Copyright on the Internet:  
A Comparative Study

By:

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DEDICATION

To my beloved parents, brother and sister...
May God save them all.
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Thanks before every thing and after every thing
are for God who provides me with the desire and
the power to complete this work.
PREFACE

Nowadays the Internet is a wide-open source for information, entertainment, and communication. Many people believe that anything and everything go in cyberspace can be freely obtained without problems. That was also my believe, until I became more informed by realizing the fact that, some times in a quest for knowledge and entertainment Internet users cross hidden lines. Those users and without proper knowledge, unintentionally break the copyright laws that govern the Internet and this is due to the common misleading facts which caused them to believe that copyright laws do not apply to the Internet.

In this dissertation I tried to focus on the most important debatable issues arising from the interaction between copyright law and the digital environment represented by the presence of the Internet. In so doing I adopted the comparative approach to study these issues by comparing between the position in the United States of America- since it was the first Country that have enacted laws to deal with the protection of copyrighted works published via the Internet, and the laws in Europe by visiting number of European Directives that govern the use of the Internet as a media to publish copyrighted materials.

The chance that I have got by spending some time at the University of Turin and the WIPO Academy was very useful in collecting the materials needed to draw such a comparison, but the main challenge that faced me is to have some materials about the position in Sudan. Unfortunately, there is no any legislative reaction in our national law to deal with the new digital challenges about the protection of copyrighted works that
have been published through the Internet, nor is there any literature made by the legal writers in Sudan to remedy this problem.

Anyway, I regard this dissertation as serious signal addressed to the Sudanese legislature in order to take a quick stand if we would like to reach the international copyright standards for an on-line copyright protection, specially, as we striving to join the WTO, the thing which -in my opinion- is very difficult to achieve without revisiting all our IP laws and in front of them, our Copyright Law.
ABSTRACT

Copyright On the Internet: A Comparative Study

This dissertation aims to highlight the copyright challenges brought about by the Internet, summarize some of the legal instruments that are available to address them today both in the international law and in the national law of the US and Europe, and project what issues a Sudanese legislature should consider to make sure that the local legal framework for protection of creative content is ready to meet the demands of the Internet revolution. In so doing, the study focused on the most major challenges that the Internet poses for law-makers in the area of copyright law.

The main objectives of this study are, firstly, to correct the common misunderstanding of the nature of the copyrighted materials that are published through the Internet by making it very clear that using the Internet as a media to publish copyrighted contents does not change the fact that, these contents are well protected by the law, and no body can use them without a proper consent from their owners being obtained. Secondly, the thesis, and through adopting the method of a comparative study, attempts to learn from other countries which have dealt with the new Internet challenges in their national laws.

The findings of this study are found in chapter four, in which the whole thesis has been concluded and followed by number of recommendations for the urgent intention of the Sudanese legislature. In short, the study recommended that some new sections have to be added to the Copyright and Neighboring Protection Rights Act 1996 such as the need to insert new definitions for some terms such as the term "reproduction", 
"copying", "communication" and the term "making available". The study recommended also that some terms in the 1996 Act be revisited and amended to give its proper legal meaning, such as the term "broadcasting". Regarding the liability of the Internet intermediaries and the private international law rules to govern copyright online disputes which are largely untested under the Sudanese copyright law, we recommend that the Sudanese legislature should take a serious and urgent stand to deal with these most demanding issues.
المستخلص

In English translation:

The document appears to be in Arabic and contains text discussing various topics, possibly legal or administrative matters. However, the specific content is not clearly visible due to the format and quality of the image.
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CHAPTER ONE

AUTHORS’ ECONOMIC RIGHTS IN THE DIGITAL ENVIRONMENT

INTRODUCTION:

Copyright laws around the world were clearly designed with analogue technology in mind. The arrival of digital technology presents these copyright laws with a set of clear challenges. Copyright works, whether in text, image or sound, once digitized\(^{(1)}\) are put in one single digital format. This means that, in practice, all copyright works look the same in their first form until they are projected onto a screen. It also means that works of a different nature can be easily combined and modified\(^{(2)}\).

It is also important to note that whilst digitization leads to a loss in quality, in practice this loss can barely be identified. Moreover, once in digital form, identical copies of the digital version can be made with no further loss in quality. Accordingly, and in such a case, people have little interest in paying for the original work or legitimate copies because, on the one hand, the quality is almost or – may be at some times – the same as with any original copy, and on the other hand, their infringing activities cannot be

\(^{(1)}\) Digitization is the process of transforming data from analog into digital form (that is binary coded files—“0” and “1” for us in computers). Scanning photographic images, uploading a music CD to your computer or ipod and converting text on paper into text in computer files, are all examples of digitization. Examples of digital content include articles available on online newspaper site, MP3 music files and web casting of Internet radio signals, photographs of movie stars on celebrity fan sites, online pictures from art galleries and digital museums. Source: High-Tech Dictionary, available at http://www.computeruser.com/resources/dictionary/definition.html?Lookup=6430. (Visited in January 2008)

traced\(^{(3)}\). So authors can not enforce their “economic rights” easily and, therefore, they lose significant income and in this sense the primary purpose of copyright which is to reward the authors, is not met\(^{(4)}\). In addition, they will be less inclined to digitize their creations by putting them in an online environment.

This chapter deals with some problematic aspects regarding publishing of copyrighted materials via the Internet through discussing the legal effect of such publication according to the law in Europe, U.S.A, and Sudanese law.

**COPYRIGHT AND THE INTERNET: HISTORICAL BACKGROUND OF THE INTERNATIONAL FRAMEWORK:**

(i) BERNE CONVENTION:

The Berne Convention 1886 was the first attempt to harmonize copyright law at a global level, and to accommodate new technological development. This Convention was updated quite regularly, namely; by the Act of Berlin (13 November 1708); the Additional Protocol of Berne (20 March 1914); the Act of Rome (2 June 1928); the Act of Brussels (26 June 1948); the Act of Stockholm (14 July 1967) along with the Protocol regarding Developing Countries, and Finally the Act of Paris (24 July 1971), along with an Appendix regarding developing countries\(^{(5)}\).

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\(^{(3)}\) R. HILTY, “Copyright in the Internal Market”, in 35 IIC 2004, p. 760 FF.


However, after the 1971 Paris Act, the international community adhered to the strategy of “guided development” to respond to changing technology, rather than trying to establish new international norms(6).

(ii) WIPO COPYRIGHT TREATY (WCT):

By the end of the 1980s, it became apparent that the non-binding standards of “guided development” favored by WIPO were insufficient to combat increasing piracy and that there was a growing divergence in national responses to the challenges of the digital revolution(7). Hence, WIPO initiated work on development of new binding norms to account for the advent of digital networks. The process resulted in two new documents, which are sometimes referred to as the “Internet Treaties”: the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT), which were adopted in 1996 and entered into force in March and May 2002 respectively(8).

The WCT, although a separate treaty rather than a modification of the Berne Convention, mostly complements Berne and adapts it to the digital environment, rather than overriding it or creating an independent framework.

(6) Ibid, P. 201-212.
THE LEGAL NATURE OF THE WCT:

The WIPO Copyright Treaty is a special agreement within the meaning of Art. 20 of the Berne Convention\(^9\). It must, therefore, be interpreted as an agreement that grants authors more extensive rights than the Berne Convention or which contains other provisions not contrary to the Convention. According to Art. 1(4) of the WCT, Member States must comply with Articles 1 to 21 and with the Appendix of the Berne Convention, which means that the principles of protection of the Berne Convention (national treatment, absence of registration formalities)\(^{10}\) have to be applied *mutatis mutandis* in respect of the WIPO Copyright Treaty.

(iii) WIPO PERFORMANCES AND PHONOGRAMS TREATY (WPPT):

The WIPO Performances and Phonograms Treaty (WPPT) can be viewed as an “Internetization” of related rights (rights related to sound recordings and performances). It updates the Rome Convention of 1961 and aims at protecting the interests of performing artists (singers, musicians, etc.) and producers of phonograms. The WPPT ensures that these stakeholders have exclusive rights of reproduction, distribution, commercial rental and the on-line “making available” to the public of their performances or recordings\(^{11}\). Furthermore, performers and phonogram producers are granted a right of remuneration for broadcasting and all forms of

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\(^9\) Art. 20 of the Berne Convention contains the following provision: “The Governments of the countries of the Union reserve the right to enter into special agreements among themselves, in so far as such agreements grant to authors more extensive rights than those granted by the convention, or contain other provisions not contrary to this Convention”.


\(^{11}\) Ibid, at 183.
communication to the public of phonograms published for commercial purposes\(^{(12)}\).

**IMPLEMENTATION OF THE INTERNET TREATIES IN THE UNITED STATES: THE DIGITAL MILLENNIUM COPYRIGHT ACT 1998 (DMCA):**

The Digital Millennium Copyright Act (DMCA) was adopted in October 1998 to implement the United States treaty obligations under the WCT and the WPPT and to “move the nation’s copyright law into the digital age”\(^{(13)}\). This legislation introduced substantial amendments to the United States Copyright Act of 1978. The DMCA has two chapters. Title I of the DMCA introduced provisions to prevent anti-circumvention technologies and protect rights management information in order to enable the United States to ratify the WCT and the WPPT. Title II of the DMCA, known as the Online Copyright liability limitation Act, codifying and modifying, the liability of Internet intermediaries for copyright infringement\(^{(14)}\).

However, none of the existing international legislation is by any means a comprehensive response to the copyright challenges associated with the Internet revolution. Much of the process of defining policy solutions is left to national policy makers themselves. This is because of the daily growth in the internet world which makes impossible to be promptly treated in an international scale through the international agreements, and it preferably to delegate this function to the national legislatures each one in its respective

\(^{(12)}\) Ibid, at 185.  
country to enact from time to time Acts and regulations to respond easily and effectively enough to the Internal needs. Another reason is that, since the standards in the Internet related technologies are quite different from country to another; it seems most fair and suitable to let such countries to find their own mechanisms.

However, the above-mentioned treaties present a solid framework for national efforts to address the most urgent issues. U.S and EU implementation measures offer examples of incorporating the international consensus in two considerably different legal frameworks, namely; the Common law teaching represented by the United States and to some extent by United Kingdom, and the Civil law Countries supported by the Members of EU Community.

AUTHORS' ECONOMIC RIGHTS:

Article 2 of the Berne Convention grants the authors of protected works economic rights that allow them to derive financial reward from the use of their work by others. Generally speaking, the copyright holder has a set of different rights that are governed partly by the Berne Convention where there are minimum rights, and partly by national law, which often takes the rights even further. In the following paragraphs, the most two important economic rights, that are, the right of reproduction and the right to communicate the work to the public, will be considered.

(a) THE RIGHT OF REPRODUCTION:

A central right is “to produce or reproduce the work in any material form whatever”. To come under this right, the owner’s work must be copied, this
means copying the form in which the ideas are expressed – not the ideas themselves, which are free to all, for example, the making of copies of a protected work is the act performed by a publisher who wishes to distribute copies of a text-based work to the public, whether in the form of printed copies or digital media such as CD-ROM. Likewise, the right of a phonogram producer to manufacture and distribute compact discs (CDs) containing recorded performances of such works to reproduce their composition in the recording.

(b) THE TELECOMMUNICATION RIGHT:

The public telecommunication right covers transmission by “wire, radio, visual, optical or other electromagnetic system\(^{(15)}\). Telecommunication right or the “right of communication as mentioned in Article 11 bis of the Berne Convention includes, for example, sending works by radio, television, cable, fax, modem, satellite, or microwave, this is why it involves telecommunication. But, to attract liability, the communication must be “to the public”, and such communication should exclude some activities as point-to-point, e-mails and faxes, and transmissions between a network and its affiliate television stations\(^{(16)}\).

\(^{(16)}\) Ibid, P. 581.
REPRODUCTION RIGHT IN THE DIGITAL ENVIRONMENT:

In digital technology, the well-established lines between copying and reading, sale and reuse, performance and viewing become blurry\(^{(18)}\). A good example is the dilemma concerning ephemeral or temporary copies used to view works online. The pertinent question is whether such copies, made as a result of the internal working of a computer, infringe on the authors’ right of reproduction?

The Berne Convention does not define the scope of the right of reproduction. Article 9(1) of the Convention covers all forms of reproduction in any manner or form, and this provision is encompassed in Article 9 of the TRIPs Agreement as well as Article 1(4) of the WCT. As the concept of reproduction under Article 9(1) of the Berne Convention extends to the reproduction in any manner or form, it applies to any reproduction, be it temporary or permanent, visible or invisible, and irrespective as to which process was applied\(^{(19)}\).

This was presumed to extend to digital works\(^{(20)}\). Anyway, Contracting States of the WCT agreed on Article 1(4) of the Treaty which says "The reproduction right as set out in Article 9 of the Berne Convention, and the exceptions permitted there under, are fully applied in the digital environment, in particular to the use of works in digital form", Thus, it is

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\(^{(19)}\) Due to the technological process of computer technology, temporary copies are also made when a temporary copy is received in the memory of a computer for display on the computer.

\(^{(20)}\) Art 9 of the Berne Convention covers all forms of storage including electronic forms.
understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of the Berne Convention. Consequently an act of copying cannot be excluded from the wide conception of reproduction simply on the ground that it is temporary, made in digital form, or constitutes storage in an electronic medium.

However, the application of the ordinary meaning of the term “copying” to the digital formats is uncertain and requires clarification. In particular, it is still unclear whether the mere act of making a temporary copy of a work in the random access memory (“RAM”) of a computer implicates the infringement of copyright owners’ exclusive reproduction rights?

