

## NEWS FROM GERMANY (PART II) – DEVELOPMENTS IN GERMAN JURISPRUDENCE FROM 2011 UNTIL EARLY 2019

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### INTRODUCTORY REMARKS

This article, which exclusively deals with developments of jurisprudence in Germany, supplements Part I on legislative developments published in the previous year.<sup>1</sup> It follows up on the news from Germany, which covered developments from mid-2005 until the end of 2010.<sup>2</sup> It thus covers a quite long period in which again jurisprudence was abundant. Therefore, this contribution will not only focus on case law of the Federal Supreme Court (BGH) and the Federal Constitutional Court (BVerfG), but will also have to make a selection of the most important cases.

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1. *S. v. Lewinski*, News from Germany (Part I – Legislative Developments in Germany 2011 until the end of 2017, *RIDA* vol. 255, 01-2018, p. 71 ff.

2. *RIDA* Vol. 228, 02-2011, p. 165 ff. and *RIDA* Vol. 229, 03-2011 pp. 204 ff.

## I. SUBSTANTIVE LAW OF AUTHORS' RIGHTS

### 1. Protected works

The most important decision of the BGH regarding works dealt with works of applied art (Geburtstagszug-decision).<sup>3</sup> Before that decision, German jurisprudence had always required for a work of applied art a higher degree of individuality than for other works.<sup>4</sup> In its decision of 2013, the BGH gave up these higher requirements, because the gradual relation that existed between the former design law and authors' rights protection was no longer justified after the introduction of the new design law in 2004 as an independent industrial property right.<sup>5</sup>

In a later judgement on musical works, the BGH made a reference to the judgment in the case 'Geburtstagszug'. The defendant had taken excerpts of around 10 seconds each from several music titles of the plaintiffs, replacing their text by his own rap text. The copied music excerpts were repeated in loops. When considering whether the excerpts were by themselves protected, the court mentioned that the degree of individual expression can be relatively low, as recognized by case law on the so-called 'small coin', but mentioned at the same time that a 'not too low degree of individuality' ('Gestaltungshöhe') should be required for authors' rights protection, and in this context referred

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3. BGH, 13 November 2013, GRUR 2014, 175 – 'Geburtstagszug'; see also MMR 2014, 333, with note *Hoeren*; K&R 2014, 106 with note *Ludwig*.

4. See in particular BGH GRUR 1995, p. 581, 582 – 'Silberdistel'.

5. BGH, 13 November 2013, GRUR 2014, 175 – 'Geburtstagszug', para. 33 ff.

to the ‘Geburtstagszug’-judgement.<sup>6</sup> After the ‘Geburtstagszug’-judgment, it had not been clear whether the BGH would want to lower the requirement for the degree of individuality also for works other than works of applied art or just to adapt the requirement for works of applied art to that for other kinds of works. In the Goldrapper-case, it clarified that it did not intend to further lower such degree of individuality. It also held that regularly, it will be necessary to refer to a musical expert in order to judge the degree of individuality.

As regards characters of a literary work, the BGH in the past had already recognized their protection as part of a literary work only. Moreover, it had recognized an isolated protection of visually represented characters, such as Asterix, if such characters were a unique combination of exterior attributes, characteristics, abilities and typical behaviours so as to form a distinct personality.<sup>7</sup> In the case ‘Pippi Longstocking’,<sup>8</sup> the BGH applied the same principles developed for visually represented characters under § 2(1) no. 4 Authors’ Rights Act (ARA) to characters created as part of a literary work. In that case, a supermarket had advertised for carnival costumes representing Pippi Longstocking (the character created by Astrid Lindgren) in form of pictures widely distributed as part of advertising material. The BGH recognized authors’ rights protection in the literary character ‘Pippi Longstocking’ as such, highlighting the considerable degree of individuality in such cases.<sup>9</sup>

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6. BGH, 16 April 2015 – Goldrapper, ZUM 2015, p. 99, para. 44; MMR 2015, p. 824.

7. BGH 11 March 1993, GRUR 1994, p. 191, 192, on the basis of § 2 no. 1(4) ARA.

8. BGH GRUR 2014, p. 216/para. 29.

9. BGH, op.cit. para. 31.

Furthermore, the BGH held that an artistic action by the artist Beuys may be protected as a pantomime or choreographic work,<sup>10</sup> and that a computer game is protected in any case as a work that is created similarly to a cinematographic work (§ 2 (1)no. 6 ARA).<sup>11</sup> As regards the collection of 400 photographs by Helmut Newton in the coffee table book 'Sumo', which included 73 photographs of earlier coffee table books, the BGH rejected the temptation of indicating a minimum amount of works taken from an earlier collection as a requirement to constitute an infringement of the earlier collection; in line with its earlier case law, it rather focused on the relevant question of whether the selection or arrangement had been reproduced from the earlier books.<sup>12</sup> The personal intellectual creation in a documentary film must rely on the preparation of the topic, the selection and arrangement of the material and the composition of the individual sequences of images.<sup>13</sup>

## 2. Authorship

A US-American professor for psychiatry had written down and reviewed a text. According to her statement, she received it in her active daydreams from Jesus of Nazareth. When the then published text was later used by the defendant, her heirs claimed authors' rights infringement, while the defendant argued that she had herself claimed only being a tool to write the received text. Like the First Instance Court, the Regional Court of Frankfurt

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10. BGH, 16 May 2013, GRUR 2014, 65 with note *Elmenhorst/Jacobs*; NJW 2014, p. 3789 with note *Schulze*.

11. BGH 12 July 2012, GRUR 2013, p. 370, 'Alone in the Dark', note *Hühner*.

12. BGH, 27 March 2013 – 'Sumo', GRUR 2013, p. 1213.

13. BGH, 20 July 2018 – 'My Lai', GRUR 2018, p. 1280, para. 12.

held it was generally recognized that inspirations from the beyond should be attributed without limits to their human recipient; only the creative act rather than the spiritual state of the author (such as hypnosis or trance) did matter. The professor was thus recognized as author.<sup>14</sup>

While under § 8(2) half sentence 1 ARA, co-authors commonly own the rights of publication and exploitation of the work, and under sentence 3 of the same provision an individual co-author may claim any payments only in favour of all co-authors, the BGH held that, as regards the right to claim information in respect of the remuneration right under the so-called best-seller clause (§ 32a ARA), a co-author may claim such information to himself, independently from the other co-authors.<sup>15</sup>

The presumption of authorship under § 10(1) ARA is based on the indication of the author ‘on copies’ of a published work. The BGH held that this condition is fulfilled if a work has been made available in the internet, because this act requires the previous upload of a copy of the work in the way described in § 16(2) ARA, namely by ‘the transfer of the work to devices for the purposes of repeated communication of video- and sound-sequences’; the act of making available is thus based on a ‘copy’.<sup>16</sup> The BGH held furthermore that an indication of authorship may trigger the presumption under § 10(1) ARA only if the general public may recognize the designation as that of

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14. OLG Frankfurt/M., 13 May 2014, MMR 2014, V.

15. BGH, 22 September 2011 – ‚Das Boot‘, GRUR 2011, p. 496 ff. For another decision on co-authorship, see BGH, 23 February 2012, GRUR 2012, p. 1022 – ‘Kommunikationsdesigner’ (note *Jacobs*), according to which distinction must be made between the association of co-authors arising by law through the act of common creation and any association formed by co-authors on the basis of a contract for the purpose of common exploitation of the work.

16. BGH, 18 September 2014, ZUM 2015, p. 391, para. 35.

a natural person and if the designation is made in the usual manner. The designation 'CT-Paradies' would not be understood by the public as referring to a natural person, while the author under the principle of 'creator' (§ 7 ARA) can only be a natural person. The presumption therefore did not apply.

### 3. Moral Rights

In case of the infringement of the right of recognition of authorship (§ 13 ARA), the author may claim compensation of material damage for example on the basis of the fictitious licensing fee (§ 97(2) sentence 3 ARA). Such damage may consist for example in the loss of subsequent jobs. Compensation of immaterial damage may be claimed only in case of substantial infringements that cannot be otherwise compensated.<sup>17</sup> In the case 'Die Hühner', the plaintiffs, musical composers and authors of related lyrics, claimed violation of the integrity right (§ 14 ARA) because their entertaining music was used by a political party, recognized by the Constitutional Court as anti-constitutional, in its pre-election event, in a way that the music was integrated into the event between a talk of a politician and talks with the citizens. The BGH confirmed a violation of the integrity right, which may occur (as in that case) without any modification of the work and only through the kind of use of the work.<sup>18</sup>

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17. BGH, 15 January 2015, GRUR 2015, p. 780 f., in particular paras. 37 ff.

18. BGH, 11 May 2017, GRUR-RR 2018, p. 61; ZUM 2018, p. 50 ff.

## 4. Economic Rights

### a) Distribution Right

German courts had again to deal with the distribution of furniture and lamps.<sup>19</sup> In particular, the BGH had submitted to the Court of Justice of the European Union (CJEU) several questions for preliminary ruling regarding Article 4 (1) of the Directive 2001/29/EC on the distribution right, namely, whether that right covers the offering of copies of works to the public for the purpose of purchase and if so, whether this covers not only contractual offers but also advertising measures. It asked furthermore whether the right is also infringed if the offer does not lead to the purchase of the original or copy of the work.<sup>20</sup> In fact, the defendant in this case, a distributor of furniture with its production seat in Italy, had advertised, on its website and in print media in German language, the sale of copies of furniture by Marcel Breuer, stating that the purchase would be effected in Italy, while the payment would only be done upon delivery in Germany. The CJEU answered all three questions in the affirmative.<sup>21</sup> In its subsequent decision, the BGH implemented this European judgment, observed that the advertising on the German language website and in different German newspapers was directed towards German buyers and that the distribution right under § 17(1) ARA was thus infringed due to the lack of authorization by the right owners.<sup>22</sup> In a parallel procedure

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19. For previous judgements on that topic, see the preceding News from Germany, *op.cit.* (fn. 1), RIDA Vol. 255, 01-2018, 71ff.

20. BGH, 11 April 2013 – ‚Marcel Breuer-Möbel‘, ZUM 2013, p. 882.

21. CJEU case C-516/13 – Dimensione and Labianca Knoll.

22. BGH, 5 November 2015 – ‚Marcel Breuer-Möbel II‘, MMR 2017, p. 67 ff., GRUR-Prax. 2016, p. 201, GRUR 2016, p. 490 ff.

against the same defendant on the advertising of lamps of Wilhelm Wagenfeld directed towards German consumers, the BGH also held that the distribution right was infringed, pointing in particular to the special system of delivery and modalities for payment for German clients in order to affirm a distribution in Germany.<sup>23</sup> In a third, parallel case following the decision of the CJEU, the BGH implemented the decision also as regards the distribution right of a performing artist in his performance recorded on a DVD, which had been offered to the public and advertised for purposes of purchase. The artists' exclusive distribution right was thus infringed through advertising for the DVD on an internet platform. While the distribution right of performing artists has been harmonized in Article 9(1)a of the Directive 2006/11/EC, the BGH applied the ruling of the CJEU on the distribution right of authors under Article 4(1) of Directive 2001/29/EC also to performers, pointing at the corresponding wording of both provisions.<sup>24</sup> Under German law, the rights of related right owners always were interpreted in the same way as those of authors.

