# Kluwer Copyright Blog

## Germany: No Digitisation without Reproduction

Benjamin Schuetze (Institute of Legal Informatics, Leibniz Universität Hannover) · Friday, May 29th, 2015

On 16th April 2015 the German Federal Court of Justice (BGH) delivered its final judgment in a lengthy legal standoff, which began its journey through the judiciary in 2009. The judgment is not yet available but is discussed in a press release here. Since that time libraries and publishing houses have fought with one another over the meaning of access to digital content, the right to reproduction and traditional copyright exploitation schemes. The dispute at hand revolved around Sec. 52b of the German Copyright Act (Urheberrechtsgesetz), containing a statutory copyright limitation which permits certain institutions such as public libraries, museums and archives to make published works of which they hold physical copies, available to the public via dedicated terminals located on the institution's premises.

**Factual and Procedural Background**

The Claimant ("Eugen Ulmer KG") is a scientific publishing house with headquarters in Stuttgart (Germany). The defendant Technische Universität Darmstadt (Technical University Darmstadt) operates as a publicly accessible academic library. The library is equipped with electronic reading terminals which allow the public to access and consult works contained in the library's digital/electronic collection.

Since January or February 2009, the library's database has included the textbook "Einführung in die neuere Geschichte" which is published by the claimant. The defendant digitised the textbook in order to make it available to users on its electronic reading terminals. Such terminals did not allow for a greater number of copies of the textbook to be consulted at any one time than the number (seven copies) of textbooks physically owned by the library. Users of the terminals could also print out the work on paper or store it on a USB stick (partly or in full), and take it out of the library in that format. Prior to the digitisation of the textbook, the claimant offered the defendant the opportunity to purchase the claimant's e-book program that, *inter alia*, included an e-book version of the textbook in dispute. The defendant, however, did not take up the claimant's offer, whereupon the claimant brought an action against the defendant before the Regional Court of Frankfurt (Landgericht Frankfurt).

In its decision of 6 March 2011 the Regional Court of Frankfurt rejected the claimant's application seeking to prohibit the defendant from digitising the textbook or having it digitised. However, it

upheld the claimant's application to prohibit library users from being able to print out the textbook and/or store it on a USB stick and/or take such copies out of the library.

Both parties, having been dissatisfied with the outcome of the case, asked to be heard by the Federal Court of Justice (BGH), leaving out the next responsible court pursuant to Sec. 566 (4) of the German Civil Procedure Act (ZPO) (leap frog appeal = Sprungrevision) arguing that the legal matter was of fundamental significance. The BGH granted the defendant's appeal on 19 October 2011, while it dismissed the claimant's appeal on formal grounds (the claimant later cross appealed according to Sec. 554 (1) ZPO). A year later in September 2012 the BGH stayed proceedings and made a reference to the CJEU for a preliminary ruling as the BGH's final judgment concerned the interpretation of Article 5(3)(n) InfoSoc Directive. The BGH referred three questions to the CJEU which were finally answered by Judgment of the Court (Case C-117/13) on 11 September 2014 (please see kluwer blog entry http://kluwercopyrightblog.com/2014/10/17/public-libraries-the-right-to-digitise-and-the-right-of-reproduction).

**Judgment of the Court (BGH)**

With its decision the BGH finally dismissed the claimant's application. The fact that the claimant offered to conclude a licence agreement on the textbook in dispute, which would have enabled the defendant to make the textbook available through its terminals in a digital format, does not bar the defendant from digitising the textbook himself pursuant to Sec. 52b Copyright Act. The term "so far as there are no contractual provisions to the contrary" shall only mean provisions in existing contracts rather than offers to conclude a contract. This question was already part of the preliminary proceedings in which the CJEU stated that Article 5(3)(n) of the InfoSoc Directive should be understood as requiring a licensing agreement in respect of the work in question (pt. 35).

Pursuant to Sec. 52b Copyright Act, the defendant shall further be permitted to digitise the claimant's textbooks and make them available through electronic reading terminals on the library's premises. In this regard the BGH states that a right to reproduce (since digitisation always means reproduction) cannot be derived from Sec. 52b Copyright Act, yet acknowledges that without an "implied" ancillary right to reproduce a copyright protected work, Sec. 52b Copyright Act would be rendered ineffective. Therefore the BGH declared that in such circumstances Sec. 52a (3) Copyright Act which explicitly allows for reproductions that are made available for instructional or research purposes, shall apply *mutatis mutandis*.

In its preliminary ruling the CJEU had already dealt with the question of whether Article 5(3)(n) of the InfoSoc Directive "must be interpreted to mean that it precludes Member States from granting to publicly accessible libraries covered by that provision the right to digitise the works contained in their collections, if such act of reproduction is necessary for the purpose of making those works available to users, by means of dedicated terminals, within those establishments" (pt. 36). In that respect the CJEU set a narrow frame and stated "that, as a general rule, the establishments in question may not digitise their entire collections" and that such condition "is, in principle, observed where the digitisation of some of the works of a collection is necessary for the purpose of the use by communication or making available, for the purpose of research or private study, to individual members of the public by dedicated terminals", as provided in Article 5(3)(n) of the InfoSoc-Directive (pt. 45-46).

The BGH further confirmed that library users may also print out parts of a digitised work or save

those parts to USB storage devices, as such reproduction will in many case fall within the scope of Sec. 53 Copyright Act that allows for reproduction of a work for private or scientific use. On this point, the CJEU had already confirmed that the interpretation of Art. 5(3) InfoSoc Directive did not limit the scope of Sec. 52b Copyright Act in the sense that it merely permits electronic copies to be displayed and read on an electronic reading terminal without allowing library users to store and print them.

The BGH ruled in favour of the defendant and one may be inclined to hope that it boosts confidence among libraries and public institutions to digitise their collections at least in part. Whether this is justified or whether new uncertainties prevent it, remains to be seen.

---

*To make sure you do not miss out on regular updates from the Kluwer Copyright Blog, please subscribe here.*



This entry was posted on Friday, May 29th, 2015 at 3:43 pm and is filed under Case Law, European

Union, Germany, Limitations, Private copying, Reproduction (right of)
You can follow any responses to this entry through the Comments (RSS) feed. You can skip to the end and leave a response. Pinging is currently not allowed.