The problem of course, is that making ordinary use of a work in digital format necessarily involves the “automatic” creation of a temporary copy of that work in the RAM. So treating transient RAM copies as falling within the scope of the exclusive reproduction right would mean that ordinary consumers potentially infringe copyright whenever they browse a web page, or open an e-book to read a section of it, or run a computer program or insert a CD to listen to music, or view a DVD movie on a player. In this regard, it is my opinion that, since a copy in a RAM is automatically extinguished when the computer is turned off, and ordinarily is not itself capable of being further reproduced, temporary copying in RAM does not implicate the traditional conception of reproduction right, which is meant to prevent unauthorized duplication.
THE POSITION UNDER THE EUROPEAN LEGISLATION:

Currently the European opinion on the above matter is not yet codified in an Act, but is contained in the proposed Information Society Directive "INFOSOC"(21). The exclusive right of reproduction should be subject to an exception to allow certain acts of temporary reproduction, which are transient or incidental reproductions. Forming an integral and essential part of a technological process carried out for the sole purpose of enabling efficient transmission in a network by third parties. These acts should have no separate economic value of their own. The Proposed Directive, however, leaves it to the Member States to make exceptions. The INFOSOC Directive grants the copyright owner the right to control the temporary reproduction of his copyrighted works in cyberspace but provides for exceptions and limitations.

THE POSITION UNDER THE UNITED STATES LEGISLATION:

A simultaneous fixation (or any fixation) meets the requirements if its embodiment in a copy or phono-record is sufficiently permanent or stable to permit it to be perceived, reproduced or otherwise communicated for a period more than transitory duration(22). For software and multimedia works, reproduction occurs by making a temporary copy and copying it into the random access memory (RAM) of the users’ computer.

From the foregoing, it is clear that it would not be justified to deny the characterization and qualification of an act that involves fixation even if the fixation was for a fraction of a second in the fear of over stretching the

(22) United States Copyright Act. Section 101.
application of right of reproduction. Under United States case law, the ninth circuit Court held that the loading of copyright software into the random access memory of the computer for the purpose of viewing system error and diagnosing problems in the computer was considered copying under copyright(23).

REPRODUCTION UNDER THE WIPO COPYRIGHT TREATY (WCT):

Save for the inclusion of Article 9 in the Treaty, the Treaty is silent on the issue of the temporary or ephemeral copies. This was due to the controversy it created during the 1996 WIPO Diplomatic Conference that eventually adopted the two WIPO treaties(24). During the conference, both the EU and the US representatives supported the inclusion of temporary (or ephemeral) copies within the reproduction right, but this was met with stiff opposition especially from the representatives of the telecommunication companies and Internet service providers(25). Some Delegations were willing to accept the controversial proposed Article 7(1) without alteration but subject to the amendment of Article 7(2), while others were willing to accept it subject to modification. Eventually this controversial section did not secure a place in the final treaty(26). In place of the draft, an agreed statement was adopted by vote confirming the application of Article 9 of the Berne Convention (with its exceptions) in the digital environment.

There is currently no international consensus about the treatment of temporary copying *vis-à-vis* the right of reproduction granted to the copyright owner. This is a fundamental challenge presented to copyright law by the digital agenda, for the refusal to cover such copies would undermine the very basis of copyright, while to give copyright owners more protection online that they have in the analogue world would upset the balance between the users' interest, on the one hand, and the copyright owner's interests on the other\(^{(27)}\).

Anyway, for me it's difficult to see how incidental copying that occurs merely as a consequence of the technical processes of a computer system would damage the owners' interest, and I do not think that protecting transient copies that are automatic and part of technical process would play a significant role in encouraging the creation of new works. Because placing transient RAM copying within the scope of the reproduction right would mark an unwarranted extension of the exclusive exploitation rights of copyright owners and shift the copyright balance too far in their favour.

**TELECOMMUNICATION RIGHT IN THE DIGITAL ENVIRONMENT:**

We are aiming here to give an overview to the right of communication to the public and to the legal developments, which have followed the technological evolution of the new digital era. From the old criterion of “communication in public” before the advent of broadcasting, today “communication in public” has been replaced by a broader and more flexible criterion: “communication to the public”. We will try to analyze such

developments by means of an analysis of the main provisions regulating the right of communication to the public; from the Berne Convention to the recent ED Directive 2001/29.

THE HISTORICAL BACKGROUND: FROM THE RIGHT OF COMMUNICATION IN PUBLIC TO THE RIGHT OF COMMUNICATION TO THE PUBLIC:

The advent and the development of new technologies for the dissemination of works have always been the cause of new legal issues as new needs of legal protection. Also the scope of protection of copyright law has gradually expanded in order to cover the new needs of emerging technology as the law normally follows inventions able to change the uses of the life.

From the point of view of the author’s rights, copyright law expanded gradually from protecting works against unauthorized reproduction by printing to cover also the unauthorized exploitation of works in non-material form\(^{(28)}\). It is known that the first way of communicating works without material reproduction was by their performance or representation\(^{(29)}\). With the expansion of copyright protection to cover musical works, which were more likely to be exploited through performances than reproduction, a new communication in public right was to be recognized and since musical


\(^{(29)}\) Under the Berne Convention, performance means “any acoustic or visual presentation of the work by any means or process”. Public does not necessarily mean the public at large. It means a large number of people who do not qualify as family or closest social acquaintances.
compositions could be performed in many different places simultaneously, an effective means of enforcing the communication in public right came into existence.

**TELECOMMUNICATION RIGHT UNDER THE WCT:**

Following the needs and the new issues of the emerging new technologies, in December 1996 the WIPO Copyright Treaty came into existence to complement and improve the Berne Convention. The most important substantive right established by the WCT is a general right of communication to the public. It is this right that deals with electronic transmission of copyright material.

The public communication right is established by Article 8 of the WCT, which provides that: “Without prejudice to the provisions of Articles 11(1)(ii), ll bis (1)(i) and (ii), ll ter (1)(ii), 14(1)(ii) and 14 bis (1) of the Berne Convention, authors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them”.

The new right of communication to the public extends the right given to authors over electronic transmissions under the Berne Convention in a number of important respects. First, it extends protection to all literary and artistic works, including computer programs. It is therefore broader than Article II of the Berne Convention, which applies only to performances of dramatic, dramatico-musical and musical works. Secondly, it applies to
communications by both wire and wireless means\(^{(30)}\). Thus, unlike Article II bis of the Berne Convention, it is not restricted to the distribution of broadcast material. Thirdly, it provides that communication to the public includes “making available” to the public. As "Weatherrall" has pointed out, the communication rights conferred by the Berne Convention do not mention “making a work available”\(^{(31)}\). Unlike the rights conferred under Berne, Article 8 of the WCT includes more than the active transmission of material to the public. Thus, as "Ficsor" explains, the right of communication to the public:

" … extends not only to the acts that are carried out by the communicators, the transmitters themselves (that is, to the acts as a result of which a work … is actually made available to the public and members of the public do not have to do more than, for example, switch on the equipment necessary for reception), but also to the acts which only consist of making the work … accessible to the public, and in the case of which the members of the public still have to cause the system to make it actually available to them\(^{(32)}\).

Fourthly, the communication right applies to the making available of works. “From a place and at a time individually chosen by members of the public”. This means that “on-demand” and interactive services are clearly encompassed by the new right of communication to the public. Article 8 of the WCT therefore extends protection to interactive point-to-point

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\(^{(32)}\) M. FICSOR, “Copyright For the Digital Era: the WIPO Internet Treaties”. In Columbia Journal of Law and Arts (1997) at 209.
communications, whereas it is arguable that the rights conferred by the Berne Convention apply only to one-way point-to multi point transmissions\(^{(33)}\).

**TELECOMMUNICATION RIGHT UNDER THE EC DIRECTIVE 29/2001:**

On April 9, 2001, the Directive on the harmonization of certain aspects of copyright and related rights in the information society (the “Copyright Directive”) was adopted. The Copyright Directive provides for the harmonization of three fundamental exclusive rights, these being the reproduction right, the communication to the public right, and the distribution right\(^{(34)}\).

The right of communication in the Copyright Directive is provided for by Article 3 and protects transmission and distribution of copyright works other than in the physical form to members of the public who are not present at the place where the communication originates. It covers remote telephone and telegraphic transmission, radio and TV Transmission, cable transmission, communication to the public via satellite, and cable retransmission as well as digital transmission of images, known in the US experience as the so called “public display” of images\(^{(35)}\).

The provision contained in Article 3 of the Directive shows that the exclusive right granted to the copyright owner, originally shaped as a point to multi point way of communication, typical of the radio and television,

\(^{(33)}\) Ibid, P. 230.
\(^{(34)}\) See ss. 2, 3 and 4 of the Directive.
now embraces also the most recent digital transmissions, in which the access is chosen individually by the users and thus it happens in distinct chronological moments\(^{(36)}\).

**NEW DIGITAL ENVIRONMENT AND AUTHORS' ECONOMIC RIGHTS UNDER THE SUDANESE LEGISLATION:**

The starting point in discussing the position of protecting economic rights in the digital age under the Sudanese copyright law is to make it clear the reality that, the present Sudanese Copyright and Neighboring Rights Protection Act 1996 is still far away from having regard to the Internet revolution when we examine its provisions.

However, in Sudan owners' rights of reproduction and publication are both organized in the Copyright and Neighboring Rights Protection Act 1996 in section 8(2)(a), by granting the owner of the copyright works the right to publish and reproduce his work by any means, known or to be developed. Two interesting notes could be pointed out here: firstly and positively, the desire of the Sudanese legislature to keep its law updated to meet the technological impact on the copyright law, and secondly but negatively, the absence of any statutory reaction to make such desire true.

Regarding the first positive note, the phrase (known or to be developed) makes it clear that the law-makers of the 1996 Act were bearing in mind that new means of the reproduction and publication of works of authorship will be available at the nearest future, so the Act leaves the door so open to cover any modern means to reproduce copyrighted works such as by saving copies

\(^{(36)}\) Ibid, P. 1093.
of a protected works in the personal computer's hard disk, and to publish such works not only through wire means, but also publishing could be made even electronically through wireless means.

Regarding the second negative note, there is a statutory problem in defining the meaning of both, the reproduction and publication rights, since the Copyright and Neighboring Rights Protection Act 1996 does not contain any definition to the term "reproduction" and there is a very strange definition for the term "publication".

Generally speaking, the term reproduction used in context of copyright law means the act of copying or recording the work in any material form including the acts of storing the work in any medium by any means. Unfortunately, there is no such a definition for the term reproduction in the 1996 Act, and in the absence of such statutory definition a lot of practical problems arise, simply, question like whether or not, the act of making a temporary copy of a work in the random access memory "RAM" of a computer implices the copyright owner's exclusive reproduction as granted by the current Act in section 8 (2) (a) right is unfortunately still waiting to be answered.

The term "Publication" is defined in the Copyright and Neighboring Rights Protection Act 1996 in section 3 so as to mean "the lawful reproduction of a work or of an audiovisual or sound recording in any material form and distribution of copies thereof to the general public by sale or otherwise". The term publication has significant importance in the Copyright and Neighboring Rights Protection Act 1996, for example, whether or not a work
is protected by the Act is in certain cases depend on where the work was first published?, in this point section 4(1) (a) of the 1996 Act grants protection to works of Sudanese authors or of aliens which are published or otherwise made available to the public for first time in the Sudan.

What I can say about the definition of the term publication is that, the status of any copyrighted work published via the Internet is very problematic under the present Copyright and Neighboring Rights Protection Act 1996, this is due to the fact that the term publication as defined in the 1996 Act apparently excludes communication to the public by telecommunication as a modern mode of publishing works of authorship.

The practical problem is that, the definition of the term publication in the 1996 Act requires the act of distributing copies of reproduced work among the public, the process which requires only material form of such works to be distributed, and accordingly works that are reproduced in any digital form or in an electronic form will not be qualified for the copyright protection under the Act merely for the fact that it is not in a material form!! But at the same time, if the work has been published to the public through wire or other material carrier like optical fiber or coaxial cable as appeared from the definition of the term "communication to the public" in section 3 of the Act, then this kind of publication can easily enjoy copyright protection in Sudan.

Again, and strangely enough, the Copyright and Neighboring Rights Protection Act 1996 mentioned the possibility of acquiring a full copyright protection in the Sudan according to section 4 (1) (a), (b) by granting in (a) the possibility of obtaining the copyright protection in Sudan for the
Sudanese and aliens if they made available the works for the first time in the Sudan. The same provision is stated in (b) but at this time for works of Sudanese nationals, which are made available to the public in the foreign country.

The Act does not define what is meant by the term "making available" but in general, the notion of making available of works simply means that, for the works to acquire copyright protection, the author should upload his work in the Internet so that the public can access this work from any place and at any time individually chosen by them. And this is the same idea with the electronic publication, which the 1996 Act completely omits as a basic for the copyright protection in Sudan.

TECHNICAL MEASURES OF PROTECTION:

The introduction of new type of technological measures is essential for the safe dissemination of copyright works, for the development of new services and in fighting against piracy. Indeed, the issue of the technical protection systems for copyrighted works published via the Internet was controversial at the Diplomatic Conference.

The WCT states that: Contracting Parties shall provide adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights under this Treaty or the Berne Convention and
restrict acts in respect of their works, which are not authorized by the authors concerned or permitted by law\(^{(37)}\).

TECHNOLOGICAL MEASURES OF PROTECTION IN EUROPE:

The EU implementation of the WCT in regard to the protection of technological measures had to take into account the fact that the EC Directive on Software already supplied a degree of Protection. Nevertheless, a new Directive was considered necessary to implement properly the WIPO Treaty on Copyright\(^{(38)}\).