Also in an earlier case on Bauhaus-furniture imported from Italy, the BGH had submitted questions for preliminary ruling to the CJEU, which then recognized an act of distribution taking place in Germany and allowing

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23. BGH, 5 November 2015 – ,Wagenfeld Leuchte II', GRUR 2016, p. 487, MMR 2017, p. 68, GRUR-Prax. 2016, p. 202, ZUM 2016, p. 522.

24. BGH, 5 November 2015, GRUR 2016, p. 493 f.; MMR 2017, p. 26; ZUM-RD 2016, p. 285; GRUR-Prax. 2016, p. 203.



criminal sanctions in Germany in the case ‘Donner’.<sup>25</sup> The BGH equally followed the CJEU in this case.<sup>26</sup>

In a case slightly different from the ‘Marcel Breuer-furniture’ case, the BGH had to decide whether the distribution right is also infringed where a chair protected by copyright and designated as a ‘prototype’ is presented at a trade fair for office furniture directed towards professionals, and where the chair was contained in an advertising flyer, describing in which variations the model of the chair would be available, while pointing at possible further changes due to the ongoing development process. In this case, the distribution right was not applicable according to the BGH, because the presentation of a production at an international trade fair could not necessarily be interpreted as a targeted advertising for the purchase of the product domestically, since such trade fairs aim mainly at establishing commercial relations between the producers and international parties; any direct advertising for the domestic market could at least not be established.

Furthermore, the BGH argued that the entire series of chairs designated in the advertising material as ‘prototype’ could not yet be ordered according to the material and that it could still be changed; these facts would show that there was no targeted advertising for the purchase of a specific product. The objection by the plaintiff, that any such changes would usually only refer to details of the product and that in other places of the advertising material the reader gets the impression that the development of the product has been

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25. CJEU, case C- 5/11– Donner; reference to the CJEU: BGH, 8 December 2010, GRUR 2011, p. 227 – Italienische Bauhausmöbel.

26. BGH, 11 October 2012, GRUR 2013, p. 62 f.

achieved at the time of presentation at the fair, was rejected by the BGH simply because it was not related to law but to the facts. However, the arguments of the BGH show that the designation as 'prototype' alone would not suffice to escape the distribution right, but that the fact whether advertising is made for a product that can be distributed would matter.<sup>27</sup>

The BGH had also referred questions for preliminary ruling to the CJEU regarding the exhaustion of the distribution right through offering of software for download from the internet.<sup>28</sup> The well-known CJEU-judgement 'UsedSoft'<sup>29</sup> was followed by a judgement by the Regional Court (OLG München).<sup>30</sup>

### **b) Communication to the Public**

The BGH rendered a number of decisions in respect of communication to the public involving hotels, restaurants, dental practices and hospitals, as well as cable retransmissions in housing complexes. In the case of a hotel, which had supplied its guest rooms with TV-devices equipped with simple room-antenna, the BGH held that the hotel did not communicate to the public the TV-programs.<sup>31</sup> The guests could directly receive, via the room-antenna, the digital terrestrial TV-program (DVB-T) without any transmission

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27. BGH, 23 February 2017 – Mart-Stam-Stuhl, ZUM-RD 2017, p. 461 f.

28. BGH, 3 February 2011, GRUR 2011, p. 418 f. (note *Scholz*); ZUM 2011, p. 397 f. (note *Paul*).

29. CJEU case C-128/11.

30. See on that judgement and further judgements on this topic, *von Lewinski*, op.cit (fn. \*). (A&M 2015/2, p. 166ff.).

31. BGH, 17 December 2015, GRUR 2016, p. 697.

made by the hotel. The simple supply of devices that allow a communication is not a communication itself according to the BGH, which also referred to the relevant case law of the CJEU. Unlike the Appellate Court, which had recognized an act of communication to the public, the BGH focused on the technical question of whether the hotel made a separate transmission in addition to the supply of the devices. The BGH also mentioned that the CJEU had affirmed a communication to the public, where a hotel owner had supplied the guestrooms with devices for communication on the basis of phonograms and with phonograms,<sup>32</sup> but the BGH seemed to distinguish that case from the simple supply of devices that allow reception by room-antennas. This distinction does not necessarily seem entirely convincing, but the BGH considered that a question for preliminary ruling to the CJEU was not necessary.

The influence of the CJEU's judgement 'Marco Del Corso'<sup>33</sup> denying a communication to the public in a small dental practice has been immediate in Germany. The BGH followed this case, mainly pointing at the CJEU's argument that regularly, patients are a rather stable group rather than persons in general and the number of persons listening at the same time is, also in the case before the court, quite limited. The BGH did not follow the argument that regularly, any person may pass by and ask for a treatment, so that the group consists of persons in general, and that dental practices are often crowded with people.<sup>34</sup> The 'Marco Del Corso'-case, which changed the law in Germany, led to the cancellation of the license agreement of dentists with

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32. CJEU, case C- 162/10– PPL/Ireland.

33. CJEU, case C-135/10.

34. BGH, 18 June 2015, MMR 2016, p. 199; ZUM-RD 2016, p. 166.

the collecting society GEMA. This case shows that authors in Germany are losing money due to the judgement of the CJEU, followed by the BGH. Also did the 'Marco Del Corso'-decision influence the notion of 'public' in a case held by the Regional Court Frankfurt, where a broadcast had been shown to the approximately 20 persons who were members of a dart club.<sup>35</sup> Unlike courts that previously had applied the definition of 'public' under § 15(3) ARA, the OLG Frankfurt did no longer ask whether the persons present were personally related to each other or to the organizer (which may or may not be the case of members of a dart club), but whether the relevant group of persons were persons in general or, as the court considered in this case, rather of a particular circle that remains stable.

It is not surprising that other users of broadcasts got inspired both by the 'Marco Del Corso'-case and the just mentioned BGH-case implementing the European judgement. In particular, a hospital which offered patients in their rooms the possibility to listen to radio through retransmission of broadcasts wanted to cancel its licensing agreement with GEMA on the basis of a change of a standing jurisprudence. However, the BGH held that in this case the hospital did perform a communication to the public via its own cables, since that case had to be distinguished from that of 'Marco Del Corso'. In particular, the hospital did not only communicate by a loudspeaker radio broadcasts to a waiting room, but retransmitted by technical means radio broadcasts to 49 rooms for patients who could choose whether or not to listen to the programs.

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35. OLG Frankfurt, 20 January 2015, ZUM-RD 2015, p. 296.

The BGH thus held, in compliance with the case law of the CJEU, that the hospital performed a communication to the public.<sup>36</sup>

Another situation in which the jurisprudence of the CJEU has worsened the situation of right owners in Germany is the simultaneous, unchanged and integral retransmission by cable of satellite signals received by a community antenna of a housing complex to the individual devices of the owners of the apartments.<sup>37</sup> The BGH in this case extensively referred to the underlying European law as interpreted by the CJEU, recognized a ‘communication’ but denied it being directed to a ‘public’, because it was directed to the specific group of owners of the apartments of the community rather than to an undetermined number of potential receivers or persons in general.<sup>38</sup> The fact that the broadcasts were retransmitted to 343 apartments alone did thus not matter to the BGH, which followed the criteria of the CJEU of ‘persons in general’. Although at least 700 persons lived in these 343 apartments and received guests or in part moved in or out, so that the number of persons could not be determined, the inhabitants of the apartments were considered specific persons characterized by particular features. The argument of the BGH, according to which the apartments were only open to their inhabitants, so that a comparison may not be made to the CJEU-cases regarding hotel guests who are considered persons in general, does not necessarily seem convincing. Furthermore, the BGH referred to the criterion of the CJEU of a ‘private group’, which was larger than the term used in the German definition of ‘public’ in § 15(3) sentence 2 ARA, which refers to the personal relations

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36. BGH, 11 January 2018, GRUR 2018, p. 608.

37. BGH, 17 September 2015, GRUR 2016, p. 71 f.

38. Op.cit. paras. 60 ff.

among the members of a group or between them and the event organizers. The BGH therefore considered that the inhabitants of the housing complex may be considered as a 'private group', even if they may not have any personal relations among each other. At the end of the judgment, the BGH revealed what might have been its main motivation for that somehow astonishing argumentation: it compared the situation of that case with a hypothetical one, where each owner of an apartment would install a separate antenna for his own apartment and would retransmit the signals by cable to the devices in his apartment, in which he would not perform a communication to the public but to specific persons of a private group. Since all owners of apartments in the end would retransmit the broadcasts only to themselves, they would do so only to specific persons of a private group.

As regards internet-related uses, a number of very important cases were decided as regards linking/framing, search engines, thumbnails, uploads/downloads and the so-called online-exhaustion.<sup>39</sup> First, it had been the BGH who had referred to the CJEU the question for a preliminary ruling in the case of 'BestWater', in which it suggested to the CJEU that the case of framing would have to be distinguished from linking, which the CJEU had considered not being a communication to the public in the circumstances of the case 'Svensson'. While the BGH considered that framing in the given case was not an act of making available within the meaning of § 19a ARA, because only the owner of the website to which the link was made could decide whether the work would remain available to the public, it considered that the act could

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39. On questions of primary and secondary liability of intermediaries such as YouTube, see below, VII..

be covered by the general clause on the right of exploitation of works in non-tangible form through communication to the public in the broad sense under § 15(2) ARA. The BGH still submitted the question to the CJEU, since it considered that this broad right would have to be interpreted in line with Art. 3(1) Directive 2001/29/EC. This latter consideration seems questionable, since this broad right of exploitation in non-tangible form has not been harmonized in Europe, all the more since it would have touched upon fundamental systematic differences between the continental European and the Anglo-Saxon system. In the latter, i.e., in the UK and Ireland, copyright is limited to the rights specifically mentioned in the law, while in the continental European countries, authors are protected as a matter of principle in all ways of exploitation in tangible and non-tangible form, which are then specified by examples but remain open to future developments.<sup>40</sup>

As is well known, the CJEU did not follow the suggestion of the BGH, which had clearly pointed out that framing would be a communication to the public in its opinion.<sup>41</sup> Rather the CJEU considered framing, without further argumentation and by referring to the previous case law on linking as not being directed to a new public and therefore not constituting a communication to the public.<sup>42</sup> The BGH thereafter in principle followed the CJEU-decision.<sup>43</sup> However, it then focused on the question of whether there was a ‘new public’

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40. For this distinction see, e.g., *von Lewinski*, International Copyright law and Policy (Oxford 2008), no. 3.56 – 3.57.

