared compatible formats and protocols for gathering and processing data from different sources in a coherent and interoperable manner across sectors and vertical markets should be encouraged through the rolling plan for ICT standardisation and (as regards public services) a strengthened European Interoperability Framework.”

<sup>20</sup> Data Act, p. 1.

<sup>21</sup> M. Ebers, *Standardizing AI – The Case of the European Commission’s Proposal for an Artificial Intelligence Act* [in:] *The Cambridge Handbook of Artificial Intelligence: Global Perspectives on Law and Ethics*, eds. L. Di Matteo, C. Poncibò, M. Cannarsa, Cambridge 2022, p. 330.

<sup>22</sup> AIA, par. 1, states that the purpose of this Regulation is to promote the uptake of human centric and trustworthy artificial intelligence and to ensure a high level of protection of health, safety, fundamental rights, democracy and rule of law and the environment from harmful effects of artificial intelligence systems in the Union while supporting innovation and improving the functioning of the internal market.

## 1.2. Intellectual property of data – engine of innovation or a restraint on new technologies

One of the aspects of data justice is securing the ownership of data and the need to protect the intellectual property of creators whose works constitute training material for artificial intelligence. As Agnieszka Wachowska and Marcin Ręgorowicz point out, the subject of the dispute is the right of operators of “learning” systems to use publicly available data sets.<sup>23</sup> Obtaining one’s “own” result through the mass, automatic acquisition and subsequent processing of data can lead to infringements of the rights of creators (or) other rights holders, as well as database producers, who have no real control over the use of their protected resources.

The generative AI type is particularly prone to infringement. It is trained on the basis of creative works (materials), e.g. texts, software code, or images. The system draws on the works, mixes them and then delivers (generates) works of a similar type (which can be considered collages). The final result may have varying degrees of similarity to the works used to generate it. Nevertheless, it is a direct result of the earlier human work that was copied and at the same time represents a competing work. Generative AI systems are able to flood the market very quickly with works that are substantially similar to original works; they are able to imitate style, distinctive colours, etc. From the technical point of view, such effects are achieved using a mathematical process called “diffusion.”<sup>24</sup>

The problem of ensuring an adequate level of intellectual property protection of data is emphasized quite often by EU decision-makers,<sup>25</sup> but so far there have been no comprehensive legal solutions, as has been indicated by the European Parliament.<sup>26</sup> Recognizing that the EU needs to harmonise and to create a common European data space (an internal market for data),<sup>27</sup> in the field of protection of data creators the EU

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<sup>23</sup> A. Wachowska, M. Ręgorowicz, *ChatGPT w praktyce – najważniejsze kwestie prawne*, <https://www.traple.pl/chatgpt-w-praktyce-najwazniejsze-kwestie-prawne/> [accessed: 2023.10.13].

<sup>24</sup> The technique was created in 2015 by AI researchers at Stanford University. The first step is to translate the piece into its constituent elements, then small elements are removed (known as denoising) to create a lossy copy (highly compressed, similar to MP3 or JPEG files). In 2020, the technique was improved by researchers at UC Berkeley, making it possible to create better compressed training images (called hidden images). Moreover, it was discovered that hidden images can be interpolated (blended mathematically), thus creating new derivative images. The work of researchers from Munich resulted in further improvement of the process in 2022, when additional information (so-called conditioning) was introduced at the stage of the denoising process. However, this does not change the fact that the new painting is a simple consequence of copying fragments of other works. R. O’Connor, *Introduction to Diffusion Models for Machine Learning*, <https://www.assemblyai.com/blog/diffusion-models-for-machine-learning-introduction/> [accessed: 2023.10.27]; <https://stablediffusionlitigation.com/> [accessed: 2023.10.26].

<sup>25</sup> For example: Directive (EU) 2019/1024; Regulation (EU) 2022/868; Regulation (EU) 2023/2854 (Data Act).

<sup>26</sup> Report on intellectual property rights for the development of artificial intelligence technologies of 2.10.2020 (2020/2015(INI)).

<sup>27</sup> Points 17–20 of European Parliament resolution of 20 October 2020 on intellectual property rights for the development of artificial intelligence technologies (2020/2015(INI)).

legislator currently refers to the solutions adopted in Directive (EU) 2019/790<sup>28</sup> and in Directive 96/9/EC.<sup>29</sup>

Directive 2019/790 introduced three exceptions in copyright law, i.e.: text and data mining for scientific research (Art. 3 and 4); for teaching activities (Art. 5); and for the preservation of collections by cultural heritage institutions (Art. 6). The first exception relates to the reproduction, presentation, downloading, and secondary use of all or part of a database protected by a *sui generis* right and to the use of press publications for text and data mining in connection with scientific research.<sup>30</sup> Article 5 covers the use of works and other protected subject matter in digital and cross-border teaching activities. The purpose of these provisions is to allow the digital use of works and other protected objects for the purpose of illustration in the context of teaching, to the extent justified solely by the non-commercial purpose to be achieved. The established exception to this concerns the exploitation of databases and works, as well as of computer programmes (reproduction). The third exception concerns the possibility of using collected works by cultural heritage institutions. Its task is to enable archiving in an appropriate amount, at any time and to the extent necessary to preserve this type of collection; however, the requirement is that works and other protected items must be permanently in the collections of a given institution.<sup>31</sup>

Exploiting the exceptions above, in accordance with Art. 4 section 3 of the Directive, is possible when “the use of works and other subject matter referred to in that paragraph has not been expressly reserved by their rightholders in an appropriate manner, such as machine-readable means in the case of content made publicly available online.” The regulation allows third parties to reproduce databases or works for the purpose of machine learning (whether for scientific or commercial purposes), provided that the rights holder may refuse permission in the case of commercial applications.<sup>32</sup>

Directive 96/9/EC takes into account the essence of “online databases” in its regulation, indicating that appropriate measures are necessary to prevent unauthorized extraction and/or re-utilization of data. Article 1(2) of this act defines the database as “a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.”<sup>33</sup> The act states *expressis verbis* that the elements of the database may also include independent works. It is worth emphasizing the cumulative protection of databases, i.e. copyright protection and the so-called *sui generis* right. If a database constitutes a work within

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<sup>28</sup> Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC, OJ L 130, 17.5.2019, pp. 92–125.

<sup>29</sup> Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, OJ L 77, 27.3.1996, pp. 20–28.

<sup>30</sup> E. Laskowska-Witak, *Komentarz do dyrektywy o prawach autorskich w ramach jednolitego rynku cyfrowego*, LEX/el. 2019.

<sup>31</sup> *Ibid.*

<sup>32</sup> A. Wachowska, M. Ręgorowicz, *ChatGPT w praktyce...*

<sup>33</sup> As indicated in recital 17, the term “database” includes: literary, artistic, musical or other collections of works or collections of other material such as texts, sound, images, numbers, facts, and data.

the meaning of copyright law, it is protected as a whole, even if the individual elements are not of a creative nature. However, *sui generis* protection is a right for the producer of a database that requires a qualitatively or quantitatively significant investment to obtain verification or presentation of its content, which is intended to protect against the extraction or re-utilization of data in whole or in significant part. Legal users of the database are only entitled to download data or re-use a non-essential part of it for any purpose, both as regards the quality and quantity of the data.

Users may not carry out acts contrary to the normal exploitation of the database or unreasonably prejudice the legitimate interests of the producer, and are obliged to respect the rights of the holder of copyright or related rights in respect of works or subject matter which constitute the contents of the database. Exceptions to the *sui generis* right are contained in Art. 9 of Directive 96/9/EC, which indicates that data may only be extracted or re-used in substantial part without the authorisation of the producer: 1) for extraction for private purposes of the contents of a non-electronic database; 2) as illustration for teaching or scientific research, as long as the source is indicated and to the extent justified by the non-commercial purpose to be achieved without prejudice to the exceptions and limitations provided for in Directive (EU) 2019/790; 3) in the case of extraction and/or re-utilization for the purposes of public security or administrative or judicial procedure.<sup>34</sup>

It should be pointed out that a broad understanding of the concept of text and data mining, understood as an automated analytical technique for analyzing digital texts and data to generate information including, but not limited to, patterns, trends, and correlations [Art. 2(2) of Directive 2019/790], is intended to guarantee the flexibility of the definition and reduce the risk of its becoming obsolete with constant technological progress. In contrast, as Martin Kretschmer and Thomas Margoni point out, an overly broad understanding of the process of text and data mining by different users in different units of time makes the development of AI entirely dependent on exceptions to the use of data, and limiting the scope of exceptions to the right of reproduction leaves the communication of research results in a grey area. According to the authors, there is no need to establish an exception for the act of extracting information value from protected works, which is a strongly debatable position.

Despite the emphasis on creators' rights in EU legislation regarding data and technologies created based on them, and the assertion that intellectual property protection must be taken into account in the development of new technologies, an "open source" philosophy is more visible. The current legislation is not sufficiently adapted to the new conditions in which creators operate. This is expressed in broadly defined protection exceptions, as well as the legislator's narrative, which emphasizes primarily the potential resulting from access to data. Also an exception from Art. 4 section 3 of Directive 2019/790 regarding the reproduction of databases or works for the purposes of machine learning, which allows the rights holders to refuse permission

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<sup>34</sup> Changes in *sui generis* protection are provided for by a regulation on harmonised rules on fair access to and use of data (Data Act).

when the activity has a commercial dimension, does not ensure them any protection, as in fact, in most cases, they do not even have the possibility to verify whether their protected objects are being used or in what way, as this is happening exponentially. It should be noted that infringement of intellectual property rights can already occur at the stage of programming and teaching the system, the generation of results, or during the evaluation of the right to use the obtained results.<sup>35</sup>

Also, the AIA will not solve the problem, although it may bring some changes to the lack of transparency. According to Art. 11, high-risk AI systems should be provided with technical (updated) documentation containing the necessary information. For example, such information could include the general characteristics, capabilities, and limitations of the system, algorithms, data, training, testing, and validation processes used, as well as documentation on the relevant risk management system.<sup>36</sup> This means that it will be necessary to provide the data used for AI training, but only for high-risk AI systems.

Internal terms of services binding on users of individual portals also do not support the rights of creators. When posting songs on popular platforms such as Google, YouTube, or X, it is worth knowing that users are granting a license to these entities. For example, under Google Terms of Service, the license allows users to host, reproduce, distribute, transmit, and use the content, for example to save it on Google's systems and make it accessible from anywhere; it permits changing user content, e.g. by reformulating or translating it, as well as sublicensing these rights, among others, to develop new technologies and services for Google.<sup>37</sup>

An even broader scope of licences was adopted in the X terms of service of 29 September 2023.<sup>38</sup> License (with the right to sublicense) includes the right "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 (for clarity, these rights include, for example, curating, transforming, and translating). This license authorizes us to make your content available to the rest of the world and to let others do the same. You agree that this license includes the right for us to provide, promote, and improve the Services and to make Content submitted to or through the Services available to other companies, organizations, or individuals for the syndication, broadcast, distribution, repost, promotion, or publication of such Content on other media and services, subject to our terms and conditions for such Content use." These internal provisions indicate that when using social media, we should be aware that our content will serve as training (validation, testing) material in the process of machine learning.<sup>39</sup>

<sup>35</sup> A. Wachowska, M. Ręgorowicz, *ChatGPT w praktyce...*

<sup>36</sup> See: Annex IV, AIA.

<sup>37</sup> Google Terms of Service of 5 January 2022, <https://policies.google.com/terms?hl=en&fg=1> [accessed: 2023.10.26].

<sup>38</sup> <https://twitter.com/en/tos> [accessed: 2023.10.25].

<sup>39</sup> For example: the case of Copilot v Microsoft and GitHub concerned the use of data published on the social network. Repositories owned by Copilot were exploited by the defendants to train

These problems are not merely abstract in nature, as is shown by lawsuits concerning the intellectual property of training data. One of the first case, *Getty Images v. Stability AI*, is pending in a federal court in Delaware. The lawsuit concerns the copying of over 12 million photos along with captions and metadata. Damage was estimated at \$150,000 for each work, which could mean a total of \$1.8 trillion.<sup>40</sup> A similar claim was filed before the High Court of Justice in London.<sup>41</sup> In another case, artists Sarah Andersen, Kelly McKernan, and Karla Ortiz sued Midjourney, Stable Diffusion, and DeviantArt.<sup>42</sup> In turn, OpenAI, the creator of ChatGPT, was sued by a group of writers and journalists, including: Michael Chabon, David Henry Hwang, Matthew Klam, Rachel Louise Snyder, and Ayelet Waldman. They claim that their works were copied without their consent and used to teach the generator how respond to commands entered by people.<sup>43</sup> Satirist Sarah Silverman accused OpenAI of unlawfully generating book summaries.<sup>44</sup> *The New York Times*, in turn, is considering accusing the chatbot of plagiarism.<sup>45</sup> The results are difficult to predict. Companies working on artificial intelligence indicate that the use of data protected by copyright is possible under the principles of fair use provided for in US law; another difficulty is proving that the work was actually used by AI.<sup>46</sup>

The lack of appropriate legislative solutions has prompted protests from the arts community. On 9 August 2023, leading global news and publishing organisations (among them: Agence France Presse, European Pressphoto Agency, the European Publishers' Council, the National Press Photographers Association, the National Writers

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generative AI. According to GitHub, users who publish their code on the platform have agreed to the viewing, usage, indexing, and analysis of public code. For this reason the owners of the portal are entitled to use, including for commercial purposes, the published data. In this case, it involved the creation of codes that were very similar to or even duplicated user codes. It is true that Copilot published under an open source licence, but the claimant considers that the scope of use, including copying of published data, does not fall within the licence granted. T. Claburn, *Microsoft and GitHub are still trying to derail Copilot code copyright legal fight*, [https://www.theregister.com/2023/07/01/microsoft\\_github\\_copilot/](https://www.theregister.com/2023/07/01/microsoft_github_copilot/) [accessed: 2023.10.21].

<sup>40</sup> M. O'Brien, *Photo giant Getty took a leading AI image-maker to court. Now it's also embracing the technology*, <https://apnews.com/article/getty-images-artificial-intelligence-ai-image-generator-stable-diffusion-a98eeaaeb2bf13c5e8874ceb6a8ce196> [accessed: 2023.10.26].

<sup>41</sup> Getty Images, *Statement of 17 January 2023*, <https://newsroom.gettyimages.com/en/getty-images/getty-images-statement> [accessed: 2023.10.26].

<sup>42</sup> J. Vincent, *AI art tools Stable Diffusion and Midjourney targeted with copyright lawsuit*, <https://www.theverge.com/2023/1/16/23557098/generative-ai-art-copyright-legal-lawsuit-stable-diffusion-midjourney-deviantart> [accessed: 2023.10.24].

<sup>43</sup> Ch. DiFelicianantonio, *Authors Michael Chabon, David Henry Hwang sue OpenAI over copyright concerns*, <https://www.sfchronicle.com/tech/article/michael-chabon-open-ai-lawsuit-copyright-18360019.php> [accessed: 2023.10.20].

<sup>44</sup> Z. Small, *Sarah Silverman Sues OpenAI and Meta Over Copyright Infringement*, <https://www.nytimes.com/2023/07/10/arts/sarah-silverman-lawsuit-openai-meta.html> [accessed: 2023.10.26].

<sup>45</sup> B. Allyn, *'New York Times' considers legal action against OpenAI as copyright tensions swirl*, <https://www.npr.org/2023/08/16/1194202562/new-york-times-considers-legal-action-against-openai-as-copyright-tensions-swirl> [accessed: 2023.10.25].

<sup>46</sup> Skeptical about the chances of winning, see: N. Senkowska, *"Trening" sztucznej inteligencji: co z prawami twórców dzieł, na których ćwicz*, *"Rzeczpospolita"*, 13.07.2023.



Union, The Associated Press, The Authors Guild) presented an open letter calling for copyright protection to be taken into account in the development of generative AI models. In particular, they demanded disclosure of the training sets used to create generative AI models.<sup>47</sup>

Taking into account the increasing number of lawsuits and objections from the press, OpenAI has announced that website operators have the option to block the content published there for Chat GPT.<sup>48</sup> The ability to block content, especially through media portals, seems to be most desirable. Many entities, including Reuters, Getty Images, *The Guardian*, *The New York Times*, *The Chicago Tribune*, CNN, Australia's ABC, *The Canberra Times*, *The Newcastle Herald*, and other content providers have already banned Chat GPT from using the content they generate.<sup>49</sup>

These examples show that the lack of adequate protection for creators will affect the quality of the data, that is – in turn, as is shown in par. 2.1 – of paramount importance for the sake of data justice. There is a risk that if reliable/quality data (e.g. valuable press releases) are blocked for AI systems, these systems will be fed with datasets containing a significant number of errors (e.g. fake news).

Intellectual property rights over data, as an element of data justice, need to be balanced according to a more instrumental approach than what is currently available. Protection in this area should focus, above all, on the transparency of training data sources or planned methods of use (applied not only to high-risk AI systems), but also in order to protect human creativity (in three dimensions: training, processing, and producing works competing with the original) should be based on the need to obtain an author's consent. First, the owners of new solutions currently do not publicly disclose information about the origin of the data used.<sup>50</sup> Second, both the regulations

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<sup>47</sup> <https://drive.google.com/file/d/1jONWdRbwbS50hd1-x4fDvSyARJMCgRTY/view> [accessed: 2023.10.23], see also <https://www.publishers.org.uk/global-summit-on-ai-the-importance-of-intellectual-property-to-the-success-of-safe-artificial-intelligence/> [accessed: 2023.10.28].

<sup>48</sup> New privacy policies from Google and the Meta-owned platforms introduce the possibility for users to block user-generated content. However, the works collected so far remain in the database. D. Milmo, *The Guardian blocks ChatGPT owner OpenAI from trawling its content*, <https://www.theguardian.com/technology/2023/sep/01/the-guardian-blocks-chatgpt-owner-openai-from-trawling-its-content> [accessed: 2023.10.28]. At the same time, the system has been improved, so that the chat is based on current content and not on data posted on the Internet until 2021. Data blocking is also possible by using appropriate plug-ins, <https://pl.wordpress.org/plugins/block-chat-gpt-via-robots-txt/> [accessed: 2023.10.28]. Another solution is the Nightshade tool, which disrupts training data. Here again, new technologies are ahead of the law, E. David, *Artists can use a data poisoning tool to confuse DALL-E and corrupt AI scraping*, <https://www.theverge.com/2023/10/25/23931592/generative-ai-art-poison-midjourney> [accessed: 2023.10.28].

<sup>49</sup> A. Bogle, *New York Times, CNN and Australia's ABC block OpenAI's GPTBot web crawler from accessing content*, <https://www.theguardian.com/technology/2023/aug/25/new-york-times-cnn-and-abc-block-openais-gptbot-web-crawler-from-scraping-content> [accessed: 2023.10.20]; see also B. Haring, *BBC Will Block ChatGPT AI from Scraping Its Content*, <https://deadline.com/2023/10/bbc-will-block-chatgpt-from-scraping-its-content-1235566868/> [accessed: 2023.10.14].

<sup>50</sup> The data often comes directly from social media, websites, or databases, including those created by non-profit projects such as LAION (Large-scale Artificial Intelligence Open Network). It provides free access to various types of databases, making a reservation that "this large-scale dataset is non-

of social networking sites, where works may come from, and artificial intelligence systems assume a presumption of consent, which significantly weakens the position of the artist. The adopted techno-procedural model is not complete enough, and the existing regulations introduce extensive exceptions that leave authors practically without protection. It is also interesting that in relation to new technologies, the protection of authors is at a weaker level than in relation to traditional forms of use of works (despite the greater potential for threats). However, an approach that guarantees the same protection regardless of the tool used is justified under the scheme of data justice.

## 2. Navigating legal significance: unravelling the journey towards data justice

### 2.1. A multifaceted concept of data justice

Data justice is a concept originally developed within the realm of the social sciences; however, in the context of digital society nowadays, it also deserves closer examination within the domain of legal studies.<sup>51</sup> There is no universally agreed upon and established definition of what data justice is or, consequently, how to address data (in) justice.<sup>52</sup> Data justice is a multifaceted concept that encompasses different aspects: the existing inequalities reflected and multiplied by data and relevant discriminations; the ways of gathering and processing data; the purposes addressed by the deployment of data; new digital rights; the “politics” of data<sup>53</sup> with the implied asymmetries of data power and “ownership” among private bodies and between private bodies and public authorities; and a society forged by data and for data.<sup>54</sup>

However, beyond these different facets, it is possible to isolate some aspects of legal relevance that deserve major discussion among legal scholars. First, the focus of data justice is on groups, in addition to individuals, and it extends beyond any personal data involvement. Second, open data policies surely align with social justice principles, because of their “democratic” approach to data sharing. But they hold a reverse side:

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curated. It was built for research purposes to enable testing model training on larger scale for broad researcher and other interested communities, and is not meant for any real-world production or application.”

<sup>51</sup> L. Dencik, J. Sanchez-Montero, *Data...*, p. 3, remind us that “To speak of data justice is thus to recognise not only how data, its collection and use, increasingly impacts on society, but also that datafication is enabled by particular forms of political and economic organisation that advance a normative vision of how social issues should be understood and resolved. That is, data is both a matter *in* and *of* justice; datafication embodies not only processes and outcomes of (in)justice, but also its own justifications.”

<sup>52</sup> R. Kitchin, *The Data Revolution...*, p. 287, observes that “there is no shared common understanding of the moral principles of social justice – and by association data justice – and how to achieve it.”

<sup>53</sup> E. Ruppert, E. Isin, D. Bigo, *Data Politics...*, p. 3.

<sup>54</sup> L. Dencik, J. Sanchez-Montero, *Data...*, p. 3.



the exacerbation of existing inequalities, since data often reflect deeply ingrained socio-cultural biases and discrimination;<sup>55</sup> the risk of further discrimination stemming from the repurposed and broader deployment of inferred (anonymous) data, originally collected for specific groups of people (e.g., unwell, elderly, or disabled individuals)<sup>56</sup> and for specific purposes concerning these groups; and the infringement of IP rights. Third, data justice upholds a procedural approach and participatory rights to ensure data sharing, data quality, and non-discriminatory practices. Considering this context, the data justice approach can also be deemed supportive of the establishment of new digital rights, which can be enforced either individually or collectively.<sup>57</sup> This means that the legal system endows citizens or groups with appropriate legal tools to defend their claims related to fair data processing, but, in doing so, it also charges them with the responsibility to consider possible cases of data (in)justice.

For our limited purposes, it is worth recalling the methodology implemented by the EU legislator to cope with data quality, data and IP protection, data security, the underlying risks of discrimination, and the objectives of making data more open and available for re-use. In this respect, the methodological pattern followed by the EU is mainly built on a techno-procedural-driven approach.<sup>58</sup> Thus, some organisational steps are required to be embedded in the technology itself (i.e. by design and by default);<sup>59</sup> furthermore, some procedural fulfilments are listed to set out a governance process addressed with tackling the question of transparency and data quality (i.e. Art. 10, AIA).

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<sup>55</sup> As stressed by the Opinion of the European Economic and Social Committee on Artificial intelligence, *The consequences of artificial intelligence on the (digital) single market, production, consumption, employment and society*, in OJ 2017/C 288/01, par. 3.5. "There is a general tendency to believe that data is by definition objective; however, this is a misconception. Data, may be biased, may reflect cultural, gender and other prejudices and preferences."

<sup>56</sup> As stressed by L. Taylor, *What is data justice...*, p. 2, "the greatest burden of dataveillance (surveillance using digital methods) has always been borne by the poor [...] Beyond socio-economic status, gender, ethnicity and place of origin also help to determine which databases we are part of, how those systems use our data and the kinds of influence they can have over us."

<sup>57</sup> B. Custers, *New digital rights: Imagining additional fundamental rights for the digital era*, "Computer Law and Security Review" 2022, vol. 44, pp. 9–10, refers (among others) to the right to change your mind, the right to start over with a clean (digital) slate, and the right to expiry dates for data.

<sup>58</sup> In this respect, digital constitutionalism rests on safeguards addressed to protect fundamental rights and democratic values, thus making private digital bodies accountable by means of procedural fulfilments, transparency, and due process in order to limit their discretionary margin of manoeuvre and mitigate the risks stemming from their practices: see G. De Gregorio, *Digital Constitutionalism in Europe – Reframing Rights and Powers in the Algorithmic Society*, Cambridge 2022, p. 312 *et seq.*; O. Pollicino, *Judicial Protection of Fundamental Rights on the Internet. A Road Towards Digital Constitutionalism?*, Oxford 2021.

<sup>59</sup> L.A. Bygrave, *Hardwiring Privacy* [in:] *The Oxford Handbook of Law, Regulation, and Technology*, eds. R. Brownsword, E. Scotford, K. Yeung, Oxford, 2018, p. 755, recalls that "with such embedment, the automated processes of the architecture will help automate legal norms, thus making the latter largely self-executing."

## 2.2. From data quality to data justice

We know that data are not neutral for various reasons. On the one hand, they involve human choices that may be questionable; they imply certain methodologies over others, the collection of certain data over others, and different modes of gathering, selecting, measuring, and analysing data. On the other hand, in today's society, data represent power, not only in terms of economic revenues as viewed through the lens of antitrust and competition law, but also because they enable a profound understanding of citizens' habits and preferences, facilitating profiling, predictions, and subsequently, personalized decision-making,<sup>60</sup> according to the settled relationship between knowledge and power, well described by Michel Foucault,<sup>61</sup> and by the more recent "surveillance capitalism" theory.<sup>62</sup>

The scale of this data power can be proven in terms of numbers, i.e. by the global market size gained in recent years by intelligent data processing and the pace of its increasing growth rate estimated for coming years;<sup>63</sup> but it can also be proven by the influence of data and information on the exercise of fundamental rights and freedoms like the freedom of expression and information (i.e. disinformation, misinformation) as well as on democratic processes (i.e. the Cambridge Analytica case with reference to the US elections and the UK referendum).

In addition to these asymmetries of power, further risks emerge when datasets and their analytics are built upon biased data;<sup>64</sup> or even if data do not contain prejudices and are not inherently discriminatory, they can be deployed in ways that yield discriminatory outcomes (the Aadhaar system in India is telling);<sup>65</sup> or in any case deployed in order to re-shape human behaviour according to the will of the data controller, impinging upon people's free will. In short, data have become a "political and social practice" and so they share with it stereotypes, gaps, prejudices, and biases.<sup>66</sup>

<sup>60</sup> J. van Dijck, *Datification, dataism and dataveillance: Big data between scientific paradigm and ideology*, "Surveillance & Society" 2014, vol. 12, no. 2, p. 197 et seq.; G. De Gregorio, *Digital Constitutionalism in Europe...*, describes the shift that has occurred within the framework of the current algorithmic society – from the freedom to conduct a business to real private digital bodies that exercise functions traditionally offered by public authorities.

<sup>61</sup> M. Foucault, *La naissance de la biopolitique. Course au Collège de France (1978–1979)*, Paris 2004.

<sup>62</sup> S. Zuboff, *The Age of Surveillance Capitalism – The Fight for a Human Future at the New Frontier of Power*, London 2019.

<sup>63</sup> See *Intelligent Document Processing Market Size, Share & Trends Analysis Report, 2023*, <https://www.grandviewresearch.com/industry-analysis/intelligent-document-processing-market-report> [accessed: 2023.10.28].

<sup>64</sup> G.A. Grasso, *GDPR Feasibility and Algorithmic Non-Statutory Discrimination*, Naples 2022, p. 10, underlines that "the presence of bias [...] leads to systematic errors that influence judgement and decisions. These distortions or false representations of reality may also affect computer systems, which consistently and unfairly discriminate against certain individuals or group of individuals in favour of others, denying opportunity or generating unwanted results for unreasonable or inappropriate reasons."

<sup>65</sup> For a description of the discriminatory background and consequences of this for India's biometric database, see L. Taylor, *What is data justice...*, pp. 4–5.

<sup>66</sup> E. Ruppert, E. Isin, D. Bigo, *Data Politics...*, p. 3, state that "the production of data is a social and often political practice that mobilizes agents who are not only objects of data (about whom data

Data sharing assumes that the data made available are of good quality to prevent discrimination resulting from big data analytics.<sup>67</sup> In this last respect (avoiding discrimination), not only are data gathering procedures and data quality relevant, but also the way they are processed by different algorithms, the algorithm models chosen, their uses, and the final aims addressed.<sup>68</sup> In respect of the mentioned risks, not only are individual rights in the foreground, but also the interests of entire groups: “Big data and associated analytics are radically transforming how people are treated collectively.”<sup>69</sup> This holds true, not only when decisions are taken and they produce legally binding effects on people, such as the case of artificial intelligence systems used in order to allocate social allowances or benefits, select workers, candidates or students, or implement predictive justice etc.<sup>70</sup> This is also true when the insight and knowledge gained through artificial intelligence systems about the habits, behaviours, and cognitive patterns of groups are employed in a softer but equally striking way, by nudging people’s freedom of will and conduct.<sup>71</sup> In this respect, power (either public or private) becomes “intimate and efficient. It knows us. It learns from us.”<sup>72</sup> In other instances, this in-depth knowledge about people, gives rise to a real “dataveillance” that entails an enforced disciplinary control over people, such as is the case in China.<sup>73</sup>

This highlights the necessity for the integration of the existing procedural approach with more stringent legislative intervention in defining which uses should be prohibited when big data analytics come into play, particularly through artificial intelligence systems. There are two primary reasons for this. First, a procedural approach

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is produced) but that they are also subjects of data (those whose engagement drives how data is produced). Our question thus shifts to social practices and agents. Data does not happen through unstructured social practices but through structured and structuring fields in and through which various agents and their interests generate forms of expertise, interpretation, concepts, and methods that collectively function as fields of power and knowledge.”

<sup>67</sup> Cases of algorithmic run by data that have brought about discriminatory outcomes are too well-known to be described; it suffices to recall the Loomis case in the US, that of Syri in the Netherlands, or Amazon’s automated recruitment system.

<sup>68</sup> European Union Agency for Fundamental Rights – Report, *#BigData: Discrimination in Data Supported Decision – Making*, Luxembourg 2018, p. 3.

<sup>69</sup> R. Kitchin, *The Data Revolution...*, p. 214.

<sup>70</sup> For an overview of the different uses of artificial intelligence systems and the consequent legal implications, see B. Custers, E. Fosch-Villaronga, *Law and Artificial Intelligence – Regulating AI and Applying AI in Legal Practice*, The Hague 2022.

<sup>71</sup> For the nudge theory see R.H. Thaler, C. Sunstein, *Improving decisions about Health, Wealth and Happiness*, New York 2009.

<sup>72</sup> J. Cheney-Lippold, *We are Data: Algorithms and the Making of Our Digital Selves*, New York 2017, p. 107.

<sup>73</sup> In this respect the testimony offered by the investigative journalist Geoffrey Cain before the U.S. Senate Committee on the Judiciary Subcommittee on Human Rights and the Law on 10 June 2023 is telling: “The Chinese Communist Party (CCP) has engineered a vast AI-powered surveillance system literally called ‘Sky Net’. It runs AI-powered ‘alarms’ that notify the police and intelligence services when someone unfurls a banner, when a foreign journalist is traveling to certain parts of the country, and when someone from an ethnic minority is present. The government accuses entire groups, such as Muslim Uyghurs, of posing a terrorist threat, and relentlessly persecutes them with the use of AI tools.”

is unable to eliminate the root-causes of inequalities deeply embedded in cultural and socio-economic structures. Second, while procedures can help to ensure transparent, fair, and accountable data processing in accordance with standards and best practices, they do not tackle the nature of the objectives pursued by the massive deployment of data.<sup>74</sup> In this respect, as set out by research developed by the Global Partnership on Artificial Intelligence,<sup>75</sup> data justice encompasses not only a focus on data openness, data sharing, data governance, data quality, and transparent and non-discriminatory algorithms, but also a focus on the targeted objectives, when operators, whether public or private, run algorithms based on data and deliver assessments, forecasts, or decisions. Therefore, it is not only data themselves that are likely to cause harm, but even in the event that data are not biased, the aims pursued, too, could potentially threaten fundamental rights and freedoms.

It is certainly a complex challenge for legislators to address all potential data uses that either cause or are likely to cause significant harm to people; moreover this is so because the legislator is requested to take into account competing interests of businesses and lobbies that often push in different directions. This has been proven by the recent “Joint industry call for a risk-based AI Act that truly fosters innovation”: it contends that “the list of prohibited AI systems would create unnecessary red tape and legal uncertainty.”<sup>76</sup>

Consequently, it seems that the approach to the objectives served by practices involving artificial intelligence, as adopted by the EU legislator, especially with regard to data-fed systems, requires further discussion and insight. This is primarily due to the current uncertainty surrounding the scope of the objectives that certain artificial intelligence systems can enable, especially with regard to their ability to cause harm to people or be a likely cause of harm (above all, foundation models and general-purpose AI systems: Art. 1, par. 1, AIA.<sup>77</sup> Hence, a more comprehensive evaluation and adjustment are required concerning the boundaries between unacceptable goals pursued by the deployment of big data (as currently outlined in Art. 5 of the AIA) and high-risk systems (as currently outlined in Art. 6 of the AIA). Therefore, it is the scope of Art. 5 that requires a more in-depth evaluation. This is to place greater emphasis on

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<sup>74</sup> C. D'Ignazio, L.F. Klein, *Data feminism*, Cambridge 2020, p. 60, denounce the insufficiency of a procedural and data governance approach when addressing data ethicists' position. M. Veale, F. Zuiderveen Borgesius, *Demystifying the Draft EU Artificial Intelligence Act – Analysing the good, the bad, and the unclear elements of the proposed approach*, “Computer Law Review International” 2021, no. 4, underline the inadequacy of the EU Draft Artificial Intelligence Act, and equally denounce the shortcomings of the prohibitions listed in Art. 5 of the proposal.

<sup>75</sup> *Advancing Data Justice Research and Practice – An Interim Guide for Policymakers for the 2022 AI UK event*, <https://gpai.ai/projects/data-governance/data-justice/> [accessed: 2023.10.14].

<sup>76</sup> <https://ccianet.org/library/joint-industry-call-for-a-risk-based-ai-act-that-truly-fosters-innovation/> [accessed: 2023.10.14].

<sup>77</sup> See also: Art. 28b Amendments adopted by the European Parliament on 14 June 2023 on the proposal for a regulation of the European Parliament and of the Council on laying down harmonised rules on artificial intelligence (Artificial Intelligence Act) and amending certain Union legislative acts (COM(2021)0206 – C9-0146/2021 – 2021/0106(COD)), [https://www.europarl.europa.eu/doceo/document/TA-9-2023-0236\\_EN.html](https://www.europarl.europa.eu/doceo/document/TA-9-2023-0236_EN.html) [accessed: 2023.10.26].

the idea that data justice is a multifaceted concept that encompasses not only data, their quality, and their ways of processing (as is done by Art. 6 and following articles), but also the objectives pursued through their processing.

In this light, an “instrumental justice”<sup>78</sup> approach needs to be better implemented and deepened by the legislator. Indeed, this seems to be the effort that the EU legislator has tried to undertake: it is worth noting that during the legislative process for the approval of the EU’s draft AIA, the European Parliament expanded the list of artificial intelligence systems prohibited within the EU.<sup>79</sup> This expansion included: the prohibition of *ex-post* remote biometric identification systems, in addition to real-time remote biometric identification systems; the deployment of sensitive characteristics for biometric categorisation, predictive policing, and emotion recognition; and indiscriminate scraping of biometric data from social media or CCTV footage to create facial recognition databases. Likewise, the opinion delivered on the draft AIA by the European Economic and Social Committee recommended expanding the lists of the AI systems banned from the EU.<sup>80</sup>

Caution proves especially beneficial when certain applications are built on uncertain theoretical foundations, as was the case with the Basic Emotion Theory (BET).<sup>81</sup> Concerning this the AIA has resulted in a ban on the practice of biometric categorization and the associated emotion recognition systems, whereas in the original European Commission proposal, these practices were neither forbidden nor classified as high-risk systems.<sup>82</sup> In a similar way, and as a relevant instance, the current Annex III provisions on high-risk AI systems encompass systems intended to be used for determining access to certain essential public services or activities (education and vocational training, recruitment: i.e. Annex III, point 3 and point 4), or monitoring the

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<sup>78</sup> According to the perspective described by R. Heeks, J. Renken, *Data Justice for development...*, p. 4, “concerns about justice only relate to the impact of the use of that data.” See also quotation n. 4.

<sup>79</sup> Amendments adopted by the European Parliament on 14 June 2023 on the proposal for a regulation of the European Parliament and of the Council on laying down harmonised rules on artificial intelligence (Artificial Intelligence Act) and amending certain Union legislative acts – P9 TA(2023)0236.

<sup>80</sup> In its opinion (INT/940, par. 4.8), the EESC called for “a ban on use of AI for automated biometric recognition in publicly and privately accessible spaces (such as recognition of faces, gait, voice and other biometric features), except for authentication purposes in specific circumstances (for example to provide access to security sensitive spaces): a ban on use of AI for automated recognition of human behavioural signals in publicly and privately accessible spaces; a ban on AI systems using biometrics to categorise individuals into clusters based on ethnicity, gender, political or sexual orientation or other grounds on which discrimination is prohibited under Art. 21 of the Charter; a ban on the use of AI to infer emotions, behaviour, intent or traits of a natural person, except for very specific cases, such as some health purposes, where patient emotion recognition is important.”

<sup>81</sup> The Basic Emotion Theory (BET), developed by psychologist Paul Ekman in the 1960s, suggests that it is possible to understand people’s emotions based on their facial expressions. The psychologist also argued that his theory had universal applicability because the expressions are the same for all human beings. However, over the years, various studies have demonstrated the invalidity of BET, since how a human being manifests his/her emotions changes according to different socio-cultural environments.

<sup>82</sup> <https://www.europarl.europa.eu/doceo/document/TA-9-2023-0236EN.html> [accessed: 2023.10.14].

behaviour of students (i.e. Annex III, point 3). In this respect, their inclusion in the list of the forbidden AI systems should better comply with the concept of “instrumental” data justice, since these purposes (monitoring students or determining access to education and job) have the potential to infringe people’s fundamental rights (access to education or work) or people’s free will and behaviour (especially when monitoring tools are employed towards students at certain stages of their development); or, in any case, because similar tools could foster blackmail practices.

An instrumental justice approach could also fit the purpose of IP protection, because its focusing on the goals addressed by the deployment of data can help to strike a fair balance between conflicting interests and the consequent definition of the adequate exceptions in copyright law.

The objection to a wider list of prohibited AI practices is based on concerns about stifling innovation and harming competition as a consequence of a too rigid approach. Nevertheless, it is also true that such an approach introduces a criterion of certainty that holds value at this “state of the (uncertain) art” for the cost-benefit assessment usually practiced by market operators.

Consequently, a precautionary approach that re-assesses certain purposes addressed by data deployment, more specifically by means of artificial intelligence practices, moving them away from the existing high-risk artificial intelligence systems list in order to integrate them into the list of banned artificial intelligence practices in the EU, is considered valuable for two primary reasons of “instrumental” data justice: on one hand, the significance of the interests involved (fundamental rights and freedoms) and the uncertainty (at the state of the art) of the scope and probability of potential harms; on the other, the enhancement of legal certainty that implies a rebalance of the boundaries between interests involved in the multifaceted concept of data justice and those involved in freedom to conduct business or control of public authorities over citizens.

## Conclusions

The pieces of EU legislation and EU initiatives seem to comply with (part of) the data justice approach. They foster data openness and data sharing (Data Governance Act and Data Act); they provide for new digital rights (i.e. transparency, free portability of data for users and third parties, submission of complaints; see here: Data Market Act and Data Services Act, Artificial Intelligence Act); they focus on technical and procedural fulfilments and a consequent data governance framework aimed to safeguard data quality (primarily, the Artificial Intelligence proposal). All this gives evidence of the effort made by the legislator in safeguarding the interests of individuals and groups, while promoting innovation and acknowledging the fluid and relative nature of data quality, which depends on specific objectives and is consequently challenging to define in precise legal terms.

However, some substantial safeguards are loosely defined. In this respect, what makes the substance of data quality is mainly delegated to private and technical standards; transparency, fairness and accountability in data processing are enacted by procedural obligations; prohibited uses remain confined in a limited list; and copyright exceptions are ill-balanced in reference to the purposes that they address.

At this time, it is crucial to emphasize one key issue: such an approach complies with only a part of the issues involved in data justice. Thus, a more comprehensive approach to data justice calls for a more incisive intervention by public authorities.

The legal implications at stake, especially in relation to social justice outcomes, are too significant to be overcome by and to be limited to procedures and rights of access or addressing complaints in order to safeguard individuals or groups. Thus, these legal implications should not be reduced to mere technical and procedural requirements to be implemented by operators, overseen and enforced by supervisory authorities, or to new enforceable digital rights.

In the light of the previous arguments, data justice needs to receive legal enshrinement in order to encompass all the multifaceted aspects described. Consequently, it should not be confined solely to personal data protection or to the broader collective concerns about which data are collected and how they are collected and processed. Nor should it be restricted to questions of data ownership, data openness, data sharing, relevant and underlying procedural and governance issues, or new digital rights. It should also address the purposes for which such data are utilized.

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## Summary

*Nadia Maccabiani, Anna Podolska, Ewelina Szatkowska*

### How Artificial Intelligence Learns. Legal Aspects of Using Data in Machine Learning

Recalling the debate around data justice in order to highlight which parts of this multifaceted concept have been endowed with legal relevance by EU legislation or initiatives, the paper argues that the EU should implement a more "instrumental" approach to data justice. This perspective emphasizes a stronger focus on the purposes addressed by the deployment of data within AI systems.

**Keywords:** data justice, artificial intelligence, intellectual property, data quality.

## Streszczenie

*Nadia Maccabiani, Anna Podolska, Ewelina Szatkowska*

### Jak uczy się sztuczna inteligencja. Prawne aspekty wykorzystywania danych w uczeniu maszynowym

Tocząca się debata na temat sprawiedliwości danych daje możliwość wskazania, które elementy tej wielowymiarowej koncepcji zostały odzwierciedlone w prawodawstwie oraz inicjatywach UE. W artykule argumentuje się, że UE powinna wdrożyć bardziej „instrumentalne” podejście do sprawiedliwości danych. Perspektywa ta podkreśla konieczność silniejszego skupienia się na celach, którym ma służyć wykorzystanie danych w systemach AI.

**Słowa kluczowe:** sprawiedliwość danych, sztuczna inteligencja, własność intelektualna, jakość danych.

**Joanna Marszałek**

University of Gdańsk, Poland

joanna.marszalek@prawo.ug.edu.pl

ORCID: 0000-0002-5412-0935

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# Blockchain and Traceability of Geographical Indication Products

## 1. Traceability system and geographical indication products

Traceability is a fundamental system of food safety and risk management. What is more, it plays a great role in certification and control processes in geographical indication (GI) products as it provides protection against counterfeits and products of poor quality. To meet these expectations, the traceability system must be efficient and have anti-tampering features. Systems that use blockchain technology are such systems.

Traceability is a process that makes it possible to follow all the steps products go through from creation to final disposal.<sup>1</sup> This is achieved by giving objects unique marks or tags which record data about and all movements of objects.<sup>2</sup> In other words, the term describes the ability to trace the various steps and locations of products through supply chains. The definition of traceability is included in the European Union (EU) General Food Law (2002),<sup>3</sup> art. 3, 15, which describes it as the ability to trace and follow a food, feed, food-producing animal or substance intended or expected to be incorporated into a food or feed, through all stages of production, processing and

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<sup>1</sup> [https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwjQuZKNjZyCAxU1FBAlHd7mBoQQFnoECCAQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod\\_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usg=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449](https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwjQuZKNjZyCAxU1FBAlHd7mBoQQFnoECCAQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usg=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449) [accessed: 2023.10.29].

<sup>2</sup> R. Schuitemaker, X. Xu, *Product traceability in manufacturing: A technical review*, 53<sup>rd</sup> Conference on Manufacturing Systems, "Procedia CIRP" 2020, vol. 93, p. 700.

<sup>3</sup> Regulation (EC) No 178/2002 of the European Parliament and of the Council of 28 January 2002 laying down the general principles and requirements of food law, establishing the European Food Safety Authority and laying down procedures in matters of food safety (Document 02002R0178-20220701).

distribution.<sup>4</sup> There is no doubt that traceability is an important system for controlling the risks which can affect food supply chains.<sup>5</sup>

The significance of traceability was underscored during the European beef crisis caused by bovine spongiform encephalopathy (BSE),<sup>6</sup> commonly known as mad cow disease, in the 1990s. When it became clear that ingesting meat from cattle infected with BSE could transmit the disease to humans, beef consumption collapsed. During the crisis, the exact origin of BSE was unknown, but it was said to have originated in the United Kingdom.<sup>7</sup> This crisis provided the impetus for work on European food law 178/2002, which came into force in Member States on 1 January 2005.<sup>8</sup> The same situation occurred in the Canadian BSE crisis of 2003 where the lack of good traceability systems resulted in losses of CAD5.3 billion for Canadian beef producers by the end of 2004.<sup>9</sup>

Another example which shows the importance of good traceability systems is the outbreak of salmonella in the US in 2008.<sup>10</sup> Initially, the public was warned against consuming tomatoes which were identified as the source by investigators from the Food and Drug Administration (FDA) and the Centers for Disease Control and Prevention. However, a month later, FDA investigators correctly identified the source of the salmonella outbreak as peppers from Mexico. This delay was caused by chaotic record-keeping among growers, distributors, wholesalers and retailers. The cost to tomato growers in Florida alone was estimated at about \$100 million.<sup>11</sup>

Based on these examples, traceability systems clearly play a significant role in food safety. What is more, they are very useful instrument when it comes to GI products. Traceability systems can be used to guarantee product authenticity and provide credible information to consumers, which is incredibly important for the protection of products. The implementation of food traceability can also add value to niche products such as regional products.<sup>12</sup> GI is a sign or mark used on agricultural, manufactured and

<sup>4</sup> “[S]tages of production, processing and distribution’ means any stage, including import, from and including the primary production of a food, up to and including its storage, transport, sale or supply to the final consumer and, where relevant, the importation, production, manufacture, storage, transport, distribution, sale and supply of feed” (art. 3, 16 of the EU General Food Law).

<sup>5</sup> <https://www.precintia.com/en/blog/food-traceability-what-is-it-and-why-is-it-important/> [accessed: 2023.10.15].

<sup>6</sup> Bovine spongiform encephalopathy – fatal neurodegenerative disease in cattle that causes a spongy degeneration of the brain and spinal cord (M. Didier, G. Day, *History of food traceability*, Boca Raton 2018, p. 15).

<sup>7</sup> The United Kingdom was the most affected country with more than 179,000 infected cattle (*ibid.*).

<sup>8</sup> *Ibid.*

<sup>9</sup> S. Charlebois, B. Sterling, S. Haratifar, S.K. Naing, *Comparison of Global Food Traceability Regulations and Requirements*, “Comprehensive Reviews in Food Science and Food Safety” 2014, vol. 13, p. 1108.

<sup>10</sup> More than 1,300 people across the country contracted the illness.

<sup>11</sup> [https://www.washingtonpost.com/national-enterprise/traceability-rule-represents-major-adjustment-for-food-industry/2011/01/21/ABG0awD\\_story.html](https://www.washingtonpost.com/national-enterprise/traceability-rule-represents-major-adjustment-for-food-industry/2011/01/21/ABG0awD_story.html) [accessed: 2023.10.16].

<sup>12</sup> [https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwjQuZKNjZyCAxU1FBAIHd7mBoQQFnoECCAQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod\\_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usq=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449](https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwjQuZKNjZyCAxU1FBAIHd7mBoQQFnoECCAQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usq=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449) [accessed: 2023.10.29].

natural goods to protect and distinguish them from other products on the market.<sup>13</sup> It is a distinctive sign used to identify products and the quality, reputation or other such characteristics of which stem from their geographical origin.<sup>14</sup> The protection of products with GI provides producers with global recognition and consumers with information on original products from specific areas.<sup>15</sup>

GI plays a significant role in food protection while promoting high-quality foodstuffs and regional and traditional products.<sup>16</sup> It is designed to support development in rural areas where such products are produced. What is more, GI creates interest in products among consumers, who very often make purchases relying on the guarantee of quality which is confirmed by geographical origin.<sup>17</sup> Traceability plays a crucial role in certifications and control processes in GI. Today, consumers, the final link in supply chains, want to have complete information about the products they purchase, and they will pay higher prices for goods for which they can trace production stages and be sure of product origins. There is no better sales promotion than full information on product origin, ingredients or what it is made of. Thus, with GI products, traceability is not only linked to safety, it also provides producers with new tools to promote the authenticity of products, their origins and is additional protection against counterfeit products.<sup>18</sup>

There are two main models of traceability systems. Manual systems based on paper documents are used in companies or by producers where the number of documents is limited. The second model is computerised systems.<sup>19</sup> The first type can include documents affixed to a product, e.g. labels. There is no doubt that computerised models of traceability are easier to manage as they reduce paper storage requirements and reaction times to create data reports.<sup>20</sup>

The computerised traceability model, which is simply a data recording system, can be based on barcodes, QR-codes and radio frequency identification (RFID), which are usually tags for items, boxes or pallets.<sup>21</sup> However, the risks of data tampering,

<sup>13</sup> S. Bashir, *The Potential Geographical Indications in Pakistan*, "Journal of Social Sciences Review" January 2023, p. 335.

<sup>14</sup> [https://policy.trade.ec.europa.eu/enforcement-and-protection/protecting-eu-creations-inventions-and-designs/geographical-indications\\_en](https://policy.trade.ec.europa.eu/enforcement-and-protection/protecting-eu-creations-inventions-and-designs/geographical-indications_en) [accessed: 2023.10.17].

<sup>15</sup> S. Bashir, *The Potential Geographical Indications...*, p. 335.

<sup>16</sup> The examples of GI are: Truskawka kaszubska/kaszëbskô malëna (Kashubian strawberry – Poland), Scotch whisky (United Kingdom), Champagne (France), Parmigiano Reggiano (Italy), Banana de Corupá (Brazil), Chanderi sari (India).

<sup>17</sup> I. Barańczyk, *Ochrona prawna oznaczeń geograficznych*, Warszawa 2008, p. 15.

<sup>18</sup> O.-V. Zisis, *Do PDO and PGI Foodstuffs have value added to stakeholders?*, 2014, p. 45, <https://edepot.wur.nl/312731> [accessed: 2023.10.17].

<sup>19</sup> <https://www.gov.mb.ca/agriculture/animal-health-and-welfare/traceability/food-processing/print,index.html> [accessed: 2023.10.17].

<sup>20</sup> [https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwj5s\\_722v2BAxUc2wIHRTGD5UQFnQECDEQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod\\_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usg=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449](https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=&ved=2ahUKEwj5s_722v2BAxUc2wIHRTGD5UQFnQECDEQAQ&url=https%3A%2F%2Ftraining.colead.link%2Fpluginfile.php%2F4150%2Fmod_data%2Fcontent%2F30371%2Fcoleac001-pip-module-2-uk-pp.pdf&usg=AOvVaw2eRQ4jYNvxHtsUN0oVAn9x&opi=89978449) [accessed: 2023.10.17].

<sup>21</sup> <https://www.uc.edu/content/dam/uc/ce/docs/OLLI/Page%20Content/PRODUCT%20IDENTIFICATION%20CODES%20BAR%20QR.pdf> [accessed: 2023.10.17].

transparency and information disclosure are rife in traditional traceability systems.<sup>22</sup> This indicates that traceability systems can only be fully effective when they are it based on modern IP technologies,<sup>23</sup> of which blockchain is certainly one.

## 2. Using blockchain in the traceability of geographical indication products

Blockchain is a nearly ideal instrument to record and secure data exchanges because it is immutable.<sup>24</sup> Its data structure is designed to support applications of distributed digital ledgers where data are stored safely in chained blocks.<sup>25</sup> It facilitates storing data in chronological order, and there is no possibility of manipulating it afterwards.<sup>26</sup> Finally, blockchain is used as a instrument to tamper-proof large amounts of data generated by traceability systems.<sup>27</sup> It creates information trails while also ensuring security and data immutability.<sup>28</sup> All of these aspects make blockchain an instrument that allows greater confidence about the product provenance, authenticity and quality. Since GI is primarily based on the values of provenance, authenticity and quality, blockchain is a natural match for this.<sup>29</sup> Blockchain has already been used successfully in traceability systems for GI products, and examples include providers of Yangcheng Lake hairy crab who have cooperated with the Jingdong quality traceability anti-counterfeiting alliance and the Jingdong blockchain anti-counterfeiting traceability platform. Chinese Gannan navel oranges have also been given a unique anti-counterfeiting label through the use of blockchain.<sup>30</sup>

<sup>22</sup> <https://temera.it/en/applications/sourcing-traceability.html> [accessed: 2023.10.17].