However, article 6 of the Copyright Directive seeks to implement the technological measures provisions of the WCT. This article, in its first version, states that member states had to provide adequate protection to prevent the act of circumvention of technological measures by forbidding any activities including the manufacture or distribution of any device or the performance of services, which have only limited commercial significant purpose or use other than circumvention, and which the person concerned carries out in the knowledge or with reasonable grounds to know, that they will enable or facilitate without authority the circumvention of any effective technological measures designed to protect any copyright or any related rights\(^{(39)}\).

Then, the parliament voted large amendments to enforce a stronger protection of technological measures. Now article 6 clarifies which devices

\(^{(37)}\) WCT, Art. 11.
\(^{(39)}\) Ibid. at 290.
and which services are covered by the provision: those are the ones which are promoted, marketed, advertised for the purpose of circumvention of technological measures designed to protect copyright, have only limited commercial purpose or use other than to circumvent technological measures; are primarily designed, produced, adapted or performed for the purpose of enabling or facilitating circumvention of technological measures\(^{(40)}\).

**TECHNOLOGICAL MEASURES OF PROTECTION IN U.S.A:**

In the United States, the DMCA prohibits the manufacture, sale or importation of technologies that can be used to circumvent technological protection for copyrighted works, popularly known as “rights management systems”\(^{(41)}\). A technology will fall within the prohibition if it is marketed knowingly for use in circumvention. In the absence of such knowledge a technology may still fall within protection, but only if it is either “primarily designed or produced for the purpose of circumvention” or has “only limited commercially significant purpose other than to circumvent” rights management technologies\(^{(42)}\).

The concept of the rights management technology is that the application of information technologies to facilitate the exploitation of rights which is commonly referred to as “digital rights management” (DRM). DRM systems are aimed at enforcing certain usage rules in respect of the use of content protected by copyright. Typically, these usage rules concern questions such as who is entitled to access a work, at what price and on which terms. These

\(^{(40)}\) Ibid. at 290.
\(^{(41)}\) DMCA, Title I, S. 3, at 81201(a) (2), (b) (1).
terms address questions such as whether a user is entitled to make any copies of the work (and, if so, how many), for how long a user is entitled to access a work; whether a user can excerpt the work or make changes to it; whether a user can access the work on one or on multiple devices, etc. In effect, DRM systems aim to automate the process of licensing works and to ensure that license terms are complied with\textsuperscript{(43)}.

**CONCLUSION:**

What should have became clear from this chapter is that the digital age and particularly, the Internet presents copyright with a number of very serious challenges, to which, up to now, only a partial answer has been given, mainly on the basis of the WIPO Internet Treaties. Digitization presents all kinds of works in a single digital format. As such, this does not change the copyrightable nature of the works, and then comes the question of upon whom the responsibility of infringing such works laid? Does it lie on the individual infringer? Or it lies on the Internet intermediaries? And what is the importance of the technical devices for online copyright protection; since they are increasingly play an important role in the area of rights management?

\textsuperscript{(43)} For more information about the Function of the DRM systems, see http://www.ssh.fi/tech/crypt/. (Last visited January 2008).
CHAPTER TWO
LIABILITY OF INTERMEDIARIES FOR ONLINE COPYRIGHT INFRINGEMENT

INTRODUCTION:

Almost ten years have passed since the USA adopted legislation to limit liabilities of intermediaries for end users’ copyright infringement. The EU followed just a few years later. The legislation was passed as a result of lobbying actions of powerful right holders' groups that wanted to impose the liability for infringing acts of users to their intermediaries, since they are easier to identify and prosecute, and have more financial resources than their users.

In Sudan and although, internet service providers' companies like "ZAIN" which provides the Internet service to the mobile sector, and "SUDATEL" which provides also this service to the fixed phone sector, play an integral role in the communication industry in the country, the Sudanese legislature did not take into account the need for statutory provisions to regulate this role.

This chapter deals with issues of online intermediaries’ liability both in private law (civil law) and in the criminal law with particular attention to the liability of so called" Information Location Tool Providers" as the most important kind of intermediaries. Because and due to uncleanness of the relevant provisions and lack of proper regulation of certain procedures (especially in the EU), the intermediaries are being misused as the right holders’ want to control the Internet even in cases where their rights have
not been infringed. Consequently, intermediaries are forced to remove the disputed content from Internet without proper consideration of its unlawfulness, which endangers freedom of expression.

**DEFINITION OF THE INTERMEDIARIES:**

An intermediary is every individual or entity positioned between the right holder and the end user of a copyright content when such content is communicated from the right holder to the end user through the Internet\(^{(1)}\). The intermediaries subject to liability rules are the ones that actually play a role, provide certain services for the dissemination of content, but do not initiate or take part in making decisions regarding the communicating of information\(^{(2)}\). However, the most important category of intermediaries is the Internet service provider.

Can an intermediary be held directly or indirectly liable for his contribution to copyright infringements? And if so, under what circumstances? As will be shown below, the answer to this question depends upon whether the defendant has performed a restricted act for the purpose of copyright law. Before examining this question, the rules governing liability for direct and indirect infringement will be discussed.

**DIRECT INFRINGEMENT:**

Under the general provisions on tort in civil law countries, a direct infringement of copyright, i.e. the unauthorized performance of a restricted act, is considered an interference with a person’s subjective right, and

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\(^{(2)}\) Terms “Content” and “Information” Are used as Synonyms.
therefore, constitutes an unlawful act in itself\(^{(3)}\). The general rules on liability, however, require that some form of fault to be shown for liability to arise. For this purpose, courts generally find that direct copyright infringers are subject to a rather stringent duty of care, even to such an extent that they are almost strictly liable\(^{(4)}\). In Germany for instance, a printer cannot escape liability by relying on statements of his clients, but must investigate for himself whether the printing of a certain publication constitutes a copyright infringement. Similarly, in the Netherlands a publisher has a duty to investigate whether the publication of material supplied by a third party infringe any copyrights\(^{(5)}\).

In the US, copyright infringement constitutes a specific tort following its own statutory rules. Under the US Copyright Act a direct infringer is strictly liable\(^{(6)}\). However, even though lack of fault cannot exonerate a direct infringer, if he is successful in proving that he was not aware, nor had a reason to believe, that his acts have constituted infringement, a court may mitigate the statutory (or punitive) damages. But even then, the defendant will be fully liable for actual damages\(^{(7)}\).

Interestingly, the UK Copyright Act distinguishes between so-called primary and secondary infringers. With regard to primary infringers, a with-fault liability with a reversal of the burden of proof exists. In principle,

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\(^{(4)}\) Ibid, at 217.
\(^{(6)}\) S. 501 of the US Copyright Act.
\(^{(7)}\) S.504 of the US Copyright Act.
primary infringers are strictly liable, but they may escape liability if it is shown that at the time of the infringemen they did not know, or had reason to believe that copyright subsisted in the item\(^{(8)}\). Secondary infringers, such as mere distributors and organizers of performances, are considered copyright infringers only if they knew or had reason to believe that they contributed to an infringement. Thus, some form of fault appears to be included in the notion of (secondary) infringement\(^{(9)}\).

Despite the conceptual difference in approach between the civil law jurisdiction and the UK, it appears that the outcome of a dispute will not differ substantially. Under Civil Law, a distributor may be considered an “infringer” for the purpose of copyright law (i.e. violate a copyright), but may at the same time avoid liability through the separate requirement of fault, whereas in UK a distributor who does not have a reason to know that he contributed to the distribution of an infringing article is not an “infringer” in the first place, and therefore, not directly liable. Moreover, due to the extensive duty of care imposed on printers and publishers under civil law jurisdiction, the publishers’ and printers' positions are very much the same as they are in common law jurisdiction\(^{(10)}\).

**INDIRECT INFRINGEMENT:**

Under the general doctrine of tort in the civil law countries like Netherlands and Germany, the distinction between direct and indirect infringement of rights is generally accepted. Indirect infringers are persons

\(^{(8)}\) Arts. 16-21 of the CDPA deal with primary infringements and Arts. 22-26 deal with secondary infringements. Arts. 96 and 97 of the CDPA are on liability in general.


\(^{(10)}\) Ibid, at 71.
who do not themselves violate a right, but whose actions or omissions contribute to such a violation\textsuperscript{(11)}. They may have acted unlawfully because of a breach of a duty of care. Thus, whereas with regard to direct infringers the duty may be relevant in establishing fault, with regard to indirect infringers' negligence may result in the act or omission becoming unlawful.

The indirect infringers’ position is not expressly regulated in the US Copyright Act\textsuperscript{(12)}. In 1984, however, in its *Betamax* decision the US Supreme Court affirmed that the concept of contributory liability, which was developed in other areas of the law, applies under copyright law\textsuperscript{(13)}. Contributory liability consists of personal conduct that forms part of the infringement, or of the contribution of machinery or goods that provide the means to infringe. To establish contributory liability, proof of fault, i.e., actual knowledge or a reason to believe of the infringing nature of the activity of the primary actor, is required\textsuperscript{(14)}. Thus, whereas a direct infringer is held strictly liable, the liability rules are less stringent with regard to the indirect infringer.

**RESTRICTED ACTS:**

The position of the defendant differs depending on whether he is considered an indirect or a direct infringer, or in other words, whether he did or did not perform a restricted act under copyright law. Is an online intermediary a direct infringer? Much ink has been spilled over this

\textsuperscript{11} Supra note (3) at 220.
\textsuperscript{12} Supra note (5) at 111.
\textsuperscript{13} *Sony Corp. V. Universal Studios, Inc.*, 16\textsuperscript{th} U.S.C.A (Federal Circuit 1984). The Court stated that the “absence of such express language in the copyright statute does not preclude the imposition of liability for copyright infringement on certain parties who have not themselves engaged in the infringing activity.
\textsuperscript{14} Supra note (5) at 201.
controversial issue. In the following, we will briefly examine how courts and legislatures have dealt with this question, and to what extent it has been settled by international regulations.

CASE LAW:

Pursuant to Article 111(a) of the US Copyright Act, which was drafted in order to deal with cable retransmission, any “passive carrier” who has no direct or indirect control over the content or selection of the primary transmission, and whose activities with respect to secondary transmission consist solely of providing wires, cables or other communication channels, is exempted from liability, but only with respect to the restricted acts of performing and publicly displaying a work(15).

Under the UK law, a person transmitting a television program will only be considered as performing the primary infringing act of “broadcasting” (Article 20 CDPA), “if he has responsibility to any extent for its contents” (Article 6(3) (a) CDPA)(16).

Thus, under both regimes a “retransmitter” that has no control over the contents cannot be held liable for direct copyright infringement. However, even though Internet intermediaries may have an equally passive role, a US district court has ruled that online access providers cannot invoke the “passive carrier” exemption(17).


Does this mean that online intermediaries should be regarded as direct infringers? Particularly in the US, this question has been addressed in several decisions. At first, the courts approached the issue in a rather rigid fashion. In 1993, in *playboy Enterprises v. Frena* a district court found a Bulletin Board Service (BBS) operator to be liable, even though the operator had not uploaded the work and was unaware of the infringement taking place. The court found that the operator had “directly” infringed copyrights and simply stated “intent or knowledge is not an element of (direct copyright) infringement”\(^{(18)}\).

In the landmark *Netcom* decision of 1995, a US district court for the first time mitigated the strictness of the liability of online intermediaries. The court found that temporary copies made while transmitting a work over the Internet constitute reproductions for the purpose of copyright law and acknowledge that fault is not required under the US Copyright Act\(^{(19)}\). However, mainly on grounds of public policy and sheer reasonableness, the court required an additional element of “volition or causation” to hold the provider liable for direct infringement.

The reasoning in the *Netcom* case was followed in several other decisions where it was found that a BBS Operator cannot be direct infringer if he does not initiate the infringement nor create or control the content of its service, he cannot be considered to have caused the infringement and, therefore, is not a direct infringer. Apparently, the notion of foreseeability, that plays a role in establishing legal cause, is introduced as an element of

\(^{(19)}\) See Netcom case, Supra note (17).
direct infringement to limit the US Copyright Act’s strict liability rule. The
courts in these decisions added that an intermediary might still be held
indirectly liable under the doctrine of contributory infringement; in which
case fault on the part of the provider must be proved (i.e. the plaintiff must
show that the provider knew or should have known of the direct infringer’s
conduct). Other courts, however, have held online intermediaries directly
liable, even when the defendant acted as passively as *Netcom*\(^{(20)}\).

**LEGISLATION IN THE EU:**

**HORIZONTAL APPROACH OF THE E-COMMERCE DIRECTIVE:**

Intermediaries’ liability for online copyright infringement is dealt with in
two European directives, namely the E-Commerce Directive\(^{(21)}\) and the EU
Copyright Directive (EUCD)\(^{(22)}\). The following paragraphs present the
relevant provisions of both directives and the relationship between them.

The E-Commerce Directive was adopted in June 2000 and entered
into force in July 2000. The Directive has been implemented by all member
states, the last one being Portugal in July 2004. The EU legislator has
chosen to apply limitations to the intermediaries’ liability horizontally\(^{(23)}\).
This means that the E-Commerce Directive addresses the intermediaries’
liability for online communication of all kinds of unlawful material (also
defamatory, pornographic material, and content protected with any
intellectual property rights)\(^{(24)}\), and that applies regardless of the type of

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\(^{(21)}\) Directive 2000/29/EC.

\(^{(22)}\) Directive 2001/32/EC.