41. BGH GRUR 2013, 818 - Die Realität; GRUR-Prax. 2013, 207.

42. On criticism of this approach, and on the conflict of criteria such as ‘new public’ with the underlying international law, see the ALAI opinion at <http://www.alai.org/en/assets/files/resolutions/2014-opinion-new-public.pdf>.

43. BGH, 9 July 2015 – Die Realität II, MMR 2016, 190 f. (note *Dietrich*); ZUM 2016, p. 370 f. (note *Fuchs/Farkas*).

as established by the CJEU where, as in this case, the same technical means (internet) had been used. The defendants had linked to the relevant film on the platform YouTube, where, according to the plaintiff, the film had been uploaded without his consent. The BGH understands this 'new public' criteria according to the CJEU in the sense that there is a 'new public', if the right owner had not permitted the upload on the site to which the link is put and confirms this view by pointing at the CJEU's formula, according to which the 'new public' is one that the right owner does not have in mind when he allows the first communication.<sup>44</sup> The BGH explicitly leaves the question open whether the right owner could restrict his permission by indications on the original website, because there were no such indications in the case to be judged. In an *obiter dictum*, the BGH however argues in favour of such a right of the right owner to restrict its permission, because otherwise the public communication right would be factually exhausted in the internet upon the first legal act of making available, which would contradict Article 3(3) of the Directive 2001/29/EC and would prevent him from exploiting his work and securing an equitable remuneration for its use in the internet.<sup>45</sup> Consequently, the BGH referred the matter back to the Appellate Court in order to establish whether the right owner had agreed to the upload of his work on the platform YouTube. The BGH did also not consider necessary any new referral to the CJEU on the question of whether an act of communication to the public occurs in case of linking to a website on which works were uploaded without the permission of the right owner – a question that at the time was referred

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44. Op.cit., para. 34.

45. Op.cit., para. 35; the BGH there also explicitly refers to the ALAI opinion of 17 September 2014 on the criterion 'new public' p. 15, [www. http://www.alai.org/en/assets/files/resolutions/2014-opinion-new-public.pdf](http://www.alai.org/en/assets/files/resolutions/2014-opinion-new-public.pdf).



to the CJEU by the Supreme Court of the Netherlands.<sup>46</sup> Since the factual question had to be clarified anyway first, the BGH nevertheless directly referred the matter back to the Appellate Court.

The Appellate Court, the OLG München,<sup>47</sup> then found that the plaintiff had not proven that it had not agreed with the upload of the film on the platform YouTube. The case was thus decided on the basis of the rules on evidence and burden of proof. Consequently, a right owner who does not agree to uploads of his work on a third person's website (and therefore wants to avoid also links to the latter website) must, upon knowledge about such uploads, also take action against the third person's website and document it.

The BGH also submitted questions for preliminary ruling to the CJEU in the equally famous case 'Cordoba' (Renckhoff).<sup>48</sup> In that case, a schoolgirl had downloaded a photograph of the city Cordoba from a publicly accessible website, where the photograph had been uploaded with the right owner's consent, and subsequently uploaded the photograph together with its own seminar paper on the school's website without authorization of the right owner. According to the BGH, the element of 'new public' was questionable according to the criteria of the CJEU, because the same technical procedure had been used (the internet) and the work on the original website had been uploaded with the right owner's consent, so that according to the case law on linking/framing of the CJEU, a 'new public' (and thus a communication to the public) would not seem to exist. The BGH however added that it

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46. Case C-160/15 – GS Media; Question 1a).

47. OLG München, 25 August 2016, ZUM 2016, p. 993.

48. BGH, 23 February 2017, GRUR 2017, 514.

considered that the interpretation of the CJEU of the communication right was not applicable to the case at hand. In particular, unlike in the linking cases, the CJEU's argument that linking contributes to the good functioning of the internet and to the exchange of information did not apply to the case of uploads of works without the authorization of their right owners. In upload cases, the interest protected by the intellectual property right under Article 17(2) EU Charter of Human Rights would prevail over the interest protected by Article 11 thereof on freedom of expression.<sup>49</sup> It also focused on the central role of the user in the upload case, who decides on whether the work remains accessible to the public on his website. In addition, the BGH pointed at the otherwise factual exhaustion of the public communication right, which would be contrary to Article 3(3) of the Directive 2001/29/EC, and it referred to further arguments expressed in the above mentioned case 'Die Realität II'.<sup>50</sup> The BGH thus affirmed a 'new public' and, importantly, clearly stated that the act of public communication does not need to be for profit making purposes in order to constitute a communication to the public – which was important, since the school girl did not act for profit making purposes. By referring to the CJEU's cases *Football Association Premier League* and *Reha Training*, it stated correctly that this criterion may have an impact on the possible remuneration for the use but is 'with certainty' non-decisive for the act of a communication to the public.<sup>51</sup> This time, the CJEU decided in favour of a communication to the public.<sup>52</sup>

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49. *Op.cit.*, para. 35.

50. *Op.cit.*, paras. 36-37.

51. *Op.cit.*, para. 39.

52. Case C-161/17, *Land Nordrhein-Westfalen v. Dirk Renckhoff*.

The so-called online exhaustion had been subject to a number of judgements, first in the context of computer software based on the Software Directive 2009/24/EC. In particular, the BGH had referred several questions to the CJEU in the well-known case ‘UsedSoft’.<sup>53</sup> In continuation of the CJEU’s ‘UsedSoft’-decision and its own implementing judgement, the BGH held later in particular that such exhaustion of the distribution right in copies of a computer program applied, irrespective of whether the right owner had agreed to the sale of a number of tangible copies or to the reproduction of such number of copies by download and the making of copies on that basis. It furthermore decided that such exhaustion applied irrespective of any restriction of the license granted, if a copy of a computer program had been put into circulation with the consent of the right owner by transfer of property.<sup>54</sup> Following the CJEU’s decision ‘UsedSoft’, several proceedings were brought to German courts regarding other works, in particular e-books and audio-books. All courts clearly and correctly rejected the application of the ‘UsedSoft’-judgment of the CJEU to works other than computer software. They applied the right of making available rather than the distribution right to the making available of such works online, thereby simply applying the clear distinction in German law (also existing in most other laws and in international treaties and European directives) between exploitation in intangible form and in tangible

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53. BGH, 3 February 2011, GRUR 2011, p. 418 f. (note *Scholz*); ZUM 2011, p. 397 f. (note *Paul*); for the CJEU see case C-128/11. For these cases see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/2, p. 166ff.

54. For more details, see BGH 11 December 2014 – UsedSoft III, ZUM 2015, p. 688 f. See also a judgment of the Kammergericht Berlin of 10 August 2015 (ZUM RD 2016, p. 182 f.), according to which a first sale of a copy of a computer program according to Art. 4(2) of Directive 2009/24/EC does not occur where the part of the program codes that are necessary for the use of a computer game always remains on the servers of the platform operator and is made available, on the basis of the existing contract, for the user only during the time of gaming online.

form. They also referred to the prohibition of online-exhaustion under Article 3(3) Directive 2001/29/EC, and in part applied the reproduction right, which also does not exhaust.<sup>55</sup> This interpretation not only of the German law but also of the EU directives methodically seems to be the only correct one, as the clear and intelligible judgments, just mentioned, show. However, the CJEU will have to decide on that question;<sup>56</sup> one should hope that the CJEU will not (as it did in *UsedSoft*) render unclear a so far – at least according to German jurisprudence – clear legal situation.

Thumbnails have continued to occupy the BGH after the first decision of 2010.<sup>57</sup> While in that first decision, images had been made available by right owners without technical protection measures and were automatically referenced to by the ‘images’-service of Google, images automatically referred to by that service in the second case had first been made available by a third person, in part with the consent of the author and without technical protection measures and in part by third persons without his consent. In both variations, following and extending its first decision of 2010, the BGH on the one hand recognized that Google had made available to the public the images in form of thumbnails, but held that the right owner had implicitly consented to the act (without licensing it) and thereby rendered it legal. The extension of its statement in the first thumbnail case to images made available

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55. OLG Stuttgart, 3 November 2011 (final), GRUR-RR 2012, p. 243 f.; ZUM 2012, p. 811 f.; LG Hamburg, K&R 2012, p. 297 f., OLG Hamburg, ZUM 2015, 503 f.; LG Bielefeld, ZUM 2013, 688 f., in particular 692-694; OLG Hamm, GRUR 2014, 853 f. and ZUM 2014, 715 f.; s. also *von Lewinski*, op.cit. (fn. \*), A&M 2015/2, p. 167ff.

56. See questions for preliminary ruling in case C-263/18– Tom Kabinet and, for example, opinion by ALAI of the 12<sup>th</sup> October 2018, <http://www.alai.org/en/assets/files/resolutions/181012-opinion-tom-kabinet-case-en.pdf>.

57. BGH, 29 April 2010, Vorschaubilder GRUR 2010, p. 628; see also *von Lewinski*, op.cit. (fn. 2) RIDA Vol. 228, 02-2011, p. 241ff.

by persons without the right owner's consent was still justified by the BGH by 'protestatio facto contraria'.<sup>58</sup> According to the Court, such engines that automatically search for images cannot distinguish between images made available with or without the consent of the right owner, and the person making available images without technical protection measures would have to be aware that such references would occur. While this way of arguing could already be criticized, this is all the more true for the third decision of the BGH on thumbnails, where none of the images at stake had been made available by the right owner with his consent. Also, the defendant was not Google, where the thumbnails were made available, but AOL, which made use of the services of Google.<sup>59</sup> Here, the right owner had made available images only to his registered clients against payment and use of a password. The clients were not allowed to make available these images on any freely accessible websites, which some of them nevertheless did. The BGH held in the first place that the defendant, who should have proven that the plaintiff would have permitted the making available without any restrictions but had not managed to do so, had committed a communication to the public by showing the thumbnails on its website. Still, the BGH argued that the defendant could not know that the images had been accessible without the authorization of the plaintiff. It thereby seemed to deviate from the presumption of knowledge established by the CJEU, according to which someone acting for profit is presumed to know the illicit character of works.<sup>60</sup> The reasoning of the BGH seems to show that it wanted to arrive at the result that there was no infringement

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58. BGH, 19 October 2011, GRUR 2012, p. 602 ff.; MMR 2012, p. 383 ff. (note *Spindler*).

59. BGH, 21 September 2017, Vorschaubilder III GRUR 2018, 178; see also *von Lewinski*, *Encore des privilèges pour les moteurs de recherche*, *Dalloz IP/IT - Droit de la propriété intellectuelle et du numérique*, 2018, 444.