<sup>23</sup> [http://briansoft.home.pl/autoinstalator/wordpress/?page\\_id=2414&lang=en](http://briansoft.home.pl/autoinstalator/wordpress/?page_id=2414&lang=en) [accessed: 2023.10.15].

<sup>24</sup> S. Krma, T. Hedberg, A. B. Feeney, *Securing the digital threat for smart manufacturing: A reference model for blockchain-based product data traceability*, US Department of Commerce, 2019, p. 8, [https://tsapps.nist.gov/publication/get\\_pdf.cfm?pub\\_id=926019](https://tsapps.nist.gov/publication/get_pdf.cfm?pub_id=926019) [accessed: 2023.10.17].

<sup>25</sup> B.B. Zarpelão, S.B. Junior, A.T. Badaró, D.F. Barbin, *Food Authentication Traceability*, New York 2021. On the use of blockchain for agrifood traceability in: T. Bosona, G. Gebresenbet, *The Role of Blockchain Technology in Promoting Traceability Systems in Agri-Food Production and Supply Chains*, Sensors (Basel), 2023, <https://www.ncbi.nlm.nih.gov/pmc/articles/PMC10255992/#B17-sensors-23-05342> [accessed: 2023.10.17].

<sup>26</sup> J.F. Galvez, J. Mejuto, J. Simal-Gandara, *Future challenges on the use of blockchain for food traceability analysis*, "TrAC Trends in Analytical Chemistry" October 2018, vol. 107, p. 222.

<sup>27</sup> R. Schuitemaker, X. Xu, *Product...*, p. 704.

<sup>28</sup> T.K. Agrawal, V. Kumar, R. Pal, L. Wang, Y. Chen, *Blockchain-based framework for supply chain traceability. A case example of textile and clothing industry*, "Computers and Industrial Engineering" April 2021, vol. 154, p. 1.

<sup>29</sup> S. Aronzon, *Blockchain and geographical indications: A natural fit?*, King's College London Law School Graduate Student Research Paper No. 2018/19-02, 2020, p. 2.

<sup>30</sup> S. Zhang, B. Du, *Tracing or not: How can the supplier of geographical indication products benefit from different traceability strategies?*, "Computers and Industrial Engineering" October 2023, vol. 184, <https://www.sciencedirect.com/science/article/abs/pii/S0360835223005405> [accessed: 2023.10.17].

The production of regional agricultural products generates a lot of data pertaining to production cycles and planting and information about soils, temperatures, humidity levels, storage, transport and purchase. Full-process data about production steps ensure the authenticity of GI agricultural products, and, by using blockchain technology, this information pertaining to all of the steps is recorded permanently and cannot be tampered with. If problems occur, for example with the quality or safety of products, it is easy to pinpoint the origin of the problems through the traceability information chain.<sup>31</sup>

## Conclusions

In summation, blockchain can be used to create nearly perfect traceability models for GI products. Of course, companies that implement such product traceability systems will incur substantial costs;<sup>32</sup> however, efficient traceability systems are worth it. Using blockchain technology can provide reliable traceability systems that reduce the generation of invalid information,<sup>33</sup> which is incredibly important when it comes to GI products. Consumers who purchase GI products want guarantees that they are getting genuine, and not counterfeit, products of the best quality that have properties provided by the producer, and, what is most important, originate from regions in which they must be produced. These properties and product quality can be verified through traceability systems and using blockchain technology is the only way to ensure that traceability systems are fully efficient.

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## Summary

*Joanna Marszałek*

### Blockchain and Traceability of Geographical Indication Products

Traceability plays a significant role in food supply chains by ensuring food safety through piloting risks and quality. It helps to ensure that all production steps meet specification and quality requirements. It is also a very important tool for geographical indication products as it proves the authenticity of products, indicates their origin and, consequently, prevents counterfeiting. The system must be efficient and have anti-tampering features. Using blockchain technology can render these systems nearly perfect.

**Keywords:** geographical indication, traceability system, food safety, blockchain, new technology.

## Streszczenie

*Joanna Marszałek*

### Blockchain i system identyfikowalności produktów chronionych oznaczeniami geograficznymi

System identyfikowalności produktów odgrywa znaczącą rolę w łańcuchu dostaw żywności, zapewniając bezpieczeństwo poprzez monitorowanie ryzyka i jakości żywności. System ten jest

gwarancją, że wszystkie etapy spełniają wymagania co do specyfikacji i jakości produktów. Identyfikowalność produktów ma również duże znaczenie dla produktów chronionych oznaczeniem geograficznym, gdyż potwierdza autentyczność tych produktów, wskazuje na ich pochodzenie, a co za tym idzie, zapobiega ich podrabianiu. Jednak system ten musi być wydajny i posiadać odpowiednie zabezpieczenia. Korzystanie z technologii blockchain w systemie identyfikowalności produktów może sprawić, że systemy te będą niemalże doskonałe.

**Słowa kluczowe:** oznaczenia geograficzne, system identyfikowalności produktów, bezpieczeństwo żywności, blockchain, nowe technologie.



**Llanos Cabedo Serna**

University of Alicante, Spain

llanos.cabedo@ua.es

ORCID: 0000-0001-7272-2131

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## **Cultural Dissemination and Commercial Exploitation of Images of Architectural and Art Works: “Freedom of Panorama” under Scrutiny**

### **Introduction**

Notably, art. 5.3(h) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society (Directive) provides that Member States may establish exceptions or limitations to authors’ rights of reproduction and communication to the public in the case of “use of works, such as works of architecture or sculpture, made to be permanently located in public places.” This exception is known as “freedom of panorama,” and originates from the German term *panoramafreiheit*, a concept that was created in Germany.<sup>1</sup> All European Union (EU) Member States implemented this exception to their national regulations and it permits photographing or videotaping (acts of reproduction) and then sharing the works on the Internet (act of public communication or making available) of images of buildings, bridges, sculptures, murals and any other art work protected by copyright that is permanently located in public space.

The impact of the freedom of panorama is enormous for consumers (or citizens in general), companies and professionals. This exception affects millions of people since the activities of reproducing and sharing images of works of architecture or art exhibited in public places on the Internet (especially on social networks) are the order of the day and currently constitute a socially accepted form of disseminating culture. The exception also has a significant economic impact as many companies and professionals in the cultural sectors benefit from it, such as publishers, advertising agencies, newspapers, photographers and digital platforms (among others), as do companies engaged in merchandising works of architecture and fine art.

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<sup>1</sup> P. Popova, *Report on the freedom of panorama in Europe*, August 2016, <https://perma.cc/6V5N-UYRA> [accessed: 2023.09.03]; S. González-Varas Ibáñez, L. Rivera Novillo, *Intellectual property protection in Spanish law: architectural work and freedom of panorama*, “Journal of Privacy and Digital Law” 2017, vol. 2, no. 8, pp. 81–107.

Despite the relevance that this exception has in the social and economic sphere, it has received limited attention from specialized legal doctrine and the Court of Justice of the European Union (CJEU) has not examined it. Hence, it merits a more in-depth legal examination, both at EU and national levels. The greatest problem with this exception is its lack of harmonization at the EU level. Even though all Member States have implemented the exception into their national copyright laws, these laws differ from one another. This article has three main objectives regarding this issue. First, to analyze the reasons for the differences among national laws; second, to highlight discrepancies between them and the Directive; and third, to propose changes to achieve legal harmonization. This is necessary to safeguard the legal security of consumers and professionals with regard to the use of images of architecture and artworks and to achieve the proper functioning of the single internal market, in particular the digital single market, which is a cross-border space.

According to the European Commission (EC), which was particularly interested in the freedom of panorama exception in the preparatory phase of Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the digital single market (Directive 2019/790), which has already implemented in Spain, the reasons that explain the aforementioned lack of harmonization include the optional nature of the exception and its current wording in the Directive.

In view of the above, this article analyses both reasons to determine whether they are so important that harmonisation is still not being achieved as a result (first objective). To address this, various national regulations will be examined, particularly from Spanish legal regulations. The analysis of the issues raised allows us to conclude whether it is necessary for the exception to become mandatory and whether or not a revision of its current regulation in the Directive should be conducted to achieve the highest possible degree of harmonization, thus solving the legal and economic problems that the current disparity among national legislations generates (third objective).

## 1. The optional nature of the exception

Currently, most of the copyright exceptions provided for in the Directive, in particular the freedom of panorama, are optional in nature, so that whether or not to implement them in national legislation is at the discretion of the Member States. Despite its optional nature, at present all Member States recognize the exemption in their national legislation. Some regulated it prior to the approval of the Directive, as is the case of Spain, which introduced this exception in the Intellectual Property Law (LPI) of 11 November 1987, and currently regulates it in art. 35.2 of Royal Legislative Decree 1/1996, of 12 April 1996.<sup>2</sup> Thus, it regulates, clarifies and harmonizes the legal provisions in force

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<sup>2</sup> Real Decreto Legislativo 1/1996, de 12 de abril, por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia; <https://www.boe.es/buscar/act.php?id=BOE-A-1996-8930> [accessed: 2023.09.03].

on the subject and provides that “works permanently located in parks, streets, squares or other public places may be freely reproduced, distributed and communicated in the form of paintings, drawings, photographs and audio-visual works.”<sup>3</sup> The exception was born at the community level in order to protect national legislations that already had it in place for some time.<sup>4</sup> In fact, the exception already in effect was confirmed, although it should be noted that it is understood differently in Member States, and these issues also arise when these works are presented in digital spaces.

Other countries have been slower to recognize the freedom of panorama in their legislation, as in Italy, Belgium and France. The latter two recognized this in 2016 by reforming the *Code de Droit Économique* and the *Code de la Propriété Intellectuelle*. In Italy, freedom of panorama is recognized not in copyright legislation but in the *Codice dei beni culturali e del paesaggio*.<sup>5</sup> By virtue of this reform, a new paragraph 3bis was added to art. 108 of the *Codice* according to which the reproduction and free disclosure of images of cultural property (including sculptures and works of architecture) is allowed, provided that they are made without profit and for the purpose of study, research, free manifestation of thought or creative expression or promotion of cultural heritage. The optional nature of the exception entails minimal regulation, and this situation has led Member States to implement the exception with a margin of discretion that they actually seem to find deficient. As a result, this has led to legal inequalities, some very significant, among these provisions.

This gradual and uneven implementation of the exception fully affects the use of images permitted by it, as neither consumers nor companies can be sure whether or not their activity is legal (i.e., whether it falls under the exception). This situation of legal uncertainty is exacerbated by the fact that images are available on the Internet and that most uses are cross-border, so what is legal in one country may not be legal in another.

For citizens in general, the situation described above arises from the legal and jurisprudential differences as to which works are covered by the exemption and from the concepts of public place and permanence of works. Thus, users who do not make commercial use of the images cannot know in advance whether the work they photograph or videotape is covered by the exception and, if not, whether it is still protected by copyright. It seems unreasonable that they should be required to investigate this as, among other reasons, this requirement sits poorly with the speed and immediacy of the Internet. As Cedric Manara<sup>6</sup> points out, transaction costs are obviously exaggerated in view of the triviality of the act of photographing works, and

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<sup>3</sup> The translation is mine.

<sup>4</sup> S. Von Lewinski, *Article 5. Exceptions and limitations* [in:] *European Copyright Law. A commentary*, eds. M.M. Walter, S. Von Lewinski, Oxford 2013, pp. 1013–1062.

<sup>5</sup> Legislative Decree No. 42 of 22 January 2004, as amended by Decree Law No. 83 of 31 May 2014, then converted into Law No. 106 of 29 July 2014.

<sup>6</sup> C. Manara, *La nouvelle “exception de panorama”*. *Gros plan sur l’Article L. 122-5 10 du Code français de la propriété intellectuelle*, “Revue Lamy Droit de l’Immatériel” 2016, n° 4049, pp. 40–43, <https://ssrn.com/abstract=2828355> [accessed: 2023.09.02].

rights holders have never taken action against citizens who carry out non-commercial uses of photographs or videos without authorization, as they know that this is a losing battle. For commercial or professional uses, legal uncertainty is even greater than that described above, since not all Member States recognize the panorama exception to the same extent, and some do not allow commercial uses of images or, if they do, require the use of the work to be ancillary.

The situation described above is explained by the optional nature of the freedom of panorama exception, which prevents true harmonization.<sup>7</sup> In contrast, opting for the exception being mandatory would put an end to the unlawfulness of uses by millions of consumers in the EU, as they would be automatically covered by the exception, thus preventing the commission of unlawful acts en masse.<sup>8</sup> Were the exception to be compulsory, this would solve problems arising from the territoriality of copyright law, as it would achieve full harmonization, thus avoiding fragmentation of the single internal market and ensuring legal certainty for all involved.<sup>9</sup> It should be noted that objections to the optional nature of the exception ceased to make sense from 2014 to 2016, when states that had not previously regulated it started to do so. It is argued that if the panorama exception were mandatory this would help to resolve legislative inequalities because Member States would be obliged to introduce the exception in their national legislation in accordance with the provisions of the Community regulation, which would neutralize the possibility of different national legislative texts.

In line with this statement, we also believe that the fact that the panorama exception was designed as optional does not justify that the national transposition deviates from the text of the Directive. Recital 32 requires Member States to consistently apply exceptions and limitations provided therein, so the conditions of application of the panorama exception in all Member States should meet this objective of consistency, without the Directive allowing Member States to alter the scope of the exceptions they decide to import into their national legislations,<sup>10</sup> so the regulations should be the same in all Member States or, at least, the disparities should be minimal.

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<sup>7</sup> See: S. Bechtold, *Article 5 DDASI* [in:] *Concise European Copyright Law*, eds. T. Dreier, P.B. Hugenholtz, The Netherlands 2006, pp. 367–382; C. Geiger, F. Schönher, *The Information Society Directive (articles 5 and 6(4))* [in:] *EU Copyright Law. A commentary*, eds. I Stamatoudi, P. Torremans, Cheltenham, UK–Northampton, USA 2014, pp. 395–484.

<sup>8</sup> European Copyright Society (ECS), *Answer to the EC Consultation on the “panorama exception,”* 2016, <https://europeancopyrightsociety.org/wp-content/uploads/2016/06/ecs-answer-to-ec-consultation-freedom-of-panorama-june16.pdf> [accessed: 2023.09.02].

<sup>9</sup> L. Montagnani, *The EU Consultation on ancillary rights for publishers and the panorama exception: Modernising Copyright through a “one step forward and two steps back” approach*, Kluwer Copyright Blog, 20.09.2016, <http://copyrightblog.kluweriplaw.com/2016/09/20/the-eu-consultation-on-ancillary-rights-for-publishers-and-the-panorama-exception-modernising-copyright-through-a-one-step-forward-and-two-steps-back-approach/> [accessed: 2023.09.02].

<sup>10</sup> E. Rosati, *Non-Commercial Quotation and Freedom of Panorama: Useful and Lawful*, “JI-PIPEC. Journal of Intellectual Property, Information Technology and Electronic Commerce Law” 2017, n° 8, pp. 311–321, <https://www.jipitec.eu/issues/jipitec-8-4-2017/4639/?searchterm=Rosati> [accessed: 2023.09.02].

The question of the nature of the exception has also been raised by EU legislative bodies. The European Parliament (EP), in its Motion for a Resolution on the implementation of the Directive of 15 January 2015, postulated in favor of a mandatory and broad panorama exception, a position it eventually abandoned, so that in the final Resolution of 9 July 2015 it limited itself to “urge the Commission to examine the application of minimum standards in exceptions and limitations, to ensure the correct application of the exceptions and limitations provided for in Directive 2001/29/EC and equal access to cultural diversity across borders within the internal market and to increase legal certainty” (paragraph 38). The EC, for its part, went so far as to state that the panorama exception is one of the key exceptions for copyright and found that the optional nature of the exception and the lack of a sufficient definition in the Directive led to uneven implementation and varying scope, causing distortions in the digital single market.<sup>11</sup> In order to take a position on the possible revision of the exception, the EC promoted a public consultation, held from 23 March to 15 June 2016, among rightholders and addressees of the exception.<sup>12</sup> The conclusion is that there are two clearly differentiated groups regarding the mandatory nature of the exception and the inclusion of commercial uses, as it could not be otherwise.<sup>13</sup> On the one hand, the authors most directly affected by the exception (visual artists and architects) and their collective management entities were against a mandatory exception of broad scope since this would have meant giving up their exclusive rights and the income that licenses of use could have earned them. Moreover, the Directive does not provide for any economic compensation for the recognition of the exception. Groups that would benefit by the exception at individual, institutional and professional levels were clearly in favor of a broad mandatory exception that would cover such persons and groups that were already using such images thus permitting them to avoid the legal uncertainty that the current situation placed them in. Finally, despite affirming the relevance of the exception<sup>14</sup> and the favorable position of other European bodies, such as the Economic and Social Committee,<sup>15</sup> the EC decided not to review the regulation of the panorama exception.

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<sup>11</sup> Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions (2015). Towards a modern and more European copyright framework. COM(2015) 626 final.

<sup>12</sup> See: Public consultation on the role of publishers in the copyright value chain and on the “panorama exception.” The questionnaire and report analyzing the results are available at <https://ec.europa.eu/digital-single-market/en/news/public-consultation-role-publishers-copyright-value-chain-and-panorama-exception>) [accessed: 2023.09.02].

<sup>13</sup> Ll. Cabedo Serna, *Freedom of panorama in the European Union copyright revision strategy: A missed opportunity?*, “Pe.i.: Revista de Propiedad Intelectual” 2019, nº 63, pp. 65–106.

<sup>14</sup> Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions (2016). Promoting a fair, efficient and competitive European copyright-based economy in the digital single market, COM (2016) 592 final.

<sup>15</sup> Opinion of the European Economic and Social Committee on the Proposal for a Directive of the European Parliament and of the Council on copyright in the digital single market (2017). Official Journal of the European Union C 125/27.

However, this does not mean that the EC is against the mandatory nature of exceptions, such as those for orphan and visually impaired works (art. 6 of Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works and art. 3 of Directive (EU) 2017/1564 of the European Parliament and of the Council of 13 September 2017 on certain permitted uses of certain works and other subject-matter protected by copyright and related rights for the benefit of persons who are blind, visually impaired or otherwise print disabled) and those adopted in Directive 2019/790, which are all mandatory. Therefore, it cannot be ruled out that, in the future, the exceptions provided for in the Directive on an optional basis will also become mandatory, including the panorama exception.

We may conclude, with regard to the optional nature of the exception, that the Member States are not entitled to determine the conditions for the application of the exceptions if this leads to a lack of harmonization, even if the exceptions are optional. Therefore, the national differences should not be attributed to the optional nature of the exception, but to an incorrect transposition of the exception by the states, which have acted with a margin of freedom that they do not really have, as we shall see in detail in the following section. On the other hand, the EC also raised the need for a better or more detailed definition of the exception at the Community level as a means to achieve greater harmonization.

## 2. Problems arising from the current regulation

The regulation of the freedom of panorama in the Directive responds to a broad or open formula in all aspects and requirements of its application. Article 5.3(h) provides for an exception to the rights of reproduction and communication to the public “when works, such as works of architecture or sculpture, made to be permanently located in public places, are used.” This broad formulation was chosen to respect national regulations already existing at the time of the entry into force of the Directive, since, according to its Recital 32, “The list [of art. 5] takes due account of the different legal traditions of the Member States.”

Thus, the EC understands that the existing legal inequalities are due precisely to this broad formulation. In my opinion, although the lack of specificity in the Community regulation may have led to the existence of national differences, the reason for them lies in the incorrect transposition of Community legislation, which is manifested, above all, in national regulations that are more restrictive than the Community regulation. The optional nature of the exception allows Member States not to incorporate it into their legal systems, as we already know, but the exceptions provided for in the Directive are either accepted or rejected and, in the first case, they cannot be restricted<sup>16</sup> for reasons already explained. On the other hand, the panorama exception is closely

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<sup>16</sup> R. Casas Vallés, *Comentario al artículo 40bis* [in:] *Comentarios a la Ley de Propiedad Intelectual*, ed. R. Bercovitz Rodríguez-Cano, Madrid 2017, pp. 791–836.

linked to freedom of expression,<sup>17</sup> which is enshrined in art. 11 of the EU Charter of Fundamental Rights and art. 10 of the Convention for the Protection of Human Rights and Fundamental Freedoms. Precisely, the CJEU points out in the Painer and Deckmyn cases that the exceptions directly justified by freedom of expression (such as quotation and parody) must be subject to broad interpretation to ensure compliance with the above-mentioned international texts. Therefore, when national legislations regulate the exception in a more restrictive manner than the Directive, it can be said that they are acting incorrectly.

Although Member States may not transpose a provision that restricts the scope of application of the exception with respect to any of the requirements set forth in art. 5.3(h) of the Directive, it is possible, for them to establish conditions whose function is to delimit more precisely the scope of application of the exception, provided that they serve the purpose and aim of the exception, as we will see below.

## 2.1. The object of the exception

First, art. 5.3(h) does not establish a closed list of works, but opts for a merely exemplary enumeration (“works, such as works of architecture or sculpture”),<sup>18</sup> Thus, art. 5.3(h) does not preclude national legislation from extending the exception to other categories of works<sup>19</sup> such as murals or graffiti.<sup>20</sup> On the contrary, one could conclude that such legislation cannot limit, *ab initio*, the types of works to those expressly listed in the community legislation and, if they did so, they would be restricting the community rule in an unjustified manner. This would be, for example, the case of France, which limits the applicability of the exception to works of sculpture and architecture,<sup>21</sup> but excludes frescoes, paintings and street art.<sup>22</sup>

Second, art. 5.3(h) does not refer to the means of reproduction or public communication, from which it is inferred, given its broad formulation, that the rule includes, in principle, all possible means of dissemination.<sup>23</sup> Spain has chosen to list the means of reproduction (“paintings, drawings, photographs and audiovisual procedures”). However, even if it is a closed enumeration, it cannot be considered

<sup>17</sup> European Copyright Society (ECS), *Answer to the EC Consultation...*; C. Geiger, F. Schönherr, *The Information Society...*, pp. 395–484.

<sup>18</sup> C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43.

<sup>19</sup> J. López Richart, *And vandalism became Art: The protection of graffiti by copyright law*, “RIIPAC. Revista sobre Patrimonio Cultural: Regulación, Propiedad Intelectual e Industrial” 2018, nº 10, pp. 53–87, <http://www.eumed.net/rev/riipac/10/grafiti.pdf> [accessed: 2023.09.02].

<sup>20</sup> S. Von Lewinski, *Article 5...*, pp. 1013–1062.

<sup>21</sup> C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43; E. Rosati, *Non-Commercial Quotation...*, pp. 311–321.

<sup>22</sup> C. Caron, *Exception de panorama: lorsque la montagne accouche d’une souris*, “La Semaine Juridique” February 2016, pp. 261–262.

<sup>23</sup> I. Hernando Collazos, *The panorama exception and the commercial use of secondary manifestations of works of art. Approach from the Spanish Copyright Law*, “RIIPAC. Revista sobre Patrimonio Cultural: Regulación, Propiedad Intelectual e Industrial” 2018, nº 10, pp. 1–52, <http://www.eumed.net/rev/riipac/10/obras-arte.pdf> [accessed: 2023.09.02].



restrictive due to the breadth of the means listed, which allows includes digital technology.<sup>24</sup> This is why it can be concluded that Spanish legislation is in line with the Community legislation on this point.

### 3. Permitted uses of images

The freedom of panorama exception does not contain any limitation with respect to commercial uses, nor does it impose or allow Member States to introduce such a limitation.<sup>25</sup> It might be assumed, then, that the exception covers all kinds of uses and all kinds of persons, both natural and legal, albeit with the limit imposed by the three-step rule, to which I will refer later.

However, there are countries that do not allow commercial uses of images of works covered by the exception, such as Bulgaria, Estonia, France, Italy, Latvia, Lithuania, Romania, and Slovenia. In Denmark and Finland, reproduction and public communication of buildings for commercial uses are allowed, but, for works of art, they are not allowed if the work is the main object of the image.<sup>26</sup> In Spain, commercial uses are permitted<sup>27</sup> as follows reasons: the adverb “freely” is used in art. 35.2 Real Decreto Legislativo 1/1996, de 12 de abril, por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia (TRLPI) in reference to the exercise of the rights of reproduction, distribution and public communication; no restriction of uses by individuals or for the private purposes of the person performing the reproduction; and no exigency regarding the absence of any lucrative purpose in the article.<sup>28</sup> In addition, the usage can be both private and collective. Moreover, the inclusion of the exclusive right of distribution in art. 35.2, as permitted by art. 5.4 of the Directive (“Where Member States may provide for exceptions or limitations to the right of reproduction under paragraphs 2 and 3, they may also provide for exceptions or limitations to the right of distribution provided for in art. 4, on condition that this is justified by the purpose of the authorized act of reproduction”). Distribution is a right that covers purely commercial acts, and it can therefore be inferred that art. 35.2 includes uses of this nature within its scope of application. It can be concluded that national legislations that have restricted the panorama exception to uses of works of

<sup>24</sup> B. Ribera Blanes, *El derecho de reproducción en la propiedad intelectual*, Madrid 2002; S. López Maza, *Comentario al artículo 35* [in:] *Comentarios a la Ley de Propiedad Intelectual...*, pp. 791–836.

<sup>25</sup> E. Rosati, *Non-Commercial Quotation...*, pp. 311–321.

<sup>26</sup> P. Popova, *Report...*

<sup>27</sup> B. Ribera Blanes, *El derecho de reproducción...*; R. Casas Valles, E. Soria Puig, *Graffiti, urban art and copyright* [in:] *Anuario Iberoamericano de Derecho del Arte*, ed. R. Sánchez Arísti, Navarra 2020, pp. 39–134.

<sup>28</sup> S. López Maza, *Comentario al artículo 35...*, pp. 791–836.



an accessory and/or non-commercial nature have not acted correctly,<sup>29</sup> as has been affirmed particularly in France.<sup>30</sup>

On the other hand, limiting the exception to non-commercial uses imposed by certain Member States to protect the owners of the exclusive rights of the works covered by it does not present advantages from a practical point of view because, at present, the doctrine of the CJEU on the concept of profit or commercial activity is not consolidated, so that the ambiguous distinction between non-commercial and commercial uses generates legal uncertainty. Thus, an exception that also covers commercial uses may provide greater legal certainty and allow a reduction in transaction costs.<sup>31</sup>

#### 4. The permanence of works in public places

Article 5.3(h) refers to works “made to be permanently located in public places.” The provision therefore requires that the works have been created for this purpose.<sup>32</sup> Is it possible for Member States to dispense with this requirement? In my opinion, yes, because by allowing the exception to include works permanently placed in public places regardless of whether they have been created for that purpose, the scope of the exception is not restricted. In fact, almost all national legislations dispense with it and simply refer to works permanently placed in public places,<sup>33</sup> except Lithuania, Malta and Portugal, which do require it. As far as Spain is concerned, the rule does not require this purpose (“permanently located works”), so it has a broader scope of application than the Community rule, including both works created to be located in public space and those that simply are in it, regardless of the initial purpose.<sup>34</sup>

Another related question concerns who is attributed such intention: only the author or also any other rights holders, such as the owner of the work? It has to be pointed out that, it is most likely to be understood that the author’s consent must be obtained when the work is placed in a public place for which it was not intended, insofar as the change of location may affect the moral right of the integrity of the work (art. 14.4 TRLPI).<sup>35</sup> On the other hand, it should also be borne in mind, in the case of the alienation of a plastic work, that the author, even having assigned the right of public exhibition to the acquirer, may oppose the exercise of this right “when the

<sup>29</sup> European Copyright Society (ECS), *Answer to the EC Consultation...*; E. Rosati, *Non-Commercial Quotation...*, pp. 311–321.

<sup>30</sup> C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43; L. Montagnani, *The EU Consultation...*

<sup>31</sup> C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43; E. Rosati, *Non-Commercial Quotation...*, pp. 311–321; J. López Richart, *And vandalism became Art...*, pp. 53–87.

<sup>32</sup> S. Bechtold, *Article 5 DDASI...*, pp. 367–382.

<sup>33</sup> P. Popova, *Report...*

<sup>34</sup> S. López Maza, *Comentario al artículo 35...*, pp. 791–836; I. Hernando Collazos, *The panorama exception...*, pp. 1–52.

<sup>35</sup> R. Casas Valles, E. Soria Puig, *Graffiti, urban art and copyright...*, pp. 39–134.

exhibition is carried out in conditions that harm their honor or professional reputation" (art. 56.2 TRLPI).

In short, although the criterion of intentionality cannot be disregarded, as it is required by the Community rule, it must be interpreted in a broad sense for two reasons. Firstly, it is a requirement for the application of the rule that is difficult to comply with, since the addressees of the exception will not be able to know for certain or in all cases, using reasonable diligence, whether or not the work was actually created with the intention of being permanently exhibited in a public place. Secondly, such a requirement would greatly limit the applicability of the exception, to the detriment of the purpose it pursues (facilitating the dissemination of works). Therefore, we understand that, although the element of intentionality must be taken into account, it does not necessarily have to exist at the time of creation of the work, as it can be supervening, nor must it necessarily be the intention of the author, as any rights holder of the work may have decided to place it outside provided that the moral right of the author to the integrity of their work or the right of opposition provided for in art. 56.2 TRLPI is respected.

Having stated the above, there is no consensus on the meaning of "permanence." While it is accepted that permanence is defined in terms of a specific period of time, there are authors who argue that the exception only includes works whose placement in a certain public place is indefinite.<sup>36</sup> On the contrary, other authors consider that the exception also refers to works that are going to be part of the urban space or landscape for a limited space of time, either because of the context in which they are exhibited or because of the perishability of the materials with which they were created.<sup>37</sup> Thus, while the former exclude those works that are part of a temporary or traveling exhibition or have been made with perishable materials (such as ice or sand statues),<sup>38</sup> the latter include them in the exception.<sup>39</sup> An issue that is discussed frequently focuses on works that are conceived as accessory to permanent elements, usually buildings (installations or artistic interventions). Their inclusion is defended on the basis of their accessory nature with respect to the main element they adorn, which is permanent.<sup>40</sup> With regard to this, the judgment of 22 January 2002 (BGH, I ZR 102/99 (KG)-Verhüllter Reichstag) of the German Federal Supreme Court (BGH) on the applicability of the freedom of panorama in the case of a temporary art installation by the artists Christo and Jeanne-Claude in the German *Reichstag* is particularly

<sup>36</sup> J.A. Cuerva de Cañas, L. Castellví Laukamp, *Arquitectura de autor: un análisis de ciertos problemas suscitados en torno a la obra arquitectónica y la propiedad intelectual*, "Pe.i.: Revista de Propiedad Intelectual" 2010, n° 36, pp. 13–86, <https://www.pei-revista.com/numerospublicados/numero-36/arquitectura-de-autor-detail> [accessed: 2023.09.02]; C. Manara, *La nouvelle "exception de panorama"...*, pp. 40–43; S. Von Lewinski, *Article 5...*, pp. 1013–1062.

<sup>37</sup> J. López Richart, *And vandalism became Art...*, pp. 53–87; S. Von Lewinski, *Article 5...*, pp. 1013–1062; I. Hernando Collazos, *The panorama exception...*, pp. 1–52.

<sup>38</sup> J.A. Cuerva de Cañas, L. Castellví Laukamp, *Arquitectura de autor...*, pp. 13–86.

<sup>39</sup> S. López Maza, *Comentario al artículo 35...*, pp. 791–836; J. López Richart, *And vandalism became Art...*, pp. 53–87.

<sup>40</sup> C. Manara, *La nouvelle "exception de panorama"...*, pp. 40–43.

interesting. The two-week art installation, known as *Wrapped Reichstag*, consisted of wrapping the building with a silver fireproof fabric tied with blue propylene cords. The BGH ruled that the criterion to be taken into account should be the original intent as perceived by an impartial observer.<sup>41</sup> Based on this decision, the BGH ruled that the German panorama exception cannot apply to photographs of a temporary art installation, as the temporary nature of the installation clearly demonstrates that there is no intention for it to be permanently exhibited.

In my opinion, the placement of a work is permanent when the intention (whether or not existing at the time of creation of the work) of the author or the rights holder (the owner, for example) is that the work should be in a certain place indefinitely. What is permanent is opposed to what is temporary, ephemeral or sporadic, and it is not possible, from my point of view, to consider as permanent that situation which, by its very nature, cannot be indefinite but clearly limited in time. Thus, an exhibition that is conceived as temporary would not fall within the scope of the application of the exception. However, works made with perishable elements should be included if the intention of their author was that they should be permanently located in a public place since it is not the time of permanence that matters, but the intention that the work should remain exhibited for an indefinite period of time. There is no doubt that street art is included in the exception, since the intention of its author is permanence. A particular case is that of falla monuments (the Fallas of Valencia or the Hogueras of Alicante, for example). They are considered plastic works of a sculptural nature and are characterized by being ephemeral since they are created to be exhibited on public roads for a short time, after which they are burned. For this reason, falla monuments are made with materials that facilitate their destruction by fire. In the opinion of Espín Alba,<sup>42</sup> it is possible to consider these monuments works protected by the exception, separating the permanent character from the ephemeral nature of the work. In this way, the author considers that these works can be interpreted as having a permanent character during the period that elapses between their construction and their destruction by fire.

The exception to this rule is not applicable because, as we have already pointed out, it is necessary to take into account the intention of the author or rights holder, and it is not possible that the intention of the author or rights holder is that the works are permanently exposed on public roads during the period foreseen for their existence. In my opinion, this case would not fall within the scope of application of the exception because, as has already been pointed out, it is necessary to take into account the intention of the author or rights holder and it is not possible that the intention is that the falla monuments are to be exhibited indefinitely since they are created to

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<sup>41</sup> T. Nobre, *Freedom of Panorama in Portugal* [in:] *Best case scenarios for copyright. Freedom of panorama, parody, education and quotation*, eds. A. Giannopoulou, T. Nobre, A. Rammo, Warsaw 2016, [www.communia-association.org/bcs-copyright](http://www.communia-association.org/bcs-copyright) [accessed: 2023.09.02].

<sup>42</sup> I. Espín Alba, *Una aportación iusprivatista al estudio del patrimonio cultural inmaterial: la protección de las fallas valencianas por el derecho de autor*, "PIDCC. Revista em propriedade intelectual direito contemporâneo" 2017, vol. 11, nº 1, pp. 1–28.

be destroyed within a short period of time. What is more, I understand that this is different from works made from perishable materials since, in this case, the duration of the works is unknown and will depend on various factors (materials, climate, place of exhibition). It is true that this position affects, particularly, images disseminated on social networks since it places them in a situation of illegality, but, as already noted, it would be an irregular situation tolerated by the rights holders since it is impossible to prevent citizens from taking photographs and videos of the Fallas or the Hogueras and then posting them on the Internet.

## 5. The concept of public place

The concept of public place should be given a broad meaning.<sup>43</sup> This means that the question should not be resolved on the basis of ownership, so that, for the purposes of the rule, only publicly owned places are public. What makes a place public is that it is accessible to the general public, regardless of its public or private ownership.<sup>44</sup> Thus, streets, roads, paths, squares and other similar public spaces are public places. However, art. 5.3(h) does not refer only to public roads, but to any place, whether or not it is a place of transit, to which the general public has access. In other words, art. 5.3(h) includes the interiors of public places,<sup>45</sup> which is consistent with the broad interpretation advocated for the exception. It has to be pointed out that, if the legislator had wanted to limit the panorama exception to places located outdoors, they would have used expressions such as “public road” or something similar.<sup>46</sup>

Precisely, on the basis of this argument, it can be concluded that in Spain the panorama exception has been restricted as far as this requirement is concerned. Article 35.2 TRLPI closes the enumeration of locations with a reference to “other public roads,”<sup>47</sup> which means, according to the judgment of the Provincial Court of Madrid No. 195/2014, of 16 June 2014, that the locations listed in art. 35.2 TRLPI are connected to the concept of public road which is “the common concept that semantically suits all of them,” understanding by public road “a space of public domain characterized by its suitability for the transit of pedestrians and/or the circulation of vehicles.” Hence, Ribera Blanes<sup>48</sup> affirms that the legal provision would be more correctly contemplated

<sup>43</sup> S. Bechtold, *Article 5 DDASI...*, pp. 367–382.

<sup>44</sup> S. Von Lewinski, *Article 5...*, pp. 1013–1062; D. Muscillo, *The Italian, French, German and English legislation regarding Freedom of Panorama*, June 2019, [https://www.academia.edu/34380380/The\\_Italian\\_French\\_German\\_and\\_English\\_Legislation\\_concerning\\_Freedom\\_of\\_Panorama\\_pdf](https://www.academia.edu/34380380/The_Italian_French_German_and_English_Legislation_concerning_Freedom_of_Panorama_pdf) [accessed: 2023.09.02]; I. Hernando Collazos, *The panorama exception...*, pp. 1–52.

<sup>45</sup> T. Nobre, *Freedom of Panorama in Portugal...*

<sup>46</sup> *Ibid.*; S. Bechtold, *Article 5 DDASI...*, pp. 367–382.

<sup>47</sup> I. Hernando Collazos, *The panorama exception...*, pp. 1–52; J.A. Cuerva de Cañas, L. Castellví Laukamp, *Arquitectura de autor...*, pp. 13–86.

<sup>48</sup> B. Ribera Blanes, *El derecho de reproducción...*

if the terms “or other public roads” of the precept had been replaced by “or other public places.”

In the case of privately owned buildings, which are works of architecture, I believe that the exception only allows photographs and videos of façades, but not of interiors since it is not possible to take pictures of building interiors from the exterior. The exception is for the reproduction of the building façades, expressly excluding interiors (art. 59 of the German Copyright Act of 9 September 1965). Some countries, such as Germany, have established that the exception only covers the reproduction of the building façades, expressly excluding interiors (art. 59 of its Copyright Act of 9 September 1965). In Spain, the decision of the Provincial Court of Barcelona (Section 15) no. 147/2006, of 28 March 2006, stated that art. 35.2 does not include in its protection the interior of the building, which is, in this particular case, a religious temple, because it is not a public road.

Therefore, the exception would allow the reproduction of works of art located in museums and similar institutions as they are places open to the public. However, as a general rule, public or private institutions that exhibit works of art do not allow the reproduction of such works if they are located indoors. This prohibition may be justified by the need to protect the condition of the works, since constant exposure to light emanating from devices may damage them, especially in the case of paintings. However, it seems that the underlying reason would be the desire to monopolize the reproduction of the works exhibited since merchandising is one of the income sources of such institutions. From a copyright point of view, it does not seem that the prohibition is justified; on the contrary, the panorama exception, as regulated at the Community level, allows reproduction.

On the other hand, the exception also includes works that are visible from a public place.<sup>49</sup> Therefore, photographs of works in private gardens or of building façades that are not visible from the street but, for example, from a neighbor’s house, are subject to the requirement of prior authorization. In this regard, the BGH ruled that a photograph taken from a balcony is not covered by the exception because it was taken in a place that is not accessible to the public.<sup>50</sup> Furthermore, it is understood that photographs obtained using accessories such as ladders or helicopters do not fall under the exception; instead, it is disputed whether the use of telephoto lenses for cameras can be considered as an accessory in this sense.<sup>51</sup> In Spain, the doctrine reaches the same conclusion regarding art. 35.2.<sup>52</sup> The judgment of the Provincial Court of Madrid No. 195/2014 of 16 June 2014, states that art. 35.2 TRLPI requires that the work be located on the public highway or bordering it, so that the limit is not applicable if

<sup>49</sup> S. Von Lewinski, *Article 5...*, pp. 1013–1062; D. Muscillo, *The Italian, French...*; C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43.

<sup>50</sup> BGH, I ZR 192/00, Hundertwasserhaus, <https://dejure.org/dienste/vernetzung/rechtsprechung?Gericht=BGH&Datum=05.06.2003&Aktenzeichen=I%20ZR%20192%2F00> [accessed: 2023.09.02].

<sup>51</sup> D. Muscillo, *The Italian, French...*

<sup>52</sup> S. López Maza, *Comentario al artículo 35...*, pp. 791–836; J. López Richart, *And vandalism became Art...*, pp. 53–87; B. Ribera Blanes, *El derecho de reproducción...*

it is located in a private place (inside a property) and, to make a reproduction, it is necessary to use means or procedures “more or less convoluted” or to be located in “unpredictable places” (in this case, since the work was located on the edge of a cliff, it was necessary to make a reproduction of it from the air or the sea).

## 6. Freedom of expression and the three-step test

We will end this section by referring to the legal instruments that must be taken into account when delimiting the concepts that are merely stated in the Community precept. From my point of view, two of them should be present: the purpose of the exception, so that there is no room for an interpretation that impedes the development of the freedom of expression, as I have already pointed out, and the three-step test, so that no concept or presupposition can be interpreted in a way that breaches the limits imposed by it.<sup>53</sup> The three-step test is in art. 5.5 of the Directive and states that “The exceptions and limitations referred to in paragraphs 1, 2, 3 and 4 shall apply only in certain specific cases that do not conflict with a normal exploitation of the work or other subject-matter and do not unreasonably prejudice the legitimate interests of the rightholder.” By applying these mechanisms, national judges can conclude whether a particular use, especially a commercial use, should require the authorization of rights holders.

The three-step rule has been taken into account particularly in relation to commercial uses, concluding that only those that respect such a rule are covered by the panorama exception.<sup>54</sup> It is even understood that, regardless of whether the user pursues a commercial purpose, the rule must be applied when the use has an economic impact for the rights holder. In this sense, it is worth citing the judgment of 4 April 2016 of the Swedish Supreme Court that resolved a dispute between the collective management entity of visual artists in Sweden (BUS) and the Swedish division of Wikimedia, a non-profit organization that collected photographs of works of art located in the public space uploaded by its users to create a database that would make them available to the public without restrictions and for any type of purpose (the recipients were the general public, the tourism industry and educational centers).<sup>55</sup> According to the judgment, the rule must be interpreted in light of the three-step rule, which implies a restrictive interpretation of the exception. It considers, accordingly, that the use of photographs in a database freely accessible to the general public has no insignificant commercial significance, so that such value should be reserved to

<sup>53</sup> S. Bechtold, *Article 5 DDASI...*, pp. 367–382; S. Von Lewinski, *Article 5...*, pp. 1013–1062.

<sup>54</sup> E. Rosati, *Non-Commercial Quotation...*, pp. 311–321; C. Manara, *La nouvelle “exception de panorama”...*, pp. 40–43.

<sup>55</sup> S. González-Varas Ibáñez, L. Rivera Novillo, *Intellectual property...*, pp. 81–107; J. Norderyd, E. Jönsson, *Swedish Supreme Court issues decision regarding the freedom of panorama*, Kluwer Copyright Blog, 9.05.2016, <http://copyrightblog.kluweriplaw.com/2016/05/09/swedishsupreme-court-issues-decision-regarding-freedompanorama/> [accessed: 2023.09.02].

the author, regardless of whether the database operator has a commercial purpose. Moreover, it is a use that does not entail any equitable compensation for the author. The court concludes that the right to exploit works of art through the Internet by means of a database belongs to the author, so it is not included in the exception.

The problem, in my view, arises when it comes to knowing how far the application of the three-step test leads us. It is argued that the application of the test means excluding direct commercial exploitation (posters, T-shirts, mugs and merchandising products in general), as well as indirect exploitation (advertising campaigns, for example), what we are stating is that the rule does not allow commercial uses (or should not allow them, as the aforementioned authors point out).<sup>56</sup> Thus, the panorama exception has been configured in an excessively generous manner, and since it does not seem reasonable to allow third parties to profit from the work of others, the fact is that the Community rule does allow commercial uses, as stated above.

This raises the question of the actual relevance of the three-step test for commercial applications. This same rule is also applicable to establish whether the limit only allows two-dimensional or three-dimensional reproductions. The conclusion we must reach is that the latter cannot be admitted since it would be the realization of a replica of the work that would enter into direct competition with the normal exploitation of the work, harming the legitimate interests of the author.<sup>57</sup> In certain countries, such as Germany, Austria, the Czech Republic, Croatia, Slovenia and Lithuania, it is expressly prohibited to make reproductions in three dimensions. It is clear, then, that the use of the image of an architectural or plastic work to create objects for commercial purposes (such as key chains or decorative elements) consisting of a small-scale reproduction of the works in question is not allowed.

The three-step test must also be taken into account in relation to the question of fair compensation for the author, which art. 5.3(h) Directive DDASI does not provide for (this is not an exceptional situation since none of the exceptions provided for in art. 5.3 DDASI does so). Since art. 5.3(h) does not provide for it, national legislators are not obliged to recognize it, although there is no impediment to doing so. On the contrary, Recital 36 DDASI provides that "Member States may provide for fair compensation to rightsholders also when applying the optional provisions relating to exceptions or limitations that do not require such compensation." And the possibility to provide for such compensation may be considered as a consequence of the application of the three-step rule, especially in the case where the use of the work is commercial.<sup>58</sup> Therefore, when certain national legislations (such as those of Slovakia, Greece and Lithuania) expressly exclude the possibility for the author to obtain fair compensation,<sup>59</sup> they are establishing a restriction that is not required by the norm

<sup>56</sup> R. Casas Valles, E. Soria Puig, *Graffiti, urban art and copyright...*, pp. 39–134.

<sup>57</sup> *Ibid.*; S. López Maza, *Comentario al artículo 35...*, pp. 791–836; S. Von Lewinski, *Article 5...*, pp. 1013–1062.

<sup>58</sup> B. Ribera Blanes, *El derecho de reproducción...*; S. Bechtold, *Article 5 DDASI...*, pp. 367–382; S. Von Lewinski, *Article 5...*, pp. 1013–1062.

<sup>59</sup> P. Popova, *Report...*



and can be considered contrary to the three-step test. From my point of view, the recognition of equitable compensation in the case of commercial uses of images would be the fairest for authors and other rights holders, given the broadness with which the exception is drafted as far as such uses are concerned.

Finally, it should be taken into account that, in the case of architectural works, it is not uncommon for their authors to resort to trademark law to protect their exclusivity over the use of the work. In such a case, the free use of photographs by third parties (mainly for commercial purposes) is not possible since the trademark establishes an *ius prohibendi*.

## Conclusions

In view of the above, it does not seem necessary to me for the exception to be made mandatory in order to achieve greater harmonization, although its recognition as mandatory could serve to achieve this. On the other hand, it seems necessary to me that the current wording of the panorama exception be made more precise to resolve the discrepancies that have arisen because of its excessively broad or open wording, essentially as far as the concept of permanence is concerned.<sup>60</sup> Moreover, the panorama exception could be considered an autonomous EU concept in the absence of any referral to national laws, and any autonomous concept must be subject to a uniform interpretation in all Member States, as the CJEU has previously pointed out.<sup>61</sup> This uniform interpretation is difficult to achieve since the application requirements and the scope of the exception are different in each Member State. A more precise regulation of the exception in the Directive would help to achieve a uniform interpretation.

Despite the problems that arise from the lack of harmonization, intervention by the EU legislative bodies should be ruled out, since they had the opportunity to revise the panorama exception when Directive 2019/790 was adopted, but they chose not to do so. A legislative solution could be found at the national level, whereby certain Member States would amend their legislation to regulate the panorama exception in a manner consistent with the Directive, although this does not seem to be the most likely way to achieve a greater degree of harmonization since it is clear, as has been demonstrated with Italy and France, that Member States, on their own initiative, are not willing to legislate to that end. Once the legislative route has been ruled out, all that remains is the judicial route. National judges must apply national legislation in light of the provisions of the Directive, insofar as doubts or ambiguities arise, which should serve to achieve a greater degree of harmonization. Ultimately, the intervention of the CJEU

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<sup>60</sup> *Ibid.*; L. Montagnani, *The EU Consultation...*; European Copyright Society (ECS), *Answer to the EC Consultation...*

<sup>61</sup> European Copyright Society (ECS), *Answer to the EC Consultation...*; E. Rosati, *Non-Commercial Quotation...*, pp. 311–321.



will be required, through the preliminary ruling mechanism, which will serve to delimit the autonomous concepts of the exception, forcing the courts to apply national law in a harmonized manner.<sup>62</sup> However, as we noted in the introduction, the CJEU has not yet had the opportunity to rule on the matter. The problem outlined in this article will also develop because trends in technological progress are difficult to predict and will also affect the exception presented in this article, particularly with regard to the dissemination of works in the virtual environment. Active monitoring of legislative solutions in this area is a necessity.

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<sup>62</sup> C. Geiger, F. Schönherr, *The Information Society...*, pp. 395–484; European Copyright Society (ECS), *Answer to the EC Consultation...*

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## Summary

### *Llanos Cabedo Serna*

#### **Cultural Dissemination and Commercial Exploitation of Images of Architectural and Art Works: "Freedom of Panorama" under Scrutiny**

The freedom of panorama is an exception to copyright regulated at the Community level that allows architectural and art works permanently located in public places to be photographed, videotaped and disseminated in any way for any purpose. Its transposition into national legislation, with significant differences, is of great importance both for the dissemination of culture and for the commercial exploitation of images, particularly in the digital environment. These differences are due to the optional nature of the exception and its broad formulation. It is worth analyzing these two issues, contrasting the UE regulation with national legislation, in particular

in Spain, to conclude whether it is possible to reduce existing differences to achieve the greatest possible degree of harmonisation among all of them.

**Keywords:** architectural works, copyright, Directive 2001/29/EC, exceptions to copyright, freedom of panorama, art work.

## Streszczenie

*Llanos Cabedo Serna*

### Rozpowszechnianie i wykorzystanie komercyjne utworów architektonicznych i plastycznych w kulturze i sztuce: „prawo panoramy” jako przedmiot analizy

Prawo panoramy jest wyjątkiem od prawa autorskiego, regulowanym na poziomie wspólnotowym, dającym możliwość rozpowszechniania, w tym fotografowania i filmowania w dowolny sposób i w dowolnym celu utworów architektury i sztuki wystawionych na stałe w ogólnie dostępnych miejscach publicznych. Implementacja tego wyjątku do ustawodawstwa krajowego z istotnymi różnicami pomiędzy poszczególnymi krajami ma ogromne znaczenie zarówno dla rozpowszechniania kultury, jak i komercyjnego wykorzystania dzieł architektury i sztuki, w szczególności w środowisku cyfrowym. Różnice te wynikają z fakultatywnego charakteru wyjątku i jego szerokiego brzmienia. Analiza tych dwóch aspektów prawa panoramy w porównaniu z regulacjami UE i ustawodawstwem krajowym, w szczególności w Hiszpanii, jest konieczna, aby stwierdzić, czy możliwe jest zmniejszenie istniejących różnic w celu osiągnięcia jak największego stopnia harmonizacji.

**Słowa kluczowe:** utwory architektoniczne, prawo autorskie, dyrektywa 2001/29/WE, wyjątki od prawa autorskiego, prawo panoramy.

**Sybilla Stanisławska-Kloc**

Uniwersytet Jagielloński, Polska

sybilla.stanislawski-kloc@uj.edu.pl

ORCID: 0000-0003-4010-1917

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## Lord Mansfield i prawo autorskie w XXI w.

### Wprowadzenie

Inspirację do napisania tego artykułu stanowiła lektura pasjonującej książki pt. *Lord Mansfield. Sędzią być!*<sup>1</sup> autorstwa Jerzego Zajadły. W rozdziale trzecim tej publikacji *Praktyka prawnicza – wzięty i skuteczny adwokat* autor odnosi się do najstarszych, najważniejszych do dzisiaj angielskich orzeczeń autorskoprawnych (*landmark decisions*), w których William Murray, znany jako Lord Mansfield, brał udział: *Millar v. Taylor* (1769) oraz *Donaldson v. Becket* (1774)<sup>2</sup>. Po wydaniu pierwszej angielskiej ustawy autorskoprawnej – Statutu królowej Anny z 1709 r.<sup>3</sup>, pomiędzy wydawcami (księgarzami) angielskimi i szkockimi toczyła się słynna batalia dotycząca czasu trwania (nieograniczonego lub ograniczonego) praw autorskich, odpowiednio na podstawie *common law*

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<sup>1</sup> J. Zajadło, *Lord Mansfield. Sędzią być!*, wyd. 2, Gdańsk 2023. O postaci Williama Murraya – Lorda Mansfielda autor pisał również w opracowaniu *Sędziowie i niewolnicy. Szkice z filozofii prawa*, Gdańsk 2019, w szczególności na s. 37–64, w rozdziale pierwszym zatytułowanym *Sędzia William Murray, Lord of Mansfield: Sprawy Somerset v. Steward i Gregson v. Gilbert*.