\(^{(24)}\) Ibid, at 66.
individual rights that might be infringed\(^{(25)}\). In this issue, the E-Commerce Directive differs from the vertical approach taken by the US legislation where copyright issues are dealt with separately in the DMCA from violations of other laws.

**LIABILITY ONLY FOR INJUNCTION:**

The E-Commerce Directive and also the DMCA excludes liability in cases where intermediary fulfils the conditions for the liability limitations. The relevant authority can, nevertheless, order prohibitory injunction (e.g. to remove the disputed content, to desist from wrongful conduct, etc.)\(^{(26)}\). However, when and if an intermediary acquires the knowledge of the infringement, it can be found liable for damages, as the conditions for limitation of its liability are not fulfilled. In this point, the Directive and the DMCA follow general provisions on liability in the TRIPS\(^{(27)}\).

Judicial authorities can, according to Art. 44(1) of the TRIPS, issue injunctions, and, according to Art. 45(1) of the TRIPS, order the infringer to compensate for the injury of right holder by paying adequate damages, when the infringer “knowingly or with reasonable grounds to know engaged in infringing activity”\(^{(28)}\).

Anyway, article 12 of the Directive provides that when an intermediary is merely providing the infrastructure (the network provider) or access to the Internet (the access provider) it is not liable for the transmission of the

\(^{(25)}\) Ibid, at 71.
\(^{(26)}\) Recital 45 of the E-Commerce Directive.
\(^{(27)}\) Agreement on Trade Related Aspects of Intellectual Property Rights.
\(^{(28)}\) Supra note (23), at 55.
content\(^{(29)}\). In order to fall under this limitation, the intermediary must not play an active role in the content transmission with regard to the origin (does not initiate the transmission), the destination (does not select the recipients of the content), or the content (does not make selections of the content)\(^{(30)}\).

Again, and according to Art. 13 of the E-Commerce Directive, when intermediaries provide services of content transmission, they are exempted from liability for automatic, intermediate and temporary storage of content that is performed with the sole purpose of making the content transmission more efficient\(^{(31)}\). The limitation can only apply if the intermediary refrains from influencing the transmitted content and from interfering with the technical systems for obtaining information on the use of the content\(^{(32)}\). In addition, it has to comply with rules and standards widely accepted by the industry, on access to content and its updating\(^{(33)}\). The intermediary must also expeditiously remove the content or bar access to it upon obtaining actual knowledge that the content at the initial source (the source page) has been removed from the network, that the access to that content has been barred, or that a competent authority has ordered removal or barring of that content\(^{(34)}\).

\(^{(29)}\) Ibid at 70.


\(^{(31)}\) Indeed, this definition refers to proxy web caching; a cache is space on a computer, where data can be stored so it can be later retrieved faster than from a slower device (e.g. hard disk).

\(^{(32)}\) This is the notion of the so-called: Digital Rights Management (DRM) Systems.

\(^{(33)}\) Supra note 23 at 81.

\(^{(34)}\) Ibid at 85.
THE EUROPEAN COPYRIGHT DIRECTIVE (EUCD):

The EUCD deals with the intermediaries’ liability in article 5 (1), providing a mandatory exception to the right of reproduction, according to which temporary, transient and incidental acts of reproduction, which are integral and essential parts of the technological process, whose sole purpose is to enable transmission by an intermediary, and which have no independent economic significance, are not an infringement. Furthermore, according to recital 33 of the EUCD, this exception includes acts, which enable browsing, acts of caching and acts, which enable transmission systems to work more efficiently. Nevertheless, Art. 5(5) and recital 33 of the EUCD provide certain conditions for this exception to apply\(^{(35)}\).

There seems to be a lack of clarity regarding the “independent economic significance” required, so it is left to the national legislations to interpret it. As a consequence definition of liability of intermediaries varies in different EU Member States\(^{(36)}\).

RELATIONSHIP BETWEEN THE E-COMMERCE DIRECTIVE AND THE EUCD:

The horizontal effect of the E-Commerce Directive is complemented with the vertical effect of the EUCD, which deals with intermediaries’ liability only in cases of copyright infringement (and not violations of law in general – e.g. defamation). As the E-Commerce Directive provides a harmonized framework of principles and provisions relevant, inter alia, to

\(^{(35)}\) According to Art. 5(5) of the EUCD this exception only applies in certain special cases which do not conflict with a normal exploitation of the work or other subject-matter and do not unreasonably prejudice the legitimate interests of the right holder.

\(^{(36)}\) Supra note 23 at 92.
important parts of the EUCD\(^{(37)}\), and certain important liability limitations\(^{(38)}\).

E-COMMERCE DIRECTIVE AND THE DMCA:

Even though the E-Commerce Directive is closely based on the DMCA\(^{(39)}\) there are certain significant differences between the two regulations. Contrary to the Directive, the DMCA takes up the vertical approach, provides for a non-profit educational institutions liability standard, and describes in detail the procedure for an intermediary to obtain knowledge on illegality of its activities (notice-and-take down procedure). In addition, although provisions of both regulations are very similar when dealing with mere conduit, and caching, the DMCA unlike the Directive regulates also liability for what it describes as information location tools activity.

The Directive provides that every two years since the entering into force, the commission will submit a report on the application of the Directive with proposals for adaptation “to legal, technical and economic developments in the field of information society services”, and that the report will “in particular analyze the need for proposals concerning the liability of providers of hyperlinks and location tool services, “notice and take down” procedures and the attribution of liability following the taking down of content”\(^{(40)}\).

\(^{(37)}\) Recital 16 of the EUCD.
\(^{(38)}\) Supra note 23, at 99.
\(^{(40)}\) Art. 21 of the E-Commerce Directive.
NON-PROFIT EDUCATIONAL INSTITUTIONS LIABILITY:

The DMCA and the Directive both apply the activities approach when determining intermediaries’ liability limitations. However, the DMCA grants a different kind of liability limitations for a specific category of intermediaries – non-profit educational institutions. When such an institution is acting as an intermediary, it is not liable for actions of its faculty members or employees who are performing teaching or research functions, if it fulfils certain conditions\(^{(41)}\).

The Directive, on the other hand, does not provide for any specific liability limitations in such cases. This means that educational institutions providing intermediary services are exposed to liability for infringing conducts of third parties having access to their facilities. It seems that a provision, similar to that one in the DMCA, should be added as it would “justly protect those intermediaries”\(^{(42)}\).

INFORMATION LOCATION TOOL SERVICES PROVIDERS LIABILITY (ILTS):

Information location Tool Services (ILTS) Providers perform two main activities for providing help to users in finding information on the Internet, which are: search tools services (identifying and indexing new web sites) and linking services (displaying lists of links\(^{(43)}\) to web sites, where the information requested by the user is located)\(^{(44)}\).

\(^{(41)}\) Section 512(e) of the DMCA.
\(^{(42)}\) Supra note 38 at 112.
\(^{(43)}\) “A link is an electronic address written into a web page that points to another location”, H.A. DEVECİ, “\textit{Hyper links Oscillating at Crossroads}”, in C.T.L.R., 2004, at 83.
\(^{(44)}\) Ibid, at 85.
Computer programs generally perform both activities. In the first case special programs(45) are constantly checking the Internet for new web sites and creative thereof. In the second case a different kind of programs, namely the search engines, display list of links to content, requested by user(46).

LEGAL ISSUES:

Linking or hyper-linking, can raise several legal issues, with respect to copyright infringement liability for linking, per se, linking to infringing content, and for using certain techniques of linking.

Linking, per se, when providing simple (not deep) links to non-infringing and publicly accessible content, even without a license of the linked-content provider, should not be considered an infringement of copyright(47). The justification of this is two-fold: - Firstly, providing links to certain content does not mean reproduction of this content, nor does it mean communication of the content to the public by providing a simple link, the content “itself is not displayed or communicated; the user is simply told where the content itself can be found and only in that particular web site is there a communication(48).

Secondly, by putting the content online, the content provider is already communicating it to the public, and implicitly giving permission for the

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(45) “Crawlers” or “robots”.
(46) Supra note (23), at 101.
content to be accessed by them\(^\text{(49)}\). Therefore, mere provision of simple links is not infringing the content.

In the case of linking to an infringing content, the legal implications might be that, the intermediary is somehow inciting users to access the linked infringing content and enabling the infringement. ILTS include identification of web sites with certain content; nevertheless, it would be virtually impossible for intermediaries to determine whether these web sites include infringing content\(^\text{(50)}\).

First of all, they are not qualified to ascertain whether certain content is infringing or not, and secondly, it is also technically impossible (or at least not feasible) to analyze millions of web sites, as it would not be possible to do it automatically by, e.g., filtering software technologies. In addition, the content provider may change the content of his web site and include infringing content, which was not included when the ILTS provider identified the web site\(^\text{(51)}\).

On the other hand, deep linking\(^\text{(52)}\) is more controversial, as it by-passes the homepage of the content provider, it also by-passes the purpose and the intended use of the website by the content provider\(^\text{(53)}\). It may skip a homepage, e.g. giving information about the author of the work, and therefore,

\(^{49}\) Ibid. at 1490.

\(^{50}\) C. WAELEDE, L. EDWARDS, “Online Intermediaries and Liability for Copyright Infringement”, seminar on Copyright and Internet Intermediaries at WIPO, 2005, P. 15.

\(^{51}\) Supra note (23) at 103.

\(^{52}\) The deep link bypasses the homepage and access page deeper within the homepage of the (target) linked site.

\(^{53}\) Supra, note (43) at 90.
infringing authors right of paternity, or skip an advertisement, thus causing loss of advertising revenue\(^{(54)}\).

\textbf{POSITION OF THE INFORMATION LOCATION TOOL PROVIDERS' LIABILITY UNDER THE DMCA:}

Section 512(d) of the DMCA provides a liability limitation of ILTS provider for linking to infringing content. An ILTS provider is not liable for damages for linking to infringing content, if it does not have the actual or constructive knowledge that the content is infringing, or upon obtaining such knowledge acts expeditiously to remove or disable access to the content, if it does not receive a direct financial benefit from the infringing activity, in the case it has the liability and the right to control such activity; and if no proper notification of infringement responds expeditiously to remove or disable access to the content.

The question of the interpretation of actual or constructive knowledge arises, as it is very important not to place an unreasonable burden of duty to monitor on the ILTS providers\(^{(55)}\). Oddly enough, the DMCA provisions do not regulate intermediaries’ liability for deep linking.

\textbf{POSITION OF THE INFORMATION LOCATION TOOL PROVIDER UNDER THE E-COMMERCE DIRECTIVE AND LEGISLATION IN EU MEMBER STATES:}

The E-Commerce Directive does not include any limitations for ILTS providers’ liability. It is, therefore, left to individual member states to provide for such limitations. The Commission 2003 report recognizes that

\(^{(54)}\) Ibid, at 92.

some Member States, “motivated by the wish to create incentives for investment and innovation and enhance the development of E-Commerce by providing additional legal clarity for service providers”, decided to provide for liability limitations for ILTS providers and that case-law in Member States in general “appears to be in line with the Internal Market objective to ensure the provision of basic intermediary services”, promoting the development of the Internet and e-commerce \(^{56}\).

A closer look at the EU Member States' national legislations and case law, however, shows a different result. Decisions on determining the limitations for ILTS providers’ liability vary from Member State to Member State and even from court to court within the same Member State \(^{57}\).

**NOTICE AND TAKE DOWN PROCEDURE:**

The DMCA provides for a detailed description of procedure, in accordance with which the intermediary is deemed to have obtained actual knowledge on the illegality of its activities. The right owner has to send a formal notice to the intermediary. When the intermediary receives the notification it has to expeditiously remove the disputed content and notify the subscriber about it. If it receives “counter-notification” from the


\(^{57}\) A French court ruled that a provider of a search machine for online newspaper articles providing deep links leading directly to full versions of articles, and skipping the newspapers’ homepage, does not infringe copyright, C, WAELDA, H. MACQUEEN, “From Entertainment to Education: The Scope of Copyright”, in I.P.Q, 2004, P. 283. A Dutch Court ruled in a similar case that deep linking violates the Databases right, while in another similar case in Holland deep linking was not considered as a copyright infringement, J. STRACHAN, “The Internet of Tomorrow: The New-Old Communication Tool of Control”, in: E.I.P.R., 2004, P. 131.
subscriber, claiming that the removal was not justified, it has to notify the right owner.

In the case the right owner does not respond within ten days, the intermediary can put the content back on. However, if the right owner files an action against the infringing activity, the intermediary should not put the content back on; otherwise it might be found liable for damages\(^{(58)}\). Furthermore, the DMCA establishes that the intermediary is not liable for the removal or disabling access to the content if the infringement claim turns out to be false\(^{(59)}\). Finally, the DMCA provides that whoever knowingly misrepresents that, certain content is non-infringing is liable for damages, which result from intermediary’s action upon such misrepresentation\(^{(60)}\).

The US regulated this procedure, with an aim to ensure that, access to content would not be blocked without proper justification. On the other hand, the Directive does not provide for such or any similar procedure. Instead, the European Commission expressed in Arts. 14(3), and 16 and in recital 40 of the Directive, the expectation for these procedures to evolve in the form of self regulation\(^{(61)}\). As the Directive does not provide for guidelines on the designation of these procedures, they will likely differ from Member State to Member State.

