

Intellectual Property and Sports:  
Essays in Honour of P. Bernt Hugenholtz

## **Information Law Series (INFO)**

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#### *Editor*

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# **Intellectual Property and Sports: Essays in Honour of P. Bernt Hugenholtz**

*Edited by*

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# Part 1

## Starting Whistle



# Introduction: An Information Law Approach to Intellectual Property and Sports

*Martin Senftleben, Joost Poort, Mireille van Eechoud,  
Stef van Gompel and Natali Helberger*

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With this collection of essays on intellectual property and sports, we celebrate the enormous achievements of Professor Bernt Hugenholtz in the field of intellectual property and information law. Under his leadership, the Institute for Information Law (IViR) has prospered and grown into an institute of world fame – widely known as a central place of inspiration that brings a diverse group of researchers and academic disciplines together, offers ample room for innovative thinking based on respect for each other’s ideas and expertise, and provides training and career opportunities for the next generation of researchers. In fact, Bernt Hugenholtz’ strict but fair approach to research work and PhD supervision – giving space for independent thinking while insisting on a critical and rigorous assessment of proposed new concepts and solutions – has led to a very successful school of information law training that regularly enabled alumni to obtain top positions in academia and legal practice.

Perhaps even more importantly, however, Bernt Hugenholtz is a very influential pioneer and champion of the information law approach to intellectual property. His passionate campaign against term extensions and excessive grants of protection, commitment to fair use and the recognition of rights and interests of users in the light of the guarantee of freedom of expression and information, tireless efforts for a copyright contract law that ensures fair remuneration of creative labour, and commitment to Creative Commons and open access, has shaped the intellectual property agenda during the last decennia and impacted the evolution of new law and practice.

With his doctoral thesis, he laid important groundwork for the subsequent debate and critical evaluation of new legal norms in the field of database

protection as early as 1989.<sup>1</sup> The 1995 Conference ‘The Future of Copyright in a Digital Environment’ – organised in Amsterdam in collaboration with the Royal Netherlands Academy of Sciences (KNAW) as a Royal Academy Colloquium – was a propelling force in establishing information law as a legal discipline and the information law approach to intellectual property as a reference point for the renewal of legal theory, lawmaking and teaching. As many other milestones of Bernt Hugenholtz’ work, the proceedings of the Conference have been published in the Information Law Series.<sup>2</sup> After his 1999 inaugural speech ‘Sleeping with the Enemy’<sup>3</sup> – a powerful plea for strengthening the position of authors and performers vis-à-vis publishers and producers – the publication of a study (with Lucie Guibault) described avenues towards the implementation of a new copyright contract law and provided important impulses for a new legal regime in the Netherlands.<sup>4</sup> The adoption of a Copyright Contract Act providing a robust set of author’s contract rights followed in 2015.<sup>5</sup> Various studies for the European Commission and other international policymakers, such as *The Recasting of Copyright and Related Rights for the Knowledge Economy*<sup>6</sup> and *Trends and Developments in Artificial Intelligence: Challenges to the Intellectual Property Rights Framework*<sup>7</sup> followed. Further groundbreaking publications, such as *The Future of the Public Domain – Identifying the Commons in Information Law*,<sup>8</sup> *Harmonizing European Copyright Law*,<sup>9</sup> and *Copyright Reconstructed*,<sup>10</sup> appeared in the Information Law Series. As founder and Series Editor, Bernt Hugenholtz has taken care of the selection and publication of more than forty-five high quality book publications since the introduction of the Information Law Series in 1991. Further examples of Bernt Hugenholtz’ achievements and impactful work could easily be added.

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1. Bernt Hugenholtz, *Auteursrecht op informatie*, (Kluwer, Deventer, 1989).
2. Bernt Hugenholtz (ed.), *The Future of Copyright in a Digital Environment* (Kluwer Law International, The Hague/London/New York, 1996).
3. Bernt Hugenholtz, *Sleeping with the Enemy – Over de verhouding tussen auteurs en exploitanten in het auteursrecht* (Vossiuspers Amsterdam University Press, Amsterdam, 1999).
4. Bernt Hugenholtz and Lucie Guibault, *Auteurscontractenrecht: naar een wettelijke regeling?* (IViR, Amsterdam, 2004).
5. Wet auteurscontractenrecht of 30 June 2015, available at <https://wetten.overheid.nl/BWBR0036745/2018-09-19>.
6. Bernt Hugenholtz, Mireille van Eechoud, Stef van Gompel et al., *The Recasting of Copyright & Related Rights for the Knowledge Economy* (IViR, Amsterdam, 2006).
7. Christian Hartmann, Jacqueline Allan, Bernt Hugenholtz, João Quintais, Daniel Gervais, *Trends and Developments in Artificial Intelligence: Challenges to the Intellectual Property Rights Framework* (European Commission/IViR/ Joint Institute for Innovation Policy, Brussels, 2020).
8. Lucie Guibault and Bernt Hugenholtz (eds.), *The Future of the Public Domain – Identifying the Commons in Information Law* (Kluwer Law International, The Hague/London/New York, 2006).
9. Mireille van Eechoud, Bernt Hugenholtz, Stef van Gompel, Lucie Guibault and Natali Helberger, *Harmonizing European Copyright Law: The Challenges of Better Lawmaking*, Information Law Series 19 (Kluwer Law International, Alphen aan den Rijn, 2009).
10. Bernt Hugenholtz (ed.), *Copyright Reconstructed. Rethinking copyright’s economic rights in a time of highly dynamic technological and economic change*, Information Law Series 41 (Kluwer Law International, Alphen aan den Rijn, 2018).

Turning to the collection of essays in this edited volume, it is noteworthy that the focus on sports-related intellectual property issues – following Bernt Hugenholtz’ suggestion for the 2021 IViR Conference ‘Intellectual Property and Sports’ – offers an ideal starting point for exploring core questions and regulatory dilemmas of information law. Sport-related news and information on sports events has particular value – not only from an economic but also from a broader cultural and societal perspective. Impressive individual sporting achievements, as well as organisational efforts and financial investments of clubs and sports associations raise complex and delicate questions as to the availability and desirability of legal protection, sufficient room for disseminating sports events and related information, and the reconciliation of available protection with freedom of expression and information, and freedom of the press. At the same time, legal rules in the area of sports and intellectual property evolve in a climate that is pervaded by powerful lobby pressures. As other societal phenomena with a strong information law dimension, new technologies have a deep impact on developments in the sports arena.

Against this background, it may come as a surprise that the arsenal of legal protection tools in intellectual property law is still in flux. While branding and merchandising efforts may lead to trademark portfolios, the legal status of individual player performances and organisational efforts of sports event organisers is much less clear. Protection under copyright law may be unavailable for sports events as such. Protection against unfair competition only enters the picture on a case-by-case basis. Leading case law in the field of database protection, however, attests to the central importance of one of Bernt Hugenholtz’ particular areas of expertise – database law and database rights – to the regulation of revenue streams and rewards for investment in the area of sports.

The essays in this volume address this panoply of fascinating information law issues through widely varying lenses and in different styles. Reflecting the broad academic network and worldwide impact of Bernt Hugenholtz’ work, the authors from both sides of the Atlantic are not only prominent experts in the field of information and intellectual property law. Many are co-authors and/or co-editors of one or more of Bernt Hugenholtz’ many publications, and have become friends of Bernt in the process. The analysis focuses first on the sporting achievements of players and the commercialisation of player popularity (Part 2) before turning to sports clubs and their substantial investment in event organisation, branding and merchandising (Part 3). After this exploration of legal issues and protection interests arising from the activities of central protagonists in the sports arena, the rules of the game, the value of event data and the need for freedom of event reporting enter the picture in Part 4. A discussion of the impact of new technologies and potential future scenarios for sports and intellectual property law completes the analysis in Part 5. The concluding Part 6 offers an intriguing reflection on the different contributions to this edited volume.

In Part 2 – exploring the legal position and protection interests of players – *Willem Grosheide* opens the discussion with an essay about the desirability of intellectual property protection for sports achievements. Examining the substantive criteria and case law of the CJEU, he arrives at the conclusion that elements of sports

can enjoy copyright protection under certain circumstances, but that a non-legal approach to protect sports performances is preferable. Continuing with a focus on individual movements, *Séverine Dusollier* asks whether intellectual property law, and copyright law in particular, vests individual ownership or reward in sports moves, dance moves or other moves. She concludes that it would be ill-advised, for various reasons, to recognise that someone's movements attract copyright, however genius or skilful they might be. Composing a text choreography of her own, *Marie-Christine Janssens* explores the intricacies of copyright protection for choreographies in the field of dance and ballet. She points out that established copyright criteria do not neatly fit all aspects of choreographic works, showing that copyright law is incapable of protecting all genuine creative achievements in modern dance and ballet. Turning from dance moves to the art of manoeuvring in chess, *Gerard Schuijt* takes the reader back to the writings of copyright's doctrinal giants like Josef Kohler in his essay querying why copyright law has so little to offer chess players. Honing in arguments that (great) players have distinctive styles of playing, the contribution clarifies why one must take the 'personal style' as an argument for copyright with a large grain of salt.

Abandoning the focus on sports achievements and switching to player popularity and individual player characteristics, *Thomas Dreier* reflects on the ownership of tattoos, such as those worn by sports celebrities, from a cultural-historical, social-aesthetical and legal perspective. On the basis of German and US law, he discusses possible copyright and data protection implications of realistically depicting tattoos of sports players in videogames. *Egbert Dommering* discusses portrait rights and their somewhat contrived relationship with copyright law using a well-known ruling of the Dutch Supreme Court on the portrait of Johan Cruijff, one of the most famous footballers of all time. Placing the Cruijff case in the wider context of privacy protection, he shows how Dutch courts edge towards developing the commercial side of privacy law as property law. *Feer Verkade* continues the discussion of commercial aspects of rights in personal portrayal. Drawing a parallel with the position of authors in their relationship with publishers, he raises the question whether sports celebrities, and portrayed persons more generally, should be placed in a better legal position when entering into contractual agreements about the exploitation of their portraits. He proposes a 'Lex Hugenholtz II': a new set of norms akin to the contractual protections for authors which Bernt Hugenholtz was instrumental in framing in the Netherlands.

Turning to questions arising from merchandising, *Paul Torremans* explores legal strategies which the merchandising industry may deploy to ensure protection for the commercial exploitation of products relating to sports celebrities and their attributes. More specifically, he scrutinises the tort of passing off and the three requirements of goodwill, misrepresentation, and damage that constitute key tests in UK law. Finally, *Thomas Riis* analyses case law addressing the use of sports data and player characteristics in the production of computer games that put the player in the position of a team manager. Popular sports manager games based on European handball championships and Olympic games have given rise to the question whether the use of players' names and characteristics infringes personality rights.

In Part 3, the investments, organisational efforts and branding activities of sports clubs occupy centre stage. Opening the discussion, *Stef van Gompel* draws attention to the fact that major sports organisations, such as the International Olympic Committee, FIFA, UEFA, Formula One and Tour de France, have combined their efforts to initiate policy debates at the World Intellectual Property Organisation and the EU legislative bodies to ensure the recognition of the value of sport and protect sports events through intellectual property law. In the light of efforts to prevent piracy of sports event broadcasts, he discusses recent endeavours undertaken by sports event organisers to preserve the broadcast business model for live sports coverage and contrasts them with critical accounts in legal scholarship, including those of Bernt Hugenholtz. Surveying the arsenal of existing protection tools – ranging from ‘house rights’ to specific ‘audiovisual rights’ that may be available in certain national systems – *Raquel Xalabarder* contrasts the ownership and control position of sports event organisers with the legal position of individual players who may show an impressive performance during a sports event, while not being eligible for neighbouring rights protection because of the requirement that the performance be connected to a work. The analysis conducted by *João Pedro Quintais* confirms that sports event organisers enjoy multi-tiered protection against unauthorised online transmissions on the basis of copyright, neighbouring rights and specific national legal regimes. They also benefit from various enforcement measures, including notice and action procedures, and blocking injunctions. While highlighting the fragmented nature of available protection tools, Quintais warns that new initiatives aiming at broader protection are likely to neglect the need for adequate substantive or procedural safeguards for due process and freedom of expression. *Thomas Hoeren* draws a comparison between exclusive rights that can be invoked with regard to carnival parades and protection tools that are available in the area of football. His analysis sheds light on a paradox: while copyright in individual scales and costumes can be invoked to protect the Rose Monday procession, these rights are tacitly waived in practice. In professional football, by contrast, copyright protection is difficult to justify. Nonetheless, football clubs claim broadcasting rights. Seeking to strengthen the legal position of both players and clubs, *Antoon Quaedvlieg* argues in favour of new intellectual property rights for players as a natural reward for the performance shown during sporting events. He points out that the creation of a right for players could be accompanied by a new neighbouring right for sports event organisers as entrepreneurs. Following a different rationale, this neighbouring right could offer investment protection. However, its term of protection should be very short to avoid inroads into freedom of information.