<sup>2</sup> Orzeczenia te, a także dokumenty z nimi związane i omówienia są dostępne w: R. Deazley, *Commentary on Donaldson v. Becket (1774)* [w:] *Primary Sources on Copyright (1450–1900)*, eds. L. Bently, M. Kretschmer, [https://www.copyrighthistory.org/cam/tools/request/showRecord.php?id=record\\_uk\\_1774](https://www.copyrighthistory.org/cam/tools/request/showRecord.php?id=record_uk_1774) [dostęp: 8.08.2024]; R. Deazley, *Commentary on Millar v. Taylor (1769)* [w:] *Primary Sources on Copyright...*

<sup>3</sup> Pełna nazwa aktu: An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned; w Wikipedii znajduje się strona poświęcona tej ustawie: [https://en.wikipedia.org/wiki/Statute\\_of\\_Anne](https://en.wikipedia.org/wiki/Statute_of_Anne) [dostęp: 8.08.2024]. Na temat znaczenia i roli, jaką odgrywał ten akt prawny, zob. np. opracowanie wydane z okazji obchodów 300-lecia jego uchwalenia: *Global Copyright. Three Hundred Years Since the Statute of Anne, from 1709 to Cyberspace*, eds. L. Bently, U. Suthersanen, P. Torremans, London 2010. Akt ten został uchwalony w 1709 r., a obowiązywał od 1710 r.

i *statutory law*<sup>4</sup>. Spór i jego rozstrzygnięcie miały znaczenie dla całego systemu prawa autorskiego<sup>5</sup>; orzeczenia te wpłynęły na kształt prawa autorskiego nie tylko w Anglii<sup>6</sup>.

Autorkę niniejszego artykułu zainspirowała także 250. rocznica wydania wyroku w sprawie *Donaldson v. Becket*<sup>7</sup>. Samo orzeczenie nie będzie tu jednak przedmiotem szerszej analizy, zostanie tylko skrótowo przywołane, aby uzasadnić wybór przywołanych w opracowaniu trzech autorskoprawnych problemów z XXI w. W pewnym sensie, o czym będzie mowa dalej, historia autorskoprawna zatacza tu koło. Przedmiotowe orzeczenia angielskie powinny być lekturą obowiązkową<sup>8</sup> nie tylko dla historyków prawa autorskiego, ale też dla wszystkich specjalistów z tej dziedziny.

Niestety, nie dowiemy się, jak dzisiaj orzekałby Lord Mansfield w sprawach autorskoprawnych. Natomiast intuicja podpowiada autorce, że przyjąłby z aprobatą dzisiejsze rozwiązania dotyczące ograniczonego czasu trwania autorskich praw majątkowych oraz nieograniczonej w czasie ochrony autorskich praw osobistych. Wydaje się, że ten dualizm praw nie byłby Lordowi Mansfieldowi obcy. Szczególnie, że obecnie niektórzy przedstawiciele doktryny dopatrują się w stanowisku Williama Murraya w sprawie *Millar v. Taylor* (przypomnijmy – wyrok z 1769 r.) prekursorskiej myśli

<sup>4</sup> J. Zajadło, *Lord Mansfield...*, s. 46–53 i przywołana tam obszerna literatura.

<sup>5</sup> R. Deazley, *On the Origin of the Right to Copy. Charting the Movement of Copyright Law in Eighteenth-Century Britain (1695/1774)*, London, 2004, s. 169 i nn.; L. Bently, B. Sherman, *Intellectual Property Law*, Oxford 2009, s. 160, 180–181.

<sup>6</sup> Np. również w Belgii; por. J. Deene, który wskazuje: „However, the Statute of Anne itself, and especially its juridical interpretation in *Donaldson v. Becket*, 1774 had a certain influence on Belgian copyright law” – *idem*, *The influence of the Statute of the Anne on Belgian copyright law* [w:] *Global Copyright...*, s. 141–142. Z kolei na ważny aspekt zwrócił uwagę E.L. Carter, który (wraz z trzema studentami) w 2011 r. przeanalizował 271 artykułów w amerykańskiej wersji „Westlaw’s Journals and Law Review”, w których cytowano to orzeczenie, i zwrócił uwagę na błędy w jego interpretacji („the review demonstrated significant confusion in the legal scholarship over the rationale and holding of *Donaldson* and showed that at least some of this confusion comes from the errors and omissions in the eighteenth-century legal reports”); szczególnie w znaczącej sprawie *Wheaton v. Peters* (z 1834 r.) – opierając się na wersji Burrowa, Sąd Najwyższy USA pomylił się, przyjmując, że 6 z 11 advisory judges wyraziło opinię, iż *common law* zostało zastąpione przez Statut królowej Anny („common law copyright was superseded by the Statute of Anne”), gdy w rzeczywistości zajęli oni odmienne stanowisko. Przy czym należy zauważyć, że ostatecznie decyzję podejmowała Izba Lordów. Por. E.L. Carter, *Choking the channel of public information: Re-examination of an eighteenth-century warning about Copyright and free speech*, „NYU Journal of Intellectual Property and Entertainment Law”, Winter 2011, s. 86–88, natomiast zestawienie tych analizowanych artykułów jest zawarte w apendyksie na s. 125–127. Por. też na temat tej pomyłki przypis 16.

<sup>7</sup> W dniu 27 lutego 2024 r. w związku z tą rocznicą w odbyło się w UCL Institute of Brand and Innovation Law w Londynie specjalne seminarium pt. „The Battle of the Booksellers: the 250th anniversary of *Donaldson v. Becket*”, które prowadził prof. Robin Jacob; zob. <https://www.ucl.ac.uk/ibil/past-events/events-2024> [dostęp: 8.08.2024].

<sup>8</sup> Orzeczenia te omawia także L. Górnicki, *Rozwój idei praw autorskich: od starożytności do II wojny światowej*, Wrocław 2013, s. 124–132, [https://www.bibliotekacyfrowa.pl/Content/42471/Rozwoj\\_idei\\_praw\\_autorskich.pdf](https://www.bibliotekacyfrowa.pl/Content/42471/Rozwoj_idei_praw_autorskich.pdf) [dostęp: 8.08.2024] oraz K. Gliściński, *Wszystkie prawa zastrzeżone. Historia sporów o autorskie prawa majątkowe 1469–1928*, Warszawa 2016, nr b. 152–167, <https://wolnelektury.pl/katalog/lektura/glicinski-dyskursy-prawa-autorskiego.html> [dostęp: 8.08.2024].

w zakresie uznania w angielskim prawie autorskim osobistych praw twórcy<sup>9</sup>, w tym prawa do autorstwa. Nawet jeśli jego poglądy nie przyjęły się od razu, to niewątpliwie nie zawiodła go intuicja prawnicza i *judicial philosophy*. Zapewne dla wykształconego na pismach rzymskich jurystów Lorda Mansfielda potrzeba realizacji idei *non omnis moriar* (nie wszystkim umrę – będę żył w dziełach swoich) Horacego w ramach rodzących się praw autorskich była oczywista<sup>10</sup>.

## 1. Wyrok w sprawie Donaldson v. Becket (1774)

Na potrzeby niniejszego opracowania skrótowo tylko przedstawiono okoliczności sprawy Donaldson v. Becket, jak i jej rozstrzygnięcie z 1774 r., a także wyjaśniono wybór trzech aktualnych kwestii prawnych, które uzasadniają tytuł artykułu.

Od momentu uchwalenia w Anglii w 1709 r. Statutu królowej Anny narodziła się nowoczesna idea ochrony praw autorskich, z określonymi terminami ochrony, które stanowiły novum w porównaniu do wcześniej nieograniczonego monopolu (*stationery copyrights*) wydawców (Stationers' Company) opartego na udzielonych im przywilejach. Statut królowej Anny wprowadzał, z dzisiejszego punktu widzenia, stosunkowo krótkie terminy ochrony praw autorskich: 21 lat dla utworów wydanych przed 1710 r., a 14 lat dla wydanych po tym roku (z przedłużeniem ochrony o kolejne 14 lat, jeśli autor jeszcze żył<sup>11</sup>). Jak łatwo obliczyć, ok. roku 1740 ochrona ta zaczęła wygasać. Ponieważ nie było szans na zmianę przepisów prawnych (nowelizację), to przedsiębiorczym wydawcom pozostała batalia sądowa (która przeszła do historii jako *battle of the booksellers*). Ujawniła ona od razu też pewien element konkurencji w środowisku wydawniczym oraz problem domeny publicznej (do której – jak dzisiaj byśmy to ujęli – przechodził utwór po upływie czasu ochrony praw autorskich), a także rzadziej analizowany w literaturze problem ochrony autorskoprawnej w relacji do swobody

<sup>9</sup> Lord Mansfield: „it is just, that an Author should reap the pecuniary Profits of his own Ingenuity and Labour. It is just, that Another should not use his Name, without his consent [...]. The author may not only be deprived of any profit, but lose the expence he has been at. He is no more master of the use of his own name” – cyt. za: R. Deazley, *Commentary on Millar v. Taylor (1769)*... Zdaniem M.T. Sundary Rajan w tym stanowisku Lord Mansfield prezentuje poglądy, które korespondują ze współcześnie rozumianym prawem do autorstwa, integralności oraz do wycofania utworu z obrotu; *eadem*, *Moral Rights: Principles, Practice and New Technology*, New York 2011, s. 94–99, <https://ssrn.com/abstract=1805395> [dostęp: 8.08.2024]. Wcześniej C.P. Rigamonti zwraca uwagę na ten aspekt pierwowzoru ochrony interesów niemajątkowych twórcy i pisze: „One of the first known judicial statements mentioning the interests underlying moral rights in a common law context was made by Lord Mansfield when he argued in favor of common law protection ‘of the copy prior to publication’ in the 1769 landmark case of *Millar v. Taylor*”; por. *idem*, *Deconstructing Moral Rights*, „Harvard International Law Journal” 2006, vol. 47, no. 2, s. 381–382.

<sup>10</sup> Ponadto możliwe, że dla kształtowania się poglądów W. Murraya dotyczących prawa autorskiego mogła też mieć znaczenie okoliczność prowadzenia (jeszcze jako adwokat) sprawy swojego przyjaciela – poety Alexandra Pope’a (sprawa Pope v. Curl z 1741 r.); o tej sprawie pisze J. Zajadło, *Lord Mansfield...*, s. 42–44.

<sup>11</sup> Por. L. Górnicki, *Rozwój idei...*, s. 123.

wypowiedzi. Wiadomo było, że nie tyle sam autor był „wrogiem” wydawcy angielskiego (autor zawsze wtedy potrzebował wydawcy), co korzystał na tym stanie rzeczy inny wydawca (szkocki), który mógł wprowadzać na rynek (nie tylko szkocki, ale też londyński) tańsze wydania<sup>12</sup>. W sprawie *Millar v. Taylor* (1769) wydawca A. Millar (członek *Stationers’ Company*), który nabył w 1729 r. prawa autorskie do utworów, tj. poematów pt. *The Seasons*<sup>13</sup> autorstwa J. Thomsona, pozwał innego wydawcę – R. Taylora (spoza *Stationers’ Company*) i zgłosił typowe i dzisiaj żądania autoroskoprawne dotyczące zaprzestania wydawania dzieła oraz odszkodowania. Oczywiście A. Millar nie kwestionował Statutu królowej Anny (byłoby to niemożliwe, skoro akt obowiązywał; nie udało się bowiem próby jego nowelizacji mające na celu wydłużenie terminów ochrony), ale podnosił, iż akt ten (jako *statutory law*) nie pozbawił wydawców wcześniejszej, przysługującej im bezterminowo ochrony (na podstawie *common law*). Ostatecznie uzyskał on korzystne dla siebie rozstrzygnięcie<sup>14</sup>. Przypadek losowy w pewnym sensie pomógł prawu autorskiemu, gdyż A. Millar krótko po wydaniu tego wyroku zmarł. Jednak prawa autorskie do wierszy J. Thomsona nabył inny wydawca – T. Becket, który pozwał szkockiego wydawcę A. Donaldsona, powołując się na wyrok z 1769 r., i oczywiście wygrał sprawę w pierwszej instancji. Jednak pozwany odwołał się do Izby Lordów, która sprawę rozpatrywała w dniach 4, 7–9, 15, 17 i 21 lutego 1774 r. i wydała wyrok w dniu 22 lutego 1774 r.<sup>15</sup> (a zatem po 7 posiedzeniach, w ciągu jednego miesiąca – w tempie nierealnym w XXI w.). Izba Lordów orzekła na korzyść A. Donaldsona<sup>16</sup> – tj. o ograni-

<sup>12</sup> Tańsze nie tylko ze względu na zaoszczędzone koszty wynagrodzenia autorskiego, ale także ze względu na gorszą jakość nośnika.

<sup>13</sup> Krótko, lecz ciekawie historię powstania tych poematów przedstawia E.L. Carter, *Choking the channel...*, s. 95 – przypis 78.

<sup>14</sup> J. Zajadło zwraca uwagę, że wyrok *King’s Bench Court* (Sąd Ławy Królewskiej) w tej sprawie nie był jednomyślny (złożono jedno zdanie odrębne, a dwóch sędziów, zgadzając się z rozstrzygnięciem, przedłożyło swoją inną argumentację – inne uzasadnienie); por. *idem*, *Lord Mansfield...*, s. 48–49.

<sup>15</sup> Szczegółowo przebieg procesu przypomina E.L. Carter; por. *idem*, *Choking the channel...*, s. 80–79. Opisał go również M. Rose, *Authors and Owners. The invention of copyright*, London 1994, s. 92–95. Społeczeństwo było istotnie zainteresowane tym sporem, w prasie codziennej ukazywały się sprawozdania z sądu oraz stanowiska stron, stąd można było dość dokładnie odtworzyć jego przebieg.

<sup>16</sup> Lord Mansfield nie przemawiał w tej sprawie, co odnotowano z zaskoczeniem (por. E.L. Carter, *Choking the channel...*, s. 109 – przypis 153), ale uzasadniano to tym, że wcześniej doradzał wydawcom angielskim (*ibidem*, s. 94 – przypis 79, s. 117 – przypis 201 i s. 188). Zatem to „dyplomatyczne” milczenie wynikało z tego, iż nie chciał ujawniać swego konfliktu interesów. Należy przyjąć, że gdyby zabrał głos, to musiałby się wypowiedzieć na korzyść wydawców angielskich i sprawa zakończyłaby się pozytywnie dla T. Becketa, a ze szkodą dla systemu prawa autorskiego, z czego światły W. Murray musiał, moim zdaniem, zdawać sobie sprawę. M. Rose pisze: „Perhaps, as Sir James Burrow suggested a few years later, Mansfield abstained out of ‘delicacy’, since it was his court’s decision that was in effect being challenged. Nonetheless, Mansfield’s support of the common-law right was well known, and had he spoken the tally would surely have been a substantial seven to five in favor of the perpetual right”; *idem*, *The Autor as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship*, „Representations” 1988, no. 23, s. 51–85, w szczególności s. 67–68, <http://oldemc.english.ucsb.edu/emc-courses/novel-mediation-s2011/novel-mediation/Articles/MarkRose.Representations.AuthorsAsProprietors.1988.pdf> [dostęp: 8.08.2024]. Jak sygnalizowałam w przypisie 6, o rozstrzygnięciu zdecydował jeden głos, i jak wskazują komentatorzy, został on dodatkowo błędnie odnotowany (zinterpretowany); por. M. Rose, *The Autor as Proprietor...*, s. 51–85, w szczególności s. 67–68 i 79 –



czonej w czasie ochrony praw autorskich (tym samym *statutory law* triumfowało nad *common law*).

Do dalszej krótkiej analizy wybrano trzy następujące zagadnienia: 1) czas trwania autorskich praw majątkowych, 2) domena publiczna oraz 3) prawa wydawców; każde z nich w pewnym sensie ma związek ze sprawą *Donaldson v. Becket*, ale ujawnia też nowe oblicze prawa autorskiego w XXI w.

## 2. Czas trwania autorskich praw majątkowych

Jak pokazują analizowane sprawy sądowe z XVIII w., problematyka czasu trwania praw autorskich determinowała losy prawa autorskiego. Od czasów Lorda Mansfielda mamy do czynienia z procesem wydłużania okresu ochrony autorskich praw majątkowych, który obecnie skutkuje ochroną nawet 10 razy dłuższą niż pierwotnie przewidzianą w Statucie królowej Anny<sup>17</sup>.

Konwencja berneńska w art. 7 wprowadziła jako ogólną zasadę 50-letni czas ochrony autorskich praw majątkowych, liczony od śmierci twórcy (*post mortem auctoris*)<sup>18</sup>. W prawie unijnym wydłużono (do 70 lat) i zharmonizowano czas trwania autorskich praw majątkowych na przełomie XX i XXI w.<sup>19</sup> Pierwsza polska ustawa o prawie autorskim

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przypis 5 oraz s. 81 – przypis 55. W tym ostatnim przypisie (nr 55) M. Rose odnosi się do stanowiska J. Whichera, *The Ghost of Donaldson v. Becket*, „Bulletin of the Copyright Society of the U.S.A.” 1961–1962, vol. 9, s. 102–151, 194–229; dodatkowo wyjaśnia on: „To summarize: my hypothesis about the genesis of this little historical puzzle is that confusion was introduced by the difficulty that the clerk had in recording Baron Eyre’s opinion—should he record it literally or should he interpret Eyre’s intent? – and that a problem was created when Baron Nares who spoke next concluded by saying that his position was on each point opposite to that of Eyre”; M. Rose, *The Author as the Proprietor...*, s. 82 – końcowy fragment przypisu 55. Na te nieścisłości w odnotowaniu stanowiska sędziów wskazuje też m.in. R. Deazley, *Commentary on Donaldson v. Becket (1774)*...; w polskiej literaturze por. L. Górnicki, *Rozwój idei...*, s. 131–132. O tej prawdopodobnej pomyłce pisze też J. Zajadło, *Lord Mansfield...*, s. 51 – przypis 79, przy czym zauważa, że nie miała ona tak dużego znaczenia, skoro ostatecznie decyzję podejmowała Izba Lordów: „Nie zmienia to faktu, że ostateczny wynik głosowania całej Izby Lordów nie pozostawiał wątpliwości co do dalszych losów *copyright*”.

<sup>17</sup> Przyjmując w tym porównaniu pierwotny 14-letni okres ochrony przewidziany w Statucie królowej Anny i obecnie ten na podstawie art. 36 pkt 1 ustawy z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (tekst jedn.: Dz. U. z 2022 r., poz. 2509 ze zm.; dalej: u.p.a.p.p.) np. dla autora, który w 1950 r. w wieku 10 lat stworzył utwór, żył jeszcze potem 70 lat, czyli zmarł w wieku 80 lat w 2020 r., a jego utwory są chronione jeszcze 70 lat po jego śmierci, to łączny okres ten wynosi 140 lat.

<sup>18</sup> Por. art. 7 i 7 bis konwencji berneńskiej o ochronie dzieł literackich i artystycznych z dnia 9 września 1886 r., przejrzonej w Berlinie dnia 13 listopada 1908 r. i w Rzymie dnia 2 czerwca 1928 r. (ratyfikowanej zgodnie z ustawą z dnia 5 marca 1934 r.) (Dz. U. z 1935 r. Nr 84, poz. 515; dalej: konwencja berneńska). Por. też J. Ginsburg, S. Ricketson, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, Oxford 2022, s. 527 i nn. Warto wskazać, że dopuszczono krótszy termin ochrony dla dzieł sztuki użytkowej i fotografii (por. art. 7 ust. 4 konwencji berneńskiej).

<sup>19</sup> Najpierw uczyniono to w dyrektywie Rady 93/98/EWG z dnia 29 października 1993 r. w sprawie harmonizacji czasu ochrony prawa autorskiego i niektórych praw pokrewnych (Dz. Urz. WE L 290 z 24.11.1993, s. 9; dalej: dyrektywa 93/98/EWG), która została zastąpiona dyrektywą 2006/116/WE Parlamentu Europejskiego i Rady z dnia 12 grudnia 2006 r. w sprawie czasu ochrony prawa autor-



z 1926 r.<sup>20</sup> przewidywała jako zasadę ochronę przez okres życia twórcy i 50 lat po jego śmierci, ale krótsze terminy dla ochrony praw autorskich do: a) fotografii i utworów kinematograficznych oraz b) przeróbek utworów muzycznych (odpowiednio 10 i 20 lat od ich sporządzenia). Kolejna ustawa z 1952 r.<sup>21</sup> pierwotnie wprowadzała jako zasadę tylko 20-letni okres ochrony autorskich praw majątkowych po śmierci twórcy i 10-letni dla utworów wskazanych powyżej w pkt a–b. Obecnie obowiązująca ustawa o prawie autorskim z 1994 r. przewiduje jednolity czas dla wszystkich kategorii utworów, pierwotnie było to 50 lat, a obecnie 70 lat, zasadniczo liczonych od śmierci twórcy. Ale na przestrzeni wieków od tej zasady liczenia czasu ochrony autorskich praw majątkowych od śmierci twórcy<sup>22</sup> wprowadzane są liczne wyjątki, np. niekiedy termin ochrony liczony jest od daty opublikowania utworu. Ponadto problemy z ustaleniem tożsamości podmiotu praw autorskich i niemożliwością w związku z tym ustalenia, czy prawa te trwają, doprowadziły w XXI w. do przyjęcia unijnej regulacji dotyczącej utworów osieroconych<sup>23</sup>. Analiza przepisów krajowych, unijnych oraz międzynarodowych pozwala łatwo zauważyć istotne różnicowanie na tych trzech poziomach regulacji prawnych w zakresie: a) podstawowego czasu trwania ochrony autorskich praw majątkowych; b) ustalenia kręgu osób (współautorów), których śmierć skutkuje rozpoczęciem biegu terminu obliczania; c) innych okoliczności niż data śmierci autora relevantnych dla biegu terminu ochrony; d) szczegółowych rozwiązań dla wybranych kategorii utworów, np. utworów audiowizualnych.

Co więcej, nowelizacje prawa autorskiego dokonane na przełomie XX i XXI w. skutkowały nie tylko wydłużeniem czasu ochrony autorskich praw majątkowych, ale także jej odzysaniem nawet w przypadku tych utworów, które znajdowały się już w domenie publicznej<sup>24</sup>.

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skiego i niektórych praw pokrewnych (wersja ujednolicona) (Dz. Urz. L 372 z 27.12.2006, s. 12; dalej: dyrektywa 2006/116/WE), a następnie zmieniona dyrektywą Parlamentu Europejskiego i Rady 2011/77/UE z dnia 27 września 2011 r. (Dz. Urz. UE L 265 z 11.10.2011, s. 1; dalej: dyrektywa 2011/77/UE). Szczególnie por. Ch. Angelopoulos, *Term Directive* [w:] *Concise European Copyright Law*, eds. T. Dreier, P.B. Hugenholtz, The Netherlands 2016, s. 336–377, a także wyrok TSUE z dnia 24 października 2024 r., C-227/23, pkt 79.

<sup>20</sup> Ustawa z dnia 29 marca 1926 r. o prawie autorskim (Dz. U. Nr 48, poz. 286).

<sup>21</sup> Ustawa z dnia 10 lipca 1952 r. o prawie autorskim (Dz. U. Nr 34, poz. 234).

<sup>22</sup> A. Drassinower, *Death in Copyright: Remarks on duration*, „Boston University Law Review” 2019, vol. 99; autor czyni też odwołania do stanowiska Lorda Mansfielda – por. pkt 4 zatytułowany *Beyond Mansfield/Yates Debates*, s. 2574–2580.

<sup>23</sup> Dyrektywa Parlamentu Europejskiego i Rady 2012/28/UE z dnia 25 października 2012 r. w sprawie niektórych dozwolonych sposobów korzystania z utworów osieroconych (Dz. Urz. UE L 299 z 27.10.2012, s. 5); S. Stanisławska-Kloc, *Utwory „osierocone”*, ZNUJ PPWI 2007, z. 4(100), s. 453–476; eadem, *Dyrektywa 2012/28/UE o utworach osieroconych – czy jesteśmy na właściwej drodze do rozwiązania problemu?*, KPP 2013, z. 1, s. 117–158.

<sup>24</sup> Por. art. 127 ust. 1 u.p.a.p.p. oraz art. 1 ust. 2 i art. 2 ustawy z dnia 9 czerwca 2000 r. o zmianie ustawy o prawie autorskim i prawach pokrewnych (Dz. U. Nr 53, poz. 637), która weszła w życie dnia 22 lipca 2000 r. Natomiast w USA w 2012 r. Supreme Court w wyroku w słynnej sprawie *Golan v. Holder* przyjął możliwość odzyskania ochrony autorskich praw majątkowych (z datą wsteczną) w stosunku do utworów, które znajdowały się w domenie publicznej („the retroactive copyright restoration”); 565 U.S. 302 (2012). Wyrok zapadł stosunkiem głosów 6:2, a opinię w tej sprawie przygotowała sędzia R.B. Gins-

Od czasów Lorda Mansfielda średnia długość życia człowieka wydłużyła się dwukrotnie (z ok. 40 do 80 lat)<sup>25</sup>. Pod koniec XIX w. istotnie zmieniły się sposoby korzystania z utworów – chodzi o możliwości ich cyfrowego wykorzystania, co pozwala na dłuższe zachowanie tych utworów (lub ich kopii), a często także na „odżycie” zainteresowania tymi utworami (których egzemplarze były unikatowe, zniszczone) oraz na komercyjną eksploatację utworów na szeroką skalę (w wersji podstawowej lub opracowania). Między innymi te okoliczności wpłynęły na wydłużenie w prawie unijnym czasu trwania ochrony z 50 do 70 lat po śmierci twórcy<sup>26</sup>, uzasadniały one społecznie wydłużenie ochrony, aby prawo autorskie mogło spełniać funkcję alimentacyjną już nie tylko dla twórcy, ale także dla jego spadkobierców. Dzisiaj tak długa ochrona autorskich praw majątkowych, której beneficjentami jest nie tylko drugie, ale czasem nawet trzecie pokolenie spadkobierców, może być kwestionowana z punktu widzenia grupowego interesu społecznego. Nie wspomnę o skomplikowanych po latach przypadkach, gdy prawa autorskie dziedziczy kilkanaście osób (w udziałach od kilku do kilkunastu procent lub wyrażonych ułamkiem, w którym mianownik jest trzycyfrowy, a licznik jedno), co utrudnia sprawne wykonywanie autorskich praw majątkowych. Interesująca jest nowa zauważalna w XXI w. tendencja wśród autorów (szczególnie tych uznanych, z dorobkiem) lub ich spadkobierców do powoływania fundacji<sup>27</sup>, które sprawnie zarządzają „długimi” autorskimi prawami majątkowymi.

O ile rewolucja cyfrowa była jednym z czynników wpływających na wydłużenie z 50 do 70 lat po śmierci twórcy ochrony autorskich praw majątkowych, to rewolucja sztucznej inteligencji (AI) może uzasadniać utrzymanie tego okresu, ale nie powinna służyć jego wydłużaniu<sup>28</sup>. Chyba że wprost przeciwnie – AI udowodni nam niedługo, iż celowy będzie powrót do krótszego terminu ochrony, aby nie blokować rozwoju ludzkości poprzez nowy trolling autorskoprawny – chodzi tu w szczególności o spory

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bourg. Jako uzasadnienie rozstrzygnięcia podano kilka argumentów, w tym przywołano aspekt historyczny (Justia Summary: „The Court held that neither the text of the Copyright and Patent Clause, historical practice, or the Court’s precedent excluded application of copyright protection to works in the public domain” – <https://supreme.justia.com/cases/federal/us/565/302/> [dostęp: 8.08.2024]). Wskazuję na ten wyrok, gdyż w zdaniu odrębnym sędzieja Breyer (do którego dołączył sędzia Alito) na początku przywołał Statut królowej Anny oraz wyrok w sprawie *Donaldson v. Becket* – <https://supreme.justia.com/cases/federal/us/565/302/#top> [dostęp: 8.08.2024].

<sup>25</sup> Podaję tę proporcję w pewnym uproszczeniu; W. Murray (1705–1793) dożył prawie 90 lat, ale oczywiście arystokracja ze względu na swoją uprzywilejowaną pozycję żyła znacznie dłużej niż przeciętni ludzie, szczególnie do początków XX w. Na temat długości życia ludzi por. O. Galor, O. Moav, *Natural Selection and the Evolution of Life Expectancy*, November 2005, w szczególności s. 5, <https://sticerd.lse.ac.uk/seminarpapers/dg09102006.pdf> [dostęp: 8.08.2024].

<sup>26</sup> Por. pkt 6 preambuły do dyrektywy 2011/77/UE oraz M.M. Walter [w:] *European Copyright Law: A Commentary*, eds. S.V. Lewinski, M.M. Walter, Oxford 2010, s. 499 i nn.

<sup>27</sup> Np. Fundacja Wisławy Szymborskiej lub Fundacja Maxa Billa, Fundacja Gali i Salvadora Dalego, Fundacja Andy’ego Warhola; należy jednak zauważyć, że fundacje te nie były powołane z powodu rozdrobnienia spadkobierców.

<sup>28</sup> Choć zapewne utwory wprowadzone do tych systemów AI pozostaną tam już na wieczność, tj. dopóki systemy te nie przestaną funkcjonować.

autorskoprawne dotyczące wytworów o niskim poziomie twórczym (lub o „pozorach” twórczości – w sferze wyboru promptów).

Przechodząc do kolejnego zagadnienia, można wskazać, że w 2024 r. wygasła ochrona utworów stworzonych przez takich polskich twórców zmarłych w 1953 r., jak: Kornel Makuszyński, Julian Tuwim czy Konstanty Ildefons Gałczyński, ale też wygasła ochrona pierwszej wersji Myszki Miki – te utwory weszły zatem do domeny publicznej<sup>29</sup>.

### 3. Domena publiczna

Na przełomie XIX i XX w. podejmowano działania mające na celu zabezpieczenie domeny publicznej<sup>30</sup> wobec ekspansji prawa autorskiego (nie tylko w wymiarze czasu trwania ochrony, ale także treści praw autorskich, tj. rozszerzania monopolu twórcy na nowe sposoby korzystania z utworów). Warto wskazać tu na dwa aspekty ochrony domeny publicznej. Pierwszy dotyczy płaszczyzny organizacyjnej, o ile bowiem twórcom (i uprawnionym do tego osobom) w niektórych krajach służą wsparciem specjalne urzędy<sup>31</sup> lub powszechnie działają organizacje zbiorowego zarządzania prawami autorskimi (w Polsce najstarszą z nich jest ZAIKS), to domena publiczna nie miała takiego wsparcia instytucjonalnego. Zmieniło się to wraz z powołaniem Stowarzyszenia

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<sup>29</sup> Na różnych stronach internetowych są udostępniane zestawienia utworów, które przestają w danym roku podlegać ochronie; por. np. <https://centrumcyfrowe.pl/czytelnia/domena-publiczna-2024/> [dostęp: 8.08.2024] oraz <https://www.euipo.europa.eu/en/news/copyright-artworks-entering-the-public-domain-in-2024> [dostęp: 8.08.2024]. Jednak zawsze przed podjęciem decyzji o wykorzystaniu utworu (szczególnie w celach komercyjnych) należy dokładnie sprawdzić, czy na podstawie prawa kraju, w którym ma dojść do eksploatacji, rzeczywiście ta ochrona wygasła. Ponadto należy pamiętać, że niektóre utwory (np. wizerunki bohaterów fikcyjnych) mogą podlegać ochronie jako zarejestrowane znaki towarowe. Natomiast zasadnie zdecydowanie ograniczono możliwość rejestrowania utworów z domeny publicznej jako znaków towarowych; por. Trade mark protection of public domain works. A comment on the request for an advisory opinion of the EFTA Court, opinia ECS z dnia 1 listopada 2016, <https://europeancopyrightsociety.org/wp-content/uploads/2016/11/ecs-efta-reference-vigeland-final-1nov16.pdf> [dostęp: 8.08.2024] oraz S. Stanisławska-Kloc, *Rejestrowanie utworów (w szczególności będących w domenie publicznej) jako znaków towarowych [w:] 100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego Rzeczypospolitej Polskiej*, red. A. Adamczak, Warszawa 2018, s. 897 i nn.

<sup>30</sup> Nie dokonuję w tym artykule szczegółowej analizy tego pojęcia; por. na ten temat np. T. Targosz, *Domena publiczna w prawie autorskim*, ZNUJ PPWI 2007, z. 4(100), s. 531–554, a także opracowanie zamówione przez Światową Organizację Własności Intelektualnej (WIPO), autorstwa S. Dusolier, *Scoping Study on Copyright and Related Rights and the Public Domain*, 2011 oraz prezentowana tam literatura przedmiotu, <https://www.wipo.int/publications/en/details.jsp?id=4143&plang=EN> [dostęp: 8.08.2024], [https://www.researchgate.net/publication/251332037\\_Scoping\\_Study\\_on\\_Copyright\\_and\\_Related\\_Rights\\_and\\_the\\_Public\\_Domain](https://www.researchgate.net/publication/251332037_Scoping_Study_on_Copyright_and_Related_Rights_and_the_Public_Domain) [dostęp: 8.08.2024].

<sup>31</sup> Co prawda nie we wszystkich krajach one działają, ale por. np. US Copyright Office, <https://www.copyright.gov/> [dostęp: 8.08.2024].

Communia, którego celem jest rozszerzenie domeny publicznej, zwiększenie dostępu do kultury i wiedzy oraz umożliwienie ponownego wykorzystania utworów<sup>32</sup>.

Drugi aspekt dotyczy sfery legislacyjnej – w prawie unijnym domena publiczna została zabezpieczona w art. 14 dyrektywy z 2019 r.<sup>33</sup> i jest to jedyny przepis umieszczony w rozdziale 4 zatytułowanym: „Utwory sztuk wizualnych znajdujące się w domenie publicznej”. Jak zauważa się w literaturze, w pkt 53 preambuły do tej dyrektywy wprowadzono termin „domena publiczna” do „europejskiego *acquis communautaire*, inicjując w ten sposób efektywny proces normatywnej ochrony tej sfery w EU<sup>34</sup>. Jest to pierwszy krok na drodze do ochrony domeny publicznej i wydaje się, że kolejne, np. w związku z ideą *Digital Knowledge Act*<sup>35</sup>, będą następować. Przyjęta regulacja pokazuje, że przepisy dotyczące czasu trwania ochrony praw autorskich oraz dozwolonego użytku utworów są niekiedy niewystarczające i niezbędna jest dodatkowa ochrona interesów społeczeństwa.

Artykuł 14 dyrektywy DSM stanowi, iż „w przypadku wygaśnięcia okresu ochrony utworów sztuk wizualnych wszelkie materiały powstałe w wyniku zwielokrotniania tego utworu nie są przedmiotem prawa autorskiego ani praw pokrewnych”. Celem przepisu było przeciwdziałanie znanej praktyce, w dodatku wprowadzającej w błąd, polegającej na opatrywaniu informacją o prawach autorskich wiernych<sup>36</sup> reprodukcji (w postaci zwykłych fotografii) utworów sztuk wizualnych<sup>37</sup> będących w domenie pu-

<sup>32</sup> W szczególności zob. Policy Recommendation, <https://communia-association.org/policy-recommendations/> [dostęp: 8.08.2024].

<sup>33</sup> Dyrektywa Parlamentu Europejskiego i Rady (UE) 2019/790 z dnia 17 kwietnia 2019 r. w sprawie prawa autorskiego i praw pokrewnych na jednolitym rynku cyfrowym oraz zmiany dyrektyw 96/9/WE i 2001/29/WE (Tekst mający znaczenie dla EOG) (Dz. Urz. UE L 130 z 17.05.2019, s. 92; dalej: dyrektywa DSM).

<sup>34</sup> Tak. R. Markiewicz, *Prawo autorskie na jednolitym rynku cyfrowym. Dyrektywa Parlamentu Europejskiego i Rady (UE) 2019/790*, Warszawa 2021, s. 130–131; autor powołuje się na A. Giannopoulou, *The New Copyright Directive: Article 14 or when the Public Domain Enters the New Copyright Directive*, <https://copyrightblog.kluweriplaw.com/2019/06/27/the-new-copyright-directive-article-14-or-when-the-public-domain-enters-the-new-copyright-directive/> [dostęp: 8.08.2024]. W kontekście wcześniejszych rozważań warto przypomnieć fragment pkt 53 preambuły do dyrektywy DSM, w którym jest mowa o tym, że „W środowisku cyfrowym ochrona takich reprodukcji na mocy prawa autorskiego lub praw pokrewnych jest niespójna z wygaśnięciem ochrony utworów na podstawie prawa autorskiego”. Choć należy też wskazać, że odwołanie do domeny publicznej było już wcześniej czynione w pkt 25 i art. 5 dyrektywy 2006/116/WE.

<sup>35</sup> *Digital Knowledge Act for Europe*, <https://communia-association.org/wp-content/uploads/2024/09/Digital-Knowledge-Act-for-Europe.pdf> [dostęp: 7.10.2024].

<sup>36</sup> W stanowisku European Copyright Society wyraźnie podkreślono, że takie wierne reprodukcje (*faithful reproduction*) nie mają charakteru twórczego; por. pkt I w: *Comment of the European Copyright Society on the Implementation of Art. 14 of the Directive (EU) 2019/790 on Copyright in the Digital Single Market*, z dnia 26 kwietnia 2020 r., [https://europeancopyrightsociety.org/wp-content/uploads/2020/04/ecs\\_cds\\_m\\_implementation\\_article\\_14\\_final.pdf](https://europeancopyrightsociety.org/wp-content/uploads/2020/04/ecs_cds_m_implementation_article_14_final.pdf) [dostęp: 8.08.2024]. Wierną reprodukcją nieobjętą ochroną będzie reprodukcja odręczna – odmalowana kopia, ale też skan, film, wydruk 3D dzieła sztuki wizualnej.

<sup>37</sup> Na potrzeby interpretacji tego przepisu zasadnie proponuje się przyjmowanie szerokiej definicji utworów sztuki wizualnej, np. obejmujących utwory architektoniczne. Por. stanowisko European Copyright Society w: *Comment of the European Copyright Society...*, s. 2 oraz E. Rosati, *Copyright in the*

blicznej. Ta nowa regulacja ma zatem przeciwdziałać „wtórnej” autorskoprawnej ochronie w XXI w. utworów starych mistrzów i ich licencjonowaniu. Co więcej, drugi skutek, jaki zostanie osiągnięty, to wyłączenie spod prawa pokrewnego (przewidzianego w niektórych krajach UE dla zwykłych fotografii<sup>38</sup>) tych fotografii, które będą przedstawiały utwory sztuk wizualnych znajdujące się w domenie publicznej. Należy przyjąć, iż brak ochrony tych zwykłych fotografii będzie dotyczył zarówno tych już istniejących, jak i nowych, powstałych po przyjęciu (a właściwie implementacji dyrektywy DSM), aby uzyskać efekt „the cutting back of exclusive rights of reproduction photographers”<sup>39</sup>.

Ochroną autorskoprawną będą mogły być natomiast objęte np. artystyczne twórcze opracowania reprodukcyjne utworów (lub ich fragmentów) znajdujących się w domenie publicznej (przeróbki, adaptacje<sup>40</sup>). Ponadto właściciele nośników, powołując się na prawo własności, będą mogli limitować dostęp do egzemplarza (pobierać opłaty wstępu do pomieszczenia, w którym jest wystawiane dzieło sztuki) czy ustalać zasady sprzedaży (cenę) reprodukcji (pocztówek)<sup>41</sup>.

W uchwalonej z opóźnieniem w Polsce, w dniu 26 lipca 2024 r. nowelizacji prawa autorskiego<sup>42</sup>, której celem jest implementacja dyrektywy DSM do prawa polskiego, nie wprowadzono ani do prawa autorskiego, ani do innej ustawy szczególnego przepisu, który stanowiłby odpowiednik art. 14 dyrektywy DSM. W uzasadnieniu nowelizacji wskazano, że nie ma takiej potrzeby; dodatkowo w polskiej literaturze wyrażono pogląd, że z powodu braku ochrony nietwórczych fotografii nie ma potrzeby implementacji art. 14 dyrektywy DSM do prawa polskiego<sup>43</sup>. W konsultacjach projektu implementacji DSM do prawa polskiego prowadzonych przez Ministerstwo Kultury i Dziedzictwa Narodowego autorka proponowała rozwiązanie polegające na implementacji art. 14

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*Digital Single Market: Article-by-Article Commentary to the Provisions of Directive 2019/790*, Oxford 2021, komentarz do art. 14, pkt 3.2.

<sup>38</sup> Por. np. art. 72 niemieckiego prawa autorskiego; odnośnie do innych praw pokrewnych wydawców oraz R. Markiewicz, *Prawo autorskie...*, s. 132. Dodatkowo problemy, jakie występują we Włoszech w związku z wykorzystywaniem wizerunków utworów dziedzictwa kulturowego (*images of cultural heritage*), są przedmiotem debaty i szczegółowej regulacji prawnej – por. D. De Angelis, *Italian Ministry of Culture's new decree opens the door for scientific publications*, June 2024, <https://communia-association.org/2024/06/28/italian-ministry-of-cultures-new-decree-opens-the-door-for-scientific-publications/> [dostęp: 8.08.2024]. Natomiast autorce były zgłaszane przez środowisko polskich historyków sztuki problemy z publikacjami artykułów naukowych zawierających wierne reprodukcje dzieł sztuki, szczególnie w niemieckich czasopismach, jeśli autor artykułu nie przedłożył umowy zawartej z fotografem (jego zgody) takiej zwykłej fotografii reprodukcyjnej.

<sup>39</sup> Por. pkt I w: *Comment of the European Copyright Society...*

<sup>40</sup> Zakres swobody tego typu działań może być ograniczony z uwagi na nieograniczone w czasie autorskie prawa osobiste (prawo do integralności, rzetelnego wykorzystania czy nadzoru nad sposobem korzystania z utworu).

<sup>41</sup> K. Grzybczyk, *O czym chciałby przeczytać profesor Ryszard Markiewicz*, ZNUJ PPWI 2023, z. 2(160), s. 37 i nn.

<sup>42</sup> Ustawa z dnia 26 lipca 2024 r. o zmianie ustawy o prawie autorskim i prawach pokrewnych, ustawy o ochronie baz danych oraz ustawy o zbiorowym zarządzaniu prawami autorskimi i prawami pokrewnymi (Dz. U. poz. 1254); [https://orka.sejm.gov.pl/opinie10.nsf/nazwa/406\\_u/\\$file/406\\_u.pdf](https://orka.sejm.gov.pl/opinie10.nsf/nazwa/406_u/$file/406_u.pdf) [dostęp: 8.08.2024].

<sup>43</sup> Por. R. Markiewicz, *Prawo autorskie...*, s. 136.

dyrektywy DSM do ustawy o muzeach<sup>44</sup>, aby uniemożliwić nadużywanie nieuprawnionej ochrony autorskoprawnej przy udostępnianiu wizerunku muzealiów.

Jak zauważył J. Zajadło: „Lord Mansfield nie dostrzegł z pewnością problemu, który dzisiaj określamy powszechnie mianem domeny publicznej (*public domain*)”<sup>45</sup> i dlatego orzeczenie w sprawie *Millar v. Taylor* (1769) zostało szybko przełamane w 5 lat później wydanym rozstrzygnięciu w sprawie *Donaldson v. Becket* (1774), jednak jak słusznie zauważa przywołany autor – „po roku 1774 narodziła się domena publiczna”<sup>46</sup>.

Lord Mansfield, który był admiratorem sztuki, zapewne z zadowoleniem przyjąłby regulację z art. 14 dyrektywy DSM, która pozwoliłaby mu cieszyć się reprodukcjami utworów plastycznych starych mistrzów<sup>47</sup>.

#### 4. Prawa wydawców w XXI w.

Trzecie zagadnienie, które co prawda najkrócej będzie tu wzmiankowane, dotyczy sytuacji autorskoprawnej wydawców. Na początku lat 90. ubiegłego wieku w UE<sup>48</sup>, a w 2000 r.<sup>49</sup> w prawie polskim zostały przyjęte dwa prawa pokrewne określane jako prawa pokrewne wydawców. Pierwsze z nich to tzw. prawo do pierwszych wydań (*editio princeps*, do wydań pośmiertnych), które wprowadziło ochronę na rzecz wydawców (szeroko rozumianych) wcześniej niepublikowanych utworów będących w domenie publicznej. O ile w czasach Lorda Mansfielda to prawo miałooby zapewne większe znaczenie, to uchwalone w przededniu rewolucji cyfrowej, jako swoista zachęta do inwestycji wydawniczych w utwory, których ochrona wygasła, raczej jest spóźnione, i jak pokazuje praktyka, raczej wyczerpało swój skromny potencjał. Można też się zastanawiać w kontekście roli, jaką teraz odgrywa art. 14 dyrektywy DSM, czy prawo do pierwszych wydań w obecnych realiach społeczno-gospodarczo-cyfrowych nie blokuje zanadto domeny publicznej.

Drugie prawo, dotyczące tzw. wydań krytycznych i naukowych utworów, w stosunku do których wygasła ochrona praw autorskich, od początku budziło w praktyce wątpliwości co do zakresu ochrony – relacji do tradycyjnej ochrony autorskoprawnej.

<sup>44</sup> Por. szersze stanowisko Katedry Prawa Własności Intelktualnej WPiA UJ z dnia 30 września 2020 r., uwagi dotyczące art. 14 przygotowane przez S. Stanisławską-Kloc, s. 13–14, <https://ipwi.uj.edu.pl/documents/122195199/151128292/Konsultacje+publiczne+dotycz%C4%85ce+wdro%C5%BCenia+najnowszych+dyrektyw+UE+w+zakresie+prawa+autorskiego+%5B2020%5D/03021537-f9a1-40a5-bff2-54c5233913ba> [dostęp: 8.08.2024] oraz uwagę R. Markiewicza, *Prawo autorskie...*, s. 136.

<sup>45</sup> J. Zajadło, *Lord Mansfield...*, s. 45.

<sup>46</sup> *Ibidem*, s. 51. Zob. też J.C. Ginsburg, 'Une Chose Publique'? *The Author's Domain and the Public Domain in Early British, French and US Copyright Law*, „Cambridge Law Review” 2006, vol. 65, s. 636 i nn.

<sup>47</sup> Por. E. Rosati, *DSM Directive Series #3: How far does Article 14 go?*, April 2019, <https://ipkitten.blogspot.com/2019/04/dsm-directive-series-3-how-far-does.html> [dostęp: 8.08.2024].

<sup>48</sup> Por. art. 4 i 5 dyrektywy 93/98/EWG.

<sup>49</sup> Artykuł 99<sup>1</sup>–99<sup>5</sup> ustawy z dnia 9 czerwca 2000 r. o zmianie ustawy o prawie autorskim i prawach pokrewnych (Dz. U. Nr 53, poz. 637).



Kilka miesięcy temu skierowano do Trybunału Sprawiedliwości UE pytanie prejudycjalne<sup>50</sup>, które odnosi się do tej kwestii. Co więcej, niektórzy komentatorzy w rzeczywistości upatrują w tej nowej interesującej sprawie istotniejszej kwestii dotyczącej statusu utworów zależnych w ramach praw autorskich w UE<sup>51</sup>. Moim zdaniem sprawa ta może dać impuls do harmonizacji autorskich praw zależnych w Unii. Niewątpliwie opinia rzecznika generalnego (jeśli będzie) i samo rozstrzygnięcie będą szeroko komentowane oraz mogą wpłynąć na wyznaczenie nowych granic prawa autorskiego oraz praw pokrewnych.

Trzecie, najnowsze, tj. XXI-wieczne, prawo wydawców, o które toczyli i w pewnym sensie nadal toczą batalię wydawcy, to przyjęte w art. 15 dyrektywy DSM z 2019 r. prawo pokrewne wydawców prasy. Było ono i jest przedmiotem licznych analiz (w tym istotnie krytycznych), zarówno na etapie kształtowania jego treści w UE<sup>52</sup>, jak i podczas krajowych implementacji oraz potem, już w czasie jego stosowania. Prawo to przewiduje bardzo krótką ochronę (tylko 2-letnią od daty opublikowania) w zakresie zwielokrotniania i publicznego udostępniania<sup>53</sup>, jednak o istotnych konsekwencjach dla swobody przepływu informacji i interesów autorów. Ustawodawca unijny przewidział nietypowe (w porównaniu do dotychczasowych praw pokrewnych), ale potrzebne ograniczenia przedmiotu ochrony (w zakresie: pojedynczych słów lub bardzo krótkich fragmentów publikacji prasowej, jak i linkowania). Nowe prawo podlega ograniczeniom na podstawie przepisów o dozwolonym użytku osobistym oraz publicznym. Najwięcej problemów wywołuje ustalenie wysokości należnego wydawcom wynagrodzenia oraz realizacja postanowienia z ust. 5 art. 15 dyrektywy DSM, przewidującego wypłatę dla twórców (w tym dziennikarzy) odpowiedniej części przychodów uzyskiwanych przez wydawców prasy z tytułu korzystania z ich publikacji prasowych przez dostawców usług społeczeństwa informacyjnego. Jest to zatem nowe prawo pokrewne wydawców, ale używając pewnej metafory prawnorzeczowej, można powiedzieć, że jest obciążone swoistą „służebnością” na rzecz twórców (tym samym ci twórcy użytkiwaliby swoiste dodatkowe „ograniczone prawo pokrewne”).

<sup>50</sup> Wniosek z dnia 31 października 2023 r., sprawa C-649/23, Institutul G. Călinescu (C/2024/1389). Pytanie prejudycjalne: „Czy przepisy art. 2 lit. a) dyrektywy 2001/29/WE (1) należy interpretować w ten sposób, że wydanie krytyczne utworu, którego celem jest ustalenie tekstu utworu pierwotnego poprzez zapoznanie się z rękopisem i które jest opatrzone komentarzami i niezbędnym aparatem krytycznym, może zostać uznane za utwór chroniony prawem autorskim?”; <https://curia.europa.eu/juris/liste.jsf?num=C-649/23&language=en> [dostęp: 8.08.2024].

<sup>51</sup> Por. E. Rosati, *When is a derivative work original and thus protectable by copyright? Classicist's critical edition makes its way to Luxembourg in fresh Romanian CJEU referral*, January 2024, <https://ipkitten.blogspot.com/2024/01/when-is-derivative-work-original-and.html> [dostęp: 8.08.2024].

<sup>52</sup> Por. przykładowo krytyczną opinię European Copyright Society – *Opinion on the Proposed Press Publishers Right*, April 2018, [https://europeancopyrightsociety.org/wp-content/uploads/2018/06/2018\\_european-copyright-societypiniononpresspublishersright.pdf](https://europeancopyrightsociety.org/wp-content/uploads/2018/06/2018_european-copyright-societypiniononpresspublishersright.pdf) [dostęp: 8.08.2024], a także R. Markiewicz, *Prawo autorskie...*, s. 137 i nn.

<sup>53</sup> Por. E. Rosati, *Copyright in the Digital Single Market...*, s. 250–294 (komentarz do art. 15); R. Markiewicz, *Prawo autorskie...*, s. 137–194.

Polska jako ostatni kraj UE w lipcu 2024 r. w związku z implementacją dyrektywy DSM do prawa polskiego przyjęła to nowe prawo wydawców<sup>54</sup>, które od początku prac legislacyjnych (konsultacji społecznych) wywoływało, delikatnie to ujmując, ogromne zainteresowanie w środowisku wydawców, twórców i dostawców usług; do ostatniego momentu ważyły się jego losy. Na etapie prac w Senacie RP zostały przyjęte nowe rozwiązania dotyczące procedury wypłaty wynagrodzenia należnego autorom (w tym procedury z udziałem prezesa Urzędu Komunikacji Elektronicznej) – losy tej procedury i wysokość wynagrodzenia niebawem będą rozstrzygane na wokandach sądowych.