\(^{(58)}\) Section 512(c) of the DMCA.
\(^{(59)}\) Section 512(9) of the DMCA.
\(^{(60)}\) Section 512(f) of the DMCA.
\(^{(61)}\) See, supra note (56).
DUTY TO MONITOR AND FREEDOM OF EXPRESSION:

Art. 15 of the Directive provides that Member States shall not impose a general obligation on the intermediaries to monitor the transferred or stored content or to “actively seek facts or circumstances indicating illegal activity”, when they provide their services in conformity with the Directive. Nevertheless, according to paragraph 2 of the same article, Member States may oblige intermediaries to promptly inform the competent authorities of illegal activities and information provided by their subscribers, and to provide information on identification of their subscribers. It is unclear how the intermediaries can deal in accordance with Art. 15(2) as there is no guidance as to what constitutes an obtainment of knowledge of an illegal activity.

Moreover, recital 28 of the Directive establishes that Member States can require hosting services providers to “apply duty of care, which can reasonably be expected from them”. There is, again, no guidance provided as to explain in further detail, what kind of duty of care could be “reasonably expected” from the intermediaries. Therefore, it is up to the Member State to determine this term.

Taking into account the uncleanness of provisions of recital 48 of the Directive, the uncertainty of terminology regarding actual or constructive knowledge\(^{(62)}\) and when such knowledge is obtained, it can be concluded that duty to monitor for intermediaries exists. However, imposition of such a standard of care is simply not reasonable. First of all, intermediaries receive multiple complaints about infringing content found or communicated

\(^{(62)}\) Especially Articles 13 and 14 of the E-Commerce Directive.
through their systems,\(^{(63)}\) the fact which creates a lot of problems to the intermediaries in deciding whether to remove the content and not be sued, or to respect the content owners’ (their customers) interests and keep the content available\(^{(64)}\).

It is completely understandable that intermediaries decide very quickly to take down the content and avoid the risk of a law-suit, not taking into account the rights of their subscribers and not taking into account the role of freedom of expression. Secondly, intermediaries are not equipped with any knowledge or skills to evaluate whether certain content could be infringing or not\(^{(65)}\).

Moreover, it is technically impossible to search for copyright infringing content automatically, as it cannot be recognized by, e.g., key words. To do it manually is simply unmanageable due to the quantities of content on the Internet. As the Internet content is not static, this kind of search would have to be done on a daily basis. If intermediaries were imposed with such a burden, it would be too costly, inefficient and consequently not interesting for them to provide intermediary services.


POSSIBLE SOLUTIONS:

Several solutions have been proposed in resolving the abovementioned issues regarding intermediaries’ liability. Shortly after the adoption of the EU legal framework for intermediaries’ liability limitations, there were proposals for establishing an independent body to decide whether certain content is infringing and should be taken down\(^{(66)}\).

Civil rights activists and providers have argued that only a court order should constitute an actual knowledge of infringing material. But in our view, it would in practice only led to a very limited number of cases. Other writers suggest that, the solution may be in codes of conduct developed by relevant industry bodies accredited by the relevant independent regulatory authority\(^{(67)}\).

In my opinion, the best solution would be a combination of the abovementioned proposals. An independent body of copyright experts (the Expert body) should be created, which could be contacted by an intermediary, in cases of receipt a notice of potential copyright infringing activities. In such case, the Expert body would have a limited time to make a binding decision. If it would decide that the content is infringing, the content would then have to be taken down and vice versa. It would be possible to appeal to this decision before the court of law. In addition, short obligatory

\(^{(66)}\) In 2003 the EU Parliament set up a committee with representatives from all the EU States involved in these issues and started working on setting up a central body for complains about illegal content. Such entity should be able to make a difference between simple complaints that can be handled by the intermediaries, and the more complex complaints that should be notified to the content providers and, upon receipt of a serious reply, should be decided before the court, Ibid at (65).

educational courses on legal basics for the intermediaries should be organized.

The intermediaries should also provide clear policies on how right holders should notify them about possible infringements and also provide forms for such notification. Adoption of at least some of these proposals, even though they are not optimal, would at least give some more clarity upon obtaining knowledge and, therefore, less danger for freedom of expression.

LIABILITY OF THE INTERMEDIARIES UNDER CRIMINAL LAW:

In most jurisdictions, copyright law provides for criminal sanctions. Although remedies under Private Law prevail in practice, prosecution under criminal law will occur in cases of piracy or other forms blatant copyright infringement. The special position of intermediaries whether online or “offline”, in disseminating third party content has been recognized in many national laws, many of which relate to criminal law and do not (directly) deal with copyright. Even so, some of these laws have inspired national and international legislators in dealing with the issue of online liability for copyright infringement. In the following section, a small selection of online liability laws will be briefly reviewed.

(i) UNITED STATES:

The Communications Decency Act of 1996 (CDA)(68) introduced a number of rules that chiefly deal with criminal liability of online providers. Section 223(e) of title 47 of the US.CDA determines that an access provider is not responsible for “obscene, Lewd, Lascivious, Filthy or indecent

material” if it solely provided access to public computer network. This exemption does not, however, apply unconditionally, as section 223(e)(2) determines that the exclusion of liability does not apply to a party which is “a conspirator with an entity actively involved in the creation or knowing distribution of communications that violate this section, or who knowingly advertises the availability of such communications”.

Section 223(e) (3) adds that this rule does not apply to a party who “provides access or connection to a facility, system or network engaged in the violation of this section that is owned or controlled by such a persons”. Section 231, drawn up as part of the Child online Protection Act(69), excludes network providers and access providers from criminal liability for deliberately providing “dangerous material” to minors, as part of conducting professional activities, on condition that they have subjected access by minors to those sites to measures intended to check and prevent such access.

(ii) UNITED KINGDOM:

The United Kingdom was the First European Country to deal specifically with online intermediary liability by statute. In the UK Defamation Act of 1996(70), which codified the “innocent dissemination” defense for distributors of hard copies, service and access providers are also specifically mentioned like any “ordinary” distributor, an online intermediary may escape liability for third party material, if he sustains the burden of proving that he took reasonable care in relation to the publication of a defamatory

statement\(^{(71)}\). In determining what would constitute reasonable care or whether an intermediary should have knowledge of his contribution, courts must expressly take into account the extent of editorial control and the nature and circumstances of the publication and the prior conduct of the author\(^{(72)}\).

**CONCLUSION:**

The EU legislator expresses expectation for the intermediaries to regulate online content while respecting freedom of expression, which is an impossible task for them to fulfill. Intermediaries are private bodies, they are business entities. Their tasks are providing Internet access and online services, not determining lawfulness of content and boundaries of freedom of expression.

When the right holders fight for imposition of liability for end users infringement on intermediaries, they generally grasp for control over dissemination of their content and ultimately control the Internet. While their interests to control their content can be legitimate and can be understood, legislators must balance them with important public interest and rights of others to have access to information, public domain, open source and educational content. Without such proper balance, important democratic values as the freedom of expression can be severely limited and technological development stifled.

\(^{(71)}\) S. NAS, Supra note 67.
CHAPTER THREE
PRIVATE INTERNATIONAL LAW AND COPYRIGHT
IN THE DIGITAL ENVIRONMENT

INTRODUCTION:

The present chapter seeks to address general issues on the interface between Private International Law and Copyright Law in the realm of Internet. The geographic “boundlessness” of electronic networks poses certain difficulties to the application of conflict of laws rules, including applicable law and jurisdiction. Indeed, a single Internet transmission could trigger multiple and multi territorial infringements on a worldwide basis. Accordingly, right owners should seek protection in different jurisdictions, should they want to fully protect their interests.

In this chapter, we are going to discuss some problematic issues regarding the law to be applied and the competent court to exercise jurisdiction, following the infringement actions brought by the right owners whose protected works had been infringed online. But, first of all, it is preferably to point out two main principles which are involved in our discussion, namely: the principle of territoriality and the principle of the national treatment.

TERRITORIALITY:

The concept of territoriality plays an enormously important role in the international IPRs system. From an historical perspective, IPRs are granted by the government of, and have effects only with respect to, the territory of a
single nation-state\textsuperscript{(1)}. In order to secure IPRs protection for one invention, expressive works or indication of origin, the inventor must obtain protection in each territory where protection is considered necessary\textsuperscript{(2)}. However, many important challenges to territoriality are already present, and more are on the horizon, but the most serious challenge is the tension between the territorial nature of IPRs and the ubiquitous nature of the Internet.

**NATIONAL TREATMENT:**
According to Article 5(1) of the Berne Convention:

“Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention”.

Principle of national treatment’ means that foreign authors (authors of other Union countries) are to receive the same treatment as nationals. However, that does not necessarily mean that all authors are entitled to all national rights without any limitations.

The principle of national treatment is one of the oldest organizing principles found in international trade and investment agreements\textsuperscript{(3)}. This was a core feature of 19\textsuperscript{th} century bilateral agreements, establishing the fundamental tenet of non-discrimination: Foreign nationals or entitled

\textsuperscript{(2)} Ibid, at 255.
subject matter (such as goods, services or investment) shall not be treated less favorably than domestic nationals or subject matter\(^{(4)}\).

National treatment effectively functions as a substitute for international harmonization\(^{(5)}\). To the extent that states concentrate on national law, and progress in international law is slow, the principle of National Treatment allows the international community to automatically benefit from improved standards in municipal law or regional law introduced mainly for the welfare, and at request of, domestic right holders\(^{(6)}\).

**GENERAL ISSUES OF CHOICE OF FORUM IN COPYRIGHT CASES IN THE INTERNET:**

The apparently “borderless” nature of Internet and digital networks primarily raises important issues on how conflicts arising between parties will be adjudicated within different states. The more intertwined is the relation between electronic communication and forms of economic exploitation of copyrighted works, the more complex is the nature of litigation. As a result, jurisdictional issues are likely to arise and are inevitable at transnational level\(^{(7)}\).

As prior mentioned, copyright law became more global with the emergence of Internet and new forms of exploitation of works of authorship through electronic network which came out and impact the increasing number of cases involving multi territorial acts of infringement. Those cases are not novel in the field of private International law, since they refer to cross border disputes arising from private transactions. In their appearance,

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\(^{(5)}\) Supra note 1, at 280.
\(^{(6)}\) Supra note 1, at 288.
however, they pose difficulties that could not be simply addressed by the traditional avenues of Private International Law. It is even said that principle of territoriality is confronted by a kind of inherent exhaustion\(^{(8)}\).

In digital environment, communication of protected material over digital networks allows the work of authorship to be available simultaneously in many countries without any physical barriers. This explains why a copyright holder would seek for “consolidated measures” addressing territorial claims in a single forum. This goal, however, seems to be difficult to realize, particularly because the plaintiff would require a forum competent to hear all territorial claims, i.e., a forum with general jurisdiction over the alleged infringer. There are considerable obstacles to this approach: if the defendant is neither resident, domiciled nor conducts business in the forum, so the only criteria attracting jurisdiction to the court would be with respect to an act of infringement of the copyright performed within the forum. Thus, acts committed outside that forum would be irrelevant to assert jurisdiction in such a case\(^{(9)}\).

Even an “exclusive” jurisdiction based on the forum of the country of protection somehow would be useless, at least in the field of copyright and related rights, where it is quite clear that there is a practical need for the possibility of adoption of consolidated measures for protection of the works in the Internet\(^{(10)}\). For instance, defining an exclusive forum, when addressing infringing websites and number of other activities impacting

\(^{(8)}\) For the criticism on this assumption, see GELLER, “International Intellectual Property, Conflict of Laws and Internet Remedies”, in 22 E.J.P.R. 2000, at 125.

\(^{(9)}\) Ibid, at

copyright over the work of authorship in global networks, is certainly not an easy task. This is true, particularly taking into consideration all the number of different criteria for assessing personal jurisdiction involved in such cross border disputes\(^{(11)}\).

One of the main issues at this stage is, therefore, to determine the relevant connections between transactions involving copyright in the Internet and the jurisdiction to adjudicate foreign disputes arising between parties. Litigants may be located in different states and this physically can also be addressed in Internet environment: host, servers, content providers and end-users still are connected to a particular jurisdiction and there must be relevant criteria for assessment of localization of their activities in cyberspace\(^{(12)}\).

**ANGLO-AMERICAN APPROACH ON JURISDICTION RELATED TO COPYRIGHT DISPUTES ON THE INTERNET:**

In the following, some aspects concerning jurisdictional issues in US Law and Common Law systems with respect to copyright law in the Internet and general cross border litigation will be discussed. New trends on the adjudication of multinational copyright disputes in Internet are likely to be found in common law countries.

In the United States, courts have generally a substantial discretion regarding rules of Private International Law encompassing all fields of choice of forum, applicable law, recognition and enforcement of judgments. In fact, US Constitution seems to establish greater restraints on the exercise

\(^{(11)}\) Ibid, at 180.

of jurisdiction over cross border disputes\(^{(13)}\), and domestic courts have been developing conflict of laws rules in the field of intellectual property, particularly in cross border trademarks and copyright disputes\(^{(14)}\). From the standpoint of US law, such disputes usually have the character of interstate litigation and they are adjudicated by domestic courts applying conflict of laws rules.

With regard to Internet related litigation in the field of copyright, judicial developments in the United States showed cases concerning the exercise of jurisdiction over the parties and over the subject-matter. Observing the trends of US case law in the end of 90’s, Ginsburg remarked that home courts increased their willingness to hear claims involving foreign Copyright Law, at least where substantive foreign copyright laws would not displace applicable US copyright law in the Forum\(^{(15)}\). However, there was an increasing tendency of US courts to affirm the applicability of their domestic copyright law in cross border disputes, with one interesting exception in *Itar-Tas Russian* case\(^{(16)}\). This decision is considered a landmark in US conflict of laws field related to foreign copyright. In this case, the question of whether the plaintiff, a Russian Press agency, owned the copyright in articles that the New York defendant, Russian Kurrier Inc., had reproduced without authorization was determined under Russian Copyright Law.