In contrast to this plea for a new neighbouring right, *Dirk Visser* concludes on the basis of a survey of specific intellectual property protection regimes that have been established in addition to copyright, patent and trademark protection, that it may be preferable to leave it to the courts to decide on a case-by-case basis whether an activity raising doubts about adequate protection should be covered by unfair competition law or one of the aforementioned central intellectual property rights. Instead of creating new *sui generis* protection regimes for every new phenomenon, he recommends the cultivation of unfair competition law as a safety net in cases where copyright, patent and trademark protection

are unavailable. Exploring protection avenues in unfair competition law, *Ansgar Ohly* analyses Anglo-Australian, US, German and French case law. He concludes that unfair competition law is strong in the area of misrepresentation where it safeguards sports organisers' rights and protects the interests of fans, for instance, by prohibiting the sale of black-market tickets and preventing false impressions of sponsorship. As a shield against the misappropriation of investments and organisational efforts of sports clubs, however, unfair competition law is weak. Given the flexibility and case-sensitivity of the doctrine, unfair competition law fails to provide a proper basis of markets for broadcasting rights. Focusing on the specific issue of (unauthorised) ticket resales, *Joost Poort* explores the phenomenon from an economic perspective and considers practices of reselling sports tickets and concert tickets. He concludes that, given the economic logic behind ticket resale, 'fighting it is like arm-wrestling with Adam Smith's invisible hand.'

The final discussion points in Part 3 concern branding activities. *Neil Netanel* provides a thoughtful and thought-provoking discussion of how trademark law should address the use of ethnic references as sport brands, in particular where ethnic references are used as badges of honour for particular minority groups, but where such uses could also easily be abused or cause sensitivities and even offence to the very same groups. The essay has been inspired by the Ajax 'Jews'. However, it also explains how US courts have dealt with the issue of ethnic references in cases relating to Braves, Chiefs, Warriors, Redskins, Squaws, and Dykes on Bykes. Discussing use of the name of the Greek hero 'Ajax' as a trademark for the Amsterdam football club, *Martin Senftleben* queries whether a cultural sign loses its value for cultural creativity if it is adopted as a trademark and, as a result of branding efforts, is no longer primarily perceived as a cultural sign, but rather as a commercial marketing instrument. He concludes that freedom of expression and freedom of information should play a bigger role in decisions about the grant of trademark rights in cultural signs.

After this foray into legal issues surrounding players and clubs, Part 4 brings sports events and related information into focus. Focusing on the protection of sports data, *Mireille van Eechoud* looks at the place of the Database Directive and sport-related milestone rulings of the CJEU in the Data Strategy of the European Commission. She predicts that the EU Data Strategy will not have a profound impact on sports data markets directly. Given the objective to facilitate the sharing of data, as opposed to subjecting it to exclusive rights, however, there might be significant indirect effects, such as the adoption of a harm-based infringement criterion, or the introduction of a spin-off criterium excluding *sui generis* database rights in data collections that result from a producer's main activities. *Matthias Leistner* scrutinises the functionality doctrine developed in the CJEU's case law in relation to copyright-protected works, which also holds relevance for the protection of collections of football fixtures and football matches. He shows that, despite its imperfections, the CJEU's functionality doctrine actually allows national courts to develop workable criteria to effectively carve out functional elements from the domain of copyright protection. From the perspective of US law, *Pam Samuelson* unpacks the extent to which copyright law offers protection to the various creative aspects of games, ranging from the initial game design

and the articulation of game rules to selections and arrangements of information about games and their players. However, her analysis shows that copyright has little to offer when it comes to the protection of games (or sporting events) in themselves, which is largely due to the functional nature of games as systems. *Ole-Andreas Rognstad* discusses the conditions for intellectual property protection of sporting events against the background of the Premier League decision of the CJEU. He emphasises that the intellectual property protection of sporting events is subject to the limitation that follows from the guarantee of the free movement of services in primary EU law. As a result, the invocation of intellectual property protection to prevent the cross-border dissemination of content in the EU must have a justification based on the opportunity to acquire 'adequate remuneration' for the exploitation in question. In line with Bernt Hugenholtz' vision of a unitary European copyright regime, no restrictions can be based on territoriality in itself. Exploring options for awarding copyright protection, *Lionel Bently* examines the conditions for protecting the football game as a creative work for copyright purposes. Providing numerous examples of creative passages of play in football games, many of which are so notorious that they be instantly recalled by regular football watchers, he argues that no convincing reasons have been put forward by the CJEU to exclude at least parts of many football games from EU copyright law.

Returning to the Premier League decision, *Christina Angelopoulos* draws attention to problems arising from the UK's failure to distinguish properly between copyright and related rights in films. As a result of the UK legislator's initial failure to appreciate the need, under international copyright law, to protect cinematographic works as such, films have developed into a known problem area in UK copyright law which cannot be rectified until the UK's closed list of subject matter is amended to separate the protection granted to film creators from that given to film producers. Continuing the discussion of the protection status of audiovisual material, *Tatiana Synodinou* analyses the protection of sports event broadcasts as original works in EU copyright law. Putting the filming of sports events to the CJEU's originality test, she concludes that while a sports event as such cannot be protected by copyright, its audiovisual coverage can attract copyright protection since various creative choices can be made before, during and after the filming of the event as well as in the ancillary content included in the live sports broadcast. *Reto Hilty* deepens the discussion by focusing on photography and the question whether protection on the basis of related rights could be justified in the case of photographs not meeting the originality threshold in copyright law. His analysis shows that, from a purely economic perspective, any justification for protecting photographs below the threshold of copyright has lost relevance in the digital environment. With the boom in image production and dissemination via online platforms for user-generated content, an indication of market failure is sought in vain. Nonetheless, there may be fairness-based reasons that could justify the protection of certain groups of photographers and film producers below the threshold of copyright law. Protection could be granted, for instance, to those who depend on the exclusive exploitation of their products, which may include amateurs who wish to commercialise them now and then.

In the final essay of Part 4, *Peter Jaszi* discusses the need for copyright exemptions that allow the use of a short clip of sports-related material without

permission or payment in a new narrative context. More specifically, he discusses new avenues in the interpretation and application of the US fair use doctrine in the light of *Google v. Oracle*. With regard to the first fair use factor concerning the ‘purpose’ of the use, his analysis identifies useful clarifications and answers to unresolved questions. The central element, however, concerns the analysis of economic consequences from unlicensed uses that the fourth fair use factor mandates. In this respect, *Google v. Oracle* introduces a whole new category of considerations that have the potential to broaden the inquiry substantially by taking public value added into account along with private monetary losses.

Part 5 of the analysis discusses the impact of new technologies and scenarios for the future of sports and intellectual property. *Paul Goldstein* discusses two central developments in US case law that threaten to tilt liability disproportionately away from equipment and service providers: the judge-made requirement that in order to avoid the imposition of ‘unreasonable liability’ only conduct animated by ‘volition or causation’ should be treated as direct infringement; and the expansion of the fair use defence to exonerate not only widespread non-commercial uses, such as home taping, but also transformative uses. The reduction of primary liability as a result of the expansion of the fair use defence, inevitably, erodes the basis for a finding of secondary liability and reduces the occasions for secondary liability of equipment or service providers. Turning to developments in Europe, *Christophe Geiger* critically discusses the European digital agenda, and the need to modernise and adapt the intellectual property framework to the digital environment, data-driven practices, and opportunities arising from artificial intelligence. Highlighting the particular importance of breathing space for text and data mining to the development of AI-driven services and applications, he argues that the current copyright framework in the EU fails to offer sufficient room for text and data mining – a lack of flexibility that is likely to have a negative impact on innovation. In their analysis of attitudes regarding the use of AI in refereeing, *Natali Helberger* and *Brahim Zarouali* explore a very practical and pressing question that everyone interested in sports undoubtedly grapples with: will AI replace referees? And if it does, can we expect this to be a change for the better or worse? The chapter is also a tribute to Bernt Hugenholtz’ openness to interdisciplinary approaches in information law, understanding the role of new technologies and evidence-based policy making. *Thomas Vinje* discusses the relationship between intellectual property and competition law in the context of e-sports. He concludes that market definition is likely to play a central role in future competition law issues in this area.

With regard to future scenarios, a rather exotic contribution stems from the mysterious author *Just Szynkovid*, giving an account of a discussion between an intellectual property lawyer and his AI-parrot about drafting an intellectual property scheme for Mars. *Daniel Gervais* introduces Jaap, a law professor at the University of Amsterdam, who is trying to teach his students about liability of robots, before bumping into Emeritus Professor H., who is disgruntled about robots who have taken over the noble game of football.

Finally – looking back on the collection of essays in Part 6 – *Martin Kretschmer* takes us to a fantasy future where the Hugenholtz League (editors and

authors of this volume) is kicking off for its twenty-fifth season of professional academic e-gaming. This piece of fantasy offers legal analysis of the nature of e-sports, as well as veiled critique of academia and developments in science publishing.

At the end of this introductory chapter, we would like to thank all authors for the preparation of contributions to this collection of essays in honour of Bernt Hugenholtz – despite all unforeseen challenges and difficulties that have evolved during the corona pandemic. We are very grateful for the excellent organisational work and support provided by Anja Dobbelsteen and Margriet Pauws-Huisink at IViR, the strong support for this special project which the editor, Christine Robben, offered at Wolters Kluwer, and the very diligent and incredibly fast copy-editing carried out by Steve Lambley. Our special thanks go to Gerrit de Jager who used his ingenuity to provide illustrations for several essays.



Part 2

## Players and Sporting Achievements: Copyright and Celebrity Rights



# Protection of Sporting Achievements *per se* in Particular by Copyright Law: Some Notes about Justifications and Proper Boundaries

*Willem Grosheide*

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## 1. INTRODUCTION

With an eye on the theme of this *liber amicorum* I would like to define the subject of this contribution more precisely as follows: is it desirable if not necessary to legally protect sporting achievements *per se*, and if so, is intellectual property law, more particularly copyright law, the proper legal domain? The words *per se* refer to the fact that this contribution focusses on the act of practising sports or sporting achievements, not on inventing and producing accessory products such as clothing or instruments, on organising accompanying competitions or events, or on distributing or communicating images of the one or the other.<sup>1</sup>

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1. This *liber amicorum* to honour Bernt Hugenholtz can very well be seen as a follow up to the twenty-fifth anniversary conference of the IViR (<https://www.ivir.nl/influx/>) with its interesting closing panel 'Who owns the World Cup?' on the case for and against (intellectual) property rights in sports events (<https://www.youtube.com/watch?v=bm86FavgKxg>). With reference to the report of that closing panel discussion, made available on the internet, it may be said that the discussion ended – in sport terms – in a draw. That leaves sufficient room for further consideration of the topic indicated in the title of this contribution. In doing so, I will concentrate on the situation in Europe. It is understood that sporting achievements, athletes, sports events and sports organisers can very well be protected by various legal regimes. In this contribution, I restrict myself to copyright law and neighbouring rights law. The literature on the relation between sports and the law is abundant. However, it follows from the nature of this contribution that only limited use of references is possible. So see *inter alia* Robert C.R. Siekman, Janwillem Soek (eds.), *Lex Sportiva: What is Sports Law?* (T.M.C. Asser Institute, The Hague, 2012); Asser Institute/Institute for Information Law,

In order to underline how, over the years, the relationship between sports and intellectual property law has been fundamentally determined by sociocultural developments, I refer in this respect particularly to its nineteenth century's Western European origin. In that period of time that part of Europe saw – what has been called – an international awakening, i.e. an outburst in cooperation between its various national states, as a result of which many social and cultural evolutions and even revolutions took place.<sup>2</sup>

It appears that in the Western World, from the last part of the nineteenth century onwards, participation in sports became of major sociocultural interest, both nationally and internationally. A milestone in this respect was the Olympic Games of 1896. The same was true of the development of intellectual property law. A milestone in that respect was the conclusion in 1886 of the Berne Convention for the Protection of Literary and Artistic Works (BC). And although at the time intellectual property law was already applied to sports where it concerned the exploitation of their side-effects (e.g. early forms of merchandising), there was no direct and specific interrelation between the two. Various causes may explain this, among which seemed prominent the feeling that, since practising sports in those days was an elitist hobby, there was no need for protection, together with conceptual positive law objections (how to substantiate the object of protection?). But in the end it may well be that the lack of protection *per saldo* following the fact that the possibility of protection of sporting achievements *per se* by intellectual property law, nationally or internationally, simply had not been considered at the time.<sup>3</sup>

However, things changed considerably in the first half of the twentieth century, when important sociocultural developments, which announced themselves already at the end of the previous century, began to persevere: the democratisation, the professionalisation and the commercialisation of sports. Taken together, these developments made sports events become a major source of revenue and worthwhile exploitation. This had an effect on the valuation of both the sports event and the sporting achievement, the latter in relation to the status of the athlete.<sup>4</sup>

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*Study on sports organisers' rights in the European Union* – February 2014 (Van Rompuy & Margoni); Thomas Margoni, 'The protection of Sports Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection', *IIC* (June 2016); Péter Mezei, 'Copyright protection of sport moves', in Enrico Bonadio and Nicola Lucchi (eds.), *Non-Conventional Copyright* (Edward Elgar, Cheltenham, 2018), 271.