\* \* \*

Lord Mansfield w XXI w. z pewnością byłby zadowolony z powołania w wielu krajach wyspecjalizowanych sądów rozstrzygających sprawy z zakresu praw własności intelektualnej<sup>55</sup>. Z zainteresowaniem przysłuchiwałby się dyskusji dotyczącej relacji pomiędzy wolnością prasy a prawem autorskim<sup>56</sup>.

Jak sztuczna inteligencja ocenia twórczość Lorda Mansfielda, o tym możemy się przekonać, wpisując jego nazwisko w ChatGPT<sup>57</sup>; jak W. Murray odniósłby się do AI, tego niestety się nie dowiemy. Można tylko mieć nadzieję, że *judicial philosophy* oraz

<sup>54</sup> Por. art. 99<sup>12</sup>; 99<sup>15</sup> ustawy z dnia 26 lipca 2024 r. o zmianie ustawy o prawie autorskim i prawach pokrewnych, ustawy o ochronie baz danych oraz ustawy o zbiorowym zarządzaniu prawami autorskimi i prawami pokrewnymi (Dz. U. poz. 1254).

<sup>55</sup> W Polsce sądy te (pięć wydziałów sądów okręgowych i dwa apelacyjne) zaczęły funkcjonować w dniu 1 lipca 2020 r. na podstawie art. 479<sup>89</sup> i 479<sup>129</sup> ustawy z dnia 13 lutego 2020 r. o zmianie ustawy – Kodeks postępowania cywilnego oraz niektórych innych ustaw (Dz. U. poz. 288), która wprowadziła rozdział IVg – „Postępowanie w sprawach własności intelektualnej”, a także na podstawie rozporządzenia Ministra Sprawiedliwości z dnia 29 czerwca 2020 r. w sprawie przekazania niektórym sądom okręgowym rozpoznawania spraw własności intelektualnej z właściwości innych sądów okręgowych (Dz. U. poz. 1152). Zob. też interesującą nową formułę rozstrzygania mniejszych sporów autorsko-prawnych w USA – Copyright Small Claims (o wartości sporu do 30 tys. dolarów), <https://www.copyright.gov/about/small-claims/> [dostęp: 8.08.2024].

<sup>56</sup> Por. np. M. Rose, *The Public Sphere and the Emergence of Copyright: Areopagitica, the Stationers' Company, and the Statute of Anne* [w:] *Privilege and Property. Essays on the History of Copyright*, eds. R. Deazley, M. Kretschmer, L. Bently, 2010, <https://books.openedition.org/obp/1046> [dostęp: 8.08.2024], s. 82; por. też wyrok TSUE z dnia 29 lipca 2019 r. w sprawie C-516/17 (Spiegel on-line) oraz V. Kraetzig, *Censorious Copyright*, ZNUJ PPWI 2024, z. 2(164), s. 23 i nn.

<sup>57</sup> Interesujące jest to, że ChatGPT dosyć dobrze w ogólnym zarysie przedstawia sylwetkę W. Murrraya, uwzględniła tło historyczne prawa autorskiego w czasach Lorda Mansfielda, jego wkład w rozwój tego prawa i wpływ długoterminowy, a w podsumowaniu możemy przeczytać: „Choć Lord Mansfield nie stworzył bezpośrednio przepisów dotyczących prawa autorskiego, jego orzecznictwo, szczególnie w sprawach dotyczących praw własności i kontraktów, miało istotny wpływ na rozwój tej dziedziny prawa w Wielkiej Brytanii. Jego interpretacja praw własności, w tym własności intelektualnej, oraz jego podejście do sprawiedliwości i dobrej wiary w umowach położyły fundamenty pod dalszy rozwój praw autorskich w XIX w. i później”. Natomiast na temat współczesnych autoroskoprawnych problemów ChatGPT por. R. Markiewicz, *ChatGPT i prawo autorskie Unii Europejskiej*, ZNUJ PPWI 2023, z. 2(160), s. 142 i nn.



intuicja prawnicza Lorda Mansfielda będą inspirować sędziów i przedstawicieli doktryny prawa autorskiego, aby tak jak przed 250 laty, tak i teraz w XXI w. zasady prawa autorskiego wpływały „from the fountain of justice”.

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## Streszczenie

*Sybilla Stanisławska-Kloc*

### Lord Mansfield i prawo autorskie w XXI w.

Lord Mansfield – William Murray był znanym XVIII-wiecznym angielskim prawnikiem i fascynującą postacią. Był zaangażowany w dwa najstarsze i najważniejsze spory autorskoprawne w Anglii (*landmark decision*). Właśnie w tym roku mija 250. rocznica wydania wyroku w sprawie *Donaldson v. Becket* (1774), co miało decydujące znaczenie dla ustalenia czasu trwania ochrony autorskich praw majątkowych po uchwaleniu Statutu królowej Anny z 1709 r. W artykule krótko przedstawiono ten wyrok i okoliczności jego wydania. W dalszej części poddano analizie trzy następujące zagadnienia: 1) czas trwania autorskich praw majątkowych, 2) domena publiczna oraz 3) prawa wydawców; każde z nich w pewnym sensie ma związek ze sprawą *Donaldson v. Becket*, ale ujawnia też nowe oblicze prawa autorskiego w XXI w., m.in. w związku z dyrektywą 2019/790 (DSM).

**Słowa kluczowe:** Lord Mansfield, William Murray, *Donaldson v. Becket*, prawo autorskie, DSM, prawa wydawców prasy, domena publiczna, czas trwania ochrony autorskich praw majątkowych.

## Summary

*Sybilla Stanisławska-Kloc*

### Lord Mansfield and Copyright Law in the Twenty-First Century

William Murray, Lord Mansfield, was a well-known eighteenth-century English jurist and a fascinating personality. He was involved in two of the oldest and most important copyright disputes in England (his was a landmark decision). This year is the 250th anniversary of the *Donaldson v. Becket* judgment (1774), which was crucial in determining the duration of copyright protection following the enactment of the Queen Anne Statute of 1709. In this article, the judgment and the circumstances of its delivery are briefly outlined. The following topics are discussed: 1) the duration of copyright protection; 2) the public domain; and 3) (press) publishers' rights. All these are related to the *Donaldson v. Becket* case, but they also demonstrate the new face of copyright law in the twenty-first century, including features connected with EU Directive 2019/17 (the Digital Single Market).

**Keywords:** Lord Mansfield, William Murray, *Donaldson v. Becket*, copyright, DSM, publisher rights, the public domain, copyright duration.

**Małgorzata Węgrzak**

University of Gdańsk, Poland  
malgorzata.wegrzak@ug.edu.pl  
ORCID: 0000-0003-2956-3117

**Concepción Saiz García**

University of Valencia, Spain  
concepcion.saiz@uv.es  
ORCID: 0000-0002-1893-2143

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# Intellectual Property Challenges for Works Created by Generative Artificial Intelligence Systems from a Spanish Perspective

## 1. Introductory remarks

The pace of progress in the field of artificial intelligence (AI) in general, and generative artificial intelligence (GenAI) in particular, is immense. GenAI, including large language models such as ChatGPT and image generation software, are powerful new tools, but they also raise profound, cutting-edge questions about how data is used in AI models and how the law applies to the outputs of these models, such as a paragraph of text or a computer-generated image. In just a few years, we have moved from a GenAI that depends on human programming to one that is almost completely independent, with results that are almost independent of human creative activity required by copyright law. At this point, it should be emphasized that AI does not possess intelligence but only imitates it, implementing an elaborate algorithm created by a programmer. Furthermore, thought processes determined by human intelligence cannot be covered by a uniform standardization of actions. Thus, it would rather be appropriate to define AI as the trained ability of algorithms to artificially replicate advanced cognitive systems, as human action is commonly considered, resulting from the ability to correctly interpret data from external sources, learn from it, and use this knowledge to perform specific tasks and achieve goals through flexible adaptation.

The operation of AI is based on analysing information obtained as input and then identifying rules and patterns based on machine learning in order to achieve the goals and results programmed for it. The predominant definition of AI implicitly designates the term intelligence as the human variety. AI is therefore understood to be a technical solution (by default, a computer programme), performing activities which are usually the domain of humans, specifically those requiring the use of human intellect.<sup>1</sup> Copyright in a computer product should also not be granted to the creator of AI, as

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<sup>1</sup> T. Zalewski, *Definition of Artificial Intelligence* [in:] *Legal and technical aspects of Artificial Intelligence*, eds. L. Lai, M. Świerczyński, Warsaw 2017, pp. 9–23.

the programmer's effort here is essentially limited to the creation of the computer programme itself, and his or her influence on the creation of the object created by the programme is minimal. In other words, the view that it is the user who can be considered the creator of computer-generated creations is difficult to defend due to the lack of intervention by that person in the creation process sufficient to satisfy the requirement of creative contribution, as AI-generated creations are created without influence and independently of human action.

Questions arise as to what generative AI is and what distinguishes it from other AI models, as to what kind of output can be created by a generative AI model, and how much human input is required, as well as the importance of training data and whether the output imitates the input. It is also necessary to consider whether current intellectual property law applies to generative AI models and whether it adequately protects the rights of human innovators and creators.

It has to be noted that in the first phase of development, AI produced artistic and literary results formally very much determined by the information implemented by the programmer, and this still allowed existing copyright rules to be stretched to find solutions. Currently, in the era of ChatGPT it seems that the rope cannot be stretched any farther. The practically accessory and formally irrelevant character of human participation in the results generated by generative AI makes it impossible to protect those results in this way. The human-centred, or anthropocentric, foundation of copyright, typical of civil-law system countries, as well as the progressive understanding of copyright as a suitable instrument to protect and promote the creative interest of human beings through motivation and, incidentally, to guarantee the progressive enrichment of our cultural heritage, is not present when it comes to results generation which is not the result of human ingenuity.<sup>2</sup> Algorithms, in contrast to human creators, lack consciousness and emotions that could be influenced by the protection afforded through exclusive rights to the outcomes of their creative processes. Nevertheless, a fundamental question persists, much as it did a decade ago: Is it necessary to protect these results in any manner? The current legal debates primarily revolve around the acquisition of extensive datasets used to train these systems, many of which consist of pre-existing works. However, the absence of protection for the results produced introduces ambiguity into the solutions offered by the market.

Given all this, in the following sections of this article, the evolution of these productive AI systems will be analysed from a copyright law perspective, and then the challenges that currently arise will be outlined using selected examples from case law.

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<sup>2</sup> For a complete overview of the history of copyright law, see: J. Marco Molia, *Bases históricas y filosóficas y precedentes legislativos del Derecho de autor*, "Anuario de Derecho Civil" 1994, vol. 47, nº 1, pp. 121–208.

## 2. The evolution of AI in the area of creativity in phases

The evolution of creations in the field of art and literature through the use of AI tools can be divided into three phases, although, on the one hand, these phases do not coincide exactly with the stages of the technological development of artificial neural networks<sup>3</sup> and, on the other hand, the fact that the phases can be associated with specific works need not be interpreted in a strict sense. We have chosen them simply because they are the most emblematic and representative from each point in time.

The first phase of generative AI is characterized by human control of the results. In this phase, humans used software as a tool for their creativity (AlaaT),<sup>4</sup> whether to translate a text or to paint a picture,<sup>5</sup> etc. In this stage of machine learning, AI as we currently comprehend it did not yet exist. AI was described as the ability of the machine to behave like the human brain with the same reasoning, learning and, in this case, creative capabilities. At this time (about the 1980s) neural networks capable of learning on their own already existed; nonetheless no deep learning was recognized.<sup>6</sup> The machine's behaviour, although potentially partly unpredictable, had been shaped by the data and the "artisanal" learning process to which it had been subjected. This implies a true collaboration between the programmer (acting as an artist) and the machine, with human input being important in the context of copyright.

The second phase of the evolution is the moment when the results of the project "The Next Rembrandt" (2016) were made public. This landmark project aimed to produce a painting that could perfectly well have been painted by Rembrandt if he were still alive today. By using deep learning algorithms and facial recognition software, the programmers were able to recognise the habitual patterns of the painter. One programme replicated the artist's techniques, while another analyzed dimensions, proportions, structure, and arrangement of facial features in various portraits. The topographies and reliefs of the paintings were scrutinized to prepare a file suitable for 3D printing and then, the state-of-the-art 3D printing machine replicated the appearance of an oil painting, mimicking the artist's style. For the development of the project, the team used deep learning algorithms, i.e. algorithms that use deeper (more layered) neural networks, rather than decision trees as machine learning does, so that the system learns by itself.<sup>7</sup>

In the light of the challenges posed by this project, with regard to the protection not only of the results obtained, but also of the methodologies and algorithms

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<sup>3</sup> *Breve Historia de las Redes Neuronales Artificiales. Aprende Machine Learning*, <https://www.aprendemachinelearning.com/breve-historia-de-las-redes-neuronales-artificiales/> [accessed: 2023.08.15].

<sup>4</sup> This is an acronym for what is known as *Artificial Intelligence as a Tool* [C. Saiz García].

<sup>5</sup> As did Aaron, the painting robot of Harold Cohen, a well-known British artist who spent much of his life training Aaron's software; <https://theconversation.com/aaron-vida-y-obra-de-la-primera-inteligencia-artificial-creativa-192281> [accessed: 2023.10.12].

<sup>6</sup> *Breve Historia de las Redes...*

<sup>7</sup> <https://d3.harvard.edu/platform-digit/submission/the-next-rembrandt/> [accessed: 2023.04.13].

developed to produce them, academic legal doctrine began to publish the first studies on the possibility of protecting these results under copyright law.<sup>8</sup> The European Commission also noted the need for European IP offices and users to examine these issues, “in order to promote innovation and legal certainty in the field of intellectual property.”<sup>9</sup> It can certainly be said that this project represents one of the milestones in the development of GenAI in the field of intellectual property. In general, experts did not consider such possible solutions from a scenario in which GenAI systems would be fully autonomous.<sup>10</sup> Instead, they assumed that GenAI systems had no place within the current copyright regime. In the case of more progressive doctrines, some attempted to apply the existing legal framework to new issues. In the case of the most far-reaching doctrine, the first proposals were made before the arrival of the third phase. Under these doctrines, an author’s work is regarded as a product of individual genius, which justifies the copyright protection within the existing copyright system.<sup>11</sup> In relation to the attribution of the ownership of an exclusive right, although the collective work scheme is not contemplated in all the legislations within the EU or, if it is contemplated, it is not regulated in the same way, nonetheless, this rule of attribution of copyright was presented with certain adjustments, in this second phase, as adequate to resolve the issue of a large part of the results derived from large creative projects in which AI systems are involved. However, in order to be able to apply this attribution rule, it is first necessary to be able to qualify the result as an original work, which presupposes having considered the degree of human participation of a creative nature relevant

<sup>8</sup> See: A. Guadamuz, *La inteligencia artificial y el derecho de autor*, “OMPI revista” 2017, nº 5, [https://www.wipo.int/wipo\\_magazine/es/2017/05/article\\_0003.html](https://www.wipo.int/wipo_magazine/es/2017/05/article_0003.html) [accessed: 2023.08.13]; A. Ramalho, *Will robots rule the (artistic) world? A proposed model for the legal status of creations by artificial intelligence systems*, 2017, [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2987757](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2987757) [accessed: 2023.04.14]; L. Bentley, *The UK provisions on computer generated works: A solution for AI creations?*, <https://europeancopyrightsociety.org/wp-content/uploads/2018/06/lionel-the-uk-provisions-on-computer-generated-works.pdf> [accessed: 2023.11.13]; J. Ginsburg, *People not machines: Authorship and what it means in the Bern Convention*, “IIC-International Review of Intellectual Property and Competition Law” 2018, no. 49, pp. 131–135; S. Navas Navarro, *Obras generadas por algoritmos, en torno a su posible protección*, “Revista de Derecho Civil” 2018, vol. 5, nº 2, pp. 273–292; C. Saiz García, *Obras creadas por sistemas de inteligencia artificial y su protección por el derecho de autor*, “In Dret – Revista para el Análisis del Derecho” 2019, nº 1; N. Sanjuan Rodríguez, *Inteligencia artificial y Propiedad Intelectual*, “Actualidad Jurídica Uría Menéndez” 2019, nº 52, pp. 82–94, <https://www.uria.com/documentos/publicaciones/6675/documento/foro04.pdf?id=8960&forceDownload=true> [accessed: 2023.04.13]; P. Lanteri, *La problemática de la IA y el Derecho de autor llama a la puerta de OMPI* [in:] *Cuadernos jurídicos del Instituto de Derecho de Autor – 15 aniversario*, ed. Á. Díez Alfonso, Madrid 2020, pp. 351–376; M. Duque Lizarralde, *Las obras creadas por inteligencia artificial: un nuevo reto para la Propiedad Intelectual*, “Pe. i.: Revista de propiedad intelectual” 2020, nº 64, pp. 13–67.

<sup>9</sup> Communication from the Commission to the European Parliament, the European Council, the Council, the European Economic and Social Committee and the Committee of the Regions, *Artificial Intelligence for Europe*, (SWD(2018) 137).

<sup>10</sup> See: S. Navas Navarro, *Obras generadas...*

<sup>11</sup> C. Saiz García, *Obras creadas...*, p. 38; IVIR & JIIP, *Trends and Developments in Artificial Intelligence: Challenges to the Intellectual Property Rights Framework*, Final Report for the European Commission, Brussels 2020, p. 8.



to these effects. The core issue is not entirely new to copyright law, nor is it limited to the point where copyright intersects with AI. It is a question of delimiting the quality and quantity of participation required from a natural person in the creative process of a work in order for that person to receive the legal consideration of co-author (when we are talking about collaborative works regulated by art. 7 TRLPI – Real Decreto Legislativo 1/1996<sup>12</sup> – Phase 1, and as happened in the Barceló case, which was resolved by the Court of Appeal of Mallorca on 22 January 2008)<sup>13</sup> or in order that the result receive legal qualification of a work when human and non-human factors are involved in collaboration to produce it (in our case an AI system).

Moreover, it is crucial to remember that the element of originality required by European national legislations must be interpreted in a subjective manner, i.e., it is sufficient that the work reflects the personality of its author, i.e., that the author “has been able to express his creative ability by making free and creative decisions.”<sup>14</sup> This implies the existence of a margin of creative freedom, not limited by technical or other conditioning factors.<sup>15</sup> The second requirement is to be precisely and objectively defined.<sup>16</sup>

In this technological state, AI learns autonomously, not solely relying on what programmers instruct. Therefore, determining whether copyright protection applies to one of these outcomes hinges on whether the involvement attributed to the human party goes beyond merely technical, organizational, or insignificant participation. It must involve a contribution through free and creative decision-making, ensuring that the result is objectively what it is, and not something else. The assessment must be carried out in the same way as for works of plural authorship whether in collaboration (art. 7 TRLPI) or in collective work (art. 8 TRLPI)<sup>17</sup> – when the creative activity of different authors is structured throughout the process, with one person taking control, directing, coordinating the project through the modification, adjustment, repetition, selection, etc. of each of the elements, original or not, that will compose the final work. Nonetheless, in situations where both individuals and algorithms contribute to the autonomous and creative decision-making process, the human intervention involved must be such that it guarantees not only the originality of the work but also the originality of the ultimate outcome. Otherwise, it cannot be considered original,

<sup>12</sup> Royal Decree 1/1996, of 12 April 1996, approving the revised text of the Intellectual Property Law, regularising, clarifying and harmonising the legal provisions in force on the matter (TRLPI).

<sup>13</sup> The “Barceló Case” is one of the landmarks judgments in Spain that respond to the problem of authorship [M. Węgrzak]. See more: R. Casas Valles, *La condición de autor: los casos Barceló y Boadella*, “Pe.i.: Revista de propiedad intelectual” 2008, n° 28, pp. 127–142.

<sup>14</sup> CJEU of 11 December 2011, Case C-145/10, “Eva-Maria Painer”, marg. (89).

<sup>15</sup> CJEU of 12 September 2019, Case 638/17, “Cofemel” and, in Spain, STS of 16 February 2021, “faena taurine.”

<sup>16</sup> CJEU (Grand Chamber) of 13 November 2018, Case C-310/17, “Levola Hengelo”; STS of 16 February 2021, “faena taurine.”

<sup>17</sup> See: Royal Decree 1/1996, of 12 April 1996, which approves the revised text of the Intellectual Property Law, regularising, clarifying, and harmonising the legal provisions in force on the subject, “BOE” No. 97, 22.04.1996.

and as it does not meet all the requirements of the legal concept of a work, thus, the protection of copyright does not arise. It is a different matter if, in the face of an alleged infringement, it can be demonstrated that the part used without authorization belongs to the author and not to the machine.<sup>18</sup> It is one thing to admit that a result is original for the purpose of predicating its protection by copyright, and another is to determine whether there has been an infringement. In the evaluation of the latter question, originality is used as a parameter to measure the content protected by the exclusive right.

In the case of “The Next Rembrandt,” the human factor delimited the artistic genre, the author on which the painting was to be based, the works that were to feed the learning algorithms that were also created, as well as the facial recognition software programmes that were to be used for the purpose of creating a work (irrespective of the author’s name). They also directed both its operation and the elements that were to determine the result (selection/choice of data with which to feed its learning – supervised or unsupervised). Further, the appearance of the partial results was modified (art. 11 TRLPI) or the software was reprogrammed and discarded, and the results were reworked along the way (art. 12 TRLPI) until the definitive result was achieved.

This is normally contained in the contract binding the definitive result to the company. If it is an employment contract, as in our case, it will be by way of art. 51 TRLPI; if it is a simple work lease, that will have to be expressly agreed. In order to comply with the requirements of art. 26.2 of Royal Decree 281/2003.<sup>19</sup> According to art. 26.2 of Royal Decree 281/2003: “The registration shall contain: the number of the registration record; the title of the work, performance or production; the subject matter of the intellectual property; the kind of work, performance or production with the specific description or identification data contained in the registration application; the identification data of the author or the original owner; the rights to be registered, their extent and conditions, if any; the owner of the economic rights with his identification data; if any, the title containing the right being registered, its date and the court, tribunal or notary who, if any, authorises it; the place, date, hour and minute of filing of the application for registration, the entry number assigned to it and the date from which the registration takes effect.”

From the project’s inception to its execution and post-production, the involvement of the human party is formally integrated into the expression of the outcome. Consequently, without the human factor, the result would yield a distinct outcome. This outcome is eligible for copyright protection. It is important to note that in the event of modifying a pre-existing work owned by a particular individual involved in the project, obtaining the relevant rights assignment is essential. This information should be incorporated into the formal documentation presenting the project’s outcome. If it

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<sup>18</sup> See: C. Saiz García, *Objeto y sujeto del derecho de autor*, Valencia 2000.

<sup>19</sup> Royal Decree 611/2023, of July 11, which approves the Regulations of the Intellectual Property Registry (art. 26.2 RRGPI), “BOE” No. 97, 22.04.1996.

is a labour contract, as in the case analyzed, it is by way of art. 51 TRLPI; if it is a simple work lease, it must be expressly agreed on.

However, in other cases, the presence of the human factor may not exceed this threshold, and the AI system generates the literary or artistic result autonomously, and thus that result is not subject to copyright protection. This is the case for most of the results created by generative AI tools; nevertheless, it should be borne in mind that free and creative decision-making on the part of the author may take place at various points in the creative process, including the post-production phase.<sup>20</sup> In the later stage, when applied to a protected work from another property, permission (for a derivative work) is necessary. Consequently, any creative process can be divided into two distinct phases: conception and performance. The conception starts with an idea, and ideas, as is well-known, are not protected by copyright. Once the execution phase commences, involving action to implement the project, that project might have evolved to a point where, contingent on the creative genre, there is minimal room (creative freedom margin) for the performer's independent decisions. In such cases, it does not matter whether a machine is responsible for the execution of the whole, because the result can only be attributed to the person who developed the detailed concept, whether it is one person or several people. On the contrary, the more human involvement there is in the process and the more the machine determines the formal elements of the final product, the more likely it is that the result will fail to meet the legal threshold for copyright protection.

The transition to the third phase was facilitated by advancements in cloud computing and the arrival of generative AI based on natural language. This enables users to prompt the system to produce a specific result matching their requirements. The AI system is presented to the user, whether the user be a company or an individual, as a content generation tool. Importantly, users are spared the necessity of investing in programming and fine-tuning the system, a service commonly referred to as AI as a Service (AlaaS).<sup>21</sup> If you asked DALL E (from OpenAI) to make an image of “a kiwi-shaped house with an open roof in a snowy landscape” it probably will generate the image without our reiterating the request (which is irrelevant for assessing originality) or employing editing tools (a relevant consideration, as derivative works may be produced). To receive these images, it is not necessary to be actively engaged in feeding or programming the system with data, as it is pre-fed with data, often comprised of protected works. Instead, the generation process is autonomously managed by the system. These indications receive the technical name of prompt and the prompt is the only thing that the human being can do throughout the whole “creative” process of generating the result. Certainly, once generated, there is the option to work on and modify the output. However, engaging in this post-production activity is neither obligatory nor necessary; it is merely possible. As previously mentioned, such

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<sup>20</sup> CJEU of 11 December 2011, Case C-145/10, “Eva-Maria Painer”, marg. (90–94).

<sup>21</sup> The AI system is offered to the user as a tool to generate content, without the user having to invest in programming and setting it up: AlaaS [C. Saiz García]; IVIR & JIIP, *Trends and Developments...*, p. 28.

modifications would subject the work to the legal framework governing derivative works (art. 11 TRLPI<sup>22</sup>).

It is remarkable that generative AI systems with these attributes extend beyond the realm of the visual arts, encompassing various artistic and literary genres. The rapid proliferation and continual refinement of these tools pose a challenge for those interested in staying abreast of developments in this domain. However, as far as copyright law is concerned, there are no major differences, as far as their functioning is concerned, between one application and another. Each of these applications, in reaching their current state, undergoes extensive training with vast amounts of information translated into data. They extract patterns through statistical induction processes, and their decisions are made through probabilistic calculations.<sup>23</sup> Despite their widespread impact on society, neither the EU<sup>24</sup> nor Spain has yet formulated a mature regulatory solution for these outcomes.<sup>25</sup> This is currently covered by the European Parliament's resolution of 20 October 2020 on intellectual property rights in relation to the development of technologies related to AI, and more recently, on 9 May 2023, by art. 28b. 4 of the proposed Artificial Intelligence Act, which imposes a number of obligations on these types of systems regarding their design and transparency, among others, in relation to one of the main problems that arise with these tools, that is when the data used to train them is protected in general and in particular by copyright.<sup>26</sup> The European Parliament resolution mentioned above was issued within a context where AI as a Service (AlaaS), specifically in the field of intellectual property rights, had not been conclusively demonstrated. After reiterating that in situations where AI serves merely as a tool to assist the author in the creative process (AlaAT), the resolution urged the Commission to diligently analyze the technology's impact on intellectual property rights. This analysis is crucial before Europe establishes a position, including considerations on the protection of autonomously generated results (paragraph 18).

Therefore, according to the position of the European Parliament, it is first necessary to assess whether some of these results can be considered as works created by means of AI systems (AlaAT) on the basis of the usual criteria set out in the explanation of Phase 2, taking into account the differences that characterise the new creative context created by AlaaS. The evaluation involves not just the degree of human involvement in the creative process leading to artistic or literary outcomes but also the quality of those outcomes, specifically whether they fulfill the criteria outlined by the Court of Justice

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<sup>22</sup> Royal Decree 611/2023, of July 11, which approves the Regulations of the Intellectual Property Registry, "BOE" No. 97, 22.04.1996.

<sup>23</sup> N. Rodríguez Ortega, *Inteligencia artificial y campo del arte*, Malaga 2020.

<sup>24</sup> European Parliament Resolution of 20 October 2020, on Intellectual Property Rights for the development of technologies relating to artificial intelligence, P9 TA(2020)0277.

<sup>25</sup> Digital Agenda 2025, p. 38, [https://portal.mineco.gob.es/RecursosArticulo/mineco/prensa/ficheros/noticias/2018/Agenda\\_Digital\\_2025.pdf](https://portal.mineco.gob.es/RecursosArticulo/mineco/prensa/ficheros/noticias/2018/Agenda_Digital_2025.pdf) [accessed: 2023.04.13].

<sup>26</sup> [https://www.europarl.europa.eu/meetdocs/2014\\_2019/plmrep/COMMITTEES/CJ40/DV/2023/05-11/ConsolidatedCA\\_IMCOLIBE\\_AI\\_ACT\\_EN.pdf](https://www.europarl.europa.eu/meetdocs/2014_2019/plmrep/COMMITTEES/CJ40/DV/2023/05-11/ConsolidatedCA_IMCOLIBE_AI_ACT_EN.pdf) [accessed: 2023.04.13].

of the European Union (CJEU) for establishing copyright protection. When considering this inquiry in the area of GenAI, one must ask whether the text inputted by a user into the system holds relevance for these purposes. The prompts, inherently, can be classified within the “concept” phase of the creative process. Conversely, the machine algorithm, in response to such prompts, retains the liberty to make independent creative decisions, determining the specific forms of the results.

In principle, applying the theory of (controlled) conception and execution, if the prompt is sufficiently detailed so as to constrain the machine’s activity to the point of limiting its margin of creative freedom, the prompt, if original, determines the result and it should generally be possible to state that, in such cases, human originality transcends machine originality, and the user can be attributed copyright over it. If, on the other hand, human involvement remains in the realm of mere ideas, the conclusion should be the opposite, and it should be considered that these results are absolutely autonomous and, therefore, not susceptible to copyright protection.

In support of this, reference can be made to the judgment of the CJEU of 16 June 2009, which permitted the possibility of originality of a passage consisting of eleven words. However, it should be noted that this conclusion refers to an unauthorised partial reproduction of another’s work, and not to whether eleven words (although most prompts have more words) are sufficient to confer originality on a work, of whatever nature, made entirely by a machine.<sup>27</sup> It should be remembered that art. 10.2 TRLP<sup>28</sup> protects the title of a work when it is original, “as part of it,” which would seem to exclude its protection when the work it gives a title to is not original. This argument is perfectly transferable to works generated by an AI system on the basis of prompts, especially those whose form of expression cannot be precisely defined by language, such as painting, video, or music. However, that argument would have to be excluded *a priori* in those cases where the result shares an expressive form with the prompt. Theoretically, this issue is once more a matter to be determined on a case-by-case basis.

Nevertheless, the practical implementation of all AI systems involves a character limit and it is recommended for the system’s optimal performance to keep prompts as concise and clear as possible. Consequently, in practice, the likelihood of encountering original results in the third phase is considerably lower than one might initially assume. The situation may differ if, after obtaining a non-protectable result, the user subjects it to a post-production process. As already mentioned, in these cases, it will be necessary to apply the legal regime of derivative works, with the added problem that, unlike those that transform other previous works, even those that have already entered the public domain, it will be very difficult to prove which part of the work is due to the automatic operation of the machine (not original) and which part is due to human activity.

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<sup>27</sup> Paragraphs 44 to 47, CJEU of 16 June 2009, Case C-5/08, “Infopaq.”

<sup>28</sup> Royal Decree 611/2023, of July 11, which approves the Regulations of the Intellectual Property Registry, “BOE” No. 97, 22.04.1996.

In the absence of precision in this regard, on the one hand, it is very likely, as is currently the case, that the registration of a machine-generated work in the Intellectual Property Register will be rejected on the grounds of incompatibility with art. 26(2) RRLPI.<sup>29</sup> On the other hand, legal certainty is a key principle in the CJEU's interpretation of the autonomous concept of „work,“ as outlined by the Grand Chamber in its judgment of 13 November 2018 (32). The court stated that for a result to be considered original, it must “necessarily be an expression of the subject matter of copyright, identifiable with sufficient precision and objectivity, even if that expression is not necessarily permanent.” Thus, it is likely that the courts will functionally extend this interpretation to these cases and also refuse its protection.<sup>30</sup> In this ruling, the CJEU compares the taste of a food to literary, artistic, or scientific works, noting that the latter, unlike taste, provide a clear and objective expression of the subject matter being protected (paragraph 42).

### 3. The current situation and legal challenges

Various questions persist regarding these types of AI productions discussed above; such questions include exploring the possibility or necessity of alternative outcomes. In particular the concept of rights related to copyright, but distinct in their basis of protection from the personalist position, should be considered. However, the analysis of this concept reveals important differences between such rights that make it necessary to favour drawing a parallel with the basis of the neighbouring right of the creator of a non-original photograph or a reproduction that is the result of a process similar to that involved with AI (art. 128 TRLPI).<sup>31</sup> This, though, would require an appropriate legislative response addressing the literary and artistic outputs generated by AI systems. Such a potential reform should be of international or at least regional scope, without being an issue to be resolved internally in each country.<sup>32</sup>

In addition, one of the relevant concerns has to do with the vast amount of data with which AI systems are programmed. Phase 1 and 2 models (known as “narrow models”) were trained to perform a single task. They were fed with specific data to focus them on the target they were aimed at. However, the algorithm of phase 3 models (known as “base models”), in addition to being trained with a huge amount and variety of data, has the ability to transfer knowledge from one task to another. As such,

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<sup>29</sup> The anonymized decisions of the Madrid IP Registry can be consulted at the following link: <https://alternativaseconomicas.coop/trabajo-inteligencia-artificial/chatgpt-pone-en-pie-de-guerra-a-las-profesiones-qualifications> [accessed: 2023.09.20].

<sup>30</sup> CJEU (Grand Chamber) of 13 November 2018, Case C-310/17, “Levola Hengelo”, ECLI:EU:C:2018:899, paragraph 40.

<sup>31</sup> Royal Decree 1/1996, of April 12 1996, approving the revised text of the Intellectual Property Law, regularizing, clarifying and harmonizing the legal provisions in force on the subject; <https://www.boe.es/buscar/act.php?id=BOE-A-1996-8930&tn=1&p=20220330> [accessed: 2023.09.20].

<sup>32</sup> See more: C. Saiz García, *Obras creadas...*, p. 30.

such a model can be trained once and then adapted to perform completely different tasks.<sup>33</sup> Base models or baseline models are used to train AI applications grounded in natural language processing (NLP) and natural language generation (NLG), allowing companies/users to save a huge amount of money on training their own machine learning model in the cloud and focus their efforts on tuning it to perform specific tasks.<sup>34</sup> Examples of baseline models include those of OpenAI, Google, or Bloom, developed by the Hugging Face platform. Some examples of generative AI applications that use pre-trained data are GPT in various versions, DALL E, BERT, etc. All of them are constantly learning and improving from their experiences, using a feedback process.<sup>35</sup>

In general, for data processing to occur, a copy of the data must be made to train the model.<sup>36</sup> The main problem revolves around the nature of this action: Does accessing, reading, analyzing, and extracting data, particularly when it involves protected works or their components, for processing purposes constitute a breach of copyright, specifically the right of reproduction? The right of reproduction, as articulated in paragraphs 21 of Directive 2001/29/EC,<sup>37</sup> requires a broad interpretation to provide authors with substantial protection, ensuring adequate compensation for the use of their works and enabling them to sustain their artistic and creative work.<sup>38</sup> Conversely, considering that many of these works have been included in a data repository with the authors' consent, one may ask whether such consent legitimizes their use for training AI tools, essentially authorizing the text and data mining required for this training purpose.<sup>39</sup> AI systems are not mystical black boxes that operate outside the law. The path to responsible AI lies in ensuring fairness and ethical considerations for all users. Emerging doubts and controversies have and will continue to lead to lawsuits, and case law might assist in answering these questions.

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<sup>33</sup> <https://www.techopedia.com/definition/34826/foundation-model> [accessed: 2023.10.10].

<sup>34</sup> For example, Stable Diffusion uses a LAION dataset, a structured dataset of more than 5 billion, not of images per se, but of its CLIP, created by a model created by OpenAI – VIT-L/14 [C. Saiz García], <https://laion.ai/blog/laion-aesthetics/> [accessed: 2023.10.23], for Bloom see: <https://www.techopedia.com/definition/34826/foundation-model> [accessed: 2023.10.23].

<sup>35</sup> For example, Dall E 2 can, through deep learning, identify individual objects and understand the relationship between them, which makes the tool very interesting when relating naturally unrelated objects, e.g. a sofa with a watermelon; an astronaut and a horse, etc., to provide a result tailored to the user's demand [C. Saiz García].

<sup>36</sup> <https://hipertextual.com/2023/02/getty-demanda-ia-stable-diffusion-derechos-autor> [accessed: 2023.10.23].

<sup>37</sup> 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, Official Journal L 167, 22.06.2001, P. 0010–0019.

<sup>38</sup> Paragraphs 9 to 11 Directive 2001/29, CJEU of 16 July 2009, Case C-05/08, “Infopaq”, ECLI:EU:C:2009:465, Nos. 40 and 41.

<sup>39</sup> V. Jiménez Serranía, *Data, mining and innovation: Quo vadis Europa? Analysis of the new exceptions for text and data mining*, “Cuadernos de Derecho Transnacional” 2020, vol. 12, nº 1; A. Guadamuz, *Artist file class-action lawsuit against Stability AI, DeviantArt, and Midjourney*, TechnoLlama, January 2023, <https://www.technollama.co.uk/artists-file-class-action-lawsuit-against-stability-ai-deviantart-and-midjourney> [accessed: 2023.10.23].



#### 4. Selected case law on GenAI in the context of copyright infringements

The majority of Generative AI lawsuits focus on the use of data, with the first US class-action case specifically addressing AI system training and output. GitHub, Microsoft, and Open AI face legal scrutiny over whether open-source code can be reproduced without licenses by AI. The lawsuit alleges copyright infringement, claiming that the development of GitHub Copilot, a coding assistant utilizing AI, constitutes “software piracy on an unprecedented scale.” Although it is in the early stages, the case has potentially far-reaching implications for copyright law in the realm of generative AI. This underscores the necessity for responsible and ethical AI practices, emphasizing that AI systems, like any innovation, must adhere to the law. Copilot, which was presented by Microsoft-owned GitHub in June 2021, was trained on repositories of code collected from the public web, many of which are published under licences that require the copyright of programmer-creators to be respected. Notably, Copilot has been identified as using substantial segments of licensed code without attribution to the original authors.<sup>40</sup>

Furthermore, several visual artists have filed a lawsuit against the companies that created image generators Stable Diffusion, Midjourney, and DreamUp (all of which generate images based on text prompts from users), claiming that the first two browsed the Internet in order to copy millions of works without the consent of the rights holders, including the works of the plaintiffs.<sup>41</sup> They argue that all generated images are derivative works and are protected by copyright law and that their works were reproduced in order to train the systems. Consequently, all the works generated by these tools are their derivative works, and, in fact, not only theirs, but also those of the five billion rights holders whose works were used to train the system.<sup>42</sup> The companies behind these image generators programmers argue that their use of this data is covered by the fair use doctrine in the USA. However, in light of the facts of the case, this is very highly questionable. In a separate lawsuit, Getty Images sued Stable Diffusion for copyright infringement, claiming that all of the images generated by Stable Diffusion were derivative works, and some even contained a trace of Getty’s watermark.<sup>43</sup>

In addition, there are now complaints from other professionals, for example, in the media sector. Recently, the Association of the Media of Information (AMI, formerly AEDE) has called on big technology companies (such as Google and Microsoft) to

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<sup>40</sup> <https://www.theverge.com/2022/11/8/23446821/microsoft-openai-github-copilot-class-action-lawsuit-ai-copyright-violation-training-data> [accessed: 2023.10.12].

<sup>41</sup> The procedure can be followed at the following link: <https://www.courtlistener.com/docket/66732129/parties/andersen-v-stability-ai-ltd/> [accessed: 2023.10.12].

<sup>42</sup> A. Guadamuz, *Artist file class-action...*

<sup>43</sup> <https://www.theverge.com/2023/1/17/23558516/ai-art-copyright-stable-diffusion-getty-images-lawsuit> [accessed: 2023.10.22]; <https://www.theverge.com/2022/11/8/23446821/microsoft-openai-github-copilot-class-action-lawsuit-ai-copyright-violation-training-data> [accessed: 2023.10.22].

negotiate how to pay for the use made of their news by these tools.<sup>44</sup> This demand is reminiscent of the AEDE canon or Google tax, which led to the closure of Google News in Spain for eight years, following the reform of the Intellectual Property Law in 2014.<sup>45</sup>

One of the most important decisions in this field is that of 15 March 2023 in which the U.S.<sup>46</sup> Copyright Office announced that works created with the assistance of AI may be copyrightable, provided the work involves sufficient human authorship. According to the policy statement, works created by AI without human intervention or involvement still cannot be copyrighted, as they fail to meet the human authorship requirement. For example, when an AI programme produces a complex written, visual, or musical work in response to a prompt from a human, the “traditional elements of authorship” are determined and executed by the technology, not by the human user. Thus, the resulting work is not copyrightable. On the other hand, a work containing AI-generated material may be copyrightable where there is sufficient human authorship, such as when a human selects or arranges AI-generated material in a creative way or modifies material originally generated by AI technology.

Here it is also worth considering a landmark court ruling in China, a country that has regulated GenAI.<sup>47</sup> A Beijing court, for the time being in a first-instance ruling, decided that creators of works involving AI contributions are eligible for copyright protection. The court ruled that the plaintiff, who created AI-generated images uploaded to an online platform, holds copyright. It emphasized that AI-generated images reflecting human creators’ original intellectual input qualify for copyright protection, meeting the criteria of originality and reflecting human intellectual contribution. As a result, the court recognized the graphics in question as copyrighted works.<sup>48</sup>

Given the potential for original works, eligible for copyright protection, to be created through generative AI systems such as Open AI’s ChatGPT, Microsoft Bing, Google Bart, etc., several challenges may arise when an author seeks to register such a work with the Intellectual Property Registry. Firstly, it is important to highlight that in Spain, registering a work in the Intellectual Property Register is both optional and declaratory. This registration provides the author with a probative advantage, but even if the Register refuses the application, the work can still be regarded and treated in the

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<sup>44</sup> [https://www.eldiario.es/tecnologia/creadores-canon-aede-quieren-tasa-chatgpt-inteligencia-artificial\\_1\\_10171676.html](https://www.eldiario.es/tecnologia/creadores-canon-aede-quieren-tasa-chatgpt-inteligencia-artificial_1_10171676.html) [accessed: 2023.10.22].

<sup>45</sup> C. Saiz García, *El retorno de Google News*, “Diario La Ley” 2021, n° 9963.

<sup>46</sup> <https://www.ropesgray.com/en/insights/alerts/2023/03/can-works-created-with-ai-be-copyrighted-copyright-office-issues-formal-guidance>; <https://githubcopilotlitigation.com/> [accessed: 2023.10.22].

<sup>47</sup> It is worth emphasizing that China has adopted the world’s first binding national regulations on AI. In particular, in 2023 the Interim Measures for the Management of Generative Artificial Intelligence Services covered a broad range of topics related to creating and delivering generative AI services [M. Węgrzak]. See more: <https://digichina.stanford.edu/work/how-will-chinas-generative-ai-regulations-shape-the-future-a-digichina-f> [accessed: 2023.10.22].

<sup>48</sup> <https://www.scmp.com/tech/tech-trends/article/3243570/beijing-courts-ruling-ai-generated-content-can-be-covered-copyright-eschews-us-stand-far-reaching> [accessed: 2023.12.09].

market as an original piece. In the event of conflicts, the matter of the work's originality can still be brought before the courts.

In view of the above, it has to be noted that two applications have been refused in Spain. One application involved a "literary work" with a text partially generated by ChatGPT, while the second concerned a series of images covering various themes generated by these systems. In both cases, the registrar scrutinized the applicant's contribution to the generation of images and texts to assess whether, according to prevailing legal and jurisprudential criteria, this participation implies intellectual authorship. The operation of the AI system ChatGPT cannot be described as a "mere tool" for the Intellectual Property Registry. The reason for this is that even if there are major contributions by the applicant, it is clear that a part of the final result, embodied in the copy, was generated randomly and unpredictably by the AI system.

For the images, which were obtained by the applicant using an AI tool and core prompts for generation, it was concluded that there was no significant human involvement. The applicant's participation consisted in supplying verbally, through natural language, a series of input instructions (prompts) within an AI system (Midjourney and Dreamstudio), in such a way that the AI system itself autonomously and unpredictably generated the images. Therefore, the result of the process does not respond to a previous conception or personal execution by the person who provided the instructions, but rather it was the system itself which, based on these instructions, determined the final form of expression (images, strokes, colours, and other visual elements).

These circumstances make it clear that the above-mentioned requirement of human creation and originality is not present in the images, since the result does not reflect the "personality" of the applicant, nor has the applicant had the opportunity to take "free and creative decisions." In this sense, the fact that the applicant has provided primary verbal input instructions (core prompts) and that the system itself has some functionalities that allow the user to choose certain parameters (such as the style or final touches), is not sufficient to consider that he has "authored" the final result.

In the case involving a text, the Register notes that despite the fact that ChatGPT was not used as a "mere tool," and as part of the final result was generated randomly and unpredictably by that system, some of the applicant's contributions may give rise to copyright in relation to the final result. The obstacle to entry in the Register is constituted by the requirements of the law including those in art. 26(2) RRGPI<sup>49</sup>. This is because the applicant's specific contribution to the overall result cannot be adequately identified. Consequently, the application for inscription was rejected<sup>50</sup>). This is because the specific participation of the applicant in the overall result cannot be adequately identified. Consequently, the application for inscription was rejected.<sup>51</sup>

<sup>49</sup> Royal Decree 281/2003, of 7 March 2003, approving the Regulations of the General Registry of Intellectual Property (RRGPI).

<sup>50</sup> Royal Decree 611/2023, of July 11, which approves the Regulations of the Intellectual Property Registry.

<sup>51</sup> <https://www.monosetocasticos.com/p/por-que-el-registro-de-la-propiedad> [accessed: 2023.10.02].

## Conclusions

The popularization of creations created with AI makes it clear that programmes equipped with skills that their creators do not necessarily possess themselves are capable of generating works of a creative nature. Whether AI productions are subject to copyright protection and, if so, whether AI can be recognized as their creator, remains controversial. The evolution of AI in creativity is set out in three phases marked by technological advances. The diminishing role of human intervention in the creative process is observed and unlike human creators, algorithms lack awareness or influence, undermining the need for copyright protection. Ongoing legal discourse focuses on ownership and data protection, and market solutions can cause confusion. The changing landscape prompts a reassessment of the adequacy of copyright law to protect the rights of creators and maintain the human-centric foundation of copyright law, which is absent in the outcomes generated by AI. Non-acceptance of AI-generated works is the current legal state of affairs. Many things may change in the future, from the rights of authors whose works have been used to train these systems to the rights of those of us who generate text, images, and (soon) videos with them.

The contemporary challenges posed by GenAI are multifaceted and require careful consideration. The rapid evolution of these AI systems, such as ChatGPT, introduces legal and ethical dilemmas that the current intellectual property framework may not adequately address. AI's autonomy in generating creative works raises questions about copyright eligibility and the recognition of AI as a creator. The blurred line between human and machine contributions adds to the complexity of determining copyright ownership.

Moreover, the lack of a specific legal or regulatory framework tailored to the unique aspects of generative AI results in uncertainty about protection and liability. As AI systems become more sophisticated, issues related to data ownership, algorithm transparency, and potential misuse of AI-generated content require urgent attention. Emerging lawsuits illustrate existing problems, but they may also provide some insights into the gaps in the legal and regulatory framework for generative AI. Thus, the legal area surrounding generative AI requires in-depth consideration to find a balance between supporting innovation and an evolution that we can no longer restrain, on one hand, and ensuring the protection of creators' rights, on the other. The Artificial Intelligence Act which is still being processed in Europe, including setting a consistent definition of AI, can give direction and help solve the problems mentioned above.

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## Summary

**Małgorzata Węgrzak, Concepción Saiz García**

### Intellectual Property Challenges for Works Created by Generative Artificial Intelligence Systems from a Spanish Perspective

The rapid development of artificial intelligence (AI), particularly in the field of generative artificial intelligence (GenAI), raises complex questions about data use and copyright protection. This article explores the significant transition from AI models relying on human influence to achieving near-complete autonomy, presenting formidable challenges to existing copyright laws. As AI-generated creations gain widespread use, debates about copyright eligibility and the recognition of AI as a creator emerge. This article also argues against granting copyright to AI creators because their products lack human influence. The nature of GenAI is discussed, distinguishing

it from other AI models, assessing the extent of human input required and questioning the application of current intellectual property laws.

The article also follows the evolution of AI in creativity, outlining three phases marked by technological advances. The diminishing role of human intervention in the creative process is highlighted, a diminution particularly evident in contemporary models such as ChatGPT. Unlike human creators, algorithms lack awareness and influence, undermining the need for copyright protection. Ongoing legal discourse focuses on ownership and data protection, and market solutions can cause confusion. The changing landscape prompts a reassessment of the adequacy of copyright law to protect the rights of creators and maintain the human-centric foundation of copyright law, a foundation that is absent in the outcomes generated by AI. The article additionally considers recent case law that could potentially offer insights into addressing the legal issues at hand. In conclusion, the article emphasizes ongoing questions regarding the necessity of protecting AI-generated outcomes and the difficulties these outcomes present within the existing legal framework, as seen from a Spanish perspective.

**Keywords:** copyright, generative artificial intelligence, IP law and artificial intelligence, ChatGPT, TRLPI – Real Decreto Legislativo 1/1996.

## Streszczenie

*Małgorzata Węgrzak, Concepción Saiz García*

### **Wyzwania związane z prawami własności intelektualnej do wytworów generatywnej sztucznej inteligencji – perspektywa hiszpańska**

Gwałtowny rozwój sztucznej inteligencji (SI), zwłaszcza generatywnej, rodzi liczne pytania dotyczące wykorzystania danych, a także ochrony praw autorskich. W artykule podjęto rozważania na temat związanych z tym wyzwań prawnych z perspektywy prawa hiszpańskiego, jak również przeprowadzono analizę rozwoju modeli sztucznej inteligencji, począwszy od tych, w których widoczny jest wyraźnie wpływ człowieka, aż do wytworów praktycznie w pełni autonomicznych. Należy ponadto zauważyć, że wraz z rosnącą popularnością dzieł generowanych przez sztuczną inteligencję rodzą się kontrowersje dotyczące przyznawania sztucznej inteligencji praw autorskich jako twórcy. Autorki podnoszą argumenty opowiadające się przeciwko przyznaniu praw autorskich SI, głównie ze względu na fakt, że wytwory te są pozbawione przejawu działalności twórczej człowieka. Ponadto analizują rozwój SI w obszarze tworzenia, identyfikując trzy fazy w zależności od postępu technologicznego. W artykule podkreślono także malejącą rolę oddziaływania człowieka na proces twórczy, szczególnie widoczną w nowoczesnych modelach, takich jak ChatGPT. W przeciwieństwie do istot ludzkich algorytmom brakuje świadomości i wpływu, co czyni bezpodstawną samą potrzebę ochrony praw autorskich. W opracowaniu przedstawiono również najnowsze orzecznictwo sądowe, które bez wątpienia będzie wpływać na rozumienie obowiązujących norm z zakresu prawa własności intelektualnej oraz wpłynie na rozwiązanie omawianych kwestii prawnych

W podsumowaniu autorki formułują wnioski, wskazując w szczególności, że zmieniająca się rzeczywistość wymaga ponownej oceny aktualności prawa autorskiego w kontekście wytworów generowanych przez SI i ochrony praw twórców. Zwracają również uwagę na trudno-

ści z zakwalifikowaniem wytworów generowanych przez SI w istniejących ramach prawnych, przedstawiając omawiane zagadnienia z perspektywy prawa hiszpańskiego.

**Słowa kluczowe:** prawo autorskie, generatywna sztuczna inteligencja, prawo własności intelektualnej i sztuczna inteligencja, ChatGPT, TRLPI – Real Decreto Legislativo 1/1996.



**Claudia S. Quiñones Vilá**

Luiss Guido Carli, Italy

claudia.quinones.vila@gmail.com

ORCID: 0000-0001-9238-6227

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## Contemporary Approaches to IP Protection: Developments in the US Art Market

### Introduction

Since the beginning of the COVID-19 pandemic in 2020, rapid technological changes have prompted challenges to the traditional interpretation of intellectual property (IP) rights, as regulators and lawmakers struggle to keep pace with ongoing developments. Multiple lawsuits have been filed involving new technologies, bringing these controversies to the fore. For instance, Google was involved in three separate cases involving fair use and copyright in the past decade alone.<sup>1</sup> The simultaneous expansion of the art market<sup>2</sup> has provided an opportunity to see how these challenges play out in real time, particularly with respect to non-fungible tokens (NFTs) and works created using artificial intelligence (AI).