\(^{(14)}\) Ibid, at 999.


US courts have been establishing substantive criteria for asserting the general jurisdiction over alleged infringer in Internet. Basically, they would assess the existence of “sufficient” contacts by the defendant "operating" and “doing business” in the Internet within the forum. The requirement is that the alleged infringer maintains (considerable, continuous and systematic contacts) with the forum, particularly when the main forum contact refers to the forum accessibility of defendant website, or the targeting effects of the website\(^{(17)}\).

The criteria of “doing business” is thus taken into consideration for purposes of asserting personal jurisdiction in Internet-related case when an alleged infringer, such as a website holder has “sufficient contact” with the forum. US courts have been developing, however, a strict view of this trend, particularly, when the website is merely “passively accessible” by the public. Under this characteristic, forum residents can access the website located outside the forum (i.e., accessible to the public resident in the forum), but cannot purchase goods or download from the site into the forum\(^{(18)}\).

Thus, if the website does not maintain any contacts, i.e., does not communicate “interactively” with the users that are residents in a particular forum, US courts tend not to assert jurisdiction. The lack of sufficient forum-related infringing acts is the decisive criteria for denying the

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\(^{(17)}\) Supra note, 12, at 1012.

jurisdiction\textsuperscript{(19)}. In fact, in copyright-related disputes this appears more
evident. For instance, a website operated by a non-resident and hosted
outside the forum that simply advertises infringing copies (but does not offer
to the public options of downloading those copies) would not be suffice for
jurisdiction.

Under Australian case law, the “global nature” of the Internet has been
deemed one of the relevant general criteria for the assertion of jurisdiction in
foreign copyright cases\textsuperscript{(20)}. Such element must be examined in light of what
domestic courts have been characterizing as the “ubiquity, universality and
utility” of Internet\textsuperscript{(21)}.

Further connecting factors in Internet-related copyright cases are
identified in Canadian Case Law. Still very recently the decision issued by
the Supreme Court of Canada in \textit{SOCAN}\textsuperscript{(22)} pointed out two relevant criteria
on the applicability of “real and substantial connection” and “host server”
tests for purposes of asserting jurisdiction in a case dealing with copyright
infringement and liability jurisdictional issues in cases related to foreign

the court rejected asserting general jurisdiction over the holder of a promotional website that did
not offer online sales to the forum, and that did not systematically conduct transactions with the
forum.

\textsuperscript{(20)} P. HAY, “\textit{Flexibility Versus Predictability and Uniformity in Choice of Law: Reflections on

\textsuperscript{(21)} In this respect, see the decision of the Federal Court of Australia in \textit{Cooper v. Universal
Music Australia pty Ltd.}, (2006) FCAFC 187, decision as of December 18, 2006, available online
at \url{http://www.austlii.edu.au/cgi-bin/disp/cases} (last visited March 2008).

\textsuperscript{(22)} \textit{Society of Composers, Authors and Music publishers of Canada v. Canadian Assn. of Internet
copyright infringement and liability of foreign copyright content providers for acts of disseminating unauthorized material over digital networks\(^{(23)}\).

In *SOCAN* case there is at least a clear limitation of the principle of territoriality in respect of the assessment of jurisdiction by a particular court, the question is always to define which connecting factors should be taken into consideration for a court to localize the infringing acts in cyberspace and thus assert jurisdiction before determining the applicable law. However, in the following paragraphs, we are going to examine two suggested models to address the question of jurisdiction.

The first model is based on the application of “real and substantial connection test” for purposes of asserting jurisdiction in foreign copyright cases. For instance, many parties could be involved herein, such as initial content providers, end-users who subsequently download electronic files containing copyrighted works and ISPs or host servers on which the websites are hosted. The activities concerning the dissemination on the protected material over the internet comprise the bundle of relevant copyrights, such as the right of reproduction (covering the act of downloading by the users), right of communication to the public (covering the act of the transmission of the copyrighted material by the ISP from the website to the end user) and the right of making available (covering the act of displaying the digitally formatted copyrighted work, which is undertaken by the content provider). In all these situations, it is important to note that

\(^{(23)}\) For general comments on the case, see S.H. LEONG, “Copyright Infringement in a Borderless World: Does Territoriality Matter?” In 273 Recueil Court 1998, at 239.
there must be a “departing points” for the analysis, which are assumptions that may help in solving conflict of laws issues in Internet-related cases\(^{(24)}\).

With regard to the first act, the downloading, it appears that reproduction takes place in the country where the end user is located, which could be his/her domicile or actual or habitual residence. Local courts, in this particular scenario, ought to have power to exercise jurisdiction over the alleged copyright infringement of the right of reproduction by the end users\(^{(25)}\). Copyright owners would be entitled to sue within that jurisdiction and the relevant connecting factor is the residence and domicile. The further acts related to the rights of communication and making available are hard to be localized from the standpoint of conflict of laws rules\(^{(26)}\).

However, in the case of the alleged act of infringement of the right of communication, and the right of making the work available, there are three relevant connecting factors to be applied:

(a) The Physical Location of the content providers hard drive;
(b) The Physical Location of the host server on which the website is hosted; and
(c) The Physical Location of the end users’ hard drive\(^{(27)}\).

In my opinion, the applicability of such test depends upon the choice of one specific connecting factor having the closest link with the jurisdiction concerned. For instance, in the case of an infringement of the right of

\(^{(24)}\) Ibid, at 302.
\(^{(25)}\) Supra note 20, at 236.
\(^{(26)}\) Ibid, at 252.
\(^{(27)}\) Ibid, at 257.
reproduction, the connecting factor having the most “real and substantial connection” may be the location of the end users; this is clear if we look upon the significant damages to the economic interests of the copyright owners in a particular market place. With regard to the making available right, the relevant point of attachment having the most “real and substantial connection” is the location of the host server\(^{(28)}\).

The second model is based on the application of the “host server test”. Apparently, this is a simplified version of the “real and substantial connection” test preserving the unity of the principle of territoriality. In a dissenting opinion in SOCAN case, Justice Lebel, held that the adequate test to determine whether an Internet communication has occurred within the country’s jurisdiction is the location of the server from which the dissemination of the copyrighted works was originated. The rational seems to be linked to the exclusion of further connecting factors in order to facilitate the analysis by the court. Thus, according to the “host server test”, both the place of the content provider (who uploads the content to the host server) and the end user (who downloads or “pull” the copyrighted material) are irrelevant\(^{(29)}\).

**JURISDICTION OVER CROSS BORDER COPYRIHT CLAIMS IN EUROPEAN LAW:**

After 30 years of existence, the Brussels Convention\(^{(30)}\) was replaced within the European Law by the Council Regulation\(^{(31)}\), which is commonly

\(^{(28)}\) Ibid, at 259.
\(^{(29)}\) Under this approach (the host server test), there is an act of communication within the forum when the internet-related activity originates from a “mirror site” located within the forum, regardless the location of the original site.
referred to as “Brussels -1- Regulation”, which is applicable to legal proceedings initiated after March 1, 2002. It is important to remark that the Regulation only refers to certain types of civil and commercial proceedings. In the field of intellectual property rights Article 22(4) of the Regulation foresees exclusive jurisdiction clause concerning claims of invalidity of registered intellectual property rights. Disputes arising between parties on this field must be decided by the courts of the country of registration of the relevant registered right (32).

The case of copyright, whether or not registered, is left aside from the scope of Article 22(4) of the Regulation. This general rule, therefore, does not apply to foreign copyright disputes. In fact, in the absence of relevant provisions on jurisdiction over copyright claims, the connecting factors attracting general jurisdiction in the framework of the Brussels Regulation are deemed to be the residence or the headquarters of the defendant (general competence deriving from Article 2 of the Regulation) or the court of the place where the “harmful event has occurred”. This refers to delictual or quasi-delictual competence deriving from Article 5(3) of the Regulation (special jurisdiction) (33).

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(32) Article 22 (Exclusive Jurisdiction). “The following courts shall have exclusive jurisdiction, regardless of domicile: (…) 4- in proceedings concerned with the registration or validity of patents, trademarks, designs, or other similar rights required to be deposited or registered, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of a community instrument or an international convention deemed to have taken place”.
(33) Article 5 “A person domiciled in a Member State may, in another Member State, be sued: (…) 3: in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur”.

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Notwithstanding its general rule, such provision gives no further specification of how the plaintiff (here to be assumed as the copyright owner) would choose between the place of causal event or “the originating act” and the place where the harmful event took place\(^{(34)}\). This hardly explains whether such provisions could be applied to cross border's copyright disputes arising in the Internet, where there is a plurality of harms, e.g., those emerging from multi territorial acts of infringement\(^{(35)}\).

However, the EC courts took a chance to clarify such issues, thus, in *Fiona Shevill* case, the court addressed a case of libel by means of press article disseminated in several Member States, the expression “place in which the harmful act occurred” was to be interpreted to mean that “the victim may institute proceedings for damages of establishment of the publisher of the defamatory publication competent to make good the totality of the prejudice resulting from the libel or before the courts of each contracting state in which the publication was distributed and in which the victim claims to have suffered injury to her reputation, competent to hear only the prejudice caused in the State of the court applied to”\(^{(36)}\).

Accordingly, two criteria would be relevant in determining the jurisdiction in this case, since the rationale of the decision seems to be based both on the damages that were effectively suffered by the victim and the certainty concerning the place where the defendant has his assets: (a) the court of the place where the publisher of the defamatory publication is


\(^{(35)}\) Ibid, at 717.

\(^{(36)}\) *Fiona Shevill, Lxora Trading Inc., Cheque point SARL and Cheque point international Ltd v. Press Alliance SA*, (c-68/93/March 7, 1995).
established and (b) the courts of each places in which the publication was distributed and where the victim claims to have suffered injury to the personal reputation\(^{(37)}\).

Although the solution proposed by the ECJ in *Fiona Shevill* case could lead to different results to the plaintiff’s claims, there is clearly a concern on the necessity of administration of justice and establishment of efficacious proceedings. To the plaintiff should be given additional alternatives concerning the adjudication of the dispute, i.e. a jurisdiction other than that of the State of the defendant’s domicile.

However, even in the scope of application of the Brussels -1- Regulation, the question of compensation and damages will be relevant to the legitimate interests of the right holder in the case of infringing acts of copyright taking place in the Internet and potentially affecting several markets\(^{(38)}\). The plaintiff would like to obtain the cessation of the infringement overseas. One of the difficulties in such a case is to determine which measures can be taken in that respect in each of those particular jurisdictions.

Curiously, in contrast to the court of the place of establishment of the server, “which may order the defendant or alleged infringer to refrain from making available the protected material to the public”, courts of the various countries in which distribution has taken place would only be able to order prohibitions limited to their territory. Thus, it is still difficult to assess

\(^{(37)}\) Ibid, According to the ECJ, in the first alternative, courts have jurisdiction to award damages for all the harm caused by the defamation, while in the second they have jurisdiction to rule solely in respect of the harm caused in the state of the court seized.

\(^{(38)}\) See, supra note 24 at 222.
whether such kind of measure could be implemented from a technical point of view in all cases\(^{(39)}\).

**SOME ALTERNATIVE TO JURISDICTIONAL ISSUES: PLACE OF DAMAGE, HARMFUL EVENT AND TARGETED MARKET:**

Some general rules could be considered for solving jurisdictional issues related to foreign copyright disputes. Besides the importance of the application on international copyright law principles, such as those established by Berne Convention in respect of the protection of authors in the countries of the Union\(^{(40)}\), it is submitted that the characterization and localization of copyright-related transaction in the Internet may have a central role on this first task\(^{(41)}\).

From the perspective of conflict rules, a market-oriented approach could also help in defining an efficient scope for the exercise of jurisdiction overseas. The choice of connecting factors in defining jurisdiction in cross border copyright disputes in the Internet should take into consideration an appropriate degree of connection between the cause of action and particular territory as point of departure\(^{(42)}\). As an alternative for the strict meaning of the application of principle of territoriality, for instance, courts might look upon the localization of the effects resulting from the infringing acts over

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\(^{(39)}\) *PLAYBOY v. CHUCKLEBERRY* (939 l. Supp-1032) (SDNY 1996), in which the court ordered the Italian server to prohibit access to the site from the United States or in case of failure, to completely switch off and block the site.

\(^{(40)}\) See in particular, Articles 5(1) and 5(2) of Berne Convention dealing with national treatment and the substantive law regulating the protection and means to remedy infringement issues.


\(^{(42)}\) Ibid, at 1337.
(domestic or regional) markets. This main function of private international law rules – the situational/spatial function – is still to be addressed.

The first (and still classic) approach of conflict of laws rules concerning foreign copyright infringement to focus on is the place of the infringing act in the Internet, referring to the classic conflict rule “Locus delicti commissi”\(^{(43)}\). Cross border copyright infringement may comprise acts that pass time and/or space before they are completed. In those cases, it is desirable, from the standpoint of Private International Law policies, that courts interpret and apply technologically neutral rules. They do not require amendments for each single innovation, since this would be useless and almost impossible in each single national law.

In Common Law jurisdiction, this is particularly clear in the analysis carried out by courts in localizing cross border torts in Internet\(^{(44)}\). They have been broadly understood the concept of “tort committed within the jurisdiction”, sustaining that the infringing act does not take place where the communication originates, but where the communication is directed\(^{(45)}\).