2. The expression 'international awakening' in relation to intellectual property is used by Edward W. Ploman and L. Clark Hamilton, *Copyright* (Routledge & Kegan Paul Ltd., London, 1980), 18 (no. 3).
3. See *inter alia* Stefan Zweig, *Die Welt von Gestern* (1944); English translation: *The World of Yesterday* (University of Nebraska Press, London, 2013); Brad Sherman and Lionel Bently, *The Making of Modern Intellectual Property Law* (Cambridge University Press, Cambridge, 1999/2008).
4. See Mike Cronin, *Sport: A Very Short Introduction* (Oxford University Press, Oxford, 2014), Ch. 5 – Business; Adam Lewis and Jonathan Taylor (eds.), *Sport: Law and Practice*, (3rd edn., Bloomsbury Professional UK, 2014); Raj Yadav, 'Commercialization of

As a consequence, these developments made it worthwhile for organisers of sports events and professional athletes to seek legal protection for their practices. Copyright law, it seemed, offered the best possibilities. The acts of athletes, so it was defended by their proponents, could very well be compared to and even equated with dancing when performing choreography. Others opposed this view and argued that sporting achievements *per se* could not be protected by copyright law since they did not allow enough space for personal creativity, which the positive law framework then required.

At the time the same objections were raised against physical human acts in the domain of performing arts (e.g. performing plays, ballets, concerts). But here the thinking started to change from the beginning of the twentieth century onwards. Indeed, already during the 1928 Rome Revision Conference of the BC, it was suggested to grant some sort of legal protection to performing artists for their acts, although for the time being political considerations stood in the way of their actual introduction. Apparently, according to the views on intellectual property law in the first half of the twentieth century, there were no longer any conceptual objections to drafting new intellectual property rights, such as neighbouring rights for performing artists. This finally led to the signing of the treaty on neighbouring rights, the Rome Convention (RC), in 1961.

As will be seen below, the same arguments pro and contra presented in the course of last century are still part of the actual debate on granting a special legal protection for sporting achievements *per se*.<sup>5, 6</sup>

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Sports and Competition Law' (24 December 2016), available at SSRN: <https://ssrn.com/abstract=2889622> or <http://dx.doi.org/10.2139/ssrn.2889622>.

5. See WIPO (ed.), *Introduction to Intellectual Property – Theory and Practice* (2nd edn., Kluwer Law International, 2017), Part. III – Chapter 8; Fabienne Brison, in Thomas Dreier and P. Bernt Hugenholtz, *Concise European Copyright Law* (2nd edn., Kluwer Law International, 2016), Rome Convention, Art. 9, note 2.
6. As a side note, it is worth mentioning that in the meantime, on the public law front, developments took place of no less importance for the interrelation between practising sports and the law. This concerns the rise of the global human rights movement. Although even at present no international human rights document *expressis verbis* protects practising sports and/or attaining sporting achievements *per se* as a human right, already at an early moment in the relevant discussion a relationship was made with the protection of participation in cultural life of the community in Article 27(1) UDHR 1948. This relationship is established more articulately in the UN 2030 Agenda in the world arena, in the European Sport for All Charter of 1975, and particularly in the Universal Declaration of Players Rights 2017 (Article 1: 'Every player has the right to a sporting environment that is well governed, free of corruption, manipulation and cheating and protects, respects and guarantees the fundamental human rights of everyone involved in or affected by sport, including the player'). For the moment, it can be observed that there exists a willingness among the epistemic communities involved to perceive the claim to practising sports and/or attaining sporting achievements *per se* by individuals, groups or communities as a human right. Such a human rights character would be of important significance when practising sports and/or attaining sporting achievements *per se* were accepted as subject matter under copyright law. Keep in mind that since the promulgation of the Charter of Human Rights of the European Union 2012, intellectual property is classified as a human right (Article 17(2)), it follows that such human rights character of practising sports and/or attaining sporting achievements *per se*, makes a collision with one or more other human rights

## 2. COPYRIGHTABILITY OF SPORTING ACHIEVEMENTS *PER SE*

Back now to the principal subject of this contribution: given the supposed desirability or need for legal protection for sporting achievements *per se*, is intellectual property law, more particularly copyright law, an adequate legal domain? Keeping in mind that, generally speaking, the different regimes of intellectual property law began to overlap in the course of the twentieth century, in the remainder of this contribution, only the option of copyright law as a protective regime will be discussed.

At the outset, it should be noted that the transition of industrial society into information society has put the positive law framework of copyright law, and particularly the work concept as one of its main instruments, under pressure. Indeed, this transition required a gradual adjustment of copyright law as a protective regime primarily for the immaterial values anchored in literary and artistic works (Article 2 BC) according to their original meanings, into a regime for the protection of commercial interests beyond the artistic domain. As a consequence, copyright protection is increasingly sought for objects that were formerly not regarded as copyrightable subject matter (i.e. works). Sporting achievements *per se* are one of those.<sup>7</sup>

However, because of the unchanged copyright positive law framework, the copyrightability of 'new and atypical works' (see Bonadio and Lucchi) still has to be measured against traditional standards. As is well known, it follows that two questions must be immutably answered. First: what human acts can be classified as works? Secondly: if a work exists, is it original enough to be protected? It appears that the first question regarding the work concept is seldom discussed or answered in separation from the second question. Neither does any consulted national or international regulation define the work concept. It turns out that, nationally and internationally, both the literature and the applicable regulations suffice with giving examples of works in either open or closed catalogues. Regarding the second question, it appears that the originality standard is generally defined as an independent creation, which means that the

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quite conceivable. Where to strike the balance and how to define the scope of monopoly power that gives athletes who attain a specific sporting achievement sufficient incentive to perform, while ensuring that the public at large has adequate access to the outcomes of their efforts, is still to be seen. See *inter alia* Willem Grosheide (ed.), *Intellectual Property and Human Rights – A Paradox* (Edward Elgar, Cheltenham, 2010); Gabriele Spina Allì, 'Intellectual Property and Human Rights: A Taxonomy of Their Interactions', 51 *IIC* (2020), 411. See ECHR, Application no. 526/18 of 11 February 2020 (*Platini v. Switzerland*), about a claim against a four-year suspension from professional football activities, instigated under Article 8 ECHR (right to respect for private and family life) which was unanimously declared inadmissible. See also the relevant CJEU case law under the InfoSoc Directive and the Charter of Fundamental Rights of the European Union, 2012/C 326/02.

7. See Robert M. Kunstadt, F. Scott Kieff and Robert G. Kramer, 'Are Sports Moves Next in IP Law?', *National Law Journal*, 20 May 1996, c1.

work is the author's own intellectual creation.<sup>8</sup> How do sporting achievements *per se* fit into this framework?

With regard to the first question of whether sporting achievements *per se* can be considered as works, it must be noted that the literature offers many examples of famous sports moves that became legendary and which might be eligible as works. The 'T formation' in American football by coach Clark Shaughnessy; the 'Zidan trick' and the 'Panenka penalty' in soccer; Michael Jordan's 'Air Jordan dunk' and Bob Cousy's behind-the-back pass in basketball; the 'Berki element' in pommel horse gymnastics; or the 'Sneak Attack by Roger [Federer]' (SABR) in tennis can be mentioned here.

Proponents of copyright protection have argued that, since no international binding copyright regulation offers an extensive or exhaustive list of classes of works protected by copyright, national copyright laws may accept novel forms of human endeavour as works. This argument is more valid for national laws with an open catalogue of works than for national laws with a closed one. Further, the copyrightability of sporting achievements *per se* is defended by comparing them with performances, in particular dance, whether connected to works of choreography or not. I will come back to this comparison in section 3 in my discussion of the Asser/IViR report.<sup>9</sup>

Opponents of this view seldom come to terms with this first question. If they do so, their objection to accepting sporting achievements *per se* as works is that copyright law was never intended to protect sporting achievements. Obviously, this is a non-argument because, as the history of copyright law shows, copyright law is constantly evolving. But generally speaking, opponents discuss the first question as part of the second question.<sup>9</sup>

The second question concerns the originality of sporting achievements *per se*. What are the legal consequences of another athlete performing – i.e. copying or imitating, or associating himself or herself with – the original athlete's achievement? Although civil law and common law traditions differ in places on this question, for both traditions – in the words of Goldstein and Hugenholtz – the 'nearly universal emphasis on authorial presence as the standard for protection explains the wide-spread assumption that the Universal Copyright Convention, no less than the Berne Convention, predicates protection for the product of human intellect and creativity'.<sup>10</sup> In other words, protection is given to the author's

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8. A real *Fundgrube* on the question of whether new and/or atypical works can or should be given copyright protection is Bonadio/Lucchi's book mentioned *supra* note 1. It gives a rather kaleidoscopic image of the topic. On sports in particular, see Mezei, *supra* note 1, p. 271.
9. See e.g. Giuliana R. Garcia, 'He Shoots, He Scores...and Receives Copyright Protection? How the Current State of Intellectual Property Law Fumbles with Sports', 11 *U. Denv. Sports & Ent. L.J.* (2011), 81.
10. Paul Goldstein and P. Bernt Hugenholtz, *International Copyright* (2nd edn., Oxford University Press, Oxford, 2010), 189. This indeed is the correct line of reasoning, although the *travaux préparatoires* for the BC indicate that the requirement of 'intellectual creation' is implicit in the concept of 'literary and artistic work'; Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond* (Oxford University Press, Oxford, 2006), §8.03.

own intellectual creation, provided that it is created independently, i.e. is not copied. It is the author's personal expression that counts. Novelty, aesthetic merit, conscious creation or usefulness play no part.

According to the proponents of copyright protection, this is exactly what counts for sports moves. Opponents, however, argue amongst other things that athletes in most sports make unpredictable moves with the result that it is impossible to make a permanent copy thereof which would be required in this view for the exercise of the reproduction right. Related objections hold that sporting achievements are purely or mostly functional, are dictated by the rules of the game, have a competitive character, are confined to the limited timespan of the athlete's career, and can be enjoyed only at the moment they are performed, whereas most works of art can be enjoyed at any time.<sup>11</sup>

### **3. THE ASSER/IViR REPORT ON SPORTS ORGANISERS' RIGHTS IN THE EU**

In this respect the 2014 Asser/IViR report on the status of sports organisers' rights in the EU is of special interest.<sup>12</sup> Although not primarily concerned with the legal protection of sports events (as such), the report nevertheless touches upon the protection of sporting achievements *per se* by copyright law or neighbouring rights law. Noting that, generally speaking, a sports event (as such) does not enjoy legal protection by copyright law, neighbouring rights law or any other intellectual property law in any of the EU Member States, and that this is in line with EU law as confirmed by the case law of the Court of Justice of the European Union (CJEU), the Asser/IViR report concludes that as a consequence sporting achievements by athletes and players cannot be protected by copyright or neighbouring rights law.<sup>13</sup>

Although the view can be endorsed that, in view of existing positive law in the EU as interpreted by the CJEU, a sports event (as such) today is still not protectable by copyright law or neighbouring rights law, the reasoning applied in the report is questionable.

First comes the possibility of copyright protection. On this point, it appears that the Asser/IViR report does not properly distinguish between the work concept and the originality requirement. According to the Asser/IViR report, it follows from the collected information that:

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11. Pro protection e.g.: Viola Elam, 'Sporting events as dramatic works in the UK copyright system', 13(1) *Entertainment and Sports Law Journal* (July 2015), doi: <https://doi.org/10.16997/eslj.1>, para. 40. Contra protection e.g.: Mezei, *supra* note 1, 291; Antoon A. Quaedvlieg, 'Three Times a Hybrid – Typecasting Hybrids Between Copyright and Industrial Property', in Jan J.C. Kabel and Gerard Mom (eds.), *Intellectual Property and Information Law*, Information Law Series (Kluwer, Deventer, 1998), 47.
12. See Asser/IViR report, *supra* note 1, Part 1, Chapter 1.
13. The most relevant decisions of the CJEU are: CJEU 16 July 2009, C-5/08, ECLI:EU:C:2009:465 (*Infopaq I*); CJEU 4 October 2011, C-403/08 and C-429/08, EU:C:2011:631 (*Premier League*); CJEU 12 September 2019, C-683/17 (*Cofemel*). In this respect, the *Premier League* decision is of particular interest, since the Court seems to leave room for additional national solutions to copyright law.

[a] sports event as such is not a work of authorship under common principles of copyright law ... The absence of any original or creative form of expression, the uncertainty enveloping the execution of the game, race, or competition, and the structural lack of a script or plot – a large part of the interest in a sports event being its unpredictability and randomness – are mentioned by national correspondents as the reasons why sports events generally fail to qualify as a works of authorship.<sup>14</sup>

However, neither the interviewed experts nor the researchers themselves answered the question as to whether a sports event (as such) could be considered as a work of authorship. Had they come to terms with defining the work concept, they would have been obliged to explain why sports events (as such) as special human acts could not be inserted into a new category of works in the open catalogue of Article 2 BC. The introduction of the protection of computer software and databases into the copyright system illustrates that this can be done.<sup>15</sup>

In the end, rejection of copyright protection is based on the presumed lack of originality of the sports event (as such). According to the Asser/IViR report, this rejection follows – in summary – from three related properties of the sports event: (a) the lack of creative expression; (b) the uncertainty and unpredictability of the execution; (c) the lack of a structural plot. But at least properties (b) and (c) equally apply to, for example, musical interpretation and improvisation which are unmistakably copyrightable. This makes the Asser/IvIR arguments less convincing. And although execution of copyright presupposes a certain degree of permanency and stability of the work in question, this is not a requirement for its copyrightability. It is recalled in this context that Article 2(2) BC leaves it to the member countries to decide whether works must be ‘fixed’ to enjoy copyright protection.