In the United States (US), IP rights with respect to copyright and patents stem from the Constitution.<sup>3</sup> Trademarks are governed by state law and the federal Lanham Act.<sup>4</sup> It is important to note that the US takes a utilitarian approach to IP, seeking to balance innovation with protection for authors. Judicial precedent, established through case law, is another source of rights in this field. In particular, courts have been instrumental in analyzing the scope of fair use in copyright and establishing an element known as transformativeness, which is unique to the US legal system. They have also provided guidance on the likelihood of confusion and fair use in the trademark context. This article will examine recent art market-related developments involving IP rights to

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<sup>1</sup> *Authors Guild, Inc. v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015); *Google LLC v. Oracle America, Inc.*, 593 U.S. \_\_\_\_ (2021); *ML Genius Holdings LLC v. Google LLC*, Case No. 20-3113 (2d Cir. Mar. 10, 2022).

<sup>2</sup> Valued at \$67.8 billion in 2022, with the US alone accounting for a 45% share of the global market (\$30.2 billion). C. McAndrew, *The Art Market Report 2023*, Art Basel & UBS, p. 17, <https://www.ubs.com/global/en/our-firm/art/collecting/art-market-survey.html> [accessed: 2024.07.10].

<sup>3</sup> Art. I, Sec. 8, Clause 8 grants Congress the 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.”

<sup>4</sup> Pub. L. 79-489 (1946), codified at 15 U.S.C. § 1051 *et seq.*

chart the ongoing evolution of this field and what protections apply to works using new technologies, beginning with copyright and concluding with trademarks.

## 1. Recent developments in US copyright law

The federal Copyright Act<sup>5</sup> is the main law in this field and holds that copyright vests in the author of an original work fixed in a tangible medium of expression from the moment of its creation.<sup>6</sup> Registration is not a prerequisite for copyright protection generally, but it can serve as evidence of the when the work was created and the identity of the author to third parties. However, registration is required to file suit with respect to the underlying work (e.g. infringement claims). The US Copyright Office (USCO) is a government agency tasked with registering copyrights and applying the Copyright Act. While not a member of the judiciary, its decisions are given great weight by courts in IP matters. A certificate of registration from the USCO is considered *prima facie* evidence of the validity of the underlying copyright.<sup>7</sup>

### 1.1. Elements of fair use

The Copyright Act allows limitations on an author's exclusive rights if the use in question is considered fair use. This means that the copyrighted work is used "for purposes such as criticism, comment, news reporting, teaching, scholarship, or research."<sup>8</sup> While considered a defense against copyright infringement, there is no uniform decision of what constitutes fair use. Determinations are made on a case-by-case basis, considering all the relevant facts and circumstances. The Copyright Act establishes the following factors to be used by courts when determining fair use: 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.<sup>9</sup>

Although other countries have similar exceptions to copyright infringement, typically related to non-profit or educational activities<sup>10</sup>, federal courts apply the

<sup>5</sup> Pub. L. 94-553 (1976), codified at 17 U.S.C. § 101 *et seq.*

<sup>6</sup> 17 U.S.C. § 102(a) and 201(a).

<sup>7</sup> 17 U.S.C. § 410(c).

<sup>8</sup> 17 U.S.C. § 107.

<sup>9</sup> *Ibid.*

<sup>10</sup> For instance, there is no fair use doctrine in France but Art. L-122-5 of the Intellectual Property Code lists exceptions to an author's exclusive right to reproduce their work. These consist of private and gratuitous performances carried out within the family circle; parody, pastiche and caricature; and copies intended exclusively for private use. Works may be disseminated for purposes of press and news reporting or political, judicial, or academic gatherings meant to inform the public, but the author must always be credited.

concept of transformativeness to their fair use analysis of potentially infringing works. If a work demonstrates a new element or message that sufficiently distinguishes it from the original, it will be considered fair use: “New ideas, new expression, new information and new arts and creations further the [Constitutional] public policy that calls for new speech, new contributions to the dialogue, fresh thoughts, and new approaches to art and literature that are protected to ensure a free exchange of ideas. Copied, repeated, and republished artworks and expressions do not satisfy these goals of the originality doctrine in copyright.”<sup>11</sup> The US Supreme Court (SCOTUS) originally adopted the transformative test in 1994, where it stated that a secondary work is considered transformative if it “adds something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message.”<sup>12</sup> Since then, transformativeness has been at the core of fair use cases.

## 1.2. Transformativeness and art law

Transformativeness is often applied to appropriation art, which involves “the intentional borrowing, copying, and alteration of existing images and objects.”<sup>13</sup> Contemporary appropriation artist Jeff Koons was accused of copyright infringement by photographer Art Rogers after Koons made a sculpture based on one of Rogers’ photographs.<sup>14</sup> Koons argued that his work was fair use on the grounds of parody, but the court found that the two works were “substantially similar” and the copying was “blatantly apparent.” In other words, “Koons used the identical expression of the idea that Rogers created” and did not add any new elements or commentary as criticism of the original, which is required for parody. Since the work was done “in bad faith, primarily for profit-making motives,” it did not fall within the scope of fair use.<sup>15</sup> Notably, other works in the same series were also found to be infringing.<sup>16</sup>

Two decades later, artist Richard Prince managed to succeed in an infringement claim by demonstrating that his works presented a new aesthetic style, and a general observer would be able to distinguish between them and the originals. Unlike Koons, Prince modified the photographs by enlarging, blurring or sharpening them, adding elements and creating composites.<sup>17</sup> Following this ruling, courts implemented a flexible interpretation of fair use, essentially holding that stylistic changes were

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<sup>11</sup> M. Murray, *Copyright Transformative Fair Use after Andy Warhol Foundation v. Goldsmith*, “Wake Forest Intellectual Property Law Journal” 2023, vol. 24, no. 2, pp. 4–5.

<sup>12</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) at 579.

<sup>13</sup> <https://www.moma.org/collection/terms/pop-art/appropriation> [accessed: 2024.07.10].

<sup>14</sup> *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

<sup>15</sup> *Ibid.* at 307–310.

<sup>16</sup> In 2021, the Paris Court of Appeals upheld a judgment against Koons for copyright infringement involving a sculpture based on an advertisement for clothing retailer Naf Naf. E. Kinsella, *A French Appeals Court Has Found Jeff Koons Guilty of Copyright Infringement Again – and Hiked Up His Fines*, Artnet News, 2021, <https://news.artnet.com/art-world/appeals-court-upholds-jeff-koons-copyright-infringement-1946573> [accessed: 2024.07.10].

<sup>17</sup> *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013).

sufficient to demonstrate transformativeness. However, a finding of fair use is heavily informed by the context in which the works were created; an artist that previously succeeded in meeting the transformativeness standard may later fail to do so. In May 2023, two lawsuits against Prince on the grounds of infringement were allowed to proceed to trial on the grounds that the artist did not provide sufficient evidence to support a fair use defense. The judge found that the relevant works – consisting of large-scale screenshots of third parties' Instagram posts, with short comments by Prince underneath – “indeed tested the boundary between appropriation art and copyright infringement.”<sup>18</sup>

### 1.3. The Goldsmith case

In May 2023, SCOTUS issued a ruling on the limits of fair use and transformativeness. In *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith et al.*,<sup>19</sup> SCOTUS held that a silkscreen print of musician Prince created by Andy Warhol based on a photograph by Lynn Goldsmith did not constitute fair use. Goldsmith had taken the photograph in 1981 and subsequently licensed it to *Vanity Fair* magazine. The license approved the one-time use of the photograph as a reference for an illustration by Warhol, to accompany an article on the musician. The article and illustration were published in 1984. However, Warhol created 15 additional copies of the resulting illustration without notifying Goldsmith or asking for her authorization. In 2016, when Condé Nast (*Vanity Fair's* parent company) licensed one of the additional copies for a retrospective issue on Prince, Goldsmith became aware of the unauthorized copies and alerted the Andy Warhol Foundation (AWF)<sup>20</sup> that this was copyright infringement. The AWF sought a declaratory judgment supporting fair use.

In an unexpected turn of events, SCOTUS sided with Goldsmith rather than the AWF. It held that because the work had the same essential purpose as the original (to illustrate a magazine story about Prince) and the use was commercial in nature, fair use did not apply. The print also lacked transformativeness since changes in comparison with the original were minor and did not imbue it with “a fundamentally different and new artistic purpose or character.” Simply changing a work from one medium to another is insufficient to qualify for fair use.<sup>21</sup> This is consistent with earlier decisions by federal courts, which focus on changes in the function and purpose of the new work rather than changes to content, meaning, or expression.<sup>22</sup> It is important to note that the court limited its holding to the work before it and did not overhaul the entire body

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<sup>18</sup> S. Cascone, *A Judge Has Greenlit Two Lawsuits Against Appropriation Artist Richard Prince from Photographers Who Say He Stole Their Work*, Artnet News, 2023, <https://news.artnet.com/art-world/richard-prince-instagram-fair-use-lawsuit-to-proceed-2301826> [accessed: 2024.07.10].

<sup>19</sup> Case No. 21-869, 598 U.S. \_\_\_\_ (2023).

<sup>20</sup> The AWF holds the official copyright in Warhol's works, ceded by the artist upon his death.

<sup>21</sup> *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith et al.*, 11 F.4th 26, 39-39 & 42 (2d Cir. 2021).

<sup>22</sup> M. Murray, *Copyright Transformative Fair...*, p. 9.

of law interpreting transformativeness. However, it does appear that in the future, artists will need to demonstrate a higher degree of change from an original work to successfully raise a defense to copyright infringement.

#### 1.4. AI machine learning and fair use

AI systems are now capable of using machine learning to train themselves on existing works and generate outputs based on this input. AI-generated art involves analyzing artworks based on different artistic styles and then mimicking these styles to produce new works.<sup>23</sup> Generative AI models can also receive a text prompt from a human author and produce complex visual works in response. The practice of “scraping,” which pulls images and text from across the internet to train AI models, is now at the forefront of the fair use debate.<sup>24</sup> The works being scraped are often protected by copyright, but the authors have not been asked for their authorization or offered compensation for this use. Many times, they are not even aware that their work is being used for this purpose until they see derivative works shared online. This is not limited to artists; the Authors Guild sent an open letter to several AI companies to request credit and fair compensation for the use of their copyrighted works in training generative AI systems.<sup>25</sup>

A group of visual artists filed a class action lawsuit against Stability A.I. in January 2023 to stop the company from scraping copyrighted artwork.<sup>26</sup> The complaint states that this is unlawful infringement, as: “Defendants are using copies of the training images [...] to generate digital images and other output that are derived exclusively from the Training Images [sic], and that add nothing new.”<sup>27</sup> Furthermore, the claimants allege that by allowing the AI systems to generate art in the style of particular artists, defendants are “siphoning commissions from the artists themselves” and devaluing and diluting the original works. In other words, the AI-generated works are usurping the market for human artistic creations. Claimants are seeking monetary damages as well as permanent injunctive relief to require that the AI image generator training models be modified and exclude copyrighted work.

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<sup>23</sup> C. Dee, *Examining Copyright Protection of AI-Generated Art*, “Delphi – Interdisciplinary Review of Emerging Technologies” 2018, no. 1, p. 32.

<sup>24</sup> E. Maiberg, *An AI Scraping Tool Is Overwhelming Websites with Traffic*, Vice, 2023, <https://www.vice.com/en/article/dy3vmx/an-ai-scraping-tool-is-overwhelming-websites-with-traffic> [accessed: 2024.07.10].

<sup>25</sup> W. Bedingfield, *The Generative AI Battle Has a Fundamental Flaw*, Wired, 2023 <https://www.wired.co.uk/artificial-intelligence-copyright-law?verso=true> [accessed: 2024.07.10].

<sup>26</sup> *Andersen v. Stability AI Ltd.*, Case No. 23-00201 (N.D. Cal. Jan. 13, 2023); E. Feldman, *Are A.I. Image Generators Violating Copyright Laws?*, Smithsonian Magazine, 2023, <https://www.smithsonianmag.com/smart-news/are-ai-image-generators-stealing-from-artists-180981488/> [accessed: 2024.07.10].

<sup>27</sup> M. Chen, *A Scientist Has Filed Suit Against the U.S. Copyright Office, Arguing His A.I.-Generated Art Should be Granted Protections*, Artnet News, 2023, <https://news.artnet.com/art-world/class-action-lawsuit-ai-generators-deviantart-midjourney-stable-diffusion-2246770> [accessed: 2024.07.10].

In response, defendants have claimed that this is fair use and “[t]o the extent that A.I.s are learning like people, it’s sort of the same thing and if the images come out differently then it seems like it’s fine.”<sup>28</sup> This indicates that the companies believe training AI systems falls within the scope of fair use because it is either for an educational purpose or because the output is transformative. However, this interpretation is contrary to long-standing copyright case law. First, it is well-established that works by machine learning technology do not qualify for copyright protection unless there has been significant participation by a human author. The US has a staunchly anthropocentric view of copyright (discussed in further detail below).<sup>29</sup> Second, under *Goldsmith*, commercial use of an appropriated artwork weighs heavily against a finding of fair use. The educational fair use exception was envisaged to apply in a more traditional scholarly setting, not in a for-profit business setting. While commerciality by itself is not dispositive, when combined with the use of a work to achieve a purpose highly similar or the same to the original, and which is likely to “supplant” the market for the original, the use cannot be considered fair.<sup>30</sup> Third, merely creating works in the style of an established artist is not transformative. An AI-generated work will need to demonstrate significant changes in content, context, function, and purpose to qualify for transformative fair use.<sup>31</sup> Fourth, the claimants have demonstrated that AI is encroaching on their livelihoods and affecting the market for their work.

Comedian Sarah Silverman filed a lawsuit against OpenAI and Meta for copyright infringement on these grounds in July 2023, further bringing the issue to the public’s attention.<sup>32</sup> It is highly probable more cases will follow in coming years, given the millions of images being used to train AI systems. These lawsuits are “challenging the very limits of copyright”<sup>33</sup> and the way in which technology and the law intersect. However, some elements of copyright remain firm, such as the requisite of human authorship for copyright protection. This is discussed in the following section.

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<sup>28</sup> E. Feldman, *Are A.I. Image Generators Violating...*

<sup>29</sup> P. Zurth, *Artificial Creativity? A Case against Copyright Protection for AI-Generated Works*, “UCLA Journal of Law & Technology” 2021, no. 25, pp. 2–3. By contrast, other countries such as the United Kingdom protect purely “computer generated works,” awarding copyright to the programmer. *Ibid.*, p. 3.

<sup>30</sup> M. Murray, *Copyright Transformative Fair...*, pp. 8–10.

<sup>31</sup> *Ibid.*, p. 19.

<sup>32</sup> *Silverman et al. v. OpenAI*, Case No. 3:23-cv-03416 (N.D. Cal. July 7, 2023).

<sup>33</sup> W. Davis, *Sarah Silverman is suing Open AI and Meta for copyright infringement*, The Verge, 2023, <https://www.theverge.com/2023/7/9/23788741/sarah-silverman-openai-meta-chatgpt-llama-copyright-infringement-chatbots-artificial-intelligence-ai> [accessed: 2024.07.10]; J. Vincent, *The scary truth about AI copyright is nobody knows what will happen next*, The Verge, 2022, <https://www.theverge.com/23444685/generative-ai-copyright-infringement-legal-fair-use-training-data> [accessed: 2024.07.10].

## 2. Copyright protection for AI works

AI artwork has gained mainstream popularity, prompting various challenges to existing interpretation of copyright law by both the USCO and judicial courts. The two cases presented below demonstrate the contemporary approach to copyright in the AI context, and what is required for protection.

### 2.2. Dr. Stephen Thaler's a recent entrance to paradise

#### 2.2.1. USCO registration attempts

Dr. Stephen Thaler is a computer scientist and founder of Imagination Engines Incorporated who develops advanced artificial neural network technology (i.e. AI systems) to create AI-generated artworks. Thaler used one of his AI systems, referred to as a "Creativity Machine," to produce a work titled *A Recent Entrance to Paradise* (the "Work"). The Work was generated in 2012 by an algorithm using pictures to create images simulating a near-death experience.<sup>34</sup> In 2018, Thaler filed an application with the USCO to register the Work, identifying himself as the author and copyright claimant. Notably, Thaler also indicated that the Work was "autonomously created by a computer algorithm running on a machine." but that he was entitled to copyright ownership through the work for hire doctrine. In 2019, the USCO denied registration on the grounds of lack of human authorship.<sup>35</sup> Thaler filed for reconsideration, admitting that the Work lacked "traditional human authorship but arguing that it nonetheless qualified for copyright protection." After re-evaluating the claim, in 2020 the USCO reiterated that human authorship is a key requirement for copyright law, and protection is limited to works resulting from "the fruits of intellectual labor [...] founded in the creative powers of the mind," according to long-standing interpretation of legal precedent.<sup>36</sup> Thaler had also failed to provide evidence of "sufficient creative input or intervention by a human author in the Work," which was necessary for registration.<sup>37</sup>

Thaler asked for reconsideration a second time, arguing that the initial refusal was "unconstitutional and unsupported by either statute or case law" and arguing that the USCO "'should' register copyrights in machine-generated works because doing so would 'further the underlying goals of copyright law'." He relied on three points: 1) there is no explicit provision prohibiting copyright for computer-generated

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<sup>34</sup> E. Kinsella, *A Court Shot Down a Computer Scientist's Latest Attempt to Copyright an A.I.-Created Artwork in a Case That Has Big Implications for A.I. Artists*, Artnet News, 2023, <https://news.artnet.com/art-world/court-shot-down-ai-art-copyright-again-2352452> [accessed: 2024.07.10].

<sup>35</sup> <https://www.copyright.gov/rulings-filings/review-board/docs/a-recent-entrance-to-paradise.pdf> [accessed: 2024.07.10].

<sup>36</sup> *Ibid.*, p. 3.

<sup>37</sup> U.S. Copyright Office, *Compendium of U.S. Copyright Practices* § 306 (3d ed. 2021). See also 17 U.S.C. § 410(b): The Register of Copyrights has the authority to cancel any registration where the "material deposited does not constitute copyrightable subject matter" or "the claim is invalid for any other reason."



artworks; 2) the Copyright Act allows non-human entities to be considered as authors under the work for hire doctrine; and 3) the USCO was relying on outdated judicial opinions. The USCO, through a three-person review board (“Board”), affirmed the earlier ruling in 2022. It reiterated that works “produced by a machine or mere mechanical processes” operating “without any creative input or intervention from a human author” are exempt from registration.<sup>38</sup> Moreover, it stressed that Thaler had failed to assert that the Work was created with contribution from a human author, and thus the remaining issue before the Board was whether the human authorship requirement was unconstitutional and unsupported by case law. After examining the Copyright Act, the Constitution, and judicial interpretations of copyright provisions, the Board determined that the decision was sound. It cited cases where courts repeatedly refused to extend copyright protections to non-human creators, such as a photograph taken by a monkey,<sup>39</sup> a “living garden,”<sup>40</sup> and a song with the Holy Spirit named as the author,<sup>41</sup> as well as another case involving Thaler, holding that an AI system could not claim inventorship of patents.<sup>42</sup>

With respect to Thaler’s contention that the Copyright Act was meant to evolve and accept new forms of creative works, the Board examined a report issued by the National Commission on New Technological Uses of Copyrighted Works (CONTU).<sup>43</sup> The report indicated that copyright law did not require amendment in light of new technological developments, as the human authorship requirement was sufficient to protect works created with computers: “the eligibility of any work for protection by copyright depends not upon the device or devices used in its creation, but rather upon the presence of at least minimal human creative effort at the time the work is produced.”<sup>44</sup> The USCO’s approach was therefore consistent with decades of precedent. While USCO’s manual (*Compendium of U.S. Copyright Office Practices*, last updated in 2021) does address works of non-human expression (e.g. derivative sound recordings, x-rays and other visual imaging, hypertext markup language), the focus on human authorship for protection remains consistent. Furthermore, the Board noted that a previous consultation by the US Patent and Trademark Office (USPTO) on whether a work produced solely by AI should qualify for copyright protection received responses overwhelmingly in favor of maintaining the human authorship requirement.<sup>45</sup>

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<sup>38</sup> U.S. Copyright Office, *Compendium of U.S. Copyright Practices* § 312.2 (3d ed. 2021).

<sup>39</sup> *Naruto v. Slater*, 888 F.3d 418 (9<sup>th</sup> Cir. 2018).

<sup>40</sup> *Kelley v. Chicago Park Dist.*, 635 F.3d 290, 304 (7<sup>th</sup> Cir. 2011).

<sup>41</sup> *Urantia Found. v. Kristen Maaherra*, 114 F.3d 955 (9<sup>th</sup> Cir. 1997). Here, the court held that “some element of human creativity must have occurred” in order for the work to be copyrightable, because copyright laws were not intended to protect “creations of divine beings.”

<sup>42</sup> *Thaler v. Hirshfield*, Case No. 1:20-cv-903 (E.D. Va. Sep. 2, 2021).

<sup>43</sup> CONTU’s mandate is set out in Pub. L. 93-573, § 201(b)(2) (1974).

<sup>44</sup> Final Report of the National Commission on New Technological Uses of Copyrighted Works, 1978, pp. 45–46.

<sup>45</sup> US Patent and Trademark Office, Public Views on Artificial Intelligence and Intellectual Property, 2020, [https://www.uspto.gov/sites/default/files/documents/USPTO\\_AI-Report\\_2020-10-07.pdf](https://www.uspto.gov/sites/default/files/documents/USPTO_AI-Report_2020-10-07.pdf) [accessed: 2024.07.10].

The Board additionally rejected Thaler's work for hire argument because under the Copyright Act, this type of work must be prepared by either an employee or one or more parties who expressly agree via a binding written contract that the work for hire doctrine shall apply.<sup>46</sup> As a machine, the relevant AI system could not enter into such a contract<sup>47</sup> or be considered an employee. Moreover, a work for hire is not exempt from the Copyright Act's human authorship requirement.

### 2.2.2. Judicial claim

Having exhausted administrative remedies, Thaler filed a lawsuit against the USCO to compel registration of the Work in June 2022.<sup>48</sup> Thaler alleged that the USCO's decision was "arbitrary, capricious, an abuse of discretion, and not in accordance with the law, unsupported by substantial evidence, and in excess of [its] statutory authority"<sup>49</sup> and argued that this denial "creates a novel requirement for copyright registration that is contrary to the plain language of the Copyright Act."<sup>50</sup> Thaler stressed that the phrase "original work of authorship" was "purposefully left undefined" by Congress,<sup>51</sup> that copyright protection can apply to non-humans (e.g. corporations), that the bar for originality in copyrightable works is low, and that lack of copyright protection for computer-generated works would affect the moral rights of human authors.<sup>52</sup> Thaler further claimed that "AI can autonomously create works indistinguishable from a human being in terms of original and creative output"<sup>53</sup> and that the Work should be copyrightable because a human (i.e. Thaler) selected and arranged the images used for the AI's output, and this was not a purely mechanical or routine process.<sup>54</sup> Under applicable case law, the threshold for creativity in the copyright context is that a work possesses "some creative spark, 'no matter how crude, humble, or obvious it might be'."<sup>55</sup>

The complaint goes on to discuss the work for hire doctrine in more detail, claiming that while "[a]n AI is not a legal person and does not have rights," and therefore cannot own intellectual property, Thaler is entitled to the works it creates as the owner and operator of the relevant AI system. Here, Thaler relies on the theory of accession, where the owner of an original piece of property is entitled to subsequent property that the original creates, such as a tree bearing fruit, as well as his control over the AI system.<sup>56</sup>

<sup>46</sup> Definition of *work for hire* at 17 U.S.C. § 101.

<sup>47</sup> Capacity is one of the main requirements in contract law. Unlike corporations, autonomous systems lack legal personhood and therefore cannot enter into contracts or be considered a party to an agreement. See N. Banteka, *Artificially Intelligent Persons*, "Houston Law Review" 2021, no. 58, p. 593.

<sup>48</sup> *Thaler v. Perlmutter*, Case No. 1:22-cv-01564 [Complaint], <https://www.courtlistener.com/docket/63356475/1/thaler-v-perlmutter/> [accessed: 2024.07.10].

<sup>49</sup> E. Kinsella, *A Court Shot Down*...

<sup>50</sup> Complaint 5 and 7.

<sup>51</sup> Complaint 23, citing H.R. Rep. No. 94-1476, p. 51 (1976).

<sup>52</sup> Complaint 29–32.

<sup>53</sup> Complaint 36–37.

<sup>54</sup> Complaint 39–42.

<sup>55</sup> *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 499 US 340, 345 (1991).

<sup>56</sup> Complaint 45–53.

Finally, Thaler claimed that recognition of AI authorship is consistent with the purpose of the Constitution and the Copyright Act, which is to offer authors protection and encourage new works of artistic production.<sup>57</sup>

In August 2023, the district court issued an opinion affirming the USCO's decision and upholding the human authorship requirement.<sup>58</sup> It noted that while copyright is "designed to adapt with the times [...] [there] has been a consistent understanding the human creativity is the *sine qua non* at the heart of copyrightability, even as that human creativity is channeled through new tools or into new media."<sup>59</sup> For instance, a photograph is the result of a mechanical device but entails a photographer's creative decisions to "craf[t] the overall image."<sup>60</sup> A human author's ultimate creative control over the work ("guiding hand") is therefore required for copyright protection, even works generated by new forms of technology.<sup>61</sup> The court further stated that the human authorship requirement was based on "centuries of settled understanding" and fully upholds both the Constitution and the Copyright Act, as "[t]here is absolutely no indication that Congress intended to effect any change to this longstanding requirement." Case law holds likewise, and Thaler could not point to any case where "a court has recognized copyright in a work originating with a non-human."<sup>62</sup> Regarding the accession and work for hire theories, Thaler failed to prove an existing and enforceable underlying property right.<sup>63</sup>

Thaler indicated that he plans to appeal this decision, although it is highly unlikely that the court of appeals will rule in his favor. It is worth noting that the district court did acknowledge "new frontiers in copyright as artists put AI in their toolbox to be used in the generation of new visual and other artistic works,"<sup>64</sup> but also that the USCO's decision was based on Thaler's own representations that the AI was the author of the Work, which contradict the long-standing human authorship requirement.<sup>65</sup> Had Thaler played a more active role in the creation of the Work, he might have obtained a different result, as illustrated below.

### 2.3. Kristina Kashtanova's *Zarya of the Dawn*

In 2022, Kristina Kashtanova applied to the USCO for a copyright registration for a comic titled *Zarya of the Dawn* (the "Work"), which had been created using the AI program

<sup>57</sup> Complaint 57.

<sup>58</sup> *Thaler v. Perlmutter*, Case No. 1:22-cv-01564 [Decision], p. 7: "The Register did not err in denying the copyright registration application presented by plaintiff. United States copyright law only protects works of human creation," [https://ecf.dcd.uscourts.gov/cgi-bin/show\\_public\\_doc?2022cv1564-24](https://ecf.dcd.uscourts.gov/cgi-bin/show_public_doc?2022cv1564-24) [accessed: 2024.07.10].

<sup>59</sup> Decision, p. 8.

<sup>60</sup> *Ibid.*

<sup>61</sup> *Ibid.*

<sup>62</sup> Decision, pp. 9–12.

<sup>63</sup> Decision, pp. 14–15.

<sup>64</sup> Decision, p. 13.

<sup>65</sup> Decision, pp. 13–14.

Midjourney. The application listed Kashtanova as the author and did not disclose the use of AI technology. This registration was approved that same day.<sup>66</sup> However, shortly afterwards, the USCO became aware that Kashtanova had used Midjourney<sup>67</sup> and requested additional information on the extent of her authorship of the Work. Kashtanova's attorney sent a letter dated November 21, 2022 describing her use of Midjourney "merely as an assistive tool" and asserting that she had authored the text of the Work in its entirety.<sup>68</sup> On February 21, 2023, the USCO concluded that Kashtanova was indeed "the author of the Work's text as well as the selection, coordination, and arrangement of the Work's written and visual elements," but that the images generated through Midjourney were not the product of human authorship and thus outside the scope of copyright.<sup>69</sup> The USCO notified Kashtanova that it would proceed to cancel the original registration and issue a new certificate limited to "the expressive material that she created."<sup>70</sup> It then proceeded to analyze the Work by its constituent parts.

First, with respect to the text, which was drafted entirely by Kashtanova, the USCO found that it qualified for copyright protection as the work of a human author. Second, the selection and arrangement of the images and text qualify for protection as a compilation, since copyright protects "the collection and assembling of preexisting materials [...] that are selected, coordinated, or arranged [...] in a sufficiently creative way."<sup>71</sup> Kashtanova demonstrated that her selection of text and visual elements was the result of a creative choice. Third, the USCO considered the use of Midjourney to generate the individual images. Midjourney uses text commands ("prompts") that describe the type of image to be generated. Users also have the option to include images from other sources to influence the output or parameters directing aspect ratios or functional directions. But Midjourney "does not interpret prompts as specific instructions to create a particular or expressive result."<sup>72</sup> The USCO determined that because it is not possible to predict what Midjourney will create ahead of time – it is a random rather than controlled process – the images were not original works of authorship protected by copyright. Although Kashtanova stated that she guided the structure and content of the images, the USCO held that Midjourney originated "the traditional elements of authorship;"<sup>73</sup> she was not "the inventive or master mind" behind the images.<sup>74</sup> Despite Kashtanova's efforts working with Midjourney, the prompts were seen as suggestions, not orders. The USCO does not consider "the amount of time,

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<sup>66</sup> <https://www.copyright.gov/docs/zarya-of-the-dawn.pdf> [Letter] [accessed: 2024.07.10], p. 2.

<sup>67</sup> R. Lawler, *The US Copyright Office says you can't copyright Midjourney AI-generated images*, The Verge, 2023, <https://www.theverge.com/2023/2/22/23611278/midjourney-ai-copyright-office-kristina-kashtanova> [accessed: 2024.07.10].

<sup>68</sup> Letter, pp. 2–3.

<sup>69</sup> Letter, p. 1.

<sup>70</sup> *Ibid.*

<sup>71</sup> 17 U.S.C. § 101.

<sup>72</sup> Letter, p. 7.

<sup>73</sup> Letter, p. 8.

<sup>74</sup> Letter, p. 9.

effort, or expense required to create the work” as justification for copyright protection, because it is not related to the necessary “minimum creative spark.”<sup>75</sup>

While this was not the outcome Kashtanova preferred, the decision was hailed as “a great victory,” since the USCO recognized that generative AI and creativity can coexist.<sup>76</sup> The decision also leaves the door open for future works using AI to be copyrighted, if the applicant can prove that they used another program and exerted greater decision-making over the image output.

## 2.4. Lessons learned

When comparing the different outcomes of these cases, it is important to note who was identified as the relevant author in the original application for copyright registration with the USCO. Thaler did not claim to be the author of *A Recent Entrance to Paradise*, but rather listed his “Creativity Machine” as the primary creator. Thaler later attempted to highlight his control over the AI system in order to meet the human authorship requirement. The USCO did not approve, and seemingly felt Thaler was improperly using false information to obtain a registration certificate. While at first glance it appears that the USCO’s approach to the *Zarya of the Dawn* registration contradicts the outcome of the Thaler registration, a closer examination of the decision letter provides valuable insight. Unlike Thaler, Kashtanova was able to demonstrate a human element present in the Work and did not list the AI system as the author.

In March 2023, the USCO issued a new rule to provide guidance for the registration of AI-generated works.<sup>77</sup> The rule specifically references Thaler’s and Kashtanova’s registrations and replicates the case law and principles set out in the related decisions. This approach was confirmed in September 2023, when the USCO declined to register an AI-generated work submitted by Jason Allen titled *Théâtre d’Opéra Spatial*. Although Allen “emphasized his hand in the work” (entering prompts, making adjustments, and dictating the tone of the image),<sup>78</sup> his use of Midjourney undermined these claims. Notably, the work had previously won first prize at the 2022 Colorado state art fair and caused controversy when Allen revealed that he had used AI to create the winning piece.<sup>79</sup>

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<sup>75</sup> Letter, p. 10.

<sup>76</sup> T. Analla, *Zarya of the Dawn: How AI is Changing the Landscape of Copyright Protection*, Harvard University Jolt Digest, 2023, <https://jolt.law.harvard.edu/digest/zarya-of-the-dawn-how-ai-is-changing-the-landscape-of-copyright-protection> [accessed: 2024.07.10].

<sup>77</sup> <https://www.federalregister.gov/documents/2023/03/16/2023-05321/copyright-registration-guidance-works-containing-material-generated-by-artificial-intelligence> [accessed: 2024.07.10].

<sup>78</sup> A. Schrader, *Another A.I.-Generated Artwork Was Denied Copyright Protection, Adding a New Knot to the Complexities of Creative Ownership*, Artnet News, 2023, <https://news.artnet.com/art-world/ai-art-copyright-2367590> [accessed: 2024.07.10].

<sup>79</sup> D. Batycka, *An A.I.-Generated Artwork Won First Prize at a Colorado State Fair. Human Artists are Infuriated*, Artnet News, 2022, <https://news.artnet.com/art-world/colorado-artists-mad-ai-art-competition-2168495> [accessed: 2024.07.10].

Thaler claims that the USCO's approach will result in "orphaned art" and "an increasing number of artists and inventors will [take] credit for the efforts of creative A.I., and in that process, creat[e] chaos."<sup>80</sup> It is true that there is no uniform test in the US to gauge what level of human participation is considered sufficient to merit copyright protection, and it has been suggested that the USCO should consult artists in these determinations, as they raise issues that affect a wider group of people and rights as well as the role of AI itself in society, whether as a tool or putative creator.<sup>81</sup> Nonetheless, the USCO is taking the matter seriously, as it has launched an initiative to examine copyright law and policy issues raised by AI, including the scope of copyright in AI-generated works and the use of copyrighted materials to train AI systems.<sup>82</sup> As this consultation is ongoing, the results are not available, but it represents a meaningful step towards informed regulation of AI in the copyright context, which is sorely needed.

### 3. NFTs and trademark infringement

NFTs, or non-fungible tokens, are "digital equivalents of rare artworks, collectible trading cards, and other assets that gain value from scarcity." Unlike other digital assets, NFTs are not interchangeable and represent a one-of-a-kind object.<sup>83</sup> NFTs are created by minting (i.e. recording) a file on a blockchain ledger. This proves the ownership and authenticity of the unique digital asset. Unlike tangible works of art, the owner of an NFT does not obtain ownership through the physical possession of the object; rather, the NFT itself acts as a certificate of ownership.<sup>84</sup> The sale of an NFT does not necessarily include the underlying IP rights, whether of the NFT itself or the physical or digital work it is based on. These rights can be transferred or licensed, but the relevant rights holder must agree to do so. NFTs became hugely popular in 2021, as sales on specialized platforms and in high-profile auction houses reached an unprecedented \$11.1 billion and \$230 million, respectively.<sup>85</sup> Therefore, NFTs involve a large portion of the marketplace and the consumers in it, falling within the scope of trademark law.

Trademarks involve "the right to own and exclusively control the use of a signifier of goods or services in commerce."<sup>86</sup> Under US law, the main purpose of trademark protection is to prevent customer confusion as regards the origin and quality of goods and services in the marketplace.<sup>87</sup> Here, registration is necessary to obtain the exclusive

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<sup>80</sup> A. Schrader, *Another A.I.-Generated Artwork...*

<sup>81</sup> *Ibid.*

<sup>82</sup> <https://www.copyright.gov/ai/> [accessed: 2024.07.10].

<sup>83</sup> J. Fairfield, *Tokenized: The Law of Non-Fungible Tokens and Unique Digital Property*, "Indiana Law Journal" 2022, no. 97, pp. 1261–1263.

<sup>84</sup> R. Carroll, *NFTs: The Latest Technology Challenging Copyright Law's Relevance Within a Decentralized System*, "Fordham Intellectual Property, Media and Entertainment Law Journal" 2022, no. 32, p. 981.

<sup>85</sup> C. McAndrew, *The Art Market Report 2023...*, pp. 14 and 16.

<sup>86</sup> M. Murray, *Trademarks, NFTs, and the Law of the Metaverse*, "Research Gate" 2022, p. 3.

<sup>87</sup> *Ibid.*, citing *Int'l Info. Sys. v. Sec. Univ, LLC*, 823 F.3d 153, 161 (2d Cir. 2016).

right to use the mark and to establish a legal presumption of the mark's validity and ownership.<sup>88</sup> To obtain nationwide protection, the applicant must show that the mark is used in more than one state. Commerce rather than creativity is the main factor for trademark protection. Note that commercial use in this context includes a situation in which a person could receive some benefit or advantage, even if it is limited or accidental; "a large or obvious profit motive is not required."<sup>89</sup>

A key inquiry in trademark infringement is whether the items are "likely to confuse a substantial number of consumers into incorrectly thinking [they] originated from or were endorsed by the trademark holder."<sup>90</sup> While the test for likelihood of confusion may vary according to the circuit where the court is located, factors typically include: 1) the strength of the original trademark; 2) the degree of similarity between the marks; 3) intent (bad faith); 4) evidence of actual confusion; and 5) the level of consumer sophistication in the marketplace.<sup>91</sup> The Lanham Act also provides for dilution, defined as a use of a mark or trade name that is likely to blur or tarnish the distinctive power of the mark as an identifier of goods.<sup>92</sup> In practice, both these provisions allow trademark owners to object to critical treatment of their marks, including parody. Trademark fair use is more limited than copyright fair use and is tied to consumer confusion.<sup>93</sup>

### 3.1. MetaBirkins

Mason Rothschild created faux-fur versions of the iconic Birkin bag (labelled "MetaBirkins") and sold them online as a collection of 100 NFTs valued at \$125 each. Although Rothschild disclaimed any affiliation with Hermès on his website, the luxury brand filed suit for trademark infringement and dilution in June 2022.<sup>94</sup> Rothschild claimed fair use because the NFTs were artistic renderings and not actual handbags or images of actual handbags. Hermès countered that it "did not authorize or consent to the commercialization or creation" of the NFTs and that Rothschild's actions were diluting its power as a name brand in the marketplace.<sup>95</sup> Notably, marks do not need to be identical to cause confusion; it is enough for them to be similar and "create the same general commercial impression in the consuming public's mind."<sup>96</sup> In June 2023, the jury found Rothschild liable despite his freedom of expression claims, holding that

<sup>88</sup> M. Yoder, *An "OpenSea" of Infringement: The Intellectual Property Implications of NFTs*, "The University of Cincinnati Intellectual Property and Computer Law Journal" 2022, no. 6, p. 11.

<sup>89</sup> M. Murray, *Trademarks, NFTs...*, p. 4.

<sup>90</sup> A. Michaels, *NFT Litigation is Raising Novel Trademark Questions*, "Social Science Research Network (SSRN)" 2022, p. 1.

<sup>91</sup> *Ibid.*

<sup>92</sup> Section 43(c).

<sup>93</sup> M. Murray, *Trademarks, NFTs...*, p. 8.

<sup>94</sup> *Hermès International and Hermès of Paris, Inc. v. Mason Rothschild*, Case No. 22-cv-384 (SDNY Feb. 2, 2023), 590 F.Supp. 3d 647, 655 (SDNY 2022).

<sup>95</sup> C. Muraca, *The 'MetaBirkin' and the Beginning of Trademark Litigation in the NFT Space*, Cardozo University AELJ Blog, 2022, p. 3, <https://larc.cardozo.yu.edu/cgi/viewcontent.cgi?article=1307&context=aelj-blog> [accessed: 2024.07.10].

<sup>96</sup> M. Yoder, *An "OpenSea" of Infringement...*, pp. 11–12.



there was a likelihood of consumer confusion and that he had intended to defraud consumers. It awarded Hermès a permanent injunction against Rothschild, preventing him from marketing and selling the NFTs, and \$133,000 in damages.<sup>97</sup>

### 3.2. Bored Ape Yacht Club (BAYC)

BAYC are some of the most popular NFTs in circulation and have sold for millions of dollars, with the entire collection previously valued at \$1 billion.<sup>98</sup> The content license for this collection expressly includes the right to display and create derivative works using the BAYC characters and brand. The BAYC parent company, Yuga Labs, filed a lawsuit against conceptual artists Ryder Ripps and Jeremy Cahen after they created NFTs using the exact same images as the authentic BAYC NFTs, with the same designated numbers and trademarked elements.<sup>99</sup> The only difference was the title “RR/BAYC” instead of BAYC and that the NFTs were sold for a lower price. Allegedly, the images were duplicated as a satiric and artistic statement, but in April 2023 the court ruled that the copied NFTs were “no more artistic than the sale of a counterfeit handbag” and did not “contain any artistic expression or critical commentary.” Even though NFTs represent a new type of asset and the extent of their IP protection is still being determined, the court cited Yuga Labs’ terms and conditions, which specifically stated that BAYC NFT holders obtained a copyright license for personal and commercial use but not a trademark license. It also cited the MetaBirkins case and confirmed that intangible goods qualify for trademark protection.<sup>100</sup>

### 3.3. Lessons learned

These cases demonstrate how existing law can be applied successfully to new technologies, by following basic principles rather than by focusing on the differences between these types of assets and traditional physical goods. They also provide established precedent for future cases to follow, in contrast to copyright infringement cases over NFTs, which are either ongoing or have settled prior to the dispositive motion stage.<sup>101</sup> Interestingly, trademark infringement appears to be a more straightforward

<sup>97</sup> A. Greenberger, *Hermès Wins Lawsuit Against Artist, Whose NFTs Based on Birkin Bags Were Deemed Not Art by Jury*, ARTnews, 2023, <https://www.artnews.com/art-news/news/hermes-wins-metabirkins-lawsuit-mason-rothschild-nfts-1234656620/> [accessed: 2024.07.10]; B. Brittain, *Hermes wins permanent ban on 'MetaBirkin' NFT sales in US lawsuit*, Reuters, 2023, <https://www.reuters.com/business/hermes-wins-permanent-ban-metabirkin-nft-sales-us-lawsuit-2023-06-23/> [accessed: 2024.07.10].

<sup>98</sup> I. Lee, *Sales of Bored Ape Yacht Club NFTs jump past \$1 billion amid heightened interest from celebrity collectors*, Markets Insider, 2022, <https://www.businessinsider.in/investment/news/sales-of-bored-ape-yacht-club-nfts-jump-past-1-billion-amid-heightened-interest-from-celebrity-collectors/articleshow/88696528.cms> [accessed: 2024.07.10].

<sup>99</sup> *Yuga Labs, Inc. v. Ryder Ripps*, No. 2:22-cv-04355 (C.D. Cal. June 24, 2022).

<sup>100</sup> E. Roth, *Bored Ape Yacht Club creator wins lawsuit over copycat NFT collection*, The Verge, 2023, <https://www.theverge.com/2023/4/24/23695703/bored-apes-creator-lawsuit-nfts-ryder-ripps-yuga-labs-trademark-copyright> [accessed: 2024.07.10].

<sup>101</sup> For example, in September 2022 director Quentin Tarantino settled with studio Miramax over a set of NFTs based on the film *Pulp Fiction*. A. Robertson, *Quentin Tarantino settles NFT lawsuit with*

matter than copyright infringement with respect to NFTs. This is likely because artistic creations are more subjective, while commercial goods fall under trademark protection on a more objective basis. “Recontextualization” or similar artistic justifications may succeed as a defense to accusations of copyright infringement, but the court rejected this argument in the *MetaBirkins* and *BAYC* cases. Parody, commentary, and criticism may also be raised, but US courts tend to err on the side of customer confusion rather than freedom of expression in this context.<sup>102</sup> For instance, if Rothschild had not used the Birkin name for his NFTs, and instead called them something else, it is possible that Hermès would have been unable to demonstrate consumer confusion (and by extension, trademark dilution and infringement).

## Conclusion

New forms of technology, particularly AI, raise interesting (and sometimes complicated) IP issues. The US frames copyright in relation to fair use and transformativeness, while AI is testing the limits of these concepts. Various lawsuits have been filed opposing the use of copyrighted materials to train AI systems, with defendants alleging that this falls within the scope of fair use. But a hallmark SCOTUS case evaluating what constitutes transformativeness would seem to discredit this theory. Moreover, the issue of whether AI-generated artworks qualify for copyright protection is subject to the human authorship requirement. US copyright law enshrines creativity, and this is something AI cannot replicate: “Machines do not reflect the zeitgeist, do not process social and societal impressions, and do not get inspired on subconscious levels. Yet [...] this is a crucial factor for copyright protection [in the US]. The mere fact that AI technology has the ability to surprise [...] even those who programmed and trained it does not necessarily amount to creativity.”<sup>103</sup> Works can merit protection if applicants can demonstrate that they, rather than the AI, made key decisions leading to the final form of the work. It is also worth considering that “NFTs do not warp the rules of trademark and unfair competition laws, but they do provide a whole new platform in which to use and potentially infringe on or dilute existing marks” and “NFTs cannot automatically be characterized as artistic expression or any kind of expression.”<sup>104</sup> This means that they qualify for trademark protection, which can be a more effective means of legal enforcement than copyright infringement, as the fair use analysis will be more strict.

Ongoing developments in the field of IP protection in the US serve as a roadmap for how new technologies interact with established legal orders. The cases discussed

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*Miramax*, The Verge, 2022, <https://www.theverge.com/2022/9/9/23344441/quentin-tarantino-pulp-fiction-nft-miramax-lawsuit-settled> [accessed: 2024.07.10].

<sup>102</sup> M. Murray, *Trademarks, NFTs...*, p. 8.

<sup>103</sup> P. Zurth, *Artificial Creativity?...*, p. 5.

<sup>104</sup> M. Murray, *Trademarks, NFTs...*, p. 16.

in this article provide examples of approaches that apply existing precedent while adapting it to contemporary needs. As new claims continue to arise, it remains to be seen how and to what extent IP law will continue to evolve in the face of rapidly changing digital assets and tools.

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## Summary

*Claudia S. Quiñones Vilá*

### Contemporary Approaches to IP Protection: Developments in the US Art Market

This article examines recent developments in United States (US) intellectual property (IP) law that directly affect the art market, namely: 1) the judicial interpretation of fair use and the use of copyrighted material to train AI systems; 2) the US Copyright Office's refusal to register certain AI-generated works; and 3) the application of trademark law to NFTs (Non-fungible tokens). The aim of this article is to provide an overview of the constantly evolving legal landscape in this field while highlighting controversies that will likely continue to arise in the near future. As a jurisdiction where new technologies, the art market, and IP case law overlap, the US is in a unique position to reflect ongoing changes as well as in-depth interpretations of existing provisions.

**Keywords:** artificial intelligence, art market, copyright, NFTs, trademarks.

## Streszczenie

*Claudia S. Quiñones Vilá*

### Współczesne koncepcje ochrony własności intelektualnej – zmiany na rynku dzieł sztuki w USA

Niniejszy artykuł analizuje ostatnie zmiany w amerykańskim prawie własności intelektualnej, które mają bezpośredni wpływ na rynek sztuki, a mianowicie: 1) sądową interpretację dozwolonego użytku i wykorzystania materiałów chronionych prawem autorskim do szkolenia systemów sztucznej inteligencji; 2) odmowę rejestracji niektórych utworów generowanych przez sztuczną inteligencję przez amerykański urząd ds. praw autorskich oraz 3) zastosowanie prawa znaków towarowych do NFT. Celem pracy jest przedstawienie przeglądu stale ewoluującego krajobrazu prawnego w tej dziedzinie, przy jednoczesnym podkreśleniu kontrowersji, które będą nadal pojawiać się w najbliższej przyszłości. Jako jurysdykcja, w której nowe technologie, rynek sztuki i orzecznictwo dotyczące własności intelektualnej nakładają się na siebie, Stany Zjednoczone są w wyjątkowej sytuacji, która umożliwi odzwierciedlenie bieżących zmian, a także dogłębną interpretację istniejących unormowań.

**Słowa kluczowe:** sztuczna inteligencja, rynek sztuki, prawo autorskie, NFT, znaki towarowe.

# Glosy







# Legal Rights of Copyright Trolls in Directive 2004/48/EC: Balance between the Right to Privacy and Copyright

Judgment of the Court of Justice of the European Union of 17 June 2021,  
C-597/19<sup>1</sup>

1. Posting segments of a media file containing a protected work on the end device of a user of a peer-to-peer network (such as Bit-Torrent), although these downloaded segments are usable as such only after reaching a certain minimum quantity specified in percentage, is making public in accordance with Directive 2001/29.
2. Copyright entities have the right to information that allows the identification of peer-to-peer network clients in order to effectively bring a lawsuit against these entities allegedly infringing copyright.
3. The status of a copyright troll, i.e. an entity that is limited to pursuing claims for damages from entities that, in its opinion, infringe these rights, does not affect the possibility of using the measures and procedures provided for in Directive 2004/48. However, the court must examine whether the request is an abuse of law, in particular whether it is justified and proportionate.

**Ewa Milczarek**

University of Szczecin, Poland  
ewa.milczarek@usz.edu.pl  
ORCID: 0000-0003-0726-0959

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## Commentary

The dynamic development of the Internet has led to massive and widespread violations of two fundamental rights: the right to privacy and the right to intellectual property. Sharing cultural goods via the Internet is extremely simple, does not generate costs and is anonymous.<sup>2</sup> Anonymity influenced the impunity of the perpetrators of infringements

<sup>1</sup> ECLI:EU:C:2021:492.

<sup>2</sup> R. Cisek, J. Jezioro, A. Wiebie, *Dobra i usługi informacyjne w obrocie gospodarczym*, Warszawa 2005, p. 94.

and the habit of free access to works. Today the possibilities of identifying potential perpetrators of infringements are currently at a high level. However, the disclosure of Internet users' data to copyright holders requires registering and processing their personal data. This raises concerns about the violation of the right to privacy. In this context, there is a conflict between the right to privacy and the right to protect intellectual property. Balancing these two rights is not an easy task, because it takes place in a dynamic environment where the tools and forms of their violations change. Statutory law does not always keep up with these changes. The judiciary, including the extensive case law of the Court of Justice of the European Union (hereinafter: the CJEU, the Court) plays a key role in determining the relationship between individual rights and freedoms on the Internet.<sup>3</sup> The judgment of the CJEU issued in mid-2021 in the case of *Mircom International Content Management & Consulting Limited* (hereinafter: *Mircom*) against *Telenet BVBA* (hereinafter: *Telenet*) (C 597/19)<sup>4</sup> is another important element of balancing intellectual property rights with the right to privacy and determining the powers of copyright trolls.

## A short description of the facts

*Mircom* is a Cyprus-registered company that owns the rights to a number of films. These videos were shared without the company's consent on a peer-to-peer network using BitTorrent. *Mircom* brought an action against the Belgian company *Telenet*, demanding that it provide information allowing the identification of its customers. *Mircom* sought damages from these customers as alleged infringers.

Against this background, two questions for a preliminary ruling raise three important issues. The first concerns the assessment of whether public disclosure, within the meaning of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society (hereinafter Directive 2001/29/EC<sup>5</sup>), by posting segments of a media file containing a protected work on the end device of a user of a peer-to-peer network can be considered as copyright infringement, although these segments are usable as such only after reaching a certain percentage minimum quantity and the configuration of the BitTorrent file-sharing software provides them automatically.

The second question referred for a preliminary ruling concerns the status of *Mircom*. That undertaking does not actually exploit the rights assigned by the makers of the films in question, but merely seeks damages from the alleged infringers. The business

<sup>3</sup> E.g. Judgment of the CJEU of 14 June 2017, C-610/15, *Stichting Brein v. Ziggo BV and XS4ALL Internet BV*, EU:C:2017:456.

<sup>4</sup> Judgment of the CJEU of 17 June 2021, C-597/19, *Mircom International Content Management & Consulting (M.I.C.M.) Limited v. Telenet BVBA*, ECLI:EU:C:2021:492.

<sup>5</sup> 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, OJ L 167, 22.6.2001, P. 0010–0019.

model adopted by the company resembles the definition of a “copyright troll.”<sup>6</sup> Often, as in the case analyzed, it takes the form of a mass mailing of requests for payment for copyright infringement, both to actual infringers and innocent people, in order to conclude as many settlements as possible. This model depends not on fighting, but on the existence of piracy. Therefore, it is difficult to determine the “detriment” as a result of an infringement of the law defined within the meaning of Art. 13 of Directive 2004/48/EC<sup>7</sup> of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (hereinafter: Directive 2004/48/EC). The question therefore centers on the question of whether copyright trolls can enjoy the same IP enforcement rights as authors or licensees exercising copyright in the normal way.