In view of the importance of establishing general principles on jurisdiction in the Internet, it may be useful to review even the classic conflict rule of “Lex Loci delicti” based on the place where the tort occurs. One should sustain that, infringing acts in the Internet pose particular challenges for establishing jurisdiction, since the place in which the tort is

\(^{(43)}\) Ibid, at 1341.
\(^{(45)}\) Ibid, at 800.
committed could be potentially “anywhere and elsewhere”. This would result in a kind of global liability emerging from the simple fact that, the internet user or a content provider has a hard disk, and his PC is connected to the Internet by a modem. Thus, it might be difficult to establish a conventional “Locus delicti” in such global environment with purposes of asserting jurisdiction, because this could be everywhere in the world\(^{(46)}\).

As a starting point, however, the localization of the infringing act could be in the place where the defendant “uploaded” the copyrighted material onto a website, and further distributed, or allowed subsequently downloading by users from other websites. The focus here is clearly the defendant’s act, since this is the cause of damage suffered by the copyright owner. On the other hand, this test is preferred by the courts than the place of the last event completing the cause of action, e.g. a single download act by the Internet user. From the plaintiff’s stand point, this would be preferable, since the court could find that it has jurisdiction over claims for all damages arising out of the Internet activity which is the subject of the complaint, in spite of the various countries in which the damages have been suffered\(^{(47)}\).

The second approach refers to the localization of the “place of damage”, which cannot be understood in the mere sense of “physical location” of the copyright owner or alleged infringer\(^{(48)}\). From the standpoint of traditional

\(^{(46)}\) Ibid, at 815.
\(^{(48)}\) See, supra note (33), at 815.
connecting factors in Private International Law, “Physical Location” would immediately concern domicile and residence. In practical terms, in as much the Internet is concerned, plaintiff could potentially suffer the damages anywhere in the world. However, as a first step on the analysis, the “earliest point in time” where the communication in the Internet takes place could be an appropriate solution to define the infringing act\(^{(49)}\).

Furthermore, the alleged infringement has to reach the recipients\(^{(50)}\). On the other hand, in Internet environment, the concept of the place where the damage is sustained may be easier to cope with, since it directs attention to the real effect of the act complained of and not the technical issue of where, within the cyberspace, it may have occurred. The focus here is primarily on the damages resulting from the infringing act and not to the location of it in the Internet.

For purposes of setting a rationalized method, jurisdiction of courts of the place where the damages were suffered should be limited. The copyright owner (the plaintiff) may sue for damages arising in those places where he effectively suffers damages\(^{(51)}\). In a market-oriented approach, this could be many potential states, in which copyright protection is to be exercised, and thus economically exploited. One of the relevant connecting factors in such case is the place where the copyrighted work are reproduced, downloaded and displayed\(^{(52)}\).

\(^{(50)}\) Ibid, at 204.
\(^{(51)}\) Ibid, at 289.
\(^{(52)}\) Supra note 46, at 201 FF.
Such example further points out other connecting factors, namely the place where the end-users, Contents providers and ISPs are located. Indeed, those are relevant places in which the copyright holder would suffer, in considerable extent, damages arising from infringing acts. The rational here, in my opinion, appears to be also conducive to jurisdictional policy, since recovery of damages would be limited to those jurisdictions in which the copyright owner had effectively suffered damages. In a market-oriented approach, this could be assessed by the domestic or regional exploitation of the protected work in the market place, the loss of sales and further criteria establishing damages\(^{(53)}\).

**COPYRIGHT AND APPLICABLE LAW IN DIGITAL ENVIRONMENT AND CLASSICAL ISSUES:**

The previous part of this chapter attempted to describe the current debate on jurisdictional issues concerning foreign copyright cases with regard to the Internet, assuming that general rules on jurisdiction are important for all the consideration of analysis. Once domestic courts in cross border copyright cases assert jurisdiction, judges have to look upon the substantive regulation of the dispute that they have to adjudicate. In the field of copyright, the principle of territoriality still plays an important role, particularly due to the fact that separate sets or bundles or rights are envisaged for each sovereign State. Nevertheless, this approach has to be reassessed in view of the application of new choice of law rules in the Internet-related disputes.

\(^{(53)}\) See the same opinion adopted by P.E GELLER, Supra note 18, at 177.
A first premise in international copyright law is illustrated by the traditional interpretation of Article 5(2) of the Berne Convention\(^{(54)}\), which is conducive to the idea that copyright protection is territorial or, put it simply, this protection can be claimed in a particular jurisdiction which is not that jurisdiction where the work was created. This means each country of the Union determines, within the substantive normative standard established by the Convention, what the scope of copyright protection is, and what the remedies are provided for infringement.

Berne Convention establishes minimum standards of protection and substantive norms, but Countries of the Union may grant more protection than that. Its provisions offer a set of rules on subject matter, duration and scope of copyright protection, combined with the substantive obligation on national treatment, all of them strictly related to the principle of territoriality. Particularly with regard to national treatment, Berne Convention requires the countries of Union to afford copyright owners from other Berne Countries the same protection as afforded to their own national authors\(^{(55)}\). In fact, this reflects a compromise between international copyright law and national policies, since the protection of copyright within the “unionist domain” appears to have primacy and the principle of National Treatment is itself

\(^{(54)}\) Art 5(2): “The enjoyment and exercise of these rights shall not be subject to any formality, such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of the Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where the protection is claimed”.

\(^{(55)}\) See Article 5(1) of Berne Convention “Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention”.

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anchored in a general obligation of non-discrimination and preservation of integrity of national legal system\(^{(55)}\).

From a normative standpoint, neither Berne Convention, nor subsequent copyright and related rights treaties have been negotiated and concluded by States at multilateral level with a particular choice-of-law concern or method in mind. It has been quite controversial that Article 5(2) of the Berne Convention offers a general conflict of laws rule on foreign cases\(^{(56)}\). This provision has been associated to the meaning of the law of the country of protection (\textit{Lex Loci Protectionism}), in the sense of the country where the protection of the work of authorship is claimed. One should associate this approach with the full application of principle of territoriality\(^{(57)}\). Some authors infer a conflict of laws rule from the provision of Article 5(2) of Berne Convention, while some deny those characters\(^{(58)}\). Two further conflict rules addressing cross border copyright litigation that are less supported in connection with Berne provisions are the law of the place of origin of the work (\textit{Lex originis}) and the law of the Forum where the dispute is to be heard (\textit{Lex Fori}).


\(^{(56)}\) Relevant are the comments of M. REINDL, Supra note (43), at 805 when said: “The identification of choice-of-law rules for copyright is difficult for a number of reasons. First, the Berne Convention was drafted in a period when the statutist approach had been giving way to new choice-of-law methods for some decades, particularly Savigny’s allocation method. There is, however, no indication in the records of the diplomatic conferences of a “savignyan” analysis of copyright nor is any such analysis to be found in the late 19\textsuperscript{th} century legal writings on the international copyright system”.

\(^{(57)}\) See analysis of the evolution of the scholarly thought in S. RICKETSON, Ibid, at 270.

However, the distinction between the law of the country for which the protection of the work is claimed (Lex Protectionism), the law of the country of origin of the work or of its author (Lex origin) and the law of the forum where the dispute is adjudicated (Lex Fori) refer to classical methods of choice of law that were established largely amongst civil law scholars in the course of historical development of Private International Law in copyright field. In this respect, one could contend that the determination of the applicable law to multinational copyright cases may depend on the “territorial localization” of the connecting factors and this would hardly be determined in the Internet-related cross border disputes\(^{(59)}\).

**SOME CONFLICT RULES CONCERNING APPLICABLE LAW IN COPYRIGHT CASES: CLASSICAL METHODS AND TERRITORIALITY:**

Amongst the main conflict rules, the (Lex Loci Protectionism) is primarily associated with the choice of law in multinational copyright cases. Scholars do not achieve consensus on the origin and foundation of this rule, contending that it derives from the territorial nature of copyright and national treatment *vis-à-vis* a conventional interpretation of Article 5(2) of the Berne Convention. The rule is often understood as the law of the country “For which the protection is claimed”, since Berne Convention was intended to establish minimum standards of protection within the common unionist space and authors should rely on each country of the Union for protection of their works of authorship\(^{(60)}\).

\(^{(59)}\) Ibid, at 200.
\(^{(60)}\) See supra note, 58 at 408.
The rule *lex loci protectionism* is read in connection with the rule *lex loci delicti commissi*, which refers to the law of the place where the infringing act (delict/wrongful act) has been committed. Thus in cases concerning infringement of copyright, the rule *lex loci protectionis* also serves as a rule for determining the applicable law, but does not govern issues on, for example, existence, ownership and transfer of copyright\(^{(61)}\).

Although it can be deployed as conflict rule of choice of law in cases related to copyright infringement, the rule *lex loci protectionism* directly refers to the acts of exploitation or use of the work of authorship. This is particularly important in those cases related to creation, dissemination and use of protected material in the Internet, since such acts of exploitation are not confined to one or other particular jurisdiction\(^{(62)}\). The existence of multiple points of attachment between the acts and different jurisdictions makes it difficult to determine which law would be more appropriate or even close to the transaction having multinational impacts.

The application and the Interpretation of Article 5(2) of the Berne Convention, however, still pose many difficulties. The designation of law of the country where protection is sought to govern the extent of protection is based on strict territoriality. The provision at least suggests that the law of the country of protection applies to determine whether and to what extent a work of authorship is protected. The expression “where” could offers some evidence that the substantive copyright law of the forum should apply in all cases, but it may be reasonable to conclude that the draft of Berne

\(^{(61)}\) See, A. KUR, Supra note 10, at 190.
\(^{(62)}\) On this issue, specifically, see REINDL, Supra note (43), at 833

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Convention either did not anticipate that the country of protection was claimed would not also be the country where the infringement took place, or assumed that the Forum’s choice of law rules would determine the application of the law of the place of committing the infringement\(^{(63)}\).

Another supported conflict rule with reference to Berne Convention is the *lex origins*. Its interpretation refers to two different aspects in the field of international copyright law rather than Private International Law itself. According to Berne Convention’s relevant provisions, the “country of origin” determines whether an intellectual creation is protected under the Convention. The country of origin must be a country of the Union in order for the author, performer or broadcast organization, to be eligible for national treatment. This concept is still found in the law of aliens. Second, the country of origin is the relevant rule determining the reciprocal protection amongst different jurisdictions, particularly in those cases related to the duration of copyright\(^{(64)}\) Protection of design\(^{(65)}\) and resale right\(^{(66)}\)..

The third conflict rule is the *lex fori* and has been associated with the interpretation of Article 5(2) of the Berne Convention by few authors. The expression “extent of protection” and “means of redress afforded to the author to protect his rights”, as referred in the text of Article 5(2), would appear to be related to the Law of Forum where a copyright dispute is to be

\(^{(63)}\) See, Supra note 10, at 205.
\(^{(64)}\) See for instance Article 7(8) of Berne Convention referring to the “comparison of terms”, whereby a term of protection granted to the author in a country of the Union may not exceed the term fixed in the country of origin of the work.
\(^{(65)}\) Article 2(7) of Berne Convention, with regard to protection of designs and models in the country of origin *vis-à-vis* the entitlement for protection in another country of the Union.
\(^{(66)}\) See Article 14, ter of Berne Convention.
decided. As a matter of practice by domestic courts, the *lex fori* governs issues concerning jurisdictional protection and defines which actions are available in the case of infringement of copyright\(^{(67)}\). This conflict rule also establishes further procedural rules underlying the means of protection, and hence, is directly associated to the state’s sovereignty for the adjudication of disputes\(^{(68)}\).

**REDEFINING TERRITORIALITY: MULTIPlicity OF APPLICABLE LAWS AND ALTERNATIVE CONNECTing FACTORS IN THE INTERNET: COUNTRY OF ORIGIN AND PUBLICATION OVER DIGITAL NETWORKS:**

As an alternative solution for the variety of cross border cases having multinational impacts, Geller observes that Berne Convention would facilitate manipulation of connecting factors\(^{(69)}\). From a territorial approach, this is particularly true with regard to the protection of authors covered by the convention. A work of authorship, which is created and published in connection with digital networks, may attract copyright protection as long as its author has done it somewhere connected to one of the unionist countries. But this does not limit the international protection in territorial sense or “global protection” claimed in the context of the Internet\(^{(70)}\).

Digital networks may indeed rationalize the access by authors to a range of points of attachment in cyberspace, since it seems that posting a work of authorship on the Internet may well affect simultaneous publication in all countries with which Internet users have contacts or access to the Web.

\(^{(67)}\) See, Supra note 8, at 177.
\(^{(68)}\) Ibid, at 183.
\(^{(69)}\) Supra note 17, at 270.
\(^{(70)}\) See, P. HAY, Supra note (19), at 167.
Geller comes with such conclusion based on the definition of “published works” established in Berne Convention\(^{(71)}\), which provides that a work will be considered “published” if copies are made available to the public in a manner that satisfies its reasonable needs.

The structure and operation of the Internet, however, changes this classical rational. First, “copies” of the work of authorship can be interpreted to include temporary reproduction in the RAM of the personal computer, and the “act of posting” a work on a website makes copies available to every single Internet user accessing the website in which such digitally stored work is uploaded\(^{(72)}\). Since digital transmission is one of relevant operational elements of the Internet, the notion of publication should assume a more elastic character. The requirement of “availability” of copies to the public has close connection with copyright transactions in cyberspace and this is better explained in light of the types of interaction between authors, content providers and end-users.

The place of publication over digital networks (thus, where the work is effectively made available to the Internet community) would maintain a close relation with a range of points of attachment, even from the standpoint of the principle of territoriality the country from where the author posted the work, the country where the website host server is located and the country where the user downloads the work which was made available. There was no surprise in concluding for this scenario, since Private International Law deals with diversity of methods and seeks to allocate justice in cross border

\(^{(71)}\) Article 3.3, Berne Convention.  
\(^{(72)}\) See, Supra note (55), at 570.
transaction. With regard to copyright law issues, courts shall play an important role to design novel alternatives using important tools provided by conflict rules.