60. *GS Media*, Case C-160/15.

by the operator.<sup>61</sup> This jurisprudence, including the CJEU's 'BestWater'-decision, largely deprives in particular photographers and other visual artists of their main possibilities to exploit their works on the internet: in particular, professional photographers regularly need to make available to the public their photographs without any technical protection measures in order to reach possible clients. At the same time, the just mentioned jurisprudence seems to force them to apply technical protection measures (TPMs) in order to be able to object to framing. The BGH seems not so certain about the hypothesis that the CJEU would consider the application of TPMs as a means to maintain the communication right, if an author has uploaded his works with his consent. Most recently, it submitted to the CJEU the question of whether framing (of a work legally uploaded on the original website) is a communication to the public if it has been made by circumventing TPMs against framing.<sup>62</sup> The situation of visual artists has led the European Parliament to introduce an amendment to the Digital Single Market Directive, according to which image search engines would have been deemed to perform an act of communication to the public and thus been subject to the need to acquire a license.<sup>63</sup> However, there may not have been sufficient time to convince also the Commission and Council during the trilogue of the importance of this proposal, which was not adopted in the final version of the DSM Directive.

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61. For criticism of these decisions, see *von Lewinski*, op.cit., (fn. 61); *Schierholz*, Die Probleme der Rechtsprechung mit dem Framing – Anmerkung zum BGH, 21 September 2017, ZUM 2018, p. 135 f.

62. BGH 25 April 2019 – I ZR 113/18.

63. See Art. 13(b) of the Text adopted on 12 September 2018 in first reading by the European Parliament, [http://www.europarl.europa.eu/doceo/document/TA-8-2018-0337\\_EN.pdf?redirect](http://www.europarl.europa.eu/doceo/document/TA-8-2018-0337_EN.pdf?redirect).

## 5. Limitations and Exceptions

### a) Reporting on Current Events (§ 50 ARA)

In line with its previous jurisprudence, the BGH held that the exception in case of use of works for the purpose of news reporting, in accordance with the purpose of the provision, only applied as long as the reporting related to news of the day. In case of reports on current art exhibits, including reproduction of art works, this exception did no longer apply to the online making available of the reports (including art works) in an online-archive when the exhibit could no longer be considered as news of the day.<sup>64</sup> Subsequently, the defendant submitted a complaint before the Constitutional Court on the basis of a violation of the freedom of the press by this decision of the BGH. The Constitutional Court, however, rejected the acceptance of the complaint, because the balancing of the freedom of the press and the authors' right was already clarified and the complainant did not have any chance of success. In particular, the fundamental rights of freedom of the press on the one hand and of property of the author on the other hand had already been balanced within the framework of § 50 ARA and its interpretation by the BGH was not subject to doubt.<sup>65</sup> Accordingly, publishers who want to make available online works that had once been news of the day but are no longer so, will have to acquire a license for the continued use in online archives.

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64. BGH, 5 October 2010, GRUR 2011, 415.

65. Constitutional Court, order of 17 November 2011, MMR 2012, p. 177 f.

In a different case, the supplier of an electronic TV-program guide financed by advertising could not, according to the BGH, rely on § 50 ARA when using text and images by broadcasting organizations, by downloading and making those works available without the consent of the broadcasters in the context of its own electronic TV-program guide.<sup>66</sup> Furthermore, in a case, where § 50 ARA could possibly apply, the BGH submitted to the CJEU several questions for preliminary ruling, asking in particular whether the application of the exception for the purpose of news reporting could be denied on the grounds that the user, in that case a press publisher, was able and it would have been reasonable for him to obtain permission by the right owner before making available the work.<sup>67</sup> The BGH has always considered that the exception on news reporting according to its purpose was not justified where such permission could be obtained timely.<sup>68</sup> In the framework of this case, the BGH also referred to the CJEU the question of whether under the quotation exception (harmonized by Article 5(3) d) of Directive 2001/29/EC) the condition that the work had already lawfully been made public means that the work had already been published with the consent of the author in the concrete shape in which it is quoted. The BGH argues in favour of such interpretation. In the same case, in which the plaintiff, a politician who was a candidate for the German parliament, was accused by the defendant of using his author's right in order to prevent news reporting on his former statements which would not be favourable for him, the BGH saw a reason for further, more fundamental questions regarding the scope of

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66. BGH, 27 March 2012, MMR 2012, p. 755, §§ 24, 25.

67. BGH, 27 July 2017 – Reformistischer Aufbruch, GRUR Int. 2017, p. 982 f., also known as the CJEU-case ‚Spiegel online‘; see case C-516/17 (pending).

68. Op.cit., para. (41).



regulation of exceptions under Article 5(3) of Directive 2001/29/EC and the possible impact of fundamental rights in this context. In particular, it asked whether this European provision leaves room for implementation in national law, and in which way the fundamental rights under the EU Charta have to be taken into account when determining the scope of this provision; according to jurisprudence of the Constitutional Court, national provisions implementing a European directive are not to be measured against the fundamental rights of the German constitution but only according to the EU Charta, if the directive does not leave any room for implementation. The BGH considers that Article 5(2)-(4) of Directive 2001/29/EC provides for a closed list of exceptions and limitations and following the CJEU-case ‘Deckmyn’, that there is no room for implementation once a member state decides to provide for a limitation. Looking at the development of Article 5 of Directive 2001/29/EC, however, the legislator always had considered that Article 5 only sets the outer limits for permitted exceptions and limitations which thus could be implemented, within this framework, in various ways.<sup>69</sup> Despite its own statement that Article 5(2)-(4) of Directive 2001/29/EC contains a closed list of exceptions, the BGH still asked in addition whether the fundamental rights of information and freedom of the press (Art. 11(1) sentence 2 and Art. 11(2) EU Charta) would justify any limitations or exceptions beyond the closed list. This idea seems contradictory in itself, given the clear intention of the European Union in 2001 to harmonize the outer framework of limitations, by integrating the different fundamental rights into concrete provisions; any direct application of fundamental rights to justify further exceptions would intervene in the legislature’s competence and create a high degree of legal uncertainty, and this

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69. *Walter/von Lewinski* European Copyright Law: A Commentary, Oxford 2010, no. 11.5.9.

was never envisaged by legislature. The BGH also put the same three general questions to the CJEU, regarding a case where a newspaper publisher had published military reports of the German army in Afghanistan that had been sent only to selected persons of the German parliament and were qualified as 'restricted',<sup>70</sup> and in the case *Metall auf Metall* dealt with below.<sup>71</sup>

### **b) Incidental uses (§ 57 ARA)**

Under § 57 ARA, it shall be permissible to reproduce, distribute and communicate to the public works that are incidental to the actual subject matter being used. The plaintiff, a painter of a canvas, had agreed with the defendant, a producer of furniture, that the canvas could be exhibited together with the furniture. The plaintiff, however, later objected to the distribution and making available of a photograph of furniture in the sales exhibition, where also his painting could be seen. The BGH held that a work is incidental in the meaning of § 57 ARA if it could be deleted or exchanged without affecting in any way the overall impression of the main subject matter, and without being noticed by an average person. In addition, it is incidental if it does not have any relation whatsoever with the main subject matter but is placed there mainly randomly and by chance. However, it is not incidental if it clearly contributes to the style or atmosphere or reinforces a certain effect of the main subject matter or its characteristic (for example for a film or theater scene).<sup>72</sup> This decision has been the first in which the BGH has focused on

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70. BGH, 1 June 2017, MMR 2017, p. 680 f.; GRUR 2017, p. 901 f.; ZUM 2017, p. 753 f. See already the Advocate General's opinion on this case C-469/17.

71. See III.2. below.

72. BGH, 17 November 2014, GRUR 2015, p. 667 f. – *Möbelkatalog* (note *Stang*).

§ 57 ARA. It rejected the broad interpretation of § 57 ARA by the lower instance courts by indicating strict criteria for the application of § 57 ARA and thus fixes a rather narrow scope thereof.

### **c) Works at public places (§ 59 ARA)**

Under § 59 ARA, works may be reproduced, distributed and made available to the public without the author's consent, if they are located permanently in public roads and ways or public open spaces. These latter conditions were interpreted by the BGH as meaning, in particular, that works are located 'in' public roads, etc., if they can be seen from such public roads, etc., irrespective of whether they are accessible to the public. In a case where a photograph showing the so-called 'AIDA kissing mouth' decorating a cruise ship had been made available to the public on a website offering excursions by cruise ships, the BGH further held that the terms 'roads and ways or public open spaces' were only examples and would also cover any open air places, and they would be 'public' if they were accessible for anyone, irrespective of being or not in private ownership. In addition, if the work changes its location, it is still in 'public roads' etc., if the various places are public. As to the criterion of a 'permanent location' at public places etc., it is fulfilled according to the BGH if the work, from the point of view of the general public, is meant to remain for a longer, mostly undefined period of time at such public places. This was the case of the ship with the painting, which was meant to cruise for an undetermined time on the sea and stop at different public places.<sup>73</sup>

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73. BGH, 27 April 2017, MMR 2017, p. 747 f.; ZUM 2017, p. 766 f. For cases on quotation under § 51 ARA, see von Lewinski, *op.cit.* (fn. \*), A&M 2015/3-4, p. 240.

**d) Terminal uses in public libraries (former § 52b ARA)**

On the basis of the (no longer valid) § 52b ARA on making available of works at dedicated terminals in public libraries, the BGH had referred a number of questions for preliminary ruling to the CJEU in the case 'TU Darmstadt'.<sup>74</sup> After the CJEU had decided this case (case C-117/13), the BGH followed it in its final judgement.<sup>75</sup> The BGH also decided a case on intranet uses in universities based on § 52a ARA, which in the meantime also has been repealed and replaced by new provisions.<sup>76</sup>

**e) Reproduction of One's Private or Other Own Use and Related Remuneration**

The system of the exception for private reproduction combined with a remuneration right is often praised and even proposed as a model for other utilizations, in particular in the internet. However, one should not forget that throughout its history, this system of a legal license has raised an enormous number of legal proceedings, often taking many years before right owners could receive the relevant remuneration. Also in the period covered in this article, the BGH alone had to decide many cases. In particular, the BGH held

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74. BGH, 20 September 2012, GRUR 2013, p. 503 f.; MMR 2013, p. 529 f.; GRUR Int. 2013, p. 479 f.; ZUM 2013, p. 401 f.

75. BGH, 16 April 2015, MMR 2015, p. 820 f.; see also critical remarks by *B. von Becker*, BGH: Elektronische Leseplätze II, GRUR-Prax. 2015, p. 438; see also a subsequent order of the BGH of 10 December 2015, ZUM-RD 2016, p. 361 f.; on the questions by the BGH to the CJEU in this case, see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 241. On the Regional Court preceding the BGH's judgement, see *von Lewinski*, op.cit. (fn. 1), RIDA Vol. 255, 01-2018, p. 110.