The third thread concerns the relationship between respect for intellectual property rights and the protection of the right to privacy and personal data, in particular as part of the proportionality assessment of the systematic recording and further processing of IP addresses of users of peer-to-peer networks sharing file segments in light of Art. 6 sec. 1 lit. (f) Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of individuals with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC<sup>8</sup> (hereinafter: GDPR).

## Decision of the Tribunal

In the context of the first question, it is important to define the status of segments of the work discussed previously. As the Advocate General points out in his Opinion,<sup>9</sup> segments are not parts of works, but parts of files containing those works, which are used to transmit those works using the BitTorrent protocol. Segments are useless by themselves. However, any user of a peer-to-peer network can easily assemble a primary file from segments available on other users’ computers. The user does not have the entire file for a certain period of time, but he/she provides the fragments he/she has, and thus contributes to a situation in which all users participating in the download of a given file ultimately have access to its entirety.

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<sup>6</sup> See also: A. Skibińska, *Trolling prawnoautorski (copyright trolling) a nadużycie prawa podmiotowego*, “Prawo Mediów Elektronicznych” 2017, no. 4, pp. 26–33.

<sup>7</sup> Directive 2004/48/EC of The European Parliament and of The Council of 29 April 2004 on the enforcement of intellectual property rights, OJ L 157, 30.4.2004, pp. 45–86.

<sup>8</sup> Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation), OJ L 119, 4.5.2016, pp. 1–88.

<sup>9</sup> Para 48–50 Opinion of Advocate General Szpunar delivered on 17 December 2020, C-597/19, *Mircom International Content Management & Consulting (M.I.C.M.) Limited v. Telenet BVBA, with participation: Proximus NV, Scarlet Belgium NV*, ECLI:EU:C:2020:1063.

Directive 2001/29 in Art. 3.1 and 2 grants authors the exclusive right to authorize or prohibit any communication to the public of their works. This article does not deal with the issue of making parts of a work available, nor with the minimum quantity threshold for making works available. Thus, any act by which a user grants, in full knowledge of its consequences, access to works or other subject-matter may constitute an act of communication.<sup>10</sup>

The Court also found that users of programs such as BitTorrent are informed about its features (e.g. in the license agreement or regulations). Therefore, they act with full awareness of their behavior and the consequences it may cause.

According to settled case law, the “audience” should be understood as an indefinite number of potential recipients and addressing them to a fairly wide circle.<sup>11</sup> It is also necessary for the work to be made available using a specific technology, other than those used so far, or for the information of a new public, i.e. one that the copyright or related rightholder had not previously taken into account when allowing the original publication of the work.<sup>12</sup> As regards the classification of peer-to-peer networks, the case-law of the Court to date shows that the management on the Internet and the provision of access to an exchange platform which, by indexing the metadata relating to protected works and providing a search engine, enables the users of that platform to search for those works and to exchange them within the network peer-to-peer, constitutes public sharing within the meaning of Art. 3 sec. 1 of Directive 2001/29.<sup>13</sup> Several factors influence this classification. First, the computers of those users that store the same file constitute a peer-to-peer network in which they play the same role as the role played by servers in the functioning of the WWW. Second, this network is used by a significant number of people. Third, those users are able to access protected works exchanged on that platform at any time and at the same time.<sup>14</sup> Thus, an announcement within a peer-to-peer network concerns an indefinite number of potential recipients and is addressed to a fairly wide circle of recipients. Moreover, since the present case concerns works published without the consent of the rightholders, it must also be considered that there is an announcement to a new public.<sup>15</sup>

In the Court’s view, even where a work has previously been published on a website without restrictions preventing it from being downloaded and with the consent of the rightholder, users of peer-to-peer networks play a decisive role in bringing that work

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<sup>10</sup> Judgment of the CJEU of 9 March 2021, C-392/19, *VG Bild-Kunst v. Stiftung Preußischer Kulturbesitz*, EU:C:2021:181, para 30.

<sup>11</sup> Judgment of the CJEU of 7 August 2018, C-161/17, *Land Nordrhein-Westfalen v. Dirk Renckhoff*, EU:C:2018:634; Judgment of the CJEU of 16 March 2017, C-138/16, *Staatlich genehmigte Gesellschaft der Autoren, Komponisten und Musikverleger registrierte Genossenschaft mbH (AKM) v. Zürs.net Betriebs GmbH*, EU:C:2017:218, point 22; *Stichting Brein v. Ziggo BV and XS4ALL Internet BV*, para 24.

<sup>12</sup> *VG Bild-Kunst v. Stiftung Preußischer Kulturbesitz*, para 31, 32.

<sup>13</sup> *Stichting Brein v. Ziggo BV and XS4ALL Internet BV*, para 48.

<sup>14</sup> Para 37 i 61 Opinion of Advocate General...

<sup>15</sup> *Stichting Brein v. Ziggo BV and XS4ALL Internet BV*, para 45.

to the attention of the public to whom the rightholder did not take into account when allowing the original release.<sup>16</sup>

The European Union establishes a high level of protection for rightholders by allowing them to receive appropriate remuneration for the use of their works or other subject matter, in particular where they are made public.<sup>17</sup> A balance must be struck in the digital environment between the interests of rightholders and related rightholders in the protection of their intellectual property, as guaranteed in Art. 17.2 of the Charter of Fundamental Rights<sup>18</sup> (hereinafter referred to as the Charter), and on the other hand, the protection of the interests and fundamental rights of users of protected objects, in particular their freedom of expression and information, guaranteed in Art. 11 of the Charter as well as the general interest.<sup>19</sup> In the Court's view, allowing a notification to be made available by posting it on the internet, without the rightholders being able to invoke the protection provided for by Directive 2001/29, would undermine the fair balance to be maintained on the internet.

In conclusion, in the light of the above considerations, the answer to the first question should be that posting segments of a media file containing a protected work on the end device of a peer-to-peer network user, although these downloaded segments are usable as such only after reaching a certain minimum quantity specified in percentage is public disclosure in accordance with Directive 2001/29.

As regards the second of the issues analyzed, related to the status of Mircom, it is necessary to indicate the circle of entities entitled to use copyright protection. These categories include, first, holders of intellectual property rights, second, all other persons authorized to use those rights, in particular licensees, third, collecting societies recognized as having the right to represent owners of intellectual property rights, and fourth, professional entities specialized in enforcing rights, recognized as having the right to represent owners of intellectual property rights. They must also have a direct interest in defending these rights and the power to bring legal proceedings to the extent permitted and in accordance with the applicable legislation.<sup>20</sup> Mircom does not manage the copyrights or related rights of its contractors, nor does it ensure their professional defense. It is limited only to pursuing claims for damages resulting from violations of these rights. It acts as an assignee, providing the producers of the films in question with a recovery service for damages. The assessment of the standing of the holder of intellectual property rights does not depend on whether the entity actually exercises its intellectual property rights. Nor is the assignment of claims in itself capable of affecting the nature of the rights which have been infringed, namely, in this case, the intellectual property rights of the film producers concerned.<sup>21</sup>

<sup>16</sup> *Land Nordrhein-Westfalen v. Dirk Renckhoff*, para 46, 47.

<sup>17</sup> According to recitals 4, 9 and 10 of Directive 2001/29.

<sup>18</sup> Charter of Fundamental Rights of The European Union, OJ C 326, 26.10.2012, pp. 391–407.

<sup>19</sup> See: *VG Bild-Kunst v. Stiftung Preußischer Kulturbesitz*, para 54.

<sup>20</sup> See: Judgment of the CJEU of 7 August 2018, C521/17, *Coöperatieve Vereniging SNB-REACT U.A. v. Deepak Mehta*, EU:C:2018:639, para 39.

<sup>21</sup> Judgment of the CJEU of 21 May 2015, C352/13, *Cartel Damage Claims Hydrogen Peroxide SA (CDC) v. Akzo Nobel NV and others*, EU:C:2015:335, para 35, 36.

Article 8 of Directive 2004/48 expresses the intellectual property right's right to information about the origin and distribution networks of goods or services infringing an intellectual property right by the infringer or any other person. In this way, it ensures the effective exercise of intellectual property rights by enabling the identification of the entity infringing this right and taking the necessary steps to protect this right.<sup>22</sup> The request for information should be justified and proportionate. The condition for obtaining information is a scale of infringements defined as commercial. The entity obliged to provide the information does not have to be the alleged infringer. It is enough that these services are used in activities that violate the law. Therefore, Mircom has the right to information allowing the identification of its clients precisely for the purpose of effectively bringing a lawsuit against these entities allegedly infringing copyright.

Summing up the findings so far regarding the second of the issues discussed, the Court states that the status of a copyright troll, i.e. an entity that is limited to pursuing claims for damages from entities that, in its opinion, infringe these rights, does not affect the possibility of using the measures and procedures provided for in Directive 2004/48. However, the court must examine whether the request is an abuse of law, in particular whether it is justified and proportionate.

Another of the analyzed issues is that of balancing between, on the one hand, intellectual property law and, on the other hand, the protection of privacy and personal data, in particular in terms of proportionality.

The Court's analysis focuses in the first stage on determining the lawfulness of the processing and sharing of personal data. In the present case, the intellectual property rightholder (or a third party authorized by him) systematically registered the IP addresses of peer-to-peer network users whose Internet connections were allegedly used for activities infringing intellectual property rights. He then requested that the Internet provider Telenet disclose the data (names and postal addresses) of those users in order to bring an action before a civil court seeking compensation for the damage allegedly caused by those users. According to the settled case-law of the CJEU, a dynamic IP address registered by an online media service provider when a person browses a website that this provider makes available to the public constitutes personal data in relation to that provider within the meaning of Art. 4 point 1 GDPR. The condition is that he has the legal means enabling him to identify the data subject, thanks to additional information available to the Internet access provider.<sup>23</sup> IP addresses are therefore personal data in this case, and the recording of these addresses for the purpose of their subsequent use in legal proceedings constitutes processing within the meaning of Art. 4 point 2 GDPR. Processing personal data, in accordance with Art. 6 sec. 1, first subparagraph, point a-f GDPR, is lawful if it is necessary for the purposes of

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<sup>22</sup> Judgment of the CJEU of 9 July 2020, C264/19, *Constantin Film Verleih GmbH v. YouTube LLC and Google Inc.*, EU:C:2020:542, para 35.

<sup>23</sup> Judgment of the CJEU of 19 September 2016, C582/14, *Patrick Breyer v. Bundesrepublik Deutschland*, EU:C:2016:779, para 49.

legitimate interests pursued by the administrator or by a third party. An exception to this rule is where the interests or fundamental rights and freedoms of the data subject take precedence, e.g. when that person is a child. This provision therefore sets out three cumulative conditions for the lawfulness of the processing of personal data: the pursuit of legitimate interests by the data controller or third party; the need to process personal data for the purposes of those legitimate interests; and that the rights and freedoms of the data subject do not take precedence.<sup>24</sup>

The Court indicates that a legitimate interest can be considered the situation of a data controller or a third party acting to obtain personal data relating to a person who allegedly violated their property, in order to sue that person for damages. It should be noted that derogations from the protection of personal data and its limitations should be applied only when it is absolutely necessary,<sup>25</sup> and the identification of the link holder is often possible only on the basis of the IP address and information provided by the Internet access service provider.<sup>26</sup>

According to the Court, identifying the owners of those IP addresses and making their names and postal addresses available to Mircom is consistent with the objective of ensuring a fair balance between the rightholders' right to information and the users' right to the protection of personal data.<sup>27</sup>

## Assessment of the CJEU decision

Intellectual property enjoys a high level of protection in the European Union. Today, the Internet is changing the shape of the cultural market and thus threatening existing media industries<sup>28</sup> through the unauthorized copying of intellectual property on the Internet. It is a common phenomenon and of great socio-economic importance.

It is impossible not to agree with the reasoning adopted by the CJEU. Awareness of how peer-to-peer networks work is high and users knowingly download and share songs. Works are thus made available to the public in a mass manner. The injured party should have the right to access the personal data of the infringers in order to protect their rights.

BitTorrent is the largest carrier of unauthorized intellectual property,<sup>29</sup> with 100% of exchanged files being unauthorized, including those that are illegal and threatened

<sup>24</sup> See: Art. 7 lit. f) Directive 95/46; Judgment of the CJEU of 4 May 2017, C13/16, *Valsts policijas Rīgas reģiona pārvaldes Kārtības policijas pārvalde v. Rīgas pašvaldības SIA "Rīgas satiksme"*, EU:C:2017:336, para 28.

<sup>25</sup> *Valsts policijas Rīgas reģiona pārvaldes Kārtības policijas pārvalde v. Rīgas pašvaldības SIA "Rīgas satiksme"*, para 30.

<sup>26</sup> Para 97 General Advocate Opinion...

<sup>27</sup> See: *Constantin Film Verleih GmbH v. YouTube LLC and Google Inc.*, para 37, 38.

<sup>28</sup> I. Gleisler, *Problem wolności w internecie*, "INFOTEZY" 2013, vol. 3, no. 1.

<sup>29</sup> See: S. Czetwertynski, *Internet peer production and unauthorized copying of intellectual property via BitTorrent network*, Institute of Economic Research Working Papers, No. 128, Toruń 2015.



with legal sanctions.<sup>30</sup> In addition to BitTorrent, similar activities are carried out by IRC, Napster, Audiogalaxy, Gnutella, Fast Track, Direct Connect, and eDonkey. The judgment of the CJEU means that the use of such programs poses a highly probable risk of copyright infringement for its users and, consequently, financial losses related to the activities of copyright trolls.

Copyright trolling is a relatively new phenomenon that emerged with the development of the Internet.<sup>31</sup> The effectiveness of this financial model is based on the massive use of summons, striving to obtain compensation without court proceedings, and the disproportion of legal competences between network users and professional law firms providing services to copyright holders. Copyright holders use the applicable legal norms instrumentally, often acting on the verge of the abuse of law and intimidation. The green light for sharing users' personal data with such entities will undoubtedly intensify their activities.

However, it is worth questioning whether the current standards of author protection, which were created in the pre-IT revolution world, are really adequate to the current reality. The aim of ensuring a high level of protection is to maintain and develop creativity in the interests of authors, performers, producers, consumers, culture and the economy, as well as the general public.<sup>32</sup> Copyright trolls do not create anything, they do not produce anything, but only prey on the author protection system. On the other hand, authors (as opposed to publishers) are one of the worst paid employee groups. As indicated by Łukasz Maryniak, the informal exploration of works in the digital environment, i.e. not derived from sources created with the consent of the creator, does not automatically translate into losses (lower income) for copyright holders.<sup>33</sup> What is more, the free availability of goods on the Internet contributes to increasing the broadly understood demand for culture.<sup>34</sup> As Sławomir Czetwertyński rightly points out, "copyright trolling is a consequence of opportunistic behavior resulting from the inadequacy of the formal institution of copyright to the prevailing technological order."<sup>35</sup> Users of peer-to-peer networks are also the group that most often reaches for legal sources of access to cultural goods. The main reason why users decide to obtain works from the Internet is the topicality of the content and the availability of new products as well as the size of the available resource.<sup>36</sup> Ensuring appropriate distribution channels (like Netflix) significantly reduces interest in unauthorized exchange via the BitTorrent network.<sup>37</sup>

<sup>30</sup> D. Price, *Sizing the piracy universe*, NetNames (Envisional), 2013, p. 30.

<sup>31</sup> J. Radziszewska, *Copyright trolling a prawo cytatu*, "Problemy Prawa Prywatnego Międzynarodowego" 2018, no. 23, p. 123.

<sup>32</sup> Recital 9 Directive 2001/29.

<sup>33</sup> Ł. Maryniak, *Ustalenie kwoty stosownego wynagrodzenia za naruszenie autorskich praw majątkowych*, Warszawa 2020, p. 12.

<sup>34</sup> M. Filiciak, J. Hofmokl, A. Tarkowski, *Obiegi kultury. Społeczna cyrkulacja treści. Raport z badań*, Warszawa 2012, pp. 40–41.

<sup>35</sup> S. Czetwertyński, *Oportunizm a prawa autorskie*, "Studia i Prace WNEiZ US" 2016, no. 44(2), p. 59.

<sup>36</sup> M. Filiciak, J. Hofmokl, A. Tarkowski, *Obiegi kultury...*

<sup>37</sup> S. Czetwertyński, *Oportunizm a prawa autorskie...*, p. 66.

The purpose of fair use<sup>38</sup> is to provide the public with access to culture. The CJEU judgment practically blocks the possibility of peer-to-peer network operation, because despite exercising due diligence, users are unable to determine whether the work they want to use has been legally distributed within this network<sup>39</sup> and whether they will not suffer legal consequences related to such action.

Access to works from legal sources is based primarily on what is offered by the largest phonographic or film concerns that homogenize culture. Distribution via the peer-to-peer network gave Internet users from individual local markets access to content previously targeted only at other national markets.<sup>40</sup> Fair use should not violate the normal use of the work or harm the legitimate interests of the author, i.e. against such moves that may unreasonably prejudice the legitimate interests of the author.<sup>41</sup> Currently, protection systems are used primarily by corporations and copyright trolls, but not by individual creators. The solution adopted by the CJEU is adequate to the current copyright protection system. However, it is worth considering whether this system really fulfills the role for which it was established.

Currently, two opposing directions of the concept of copyright regulation can be observed. The first seeks to foreclose access to resources through measures such as tightening intellectual property regulations or penalizing their abuse. Some doctrines and creators' circles are of the opinion that universal and free access to works will inhibit the development of creativity and the effectiveness of exclusive rights and copyright monopolies. In opposition to it, a "free culture" is developing, which aims, among other things, at the sharing and dissemination of works. In their opinion, threats to the development of culture are realized precisely through the lack of access to it by recipients and other creators.<sup>42</sup> The changes proposed by the advocates of free culture include increasing access to creativity, stimulating creativity by providing protection to creators, not publishing, recording or film companies,<sup>43</sup> or shortening the term of copyright.<sup>44</sup> Business models and strategies of entities producing and distributing information goods should be adapted, which means not a direct fight against unauthorized copying, but an increase in incentives to participate in market transactions.<sup>45</sup> The current legal situation does not satisfy either party. Creators do not

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<sup>38</sup> E.g. Art. 23 Ustawa z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (tekst jedn.: Dz. U. z 2022 r., poz. 2509); Art. 53 Urheberrechtsgesetz (Gesetz über Urheberrecht und verwandte Schutzrechte) Gesetz vom 09.09.1965 (BGBl. I S. 1273).

<sup>39</sup> M. Czerniawski, *Glosa do wyroku TS z dnia 10 kwietnia 2014 r., C-435/12*, LEX/el. 2014.

<sup>40</sup> A.A. Janowska, *Umiędzynarodowienie branży fonograficznej* [in:] *Globalizacja współcześnie. Komponenty i cechy charakterystyczne*, eds. R. Malik, A.A. Janowska, R. Wosiek, Warszawa 2018, p. 127.

<sup>41</sup> E. Traple, *Komentarz do art. 35 ustawy o prawie autorskim i prawach pokrewnych* [in:] *Prawo autorskie i prawa pokrewne. Komentarz*, eds. J. Barta, R. Markiewicz, Warszawa 2011.

<sup>42</sup> I. Gleisler, *Problem wolności w internecie...*

<sup>43</sup> K. Dobrzeński, *Lex informatica*, Toruń 2008, p. 107.

<sup>44</sup> J. Gurczyński, *Wolny internet, wolna kultura*, "Kultura i Wartości" 2013, no. 2(6), p. 81.

<sup>45</sup> S. Czetwertyński, *Źródła kryzysu instytucji praw autorskich w społeczeństwie online* [in:] *Nauka, badania i doniesienia naukowe 2018. Nauki humanistyczne i społeczne. Część II*, ed. T. Wysoczański, Świebodzice 2018, p. 56.

feel that they are provided with effective protection, and, on the other hand, network users have blocked access to cultural goods. It is therefore worth considering reforming the copyright protection system and adapting it to the realities of the digital world.

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## Summary

*Ewa Milczarek*

### Legal Rights of Copyright Trolls in Directive 2004/48/EC: Balance between the Right to Privacy and Copyright

The gloss refers to the judgment of the CJEU of 17 June 2021 in case C-597/19, *Mircom International Content Management & Consulting Limited v. Telenet BVBA*. This judgment is another important element in balancing the rights to protect intellectual property and the right to

privacy, as well as determining the rights of copyright trolls. The Court set out the conditions for sharing customer data with peer-to-peer networks. According to the author, the green light on sharing personal data of Internet users with copyright trolls will undoubtedly intensify the activities of the latter. Protecting the rights of copyright trolls is contrary to the purpose and axiology of copyright.

**Keywords:** copyright, access to culture, open culture, copyright trolls, abuse of law, CJEU.

## Streszczenie

*Ewa Milczarek*

### **Prawa trolli autorskich w dyrektywie 2004/48/WE – równowaga między prawem do prywatności a prawem autorskim**

Glosa dotyczy wyroku TSUE z dnia 17 czerwca 2021 r. w sprawie C-597/19, Mircom International Content Management & Consulting Limited przeciwko Telenet BVBA. Wyrok ten stanowi kolejny, istotny element wyważenia praw ochrony własności intelektualnej i prawa do prywatności oraz określenia uprawnień trolli prawnoautorskich. Trybunał określił w nim warunki udostępnienia danych klientów sieci peer-to-peer. Według autorki zielone światło do udostępniania trollom prawnoautorskim danych osobowych użytkowników sieci spowoduje bez wątpienia zintensyfikowanie ich działalności. Ochrona praw trolli prawnoautorskich mija się z celem i aksjologią praw autorskich.

**Słowa kluczowe:** prawo autorskie, dostęp do kultury, otwarta kultura, trolle prawnoautorskie, nadużycie prawa, TSUE.

# Obligations Imposed on Online Content-Sharing Service Providers and Freedom of Expression and Information

Judgment of the Court of Justice of the European Union of 26 April 2022, C-401/19<sup>1</sup>

**The obligation on online content-sharing service providers to review, prior to its dissemination to the public, the content that users wish to upload to their platforms, resulting from the specific liability regime established in Article 17(4) of Directive 2019/790, and in particular from the conditions for exemption from liability laid down in point (b) and point (c), *in fine*, of Article 17(4) of that directive, has been accompanied by appropriate safeguards by the EU legislature in order to ensure, in accordance with Article 52(1) of the Charter, respect for the right to freedom of expression and information of the users of those services, guaranteed by Article 11 of the Charter, and a fair balance between that right, on the one hand, and the right to intellectual property, protected by Article 17(2) of the Charter, on the other.**

**Aleksandra Górska-Jankowska**

University of Gdańsk, Poland

aleksandra.gorska-jankowska@phdstud.ug.edu.pl

ORCID: 0000-0002-6326-4703

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## Commentary

### 1. Legal framework of online content-sharing service providers' liability

Directive 2019/790<sup>2</sup> was enacted to harmonize and modernize the copyright framework within the European Union's internal market, addressing the challenges posed by rapid technological advancements and the digital environment. The objective of Directive

<sup>1</sup> ECLI:EU:C:2022:297.

<sup>2</sup> Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on Copyright and Related Rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC, OJ L 130, 17.5.2019, pp. 92–125.

2019/790 is also to balance the protection of rightholders with the promotion of cultural diversity and access to content and to reduce legal uncertainties concerning the use of works in digital and cross-border contexts, ensuring a fair, well-functioning marketplace for copyright.<sup>3</sup> Article 17, which stands out as the most controversial provision of this Directive and serves as the foundation for the judgment under review, pertains to the liability of online content-sharing service providers (OCSSPs). Until Article 17 entered into force, the liability of OCSSPs for giving the public access to protected content, uploaded to their platforms by their users in breach of copyright, was governed by Article 3 of Directive 2001/29<sup>4</sup> and Article 14 of Directive 2000/31.<sup>5</sup> Previously, service providers were exempt from liability, on the condition that: (a) the provider does not have actual knowledge of illegal activity or information and as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or (b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.<sup>6</sup> In the YouTube and Cyando ruling,<sup>7</sup> the Court of Justice of the European Union (CJEU) also clarifies that, in accordance with Article 3(1) of Directive 2001/29, the operator of a video-sharing platform or a file-hosting and file-sharing platform, on which users can illegally make protected content available to the public, does not make a “communication to the public” of that content, unless it contributes, beyond merely making that platform available, to giving access to such content to the public in breach of copyright. However, as indicated in recital 61 and 66 of Directive 2019/790, such rules of liability of service providers had to be modified due to recent changes in the functioning of the online content marketplace. The EU legislature decided that, since content-sharing services providing access to a large amount of copyright-protected content have become a main source of access to content online, it was necessary to provide a specific liability mechanism in respect of the providers of those services in order to foster the development of a fair licensing market between rightholders and those service providers. Instead, the mechanism introduced by Article 17 stipulates that the OCSSPs perform an act of communication to the public or an act of making available to the public when it gives the public access to copyright-protected works or other protected subject matter uploaded by its users and that it must, therefore, obtain an authorisation from the rightholders for that purpose, for instance by concluding a licensing agreement. Accordingly, the awareness of OCSSPs that the files to which it has granted access contain illegally distributed works is irrelevant to its liability. In

<sup>3</sup> Recitals 1–3 of the Directive 2019/790.

<sup>4</sup> 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, OJ L 167, 22.6.2001, pp. 10–19.

<sup>5</sup> Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market, OJ L 178, 17.7.2000, pp. 1–16.

<sup>6</sup> Article 14(1) of Directive 2000/31/EC.

<sup>7</sup> Ruling in joined cases C-682/18 (YouTube) and C-683/18 (Cyando), ECLI:EU:C:2021:503.

addition, Article 17(4) of Directive 2019/790 introduces new rules for exemption from liability where authorization has not been granted. OCSSPs may exempt themselves from liability for acts of making available or communicating copyright-infringing content only under certain cumulative conditions, which are listed in paragraphs (a) through (c) of the provision. According to them, in the event of failure to obtain permission from the rightholders, such service providers shall be liable, unless they demonstrate that they have: “(a) made best efforts to obtain an authorisation, and (b) made, in accordance with high industry standards of professional diligence, best efforts to ensure the unavailability of specific works and other subject matter for which the rightholders have provided the service providers with the relevant and necessary information; and in any event (c) acted expeditiously, upon receiving a sufficiently substantiated notice from the rightholders, to disable access to, or to remove from their websites, the notified works or other subject matter, and made best efforts to prevent their future uploads in accordance with point (b).”<sup>8</sup> The new regulation thus includes an obligation to both take steps to obtain permission from rightholders and to take steps directed at blocking those works that have been reported by rightholders. While some of these obligations address existing violations, the majority are preventive in nature. Furthermore, these duties hinge on the provider’s commitment to making “best efforts.”

The introduction of Article 17 was widely commented on by European legal scholars. It was criticized, among other things, that this regulation is contradictory, ambiguous, and therefore difficult to implement, harmful to small and medium-sized enterprises, and, above all, that it interfered with fundamental rights, such as artistic freedom and the right to access information.<sup>9</sup>

## 2. Judgment of 26 April 2022 in case C-401/19

### 2.1. The Republic of Poland’s challenge to Directive 2019/790: balancing copyright protection with fundamental rights

The Republic of Poland has asked the CJEU, principally, to annul Article 17(4), point (b), and point (c), *in fine*, of Directive 2019/790 and, in the alternative, should the Court consider that those provisions cannot be severed from the other provisions of Article 17 of Directive 2019/790 without altering the substance thereof, to annul Article 17 of

<sup>8</sup> Article 17(4) of the Directive 2019/790.

<sup>9</sup> See: P. Samuelson, *Hearing on Copyright Law in Foreign Jurisdictions: How Are Other Countries Handling Digital Piracy?*, Before the United States Senate Committee on the Judiciary Subcommittee on Intellectual Property 116<sup>th</sup> Congress, 2020, <https://www.judiciary.senate.gov/imo/media/doc/Samuelson%20Testimony.pdf>, quoted in: R. Markiewicz, 9.3. *Zagadnienia szczególne* [in:] *idem*, *Prawo autorskie na jednolitym rynku cyfrowym. Dyrektywa Parlamentu Europejskiego i Rady (UE) 2019/790*, Warszawa 2021 (unless indicated otherwise, all translations from Polish are made by the author of the article).



that directive in its entirety. The Republic of Poland claimed that the abovementioned provisions violate the right to freedom of expression and information, guaranteed by Article 11 of the Charter of Fundamental Rights (Charter), according to which, “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.”<sup>10</sup> The Polish plea was based on the argument that OCSSPs are required to monitor all user-uploaded content to avoid copyright violations, as mandated by Article 17(4) of Directive 2019/790. To achieve this, these platforms should employ technology that can automatically filter content beforehand. However, by enforcing such preemptive monitoring without ensuring the protection of freedom of expression and information, it is believed that the contested provisions “constitute a limitation on the exercise of that fundamental right”<sup>11</sup> and since this infringement does not meet all criteria indicated in Article 52(1) of the Charter (does not respect the essence of that right and principle of proportionality), it is thus viewed by the Republic of Poland as unjustifiable.

The Republic of Poland’s legal action was not supported by any of the EU Member States. The Kingdom of Spain, the French Republic, the Portuguese Republic, and the European Commission were granted leave to intervene in support of the forms of order sought by the European Parliament and the Council of the European Union.

## 2.2. The ruling of the Court of Justice of the European Union

The CJEU ruled in the Grand Chamber due to the fundamental significance of the issue at hand. The Court disagreed with the argumentation presented by the Polish side and rejected the plea advanced by Poland in support of its action. The CJEU began its consideration of the admissibility of the action brought by the Republic of Poland. It pointed out that action for annulment of only part of Article 17 is inadmissible, as it would change the essence of the provision and create a liability system that would be more favorable to OCSSPs. However, the Polish claim submitted in the alternative (to annul Article 17 in its entirety) the Court found admissible.<sup>12</sup> The CJEU concluded that, contrary to the defendant’s (European Parliament and Council of the European Union) claim, the liability regime, established in Article 17(4) of Directive 2019/790, entails a limitation on the exercise of the right to freedom of expression and information of users of content-sharing services guaranteed in Article 11 of the Charter.<sup>13</sup> The Court pointed out, however, that this limitation meets the requirements laid down in Article 52(1) of the Charter, i.e. it is provided for by law<sup>14</sup> and respects the essence of those

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<sup>10</sup> Charter of Fundamental Rights of the European Union, Article 11, OJ C 326, 26.10.2012, pp. 391–407.

<sup>11</sup> Judgment of the CJEU of 26 April 2022 in Case C-401/19, Republic of Poland v. European Parliament and Council of the European Union, EU:C:2022:297 (“Case C-401/19”), para 24.

<sup>12</sup> Case C-401/19, para 16–22.

<sup>13</sup> Case C-401/19, para 56 and 58.

<sup>14</sup> Case C-401/19, para 72.

rights and freedoms,<sup>15</sup> is necessary<sup>16</sup> and genuinely meets objectives of general interest recognised by the EU or the need to protect the rights and freedom of others<sup>17</sup> and also it does not disproportionately restrict the right to freedom of expression and information of users of those services.<sup>18</sup> The Court also identified the following arguments in support of the position that such limitation does not disproportionately restrict the right to freedom of expression and information of users of those services:

1. The EU legislature laid down a clear and precise limit on the measures that may be taken or required in implementing the obligations laid down in point (b) and point (c), *in fine*, of Article 17(4) of Directive 2019/790;<sup>19</sup>
2. Article 17(7) of Directive 2019/790 requires Member States to ensure that users in each Member State are authorised to upload and make available content generated by themselves for the specific purposes of quotation, criticism, review, caricature, parody, or pastiche;<sup>20</sup>
3. The liability of service providers can be incurred only on condition that the right-holders concerned provide them with the relevant and necessary information with regard to that content;<sup>21</sup>
4. Article 17(8) of Directive 2019/790 provides an additional safeguard for ensuring that the right to freedom of expression and information of users of online content-sharing services is observed by stating clearly that the application of this provision must not lead to any general monitoring obligation;<sup>22</sup>
5. Article 17(9) of Directive 2019/790 introduces several additional procedural safeguards, which protect the right to freedom of expression and the information of users of online content-sharing services in case such providers block content unlawfully;<sup>23</sup>
6. Article 17(10) of Directive 2019/790 supplements the system of safeguards by requiring the Commission to organize, in cooperation with Member States, stakeholder dialogues to discuss best practices for cooperation between OCSSPs and rightholders.<sup>24</sup>

On the basis of these findings, the CJEU pointed out that the obligation imposed on online content-sharing has been accompanied by appropriate safeguards by the EU legislature in order to ensure, in accordance with Article 52(1) of the Charter, “respect for the right to freedom of expression and information of the users of those services, guaranteed by Article 11 of the Charter, and a fair balance between that right,

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<sup>15</sup> Case C-401/19, para 76.

<sup>16</sup> Case C-401/19, para 83.

<sup>17</sup> Case C-401/19, para 82.

<sup>18</sup> Case C-401/19, para 84.

<sup>19</sup> Case C-401/19, para 85.

<sup>20</sup> Case C-401/19, para 87.

<sup>21</sup> Case C-401/19, para 89.

<sup>22</sup> Case C-401/19, para 90.

<sup>23</sup> Case C-401/19, para 93.

<sup>24</sup> Case C-401/19, para 96.

on the one hand, and the right to intellectual property, protected by Article 17(2) of the Charter, on the other.”<sup>25</sup>

### 3. Commentary on the judgment

Addressing the position expressed by the Court, it should first be noted that in the C-401/19 ruling, the Court of Justice of the European Union essentially performed a Dworkinian weighing of principles:<sup>26</sup> its interpretation focused on the conflict between the users' right to freedom of expression and information, guaranteed by Article 11 of the Charter and the need to protect intellectual property guaranteed in Article 17(2) of the Charter. In fact, it is worth mentioning that the ruling could also have been analyzed through the prism of violations of other fundamental rights, such as freedom to conduct business, freedom to communicate and receive information, freedom of artistic creativity, the right to privacy, the right to a fair trial or the right to property, but the Polish challenge was limited only to the issue of freedom of speech.<sup>27</sup> While the Court's judgment is regarded as the “CJEU's most significant digital speech ruling today”<sup>28</sup> and “one of the silent blocks of European digital constitutionalism,”<sup>29</sup> it was hoped that the ruling would clarify some of the ambiguous concepts contained in the provision in question.<sup>30</sup> However, one must note that the CJEU fell short of providing Member States with sufficient guidance on the implementation of this new liability framework.

The author endorses part of the C-401/19 ruling in which the CJEU clarified that the filtering adopted by OCSSPs applies to only those means that are “strictly targeted.”<sup>31</sup> Although it is not clarified in the judgement what exactly the CJUE meant by this term, it needs to be highlighted that for OCSSPs this interpretation means that they must refrain from systematic, large-scale content blocking. One should also approve the Court's view that a filtering system that fails to accurately differentiate between lawful and unlawful content, potentially blocking lawful communication infringes upon the

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<sup>25</sup> Case C-401/19, para 98.

<sup>26</sup> G. Maroń, *Dworkinowska wizja zasad prawa*, “Zeszyty Naukowe Uniwersytetu Rzeszowskiego” 2008, iss. 8, p. 107.

<sup>27</sup> Ch. Geiger, B.J. Jütte, *Platform liability under Article 17 of the Copyright in the Digital Single Market Directive, Automated Filtering and Fundamental Rights: An Impossible Match*, “GRUR International” 2021, vol. 70(6), pp. 523–530, quoted in: R. Markiewicz, 3.3. Art. 17 dyrektywy 2019/790 a zasada proporcjonalności [in:] *idem, Zasada proporcjonalności w prawie autorskim w Unii Europejskiej*, Warszawa 2023.

<sup>28</sup> M. Husovec, *Mandatory Filtering Does Not Always Violate Freedom of Expression: Important Lessons from Poland v Council and European Parliament (C-401/19)*, “Common Market Law Review” 2023, vol. 60, no. 1, pp. 173–198.

<sup>29</sup> *Ibid.*

<sup>30</sup> R. Markiewicz, *Prawo autorskie na jednolitym rynku cyfrowym...*, p. 245.

<sup>31</sup> Case C-401/19, para 81.

right to freedom of expression and information as guaranteed by Article 11 of the Charter.<sup>32</sup>

Additionally, it needs to be noted that, although CJEU's attempt to protect users' rights should be endorsed, the expectation for a machine to tell the difference between lawful parody and unlawful infringement appears challenging. As indicated in the literature, contemporary algorithms are known to be "technically sophisticated but legally blind."<sup>33</sup> As an illustration of such a limitation, consider the case of the photograph titled "Napalm Girl," which ignited a discussion on the Internet several years ago regarding content moderation algorithms and their implications for online freedom of expression. The photograph taken by Nick Ut during the Vietnam War captures the harrowing moment when Phan Thị Kim Phúc, a young girl runs naked and terrified down a road after a napalm attack. This image, which won the Pulitzer Prize in 1973, has since become emblematic of the horrors of war and its profound impact on innocent civilians. In 2016, Facebook removed this photograph from a post made by the editor of the Norwegian newspaper *Aftenposten*, citing its policy against displaying nudity. This decision was met with widespread criticism, as many argued that the platform's algorithm failed to distinguish between explicit content and historically significant images.<sup>34</sup> In protest against this policy, many Facebook users, including the prime minister of Norway, posted this photograph on their Facebook pages; however, Facebook removed them as well. This incident sparked a broader discussion about the challenges of content moderation in the digital age, which is also relevant to the judgment in question. Relying on algorithms to make nuanced decisions about content appropriateness (in the case of the "Napalm Girl" photograph) or lawfulness (in the case of the CJEU judgment in question) is problematic at best. While artificial intelligence systems perform admirably in the face of many, often very complex tasks, it is difficult to expect them to become judges in their own case and to be able to distinguish between a parody that is permitted by law and unlawful acts of users, which is often a challenge even for humans. This is because artificial intelligence does not cope with contextual thinking, which is crucial in such matters. As a result, these technological systems may not work best in legally relevant situations and may provide false positives. In addition, OCSSPs may have an incentive to overblock content on their platforms due to the fear of being held liable for copyright infringement. In the context of the risk of excessive blocking, it is also worth noting the issue of "delegated law enforcement" within the European Union. This concept has been explored in scholarly literature and is described as a "situation when the law expects platforms to act as enforcers of the law, by entrusting them with various tasks, such as the removal of content."<sup>35</sup> This problem in relation to Directive 2019/790, was highlighted by Advocate

<sup>32</sup> Case C-401/19, para 86.

<sup>33</sup> M. Husovec, *Mandatory...*, pp. 173–198.

<sup>34</sup> <https://www.bbc.com/news/technology-37318031> [accessed: 2024.04.05]; <https://www.theguardian.com/technology/2016/sep/09/facebook-reinstates-napalm-girl-photo> [accessed: 2024.04.05].

<sup>35</sup> M. Husovec, *Mandatory...*, pp. 173–198. See also: *idem*, (Ir)Responsible Legislature? Speech Risks

General (AG) Henrik Saugmandsgaard Øe. The AG argued that the EU legislator, by placing obligations on OCSSPs, essentially entrusts the duty of proper copyright law application to private entities.<sup>36</sup> Drawing a parallel, the AG referred to the judgment of the ECHR from 25 March 1993 in *Costello-Roberts v. the United Kingdom*, according to which “the State cannot evade its responsibility by transferring its obligations to private entities or individuals.”<sup>37</sup> The CJEU followed the AG’s opinion, pointing out that Member States when transposing Article 17 of Directive 2019/790 into national law, should interpret this provision in such a way as to ensure a fair balance between the various fundamental rights protected by Charter.<sup>38</sup> The CJEU’s conclusion should be also approved. However, the Court does not say how to achieve this balance, which leaves Member States with discretion in implementing Article 17 into their national legal orders. Although some level of leeway with respect to national implementation is desired – especially considering the rapid development of advanced technologies – some directions from the Court on interpreting terms like “strictly targeting” would be desirable. Such guidance would be pertinent not only for Member States, but also for national courts, users, and the providers themselves. However, in the absence of a more detailed explanation from the CJEU, Member States must decide for themselves how to maintain this “fair balance.”<sup>39</sup> As a result, despite the ruling, there is no consensus on how to implement Article 17 into national law. European Intellectual Property scholars have adopted two main ideas regarding the implementation process:<sup>40</sup> a “copy-paste” approach,<sup>41</sup> according to which the implementation should involve a literal transfer of the content of the Directive into national legislation, and the second, more proactive approach, emphasizing the need for such implementation, which will include a system of guarantees of users’ rights.<sup>42</sup> Different ideas about how to implement this provision

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under the EU’s Rules on Delegated Digital Enforcement, SSRN, September 2021, [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3784149](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3784149) [accessed: 2024.04.05].

<sup>36</sup> Opinion of Advocate General Saugmandsgaard Øe, *Republic of Poland v. European Parliament and Council of the European Union* (C-401/19), ECLI:EU:C:2021:613, para 84.

<sup>37</sup> European Court of Human Rights ruling of 25 March 1993, *Costello-Roberts v. the United Kingdom*, CE:ECHR:1993:0325JUD001313487, para 27.

<sup>38</sup> Case C-401/19, para 99.

<sup>39</sup> B.J. Jütte, G. Priora, *CJEU Rejects Poland’s Challenge to Preventive Upload Filtering to Combat Copyright Infringement on Online Platforms (Case C-401/19)*, “EIPR” 2022, vol. 44, no. 10, pp. 8–9.

<sup>40</sup> K. Gliściński, *Gwarancje ex ante praw użytkowników na tle wyroku Trybunału Sprawiedliwości z 26.04.2022 r., C-401/19, Rzeczpospolita Polska przeciwko Parlamentowi Europejskiemu i Radzie Unii Europejskiej*, “Europejski Przegląd Sądowy” 2023, no. 3(210), pp. 30–31.

<sup>41</sup> Postulated by, among others, E. Rosati, *The legal nature of Article 17 of the Copyright DSM Directive, the (lack of) freedom of Member States and why the German implementation proposal is not compatible with EU law*, “Journal of Intellectual Property Law & Practice” 2020, vol. 15, iss. 11, pp. 874–878, also: *eadem*, *What does the CJEU judgment in the Polish challenge to Article 17 (C-401/19) mean for the transposition and application of that provision?*, The IPKat, May 2022, <https://ipkitten.blogspot.com/2022/05/what-does-cjeu-judgment-in-polish.html> [accessed: 2024.04.05].

<sup>42</sup> Postulated by, among others, by: F. Reda, P. Keller, *CJEU upholds Article 17, but not in the form (most) Member States imagined*, Kluwer Copyright Blog, April 2022, <https://copyrightblog.kluweriplaw.com/2022/04/28/cjeu-upholds-article-17-but-not-in-the-form-most-member-states-imagined/> [accessed: 2024.04.05]; M. Senftleben, *The Meaning of “Additional” in the Poland ruling of the Court of*

will inevitably lead to a variety of legal solutions, creating potential legal uncertainties for users. In summary, the Court's conclusion that the implementation of Article 17 of Directive 2019/790 into national laws must strictly comply with the fundamental rights of users receives full endorsement. However, the judgment does not offer guidance on how to integrate these provisions into national legal systems, leaving the responsibility to achieve this "fair balance" to Member States.

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## Summary

*Aleksandra Górka-Jankowska*

### Obligations Imposed on Online Content-Sharing Service Providers and Freedom of Expression and Information

The subject of the commentary is related to the judgment of the CJEU of 26 April 2022 in case C-401/19 Republic of Poland v. European Parliament and Council of the European Union, in which the court addressed one of the more widely discussed regulations in the doctrine of copyright law in the European Union, namely the new liability rules for providers of online content-sharing service providers. In essence, the issue concerns the relationship between intellectual property protection and Internet users' right to freedom of expression and information. The CJEU upheld Article 17 of Directive 2019/790, emphasizing that it contains the necessary safeguards to maintain a fair balance between the right to freedom of expression of information of the users of online content-sharing services, and the right to intellectual property.

**Keywords:** Directive 2019/790, overblocking, freedom of expression, delegated enforcement, Article 17 CDSM, Copyright, platform regulation, upload filters, OCSSPs.

## Streszczenie

*Aleksandra Górka-Jankowska*

### Obowiązki nałożone na dostawców usług udostępniania treści online a wolność wypowiedzi i informacji

Tematem glosy jest wyrok TSUE z 26 kwietnia 2022 r. w sprawie C-401/19 Rzeczpospolita Polska przeciwko Parlamentowi Europejskiemu i Radzie Unii Europejskiej, w którym Trybunał odniósł się do jednego z szeroko dyskutowanych przepisów w doktrynie prawa autorskiego w Unii Europejskiej, a mianowicie nowych zasad odpowiedzialności dla dostawców usług udostępniania treści online. W istocie problem dotyczy relacji między ochroną własności intelektualnej a prawem użytkowników Internetu do wolności wypowiedzi i informacji. TSUE utrzymał w mocy art. 17 dyrektywy 2019/790, podkreślając, że jest on otoczony odpowiednimi gwarancjami w celu zapewnienia sprawiedliwej równowagi między prawem do wolności wypowiedzi i informacji a prawem własności intelektualnej.

**Słowa kluczowe:** dyrektywa 2019/790, nadmierne blokowanie treści, wolność słowa w Internecie, delegowane egzekwowanie prawa, art. 17 DSM, prawo autorskie, regulacja platform cyfrowych, DUUTO.



## Towards e-Lending by Libraries

Judgment of the Court of Justice of the European Union of 10 November 2016, C-174/15<sup>1</sup>

1. Article 1(1), Article 2(1)(b) and Article 6(1) of Directive 2006/115/EC [...] on rental right and lending right and on certain rights related to copyright in the field of intellectual property must be interpreted as meaning that the concept of 'lending', within the meaning of those provisions, covers the lending of a digital copy of a book, where that lending is carried out by placing that copy on the server of a public library and allowing a user to reproduce that copy by downloading it onto his own computer, bearing in mind that only one copy may be downloaded during the lending period and that, after that period has expired, the downloaded copy can no longer be used by that user.
2. EU law, and in particular Article 6 of Directive 2006/115, must be interpreted as not precluding a Member State from making the application of Article 6(1) of Directive 2006/115 subject to the condition that the digital copy of a book made available by the public library must have been put into circulation by a first sale or other transfer of ownership of that copy in the European Union by the holder of the right of distribution to the public or with his consent [...].
3. Article 6(1) of Directive 2006/115 must be interpreted as meaning that it precludes the public lending exception laid down therein from applying to the making available by a public library of a digital copy of a book in the case where that copy was obtained from an illegal source.

### **Konrad Gliściński**

Jagiellonian University, Poland

[konrad.gliscinski@uj.edu.pl](mailto:konrad.gliscinski@uj.edu.pl)

ORCID: 0000-0002-2532-3856

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<sup>1</sup> Judgment of the Court (Third Chamber) of 10 November 2016, Case C-174/15 (Vereniging Openbare Bibliotheken v. Stichting Leenrecht), EU:C:2016:856.

## Commentary

### 1. The facts of the case

The judgment was issued in a dispute between *Vereniging Openbare Bibliotheken* (Netherlands Association of Public Libraries [VOB]) and *Stichting Leenrecht*, the foundation designated to collect public lending right (PLR) payments. The dispute concerned whether, under the applicable provisions of Dutch law, the derogation from the exclusive right to lend books also covers the lending of electronic copies. In connection with ongoing legislative work, the Netherlands Ministry of Education, Culture, and Science commissioned a report on this matter. The report adopted a traditional approach, stating that the exclusive lending right, as defined in the Rental and Lending Directive,<sup>2</sup> and the derogation provided for in Article 6(1) of that directive, apply only to physical copies of books. As a result, it was determined that it is not possible to introduce a national law exception allowing libraries to lend books in digital form (e-lending). Based on this traditional position, the government prepared a draft law.

VOB did not share this view, arguing that the relevant provisions of Dutch law also apply to digital lending. This association brought court proceedings in which it sought a declaration that, essentially, Dutch copyright law already covers digital lending, especially in the “one copy, one user” model. The district court in The Hague found that answering the questions raised by VOB requires the interpretation of EU law provisions.

### 2. Judgment of the Court

The Court found that the fundamental question in the present case was “whether Article 1(1), Article 2(1)(b) and Article 6(1) of Directive 2006/115 must be interpreted as meaning that the concept of ‘lending’, within the meaning of those provisions, covers the lending of a digital copy of a book, where that lending is carried out by placing that copy on the server of a public library and allowing the user concerned to reproduce that copy by downloading it onto his own computer, bearing in mind that only one copy may be downloaded during the lending period and that, after that period has expired, the downloaded copy can no longer be used by that user.”<sup>3</sup>

CJEU noted that Article 1(1) of Directive 2006/115, “does not specify whether the concept of ‘copies of copyright works’, within the meaning of that provision, also covers

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<sup>2</sup> Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property, OJ L 376, 27.12.2006, pp. 28–35.

<sup>3</sup> Judgment of the Court (Third Chamber) of 10 November 2016, Case C-174/15 (*Vereniging Openbare Bibliotheken v. Stichting Leenrecht*).

copies which are not fixed in a physical medium, such as digital copies.”<sup>4</sup> Additionally, the court highlighted that the definition of lending, as found in Article 2(1)(b) of that directive, does not specify whether the scope of lending should exclusively encompass physical copies of works or if it could also include intangible items like digital copies. This opened the way for the court “to examine whether that are grounds to justify the exclusion, in all cases, of the lending of digital copies and intangible objects from the scope of Directive 2006/115.”<sup>5</sup>

The court noted that the WIPO Copyright Treaty and Agreed Statements clarify that the terms “original” and “copies,” in Article 7 of that treaty, in relation to the right of rental, refer “exclusively to fixed copies that can be put into circulation as tangible objects.”<sup>6</sup> Consequently, this means the need to interpret “rental” in Article 2(1)(a) of Directive 2006/115 as referring exclusively to tangible objects and “copies” in Article 1(1) of the directive as referring to physical copies for rental purposes.<sup>7</sup> However, this treaty does not address lending rights nor does any other international copyright law. Therefore, Directive 2006/115 serves as the only source of lending rights. Also, according to the Court, there is no need to consider that “EU Legislation necessarily intended to give the same meaning to the concepts of ‘objects’ and ‘copies,’ whether with regard to the rental system or to the lending system.”<sup>8</sup> This is because “the EU legislature sought to define the concepts of ‘rental’ and ‘lending’ separately. Thus the subject matter of ‘rental’ is not necessarily identical to that of ‘lending.’”<sup>9</sup> Therefore, there are no reasons from international law or the history of Directive 2006/115 that would require excluding digital copies and intangible objects from this Directive in all cases.

In the court’s opinion, a different conclusion is justified because of the directive’s purpose. “Recital 4 of that directive states, inter alia, that copyright must adapt to new economic developments such as new forms of exploitation. Lending carried out digitally indisputably forms part of those new forms of exploitation and, accordingly, makes necessary an adaptation of copyright to new economic developments.”<sup>10</sup> Moreover, “the general principle of requiring a high level of protection for authors”<sup>11</sup> supports the idea that lending rights cover both physical and digital copies. This is because implementing an exception to exclusive lending rights by a Member State requires compensating authors for lending (Article 6(1) of Directive 2006/115).

According to the Court, the lending of digital copies of books by public libraries may fall within the scope of a derogation from the exclusive right of lending if it

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<sup>4</sup> *Ibid.*, point 28.

<sup>5</sup> *Ibid.*, point 30.

<sup>6</sup> *Ibid.*, point 34.

<sup>7</sup> *Ibid.*, point 35.

<sup>8</sup> *Ibid.*, point 36.

<sup>9</sup> *Ibid.*, point 38.

<sup>10</sup> *Ibid.*, point 45.

<sup>11</sup> *Ibid.*, point 46.