As part of its discussion about the copyrightability or neighbouring-rightsability of the sports events (as such), the Asser/IViR report, also more or less in passing addresses the protection of sporting achievements *per se* under copyright law and neighbouring rights law. With regard to copyright law the report concludes that, with the possible rare exceptions of sporting achievements following a predefined, creative script, as is perhaps the case for figure skating, gymnastics and similar dance-related sports, on the basis of the survey of EU national laws and in accordance with the CJEU case law, sporting achievements *per se* cannot be considered works of authorship. Equally, since sports events (as such) do not qualify as works, an athlete who is making sport moves does not

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14. See Asser/IViR report, *supra* note 1, p. 29 (Section 1.2.2).

15. See inter alia John M. Griem Jr., ‘Against a Sui Generis System of Intellectual Property for Computer Software’, 22(1) *Hofstra Law Review* (1993), Article 4; Jane C. Ginsburg, ‘Four Reasons and a Paradox: The Manifest Superiority of Copyright over Sui Generis Protection of Software’, 94 *Colum. L. Rev.* (1994), 2559; Lester C. Thurow, ‘Needed: A New System of Intellectual Property Rights’, *Harvard Business Review* (September-October 1997), 95–103. See also Art. 15 DSM Directive introducing a special neighbouring right for the protection of press publications concerning online uses.

perform a work and as a consequence cannot be considered a performer under the RC.<sup>16</sup> This reasoning again seems questionable.

First, despite the deletion of the proposed Article 12a on the protection of sports events organisers from the DSM Directive, which may be seen as a contra-indication to the prospect of a possible specific right for sports events (as such) in the EU, other reported developments in the EU and worldwide (i.e. the USA) do signal a trend to protect sports events (as such) in one way or another. This may well have a positive effect on the willingness to protect sporting achievements *per se* as well.

Secondly, given that Article 9 RC permits contracting states to extend the protection of the Convention to artists who do not perform literary or artistic works, it seems quite possible, within the framework of the Convention, to equate the position of an athlete to that of a variety of persons whose performances are not connected to literary or artistic works (e.g. circus artists).<sup>17</sup>

#### 4. RELEVANT CASE LAW OF THE CJEU

In the light of the foregoing, some comments seem in order with regard to the case law of the CJEU.

With regard to copyright law it is clear that the CJEU also does not make the necessary distinction between the work concept and the originality requirement. In fact, anything that can be original qualifies as protectable subject matter. Phenomena like tastes (and smells, feelings and the like, one may assume) and human acts like (organising) sports events *per se* and sporting achievements (*per se*) are denied copyright protection, not because they do not qualify as works, but because they are not original. In summary, for a work to be original the CJEU prescribes that: (a) it must concern subject matter which is original in the sense that it is its author's own intellectual creation; (b) it is expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression does not need to be in permanent form; (c) it is not subject to rules of a game, which do not leave room for creative freedom.<sup>18</sup>

So, what these decisions present is a further sharpening of the originality requirement but by no means a delineation of the work concept. Besides, the decisions do not make clear why a sporting achievement *per se* is not equally copyrightable as, for instance, a musical interpretation or improvisation. Particularly element (b) of the sharpened originality requirement needs clarification. Although presented in relation to the originality requirement, this element, it seems, is in fact more closely related to the work concept. In that sense, while

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16. See Asser/IViR report, *supra* note 1 (with references *supra* note 14).

17. The Directive on Copyright in the Digital Single Market, formally the Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC has been adopted and came into force on 7 June 2019. The proposed Art. 12a provided that only the organiser of a sports event had the right to reproduce and make available footage of its events. On neighbouring rights see Brison, *supra* note 5, Rome Convention, Art. 9.

18. See *supra* note 13.

musical improvisation in contrast to a musical composition lacks any notation, it is definitively identifiable with sufficient precision and objectivity. And is improvising on a ‘theme and variations’ or following the form of a ‘fuga’ or ‘rondo’ not comparable with playing a game subject to its rules?

As far as protection by neighbouring rights or *sui generis* rights is concerned, the *Premier League* decision leaves the door open for an intellectual property law related protective regime.

## 5. CONCLUSION

In light of the foregoing paragraphs I conclude as follows.

At present there are no international positive law objections to protecting practising sports or sporting achievements *per se* under any national intellectual property law regime, be it copyright law, neighbouring rights law or a *sui generis* rights law regime. Legal developments over the last sixty years have made such protection possible by gradually adjusting, over and over again, the frameworks of international intellectual property law, particularly those of copyright law and neighbouring rights law under the BC and RC.

With regard to copyright law, taking account of the sociocultural context in which practising sports and/or sporting achievements are attained, one can think of granting copyright protection only to professional athletes, and adapting to that aim the actual system of limitations and restrictions as regulated in the BC and the various EU directives to avoid sports events being unnecessarily hindered. A tailor-made approach in other words.

With regard to a special *sui generis* law regime it is obvious that, when designing such a new regime, affiliation can be sought with existing neighbouring rights regimes.

On these points, my interpretation of the existing positive international and EU legislation differs from that offered in most of the referenced literature and in particular from that substantiated in most court decisions, especially in those of the CJEU.

So it appears that, according to the leading approach of practising sports or sporting achievement protection by copyright law, a related rights law regime or any other special legal regime at present is out of the question. In view of that state of affairs, to achieve that goal, legislative adaptation cannot be avoided. However, insofar as this would already be possible on a national scale, such adaptation, if any, of the relevant international framework is certainly not to be expected within the foreseeable future. As was reported about the state of affairs at the beginning of the twentieth century, political considerations are standing in the way of its actual introduction.

Considering that in the end those who would take advantage of any such adapted or special legal regime would only be the great names among professional athletes, not the lesser ones let alone the amateurs, it is debatable whether or not the actual state of affairs is really detrimental to practising sports and/or sporting achievements. Besides, one may wonder whether the great effort it would take introducing a special protective legal regime for practising sports and/

or sporting achievements would be worth the effort. Moreover, it may well be that other legal regimes, such as contract law, image rights law, trademark law or unfair competition law, will continue to function sufficiently well to protect the interests of particularly professional athletes. On the other hand, one can imagine that a special form of legal protection for professional athletes would strengthen their professional position.

All this leads me to the final conclusion that a sport that is practised can indeed be protected by intellectual property law, particularly by copyright law. But taking into account the expected modest benefits of following the legal route and the foreseeable difficulties in doing so, I doubt whether a legal answer to the question is the best answer. In light of that, I prefer a non-legal approach similar to that proposed by Mezei. ‘The overprotection of sport moves’, he writes, ‘appear to be detrimental to the normal functioning of amateur and professional sports. As an alternative to copyright law, the most effective “protection” of ... individual sport moves would be an extra-legal “professional honouring method”’.<sup>19</sup> Mezei offers various ways in which this honouring could be executed. It may well be that such non-legal appreciation of their performances would strengthen the commercial position of professional athletes as a legal right would equally do. But the essence of Mezei’s proposal is that it is extra-legal.

Too much law is too much of a good thing. Indeed, a juridification of society should be avoided, as it could very well be against the public interest.

#### **POST SCRIPTUM**

Those who know Bernt Hugenholtz know equally well that he is a great fan of soccer, particularly of his favourite Amsterdam football club Ajax. In the 1960s and 1970s, Ajax celebrated national and European triumphs and victories with a team of which the late left winger Piet Keizer was a member. Europe-wide, if not worldwide, Piet Keizer was famous for a very special act, called ‘the scissors move’, an unpredictable way of passing his opponent. I am convinced that, over the years, Bernt Hugenholtz has very much enjoyed the football play of Piet Keizer. However, I am less convinced that this enjoyment would have made him an advocate of either copyright protection or protection by a special protective regime of sporting achievements. As is equally well known, he is a firm opponent of overstretching protection by intellectual property law.<sup>20</sup> So it remains an intriguing question as to what suggestions Bernt Hugenholtz would possibly offer when asked to improve the status of athletes, should he consider it desirable or even necessary under the actual sociocultural circumstances. It might well be that non-legal suggestions, such as those quoted from the study by Mezei in the final conclusion, would turn out to be his preference. But reflecting upon that is beyond the subject of this contribution.

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19. See Mezei, *supra* note 1, p. 297. Comp. Asser/IViR report, *supra* note 1, p. 38 (Section 1.2.5 on Special forms of protection: sports codes).

20. See *inter alia* Bernt Hugenholtz, ‘Why the Copyright Directive is Unimportant, and Possibly Invalid’, 11 *EIPR* [2000], 501.

# Get a Move On: Copyright in Movement<sup>1</sup>

*Séverine Dusollier*

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*Minister:* Good morning. I'm sorry to have kept you waiting, but I'm afraid my walk has become rather sillier recently, and so it takes me rather longer to get to work. Now then, what was it again?

*Mr. Pudey:* Well sir, I have a silly walk and I'd like to obtain a Government grant to help me develop it.

*Minister:* I see. May I see your silly walk?

*Mr. Pudey:* Yes, certainly, yes.

(He gets up and does a few steps, lifting the bottom part of his left leg sharply at every alternate pace. He stops.)

*Minister:* That's it, is it?

*Mr. Pudey:* Yes, that's it, yes.

*Minister:* It's not particularly silly, is it? I mean, the right leg isn't silly at all and the left leg merely does a forward aerial half turn every alternate step.

*Mr. Pudey:* Yes, but I think that with Government backing I could make it very silly.

*Minister:* (rising) Mr. Pudey, (he walks about behind the desk in a very silly fashion) the very real problem is one of money. I'm afraid that the Ministry of Silly Walks is no longer getting the kind of support it needs. You see there's Defence, Social Security, Health, Housing, Education, Silly Walks ... they're all supposed to get the same. But last year, the Government spent less on the Ministry of Silly Walks than it did on National Defence!

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1. This article expands on a former dialogue we held, Valérie-Laure Benabou and myself, on copyright in movement in 2008 in Brussels, during the Jonctions festival organised by the artists collective Constant. It has been partially published as V.L. Benabou and S. Dusollier, 'Du droit d'auteur sur les mouvements, de l'interprétation du droit d'auteur', *Le journal des laboratoires*, Les Laboratoires d'Aubervilliers (May–August 2012), 26–33.

Now we get £348,000,000 a year, which is supposed to be spent on all our available products.<sup>2</sup>

Bernt Hugenholtz would certainly immediately recognise this dialogue, extracted from one of the most famous Monty Python sketches. John Cleese, one pillar of the British troupe, was already a source of inspiration for one of Bernt's most brilliant and funniest lectures on copyright exceptions, 'Fierce creatures – Copyright Exemptions: Towards Extinction?'.<sup>3</sup> I heard him delivering that talk in Amsterdam in October 1997, during one of the EU-funded IMPRIMATUR conferences that then gathered all stakeholders and scholars who mattered around the nascent topic of digital rights management in copyright. For a young researcher starting her career in a satellite research project on the same theme, as for a confirmed academic alike, Bernt's publications and conferences have always been stimulating and thought-provoking. 'Fierce creatures' was one of the first attempts in copyright scholarship to distinguish between exceptions and strengthen their existence in the digital environment. As with many of his publications, it has become a classic.

But let's come back to silly walks, which give me the pretext to talk about copyright in movement, the only topic that my complete absence of interest in sports could most closely associate with the topic of IP and sports, to which this *Festschrift* is dedicated. John Cleese plays the Minister in charge of development of silly walks and assesses the merit of a walk performed by Michael Palin in order to grant him some subsidy to further develop his particular walk. Behind the hilarious walks performed by the actors, this sketch is an interesting allegory to rights in valuable intangible products. Only walks that go beyond banality could get a grant helping individuals to support and develop their particular walk, upon condition of its silliness (the walk, not the individual).

This policy of supporting innovation and originality in ways of walking is of paramount importance, according to the Minister, as much as health, education or national defence. As in intellectual property, the objective is incentivisation, as well as a matter of national development of 'walkative' innovation, to be able to compete with the outstanding Japanese or Israeli walkers Cleese refers to later on in the sketch. Compared to our intellectual property system, the grant does not appear to confer any exclusivity or property right in the walk, only a State-supported award to enhance its development, which is a rather different model to incentivise intellectual innovation. However, by definition, the walk will be proper to one individual as it would convey his or her idiosyncratic gait, as a fact if not by law. Each silly walker will 'own' it in a way.

Could our intellectual property system, and particularly copyright, similarly vest some individual ownership or reward in movement?