76. BGH, 28 November 2013, ZUM 2014, p. 524 f.; MMR 2014, p. 616 f.; see on that case also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 241 f.

that the limitation under § 53(1) ARA also allowed reproduction for private purposes of unpublished works, since the wording did not distinguish between published and unpublished works and the BGH did not see any compelling reason to reject the application to unpublished works.<sup>77</sup> Also, in respect of the relevant provision valid until the end of 2007, the BGH clarified several issues regarding audio-visual reproduction on PCs for one's own use and reacted to some aspects of the CJEU's *Padawan*-decision. Several aspects of this judgement are also relevant for the current rules on remuneration for private use.<sup>78</sup> Also the question of a remuneration for private reproduction by printers and plotters had been meandering for many years, even after a first judgment of the BGH in 2007, which was followed by a Constitutional Court decision in 2010 and questions by the BGH submitted to the CJEU,<sup>79</sup> again followed by the final decision of the BGH in 2014.<sup>80</sup> The BGH also decided a case on operators of copying machines, who are subject to a payment obligation under § 54(1) of the current ARA (and were so under the previous law), stating that devices that are, according to their nature, designed for reproduction for one's private or other own use are presumed to be so used, which is sufficient to apply this provision; however, the debtor of the remuneration may rebut the presumption by showing that in fact, the devices are not or only to a minimal extent used for the relevant reproduction.<sup>81</sup>

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77. BGH, 29 March 2014, GRUR 2014, p. 974 f.

78. BGH, 30 November 2011, ZUM 2012, 567; for a detailed presentation, see *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 237 f.

79. BGH, 21 July 2011 – Drucker und Plotter II, GRUR 2011, p. 1007 f., and cases C-457/11 to C-460/11 of the CJEU.

80. BGH, 3 July 2014, GRUR 2014, p. 979 f. On the details of this case, see *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 238 f.

81. BGH, 9 February 2012, GRUR 2012, p. 1017 f.; ZUM 2012, p. 895 f.; GRUR 2012, p. 389 f. and, for more detail, *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 239.

The BGH clarified more aspects of the remuneration for private use under §§ 54, 54b ARA. Accordingly, the amount of remuneration due for devices corresponds to the harm caused by the use made by the relevant device under the private copy limitation. This harm is measured according to the equitable remuneration that users would have had to pay for a permission for the acts of private reproduction, had there been an exclusive right. The remuneration also has to be paid if works are downloaded from the internet and the right owner had agreed to the download, unless he had received a remuneration for such copy. In any case, copies made on the basis of the downloaded copy are subject to the remuneration. The remuneration also applies when the reproductions are made on the basis of CDs or DVDs equipped with an ineffective technical protection measure.<sup>82</sup> Under § 54a (4) ARA, the remuneration shall not have an inequitable effect on the manufacturers of devices and storage media and its relationship to the price level thereof must be economically equitable. According to the BGH, the remuneration would not fulfill these criteria if the possible users of devices or storage media would buy them to a considerable extent in foreign countries, where the price is lower because there is no or a lower remuneration for such devices or such media.<sup>83</sup> The BGH confirmed and supplemented the latter aspect in a subsequent judgement. Accordingly, manufacturers of such devices and media would also be inequitably affected, if they could not fully pass on the remuneration via the price of the devices and media to be paid by the users, because the latter would otherwise not buy them, given the inadequate relationship between the remuneration and the price of the device or medium.<sup>84</sup>

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82. BGH, 19 November 2015, GRUR 2016, p. 792 f.

83. Idem.

84. BGH, 21 July 2016, GRUR 2017, p. 161 f.

The BGH had to apply the former version of the remuneration right (valid until the end of 2007) to mobile phones as devices subject to remuneration. It held that mobile phones and certain memory cards for insertion in mobile phones were covered by the remuneration right if the integrated or insertable memory cards had a capacity of at least five MB and announcements, guides, test reports or press publications referred to the possibility of storing and playing musical works. It also applied the then valid annex on the relevant amount of remuneration.<sup>85</sup> In a case related to USB-sticks and memory cards, the BGH held that they were subject to the remuneration right, even if there is no valid tariff or inclusive agreement.<sup>86</sup>

## II. LAW ON AUTHOR'S CONTRACTS

### 1. Different Aspects of Licensing

In respect of a case where a musical work covered by a license possibly did not qualify as a protected work, the BGH held that the contract was subject to extraordinary notice of cancellation, but remained effective until cancellation. At the same time, the BGH considered as permissible any contractual stipulation such as that on the burden of proof regarding the qualification as a protected work.<sup>87</sup>

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85. BGH, 21 July 2016, GRUR 2017, p. 172 f.; see also BGH, 18 May 2017, ZUM-RD 2017, p. 641 f., according to which mobile phones that can only store ringtones were not covered by the old version of the remuneration right.

86. For more detail, see BGH, 18 May 2015, GRUR-RR 2017, p. 486 f., ZUM 2018, p. 185 f. For further judgements on the remuneration right for storage media, including PCs with integrated hard drive, see BGH, 16 March 2017, MMR 2018, p. 175 f., BGH, 16 March 2017, ZUM-RD 2017, p. 445; BGH, 16 March 2017, ZUM-RD 2017, p. 436 f. and BGH, 14. December 2017, ZUM 2018, p. 364 f.

87. BGH, 2 February 2012 – Delcanto Hits, GRUR 2012, p. 910; ZUM-RD 2012, p. 514; for details see *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 242.

In 2009, the BGH had decided about the fate of a sublicense if the main license was no longer effective, because it had been revoked due to non-exercise of the right.<sup>88</sup> The BGH thereafter clarified that it protected the sublicense not only in cases of revocation based on § 41 ARA, but also in other cases, in particular, where an exclusive license had become ineffective due to consensual termination, and in case of a non-exclusive license.<sup>89</sup>

The 'purpose-of-grant-rule' under § 31(5) ARA (*Zweckübertragungslehre*), according to which any grant of rights in kinds of uses that are not explicitly and individually mentioned in the contract is limited to those uses that are covered by the purpose of the contract according to the intentions of the parties, is a key interpretation rule in favour of authors under German authors' rights contract law. Nevertheless, the BGH did not recognize it as a model (*Leitbild*) in the framework of the so-called control of the contents (*Inhaltskontrolle*) of standard form contracts.<sup>90</sup> Just as the BGH thus considered § 31(5) ARA as a mere interpretation rule rather than a model expressing an overall concept in the framework of the above mentioned provisions on standard form contracts, it also did so regarding §§ 88 ff. ARA on film contracts and § 11 sentence 2 ARA,<sup>91</sup> so that the provisions on

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88. BGH, 26 March 2009, GRUR 2009, p. 946 – ReifenProgressiv; see for more detail von Lewinski, op.cit. (fn. 2) RIDA Vol. 229, 03-2011, 213ff.

89. BGH, 19 July 2012 – Take 5, GRUR 2012, p. 914, and BGH, 19 July 2012 – M2Trade, GRUR 2012, p. 916; see for more detail von Lewinski, op.cit. (fn. \*), A&M 2015/3-4, p. 243, also regarding further issues (fallback of the right of use *ipso iure*; questions of remaining licensees).

90. §§ 307 ff. Civil Code/BGB (the contents of such contracts may be verified against provisions recognized as such models; see BGH, 31 May 2012, GRUR 2012, 1031, and for more detail, von Lewinski, op.cit. (fn. \*), A&M 2015/3-4, p. 243.

91. BGH, 31 May 2012, GRUR 2012, p. 1031, and BGH, 17 October 2013, I CR-41/12 Rechteeinräumung Synchronsprecher.



standard form contracts will mostly not be helpful to authors who had to agree to buy-out contracts.

Furthermore, in a case where in principle French law on authors' rights and contracts was applicable, the BGH considered that § 31(5) ARA was not an internationally overriding mandatory provision under Art. 34 EGBGB (which preceded the provisions of the Rome I-Regulation 593/2008 and still applied to the contract of the 2003 subject to this case).<sup>92</sup> The lower instance courts had however recognized such overriding mandatory character of § 31(5) ARA.

## **2. Additional Payment under the 'Fairness Compensation'**

Where an author (or a performer) has granted a license upon conditions resulting in a striking disproportion between the agreed remuneration and the benefits from the use of the work or performance, he may claim from his contractual partner the consent to modify the contract in order to obtain an additional, equitable participation, whether or not the parties could have foreseen the amount of benefits from the use of the work (§ 32a ARA). The BGH applied this rule to a dubbing actor (who had dubbed Johnny Depp in the films 'Fluch der Karibik I-III'), thereby rejecting the argument of the Regional Court that that actor had made only a subordinate contribution to the German version of the films, when compared to contributions of other

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92. BGH, 24 September 2014 – Hi Hotel II, ZUM 2015, p. 330 f.; MMR 2015, p. 324 f., GRUR Int. 2015, p. 375 f. (note Katzenberger, who criticizes the judgement with respect of its possible implications on § 32b ARA (in context with rules on equitable remuneration under the Law of 2002)).

performers, and would not enjoy any right under § 32a ARA.<sup>93</sup> The BGH also clarified that this rule allows each co-author of a film to assert separately the claims for information and for additional remuneration under § 32a ARA.<sup>94</sup> In a case involving not only the relation to a direct licensee but also to a third party under § 32a (2) ARA, the Regional Court in its final judgment held that both claims (against the direct licensee and any third party/sublicensee) are separate claims, and interpreted the term 'agreed remuneration', to which a disproportionate relationship to the benefits must exist, in a way which has been harshly criticized because it would contravene the aim of the legislator to improve the position of authors and performers.<sup>95</sup>

### **3. Equitable Remuneration under the Law of 2002**

The then novel provisions of the Law of 2002, creating a system to guarantee to authors and performers an unwaivable right to equitable remuneration, so as to remedy the disadvantages of their typically weaker bargaining position in individual licensing contracts, continue to provoke many court cases and were even, as regards § 32 und § 132 ARA, challenged before the Constitutional Court by a publisher against two judgements of the BGH by which he was defeated.<sup>96</sup> The Constitutional Court in essence held

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93. BGH, 10 May 2012 - Fluch der Karibik, GRUR 2012, p. 1248 ff.; for more details, see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 244 f.

94. BGH, 22 September 2011 – Das Boot, GRUR 2012, p. 496; ZUM-RD 2012, p. 192 f.

95. OLG München, 1 June 2017 – Elvis Presley, GRUR-RR 2017, p. 376 ff.; see on that judgement the critical upraising by *N. Reber*, Territorial gespaltene Tonträgernutzung und Künstlernachvergütung – Elvis Presley inflationsbedingt kein Bestseller-Künstler, GRUR Int. 2017, p. 943 f.