“has essentially similar characteristics to the lending of printed works.”<sup>12</sup> This is the characteristic of the model that is the subject of the proceedings, according to which the lending of a digital copy of a book takes place by “placing it on the server of the public library and allowing the user concerned to reproduce that copy by downloading it onto his own computer, bearing in mind that only one copy may be downloaded during the lending period and that, after that period has expired, the downloaded copy can no longer be used by that user.”<sup>13</sup> This assessment results from the fact that, first, “the limitation of simultaneous downloads to a single copy implies that the lending capacity of the library concerned does not exceed that which it would have as regards a printed work and, secondly, that lending is made for only a limited period.”<sup>14</sup>

The court found that e-lending in the “one copy, one user” model aligns with Directive 2006/115. At the same time, the CJEU allowed the possibility of introducing additional requirements at the national level. In particular, Member States can add to their national laws a requirement that “the digital copy of a book made available by the public library must have been put into circulation by a first sale or other transfer of ownership of that copy in the European Union by the holder of the right of distribution to the public or with his consent.”<sup>15</sup> Moreover, the CJEU pointed out that the possibility of e-lending depends on libraries using digital copies of books from a legal source.<sup>16</sup>

### 3. Dynamic interpretation of UE law

There is no doubt that the interpretation adopted by the Court significantly departs from the previously prevalent interpretation of EU law.<sup>17</sup> According to the traditional approach, which was also acknowledged by the Dutch government, it was presumed that lending rights exclusively pertained to the lending of tangible copies of works. Under this interpretation, e-lending, which involves providing access for a limited duration, without direct or indirect economic or commercial gain, through facilities accessible to the public, of digital copies of works, did not fall within the concept of lending. These activities were deemed a form of the right to communicate works to the public as defined in Article 3 of the InfoSoc Directive.<sup>18</sup> Consequently, this interpretation established that libraries could not engage in e-lending without the consent of rights holders. This is because none of the exceptions to the exclusive right outlined in Article 5 of the InfoSoc Directive could serve as the basis for such activities.

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<sup>12</sup> *Ibid.*, point 51.

<sup>13</sup> *Ibid.*, point 52.

<sup>14</sup> *Ibid.*, point 53.

<sup>15</sup> *Ibid.*, point 65.

<sup>16</sup> *Ibid.*, point 72.

<sup>17</sup> Cf. S. Dusollier, *A manifesto for an e-lending limitation in copyright*, “JIPITEC” 2014, vol. 5, 213 para 1.

<sup>18</sup> 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, OJ L 167, 22.6.2001, pp. 10–19.

However, due to the “importance of the public lending of digital books, and in order to safeguard both the effectiveness of the derogation for public lending referred to in Article 6(1) of Directive 2006/115 (‘the public lending exception’) and the contribution of that exception to cultural promotion,”<sup>19</sup> the CJEU found that the possibility of e-lending cannot be excluded in all cases. The Court concurred with the view of Attorney General Maciej Szpunar, who highlighted that “books are not regarded as an ordinary commodity and that literary creation is not a simple economic activity. The importance of books for the preservation of, and access to culture and scientific knowledge has always taken precedence over considerations of a purely economic nature.”<sup>20</sup>

The role of the public lending exception is to enable the library to conduct its activities. “Today, in the digital age, libraries must be able to continue to fulfill the task of cultural preservation and dissemination that they performed when books existed only in paper format.”<sup>21</sup> According to the Attorney General, “in fields where technological progress has a profound effect, such as copyright”<sup>22</sup> justifies referring to the dynamic interpretation of law. “The anachronistic character of obsolete legal rules is a common source of interpretative problems, uncertainty and juridical lacunae. In such cases, only an adjusted judicial interpretation will be able to ensure the effectiveness of the legislation in question in a sector experiencing such rapid technological and economic development.”<sup>23</sup>

The court emphasized that when interpreting exceptions to copyright law must be interpreted strictly.<sup>24</sup> At the same time, the CJEU reiterated that “the interpretation given must also enable the effectiveness of the exception thereby established to be safeguarded and its purpose to be observed.”<sup>25</sup> This approach is consistently reaffirmed in subsequent Court judgments. This is primarily because there is an increasing emphasis on the necessity of considering the dimension of fundamental rights in the interpretation of copyright provisions. “[T]he recourse to fundamental rights-based reasoning in CJEU case law has sharply increased since the Treaty of Lisbon came into force, through which the Charter of Fundamental Rights of the EU3 (Charter) acquired legally binding character.”<sup>26</sup>

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<sup>19</sup> Judgment of the Court (Third Chamber) of 10 November 2016, Case C-174/15 (Vereniging Openbare Bibliotheken v. Stichting Leenrecht), point 51.

<sup>20</sup> Advocate General Szpunar, 16 June 2016 (opinion), Case C-174/15 (Vereniging Openbare Bibliotheken v. Stichting Leenrecht), point 37.

<sup>21</sup> *Ibid.*, point 38.

<sup>22</sup> *Ibid.*, point 28.

<sup>23</sup> *Ibid.*

<sup>24</sup> Judgment of the Court (Third Chamber) of 10 November 2016, Case C-174/15 (Vereniging Openbare Bibliotheken v. Stichting Leenrecht), point 50.

<sup>25</sup> *Ibid.*

<sup>26</sup> T. Rendas, *Fundamental rights in EU copyright law* [in:] *The Routledge handbook of EU copyright law*, ed. E. Rosati, New York 2021, p. 19.

#### 4. Functional equivalence

The means of achieving compliance between these requirements (strict interpretation vs the effectiveness of the exception) is an approach grounded in the concept of functional equivalence. This concept is manifested in various interpretations in the Court's case law. In the case under analysis, it pertains to entities that are functionally equivalent from an economic standpoint.<sup>27</sup> The adoption of such an interpretation was possible thanks to the recognition that e-lending digital copies of books "has essentially similar characteristics to the lending of printed works."<sup>28</sup> Acknowledging the existence of functional equivalence between both types of lending enabled the development of a flexible interpretation of the derogation from the exclusive right. While the Court did not explicitly state it, embracing such equivalence must imply that e-lending does not infringe upon the three-step test of either European law or international treaties. Nevertheless, for a specific model of e-lending digital copies to be deemed the functional equivalent of lending physical copies of works, it must satisfy particular conditions.

The form of e-lending considered in these proceedings and recognized by the Court as having essentially similar characteristics to the lending of printed works was the "one copy, one user" model. First, this model created "the limitation of simultaneous downloads to a single copy implies that the lending capacity of the library concerned does not exceed that which it would have as regards a printed work."<sup>29</sup> Secondly, lending is made for a limited period.<sup>30</sup> In practice, this requires a library interested in such e-lending employs some form of digital rights management. The question that remains is whether there are other e-lending system models with similar characteristics to lending printed works.

It appears that, in the Court's view, this approach effectively strikes a balance within the copyright system. On one hand, libraries can fulfill their public mission in the digital realm, authors should receive remuneration (PLR), and the interests of rights holders, especially publishers, are safeguarded by restricting e-lending to the "one copy, one user" model.

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<sup>27</sup> Cf. *V. Breemen, E-lending according to the ECJ: Focus on functions and similar characteristics in VOB v. Stichting Leenrecht*, "EIPR" 2017, vol. 39, no. 4, pp. 251–253.

<sup>28</sup> Judgment of the Court (Third Chamber) of 10 November 2016, Case C-174/15 (*Vereniging Openbare Bibliotheken v. Stichting Leenrecht*), point 51.

<sup>29</sup> *Ibid.*, point 53.

<sup>30</sup> *Ibid.*

## 5. Where to get a legal digital copy – practical problems and theoretical solutions

The judgment was seen as a favorable ruling in support of libraries. Regrettably, in practice, it did not lead to an increase in the availability of digital copies of books offered through e-lending in public libraries.<sup>31</sup> The judgment established that the exception from the exclusive lending right, under Directive 2006/115, includes not only the lending of physical books but also digital copies of books.

First, this judgment did not alter the fundamental nature of the public lending exception itself. It continues to be an optional provision, allowing Member States the freedom to implement it or not.

They can choose to forgo its implementation and maintain book lending regulations based entirely on the licensing model (e.g., with Collective Management Organizations).<sup>32</sup> Theoretically, they could also opt to exclude digital copies from its scope. To the best of my knowledge, no country has explicitly excluded e-lending from its regulations. Nonetheless, many of them are still influenced by a traditional interpretation, sometimes rooted in dogmatic construction of lending rights,<sup>33</sup> while in other cases, they adhere to the conventional interpretation of the concept of a “copy” of a work, understood solely as a physical copy. Particularly in the latter instances, it appears feasible to overcome such an interpretation and similarly adopt the dynamic interpretation upheld by the Court. This approach can be found in the literature on Polish law. As Aurelia Nowicka points out “the position of the CJEU may also be used in the interpretation of lending within the meaning of Article 28 sec. 1 point 1 pr. aut.”<sup>34</sup>

Second, the judgment highlights that the possibility of e-lending depends on digital copies of books used for this purpose being sourced legally. It is undisputed that such copies can come from rights holders, such as publishers or aggregators. The challenge lies in the fact that, while for physical books, libraries can simply purchase a book on the market, digital copies involve a licensing agreement rather than a straightforward sales contract. In practice, many rights holders are either uninterested in providing such licenses to libraries or offer them at significantly higher prices compared to those available to individual consumers.<sup>35</sup>

<sup>31</sup> Cf. *First European Overview on E-lending in Public Libraries. An interim report prepared by EBLIDA EGIL (Expert Group on Information Law). Country profiles and Summary Tables*, June 2022.

<sup>32</sup> E.g. the lending system in Slovak law is not based on an exception but on a collective licensing system.

<sup>33</sup> With regard to German law, cf. K. de la Durantaye, *Große Hafennrundfahrt – Optionen für eine (Neu-)Regelung des e-Lending in Deutschland*, “Zeitschrift für Urheber- und Medienrecht” 2022, vol. 66(8–9), p. 587.

<sup>34</sup> A. Nowicka, *Komentarz do ustawy o prawie autorskim i prawach pokrewnych* [in:] *Ustawy autorskie. Komentarze. Tom I*, ed. R. Markiewicz, Warszawa 2021, p. 765. See also: J. Marcinkowska, *Wyrok TSUE z 10.11.2016 r. w sprawie Vereniging Openbare Bibliotheken przeciwko Stichting Leenrecht* [in:] *Prawo autorskie. Komentarz do wybranego orzecznictwa Trybunału Sprawiedliwości UE*, eds. E. Laskowska-Litak, R. Markiewicz, Warszawa 2019.

<sup>35</sup> R. Matulionyte, *Lending e-books in libraries: Is a technology-neutral approach the solution? Get access*



The second option is to digitize the paper books that libraries have acquired. Nevertheless, for this digitization to be legal, the library must possess the appropriate rights to reproduce books for e-lending purposes. The exceptions available under EU law do not explicitly address this scenario. However, there seems to be room for interpreting provision 5(2)(c) of the InfoSoc Directive, which could serve as the foundation for such digitization. The Advocate General pointed out this potential in his opinion: “reproductions made by libraries, [...] are [...] covered by the exception to the reproduction right provided for in Article 5(2)(c) of Directive 2001/29, read in the light of the Court’s judgment in *Technische Universität Darmstadt*. [...] That provision provides for an exception to the reproduction right for ‘specific acts of reproduction made by publicly accessible libraries [...] which are not for [...] economic [...] advantage.’ In the abovementioned judgment, the Court held that that exception could apply so as to enable libraries to complete acts of communication to the public under another exception [...] By analogy, the exception under Article 5(2)(c) of the same directive ought to come into play to enable libraries to benefit from the derogation from the lending right provided for in Article 6(1) of Directive 2006/115.”<sup>36</sup>

## 6. Independent Secure Digital Lending – (i)SDL

Both the VOB and Technische Universität Darmstadt/Eugen Ulmer<sup>37</sup> (C-117/13) judgments should be placed in a broader context of libraries’ implementation of e-lending. The digitization of paper books for e-lending in the USA is often referred to as Controlled Digital Lending (CDL). However, due to differences in legal systems, e-lending based on paper books digitized by European libraries is referred to as Independent Secure Digital Lending (iSDL).<sup>38</sup> CDL is grounded in the first-sale doctrine (17 US Code § 109) and fair use (17 US Code § 107). Conversely, (i)SDL derives its legal justification from Article 6 of the Rental and Lending Directive and Article 5(2)(c) of the InfoSoc Directive. The use of the letter “i” was intended to indicate that this type of e-lending is based on books that are digitized or otherwise created by a library; it is not based on license agreements related to the use of e-books. Both models enable libraries to offer noncommercial e-lending with the following rules:

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Arrow, “International Journal of Law and Information Technology” Winter 2017, vol. 25, iss. 4, p. 261; Case C-174/15, AG Opinion, para 38.

<sup>36</sup> Advocate General Szpunar, 16 June 2016 (opinion), Case C-174/15 (Vereniging Openbare Bibliotheken v. Stichting Leenrecht), point 57.

<sup>37</sup> Judgment of the Court (Fourth Chamber) of 11 September 2014, Case C-117/13 (Technische Universität Darmstadt v. Eugen Ulmer), ECLI:EU:C:2014:2196.

<sup>38</sup> This name was adopted as part of a study “Secure Digital Lending in European libraries” conducted by the Digital Center and the Future Law Lab of the Jagiellonian University, which concerned a comparative analysis of the current state of copyright law regarding the possibility for libraries to digitize and lend books under national and European law, <https://centrumcyfrowe.pl/en/projekty/secure-digital-lending-in-european-libraries/> [accessed: 2024.04.03].

1. The library must have a legal, physical copy of a book, whether purchased or donated.
2. The library must maintain an owned-to-loan ratio, which means lending no more copies than it legally owns (owned to loaned ratio/"one copy, one user").
3. The library must take technical measures to prevent digital files from being copied or redistributed.

Both CDL and (i)SDL are conceptually based on an important limitation, according to which a library can e-lend as many electronic versions of books as it has paper copies. In other words, it must use the "one copy, one user" model. This model was accepted in the VOB ruling. However, as indicated above, the practical possibility of libraries implementing e-lending in the (i)SDL model depends, among others, on national provisions. None of the EU countries have legal regulations directly enabling e-lending. Consequently, the possibility of implementing this system will be contingent on the interpretation of existing regulations. It seems that, at least in certain EU countries, it will be feasible to employ a dynamic interpretation to uphold the fundamental rights of library users.<sup>39</sup> Interpretational difficulties at the national level pertain to both the understanding of "lending" and "copies of works" in line with the VOB CJEU ruling, as well as finding legal grounds for book digitization by libraries, similar to what occurred in the Technische Universität Darmstadt/Eugen Ulmer judgment (C-117/13).

## Conclusions

The judgment discussed above represents a significant step towards adapting exceptions and limitations to copyright law to meet the needs of technological development. In principle, one must agree that interpreting the concept of lending as encompassing both the lending of physical books and electronic books is the proper solution. At the same time, this judgment leaves a certain sense of dissatisfaction. It does not directly determine whether libraries have the right to digitize books for the purpose of e-lending, nor whether they can lend books for this purpose in contravention of licensing agreements and by circumventing technological protection measures. However, it seems that reading this judgment in conjunction with the principles established in the Darmstadt ruling permits justifying, at least to some extent, the existence of the right for libraries to digitize physical books for the purpose of e-lending. Such an interpretation means that, at the level of EU law, it is permissible for libraries to conduct e-lending within the iSDL model. However, whether this is feasible in practice depends on how exceptions for libraries are implemented in national laws.

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<sup>39</sup> The assessment of this possibility in some EU countries is the subject of the report prepared as part of the project mentioned above.

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## Summary

**Konrad Gliściński**

### Towards e-Lending by Libraries

The commentary discusses a judgment of the CJEU on the interpretation of EU law in relation to e-lending by libraries. E-lending conducted by libraries using digitized paper books is known as Independent Secure Digital Lending (iSDL), which is the European equivalent of the Control Digital Lending (CDL) system used in the USA. The Court clarified that lending digital copies of books by public libraries can be covered by the exception from the exclusive lending right provided it has similar characteristics to lending printed works. The "one copy, one user" model, where a digital copy is placed on the library's server, and only one user can download it during the lending period, aligns with Directive 2006/115. However, the practical implementation of e-lending in public libraries still faces challenges. The judgment does not change the optional nature of the public lending exception, allowing Member States the freedom to implement it or not. Many countries are influenced by traditional interpretations that limit lending only to physical copies. Moreover, for e-lending to be considered legal under EU law, libraries must possess a digital copy from a legal source. This raises the question of whether libraries can, under the existing exceptions outlined in the InfoSoc Directive, digitize their physical book copies for subsequent e-lending. This issue was not definitively addressed in this judgment, but it found support in the Advocate General's opinion. Simultaneously, due to the prevailing traditional approach to lending at the Member State level, e-lending is still not widespread in practice.

**Keywords:** e-lending, Independent Secure Digital Lending (iSDL), Control Digital Lending (CDL), definition of a copy, lending right.

## Streszczenie

*Konrad Gliściński*

### W kierunku e-użyczeń przez biblioteki

Glosa omawia orzeczenie TSUE dotyczące interpretacji prawa UE w kontekście e-użyczeń realizowanych przez biblioteki. E-użyczenia przeprowadzane przez biblioteki z wykorzystaniem zdigitalizowanych książek papierowych znane są jako Independent Secure Digital Lending (iSDL), co stanowi europejski odpowiednik systemu Control Digital Lending (CDL) stosowanego w USA. Trybunał wyjaśnił, że użyczenie cyfrowych kopii książek przez publiczne biblioteki może być objęte wyjątkiem od wyłącznego prawa do użyczenia, pod warunkiem że charakteryzuje się podobnymi cechami do wypożyczenia dzieł drukowanych. Model „jedna kopia, jeden użytkownik”, w którym cyfrowa kopia jest umieszczana na serwerze biblioteki, a tylko jeden użytkownik może ją pobrać w czasie trwania okresu użyczenia, jest zgodny z dyrektywą 2006/115. Niemniej jednak praktyczna realizacja e-użyczenia w publicznych bibliotekach wciąż napotyka wyzwania. Orzeczenie nie zmienia dobrowolnego charakteru wyjątku dotyczącego wypożyczenia publicznego, co daje państwom członkowskim swobodę w jego wdrażaniu lub rezygnacji z niego. Wiele krajów kieruje się tradycyjnymi interpretacjami, które ograniczają użyczenia jedynie do kopii fizycznych. Ponadto, aby e-użyczenia mogły być uznane za legalne w świetle prawa UE, biblioteki muszą posiadać cyfrową kopię pochodzącą z legalnego źródła. Rodzi to pytanie, czy biblioteki mogą, w ramach istniejących wyjątków określonych w dyrektywie InfoSoc, zdigitalizować swoje fizyczne egzemplarze książek w celu późniejszego e-użyczenia. Ta kwestia nie została jednoznacznie rozstrzygnięta w tym orzeczeniu, ale znalazła wsparcie w opinii rzecznika generalnego. Równocześnie, ze względu na panujące tradycyjne podejście do wypożyczenia na poziomie państw członkowskich, e-użyczenia wciąż nie są powszechnie stosowane w praktyce.

**Słowa kluczowe:** e-użyczenie, Independent Secure Digital Lending (iSDL), Control Digital Lending (CDL), definicja kopii, prawo do użyczenia.

# Desygnat pojęciowy zwrotu „działalność twórcza” użytego w art. 1 ust. 1 ustawy o prawie autorskim i prawach pokrewnych

Wyrok Sądu Apelacyjnego w Warszawie z dnia 24 listopada 2022 r.,  
V ACa 519/21<sup>1</sup>

1. Za utwór uznaje się tylko przejaw takiego działania, które choćby w minimalnym stopniu odróżnia się od innych rezultatów takiego samego działania, a zatem że posiada cechę nowości, której stopień nie ma jednak znaczenia.
2. Przejaw działalności twórczej, aby podlegał ochronie prawnoautorskiej, musi mieć ponadto indywidualny charakter. Nie oznacza to jednak, że utwór musi odzwierciedlać cechy indywidualności twórcy, ale że sam przez się musi wyróżniać się od innych takich samych przejawów działalności twórczej, w sposób świadczący o jego swoistości, oryginalności i tych wszystkich właściwościach, które sprawiają, że w większym czy mniejszym stopniu jest on niepowtarzalny i nieposiadający swojego odpowiednika w przeszłości.
3. Indywidualny charakter utworu oznacza również, iż utwór odróżnia się w sposób obiektywny od innych przedmiotów intelektualnych, przy czym ten indywidualny charakter musi być rozpoznawalny dla osób, które z utworem mają do czynienia, a nie dla twórcy.

## Maciej Barczewski

Uniwersytet Gdański, Polska  
maciej.barczewski@prawo.ug.edu.pl  
ORCID: 0000-0001-6083-7249

## Sebastian Sykuna

Uniwersytet Gdański, Polska  
sebastian.sykuna@ug.edu.pl  
ORCID: 0000-0002-2582-612X

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## Glosa

Zgodnie ze stanem faktycznym ustalonym przez sąd I instancji pozwana prowadziła lokale gastronomiczne w formie barów sałatkowych. Pomysł prowadzenia takiej działalności wyszedł od partnerki powoda, która określiła niezbędne wyposażenie lokali. Powód uzgodnił ze współnikami komplementariusza pozwanej, że wniesie prawa

<sup>1</sup> LEX nr 3450528.

autorskie do przysługujących mu utworów, tworzących koncept biznesowy, w tym m.in. prawa do projektów architektonicznych.

Powód z pomocą zatrudnionych pracowników – m.in. kreślarzy, grafików, stworzył projekty architektoniczne dwóch lokali prowadzonych przez pozwaną. Wspomniane projekty musiały być zgodne z wytycznymi zarządców centrów. W wytycznych zawarte były informacje m.in. co do granicy lokalu, ogólnego kształtu bryły, wysokości pomieszczenia, sufitu podwieszanego, charakteru materiałów. Powód w projekcie nie miał wpływu na elewację, posadzki, sufity, kolorystykę i wykończenie ścian, które były narzucone przez centrum. Twórczy charakter miał projekt lokalu w zakresie układu wnętrza o nietypowym kształcie, wymagającym przystosowania do funkcji gastronomicznej. Twórczo zaprojektowano również technologię i umeblowanie, wymagało to przystosowania ciągu technologicznego do nieregularnego kształtu pomieszczenia.

Pismami z grudnia 2015 r. powód zawiadomił zarządców obu galerii handlowych, w których zlokalizowane były lokale pozwanej, o naruszeniu praw autorskich jego i jego partnerki. W szczególności powód wskazał, że posiada wyłączne prawa autorskie do projektu architektoniczno-wizualnego, znaku handlowego i grafik, zaś jego partnerka do menu, nazw potraw, fotografii i elementów graficznych, koncepcji menu-boardów oraz tekstów do zamieszczenia na stronie internetowej.

Dokonując oceny, czy projekty architektoniczne lokali wykorzystywanych do prowadzenia działalności przez pozwaną spółkę stanowią przedmiot ochrony prawnej, tj. stanowią utwór w rozumieniu art. 1 ust. 1 ustawy z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych<sup>2</sup>, sąd I instancji miał na uwadze, że za utwór można uznać jedynie przejawy działalności twórczej o indywidualnym charakterze. Chodzi zatem o kreacyjny, subiektywnie nowy, oryginalny wytwór intelektu, wywołany niepowtarzalną osobowością twórcy, który wykonany przez kogoś innego wyglądałby inaczej. Zdaniem sądu projekt zagospodarowania wnętrza, nawet jeśli zawiera dostępne na rynku przedmioty wyposażenia mieszkania, jak standardowe meble, fabrycznie produkowane „obrazy”, jednokolorowe gładkie zasłony, chodniki, dywany itp., przedmioty dostępne w marketach, może być przedmiotem regulacji ustawy o prawie autorskim, jeśli ich dobór i kompozycja w pomieszczeniu wskazują na twórczy i oryginalny charakter. W konsekwencji sąd I instancji uznał, iż wykonane przez powoda projekty lokali są przedmiotem prawa autorskiego, posiadają bowiem indywidualny, oryginalny charakter.

Sąd Apelacyjny (dalej: SA) w Warszawie w wyroku wydanym na skutek apelacji pozwanej<sup>3</sup> potwierdził, że o tym, czy wprowadzone do wytycznych wynajmującego modyfikacje lokali stanowią utwór podlegający ochronie prawnej decyduje to, czy stanowiły one przejaw działalności twórczej o indywidualnym charakterze, tak jak wymaga tego art. 1 ust. 1 pr. aut. Sąd podkreślił zarazem, że zwrot „działalność twórcza” użyty w tym przepisie oznacza, że za utwór uznaje się tylko przejaw takiego działania,

<sup>2</sup> Ustawa z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (tekst jedn.: Dz. U. z 2022 r., poz. 2509; dalej: pr. aut.).

<sup>3</sup> Wyrok SA w Warszawie z dnia 24 listopada 2022 r., V ACa 519/21, LEX nr 3450528.

które choćby w minimalnym stopniu odróżnia się od innych rezultatów takiego samego działania, a zatem że posiada cechę nowości, której stopień nie ma jednak znaczenia. Przejaw działalności twórczej, aby podlegać ochronie prawnoautorskiej, musi mieć indywidualny charakter. Nie oznacza to jednak, że utwór musi odzwierciedlać cechy indywidualności twórcy, ale że sam przez się musi wyróżniać się od innych takich samych przejawów działalności twórczej, w sposób świadczący o jego swoistości, oryginalności i tych wszystkich właściwościach, które sprawiają, że w większym czy mniejszym stopniu jest on niepowtarzalny i nieposiadający swojego odpowiednika w przeszłości. Indywidualny charakter utworu oznacza również, że utwór odróżnia się w sposób obiektywny od innych przedmiotów intelektualnych, przy czym ten indywidualny charakter musi być rozpoznawalny dla osób, które z utworem mają do czynienia, a nie dla twórcy. Indywidualny charakter może nadać utworowi twórca, który sięgając po środki artystycznego wyrazu, świadomie wywołał u odbiorcy pewien efekt nowości. Działanie twórcy nie może być tym samym mechanicznym wyborem istniejących możliwości. Spełnienia przesłanki indywidualnego charakteru można zaś doszukiwać się w różnych elementach utworu, w tym w doborze, układzie lub uporządkowaniu jego składników.

Zgodnie z definicją zawartą w art. 1 ust. 1 pr. aut. przedmiotem prawa autorskiego jest każdy uzewnętrzniony „przejaw działalności twórczej o indywidualnym charakterze”<sup>4</sup>. Bez znaczenia jest, czy cecha osobistej twórczości jest wyraźna i uderzająca, czy też ledwie dostrzegalna<sup>5</sup>. Należy w tym miejscu odnotować, iż przyjęcie przez ustawodawcę cech twórczości i indywidualności jako kumulatywnych przesłanek ochrony prawnoautorskiej odzwierciedla założenia uznawane także w innych państwach systemu prawa eurokontynentalnego<sup>6</sup>.

Jak słusznie podkreśla Ryszard Markiewicz, wspomniane znaczenie określenia „twórczość o indywidualnym charakterze” jest jednym z najważniejszych teoretycznie i praktycznie zagadnień prawa autorskiego. Jest tak dlatego, że przesądza ono nie tylko o tym, czy określony wynik pracy intelektualnej jest utworem w rozumieniu prawa autorskiego, ale równocześnie o tym, które elementy (składniki) utworu są chronione przez to prawo. Wypada zarazem zaznaczyć, że jest to jedno z najbardziej mglistych, niedookreślonych pojęć prawa autorskiego – wywołujących przy tym ciągłe spory w doktrynie i niekonsekwentnie interpretowanych przez orzecznictwo sądowe<sup>7</sup>.

<sup>4</sup> W ten sposób nawiązano do konstrukcji przyjętej w ustawie z dnia 29 marca 1926 r. o prawie autorskim (Dz. U. Nr 48, poz. 286), w której za przedmiot prawa autorskiego uznawano „przejaw działalności duchowej, noszący cechę osobistej twórczości”. Wymóg osobistej twórczości pominięto natomiast w ustawie z dnia 10 lipca 1952 r. o prawie autorskim (Dz. U. Nr 34, poz. 234), mimo że w doktrynie i orzecznictwie powszechnie przyjmowano, iż jest on podstawową przesłanką objęcia dzieła ochroną prawnoautorską.

<sup>5</sup> A. Karpowicz, *Autor-Wydawca. Poradnik prawa autorskiego*, Warszawa 1999, s. 15.

<sup>6</sup> W systemie *common law* dominuje natomiast stanowisko, zgodnie z którym wystarczy, że utwór nosi znamię niepowtarzalności, uzyskanej dzięki nakładowi pracy włożonej w stworzenie dzieła. Por. J. Błęszyński, M. Staszów, *Prawo autorskie i wynalazcze*, Warszawa 1983, s. 45; A. Latman, *Howell's Copyright Can*, Washington 1962, s. 1.

<sup>7</sup> R. Markiewicz, *Ilustrowane prawo autorskie*, Warszawa 2018, s. 39–40.



Wspomniany autor – wespół z Januszem Bartą – wskazuje, iż przesłanka „twórczości” odnosi się do stwierdzenia, że dany rezultat działalności człowieka ma charakter kreatywny. Cecha twórczości jest spełniona wówczas, gdy istnieje subiektywnie nowy wytwór intelektu. Jest ona ujmowana w płaszczyźnie nowości subiektywnej i zorientowana retrospektywnie<sup>8</sup>. Nie zakłada przy tym badania stanu świadomości ani woli autora, ale odnosi się do elementów przedmiotowych, zakorzenionych w samym utworze<sup>9</sup>.

Zdaniem Rafała Gołata najbardziej odpowiednim pojęciem, oddającym istotę przesłanki twórczego charakteru przedmiotu praw autorskich, wydaje się być kreatywność utworu, rozumiana jako konstruowanie dzieł, wyposażanych w nowe, nieistniejące wcześniej wartości, które byt swój zawdzięczają twórczym możliwościom i uzdolnieniom autora. Wystarczy więc, iż jeden z elementów weryfikowanego dobra, niezbędny dla jego istnienia w zaplanowanej przez autora postaci, będzie miał twórczy charakter, aby stwierdzić, że omawiana przesłanka została spełniona, a dobro to jest utworem w rozumieniu prawa autorskiego<sup>10</sup>.

Jak słusznie podkreśla Rafał M. Sarbiński, zaprzeczeniem twórczości jest zatem działalność schematyczna, a także stosowanie wzorów, norm i szablonów wyłączających nie tylko własną inwencję, ale nawet możliwość dokonania wyboru. Twórczość wyklucza ponadto praca o charakterze technicznym, wymagająca jedynie określonej wiedzy i umiejętności oraz zastosowania narzędzi. Przeciwnością twórczości jest zatem działalność odtwórcza<sup>11</sup>.

We wspomnianym kontekście wypada przytoczyć tezę orzeczenia krakowskiego Sądu Apelacyjnego z dnia 29 października 1997 r., zgodnie z którym „o twórczym charakterze pracy autora można orzekać przede wszystkim na podstawie właściwości, które przysługują jego utworowi w porównaniu z innymi produktami intelektualnymi: natomiast odwrócona inferencja, tj. orzekanie o twórczym charakterze na podstawie swoistych cech jego powstawania, opiera się na kryteriach intersubiektywnie niesprawdzalnych i wskutek tego nieprzydatnych w ocenach prawnych”<sup>12</sup>.

Jeżeli chodzi o drugą z cech koniecznych do objęcia utworu ochroną, czyli jego indywidualny charakter, należy zaznaczyć, że pojęcie indywidualności jako przesłanki ochrony prawnoautorskiej nie było i nie jest rozumiane jednolicie<sup>13</sup>. Zdaniem niektórych chodzi w nim o możliwość wychwycenia w utworze cech charakterystycznych dla niepowtarzalnej osobowości danego twórcy<sup>14</sup>. Dyskusyjne pozostaje kryterium poziomu natężenia cech indywidualizujących dany utwór – np. według koncepcji

<sup>8</sup> J. Barta, R. Markiewicz, *Prawo autorskie*, Warszawa 2016, s. 49.

<sup>9</sup> E. Laskowska-Litak [w:] *Ustawy autorskie. Komentarze. Tom I*, red. R. Markiewicz, Warszawa 2021, s. 50.

<sup>10</sup> R. Gołat, *Prawo autorskie i prawa pokrewne*, Warszawa 2005, s. 34–35.

<sup>11</sup> R.M. Sarbiński [w:] *Prawo autorskie i prawa pokrewne. Komentarz*, red. W. Machała, R.M. Sarbiński, Warszawa 2021, s. 30–31.

<sup>12</sup> Orzeczenie SA w Krakowie z dnia 29 października 1997 r., I ACa 477/97 [opubl. w:] *Dobra osobiste, Zbiór orzeczeń Sądu Apelacyjnego w Krakowie*, oprac. B. Gawlik, Kraków 1999, s. 262 i nn.

<sup>13</sup> R.M. Sarbiński [w:] *Prawo autorskie...*, s. 30–31.

<sup>14</sup> J. Barta, R. Markiewicz, *Prawo autorskie...*, s. 52; por. R. Gołat, *Prawo autorskie...*, s. 35.

tw. drobnych monet wystarczy, że dany wytwór w minimalnym stopniu wyróżnia się z istniejącego zasobu twórczości<sup>15</sup>. Przesłanka indywidualnego charakteru często bywa weryfikowana również poprzez odwołanie się do teorii statystycznej jednorazowości sformułowanej przez Maxa Kummera<sup>16</sup>, która zakłada „badanie, czy takie samo lub bardzo podobne dzieło powstało już wcześniej oraz czy jest statystycznie prawdopodobne sporządzenie w przyszłości takiego samego dzieła przez inną osobę. Odpowiedź przecząca uzasadnia tezę o istnieniu cechy indywidualności dzieła”<sup>17</sup>.

Jak podkreśla Ewa Laskowska-Litak, pojęcie indywidualności należy odnieść również do testu swobody twórczej, weryfikującego, czy twórcy przysługiwał zakres swobody twórczej oraz czy autor ten zakres efektywnie wykorzystał. Zdaniem wspomnianej autorki ten drugi element ma charakter limitujący zakres ochrony prawnoautorskiej, tylko bowiem w takim zakresie, w jakim twórcy przysługiwała swoboda twórcza i w jakim została ona przez niego kreatywnie wyeksploatowana, przyznawana jest ochrona prawnoautorska<sup>18</sup>.

W przywołanym wcześniej orzeczeniu SA w Krakowie zasadnie podkreślono ponadto, że „nie da się generalnie oznaczyć minimum indywidualności, które stanowiłyby wartość progową dla uzyskania ochrony w prawie autorskim i pozwalałyby w sposób dostatecznie bezpieczny rozróżniać wytwory intelektualne zdadne i niezdatne do ochrony. W każdym przypadku budzącym wątpliwości [...] zachodzi konieczność odwołania się do ocen wartościujących. W ocenach tych należy kierować się dyrektywą nakazującą uwzględniać aksjologiczne uzasadnienie norm prawa autorskiego, jak i właściwości wytworów intelektualnych poddanych ocenom wartościującym”<sup>19</sup>. Słusznie więc podkreśla się w doktrynie, że w przypadku wielu kategorii dzieł stwierdzenie istnienia indywidualności jest w istocie niemożliwe do uzasadnienia (wykazania), gdyż często opiera się wyłącznie na intuicyjnym przekonaniu<sup>20</sup>.

Dlatego w literaturze coraz częściej podnosi się, że dotychczasowe próby zakresowania desygnatu pojęcia „indywidualnego charakteru” wydają się nie przystawać do obecnej rzeczywistości, tak bardzo odmiennej od tej, w której tworzone teoretyczne założenia prawa autorskiego<sup>21</sup>. Jak trafnie zauważa Damian Flisak, brak wyraźnie zarysowanych granic tego pojęcia prowadzi pośrednio do rozszerzania się granic ochrony prawnoautorskiej. W konsekwencji wskazane jest odejście od wiązania przesłanki

<sup>15</sup> Koncepcja ta spotkała się z krytyką m.in. w wyroku Sądu Najwyższego (dalej: SN) z dnia 6 marca 2014 r., V CSK 202/13, LEX nr 1486990. Szerzej zob. A. Niewęglowski, *Prawo autorskie. Komentarz*, Warszawa 2021, s. 39.

<sup>16</sup> M. Kummer, *Das Urheberrechtlich Schützbare Werk*, Bern 1968, s. 30 i nn.

<sup>17</sup> Tak: wyrok SN z dnia 27 lutego 2009 r., V CSK 337/08, LEX nr 488738. Krytycznie o teorii statystycznej jednorazowości zob. D. Flisak, *Maxa Kummera teoria statystycznej jednorazowości – pozorne rozwiązanie problematycznej oceny indywidualności dzieła* [w:] *Spory o własność intelektualną. Księga jubileuszowa dedykowana Profesorom Januszowi Barcie i Ryszardowi Markiewiczowi*, red. A. Matlak, S. Stanisławska-Kloc, Warszawa 2013, s. 292.

<sup>18</sup> E. Laskowska-Litak [w:] *Ustawy autorskie...*, s. 55.

<sup>19</sup> Orzeczenie SA w Krakowie z dnia 29 października 1997 r., I ACa 477/97.

<sup>20</sup> J. Barta, R. Markiewicz, *Prawo autorskie...*, s. 24.

<sup>21</sup> M. Późniak-Niedzielska, A. Niewęglowski [w:] *Prawo autorskie i prawa pokrewne. System prawa prywatnego*, t. 13, red. J. Barta, Warszawa 2017, s. 14.

indywidualności z subiektywnym przekonaniem twórcy o tworzeniu nowego dzieła na rzecz ustalenia stopnia indywidualności utworu wyłącznie na podstawie obiektywnej oceny jego właściwości<sup>22</sup> (tzw. nowości obiektywnej).

Na tym tle interesującą próbę usystematyzowania nurtów interpretacji pojęcia „przejawu działalności twórczej o indywidualnym charakterze” podjął ostatnio Zbigniew Okoń. Według wspomnianego autora historycznie najstarsza była koncepcja polegająca na poszukiwaniu w utworze subiektywnie pojmowanego „piętna osobistego”, będącego następstwem specyfiki procesu powstawania dzieła. Opiera się ona na założeniu, że niepowtarzalność ludzkiej osobowości prowadzi do niepowtarzalności wytworu intelektualnego będącego wynikiem pracy intelektualnej autora (twórczości), a więc że naznaczenie utworu częścią indywidualności autora (indywidualność) jest następstwem tego, iż to autor stworzył dzieło<sup>23</sup>. W tym ujęciu przesłanka „twórczości” nie jest jednakże przeciwstawiana „indywidualności”, lecz traktowana jako znamię współzależne<sup>24</sup>.

Drugi nurt nawiązuje do teorii statystycznej jednorazowości, wymagając od utworu, aby nie tylko pochodził od twórcy, ale był także unikatowy zarówno w chwili powstania, jak i w przyszłości. Nie chodzi tu więc o badanie procesu powstawania utworu, lecz charakteru samego dzieła jako wytworu intelektualnego, a w szczególności jego indywidualnego, niepowtarzalnego charakteru. W konsekwencji możliwa jest więc weryfikacja cechy indywidualności na podstawie badania, czy wcześniej takie dzieło powstało oraz czy jest statystycznie prawdopodobne stworzenie go w przyszłości przez inną osobę<sup>25</sup>.

Trzeci nurt kładzie zaś nacisk na ocenę danego wytworu intelektualnego w zestawieniu ze stworzonymi wcześniej rezultatami działalności intelektualnej człowieka, a w konsekwencji cech utworu upatruje w istnieniu w nim elementów pozwalających na jego odróżnienie od innych dzieł<sup>26</sup>.

W takim ujęciu tezy komentowanego orzeczenia korespondują z założeniami dwóch ostatnich z wymienionych nurtów, wskazując zarazem, że cechę twórczego charakteru należy postrzegać w kategoriach nowości subiektywnej, zaś indywidualność dzieła – nowości obiektywnej. Przedmiotowy wyrok Sądu Apelacyjnego wpisuje się zarazem w – akcentowane zarówno w orzecznictwie, jak i poglądach doktryny – dążenie do obiektywizacji kryteriów oceny wytworu intelektualnego jako przedmiotu praw autorskich (utworu)<sup>27</sup>.

<sup>22</sup> D. Flisak, *Pojęcie utworu w prawie autorskim – potrzeba głębokich zmian*, PPH 2006, nr 12, s. 32 i nn. Zob. E. Ferenc-Szydełko [w:] *Ustawa o prawie autorskim i prawach pokrewnych. Komentarz*, red. eadem, Warszawa 2021, s. 9 i nn.; D. Flisak [w:] *Prawo autorskie i prawa pokrewne. Komentarz*, red. idem, Warszawa 2015, s. 23 i nn.

<sup>23</sup> Z. Okoń, *Prounijna wykładnia przesłanki twórczości i indywidualności utworu*, ZNUJ PPWI 2022, z. 3, s. 21–22.

<sup>24</sup> *Ibidem*, s. 23.

<sup>25</sup> *Ibidem*, s. 25–26.

<sup>26</sup> *Ibidem*, s. 21.

<sup>27</sup> Zob. np. J. Chwalba, *Utwór czy twórczość? O przedmiocie ochrony w prawie autorskim*, ZNUJ PPWI 2022, z. 4, s. 37–38.

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## Streszczenie

*Maciej Barczewski, Sebastian Sykuna*

### **Desygnat pojęciowy zwrotu „działalność twórcza” użytego w art. 1 ust. 1 ustawy o prawie autorskim i prawach pokrewnych**

W komentowanym wyroku wskazuje się, że za utwór uznaje się tylko przejaw takiego działania, które choćby w minimalnym stopniu odróżnia się od innych rezultatów takiego samego działania, a zatem że posiada cechę nowości, której stopień nie ma jednak znaczenia. Podkreślono ponadto, że przejaw działalności twórczej, aby podlegać ochronie, musi mieć indywidualny charakter. Nie oznacza to jednak, że utwór musi odzwierciedlać cechy indywidualności twórcy, ale że sam przez się musi wyróżniać się od innych takich samych przejawów działalności twórczej, w sposób świadczący o jego swoistości, oryginalności i tych właściwościach, które sprawiają, że w większym czy mniejszym stopniu jest on niepowtarzalny i nieposiadający swojego odpowiednika w przeszłości. Indywidualny charakter utworu oznacza również, iż utwór odróżnia się

w sposób obiektywny od innych przedmiotów intelektualnych. Wspomniane tezy sugerują, że cechę twórczego charakteru utworu należy postrzegać w kategoriach nowości subiektywnej, zaś indywidualności dzieła – nowości obiektywnej. Omawiany wyrok Sądu Apelacyjnego wpisuje się zarazem w – akcentowane zarówno w orzecznictwie, jak i poglądach doktryny – dążenie do obiektywizacji kryteriów oceny wytworu intelektualnego jako przedmiotu praw autorskich (utworu).

**Słowa kluczowe:** prawa autorskie, twórczość, indywidualność, utwór.

## Summary

*Maciej Barczewski, Sebastian Sykuna*

### The Conceptual Referent of the Term “Creative Activity” As Used in Article 1(1) of the Polish Act on Copyright and Related Rights

In the judgment discussed, it is pointed out that only a manifestation of an activity, which even minimally differs from other results of the same activity, is considered a work, and, therefore, that it has the feature of novelty, the degree of which, however, is irrelevant. It is further emphasized that a manifestation of creative activity must also have an individual character in order to be protected. This does not mean, however, that the work must reflect the characteristics of the creator’s individuality, but that, by itself, it must stand out from other identical manifestations of creative activity, in a way that testifies to its peculiarity, to its originality, and to those qualities that make it, to a greater or lesser degree, unique and without a counterpart in the past. The individual character of a work also means that the work is objectively distinguishable from other intellectual objects. The aforementioned principles suggest that the creative character of a work should be viewed in terms of subjective novelty, while the individuality of a work should be viewed in terms of objective novelty. At the same time, the judgment of the Court of Appeals under discussion is part of a desire that is emphasized in both case law and doctrinal discussions, a desire to objectivize the criteria for evaluating an intellectual creation as a subject of copyright (a work).

**Keywords:** copyright, creativity, individuality, work.

# Odpowiedzialność partii politycznych za działalność komitetów wyborczych. Ochrona wizerunku osoby w związku z wykonywaniem przez nią zawodu dziennikarza stacji informacyjnej na tle kodeksu cywilnego i prawa autorskiego

Wyrok Sądu Najwyższego z dnia 25 maja 2023 r., II CSKP 1555/22<sup>1</sup>

1. Komitety wyborcze jako jednostki organizacyjne są odrębne od partii politycznych, które je utworzyły, oraz ich organów, jak również od podmiotów, które wchodzi w skład tych komitetów wyborczych, w związku z tym mogą one samodzielnie występować w obrocie prawnym, w zakresie wynikającym z przyznanych im przez kodeks wyborczy uprawnień.
2. Wykorzystanie wizerunku osoby w związku z wykonywanym przez nią zawodem dziennikarza stacji informacyjnej nie stanowi usprawiedliwienia dla dowolnego użycia tak pozyskanego wizerunku.
3. Pojęcie wizerunku na tle przepisów kodeksu cywilnego<sup>2</sup> oraz ustawy o prawie autorskim i prawach pokrewnych<sup>3</sup> jest tożsame, przy czym w przypadku, o którym stanowi art. 81 u.p.a.p.p., dla zrealizowania ochrony prawnej konieczne jest wykazanie, że doszło do nieuzgodnionego rozpowszechnienia wizerunku jako dobra niematerialnego i nie zaszyły wyjątkowe przesłanki wyłączające naruszenie, a w przypadkach naruszenia praw do wizerunku w inny sposób niż jego rozpowszechnienie konieczne jest wykazanie ingerencji w sferę interesu związanego z tym dobrem.

## Marcin Perzyna

Uniwersytet Gdański, Polska  
m.perzyna@festivalgroup.pl  
ORCID: 0009-0006-0663-6714

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<sup>1</sup> LEX nr 3567382.

<sup>2</sup> Ustawa z dnia 23 kwietnia 1964 r. – Kodeks cywilny (tekst jedn.: Dz. U. z 2023 r., poz. 1610 ze zm.; dalej: k.c.).

<sup>3</sup> Ustawa z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (tekst jedn.: Dz. U. z 2022 r., poz. 2509; dalej: u.p.a.p.p.).

## Glosa

### Uwagi wstępne

Komentowane orzeczenie dotyczy dwóch zagadnień, tj. odpowiedzialności partii politycznych za działalność komitetów wyborczych w okresie po formalnym zakończeniu ich istnienia oraz ochrony wizerunku dziennikarza, w związku z wykonywaniem przez niego zawodu, na tle unormowań kodeksu cywilnego oraz ustawy o prawie autorskim i prawach pokrewnych. W pierwszej części glosa komentuje orzeczenie Sądu Najwyższego (dalej: SN) w zakresie odpowiedzialności następczej partii politycznej za działalność komitetu wyborczego, uwzględniając sposób wypełnienia luki prawnej, polegającej na braku regulacji odpowiedzialności partii politycznych za działalność komitetów wyborczych, po zakończeniu przez nich działalności oraz rozstrzygając kwestię następstwa prawnego komitetów wyborczych. W drugiej mowa jest o zależnościach regulacji chroniących wizerunek, na gruncie kodeksu cywilnego oraz ustawy o prawie autorskim i prawach pokrewnych, wyraźnie określając, na czym polega niedozwolone naruszenie norm stanowiących ograniczoną ochronę wizerunku dziennikarza w związku z wykonywaniem przez niego zawodu.

### Stan faktyczny sprawy

Asumptem do wytoczenia przez dziennikarkę powództwa przeciwko partii politycznej (dalej: P.) był brak zgody na wykorzystanie jej wizerunku w sposób nadający mu istotnie zmieniony i rozwinięty kontekst, który mógłby zostać uznany przez odbiorców za popierający konkretną partię polityczną lub co najmniej będący elementem szerszej wypowiedzi, odmiennej aniżeli jej rzeczywisty zamiar. Została ona przedstawiona w materiale wyborczym partii politycznej P. w sposób, który umożliwił jej identyfikację. Materiał wyborczy był rozpowszechniany w celach reklamowych, co nie było dopuszczalne, ponieważ powódka nie wyraziła zgody na rozpowszechnianie swojego wizerunku w takich celach. Powództwo o zadośćuczynienie pieniężne za naruszenie jej dóbr osobistych oraz wydanie oświadczenia o wykorzystaniu jej wizerunku w spocie wyborczym partii, wyemitowanym w ramach kampanii wyborczej do organów samorządu terytorialnego, bez jej wiedzy i zgody, zostało oparte na twierdzeniu, że wykorzystanie wizerunku dziennikarki w spocie wyborczym stanowiło naruszenie prawa do niezależności i rzetelności dziennikarskiej. Argumentacja dziennikarki opierała się na twierdzeniu, że jej wystąpienie w spocie wyborczym w roli osoby popierającej stanowisko partii P. w sprawie uchodźców mogło zostać odebrane jako wyrażenie osobistej opinii w tej kwestii.

Z zarzutami powódki nie zgodziła się strona pozwana, argumentując, że wizerunek powódki, z uwagi na fakt wykonywania przez nią zawodu dziennikarki, jest



powszechnie dostępny, a wykorzystanie go w spocie wyborczym nie stanowiło naruszenia dobra osobistego, ponieważ jej wypowiedź jako nieprzemontowana została wykorzystana w sposób rzetelny i obiektywny. Argumentacja pozwanej opierała się również na twierdzeniu, że powódka została przedstawiona jako osoba, która przekazuje fakty, a nie wyraża osobiste opinie, co oznacza, że nie przysługuje jej ochrona przewidziana w art. 24 k.c., ponieważ wizerunek został wykorzystany w spocie wyborczym w celu informowania opinii publicznej o stanowisku partii P. w sprawie uchodźców.

Sąd okręgowy, mając na względzie stan faktyczny, zauważył, że w niniejszej sprawie mamy do czynienia z luką prawną, wskazując, że choć kampania wyborcza w rzeczywistości prowadzona była przez odpowiadający za nią bezpośrednio komitet wyborczy, to *sensu largo* prowadzi ją, co do zasady, partia polityczna. Stanowisko sądu pierwszej instancji podzielił Sąd Apelacyjny (dalej: SA) w Warszawie, doprecyzowując jedynie, że komitety wyborcze „z uwagi na ich epizodyczny charakter oraz brak wyraźnego stanowiska ustawodawcy w tym zakresie nie posiadają osobowości prawnej, a tym samym w świetle art. 64 § 1 k.p.c.<sup>4</sup> zdolności sądowej”<sup>5</sup>. Sąd odwoławczy wywiódł powyższe z przepisów kodeksu wyborczego<sup>6</sup>, które wprost nie wskazują odpowiedzialności komitetów wyborczych za naruszenie dóbr osobistych (o czym dalej). W konsekwencji sąd uznał, że w tej sytuacji uzasadniona jest legitymacja procesowa partii politycznej P., której jednostką organizacyjną jest komitet wyborczy. Stanowisko sądu apelacyjnego, w zakresie dotyczącym odpowiedzialności partii politycznej, należy uznać za prawidłowe, jednak samo uzasadnienie tej odpowiedzialności w zakresie, w którym wskazywany jest brak posiadania zdolności do ponoszenia przez komitety wyborcze odpowiedzialności za naruszenie dóbr osobistych, można uznać, w świetle dalszych wyjaśnień, za nieprawidłowe. Uzasadnienie to stanowiło jedną z podstaw do wniesienia przez pozwaną skargi kasacyjnej.

W dniu 25 maja 2023 r. Sąd Najwyższy oddalił skargę kasacyjną P. od wyroku Sądu Apelacyjnego w Warszawie z dnia 9 grudnia 2020 r. (V ACa 127/20)<sup>7</sup>, dzieląc tym samym stanowisko sądów niższych instancji. Warto podkreślić, że wyrok SN jest orzeczeniem, które w istotny sposób wzmacnia ochronę dóbr osobistych. Został w nim bowiem potwierdzony zakres ochrony podmiotów, których dobra osobiste zostały naruszone w związku z działalnością komitetu wyborczego. Sąd Najwyższy podkreślił, że w przypadku wykorzystania wizerunku osoby fizycznej w materiale wyborczym bez jej zgody należy wziąć pod uwagę sposób jego wykorzystania, treść materiału wyborczego, w którym został on wykorzystany, oraz stosunek osoby fizycznej do treści materiału wyborczego. Ponadto, uzasadnienie wyżej wymienionego wyroku zostało oparte na twierdzeniu, że komitety wyborcze są tzw. ułomnymi osobami prawnymi, co oznacza, że mogą być podmiotami stosunku cywilnoprawnego, nie posiadając

<sup>4</sup> Ustawa z dnia 17 listopada 1964 r. – Kodeks postępowania cywilnego (tekst jedn.: Dz. U. z 2023 r., poz. 1550 ze zm.).