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2. Transcript of 'The Ministry of Silly Walks' sketch from the television show *Monty Python's Flying Circus*, series 2, episode 1, first aired on 15 September 1970.
3. P. Bernt Hugenholtz, 'Fierce creatures – Copyright exemptions: Towards extinction?', in *Rights, Limitations and exceptions: Striking a proper balance*, Conference IFLA/IMPRIMATUR, Amsterdam, 30–31 October 1997.

The closest the CJEU got to address this question was in the *Football Association Premiere League* case and the issue of copyrightability of football matches (back to sports!). When the judges in Luxembourg had to decide whether a football match could be a copyrighted work, they largely avoided the question, or to use a sporting metaphor, they kicked the ball into touch (it might work better with the French expression ‘*botter en touche*’). Instead, the European jurisdiction resorted to originality by considering that ‘football matches, ... are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright’.<sup>4</sup> This assertion is more than contestable as originality and creative choices might have a place even when creation is constrained by rules. Football fans could also blame the Court for its indifference to the genius of football players and the creativity they deploy in the game.

Anyway, the decision did not really solve the copyrightability of a sporting move in itself, such as a penalty kick, a skating jump, a rugby pass, an elegant dive or any graceful gymnastic figure. If the athletes who ‘create’ or embody them could sometimes have their names associated with them in a permanent way, could they also enjoy an exclusive right or a monopoly therein?

Without pretending to carry out an extensive overview of the issue of IP rights in sports,<sup>5</sup> I will rather idly explore the issue, before expanding the question of copyright in any type of movement and its recent digital embodiment.

## 1. TESTING THE COPYRIGHTABILITY OF SPORTING MOVEMENT

Copyrighting sporting movement is a 110-metres hurdles event. A first obstacle is the notion of literary and artistic work. This concept is not limited to the artistic or cultural field, yet the expression needs to be conveyed in a literary or artistic medium or form.

A move in sports has a function: a good move would be to score or outrun other players; it is useful and aims for success.<sup>6</sup> Conversely the objective of a copyrightable work is not a matter of utility but of aesthetics. The work does not need to be beautiful, it can be ugly, but it seeks an aesthetic expression, irrespective of its possible usefulness. Yet numerous works protected by copyright are situated on the indistinct blurry border between aesthetics and utility, and it is certainly true with some sports.<sup>7</sup> For instance, artistic skating or synchronised swimming are a hybrid between choreography and sportive performance and skill.

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4. CJEU, 4 October 2011, C403/08 & C429/08, ECLI:EU:C:2011:631, *Football Association Premiere League*, para. 98. However the CJEU recognised the possibility of protection of the broadcast of the match. See also, *Baltimore Orioles, Inc., v. Major League Baseball Players Association*, 805 F.2d 663 (7th Cir., 1986) (admitting the copyrightability of the telecasts of baseball games, as audiovisual works).

5. Such an extensive analysis can be found in the excellent paper by Peter Mezei, ‘Copyright Protection of Sport Moves’ in Enrico Bonadio and Niccola Lucchi (eds.), *Non-Conventional Copyright* (Edward Elgar, Cheltenham, 2018), 271–297.

6. *Ibid.*, 279.

7. *Ibid.*, 281 et seq., for a comprehensive and fascinating empirical study of the role of creativity and functionality in different sports.

The functionality of a work is not in itself an obstacle to copyright protection, but in the *Brompton* decision, the CJEU insisted that the technical effect of a work should however leave enough space for free and creative choices to satisfy the condition of originality.<sup>8</sup>

Another hurdle is the possible lack of intentional creation. Indeed a work is eligible to copyright if it results from an act of creation. Many copyright laws state that the work is protected *from* the act of creation, which not only precludes any formality or registration, but also relates the subject matter of protection to a creative ‘act’. Can it be read as requiring some level of consciousness of the creation or of the creation process?<sup>9</sup> I would say yes. Likewise, Bernt Hugenholtz once wrote, in a critical comment of the *Endstra tapes* case in the Netherlands that addressed the question of copyrightability of conversations,<sup>10</sup> that creation is by its very nature a conscious human act.<sup>11</sup> Spontaneous works, created on the spur of the moment, could benefit from copyright protection, but only if that spontaneity partakes of a process that is thought of as creative. Whereas the silly walker consciously walks in that fashion after much effort and investment, my own walk might be ridiculous, but I am not consciously creating it, nor am I improvising it in a creative frame. If some sporting moves are the outcome of thoughtful consciousness, others might be highly improvised. That intentionality of creation might distinguish again between the skater and the footballer.

Relatedly, the CJEU requires that the work could be identified with sufficient precision and objectivity,<sup>12</sup> a condition that it borrows from trade mark law. I disagree with that additional condition as there is no need in copyright law, in contrast to trade mark law, to ascertain the exact scope of the object to be protected: copyright works can be subjectively perceived and are to some extent indeterminate. Choreographic moves might be improvised but still protected, and the necessary delimitation of the scope of protection is an evidentiary issue, not a condition for protection.

Yet, the Spanish Supreme Court has applied this requirement of a precise and objective determination of the work to deny copyright protection to moves of a matador during a bullfight.<sup>13</sup> The sequence that was registered by the matador consisted in a shift of hands from one side to the other that distracts the animal and enables the man to bypass the bull. The Spanish judges held that, despite the possibility to make beautiful movements and figures, the sequence cannot be copied as it would depend each time on uncertainty introduced by a different

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8. CJEU, 11 June 2020, C-833/18, ECLI:EU:C:2020:461, *Brompton Bicycles*, para. 26.
9. See on that point, André Lucas, Agnès Lucas-Schloetter and Carine Bernault, *Traité de propriété littéraire et artistique* (5th edn., LexisNexis, Paris, 2017), 77, as well as the Swiss Federal Court decision (14 June 1990, *ATF* II 116 351) granting copyright to messages pronounced by a medium in trance. In the Netherlands, the Hoge Raad has refused to impose a condition of conscious choice, see Hoge Raad, 30 May 2008, *Zonen Endstra v. Nieuw Amsterdam*, NJ 2008, 556, commented by P. Bernt Hugenholtz, ‘De Endstra tapes’, *Ars Aequi* (November 2008), 1–4.
10. Hoge Raad, *supra*, note 9. That decision held that no intentionality of creation is required.
11. Hugenholtz, *supra*, note 9, 4.
12. CJEU, *Brompton*, *supra* note 8, para. 32.
13. Tribunal Supremo, sala de lo Civil, 16 February 2021, Sentencia núm. 82/2021.

bull and its random behaviour.<sup>14</sup> The requirement of reproducibility introduced in that decision is however not a condition for copyright protection.

A further requirement for protection is originality. To enjoy copyright, the move, whether in sport or in daily life, needs to result from creative choices and reflect the personality of its author. On that ground, the court of appeals of Paris declined to recognise copyright protection in a sequence of moves performing some form of martial art, considering that such a performance consisted in a series of technical and codified positions that did not convey a personal or original choreography,<sup>15</sup> even if such moves were re-enacted during an event promoting this sport, thus choreographed to some extent, and not during a fight or competition. As seen above, the CJEU similarly denied copyright protection to football moves due to the existence of the rules of the games that prevent creative choices. The moves of a matador during a bullfight are likewise devoid of free and creative choice by reason of the many constraints and rules of corrida, according to the Spanish Supreme Court.<sup>16</sup>

## 2. MOVES AS IDEAS

The requirement of originality excludes banal movements, such as kicking a ball, jumping, flicking, or scratching one's nose. But what about a succession of banal movements? If I scratch my nose six times in a row, before pulling my ear,<sup>17</sup> would this sequence of moves gain in originality? Is it a matter of degree then? Or should the originality be found only in sequences of moves, that are closer to choreography, for they convey creative and intentional choices?

Formulating the question as such is close to considering simple movements as the basic blocks for an expression that could be subject of copyright, like notes or words that in themselves are not protected. Moves would be the basic vocabulary that could never be monopolised or subject to private and exclusive rights. They would belong to the category of ideas, immune from copyright protection, or would not amount to an intellectual creation.<sup>18</sup>

On that ground, a US court of appeals refused copyright protection to a sequence of twenty-six yoga poses and two breathing exercises.<sup>19</sup> More precisely the sequence of postures was considered as a process to maintain optimal

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14. The judges compared it with choreography where a system of notation enables the movements of the dance in which the original creation of the author consists to be identified with precision and objectivity.

15. Cour d'appel de Paris, 14 décembre 2007, *Hassane Thierry Guerrib et Frank Delhaye v. Européenne de Magazine, Propri. intell.*, 2008, 225, obs. Jean-Michel Bruguière.

16. Tribunal Supremo, *supra* note 13.

17. Some contemporary choreographers excel in the art of combining banal movements.

18. By analogy, CJEU, 2 May 2012, C-406/10, ECLI:EU:C:2012:259, *SAS Institute*, para. 66 ('the keywords, syntax, commands and combinations of commands, options, defaults and iterations consist of words, figures or mathematical concepts which, considered in isolation, are not, as such, an intellectual creation of the author of the computer program').

19. *Bikram's Yoga College of India, L.P., v. Evolution Yoga, LLC, et al.*, 803 F.3d 1032 (9th Cir. 2015).

health ‘which primarily reflects function, not expression’. The decision held that: ‘successions of bodily movement often serve basic functional purposes. Such movements do not become copyrightable as “choreographic works” when they are part and parcel of a process.’ Even beyond that particular sequence of yoga *asanas* that the court of appeals would connect with a healing function, the decision hints at the impossibility that movements in themselves would be eligible to copyright protection on the ground of the idea/expression dichotomy:

Our day-to-day lives consist of many routinized physical movements, from brushing one’s teeth to pushing a lawnmower to shaking a Polaroid picture, that could be (and, in two of the preceding examples, have been) characterized as forms of dance. Without a proper understanding of the idea/expression dichotomy, one might obtain monopoly rights over these functional physical sequences by describing them in a tangible medium of expression and labeling them choreographic works. The idea/expression dichotomy thus ensures that expansive interpretations of the categories enumerated as proper subjects of copyright will, ‘[i]n no case’, extend copyright protection beyond its constitutional limits.

According to this reasoning, isolated movements would not be protected, constituting basic blocks of expressions or mere ideas, nor sequences of movements that pursue a determined function. This decision walks a fine line between the exclusion of functions from copyright and the idea/expression dichotomy. A similar argument can be found in the Spanish decision about bullfighting as the matador did not claim protection in individual passes that are the basic vocabulary of that ‘sport’, but only in a specific sequence he deemed original and personal.

Would that leave the door open to sequences of movements that are not properly functional? Copyrighting a walk would then be impossible, but copyrighting a silly walk that stands in the way of the normal function of moving forward could be.

Choreographic sequences of movements, even trivial ones, have been protected by copyright in many countries, if they are creative and original.<sup>20</sup> For instance a scene in a ballet consisting of a dancer crossing the stage at a slow pace, with TV sets attached to his feet, interrupted by a pause, is a work of authorship, but the slow-paced walk in isolation would not be.<sup>21</sup>

### **3. MOVING IN DIGITAL STEPS**

If simple moves generally do not claim copyright protection, very brief sequences of moves might raise some issues, as demonstrated by recent litigations related to dance in digital contexts. In the US, several copyright infringement suits were filed against Epic Games, the company owning the Fortnite game, by individuals who had developed a particular dance move or routine, to stop their moves from

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20. See the contribution by Marie-Christine Janssens in this volume.

21. Civ. Bruxelles (cess.), 27 February 1998, *Frédéric Flamand v. Maurice Béjart*, J.L.M.B., 1998, p. 821; Court of Appeal of Brussels, 18 September 1998, I.R.D.I., 1998, p. 346.

being used as ‘emotes’ by digital avatars in the game, emotes being movements that an avatar performs to express emotions. Dances performed on TikTok have also resulted in reappropriation in digital form, in Fortnite or in other contexts. The creators of the dance routine are mostly unhappy that they are not credited when the dance is integrated into a video game or any other commercial product, but they sometimes seek financial compensation too.

Most of the time, the movement at stake is rather short and could not easily qualify as a choreography. One example is the claim made by the rapper 2 Milly that his Milly Rock Dance<sup>22</sup> was reproduced without his authorisation as an ‘emote’ performed by an avatar in season 5 of *Fortnite*.<sup>23</sup> Actually the portion of the dance reproduced by the digital character is limited to two or three postures and basic moves, consisting, according to the rapper, in ‘a side step to the right while swinging the left arm horizontally across the chest to the right, and then reversing the same movement on the other side’.

The rapper finally withdrew his suit<sup>24</sup> and the registration of the dance was refused by the US Copyright Office,<sup>25</sup> but comments thrived on the web on the issue of admitting a monopoly on a dance step and routines, and their proper delineation from copyrightable choreographies. The Copyright Office has also rejected the registration of the so-called Carlton dance, first performed by Alfonso Riveiro in the *Fresh Prince of Bel-Air*, and faithfully reproduced by another Fortnite emote, for being too simple.<sup>26</sup> The Copyright Office dictum is supported by its circular on copyright registration of choreography and pantomime that indicates that ‘choreography and pantomimes consisting of ordinary motor activities, social dances, commonplace movements or gestures, or athletic movements may lack a sufficient amount of authorship to qualify for copyright protection’.<sup>27</sup> Among the moves ineligible for protection, the circular evokes individual movements, dance steps, yoga positions, simple routines, social dances, functional physical movements, athletic movements, ordinary motor activity, skateboarding or

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22. That can be seen at <https://www.youtube.com/watch?v=MWkJAE9J9SM>.