PLACE OF EMISSION AND PLACE OF RECEPTION OF COMMUNICATIONS:

Works of authorship are disseminated simultaneously to a global community of users and independently from the physical or virtual place where they were created\(^{(73)}\). In this sense, infringement of copyright may occur pervasively in many places where alleged infringers have access or with which infringers establish sufficient contacts. This could be in the country from which the alleged infringement originated or the countries to which the infringement was communicated\(^{(74)}\). Two alternatives of choice-of-law are provided in this respect: either the law of each country of receipt, or, a single law governing the issue, such as the law of the country of initiation of the infringement\(^{(75)}\).

Generally speaking, choice of law rules based on the law of each country of receipt would be compatible with the classical foundations of international copyright law, i.e., that there is no global copyright law as such, but rather a set body of national copyright laws that are bound by Berne Convention into national treatment obligations. According to this approach, the author of a work first published in France is not only the French copyright owner, but in accordance with Berne Convention, a UK owner, Japanese owners, and Sudanese owner. For each different

\(^{(73)}\) See W. PATRY; supra note 58, at 503 ff.
\(^{(74)}\) Ibid, at. 525.
\(^{(75)}\) Ibid, at .531.
jurisdiction, there is a distinct domestic market where the work is exploited and which defines the local protection\(^{(76)}\).

On the other hand, it is submitted that a choice of law rule that is based on the law of the country where acts of infringement originate is compatible with a territorial approach. As a matter of fact, the sole territory to take into consideration is the one of the country from which the infringement originated.

CONCLUSION:

It is not yet clear how Private International Law applies in the context of the Internet; however, the following principles are relevant: Because works cross borders without restrictions, the territorial nature of copyright legislation is challenged. Questions arise, for instance, about the copying of a work and the location in which such acts take place. Is it the location where the work was originated? It's terminal in another location in which the works are viewed, or where the work is published? Which jurisdiction will decide the case and under whose law?

In this chapter we discussed all these scenarios, and we tried to find out some alternatives and modern-nature connecting factors to decide which court shall exercise jurisdiction and which law to be applied regarding infringement cases in the digital world.

\(^{(76)}\) Ibid, at .546.
The first point is that, the Internet offers the fastest means ever of reproduction and distribution of information. This new environment has created new business models that have presented fundamental challenges to the copyright industries and, in fact, to the copyright system itself. The digital era, the convergence of telecommunication, computer technology, and the emergence of the Internet have brought into question the very definition of terms used in the copyright arena, such as reproduction/copying, publishing, broadcasting and communication to the public. The online world such as service providers and content providers is facing multiple and complex challenges in applying national copyright legal systems to a borderless and seamless cyberspace.

The WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT) – known together as the WIPO Internet treaties – are seminal initial steps in modernizing international copyright law to take into account the new digital environment. These two treaties set out the legal framework for safeguarding the interests of creators in cyberspace and open new horizons for composers, artists, writers and others to use the Internet with confidence to create, distribute and control the use of their works within the digital environment. But of all these issues the Internet treaties pay a
considerable intention to protect the exclusive right of reproduction and the right to communicate the copyrighted works.

The right to reproduce the copyrighted work is normally termed as the basic right granted to the copyright owner. There are various acts that are considered to be reproduction, for instance: Inclusion of a copyright protected work or the object of a related right in any offline, digital storage device, for example CD-ROM, and Digital Video Discs (DVD), uploading or downloading of copyright protected works, and any other digitization of copyrighted works.

In digital technology, the well established lines between copying and reading, sale and reuse, performance and viewing become blurry. A good example is the dilemma concerning ephemeral or temporary copies used to view works online. The pertinent question is whether such copies, made as a result of the internal workings of a computer, infringe on the authors’ right of reproduction.

The Berne Convention does not define the scope of the right of reproduction. Article 9(1) of the Berne Convention covers all forms of reproduction in any manner or form. This provision is encompassed in Article 9 of the TRIPS Agreement as well as Article 1(4) of the WCT. This was presumed to extend to digital works. There were scholars who had certain doubts as to whether transitional storage may always be considered fixation and thus reproduction. They were of the opinion that works were not sufficiently fixed if they were purely evanescent not transient in nature as those briefly projected on the screen shown electronically on Television or
cathode ray tube, or captured momentarily in the RAM memory of a computer.

In the Sudanese Copyright and Neighboring Rights Protection Act 1996 there is no definition for the term reproduction, so amendments are required to make it clear that the term reproduction means the act of copying or recording the work in any material form including the acts of storing the work in any medium by any means. And to maintain the balance between the interests of the copyright owners in having their works well published and at the same time well protected and the interest of the public to get a free access to such works, the Sudanese legislature may choose between two solutions; namely:

a- Since the diplomatic conference preceding the WIPO Copyright Treaty could not agree as to whether temporary copies should fall within the scope of the reproduction right, and the Treaty leaves the matter open, Sudan can insert the above recommended proposed definition for the term reproduction with making a clear exclusion of temporary reproduction in the RAM and still comply with the Treaty for the purpose of its ratification in the future. This would carry over into the digital environment the right of the consuming public to make normal use of a work without fear of infringing copyright. Or,

b- The Sudanese legislature can adopt the same approach, which is adopted by both the U.S.A Digital Millennium Copyright Act and the EU Copyright Directive, by stating that the proposed definition for the term reproduction covers all digital formats and includes even
temporary or incidental copying in the RAM. The Act then may provide limited exceptions to the reproduction right for transient copying undertaken by computers or communication networks as a result of an automatic or inevitable technical process.

I strongly recommend the adoption of the last exception-based solution because it enables the exemption from the exclusive reproduction right to be confined to transient copies made" for purely purposes" and having "no independent economic significance".

With the arrival of the radio and other modern mass media, we have seen that the “communication in public” was replaced with the “communication to the public” as the main criterion for the application of copyright law to the dissemination of works in non-material form.

To this extent, the communication to the public may become the primary vehicle for the protection of author’s works against on-line exploitation, with the other rights of reproduction and distribution being subordinate to it. For this purpose, a more systematic approach should be followed that allows grouping the protection of all types of authors’ works against their communication to the Public under one provision and to abolish the different protection provided for in Articles 11, 11bis, 11ter, 14 and 14bis of the Berne Convention. In this way, the right of communication to the public would become an all-encompassing right that would render the different rights of public performance, broadcasting and cabling redundant.
As a result, the WCT extends the traditional exclusive right of authors to communicate to the public to all categories of works. Furthermore, the WCT explicitly provides that the right of communication to the public explicitly includes the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them. The communication right is set out in article 8 of the WCT:

(Without prejudice to the provisions of Articles 11(1)(ii), 11bis(1)(i) and (ii), 11ter(1)(ii), 14(1)(ii) and 14bis(1) of the Berne Convention, authors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them).

Unfortunately the Sudanese Copyright and Neighboring Rights Protection Act 1996 does not provide for a modern definition for the term communication as section 3 defines the term to mean "the operation by which sounds or images or both are transmitted by wire or other material carrier for the reception by the public".

This definition is in reality a definition for the term (broadcasting) rather than the term (communication), which exclusively deals with communicating works via Radio and Television. And since the definition does not make it possible for a wireless communication and the electronic communication to be treated as a proper means of communicating copyrighted materials and as a result will not acquire copyright protection in
the Sudan for lack of publication, the Sudanese present copyright Act should be amended firstly, by correcting the wrong term of communication to the public by the term broadcasting, and the definition should not be altered.

Secondly, a new term should be added to section 3 of the 1996 Act that is the term "making available" followed by this proposed definition as to mean the act of uploading any information, contents, in any form or mode of expression, and enable the public to access such works from any place, and at any time individually chosen by them.

Anyway, there is a global understanding that to fight against online copyright piracy, using high technology is essential. For this, some technological measures of protection should be involved.

Both the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty set out obligations on states that join the treaties to provide adequate legal protection and effective legal remedies against the circumvention of technological protection measures used by authors to protect their copyright. Technological protection measures envisaged in these treaty obligations include passwords, encryption, signatures, access codes, and key systems.

In Sudan there is of course no mention to such technical devices, however, I am of the opinion that the Sudanese legislature should postpone taking a position on this issue until after a clearer national understanding about the whole issue i.e. copyright protection on the Internet is established. Then the legislature can make a provision to make it a crime the act of
circumventing any technological protection measures made by the copyright owners to prevent online infringement.

Another very fundamental problem that came with the Internet dilemma is the problem of establishing the responsibility against the infringing activities committed online, and since such kind of infringements always related to a copyrighted materials published through the assistance of a so called the internet intermediaries, it became more than important to deal with this kind of digital infringement by tracing those intermediaries, and then either the internet intermediaries to be treated as a direct infringer or as an indirect infringers, is a matter completely governed by the national laws.

Trying to solve the conundrum of copyright protection on the Internet, one may not find a simple and straightforward answer to the questions posed by new technologies. Creation of an effective liability regime for the Internet intermediaries is one of the elements necessary to provide an adequate response to the perpetual hi-tech advance. Although clearly an appropriate balance should be sought in establishing an on-line liability regime, the various interests at stake are difficult to reconcile. Indeed, it does not really clear how measured the relevant legislation is, there will always be some parties who benefit more than the others. Both the DMCA and the EC Directive have their drawbacks as well as their merits. However, a comparative analysis allows seeing the problem deeper. The DMCA despite its complexities and uncertainties was “a much needed piece of legislation.” The same can be said about the EC Directive.
The legislation as it stands now permits normal functioning of the Internet and protects interests of the stakeholders to a certain extent both in the US and in the EU. Nevertheless, new concerns might arise very soon. The absence of a general obligation to monitor does not seem to be unconditional. Indeed, both the DMCA and the EC Directive contain provisions that might lead to the imposition of some monitoring duties on the Internet intermediaries. One of the conditions for eligibility for limitations under the DMCA is the pursuance by an ISP a policy designed to discontinue subscriber’s account if the subscriber is a repeat infringer. Such a policy, among other measures, might require some supervising activities by ISPs.

The EC Directive allows Member states to demand monitoring in a “specific case.” Moreover, the host service providers may be obliged to apply “duties of care” in some situations according to national laws. Indeed, all the provisions mentioned above concern only specific cases. However, these cases might be interpreted rather broadly and thus ISPs can not be sure about the absence of their duties to monitor the content of the information.

In the Sudan and despite the fact that the country nowadays is witnessing a very big revolution era in the communication industry represented in the increased number in the telecommunication companies, which provide the Internet services in Sudan, unfortunately there is no any law to regulate its activities nor to determine its responsibility with regard to copyright infringement cases.
To remedy this position we recommend that, the Sudanese legislature should add at least in the Copyright and Neighboring Rights Protection Act 1996 some sections to deal with the above mentioned issues, and before all a definition to the term Internet Service Provider should also be added in section 3 of the Act. However, the recommended model for such a definition is the United States' Digital Millennium Copyright Act, which defines the term in section 105 as to mean:

a- An entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user's choosing, without modification to the content of the material sent or received.

b- A provider of online services or networks access, or the operator of facilities therefore, and includes an entity described in (a).

The borderless and international nature of the Internet leads to the third point. Works cross border on the Internet without restriction. The contrast with the territorial nature of copyright legislation gives rise to numerous issues of private international law; the most obvious examples are the copying of a digitized work over the Internet. Where does the copying take place? Does it take place on the server where the work is stored, or on the foreign terminal on which the user views the work and where he or she prints a copy of it, or in any of the countries through which the work passes on its way from the server to the user’s computer? Which national court will have jurisdiction to decide a dispute arising in such scenario? And under which law will the issue be decided?
The Berne Convention does not provide an answer to jurisdiction questions. In the Berne Convention, jurisdiction is a matter that is left to the domestic private international law of the Contracting States. Suffice it to say that most Contracting States have rules that allow a defendant to be sued in his or her place of domicile or residence or sometimes even in the place where he or she is present. Most of them also see copyright infringement as cases that could be classified as tort cases. That means that, depending on the national laws, the case can also be brought in the courts of the Contracting State where the infringement took place. How all these private international law rules apply in the context of the Internet is often far from clear though.

Another question relates to the law applicable in cases of cross-border disputes. In that context, one of the few existing private international law rules contained in international IP law treaties can be found in the Berne Convention (Article 5(2)) which makes reference to the law of the country in which protection is sought.

There has been some debate whether this term is to be understood to refer to the country where the court proceedings are brought, or to the country for whose territory protection is claimed (i.e. the country where the infringing acts have occurred). Today, the latter understanding is widely accepted. Therefore, the starting point would be that, in principle, the law of the country where the infringing acts occurred governs the scope of copyright protection, as well as the means of redress afforded to the right holder to protect his rights. For example, the law of the country where protection is
sought will determine the level of originality that is required for copyright protection in that jurisdiction, as well as the exact regime of protection that will be applicable.

In Sudan there is no mention to any private International law rules that govern disputes arising in the digital environment. This is not a strange position since the Sudanese Copyright and Neighboring Rights Protection Act 1996 does not make any legal provisions to regulate Authors' rights in the digital age, let alone react accordingly!! And at this stage, the Sudanese legislature should take a serious stand to develop conflict rules to deal with the online infringement cases which are sooner or later will come into existence due to the advance technology being used by copyright authors as a modern style way in disseminating their creativity among people.
BIBLIOGRAPHY

Books


ARTICLES