96. BGH, 20 January 2011, GRUR 2011, p. 328 f. – Destructive Emotions (see also *von Lewinski*, op.cit. (fn. 2), RIDA Vol. 229, 03-2011, p. 215 ff.; BGH, 20 January 2011 – Drop City, ZUM 2011, p. 403 f.

that these provisions as well as the two decisions of the BGH complied with the fundamental rights of exercising a profession (Art. 12(1) Constitution/*Grundgesetz*), of non-discrimination (Art. 3(1) *Grundgesetz*) and the freedom of contract (Article 2(1) in connection with Article 20(3) *Grundgesetz*).<sup>97</sup> It recognized in particular that, while Article 12(1) *Grundgesetz* included the freedom to negotiate the remuneration for professional achievements, the legislator may also limit this freedom by mandatory legal rules in order to counter social or economic imbalances.<sup>98</sup>

§ 32(1) sentence 3 ARA entitles an author to claim from his contractual partner the consent to modify the contract with a view to stipulate an equitable remuneration, if the agreed one is not equitable. The BGH applied this provision by analogy to several authors who had established a partnership under the Civil Code, in order to administer their rights commonly; the co-authors were the only members of the partnership. Accordingly, the partnership was entitled to claim consent to a modification of a contract.<sup>99</sup> Furthermore, three cases dealt with the equitable remuneration for free journalists, for whom a joint remuneration agreement under § 36 ARA had been concluded in 2010. Accordingly, in particular, the personal, material and time-related conditions for the application of the joint remuneration agreement must be fulfilled. However, under § 32(2) sentence 2 ARA, under which a remuneration is equitable also if it corresponds to what in business relations is customary and

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97. For more detail, see the judgment of the Constitutional Court, 23 October 2013, ZUM 2014, p. 130 f., and *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 244.

98. See however also the critical appraisal by: *Czychowsky*, Vergütungsrecht im Urheberrecht verfassungskonform, GRUR-Prax. 2014, p. 27.

99. BGH, 23 February 2012 – Kommunikationsdesigner, GRUR 2012, p. 1022; ZUM-RD 2012, p. 510; MMR 2013, p. 49.

fair, considerations may be drawn from joint remuneration agreements that are not (fully) applicable in the given case and therefore do not have the effect of a non-rebuttable presumption of equitableness under § 32(2) sentence 1 ARA. In order to do so, a comparable situation as regards different interests suffices, subject to possible modification of the (not (fully) applicable) joint remuneration agreement.<sup>100</sup>

According to the second judgment based on the joint remuneration agreement,<sup>101</sup> § 32 ARA only applies to any remuneration as a counterpart for the licensing of rights of use and the permission to use the work; however, it does not apply to any other elements that may have been agreed in a joint remuneration agreement, such as regarding travel costs of a journalist incurred in context with his research. A third judgement in the context of the joint remuneration agreement regarding free journalists mainly related to the condition under § 36(2) ARA that the association must be 'representative' (of a significant portion of the respective authors or users). According to the aim of the provision, i.e., in particular to avoid any misuse of joint remuneration rules and the related presumption under § 32(2) sentence 1 ARA and to ensure that representative associations in fact have a position justifying them to speak for those whom they represent, the BGH held that the representativity may not be judged on mere formal grounds but must correspond to the factual representation. Qualitative and quantitative criteria would have to be applied, such as the number of members of the association as compared to all relevant

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100. BGH, 21 May 2015 – GVR Tageszeitungen I, GRUR 2016, p. 62 f., also continuing its earlier jurisprudence in the case '*Talking to Addison*' (on that case see *von Lewinski*, op.cit. (fn. 2), RIDA Vol. 229, 03-2011, p. 216.

101. BGH, 21 May 2015 – GVR Tageszeitungen II, GRUR 2016, p. 67 f.

persons. Accordingly, the fact alone that only western German regional associations of the federal association at stake had participated in the joint remuneration agreements did not exclude their possible effectiveness also for eastern German regional organizations (of newspaper publishers).<sup>102</sup>

According to § 36(1) ARA, authors' associations together with associations of, and individual, 'users of works' shall establish joint remuneration agreements. The BGH held that this term does not mean that the plaintiff would be legally obliged to negotiate joint remuneration standards:<sup>103</sup> the question of whether the plaintiff, a broadcasting organization, was such a 'user of works' in particular for its own productions thus has not been finally clarified.

### III. RELATED RIGHTS

#### 1. Simple Photographs

Under § 72 ARA, the maker of a photograph that is not a photographic work enjoys a related right in the photograph or product made in a similar manner to that of photographs. In an interesting case, the defendant had scanned pictures from a museum catalogue of paintings that were in the

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102. BGH, 15 September 2016 – GVR Tageszeiungen III, GRUR 2016, p. 1296 f.

103. BGH, 2 March 2017, ZUM 2017, 929 – Verhandlungspflicht (note Thum); GRUR-Prax. 2017, p. 403 ff. See also *Reber*, Der ‚Werknutzer‘-Begriff im Recht der gemeinsamen Vergütungsregeln (§§ 36, 36a UrhG), Alle Fragen offen? Zugleich Anmerkung zu BGH, ZUM 2017, 929 – Verhandlungspflicht, ZUM 2018, p. 417 f. Reber criticizes that unlike the lower courts, the BGH did not understand the claim by the plaintiff as relating to the question whether he would be considered a 'user of works' under the law, which would have submitted him to the arbitration procedure under § 36a ARA.

public domain and uploaded them to make them available to the public on Wikimedia Commons, without authorization of the right owner in the photographs. He had also taken photographs of public domain works in the museum, despite the indications of the museum that photographs were prohibited. The plaintiff, the museum, which had commissioned the photographs in the catalogue, in a lawsuit requested the defendant to take down the relevant photographs. On 20 December 2018, the BGH largely confirmed the lower instance courts in stating that the photographs were at least protected as simple photographs under § 72 ARA, because they involved more than a mere photo-mechanical reproduction of the paintings and fulfilled the minimum threshold of a minimal intellectual effort. Even if the aim is to reproduce the paintings as exactly as possible, the photographer needs to take decisions on a number of configurations, such as the place from which the photograph is taken, the distance to the painting, the angle, lightening and the cut-out. Therefore, regularly, also photographs of paintings (as in the case it at stake) enjoy the protection under § 72 ARA. Such protection had been put into question by parts of legal doctrine as well as by the defendant, based on the argument that such protection would in fact contravene the duration of author's rights in the paintings, because the owner of a right in the painting could apply a prohibition of photography and make available to the public only his own, protected photographs; however, after expiry of the author's rights protection, anybody should be able to make reproductions of public domain works.

Yet, the BGH did not follow those arguments and thus did not discriminate between photographs made of any other object and those made

of public domain works. Given the aims of the related rights protection, i.e., to protect the intellectual effort made in producing the photograph (whatever the object thereof), this judgment seems only logical. The BGH also pointed at the new extension of the quotation exception under § 51 sentence 3 ARA, which has been amended to cover also photographs of works (even if the quotation purpose was not fulfilled by simply inserting the picture in the database Wikimedia Commons). Furthermore, regarding the photographs taken by the defendant in the museum, the BGH acknowledged that the plaintiff could claim injunctive relief, based on the contract concluded when visiting the museum, including the prohibition of photography.<sup>104</sup> This legal proceeding (where the previous instances largely decided like the BGH) may have been at the outset of Article 10b introduced by the European Parliament into the Digital Single Market Directive (Article 14 in its final version), according to which any material resulting of an act of reproduction of a work of visual art no longer protected by authors' rights shall not be subject to copyright or related rights, unless it is original in the sense that it is the author's own intellectual creation. In the just mentioned case, the BGH did not need to decide whether the photograph was only protected by a related right or even fulfilled the criteria of a work, which under Article 14 of the DSM Directive would still be protected.

Article 14 of the DSM Directive certainly follows a political decision, but seems inconsistent from a systematic point of view; also in other areas, related rights protection is granted for a separate achievement and subsists even in context with the reproduction of no longer protected works, such as

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104. BGH, 20 December 2018, ZUM 2019, 335 – Museumsfotos (note *Lauber-Rönsberg*).

in particular in the case of phonograms protected irrespective of whether the recorded musical work is protected or not.

According to the BGH, the related right for simple photographs under § 72 ARA covers film stills;<sup>105</sup> see also an earlier judgement according to which the right of the film producer covered individual images from a series of moving images,<sup>106</sup> which may be doubtful from a EU-law point of view.<sup>107</sup>

## 2. Phonogram Producers

The famous case *Metall auf Metall* continues to meander between different courts. It was already described in much detail in the previous 'News from Germany'.<sup>108</sup> The BGH in 2008 held in that sound sampling case that the reproduction and subsequent use of two seconds of a sequence of a rhythm from the title 'Metall auf Metall' in a continuous repetition was an infringement of the phonogram producer's rights; however, it asked the Appeal Court to examine whether the defendant could rely on an analogue application of § 24(1) ARA as a defense, while excluding such analogue application where the user could produce the relevant samples himself. The Appeal Court then rejected the analogue application of § 24(1) ARA.<sup>109</sup> The BGH thereafter also held that § 24(1) ARA could be applied by analogy where the user could not produce the relevant samples himself; the purpose

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105. BGH, 6 February 2014 - Peter Fechter, 2014, ZUM p. 401 f.; GRUR 2014, p. 363 f.; see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 245.

106. BGH, 16 August 2012, ZUM 2013, p. 406 f.; GRUR-RR 2013, p. 312 f.

107. *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 245.

108. *von Lewinski*, op.cit. (fn. 2), RIDA Vol. 229, 03-2011, p. 225.

109. OLG Hamburg, GRUR-RR 2011, p. 396 f.



of § 24(1) ARA was to enable further development of creation, while in the case of sound sampling, the creation could be further developed by an own production of samples. Also a balance of interests between the property right and the freedom of arts did not result in a different judgement, even if in fact sound sampling had in fact become widely practiced.<sup>110</sup>

The case however did not stop there. The defendant submitted a constitutional complaint based on the fundamental right of freedom of the arts under Article 5(3) sentence 1 of the German Constitution/Grundgesetz. The Constitutional Court first clarified that the legal provisions in particular on the phonogram producers' rights and § 24(1) ARA themselves do not raise any objections from a constitutional point of view, in particular the fundamental rights of property and of freedom of the arts. In respect of the judgement of the BGH, the Constitutional Court however held that it violated the freedom of the arts under Article 5(3) sentence 1 Grundgesetz. The mere affirmation of an intervention in the phonogram producer's right through reproduction of a short sound sequence did not necessarily affect the freedom of the arts, because such an intervention might be justified in particular by an analogue application of § 24(1) ARA. However, the Constitutional Court did not follow the BGH in its requirement for such analogous application, namely, that the users could not produce the relevant samples themselves, because this requirement would not sufficiently take into account the freedom of the arts. In particular, the possibility of obtaining a licence would not be guaranteed, since the right owner does not need to grant a license, and the need to

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110. BGH, 13 Dezember 2012 – Metall auf Metall II, ZUM 2013, p. 484 f.; GRUR 2013, p. 614 f. See also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 245.

produce a sample oneself could be quite complex and costly, and the criterion of such possibility too vague, so that users of samples could be inclined not to use samples for their own creations anymore. However, samples would be characteristic features of hip hop-music. The Constitutional Court explicitly distinguished the case of use of samples for a particular genre of music from other uses of samples that are done mainly to save costs; it is thus possible that in the latter cases, the Constitutional Court would reject a violation of Article 5(3) sentence 1 Grundgesetz.