23. The copied movement can be seen at <https://www.youtube.com/watch?v=LRTEFcB1zSI>.

24. For recent news on that case and other suits against Epic Games, see A.J. Park, ‘The dance-off ends: a (partial) resolution to Fortnite’s slurry of copyright lawsuits’, 17 November 2020, available at <https://www.lexology.com/library/detail.aspx?g=32bcc55-88e7-4b47-92de-52e8bfc5762e>.

25. With a disputable motivation as choreographic works are said to be reserved to performances by skilled dancers for an audience, whereas ‘social dances’ and similar movements not created by professional dancers would be excluded from this definition (quoted in M.A. Weiss, ‘Copyrighting a dance step? Between a Hard (Milly) Rock and a Copyright Office’, *The 1709 Blog*, 18 February 2019, available at <http://the1709blog.blogspot.com/2019/02/copyrighting-dance-step-between-hard.html>). That would exclude urban dances from copyright protection which conveys an inadmissible racial and social bias.

26. E. Harris, ‘Carlton Dance Not Eligible for Copyright, Government Says’, *New York Times*, 15 February 2019, <https://www.nytimes.com/2019/02/15/arts/dance/carlton-dance.html>

27. Available at <https://www.copyright.gov/circs/circ52.pdf>. See also chapter 800, sections 805 and 806 of the *Compendium of US Copyright Office Practices*, available at <https://www.copyright.gov/comp3/chap800/ch800-performing-arts.pdf>.

snowboarding tricks or routines not performed by humans.<sup>28</sup> The Monty Pythons would have had a hard time registering their silly walks!

#### 4. THE MOVING SUBJECT

Last but not least, an issue in copyright and movement is the presence of a body, which is the indispensable vehicle of the movement, its 'embodiment'. Movements are performed by bodies, whether athletes, dancers or John Cleese.

Who owns the move then? Its creator, or the body who performs it? They are the same for sporting moves and silly walks, but not necessarily for other sorts of movement, choreographic or not, and the dividing line between a copyright and performer's right here might be difficult to draw. The limited size of this paper will prevent me from delving into this fascinating question.<sup>29</sup>

Sometimes, the body is even absent. The recent cases against Fortnite could completely turn the question upside down: what about moves originally performed by digital avatars? Would they be creations, and by whom? If not performed by human body, is a move by an object or a digital embodiment of a move a copyrightable work (the question of artificial intelligence left aside)?

In 2003, the court of appeal of Paris decided an intriguing case about the copyrightability of a flying piano.<sup>30</sup> This trick performed during a magic show consisted of a white piano that would elevate in the air along with the pianist. The movement was described as follows:

the piano slowly rises in the air in a seemingly irregular looping trajectory, the front foot of the piano lifts off the ground first, followed by the whole front of the piano. Then, it swings from one side to the other until it reaches the vertical position, marks a stop in its evolutionary movement, before continuing it, until being totally upside down. The pianist who has kept legs tight throughout the illusion has his back on the ground, and back and forth loops are performed, one or more, depending on the timing of the show, following which the piano and the musician land back on the ground, the front foot lands first.<sup>31</sup>

The court held that this scene might have been practised by other magicians before, but rarely and in a less complex way. The musical score that accompanies the taking off in its rhythm and the atmosphere accentuated by the whiteness of the instrument added some weightlessness to the scene, which contains the personal imprint of the magician and demonstrates the originality of his trick. However, a similar performance by another magician was held to be not infringing, as it copied the rise of the piano and its evolution in loops, which is

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28. In the case of an elephant trainer and a German TV channel having filmed her show without her authorisation, a German court had to decide whether the moves of the animal could be protected. See *Landgericht München*, 21 March 1967, *Holzmüller v. W.D.R.*

29. On this point see Charlotte Waelde, Sarah Whatley and Mathilde Pavis, 'Let's Dance! But who owns it?', 36(4) *EIPR* (2014), 217–228.

30. Court of Appeal of Paris, 17 December 2003, *Prop. Intellect.*, 2004, no. 10, 537.

31. *Ibid.*

only the standard common to the same trick, but distinguishes itself by many differences in its execution. The decision here rests on the recognition of the originality of the moves, that are said to be quite different from usual moves of a levitating object, and the qualification of such moves as a common standard, hence an unprotectible idea.

## 5. MOVING TO A CONCLUSION

Silly moves lead to silly questions, which abound in this paper. Let's be more serious: would copyrighting simple moves even make sense? What about our freedom of movement and our basic right to mobility? Or the sports ethics? E. Rosenblatt rightfully remarks that:

Athletes seldom seek intellectual property protection for their moves because doing so would violate the principles of sport and deprive others of an 'even playing field'; they believe that society – or at least the athletic microcosm thereof – benefits from free access to athletic innovations.<sup>32</sup>

From copyright in sports to commons, this is a territory in which I feel more at ease.

The idea of a commons or a public domain of walks is missing in the Monty Python kingdom. Their sketch contains many tropes of the intellectual property narrative, such as the incentive-based justification of a reward for intellectual creations, the need to sustain innovation and innovators based on a public interest, or individual originality and genius in creations. The question of copyrighting moves, in sports or elsewhere, might sound like a silly one, as silly and entertaining as the Pythons' idiotic walks. Yet, intellectual property is regularly filled with claims, that appeared rather excessive at first and slowly made their way into its realm, artificially supported by similar arguments of incentives or public interest, that ultimately further erode what is left for all to use, copy and get inspiration from. Bernt Hugenholtz has repeatedly denounced such expansion, from the extended duration of neighbouring rights in recorded music to rights for news publishers. Despite his passion for sport, he would vehemently reject exclusive rights in its moves and skilled figures. Whatever the genius and skill that some iconic moves, in sports, dance and comedy could contain, copyrighting them for the sole benefit of some would be a dangerous move, another step too far in copyright voracity.

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32. Elizabeth Rosenblatt, 'Intellectual Property's Negative Space: Beyond the Utilitarian', 40 *Fla. St. U. L. Rev.* (2013), 441, at 474. For a similar argument, Stef van Gompel, 'Creativity, autonomy and personal touch – A critical appraisal of the CJEU's originality test for copyright', in M. van Eechoud (ed.) *The Work of Authorship* (Amsterdam University Press, 2014), 105–106.



# Copyright and Choreography: Exploration in Three Acts

*Marie-Christine Janssens*

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Bernt, may I invite you to dance

The etiquette prescribes that the gentleman asks the lady to dance, but fortunately today the other way around is also allowed.

## 1. PRELUDE

This essay seeks to design a choreographic work consisting of some reflections, comments and findings related to the application of the basic principles of copyright law to choreography. The sequence of the movements is anything but according to the rules, but that is precisely what modern dance – which will be given particular attention in this contribution – is all about. Maybe this may explain why Johan Cruijff, iconic football player for Bernt's favourite club Ajax, was sometimes compared to a dancer (he actually took part in a documentary with the famous modern ballet choreographer Rudi van Danzig<sup>1</sup>). While I will not discuss further the interesting notion of 'football dance', this theme makes a playful link with the title of this book.

My choreography consists of three main acts, preceded by a Prelude and concluded with a Révérance. In the first Act, I will explain the difficulty in defining the notion of 'choreography' and briefly describe the statutory framework. The Second Act will examine the possibilities and challenges in applying the conditions for copyright protection. In the third Act, I will look at particular traditions in the dance world as well as future developments.

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1. See the article on 'Football dance', in <https://dansmagazine.nl/reportage/voetbaldansen>. Last accessed 30 April 2021.

## 2. FIRST ACT

### 2.1 Warming Up (Definition)

A scientific argument should normally seek to delineate the subject of exposé. To this end, I limited myself to summarising some attempts to define ‘choreography’ in the existing sources. Many scholars, especially in common law systems,<sup>2</sup> but also courts as well as administrations (US Copyright Office<sup>3/4</sup>) have formulated to define choreography or choreographic works.

A very simple definition which is often referred to is taken from the US case *Horgan v. Macmillan* where the New York District Court held that a choreography is in essence ‘a flow of steps’.<sup>5</sup>

Some scholars suggest that the element of ‘human bodily movement’ should be at the core of a definition (instead of the ‘dance’-specific language used in the clarifying documents from the US Copyright Office).<sup>6</sup> Choreographies are not always (solely) composed of ‘dance steps’, but may include regular, every day, bodily movement like pedestrian movement.<sup>8</sup> This more open definition would better accommodate the more experimental aspects that characterise postmodern dance today.<sup>9</sup> Another scholar proposes understanding dance as ‘planned movement, set into a time frame, for the benefit and enjoyment of the passive observer’.<sup>10</sup>

Yet, none of these descriptions is entirely precise since choreography can also exist in ‘non-movement’. For example, in *Duet*, Paul Taylor and his partner

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2. See e.g. contributions of Leslie Erin Wallis, ‘The Different Art: Choreography and Copyright’, 33 *UCLA Law Review* (1986), 1442 (1446 and 1455); Kara Krakower, ‘Finding the Barre: Fitting the Untried Territory of Choreography Claims into Existing Copyright Law’, *Media & Entertainment Law Journal* (2018), 671; Melanie Cook, ‘Moving to a New Beat: Copyright Protection for Choreographic Works’, 24 *UCLA L Rev.* (1977), 1287 (1288–1289).
3. In the US, a definition was felt to be useful, in particular after the official introduction of a distinct category of ‘choreographic works’ as protectable subject matter since 1 January 1978, the effective date of the Federal Copyright Law of 1976 (17 U.S.C. § 102).
4. U.S. Copyright Office, Compendium III: Compendium Of Copyright Office Practices, 3rd ed., 2017, § 805. Additional guidelines are given in U.S. Copyright Office, Circular 52: Registration of Choreography and Pantomime, (Sept. 2017), available at <https://www.copyright.gov/circs/circ52.pdf> (Accessed 22 December 2020).
5. *Horgan v. Macmillan, Inc*, 621 F. Supp. 1169 (S.D.N.Y. 1985). See a discussion of this case in Julie Van Camp, ‘Copyright of Choreographic Works’, in Stephen F. Breimer, Robert Thorne, and John David Viera (eds.), *Entertainment, Publishing and the Arts Handbook* (Clark, Boardman, and Callaghan, New York, 1994), 59 and Krakower, *supra* note 2, at 697 ff.
6. *Supra* note 4.
7. Jodi Collova, ‘Beyond Bikram: Stretching the Definition of Choreographic Works’, 1 *Legal Information Review* (2016), 75 (78–79).
8. *Ibid.*, at 92–93.
9. Sally Banes and Noël Carroll, ‘Cunningham, Balanchine, and Postmodern Dance’, 29 *Dance Chronicle* (2006), 50.
10. Martha M. Traylor, ‘Choreography, Pantomime and the Copyright Revision Act of 1976’, 16 *New England Law Review* (1981), 227 (229). See also an alternative definition proposed by Krakower, *supra* note 2, at 714, inspired by the Compendium and the case *Horgan*, *supra* note 5.

do nothing but sit on stage, in silence, for three minutes.<sup>11</sup> And even the element ‘human’ may be too narrow if one thinks of Balanchine’s choreography *Circus Polka* to music by Stravinsky ‘for 50 elephants and 50 beautiful girls’.<sup>12</sup>

I believe it is hardly possible to put forward a workable definition. Any definition would be inappropriate or even dangerous as it may lose sight of the avant-garde, postmodern<sup>13</sup> and yet unknown types of choreography. In contrast to classical and modern dance, ‘post-modern choreographers do not initially preselect movements for their aesthetic characteristics, but rather, pursuant to a larger artistic concept of the choreographic work as a whole’.<sup>14</sup> They would probably not even care if their work were not considered to be ‘dance’. As it has been suggested, it is ultimately choreographers and their audiences, rather than legal scholars, politicians or judges that should define choreography.<sup>15</sup>

Protection for developments in dance that cannot be foreseen today should be left open. Therefore, rather than a definition, the question of the copyrightability of choreography is better served by an open standard, such as the ‘own intellection creation’ standard applicable in EU copyright law. The latter does better justice to the protection of a choreographic work than any definition could achieve.

## 2.2 Setting the Scene (Statutory Framework)

At first glance, it seems hardly disputable that choreography is ‘a production in ...the artistic domain’ within the meaning of Article 2 of the Berne Convention, in particular, because the subsequent non-exhaustive list in the provision explicitly mentions ‘choreographic works’.