<sup>5</sup> Wyrok SA w Warszawie z dnia 9 grudnia 2020 r., V ACa 127/20, LEX nr 3359526.

<sup>6</sup> Ustawa z dnia 11 stycznia 2011 r. – Kodeks wyborczy (tekst jedn.: Dz. U. z 2023 r., poz. 2408; dalej: k. wyb.).

<sup>7</sup> Wyrok SA w Warszawie z dnia 9 grudnia 2020 r., V ACa 127/20, LEX nr 3359526.

osobowości prawnej, lecz dysponując zdolnością prawną *ex lege*. Rozumieć przez to należy, że komitety wyborcze, posiadając zdolność do czynności prawnych, mogą nabywać prawa i zaciągać zobowiązania, a w procesach o ochronę dóbr osobistych, które zostały naruszone, w związku z ich działalnością, mogą być podmiotami postępowania sądowego, posiadając tzw. legitymację bierną. SN, argumentując swoje stanowisko, wskazał, że kodeks wyborczy nie zawiera przepisów wyłączających lub ograniczających odpowiedzialność komitetów wyborczych za naruszenie dóbr osobistych. Jak podkreślono w uzasadnieniu wspomnianego orzeczenia, w przypadku odpowiedzialności za naruszenie dóbr osobistych nie ma znaczenia, czy odpowiedzialność ponosi osoba fizyczna, osoba prawna czy też jednostka organizacyjna nieposiadająca osobowości prawnej. Co istotne, Sąd Najwyższy uznał, że partia polityczna może być bezpośrednio odpowiedzialna za naruszenie dóbr osobistych osoby fizycznej, które zostało dokonane przez komitet wyborczy tej partii. Z uwagi na fakt, że partia polityczna tworzy komitet wyborczy oraz ma prawo do jego kontroli, istnieje pomiędzy nimi bezpośrednia więź. Oznacza to, że w przypadku naruszenia dóbr osobistych osób fizycznych przez komitet wyborczy partia polityczna może w pewnych przypadkach ponosić za to odpowiedzialność bezpośrednio. Podstawą takiej odpowiedzialności jest art. 113 w zw. z art. 112 k. wyb., ponieważ materiał wyborczy, który naruszył dobra osobiste, był rozpowszechniany pod wyraźnie wyeksponowanym szyldem partii politycznej. W konsekwencji wyrok SN oznacza, że osoby, których dobra osobiste zostały naruszone w związku z działalnością komitetu wyborczego, mogą dochodzić swoich roszczeń przed sądem przeciwko partii politycznej, która utworzyła ten komitet.

Tym samym należy stwierdzić, że wyrok Sądu Najwyższego z dnia 25 maja 2023 r. określający zakres ochrony podmiotów, których dobra osobiste zostały naruszone w związku z działalnością komitetów wyborczych, precyzuje odpowiedzialność partii politycznych za naruszenie dóbr osobistych osób fizycznych. Orzeczenie potwierdza również, że wykorzystanie wizerunku osoby fizycznej w materiale wyborczym bez jej zgody może godzić w jej dobre imię, stanowiąc naruszenie dobra osobistego, co w komentowanym przypadku miało miejsce.

## **Ocena stanowisk sądów orzekających w sprawie**

Na wstępie należy wyrazić aprobatę dla stanowisk sądów powszechnych orzekających w niniejszej sprawie, przy uwzględnieniu uwag, które zostaną podniesione w dalszej części glosy. Na szczególną uwagę zasługuje obszerne uzasadnienie Sądu Najwyższego, który przeprowadził szczegółową i wnikliwą analizę zarówno odpowiedzialności następczej partii za działalność jej komitetu wyborczego, jak i ochrony wizerunku osoby, w związku z wykonywaniem przez nią zawodu dziennikarza na gruncie kodeksu cywilnego oraz ustawy o prawie autorskim i prawach pokrewnych.

Kluczowym zagadnieniem, które w swoim orzeczeniu rozstrzygnął SN, była odpowiedzialność następcza partii politycznej za działalność swojego komitetu

wyborczego. Sąd pierwszej instancji, tj. Sąd Okręgowy (dalej: SO) w Warszawie, w wyroku z dnia 18 września 2019 r.<sup>8</sup> stwierdził, że nie istnieje przepis prawny przewidujący odpowiedzialność partii politycznej za działanie komitetów wyborczych po zakończeniu ich istnienia, a także że ze względu na przedmiot sprawy proces ten nie może być prowadzony w ramach postępowania szczególnego, uregulowanego kodeksem wyborczym. Mimo to, jak wskazuje Sąd Najwyższy: „Wprawdzie Komitet Wyborczy, który prowadził kampanię wyborczą i który odpowiada bezpośrednio za wyemitowanie spornego spotu wyborczego, już przestał istnieć prawnie na podstawie stosownych przepisów kodeksu wyborczego i w związku z tym nie może być stroną w procesie, ale z drugiej strony nie może to skutkować oddaleniem powództwa, gdyż doprowadziłoby to do pozbawienia poszkodowanego, którego dobra osobiste zostały naruszone, ochrony prawnej, zaś komitety wyborcze mogłyby bez narażenia się na odpowiedzialność prawną naruszać dobra osobiste podmiotów prawa”<sup>9</sup>. Jak wspomniano wyżej, sąd apelacyjny podzielił stanowisko sądu pierwszej instancji, a pozwana P. wykorzystała przysługujące jej instrumenty prawne, występując ze skargą kasacyjną.

Wskutek powyższego Sąd Najwyższy w wyroku z dnia 25 maja 2023 r. uznał, że komitety wyborcze są jednostkami organizacyjnymi objętymi ochroną prawną. Argumentując swoje stanowisko, podkreślił, że „uznawanie komitetów wyborczych za ułomne osoby prawne [...], czyli jednostki organizacyjne niebędące osobami prawnymi, którym ustawa (w tym wypadku kodeks wyborczy) przyznaje zdolność prawną”<sup>10</sup>, jest uzasadnione, z czym należy się zgodzić. Warto przy tym dodać, że komitety wyborcze posiadają również zdolność sądową w zakresie wynikającym z przepisów kodeksu wyborczego. Co istotne, nie można tego wyprowadzić z jednego, konkretnego przepisu ustawy, lecz z kilku jej przepisów, głównie z art. 94, art. 100, art. 106 i art. 130 k. wyb. poprzez zastosowanie pośredniej metody opisowej. Ponadto w doktrynie prezentowane jest stanowisko, zgodnie z którym „ochrona ta nie należy do kompetencji organów wyborczych, ponieważ komitety wyborcze korzystają na ogólnych zasadach [...] z ochrony prawnej przewidzianej dla dóbr osobistych (zob. art. 23, 24 i 43 k.c.)”<sup>11</sup>.

Pomimo że komitet wyborczy jest podmiotem odrębnym od organu partii politycznej, nie jest on uprawniony do jej reprezentowania na zewnątrz. Z uwagi na fakt, że samemu organowi partii politycznej nie przysługują zdolność prawna i zdolność sądowa, biorąc pod uwagę wcześniejsze wyjaśnienia oraz konstatację, że powódka ze względu na przedmiot sporu nie mogła dochodzić ochrony prawnej, w ramach postępowania prowadzonego w trybie wyborczym, Sąd Najwyższy musiał zmierzyć się z brakiem normy regulującej określoną sytuację prawną. Powstała luka została sanowana komentowanym orzeczeniem. W ocenie SN brak odpowiednich regulacji w zakresie odpowiedzialności cywilnej partii politycznej za zobowiązania niemajątkowe,

<sup>8</sup> Wyrok SO w Warszawie z dnia 18 września 2019 r., IV C 213/19, niepub.

<sup>9</sup> Wyrok SN z dnia 25 maja 2023 r., II CSKP 1555/22, LEX nr 3567382.

<sup>10</sup> *Ibidem*.

<sup>11</sup> K.W. Czaplicki, J. Zbieranek, *Komentarz do art. 92, art. 93, art. 94, art. 95 k. wyb.* [w:] B. Dauter, S.J. Jaworski, A. Kisielewicz, F. Rymarz, K.W. Czaplicki, J. Zbieranek, *Kodeks wyborczy. Komentarz*, wyd. 2, Warszawa 2018.

wynikające z naruszenia cudzych dóbr osobistych, należało wypełnić w ten sposób, że po ustaniu bytu prawnego komitetu wyborczego cywilną odpowiedzialność ponosi partia polityczna, której organy zgodnie z art. 86 k. wyb. pełniły funkcję komitetu wyborczego. Jeżeli w toku kampanii wyborczej partia polityczna zleciła publikację materiałów, które naruszały cudze dobra osobiste, to na podstawie art. 113 k. wyb. w zw. z art. 24 § 1 k.c. jej bezpośrednia odpowiedzialność nie jest wykluczona. Jednakże dla właściwej oceny niezbędne było rozstrzygnięcie zagadnienia następstwa prawnego partii P., która dany komitet wyborczy utworzyła. Argumentacja przyjęta przez Sąd Najwyższy wskazuje wprost, że komitet wyborczy działa na rzecz partii oraz w jej interesie. To partia tworzy komitet wyborczy, a zgodnie z art. 86 k. wyb. „funkcję komitetu wyborczego pełni organ tej partii upoważniony do reprezentowania jej na zewnątrz”. Dodatkowo Sąd Najwyższy uznał, że sporny spot był rozpowszechniany pod wyraźnym szyldem partii P., a fakt ten przesądza, iż miała ona wpływ na jego treść. Prowadzi to do konstatacji, że partia P. na podstawie art. 113 w zw. z art. 112 k. wyb. posiada legitymację bierną niezależnie od przesądnego powyżej następstwa prawnego. Powyższe stanowisko znajduje poparcie w orzecznictwie SN, które dopuszcza przypisanie odpowiedzialności za naruszenie cudzych dóbr osobistych podmiotowi działającemu w imieniu i na rzecz określonej jednostki bądź też w charakterze organu osoby prawnej lub w charakterze funkcjonariusza publicznego<sup>12</sup>.

Równie ważnym zagadnieniem poruszonym przez Sąd Najwyższy, a z perspektywy komentowanego orzeczenia wartym uwagi jest wykorzystanie wizerunku osoby w związku z wykonywanym przez nią zawodem dziennikarza stacji informacyjnej. Zdaniem organu orzekającego fakt ten nie stanowił usprawiedliwienia dla dowolnego użycia tak uzyskanego wizerunku *in genere*.

Zgodnie z dyspozycją art. 23 k.c. poprzez publikację spotu godzącego w prawo powódki do rzetelnego wykonywania zawodu (renoma zawodowa budowana głównie poprzez cechę niezależności) równolegle mamy do czynienia z ingerencją w cześć osobistą (dobre imię człowieka). Warto wskazać, że elementarne zasady, z których można wywieść podstawy wykonywania zawodu dziennikarza, zostały zapisane w rozdziale II Konstytucji, poświęconemu wolności i prawom osobistym. Jak wskazuje art. 54 ustawy zasadniczej, „każdemu zapewnia się wolność wyrażania swoich poglądów”<sup>13</sup>. Na uwagę zasługuje również stanowisko SN, zgodnie z którym „Prawo człowieka do poszanowania godności wyrażającej się w poczuciu własnej wartości i oczekiwania szacunku ze strony innych ludzi dotyczy wszystkich aspektów życia człowieka: osobistego, społecznego i zawodowego”<sup>14</sup>. Ponadto „We wszystkich tych sferach powinno się [...] żywić szacunek do innego człowieka oraz liczyć się z jego poczuciem własnej godności, osobistej wartości i użyteczności społecznej”<sup>15</sup>. Oznacza to, że podstawową rolę mediów jest przekaz informacji, a nie manipulowanie nimi w sposób dowolny

<sup>12</sup> Wyroki SN: z dnia 8 listopada 2012 r., I CSK 177/12, LEX nr 1331252; z dnia 21 marca 2013 r., III CSK 225/12, LEX nr 1324300; z dnia 15 marca 2018 r., III CSK 387/16, LEX nr 2510660.

<sup>13</sup> Konstytucja Rzeczypospolitej Polskiej z dnia 2 kwietnia 1997 r. (Dz. U. Nr 78, poz. 483 ze zm.).

<sup>14</sup> Wyrok SN z dnia 9 października 2002 r., IV CKN 1402/00, LEX nr 78364.

<sup>15</sup> Wyrok SN z dnia 19 września 1968 r., II CR 291/68, OSNC 1969, nr 11, poz. 200.

i uznaniowy. Szczególnie nieakceptowalnym wydaje się być montaż materiału prasowego, w sposób naruszający czyjekolwiek prawa osobiste lub chociażby podający w wątpliwość rzetelność przekazu. Nie sposób również pominąć faktu, że edycja spotu konkretnej partii politycznej wkładająca wypowiedź dziennikarki (nawet niezmienioną) w dłuższy scenariusz, który miał bardzo konkretny wydźwięk polityczny, odnoszący się do głośnej i wywołującej emocje społeczne sprawy, należy uznać za godzący w niezależność dziennikarską. Tym bardziej że z politycznych powodów spot ten prezentował określony punkt widzenia i eksponował cele polityczne partii P. Należy zatem uznać, że tego rodzaju montaż, bez wiedzy i zgody dziennikarki, można rozpatrywać, bazując również na art. 10 § 3 prawa prasowego<sup>16</sup>, który stanowi, że „dziennikarz może nie zgodzić się na publikację materiału prasowego, jeśli wprowadzono do niego zmiany, które wypaczają sens i wymowę jego wersji”. Należy przy tym zauważyć, iż stan faktyczny niniejszej sprawy wskazywał, że powódka nie mogła realizować swoich uprawnień wynikających z prawa prasowego, ponieważ nie był to materiał prasowy, a reklamowo-wyborczy, który został przygotowany bez jej wiedzy.

Sąd Najwyższy potwierdził prawidłowość rozstrzygnięć sądów niższych instancji, wskazując, że ochrona dóbr osobistych w przedmiotowym postępowaniu może być realizowana nie tylko na gruncie prawa autorskiego, tj. art. 81 ust. 1 i ust. 2 pkt 1 oraz art. 83 u.p.a.p.p., ale także na podstawie art. 23 k.c. Warto przy tym podkreślić, że doktrynie znane są dwa nurty interpretacyjne relacji ochrony wynikającej z obu ustaw. Pierwszy z nich, określany jako nurt autonomii zakłada, że ochrona wizerunku osoby fizycznej opiera się na dwóch niezależnych podstawach prawnych: prawie autorskim – w odniesieniu do utrwalenia wizerunku w formie utworu fotograficznego lub filmowego, oraz dobrach osobistych – w odniesieniu do utrwalenia wizerunku w innej formie. Zgodnie z nim wyżej wymienione przepisy ustawy o prawie autorskim i prawach pokrewnych stanowią szczegółowe uregulowania dotyczące ochrony wizerunku w zakresie utworów fotograficznych i filmowych. Oznacza to, że w przypadku utrwalenia wizerunku w innej formie ochrona ta jest regulowana wyłącznie przez przepisy kodeksu cywilnego<sup>17</sup>. Nurt drugi, określany jako nurt kumulatywności zakłada, że ochrona wizerunku osoby fizycznej opiera się na jednej, wspólnej podstawie prawnej, tj. na przepisach kodeksu cywilnego. Zgodnie z nim art. 81 oraz art. 83 u.p.a.p.p. nie stanowią autonomicznych podstaw ochrony wizerunku, lecz jedynie uzupełniają ochronę wynikającą z przepisów kodeksu cywilnego. Oznacza to, że w przypadku utrwalenia wizerunku w formie utworu fotograficznego lub filmowego osoba fizyczna ma prawo do ochrony zarówno na podstawie prawa autorskiego, jak i na podstawie

<sup>16</sup> Ustawa z dnia 26 stycznia 1984 r. – Prawo prasowe (tekst jedn.: Dz. U. z 2018 r., poz. 1914).

<sup>17</sup> J. Barta, R. Markiewicz, *Komentarz do art. 81 u.p.a.p.p.* [w:] M. Czajkowska-Dąbrowska, Z. Cwiąkałski, K. Felchner, E. Traple, J. Barta, R. Markiewicz, *Ustawa o prawie autorskim i prawach pokrewnych. Komentarz*, wyd. 5, Warszawa 2011; por. A. Niewęglowski, *Komentarz do art. 81 u.p.a.p.p.* [w:] *idem*, *Prawo autorskie. Komentarz*, Warszawa 2021; por. S. Kalus, *Komentarz do art. 23 k.c.* [w:] *Kodeks cywilny. Komentarz. Tom I. Część ogólna (art. 1–125)*, red. M. Fras, M. Habdas, Warszawa 2018; por. P. Machnikowski, *Komentarz do art. 23 k.c.* [w:] *Kodeks cywilny. Komentarz*, red. E. Gniewek, P. Machnikowski, wyd. 11, Warszawa 2023, s. 33.

przepisów kodeksu cywilnego. Argumenty przemawiające za kumulatywną ochroną prawa do wizerunku wywodzą się z teorii prawa i z praktyki stosowania prawa. Argumenty z zakresu teorii prawa odnoszą się do natury prawa do wizerunku – wizerunek osoby fizycznej jest istotnym dobrem osobistym, które podlega ochronie, niezależnie od tego, czy został on utrwalony w formie utworu. Ochrona ta powinna być zatem kompleksowa i obejmować wszystkie przypadki naruszenia wizerunku, niezależnie od formy jego utrwalenia<sup>18</sup>. Argumenty z zakresu praktyki stosowania prawa odnoszą się zaś do orzecznictwa sądowego. W ostatnich latach sądy coraz częściej przyjmują pogląd, że ochrona wizerunku osoby fizycznej opiera się na jednej, wspólnej podstawie prawnej, tj. na przepisach kodeksu cywilnego<sup>19</sup>.

Mając na względzie stan faktyczny, należy wskazać, że spór dotyczący podstaw ochrony wizerunku wydaje się być bezprzedmiotowy, ponieważ w komentowanej sprawie zostały zrealizowane przesłanki ochrony na podstawie zarówno kodeksu cywilnego, jak i prawa autorskiego. Sąd Najwyższy uzasadniał powyższe stanowisko, stwierdzając, że ograniczenie ochrony wizerunku osób powszechnie znanych na gruncie prawa autorskiego odnosi się jedynie do rozpowszechniania tego wizerunku w celach związanych z informowaniem o pełnieniu funkcji publicznej. Nie odnosi się do celów reklamowych czy innych celów komercyjnych. Brak zgody powódki na użycie tego materiału skutkowało naruszeniem jej prawa do wizerunku, chronionego przez art. 81 ust. 1 u.p.a.p.p. Oznacza to, że wizerunek powódki został wykorzystany w sposób godzący w jej cześć i dobre imię. Tym samym Sąd Najwyższy trafnie uznał, że przy uwzględnieniu wszystkich przedstawionych w uzasadnieniu argumentów doszło do naruszenia art. 81 ust. 1 u.p.a.p.p. oraz art. 23 w zw. z art. 24 § 1 k.c.

Warto zaznaczyć, że komentowane orzeczenie Sądu Najwyższego zyskało uznanie zarówno wśród komentatorów, jak i w judykaturze, ustanawiając w zakresie rozstrzyganych w nim zagadnień swego rodzaju punkt odniesienia. Jest ono wielokrotnie powoływane jako podstawa do uznania, że komitety wyborcze mają zdolność prawną i sądową. Powyższe potwierdza jego doniosłe znaczenie dla funkcjonowania komitetów wyborczych w polskim systemie prawnym. Wydaje się bowiem, że rozstrzyga ono istotną kwestię prawną, będącą jak dotąd przedmiotem sporów zarówno w doktrynie, jak i orzecznictwie. Zapadły wyrok umożliwił bowiem komitetom wyborczym samodzielne występowanie w obrocie prawnym, a także bycie stroną w postępowaniach sądowych.

Podsumowując, należy przyjąć, że wyrok Sądu Najwyższego z dnia 25 maja 2023 r. (II CSKP 1555/22) zasługuje w całości na aprobatę. Wnikliwość składu orzekającego odnosząca się do każdego z uzasadnianych zagadnień zapewniła, że orzeczenie ma

<sup>18</sup> T. Sokołowski, *Komentarz do art. 23 k.c.* [w:] *Kodeks cywilny. Komentarz. Tom I. Część ogólna*, red. A. Kidyba, wyd. 2, Warszawa 2012; por. S. Dmowski, S. Rudnicki, *Komentarz do art. 1 k.c.* [w:] *idem*, *Komentarz do Kodeksu cywilnego. Księga pierwsza. Część ogólna*, wyd. 10, Warszawa 2011, s. 84; por. M. Gutowski, *Komentarz do art. 23 k.c.* [w:] *Kodeks cywilny, Komentarz*, t. 1, red. *idem*, wyd. 3, Warszawa 2021, s. 202.

<sup>19</sup> Wyroki SA w Katowicach: z dnia 6 kwietnia 2017 r., I ACa 1088/16, LEX nr 2287396 oraz z dnia 9 czerwca 2017 r., I ACa 1068/16, LEX nr 2330639.



niezwykle istotne znaczenie zarówno dla działalności partii politycznych w Polsce, jak i dla ochrony prawa do wizerunku. Wyrok jest korzystny dla osób fizycznych, które mogą realizować przysługujące im prawo do ochrony swojego wizerunku przed bezprawnym wykorzystaniem go przez komitety wyborcze, a w konsekwencji – przez partie polityczne. Dodatkowo warto podkreślić, że jest ono zgodne z trendami rozwoju społecznego i technologicznego, zgodnie z którymi utrwalenie wizerunku osoby fizycznej jest coraz łatwiejsze i bardziej powszechne. Zagadnienie jest o tyle istotne, że partie polityczne mają duży wpływ na opinię publiczną i mogą wykorzystać wizerunek osób fizycznych w sposób dla niej niekorzystny, a jednostka – jak słusznie uznał Sąd Najwyższy – nie może zostać pozbawiona prawa do jego ochrony.

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## Streszczenie

*Marcin Perzyna*

**Odpowiedzialność partii politycznych za działalność komitetów wyborczych.  
Ochrona wizerunku osoby w związku z wykonywaniem przez nią zawodu dziennikarza  
stacji informacyjnej na gruncie kodeksu cywilnego i prawa autorskiego**

W komentowanym wyroku Sąd Najwyższy uznał, że partia polityczna ponosi odpowiedzialność za bezprawne wykorzystanie wizerunku osoby fizycznej przez jej komitet wyborczy, po ustaniu jego działalności. Odpowiedzialność ta wynika z następstwa prawnego partii, jak również jest bezpośrednim skutkiem legitymacji bierniej pozwanej partii, będącej następstwem oznaczenia



spotu wyborczego mocno eksponowanym szyldem tej partii. W zakresie naruszenia prawa do wizerunku SN uznał, że wizerunek powódki został naruszony równolegle na gruncie prawa autorskiego poprzez brak zgody powódki i brak zajęcia przesłanek ograniczających ochronę oraz na gruncie kodeksu cywilnego, ponieważ publikacja spotu wyborczego partii wykorzystująca wizerunek powódki ingerowała w sposób niedozwolony w jej cześć osobistą i zawodową, dobre imię człowieka i dobre imię zawodowe.

**Słowa kluczowe:** odpowiedzialność partii politycznych, komitety wyborcze, ochrona wizerunku dziennikarza.

## Summary

*Marcin Perzyna*

### **The Liability of Political Parties for the Activities of Electoral Committees. Protection of a Person's Image in Connection with His/Her Profession as a Journalist on a News Channel under the Polish Civil Code and Copyright Law**

The subject of the Supreme Court judgment under review is the recognition of the liability of a political party for the unlawful use of an individual's image by its electoral committee after the committee's activities are over. This liability arises both from the legal status of the party and as a direct consequence of the passive legitimation by the defendant party as a result of the marking of an election advertisement with the party's clearly visible name. With regard to the violation of the plaintiff's personal rights, the Supreme Court held that her right to her image had been violated, both under copyright law, because of the lack of the plaintiff's consent and the absence of conditions limiting protection, and under the Civil Code, since the publication of the party's election advertisement using the plaintiff's image in an unauthorised manner interfered with her personal and professional honour, her good name as a human being, and her professional reputation.

**Keywords:** liability of political parties, electoral committees, protection of a journalist's image.

# Kwalifikacja środków płatniczych jako materiałów urzędowych na gruncie ustawy o prawie autorskim i prawach pokrewnych. Dopuszczalność ochrony prawnoautorskiej w przypadku naruszenia praw autorskich podczas wytwarzania materiałów urzędowych

Wyrok Sądu Najwyższego z dnia 26 stycznia 2023 r., II CSKP 566/22<sup>1</sup>

Z uwagi na procedurę prawną powstania środków płatniczych stanowią one materiały urzędowe bez względu na to, czy w danej sytuacji posiadają również charakter komercyjny. Środki płatnicze: banknoty i monety, objęte są wyłączeniem z art. 4 ustawy z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych. Implikuje to wniosek, że nie stanowią one przedmiotu prawa autorskiego.

## Kamil Wasilewski

Pomorska Izba Adwokacka, Polska

wasilewski@kancelariasbp.pl

ORCID: 0009-0003-0425-6046

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## Glosa

Glosowany wyrok Sądu Najwyższego (dalej: SN) jest kolejnym stanowiskiem w dyskursie dotyczącym kwalifikacji prawnej środków płatniczych jako elementu katalogu wytworów wyłączonych spod ochrony prawnoautorskiej, o którym mowa w art. 4 ustawy z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych (tekst jedn.: Dz. U. z 2022 r., poz. 2509; dalej: u.p.a.p.p.). Na kanwie rozpoznawanej sprawy SN odnosi się również do znaczenia funkcji środka płatniczego, którego emisja w tym przypadku miała charakter komercyjny. Poruszana jest także istotna kwestia ograniczenia swobody korzystania z wytworów niestanowiących przedmiotu prawa autorskiego.

W przedmiotowym stanie faktycznym Narodowy Bank Polski (dalej: NBP) planował komercyjną, nastawioną na zysk emisję monet okolicznościowych, której motywem przewodnim miała być promocja polskich malarzy. Sporne monety dotyczyły

<sup>1</sup> OSNC-ZD 2023, nr 4, poz. 47; LEX nr 3519173.

malarza W.S. Każda z nich miała zawierać portret artysty i jego najbardziej charakterystyczny obraz. NBP zawarł z projektantką E.T. dwie umowy o dzieło, których przedmiotem było opracowanie projektu monet.

W projekcie monety 2 zł autorstwa E.T. wykorzystany został w całości utwór W.S. z 1942 r., natomiast w monecie 20 zł wykorzystano w całości utwór (obraz olej na płótnie) z 1934 r., a także znaki graficzne (czcionki) autorstwa W.S. Obrazy malarza przedstawione na monetach nie były modyfikowane i stanowiły odwzorowanie oryginalnych utworów. Korzystanie przez pozwanego ze spornych monet zostało uznane przez orzekające w sprawie sądy powszechne za mieszczące się w kategoriach pól eksploatacji określonych w art. 50 u.p.a.p.p. i obejmowało w szczególności utrwalenie utworu w pamięci komputera, zwielokrotnienie utworu na nośnikach materialnych (monetach) oraz odpłatne wprowadzenie tego nośnika do obrotu. Korzystanie to miało charakter bezpośredni, albowiem utwory autorstwa W.S. stanowiły niezależne i kompletne elementy projektów autorstwa projektantki E.T.

Narodowy Bank Polski, przygotowując emisję, standardowo poszukuje osób posiadających prawa autorskie do wizerunków i utworów wykorzystywanych na znakach pieniężnych. W przypadku spornych monet i osoby W.S. poszukiwania zakończono na nieżyjącej córce malarza. Wskutek zbyt okrojonej kwerendy, która ograniczyła się do przeglądania stron internetowych, NBP nie wykrył, że w momencie planowania emisji majątkowe i niemajątkowe prawa autorskie przysługiwały wnuczce zmarłego.

Po wyemitowaniu i zakończeniu sprzedaży monet powództwo przeciwko Narodowemu Bankowi Polskiemu o zapłatę wynagrodzenia za korzystanie z utworów W.S. bez zgody osoby uprawnionej wytoczyła wnuczka malarza, która na podstawie dziedziczenia nabyła po matce wszelkie majątkowe i niemajątkowe prawa autorskie odziedziczone przez nią po zmarłym artyście. Kwestia dziedziczenia autorskich praw majątkowych i niemajątkowych, choć podnoszona w wywiedzionej skardze kasacyjnej i rozważana w glosowanym orzeczeniu, z uwagi na ramy niniejszej glosy, nie będzie przedmiotem dalszych rozważań.

Sąd I instancji uwzględnił powództwo w całości. Strona pozwana wywiodła apelację, która została przez sąd II instancji oddalona. Od wyroku sądu odwoławczego pozwany wywiodł skargę kasacyjną, zarzucając w niej naruszenie szeregu przepisów ustawy o prawie autorskim i prawach pokrewnych oraz kodeksu postępowania cywilnego<sup>2</sup>. W kontekście przedmiotu zainteresowania niniejszej glosy najwięcej uwagi należy poświęcić zarzutowi naruszenia art. 4 pkt 2 u.p.a.p.p., na tle którego Sąd Najwyższy przedstawił omawiane stanowisko.

Argumentacja skarżącego zmierzała do wykazania, że z uwagi na posiadanie przez emitowane monety statusu środka płatniczego stanowią one materiały urzędowe w rozumieniu art. 4 pkt 2 u.p.a.p.p., a w konsekwencji są wyłączone spod ochrony prawa autorskiego. Sąd Najwyższy uznał ten zarzut za niezasadny, stwierdzając, że o ile środki płatnicze z uwagi na procedurę prawną ich powstawania mieszczą się w pojęciu

<sup>2</sup> Ustawa z dnia 17 listopada 1964 r. – Kodeks postępowania cywilnego (tekst jedn.: Dz. U. z 2023 r., poz. 1550).

materiałów urzędowych, o tyle na kanwie przedmiotowej sprawy kwestia ta nie ma decydującego znaczenia. Istotne było bowiem to, że do naruszenia praw autorskich doszło podczas wytwarzania znaków pieniężnych. Bez znaczenia pozostawał również fakt, że monety miały charakter kolekcjonerski. Należy bowiem zauważyć, że na gruncie ustawy z dnia 29 sierpnia 1997 r. o Narodowym Banku Polskim (tekst jedn.: Dz. U. z 2022 r., poz. 2025; dalej: u.n.b.p.) stanowią one środek płatniczy o wartości nominalnej na nich wskazanej.

Stanowisko przedstawione przez Sąd Najwyższy w glosowanym orzeczeniu zasługuje na pełną aprobatę, zarówno w zakresie stwierdzenia, że środki płatnicze zawierają się w pojęciu materiałów urzędowych bez względu na komercyjny charakter emisji, jak również w kwestii ustalenia, że wytwarzanie materiałów urzędowych z naruszeniem praw autorskich nie może skutkować pozbawieniem osoby uprawnionej prawa do realizacji ochrony prawnoautorskiej, w tym do dochodzenia roszczeń, o których mowa w art. 79 u.p.a.p.p.

Zgodnie z art. 1 ust. 1 u.p.a.p.p. przedmiotem prawa autorskiego jest każdy przejaw działalności twórczej o indywidualnym charakterze, ustalony w jakiejkolwiek postaci, niezależnie od wartości, przeznaczenia i sposobu wyrażenia (utwór). Na podstawie art. 4 pkt 2 u.p.a.p.p. nie stanowią przedmiotu prawa autorskiego urzędowe dokumenty, materiały, znaki i symbole. Choć sam katalog wytworów wyłączonych spod prawa autorskiego jest niewątpliwie zamknięty, to pojęcia w nim zawarte mają potencjalnie szerokie i niedookreślone wprost znaczenie. Spośród środków wymienionych w przytoczonym przepisie terminem niewątpliwie najszerszym są materiały urzędowe. W konsekwencji braku definicji legalnej w judykaturze i doktrynie podjęto liczne próby wykładni tego pojęcia. W wyroku z dnia 19 lutego 1997 r. Naczelny Sąd Administracyjny (dalej: NSA) podkreślił, że termin „materiały urzędowe” odznacza się stosunkowo dużą pojemnością, jest on bowiem zdolny pomieścić wszystko to, co nie będąc dokumentem, jest urzędowe. Przy czym cechę tę materiał może uzyskać, gdy pochodzi od urzędu bądź dotyczy sprawy urzędowej, bądź wreszcie dlatego, że powstał on w rezultacie procedury urzędowej<sup>3</sup>. W kwestii wykładni pojęcia materiałów urzędowych, w orzecznictwie SN i NSA widoczna jest dominująca tendencja do stosowania wykładni rozszerzającej<sup>4</sup>.

Przeciwnicy rozszerzającej wykładni pojęcia materiałów urzędowych wskazują na zasadność stanowiska Zbigniewa Pinkalskiego, zgodnie z którym materiał urzędowy istnieje w przypadku łącznego spełnienia następujących przesłanek: stworzenia materiału w ramach urzędu, w związku z procedurą urzędową oraz odnoszenia się go do sprawy urzędowej<sup>5</sup>. Niezależnie od podzielanego poglądu należy zauważyć, że środki

<sup>3</sup> Wyrok NSA z dnia 19 lutego 1997 r., I SA/Kr 1062/96, LEX nr 29303.

<sup>4</sup> Zob. wyrok SN z dnia 26 września 2011 r., IV CKN 458/00, LEX nr 52711; wyrok NSA z dnia 27 stycznia 2012 r., I OSK 2130/11, LEX nr 1126276.

<sup>5</sup> Z. Pinkalski, *Wyłączenia spod ochrony prawnoautorskiej*, ZNUJ PPWI 2009, z. 4, s. 48. Zob. także J. Barta, R. Markiewicz, *1.5. Wyłączenia wybranych kategorii wytworów intelektu spod prawa autorskiego* [w:] *idem, Prawo autorskie i prawa pokrewne*, Warszawa 2019 oraz wyrok SN z dnia 27 lutego 2009 r., V CSK 337/08, LEX nr 488738.

płatnicze mieszczą się również w tej węższej koncepcji, gdyż proces ich wytwarzania oraz cel im przypisany spełniają wszystkie wymienione powyżej przesłanki.

Kwalifikację przez SN środków płatniczych jako materiałów urzędowych z uwagi na ich charakter oraz ściśle określoną procedurę emisji należy uznać za prawidłową. Stosując wnioskowanie *a contrario*, środki płatnicze, w tym monety kolekcjonerskie, z pewnością nie zawierają się w terminie dokumentu ani symbolu. Z uwagi na tożsamość pojęciową niewykluczone jest natomiast zakwalifikowanie środków płatniczych jako znaków urzędowych w rozumieniu art. 4 pkt 2 u.p.a.p.p.<sup>6</sup> Sugeruje to chociażby zbieżność nazewnictwa. Zgodnie bowiem z art. 31 u.n.b.p. znakami pieniężnymi Rzeczypospolitej Polskiej są banknoty i monety opiewające na złote i grosze, natomiast art. 32 wspomnianej ustawy stanowi, że znaki pieniężne emitowane przez NBP są prawnymi środkami płatniczymi na obszarze Rzeczypospolitej Polskiej. Widoczna jest więc tożsamość pojęciowa przejawiająca się w treści obu ustaw. Niemniej, przy definiowaniu terminu znaków urzędowych w doktrynie wskazuje się raczej na znaki jakości, znaki gwarancyjne, znaki kontrolne, znaki promocyjne, znaki drogowe, stemple oraz odznaczenia, jako elementy o określonej specyfice. W świetle powyższego za zasadne należy uznać zaliczenie środków płatniczych do kategorii materiałów urzędowych.

Kolejnym argumentem przemawiającym za taką kwalifikacją jest wysoce sformalizowana procedura ich wytwarzania, którą regulują przepisy ustawy o Narodowym Banku Polskim oraz wydane na jej podstawie akty wykonawcze. Każdorazowa emisja środków płatniczych, także tych kolekcjonerskich, następuje na podstawie zarządzenia Prezesa NBP. W zarządzeniu określany jest wzór, wartość nominalna banknotów, wzory, wartość nominalna, stop, próba i masa monet, wielkość samej emisji, a także terminy wprowadzenia znaków pieniężnych do obiegu. Ponadto Narodowy Bank Polski jako centralny bank państwa jest wyłącznym emitentem znaków pieniężnych Rzeczypospolitej Polskiej, umocowanym do tego w ustawie zasadniczej.

Niezależnie od powyższego, w warunkach stanu faktycznego, na kanwie którego zapadło głosowane orzeczenie, kwestia kwalifikacji wyemitowanych monet w ramach art. 4 u.p.a.p.p. nie miała decydującego znaczenia dla rozstrzygnięcia sprawy. Niezależnie bowiem od zaliczenia środków płatniczych do kategorii materiałów urzędowych czy też znaków urzędowych na gruncie aktualnego brzmienia ustawy o prawie autorskim niewątpliwie nie podlegają one ochronie prawnoautorskiej.

Z poglądem tym należy się zgodzić. Zgodnie z wyrokiem Sądu Apelacyjnego (dalej: SA) w Lublinie z dnia 31 maja 2005 r. przewidziane w art. 4 u.p.a.p.p. wyłączenia mają charakter „całkowity” w tym sensie, że wytwory intelektualne usytuowane w którejkolwiek z wyluczonych w tym przepisie kategorii materiałów są pozbawione prawnoautorskiej ochrony zarówno w przypadku eksploatacji tych materiałów w całości,

<sup>6</sup> Tak m.in. D. Flisak, *Komentarz do art. 4 u.p.a.p.p.* [w:] M. Bukowski, Z. Okoń, P. Podrecki, J. Raglewski, S. Stanisławska-Kloc, T. Targosz, D. Flisak, *Prawo autorskie i prawa pokrewne. Komentarz*, Warszawa 2015.

jak i w części oraz niezależnie od kontekstu eksploatacji<sup>7</sup>. Aktualne brzmienie przytoczonego art. 4 u.p.a.p.p. nie daje bynajmniej podstaw do stosowania wykładni rozszerzającej, w wyniku której brak ochrony prawnoautorskiej byłby uzależniony od warunków, charakteru lub sposobu eksploataowania wytworu.

W całości należy podzielić także przedstawiony w glosowanym orzeczeniu pogląd, zgodnie z którym fakt wyłączenia materiałów urzędowych spod ochrony prawnoautorskiej nie może skutkować pozbawieniem tej ochrony twórców utworów stanowiących przedmiot prawa autorskiego, których prawa zostały naruszone podczas opracowywania materiałów urzędowych.

Szczególną uwagę w tym aspekcie należy zwrócić na moment, w którym doszło do naruszenia praw autorskich. W przedmiotowym stanie faktycznym do wykorzystania utworów bez zgody osoby uprawnionej doszło w trakcie procesu wytwarzania środków płatniczych, zanim jeszcze przystąpiono do emisji monet kolekcjonerskich. O ile bowiem sam środek płatniczy nie podlega ochronie prawa autorskiego, o tyle status środka płatniczego znak pieniężny uzyskuje dopiero w momencie jego emisji dokonywanej na podstawie zarządzenia Prezesa NBP. Konsekwencją powyższego powinno być uznanie, że do czasu nabycia przez utwór statusu wyłączającego go spod ochrony prawnoautorskiej może on korzystać z przepisanej prawem ochrony przed naruszeniami.

Zasadność wyżej wskazanego stanowiska potwierdza prezentowany w doktrynie pogląd, zgodnie z którym pomimo wykluczenia z zakresu prawa autorskiego określonych wytworów, takich jak materiały czy znaki urzędowe, swoboda korzystania z nich nie może być uznawana za bezgraniczną. Może ona bowiem doznawać ograniczeń na podstawie innych przepisów, takich jak przepisy chroniące dobra osobiste, tajemnicę czy przeciwdziałające nieuczciwej konkurencji. Reprodukowanie bądź rozpowszechnianie materiałów wskazanych w art. 4 u.p.a.p.p. może także stanowić szkodę, której naprawienia można dochodzić na zasadach ogólnych<sup>8</sup>. Ograniczenie swobody może wynikać także z ustaw szczegółowo regulujących zasady i sposób wykorzystania określonych przedmiotów, takich jak chociażby znaki pieniężne w rozumieniu ustawy o Narodowym Banku Polskim<sup>9</sup>.

Dopuszczenie ochrony wytworów niestanowiących przedmiotu prawa autorskiego na podstawie innych przepisów powszechnie obowiązujących znajduje swoje uzasadnienie aksjologiczne oraz systemowe. Stanowisko przeciwne skutkowałoby dopuszczeniem możliwości pośredniego naruszania praw autorskich przy wytwarzaniu wytworów objętych katalogiem wyłączeń, o którym mowa w art. 4 u.p.a.p.p., co prowadziłoby do potencjalnych nadużyć i w konsekwencji pozbawiałoby twórców jakiegokolwiek ochrony przed tego rodzaju szkodliwymi praktykami. Poza sytuacją bezprawnego wykorzystania dzieł malarskich przy emisji monet kolekcjonerskich w ramach

<sup>7</sup> Wyrok SA w Lublinie z dnia 31 marca 2005 r., I ACa 83/05, LEX nr 535043.

<sup>8</sup> Wyrok SN z dnia 26 września 2011 r., IV CKN 458/00, LEX nr 52711.

<sup>9</sup> Tak m.in. A. Nowicka, *Komentarz do art. 4 u.p.a.p.p.* [w:] *Ustawy autorskie. Komentarze. Tom I*, red. R. Markiewicz, Warszawa 2021; D. Flisak, *Komentarz do art. 4 u.p.a.p.p.* [w:] M. Bukowski, Z. Okoń, P. Podrecki, J. Raglewski, S. Stanisławska-Kloc, T. Targosz, D. Flisak, *Prawo autorskie...*

przykładów takiego postępowania można wskazać chociażby powielenie treści pracy naukowej przy opracowywaniu projektu aktu normatywnego lub pisma urzędowego bądź też implementację znaku graficznego przy projektowaniu herbu jednostki samorządu terytorialnego. Wydzielenie momentu, w którym dany wytwór uzyskuje status dyskwalifikujący go z przedmiotu prawa autorskiego, ma więc fundamentalne znaczenie dla oceny, czy doszło do naruszenia praw autorskich twórcy.

Konstatując, w omawianym wyroku Sąd Najwyższy rozstrzygnął dwa niezwykle ważne zagadnienia istotne z uwagi na przedmiot zainteresowania niniejszej glosy – kwestię uznania środków płatniczych za materiały urzędowe w rozumieniu art. 4 pkt 2 u.p.a.p.p. bez względu na charakter ich emisji oraz dopuszczalność stosowania ochrony praw autorskich w przypadku ich naruszenia podczas wytwarzania wytworów niestanowiących przedmiotu prawa autorskiego. Przedmiotowe orzeczenie jest niewątpliwie istotnym głosem w trwającej od wielu lat dyskusji w tym zakresie.

Przedstawione stanowisko autora jest zbieżne z poglądami wyrażonymi w glosowanym wyroku. Wysoki stopień formalizacji procedury emisji środków płatniczych oraz swoisty monopol na ich emisję przez Narodowy Bank Polski potwierdzają zasadność ich kwalifikacji jako materiałów urzędowych bez względu na to, czy w danej sytuacji posiadają one charakter komercyjny. Przedmiotowy wyrok, choć wydany na kanwie dość specyficznego stanu faktycznego, pozwolił także na uchwycenie *ratio legis* przepisu określającego katalog środków niestanowiących przedmiotu prawa autorskiego. Przyjęcie ograniczonej swobody korzystania z wytworów wyłączonych spod ochrony prawnoautorskiej jest koncepcją uzasadnioną aksjologicznie oraz wzmacniającą pozycję twórców.

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## Streszczenie

*Kamil Wasilewski*

**Kwalifikacja środków płatniczych jako materiałów urzędowych na gruncie ustawy o prawie autorskim i prawach pokrewnych. Dopuszczalność ochrony prawnoautorskiej w przypadku naruszenia praw autorskich podczas wytwarzania materiałów urzędowych**

Przedmiotowa glosa wyraża aprobatę dla tez postawionych w wyroku Sądu Najwyższego z dnia 26 stycznia 2023 r. wydanym w sprawie II CSKP 566/22. W glosowanym orzeczeniu SN opowiedział się za kwalifikacją środków płatniczych w ramach pojęcia materiałów urzędowych, o którym mowa w art. 4 pkt 2 ustawy o prawie autorskim i prawach pokrewnych bez względu na charakter emisji. Wskazano również na dopuszczalność stosowania ochrony prawnoautorskiej w przypadku naruszenia praw autorskich w toku wytwarzania wytworów niestanowiących przedmiotu prawa autorskiego. Zdaniem autora niniejszej glosy podjęte rozstrzygnięcie odpowiada *ratio legis* przepisu określającego katalog środków wyłączonych spod ochrony prawnoautorskiej, którym nie jest całkowita swoboda w korzystaniu z nich. Wysoki stopień formalizacji procedury emisji środków płatniczych potwierdza natomiast zasadność uznania ich za materiały urzędowe.

**Słowa kluczowe:** materiały urzędowe, środki płatnicze, naruszenie praw autorskich.

## Summary

*Kamil Wasilewski*

**Qualification of Means of Payment as Official Materials Contained in the Copyright and Related Rights Act. The Admissibility of Copyright Protection in the Event of Copyright Infringement That Occurred during the Production of Official Materials**

This gloss expresses approval of the theses set out in the Polish Supreme Court's judgment delivered on 26 January 2023 in case II CSKP 566/22. In the judgment discussed, the Supreme Court supported the classification of means of payment within the definition of official materials contained in art. 4(2) of the Copyright and Related Rights Act, without regard to the character of their type of issue. Another important subject discussed refers to the relationship between the lack of copyright protection for products that are not the subject of copyright laws and the infringement of the rights of the creator of the protected work during the production of these products.

**Keywords:** official materials, means of payment, copyright infringement.



# Varia





**Aleksandra Górska-Jankowska**

University of Gdańsk, Poland

aleksandra.gorska-jankowska@phdstud.ug.edu.pl

ORCID: 0000-0002-6326-4703

## **The EIPIN Doctoral Seminar and International Conference: “Coordination of Intellectual Property Law and the New European Data Law”, Munich, 1–2 June 2023 (Report)**

On 1–2 June 2023 the Doctoral Seminar and International Conference entitled “Coordination of Intellectual Property Law and the New European Data Law” was held at the Max Planck Institute for Innovation and Competition in Munich. This was the subsequent edition of the regular academic meeting organized by the EIPIN-Innovation Society in cooperation with associated universities and research institutions.

The European Intellectual Property Institutes Network (EIPIN) is a network of European institutions established in 1999 to facilitate and increase cooperation among intellectual property (IP) institutions and students in Europe. Its activity mainly focuses on conducting research in the field of IP law and organizing seminars and conferences. Among its members are the University of Alicante, Spain, the University of Strasbourg, France, Maastricht University, Netherlands, and the Max Planck Institute for Innovation and Competition, Germany. As part of EIPIN’s activities, affiliated institutions organize annually a doctoral seminar, during which doctoral candidates at different stages of their research have the opportunity to report on their research and to receive feedback from professors and other doctoral candidates.

The 2023 edition of the EIPIN Doctoral Seminar took place on 1 June 2023 at the Max Planck Institute for Innovation and Competition in Munich. This year’s edition was attended by seven doctoral students. The seminar began with a warm welcome from Prof. Dr. Josef Drexler, LL.M. (UC Berkeley), a Director and Scientific Member at the Max Planck Institute for Innovation and Competition. The seminar’s inaugural presentation was by Filipe de Andrade from Maastricht University entitled “Technology Transfer, Intellectual Property, Trade Law and Sustainability.” Prof. Manuel Desantes Real from the University of Alicante provided insightful commentary on de Andrade’s research. Next, Aleksandra Górska-Jankowska, from the University of Gdańsk, on behalf of the University of Alicante, explored the topic entitled “The Bestseller Clause as a Realization of the Principle of Appropriate and Proportionate Remuneration of Authors and Performers.” Prof. Guido Westkamp from Queen Mary University of London offered his detailed expert critique on the matter presented by Górska-Jankowska. Next, Abhijeet Kumar of Queen Mary University of London presented the topic entitled “Protecting

Intangible Cultural Heritages of Adivasis.” Kumar’s presentation was subsequently commented on by Anke Moerland from the University of Maastricht, who shared her perspective on this research topic. The seminar also featured Li Aolan of Queen Mary University of London with a presentation entitled “Contextualizing Legitimate Interests of Data Controllers in Private Sector: A Comparative Perspective,” which Klaus Wiedemann of the Max Planck Institute commented on; Chen Yiqiong of the Max Planck Institute presented “Access to and (Re-)Use of Data for Developing AI Systems,” with Prof. Julián López Richart of the University of Alicante offering commentary, and Korbinian Schrom of Munich University, analyzed “Data access obligations to enable horizontal competition. A sector-specific analysis of Art. 6(11) Digital Markets Act with special consideration of trade secret protection,” with complementary insights from Beatriz Conde Gallego of the Max Planck Institute. The seminar closed with doctoral student Liza Herrmann of the Max Planck Institute, who presented a topic entitled “Cyber Bots as a Competitive Threat – A Competition Policy Risk Assessment and Regulatory Approaches,” with Anselm Kamperman Sanders of Maastricht University providing the closing remarks.

In reviewing the seminar, it is important to highlight the high quality of the presentations. All speakers delivered engaging, in-depth presentations. Additionally, the feedback and insights from the professors added great value. Their guidance was insightful, encouraging deeper thought and further exploration of the topics.

On 2 June, the Max Planck Institute hosted the EIPIN International Conference, which was structured into several insightful panels, each addressing pivotal issues at the intersection of intellectual property, technology and competition. Prof. Dr. Josef Drexler began by welcoming all attendees giving the floor to the speakers.

The first panel, “Data Interoperability and IP,” was led by Prof. Anselm Kamperman Sanders from Maastricht University. This panel featured two speakers: Giuseppe Colangelo from the University of Basilicata, who discussed “The Need to Promote Access to (Potentially IP or Trade Secrets Protected) Application Programming Interfaces (APIs),” and Valentina Moscon from the Max Planck Institute (MPI), Munich, who presented her research on “Coordination of Data Access Rules with Protection of Technical Protection Measures (TPMs) against Circumvention.” Following this, the second panel delved into “IP and Trade Secrets Protection as a Potential Impediment to AI Development.” Luke McDonagh from the London School of Economics, examined the topic of “Potential IP and Trade Secrets Protection for Data Used for AI Development,” while Jean-Marc Deltorn from Center for International Intellectual Property Studies, Strasbourg, addressed “IP and Trade Secrets Protection for Software Elements of AI Systems.” The second panel was moderated by Prof. Julián López Richart of the University of Alicante. The third panel, entitled “Competition Policy-Inspired Data Access,” was chaired by Hanns Ullrich from MPI Munich. It began with a presentation by Björn Lundqvist from the University of Stockholm on “The DMA and the German GWB: Coordination of IP and Trade Secrets Protection under Specific Competition Policy-Inspired Data Access Rules.” Peter Picht from the University of Zurich then discussed his research “On the Need for a Uniform Approach of Competition Law to the Duty to License IP and the

Sharing of Data.” The fourth panel focused on the topic “Prohibitions of International Data Transfers for Protecting IP and Trade Secrets.” The panel was chaired by Prof. Manuel Desantes Real from the University of Alicante and featured three researchers: Tobias Naef from the Office of the Data Commissioner of the Canton Zurich (“The GDPR: Governing International Data Transfers at the Intersection of Privacy and Trade”), Heiko Richter from MPI Munich (“The Data Governance Act: Controlling International Data Transfers of Public Sector Data”), and Josef Drexl, also from MPI Munich (“The Data Act: Prohibition of International Data Transfers as an Obligation of Cloud Service Providers”). The conference concluded with a comprehensive panel discussion entitled “What Comes Next? New Challenges at the Interface of IP, Competition, and Data Law,” where experts deliberated on the future trajectory of these intertwined domains.

The EIPIN International Conference, held at the Max Planck Institute for Innovation and Competition in Munich, served as a key platform for European professionals and academics in the realm of intellectual property, technology and competition. The structured panels and expert-led discussions not only deepened the understanding of current challenges but also highlighted potential avenues for future research and collaboration. The presentations were met with interest, leading to active panel discussions that often extended beyond the formal sessions into less formal collegial discussions. The inclusion of legal scholars from various research centers further enriched the dialogue, allowing for a comprehensive exchange of views and experiences on the topics discussed.