According to the Constitutional Court, the legally permitted sampling in the case *Metall auf Metall* would only represent a minor intervention into the phonogram producer's right, without resulting in any considerable economic losses. The Constitutional Court concluded that a minor intervention into the phonogram producer's right without any major economic disadvantages is opposed to a considerable interference with the freedom of artistic activity and development, so that the BGH would have to decide anew, by taking into account this balance of interests, which could be achieved, according to the Constitutional Court, either by an analogue application of § 24(1) ARA or by a restrictive interpretation of the phonogram producer's rights. The Court also gave a hint to the BGH when mentioning in general that national courts may have to submit questions to the CJEU, also in respect of fundamental rights. To the extent that national law implements a European Directive that does not leave any room for various ways of implementation, it would be the fundamental rights of the European Charter that would apply. Otherwise, German fundamental rights could, as in the scope of application of the Directive 2001/29/EC, possibly apply.<sup>111</sup>

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111. Constitutional Court, 31 May 2016, ZUM 2016, 626 f. (note *Stieper*); GRUR 2016, p.

According to the just mentioned criteria of the Constitutional Court, it might have even been obliged itself to submit questions to the CJEU. It is not astonishing that the BGH, after that judgement, proceeded to submit to the CJEU a number of questions on that case.<sup>112</sup> In the meantime, the Advocate General has given his opinion.<sup>113</sup> In particular, as regards the balancing of fundamental rights, the Advocate General found that the phonogram producer's exclusive right even to prohibit the use of parts for sampling purposes is not contrary to the freedom of the arts under the Charter of Fundamental Rights of the EU and, in particular, that the requirement of obtaining a license does not restrict that freedom 'to a degree that extends beyond normal market constraints'.

### 3. Database Makers

Several cases on the sui generis-right of database makers involved the taking of around 10 % of evaluations of dentists from a web portal for an own portal, where the BGH found an infringement based on a qualitative evaluation of the part of the database taken over.<sup>114</sup> In a case where the defendant had taken individual geo data from a topographical map in order to use it for his own maps, the BGH followed the judgement of the CJEU with its final decision, according to which such geo data as used in the case at

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690 f.; see also *Wagner*, Sampling als Kunstform und die Interessen der Tonträgerhersteller, MMR 2016, p. 513 f.; *Leistner*, Die „Metall-auf-Metall“-Entscheidung des BVerfG, GRUR 2016, p. 772 f.

112. BGH, 1 June 2017 – Metall auf Metall III, GRUR 2017, p. 895 f.; GRUR Int. 2017, p. 888 f.; ZUM 2017, p. 760f.

113. Case C-476/17 – Pelham & others.

114. BGH, 1 December 2010, GRUR 2011, p. 724 f.; ZUM-RD 2011, p. 463 f.; for this and a similar case, see *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, 246.

hand constituted 'independent elements' of a 'database' in the meaning of the EU Database Directive, as they contained sufficient informational value after their extraction.<sup>115</sup>

#### IV. TECHNICAL PROTECTION MEASURES

In a case regarding videogames ('Nintendo'), the BGH followed the judgement of the CJEU in a parallel Nintendo-case from Italy<sup>116</sup> and thus held that the more protective provisions on technical protection measures under § 95a ARA (implementing the Directive 2001/29/EC) are applicable in addition to the more restrictive ones regarding computer software, since videogames consist not only of computer software, but also of literary, musical and film works. In addition, it considered the measures applied in this case as effective technical measures in the meaning of § 95a(2) ARA. The plaintiff had used chips on which the videogames were stored; these chips only fitted into the consoles/hardware of the plaintiff, according to a 'key-lock-principle'. Accordingly, any adaptors that could be used like a second key in order to circumvent that safety technology were considered as technical protection measures in the meaning of the law. At the same time, the BGH clarified that a violation of the protection of technical measures does not amount to a violation of authors' rights or related rights, so that the plaintiff could not claim destruction of the adaptors offered for circumvention, because the claim under § 98(1) ARA, require an infringement of authors' or related rights.<sup>117</sup>

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115. BGH, 10 March 2016, GRUR 2016, p. 930 f.; see also the CJEU case C-490/14.

116. CJEU, 23 January 2014, Case C-355/12 – Nintendo and Others

117. BGH, 27 November 2014, GRUR 2015, p. 672 f. (note *Peifer*); MMR 2015, p. 460 f. (note *Roth*).

## V. COLLECTIVE MANAGEMENT ORGANIZATIONS

The probably most important case in the period reported upon is a claim by an author to receive 100 % of the income of statutory remuneration rights, in particular from private copying remuneration inside the literary collective management organization (CMO VG Wort). The distribution plan of VG Wort, which had been made part of the contractual relationship between the author and the VG Wort, provided equal shares for authors and publishers, according to a long-standing practice in German and most other CMOs. However, after a modification of the ARA in 2002, authors could entrust their remuneration rights only to a CMO; when this raised doubts about the continued participation of publishers in the income from statutory remuneration rights, § 63a ARA was adopted in 2008 in order to clarify that publishers could still participate in such income.<sup>118</sup> While the legislative motives clearly indicated that § 63a sentence 2 case 2 ARA was to ensure further participation of publishers in the income through a flat rate remuneration, the BGH held that this was not clearly expressed in the wording of the text. For this and for other reasons (in particular EU-law, which, according to the CJEU's case 'Luksan/van der Let', would not allow any waiver or presumption of transfer in particular as regards the right of a private copy remuneration to the detriment of authors), the BGH held that the distribution of a share to publishers was unjustified and therefore constituted an infringement of the

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118. According to § 63a ARA, statutory remuneration rights may not be waived by the author in advance but may be assigned in advance, though only to a CMO, or together with the grant of right of publication to the publisher, if the latter lets them be managed by a CMO manages publishers' and authors' rights jointly.

then valid § 7 sentence 1 Law on Collective Administration, requiring a non-arbitrary distribution of the income.<sup>119</sup>

Inside the VG Wort, authors and publishers agreed that their successful cooperation and sharing of revenues inside VG Wort should be continued as far as possible, not least in order to avoid a loss of impact of the existing CMOs in Germany. As a first measure to reach this aim, the German legislator adopted the new § 27a VGG, permitting by law the author to agree, after publication of a work by a publisher, to the participation of the publisher in the revenues from the statutory remuneration rights according to fix percentages. This option had been permitted by the BGH.<sup>120</sup> A second measure by the competent German Ministry of Justice and for Consumer Protection was to submit to the European Commission a proposal to provide an article in EU-law allowing continuous participation of publishers in CMOs. The Commission then proposed Article 12 of the DSM Directive, which became Article 16 in the final version.<sup>121</sup> For Germany, Article 12 of the DSM Directive should thus serve the aim of reestablishing the previous situation where publishers regularly participated in revenues from rights in published works.

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119. BGH, 21 April 2016, GRUR 2016, p. 596 f. For the lower court instances and the suspension of legal proceedings by the BGH in 2014, see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 247 f. For a critical analysis of that judgment, see *Riesenhuber*, Die Kontrolle des Verteilungsplan im Licht unionsrechtlicher Vorgaben – zugleich eine Besprechung des BGH-Urteils zur Verlegerbeteiligung, ZUM 2016, p. 613 f. Notably, even the state supervision of authority before and during the legal proceedings did not indicate that the legal practice participation of publishers would be contrary to the law.

120. See for more detail, also on § 27(2) VGG regarding exclusive rights, *von Lewinski*, op.cit. (fn. 1), RIDA Vol. 255, 01-2018, 91 ff.

121. See also hereon *von Lewinski*, op.cit. (fn. 1), RIDA Vol. 255, 01-2018, 92 ff.

A number of further cases involving CMOs was decided on the basis of the former Law on Collective Administration preceding the law implementing Directive 2016/26/EU. They related to cases where right owners had made incorrect indications regarding the public performance of their works, leading to the adoption by GEMA of rules to avoid abuses;<sup>122</sup> to the exclusion of certain works from payment;<sup>123</sup> on the obligation of GEMA to bring a lawsuit against any infringer and the involvement of individual right owners to participate in the proceedings;<sup>124</sup> to the possible liability of a CMO as regards possibly arbitrary distribution plans that would be in conflict with the then § 7 of the Law on Collective Administration;<sup>125</sup> to the calculation of damages for infringement, which should normally take into account license fees and may refer to similar kinds of uses;<sup>126</sup> to the obligation to conclude contracts with users;<sup>127</sup> to the possibility of GEMA to claim equitable remuneration for certain uses that were not covered by a tariff.<sup>128</sup> Further cases dealt with a specific clause in rules accompanying the distribution plan of GEMA,<sup>129</sup> and the liability of an event organizer to ask for authorization by the GEMA under the former § 13b Law on Collective Administration.<sup>130</sup>

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122. Judgement on such rules, BGH, 5 December 2012, ZUM-RD 2013, p. 176.

123. BGH, 22 January 2014, GRUR 2014, 769.

124. BGH, 1 December 2010 – Multimedia Show, GRUR 2011, p. 720.

125. BGH, 24 September 2013 – Verrechnung von Musik in Werbefilmen, GRUR 2014, p. 479 f.; ZUM-RD 2014, p. 276 f.

126. BGH, 1 December 2010 – Multimedia Show, GRUR 2011, p. 720 f.

127. BGH, 20 March 2013 – Gesamtvertrag Hochschul-Intranet, ZUM-RD 2014, p. 11 f.

128. BGH, 27 October 2011 – Bochumer Weihnachtsmarkt, GRUR 2012, p. 715 f. For all those judgements and reference for further judgements on CMOs see also *von Lewinski*, op.cit. (fn. \*), A&M 2015/3-4, p. 246-249.