Interestingly, this conclusion was much less obvious in earlier times. Dance was initially considered uncopyrightable because it existed only as a live performance. As it was ‘not an object’ it could not be property.<sup>16</sup> For a long time, legislators did not see choreography as an art form, but rather a form of vulgar entertainment.<sup>17</sup> This is demonstrated in the fascinating historical and socio-cultural exploration of copyright’s emergence and exploitation on the stages

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11. E.g. Deborah Jowitt reports in the NYT the following story: Paul Taylor ‘was, as far as I know, the first choreographer to make a dance equivalent to Cage’s rigorous essay in silence, “4’ 33”, in which the pianist sits at the keyboard, but plays not a single note. In “Duet” (1957), Taylor stood and his partner, Toby Glanternick, sat for three minutes, the duration of the dance.’ (‘Rebel Turned Classicist’, *The New York Times*, 10 March 1974). See also Van Camp, *supra* note 5, at 60.
12. Horst Koegler, *The Concise Oxford Dictionary of Ballet* (Oxford University Press, Oxford, 1982), 122.
13. See Banes and Carroll, *supra* note 9, at 50, referring to postmodern choreography as ‘an experimental reflection upon the nature and limits of dance’.
14. Collova, *supra* note 7, at 77 and 90, with reference to M. K. ‘Expressionism Issue: An Introduction’, 19 *The Drama Review: TDR* (1975), 3–4.
15. Collova, *supra* note 7, at 93; Van Camp, *supra* note 5, at 74–75.
16. Kriss Ravetto-Biagioli, ‘Whose Dance Is It Anyway?: Property, Copyright and the Commons’, 38 *Theory Culture & Society* (2021), 101 (106).
17. Krakower, *supra* note 2, at 678–679.

and in the studios of nineteenth to twenty-first century America undertaken by dance scholar Kraut.<sup>18</sup>

Therefore, allowing copyright protection for dance was not evident in the minds of the drafters of the Berne Convention either, as Ricketson and Ginsburg explain in their unsurpassed standard work.<sup>19</sup> At the 1884 Conference, choreographic works were only included in the Final Protocol that provides that the countries whose laws implicitly protected these types of works (as dramatic-musical works) should grant them the benefits of the Convention. Change only came with the Berlin revision of 1908 where it was agreed to include choreographic works in Article 2. However, unlike other works, this addition was subject to the condition that the works should be recorded, in writing or by other means. This long discussion was only resolved at the occasion of the Stockholm revision (1967) when it was decided to treat all works in the same manner. It is required, but also sufficient, that a choreographic work be made perceptible (by the senses of hearing or vision I may now add for the EU<sup>20</sup>), in any way.

The second paragraph of Article 2 Berne Convention, however, leaves Members free as to whether or not to impose additional conditions: 'It shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form'.

Although not in the United States,<sup>21</sup> choreographic works are today explicitly mentioned as examples of what could constitute protected works in the literary and artistic domain in many jurisdictions. This is the case, for example, in Italy,<sup>22</sup> Germany,<sup>23</sup> Greece,<sup>24</sup> Spain,<sup>25</sup> United Kingdom,<sup>26</sup> France<sup>27</sup> and the Netherlands<sup>28</sup>

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18. Anthea Kraut, *Choreographing Copyright. Race, Gender and Intellectual Property Rights in American Dance* (Oxford University Press, Oxford, 2016). On the history of dance and choreography, see also Krakower, *supra* note 2, at 676 ff.
19. Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights. The Berne Convention and Beyond* Oxford University Press, New York, 2006), 421–423.
20. CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, Levola Hengelo. See also section 3.2.2 below.
21. See *supra* note 4.
22. Art. 2 Italian Copyright Act. Explicit protection was already included in the Italian Law of 18 May 1882, Art. 1 (a). Italy had proposed, however in vain, a mention in the first version of the Berne Convention (Ricketson and Ginsburg, *supra* note 19, at 421–422).
23. German Copyright Act, Section 2, (1), at 3° 'Pantomimic works, including works of dance'.
24. Greek Law no. 2121/1993 on Copyright, Related Rights and Cultural Matters, Article 2.1 (paraphrasing the examples in Art. 2 Berne Convention, thus including 'choreographies and pantomimes').
25. Ley de Propiedad Intelectual (12 April 1996, as amended), Article 10.1.c (also paraphrasing the examples in Art. 2 Berne Convention, thus including 'choreographies and pantomimes').
26. In the United Kingdom, a common law country with the tradition of categorisation, dance was included and defined in the Copyright Act as from 1911 as part of the category of 'musical and dramatic works'. See today s.3 (1) Copyright, Designs and Patents Act 1988 ('dramatic work' includes a work of dance or mime).
27. Code de la propriété intellectuelle, Article L 112-2, 4° ('Les œuvres chorégraphiques, les numéros et tours de cirque, les pantomimes, dont la mise en œuvre est fixée par écrit ou autrement').
28. Art. 10, 4° Auteurswet van 1912 ('choreografische werken en pantomimes').

where most laws use a text that paraphrases the wording of the examples listed in Article 2 Berne Convention, thus including ‘choreographies and pantomimes’. Interestingly not only common law countries have included the additional requirement of a fixation for these works (see below).

### 3. SECOND ACT

#### 3.1 *Port de Bras* (Requirements)

The explicit inclusion in the long list in Article 2 Berne Convention is obviously not sufficient to enjoy protection as also the substantial copyright requirements must be met. In a contribution dedicated to a renowned copyright expert, I do not need to expand on the basic standards of general copyright law in depth. In a nutshell: only something which is the expression of the author’s own intellectual creation may qualify as a ‘work’ within the meaning of Directive 2001/29.<sup>29</sup> Protection in the EU stands or falls with the presence of the (two) elements of originality and expression. These are today to be interpreted according to the autonomous standards prescribed by the European Court of Justice, deploying – as Bernt never ceases to underline – an activist agenda.<sup>30</sup>

In this contribution, I will first address the issue of expression identified by the CJEU as the second requirement for protection. In passing, I would like to note that I found that order puzzling, as it seems more logical to me to first determine whether there is an expression of an idea and to examine subsequently whether that expression is original.

#### 3.2 *Développé* (An Expression)

As indicated above, the drafters of the Berne Convention already believed choreography to be more difficult to define or demarcate than most other works. Also, in practice, the condition of expression may pose a bigger problem than that of originality. This is not only the case in the common law systems, where the expression needs to be fixed, but also in continental systems. In the latter cases, there remains indeed the importance of proof of the existence of a creation (*idem est non esse aut non probari*). But more importantly, there are also continental systems that impose the requirement of fixation.

A notable example is to be found in France – normally the ultimate example of the civil law tradition in copyright law. Article L 112-2 includes as an additional condition the obligation that the choreographic work is ‘fixed in

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29. CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, Levola Hengelo, para. 37; 6 July 2009, *Infopaq International*, case C-5/08, EU:C:2009:465, para. 39, and 4 October 2011, *Football Association Premier League and Others*, case C-403/08 and case C-429/08, EU:C:2011:631, para. 159.

30. P. Bernt Hugenholtz, ‘Het einde van de Auteurswet nadert. Veertig jaar harmonisatie van het auteursrecht in Europa (1977–2017)’, *Tijdschrift voor Auteurs-, Media- & Informatierecht* (2017), 177 (179): ‘een activistische agenda van “harmonisatie door interpretatie”’.

writing or otherwise'.<sup>31</sup> This requirement is surprising in that it conflicts with the fundamental principle expressed in continental copyright law that protection arises from the mere creation of an intellectual work.

To interpret this 'oddity', Advocate General Combaldieu reasoned as follows in a case dealing with Jean Cocteau's choreography of 'Le Jeune Homme et la Mort' (The Young Man and Death): the law allows for autonomous protection of the choreography if it is a creation in an original form (conditions set by law) and if the applicant produces a 'written, drawn, photographic or better document', describing or showing, in their movement, the steps, gestures and movements of the film attitudes.<sup>32</sup> He seems to suggest that the latter requirement should not be interpreted as adding an extra condition of fixation, but simply is a matter of proof, albeit nevertheless essential for the protection of the choreographer, because in his or her absence he or she cannot demand that anyone else respect his or her work.

In the following section, I will address in more detail the problem of applying the fixation requirement to choreographic works.

### **3.2.1 At the Barre (A Fixation)**

Most dance scholars confirm that the fixation requirement is a major obstacle to copyright protection for choreographic works.<sup>33</sup> Bordon explains that 'choreography is a unique artistic category which, by its nature, is intangible, prefigurative and fleeting. In the eyes of choreographers, the fixation condition is incompatible with the essence of the choreography'.<sup>34</sup> Choreographies, especially modern and postmodern, are the result of a symbiotic process between choreographers and dancers and cannot be stored in tangible forms as it is in a constant 'state of flux'.<sup>35</sup>

A partial explanation can be found in the fact that, for a very long time, the 'oral tradition' has prevailed,<sup>36</sup> causing the loss of many great ballets.<sup>37</sup> Over time multiple systems to make choreography perceptible have been developed. Yet, the fact that, unlike in music and drama, the dance community has failed

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31. Code de la propriété intellectuelle, Article L 112-2, 4° ('Les œuvres chorégraphiques, les numéros et tours de cirque, les pantomimes, dont la mise en œuvre est fixée par écrit ou autrement').

32. CA Paris, 1e ch. 8 juin 1960, Eudes c. Jean Cocteau et autres ; *JCP* G 1960, II, 11710 conclusions Combaldieu.

33. Frances Yeoh, 'Choreographers' copyright dilemma', 23 *Ent.L.R.* (2012), 201 (202); Charlotte Waelde and Philip Schlesinger, 'Music and Dance: Beyond Copyright Text?', 8(3) *SCRIPTed* (2011), 274 ff.

34. Chloé Bordon, 'Copyright et droit d'auteur des chorégraphies; la protection intellectuelle des chorégraphies est-elle adaptée à cet art?', blog post 25 February 2012 on *in MBDE* (Université Paris Nanterre), available at <https://blogs.parisnanterre.fr/content/copyright-et-droit-d%20%80%99auteur-des-chor%23%A9ographies-la-protection-intellectuelle-des-chor%C3%A9ographies>. Accessed 23 December 2020.

35. Yeoh, *supra* note 33, at 203 ('Their nature militates against the idea of permanency').

36. Tim Scholl, *From Petipa to Balanchine. Classical Revival and the Modernization of Ballet* (Routledge, 1994), 12.

37. Cook, *supra* note 2, at 1294.

to adopt a universal standardised notation system may explain the challenges in applying the copyright framework.<sup>38</sup> The exercise below will provide an overview of the alternative systems adopted over the years.

**Première position.** There is the option of a *textual description, still photographs* or *drawings* of the movements. However, for a work to be reconstructed, such analog presentation modes should be sufficiently detailed.<sup>39</sup> In its judgment of 13 May 2016 concerning experimental choreography, the Paris Court of First Instance accepted that a booklet containing images and detailed explanations of the movements present in the various choreographies was sufficient to consider the condition of expression to be met.<sup>40</sup> To what extent that would be enough to grant copyright to the content, in addition to the general textual description, remains, however, questionable.<sup>41</sup>

**Deuxième position.** In recent decades and still today, the most favoured modes of capturing dance performances are film and video recordings.<sup>42</sup> This is a rather inexpensive and easily accessible tool that has made the requirement of fixation less insurmountable.<sup>43</sup> Especially with the availability of digital modes, high definition recordings of dance are available, not merely to record and archive, but also to ‘calculate, analyse and model it’.<sup>44</sup> We should, on the other hand, not forget that the increased availability of such recordings, combined with the rise of digital distribution channels and the ‘viral effects’ through social media such as Instagram and TikTok, bring new challenges for choreographers that they do not yet seem to fully grasp.<sup>45</sup>

**Troisième position.** In line with the above, computational media, such as computer programs<sup>46</sup> and animation, constitute alternative modes of recordings. An early application of computer programming for dance was the use of ‘interactive and graphical movement systems’ to record dance notation.<sup>47</sup> Yet, these modes

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38. Yeoh, *supra* note 33, at 202.

39. Cf. *Horgan v. MacMillen*, 789 F. 2d 157 (2d Cir. 1986) (‘recreation of the original from the [photographs] ... is unlikely if not impossible’, at 162). Yet this case decided that a book portraying several still photographs of a performance of *The Nutcracker* constituted an infringement of choreographer Balanchine’s copyright.

40. TGI Paris, 3e ch.13 May 2016, case no. 14/05221 (Kluwer database Lamyline-Actualités du droit. Accessed 11 January 2021). About this case, see also section 3.3.3.

41. J. E. Fitzgerald, ‘Copyright and Choreography’, *CORD News* 1973, 25 (26).

42. See also the earlier mentioned case *Horgan*, wherein it was held that ‘copyright can be obtained by recording a dance in tangible form through a system of written notation or by depositing a film or tape depicting the dance’ (Horgan, 789 F.2d at 160).

43. Yeoh, *supra* note 33, at 208.

44. Ravetto-Biagioli, *supra* note 16, at 106. Cf. Waelde and Schlesinger, *supra* note 33, at 275.

45. See section 4.1 below.

46. E.g. the computer program DanceForms. This is an updated version of the software that was originally used by Merce Cunningham and that had the name LifeForms in his time. Another popular option is ChoreoPro which is used among choreographers who work in several dance genres.