129. BGH, 8 October 2015, GRUR 2016, p. 606 f.

130. BGH, 12 February 2015, GRUR-Prax 2015, p. 410 (report by *Thum*).

## VI. INTERNATIONAL PROTECTION

In a case involving the performing artist Marlene Dietrich, her successor in title had claimed an injunction against YouTube in order to make it take down a video clip of excerpts from a recording of a concert in 1972 in London. The BGH confirmed that German law applied, since the plaintiff requested protection for Germany. German law provides for an exclusive right of making available in favour of performing artists under § 78(1) no. 1 ARA. Since Marlene Dietrich was no longer a German citizen at the time of her concert in 1972, § 125(1) sentence 1 ARA providing protection for German citizens did not apply; likewise, § 125(3) ARA did not apply, because the recording was not first published in Germany (or within 30 days after a first release outside of Germany). It also stated that under the applicable treaties (on the basis of § 125(5) ARA), the making available right could not be based on the TRIPs Agreement or the WPPT, which both do not provide for any minimum right of making available for performing artists regarding audio-visual recordings and which both restrict the scope of national treatment to the minimum rights explicitly provided in these treaties. This is an undoubtedly correct interpretation of the TRIPs Agreement and the WPPT. The BGH also mentioned that the Beijing Treaty on Audiovisual Performances had not yet entered into force.

However, unlike the Appeal Court, the BGH considered that the plaintiff could base her claim on national treatment based on the Rome Convention of 1961 in connection with § 125(5) ARA. Article 2(2) of the Rome Convention



reads: ‘National Treatment shall be subject to the protection specifically guaranteed, and the limitations specifically provided for, in this Convention.’ This clause is interpreted by doctrine in different ways – either as full national treatment according to national treatment under the Berne Convention, or as later explicitly stipulated in the TRIPs Agreement and the WPPT, namely, as a national treatment restricted in its scope to that of the minimum rights under the Convention.<sup>131</sup> It also rejected the statement by the Appeal Court, according to which Article 19 Rome Convention (which excludes protection under its Article 7 – the minimum rights for audio-visual recordings – after the performer’s consent to the incorporation in the film) would also prohibit the application of national treatment to audio-visual recordings. In respect of the different ways of interpretation of Article 2(2) Rome Convention in doctrine, the BGH admits that the wording of Article 2 is not very clear, even when looking at the different language versions (English, French, and Spanish). However, it argues in favour of full national treatment on the basis of the systematic context between Article 2 (2) and Article 19 Rome Convention, which limits only the minimum protection, and with Article 21 Rome Convention, which clarifies that national law may provide more extensive protection than the minimum rights; according to the BGH, this would confirm a broad scope of national treatment. The latter argument may not be entirely convincing, since also the TRIPs Agreement provides a clause comparable to Article 21 Rome Convention and Article 19 Berne Convention, and at the same time, limits the scope of national treatment to the minimum rights. The BGH may have had the same impression and therefore in addition had recourse to the historic interpretation and to a comparison with the Berne

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131. *von Lewinski*, *International Copyright Law and Policy*, 2008, nos. 6.27 and 7.34 – 7.40.

Convention and the Universal Convention on Copyright. The BGH even analysed Article 31(3) a, b Vienna Convention on the Law of Treaties, which requires taking into account any subsequent agreement on the interpretation of a treaty and rejected the argument that the restricted national treatment under the TRIPs Agreement and the WPPT could be such an agreement. With these statements, the BGH referred the case back to the Appeal Court (which however held that the plaintiff was not the owner of the rights, which had been passed to the film producer).<sup>132</sup>

### VII. Liability of Internet Service Providers (ISPs)

The number of cases submitted to German courts in the past years on different aspects of the liability of ISPs and owners of internet connections is considerably high and would suffice for a self-standing article. Therefore, for most of these cases, mere references are indicated below.<sup>133</sup> Only several

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132. BGH, 21 April 2016 – An Evening with Marlene Dietrich, GRUR 2016, 1048, *Katzenberger*; for the following Regional Court's final decision, see OLG München, 13 April 2017, GRUR-RR 2017, p. 417 f.

133. See the following decisions of the BGH: MMR 2012, 815 in particular on § 97 ARA on the quality as a 'doer' (primary infringer); GRUR 2013, 370 – Alone in the Dark (in particular on liability as 'Störer' (disturber) and the conditions for liability of the file hosting service Rapidshare and, in continuation of this case, decision of 15 August 2013 – File Hosting Dienst, GRUR 2013, 1030, ZUM-RD 2013, 565 and 514, MMR 2013, 733, ZUM 2013, 874. Decision of 15 November 2012 – Morpheus, GRUR 2013, 511; MMR 2013, 388 on non-liability of parents of a child that was instructed about illegal file sharing and there was no reason for them to presume an infringement. Decision of 8 January 2014, GRUR 2014, 657 (note *Neurather*) – BearShare, on non-liability of an owner of internet access for full-age family members; see also BGH ZUM 2016, 373 – Tauschbörse III; for more decisions on liability of owners of internet access, see BGH 12 May 2016 – Everytime we touch, ZUM 2017, 62; GRUR 2016, 1280; BGH 6 October 2016 – Afterlife, GRUR 2017, 386; ZUM 2017, 503; BGH 12 May 2016 – Silver Linings Playbook, GRUR 2016, 1289; ZUM 2016, 1043. Decision of 30 March 2017 – Loud, MMR 2018, 172, GRUR 2017, 1233, GRUR Prax 2017, 509, in particular obliging parents owning an internet access to indicate the name of their full-age family member who has admitted to them an infringement of rights in a file-sharing network. BGH 27 July 2017 – Egoshooter, GRUR 2017, 6; MMR 2018, 311, on presumption that owner of internet access was infringer. BGH 24 November 2016 –

references to the CJEU for preliminary ruling are highlighted here, in particular one by the LG München regarding an owner of an internet connection, who had not himself infringed upon copyright, but an adult member of his family had so, and he did not want or was not able to name the infringer's name. The question was whether he could be exempted from liability if he only mentioned generally who had access to his internet connection. After weighing the different rights involved, including the right to intellectual property and to an effective remedy, as well as the right to the respect of private life and family life, the CJEU concluded that under the circumstances of the case, such exemption of liability would not be in compliance with Art. 8(1), (2) Directive 2001/29/EC and Art. 3(2) Directive 2004/48/EC.<sup>134</sup>

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WLAN Schlüssel, ZUM 2017, 672 (security obligations of internet access owner with Wifi function). BGH 26 July 2018 – Dead Island, GRUR Int 2018, 1070; GRUR 2018, 1044; MMR 2018, 811; see also note by *Obly*, JZ 2019, 251; in this case, the BGH applied the new version of the Telemediengesetz (Law implementing in particular the liability provisions of the e-commerce Directive), Sec. 8(1) phr. 2, according to which a wifi operator is not (no longer) liable for violations of copyright by third parties using such wifi connection in P2P networks. However, the new version of the TMG in Sec. 7(4) allows to block internet access. Following the CJEU's UPC/Telekabel decision, the BGH held that a telecom company that provides access to websites with copyright-infringing content can be liable as 'disturber', BGH 26 November 2015, GRUR 2016, 268 – Störerhaftung des Access Providers. Decisions on liability for thumbnails, GRUR 2012, 602 – Vorschaubilder II and BGH 21 September 2017 – Vorschaubilder III, ZUM 2018, 123; GRUR 2018, 178 (on the latter, see also: *von Lewinski*, *Encore des privilèges pour les moteurs de recherche*, *Dalloz IP/IT – Droit de la propriété intellectuelle et du numérique*, 2018, 444 – 447. Decision of 16 May 2013 – Kinderhochstühle im Internet II, MMR 2014, 55, GRUR 2013, 1229 (on liability and increased control obligations of a platform operator in case of electronic links). Decision of 19 April 2012 – Alles kann besser werden, GRUR 2012, 1026 MMR 2012, 689 and BGH 13 July 2017 – Benutzerkennung, GRUR 2018, 189; MMR 2018, 313, as well as BGH 21 September 2017 – Sicherung der Drittauskunft, GRUR 2017, 1236; ZUM 2018, 136 (on the right to claim information under § 101 ARA in the context with infringements in the internet). As regards links in an online-article to websites regarding possibilities to circumvent technical protection measures, see also Supreme Court, 14 October 2010 – AnyDVD, MMR 2011, 391 and Constitutional Court, 15 December 2011, GRUR 2012, 390.

134. LG München I, 17 March 2017 - 21 S 24454/14; GRUR Int 2017, 452 – Bastei Lübbe; CJEU 18 October 2018, case C-149/17.

More recently, the BGH submitted to the CJEU a referral on the interpretation of Art. 8(2)a Directive 2004/48/EC, as regards the concrete indications required thereby for operators such as, in this case, YouTube; in particular, whether information such as e-mail addresses and phone numbers of users must be provided.<sup>135</sup>

Two other referrals by the BGH are of major interest, especially against the background of Art. 17 of the EU Digital Single Market (DSM) Directive of 2019. The first one concerns in particular the question of whether YouTube does perform an act of making available itself and thus is not just a 'disturber' and subject to secondary liability for the infringing acts of users of YouTube, but is subject to primary infringement. In fact, the latter approach has been adopted by Article 17 of the DSM Directive. Whatever will be the outcome of the case, any CJEU judgement will be made on the basis of the law before the Directive and thus not affect the DSM Directive.

This question of a possible primary liability had previously been answered to the negative by the Regional Courts of Munich and Hamburg.<sup>136</sup> The BGH in 2018 not only referred the question of primary liability of YouTube in the described circumstances to the CJEU, but also the question of whether the acts of YouTube are covered by Article 14 E-commerce Directive and whether the knowledge required must refer to concrete illegal acts or information.

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135. BGH, 21 February 2019, I ZR 153/17.

136. OLG München, GRUR 2016, 612 – Allegro Barbaro, and OLG Hamburg, 1 July 2015 – GRUR-RS 2015, 14370 – YouTube.

Further questions relate to Article 8(3) Directive 2001/29/EC and Article 11 phr. 1 and Article 13 Directive 2014/49/EC.<sup>137</sup>

A case with similar questions, though relating to a sharehosting service, was also referred to by the BGH.<sup>138</sup>

## VIII. CONCLUSIONS

As it has become apparent from this article, copyright remains a highly dynamic field, not only as regards legislative developments but also jurisprudence. The latter is ever more often influenced by harmonized EU law, including by case law of the CJEU, which frequently itself requires interpretation and thus provokes new questions for similar situations. Not all cases by the Supreme Court could be covered, but a selection of the more important ones had to be made.

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137. BGH, 13 September 2018, I ZR 140/15, GRUR 2018, 1132; MMR 2019, 37 – YouTube. CJEU case C-682/18. See an opinion on this case by ALAI: <http://www.alai.org/assets/files/resolutions/190225-opinion-youtube-en.pdf>

138. BGH, 20 September 2018, I ZR 53/17, GRUR 2019, 1239; ZUM 2018, 870 - Uploaded. CJEU case C-683/18.