47. Thecla Schiphorst, ‘A Case Study of Merce Cunningham’s Use of the Lifeforms Computer Choreographic System in the Making of Trackers’, Simon Fraser University, March 1993,

of recording may be very time-consuming and only few choreographers seem to know how to use them.

**Quatrième position.** A few dance notation languages exist.<sup>48</sup> These seem to work fairly well in recording dance movement. The best notation known is Labanotation, which is a system for recording and analysing human movement that was derived from the work of choreographer Rudolf von Laban.<sup>49</sup> Besides, there is the Benesh Movement Notation (BMN), invented by Joan and Rudolf Benesh in the late 1940s as well as the Eshkol-Wachman movement notation.<sup>50</sup> However, none of these systems enjoy wide literacy among dancers as they are complex, require the services of a specially trained expert<sup>51</sup> and hence are quite expensive.<sup>52</sup> Furthermore, although notation can reflect the most subtle nuances of movement, it does not capture style or individual interpretation.<sup>53</sup>

**Cinquième position.** Last but not least, artificial intelligence has made its appearance in the dance world, originally to help to capture notation, but also in creating choreography. I come back to the growing influence of AI on the dance world in the Third Act.

**Balance.** Most scholars seem to agree that no dance notation method, nor any other means can display all the details or even the essence of a choreographic work.<sup>54</sup> ‘Dance is often described as haunted by its own ephemerality. ... The complexity of movement, and its sudden disappearance, makes dance impossible to capture in its embodied liveness, or even difficult for an audience to see’<sup>55</sup>

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[http://www.sfu.ca/~tschipho/publications/Schiphorst\\_M.A.Thesis.pdf](http://www.sfu.ca/~tschipho/publications/Schiphorst_M.A.Thesis.pdf), 13.

48. For an overview, see the thesis of K.J. Lack, ‘Capturing dance: the art of documentation (An exploration of distilling the body in motion)’, 2012, [https://ro.ecu.edu.au/theses\\_hons/77](https://ro.ecu.edu.au/theses_hons/77). Accessed 6 January 2021.
49. See more details in Fitzgerald, *supra* note 41, at 27, with reference to Ann Hutchinson, *Labanotation* (Theatre Arts Books, New York, 1970), 6–10; Krakower, *supra* note 2, at 689 ff; Anthea Kraut, *Choreographing Copyright. Race, Gender and Intellectual Property Rights in American Dance* (Oxford University Press, 2016).
50. See more details in Seymour Kleinman, ‘Movement Notation Systems: An Introduction’, 23 *Quest* (1975), 33–34.
51. Judy Van Zile. ‘What Is the Dance? Implications for Dance Notation’, 17 *Dance Research Journal* (1985), 41.
52. Barbara Singer, ‘In Search of Adequate Protection for Choreographic Works: Legislative and Judicial Alternatives vs The Custom of the Community’, 38 *U. Miami L. Rev.* (1984), 287 (301).
53. *Ibid.*, at 302.
54. John Martin, long-time dance critic for *The New York Times*, found films unacceptable because a film is a recording, not of the composition itself, but of a specific performance of it, which is inevitably an interpretation (sometimes even an adaptation because of the limitations of the individual performers) and consequently may depart radically from the choreographer’s intent (Comments and Views Submitted to the Copyright Office on Copyright in Choreographic Works, in Senate Comm. on the Judiciary, 86th Cong., 2d Sess., Studies on Copyright Law Revision (Comm. Print 1961), 111).
55. Ravetto-Biagioli, *supra* note 16, at 101; Sarah Whatley, ‘Dance Identity, Authenticity and Issues of Interpretation with Specific Reference to the Choreography of Siobhan Davies’, 23 *Dance Research: The Journal of the Society for Dance Research* (2005), 87 (89).

Dance ‘eludes fixation and thus being captured as property rights’.<sup>56</sup> In particular the experimental forms of dance are simply ‘beyond fixation’.<sup>57</sup>

This quasi-impossibility to capture dance expression should, however, not lead to the conclusion of a failure to comply with the requirement of a perceptible expression. In this presentation, I do not want to go into a confrontation with the age-old problem of the demarcation between (non-protectable) ideas<sup>58</sup> and (protectable) expression to screen out uncopyrightable content from copyrightable works. As Buccafusco notes, the idea v. expression alternative is better understood as a spectrum rather than as a dichotomy.<sup>59</sup> I am convinced that at some point along that spectrum, a choreography may be expressed with sufficient specificity such that copyright protection may be available.

I leave it to other scholars to solve the problems that choreographic works face with a statutory fixation requirement. In the EU copyright system, there seems to be little problem, as any type of expression will qualify. Or not?

### 3.2.2 *Interlude with a Cheese Snack*

Any inquiry into the meaning of the requirement of expression in EU copyright law today can hardly ignore the *Levola* ruling<sup>60</sup> (probably another example of what Bernt would refer to as ‘Judge-made’ law). It may show a lack of tact to compare cheese-tasting to a choreographic work. Nevertheless, where before this decision the protection of non-fixed choreographic works may have seemed evident, the new interpretation imposed by the Court of Justice rule may trigger new questions.

Henceforth, according to the CJEU, for there to be a ‘work’ as referred to in Directive 2001/29, the subject matter protected by copyright must be expressed in a manner that makes it identifiable with enough precision and objectivity, even though that expression is not necessarily in permanent form. That is because, first, the authorities responsible for ensuring that the exclusive rights inherent in copyright are protected must be able to identify, clearly and precisely, the subject matter so protected. The same is true for individuals, in particular economic operators, who must be able to identify, clearly and precisely, the subject matter of protection which third parties, especially competitors, enjoy. Secondly, the need to ensure that there is no element of subjectivity – given that it is detrimental to legal certainty – in the process of identifying the protected

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56. Waelde and Schlesinger, *supra* note 33, at 265.

57. Charlotte Waelde and Sarah Whatley, ‘Digital dance: the challenges for traditional copyright law’ in M. Bleeker (ed.), *Transmission in Motion: The Technologizing of Dance* (Routledge, 2017), 168 (176). See also Waelde and Schlesinger, *supra* note 33, at 274–275.

58. Articles 2 WCT and 9.2 TRIPS.

59. Christopher Buccafusco, ‘Authorship and the Boundaries of Copyright: Ideas, Expressions, and Functions in Yoga, Choreography, and Other Works’, 39 *Columbia Journal of Law & the Arts* (2016), 421 (425–426) (also with reference to 2 Patry on Copyright § 4:36).

60. CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, *Levola Hengelo*.

subject matter means that the latter must be capable of being expressed in a precise and objective manner.<sup>61</sup>

As I have pointed out above, it is indeed not so easy to express a choreographic work, let alone in an accurate and objective manner. On the other hand, everyone realises that, especially in the artistic domain, accuracy and objectivity in the literal sense is an illusion. While the decision of the CJEU is perfectly acceptable for the taste of a food product, it should not be interpreted as narrowing down the scope of copyright. In essence, the criteria laid down by the court must be understood in the light of its concerns to exclude from the scope of copyright everything that belongs to the realm of ‘ideas’, as these have by nature an abstract, indeterminate and non-seizable character.<sup>62</sup>

### 3.3 *Enveloppé* (Originality)

There can be little doubt that the vast majority of choreographic works meet the originality criterion and are eligible for copyright protection. Consider the works of legendary choreographers like George Balanchine, Paul Tayler, Alvin Ailey, Martha Graham,<sup>63</sup> Merce Cunningham, Maurice Béjart and Anna Teresa de Keersmaeker. Yet, it may sometimes be hard to distinguish between, on the one hand, a copyrightable choreographic ‘work’ and, on the other hand, a simple set of movements<sup>64</sup> or common dance steps. The criteria suggested by the US Copyright Office that copyrightable ‘choreographic works are typically performed by skilled dancers’ ‘before an audience’, while uncopyrightable ‘social dances are not created for professional dancers [as] they are intended to be performed by the general public’ ‘for the personal enjoyment of the dancers themselves’<sup>65</sup> seems hardly useful and reflects a very conservative view of (contemporary) dance.

The extreme cases are always easy. At the one extreme, one could then place one of the many conventional classical ballet choreographies such as *Swan Lake* as well as modern dance and other complex works that represent a related series of dance movements.<sup>66</sup> At the other extreme might figure simple routines and other uncopyrightable movements. The vast middle ground between these extremes is more problematic, in particular considering the diversity of contemporary dance.

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61. *Ibid.*, paras. 40–42.

62. Julien Cabay and Frank Gotzen, ‘Une saveur n’est pas une œuvre: “Cette leçon vaut bien un fromage, sans doute”’, 29 *Revue de droit commercial* (2019), 793, 805.

63. See the long-lasting procedure related to the question of ownership of the rights to her estate in *Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624 (2004). For more details, see Sharon Connelly, ‘Authorship, Ownership, and Control: Balancing the Economic and Artistic Issues Raised by the Martha Graham Copyright Case’, 15 *Fordham Intellectual Property, Media & Entertainment Law Journal* (2006), 855 and Bordon, *supra* note 34.

64. Ravetto-Biagioli, *supra* note 16, at 107.

65. Compendium of U.S. Copyright Office Practices, S § 101, 3d ed., 2014, at 805.2 (F) and 805.5 (B).

66. *Ibid.*, at 805.5 (B).

### 3.3.1 Plié (Basic Steps)

As suggested before, basic dance steps do not qualify for protection for the same reason that individual words, numbers, notes, colours, or shapes are not protected by copyright law.<sup>67</sup> These would include individual movements or simple routines by themselves, commonplace movements or gestures or any element of a standard dance vocabulary, such as a plié or a pirouette.<sup>68</sup> To paraphrase Nimmer's words such basic movements 'are raw materials that serve as building blocks for creativity enabling others to build on them'.<sup>69</sup>

Non-protectable movements would, at least in the US, include a yoga sequence.<sup>70</sup> I think that such a fundamental conclusion should be applied with caution and seems, at least from an EU perspective, too restrictive. Although I could not find jurisprudence in Europe regarding the eligibility for protection of yoga, courts in France and Germany have held that a sequence of 'meditational choreography'<sup>71</sup> and of 'acrobatic performances'<sup>72</sup> constituted copyrightable subject matter.

### 3.3.2 Kick-Jeté (New Steps)

But what about a completely new pass? Some dancers and choreographers became known by a new self-invented leap such as the split tour-jeté made famous by Mikhail Baryshnikov or Maya Plisetskaya's kick-jeté, stabbing the air with one leg and bringing the head back to the other foot.<sup>73</sup> It is argued that such newly

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67. F. F. Scott Kieff, Robert G. Kramer, and Robert M. Kunstadt, 'It's Your Turn, But It's My Move: Intellectual Property Protection for Sports Moves', 25 *Santa Clara High Tech. L.J.* (2012), 765 (777).

68. Van Camp, *supra* note 5, at 67.

69. Melville B. Nimmer and David Nimmer, *Nimmer on Copyright: A Treatise on the Law of Literary, Musical and Artistic Property, and the Protection of Ideas* (M. Bender, New York, 1963) § 19E.04(B).

70. *Bikram's Toga College of India, L.P. v. Evolution Yoga, LLC*, 803 F.3d 1032 (9th Cir. 2015). The court denied granting copyright protection to the sequence of twenty-six positions (asanas), described by the plaintiff as 'his selection, coordination, and arrangement of twenty-six poses and two breathing exercises create a coherent and expressive composition' (at 1041). The Court decided that this sequence 'is an idea, process, or system to which copyright protection may in no case extend', at 1044. See interesting comments by Collova, *supra* note 7, at 75.

71. TGI Paris, 3e ch., 13 May 2016, case no. 14/05221 (Kluwer database Lamyline-Actualités du droit. Accessed 11 January 2021). These meditational poses included very simple movements such as walking in circles, outstretching arms towards the sky and joining hands in a sign of prayer. See more details in Emmanuel Pierrat, Léopold Kruger, 'La protection et la conservation des œuvres chorégraphiques', 55(1) *L'Observatoire* (2020), 80–82.

72. Higher Regional Court (OLG) Cologne, 2 February 2007, case 6 U 117/06, retrieved at <https://openjur.de/u/122350.html>. Accessed 23 December 2020. In this case, the performance of a group of Asian contortionists with the Circus 'S' was at stake, with dancers bending their bodies in an extreme manner so as to appear to be boneless.

73. A. Messerer, 'Maya Plisetskaya: Childhood, Youth, and First Triumphs, 1925–59', *Dance Chronicle* (1989), 1 (32). Accessed 14 October 2020. <http://www.jstor.org/stable/1567707>. See also Van Camp, *supra* note 5, at 64.

created steps, in isolation from any particular sequence, might be ‘original’, but are probably ineligible for protection, as they constitute ‘ideas, systems, or methods of operations’ excluded from protection.<sup>74</sup> Reasoning otherwise would be a naïve extension of a long-established principle in copyright law. ‘If a writer could copyright a newly coined word or a musician copyright a new atonal scale or chord, the dialogue and the means for creativity in these arts would be severely restricted, to the detriment of the society,’ Van Camp reasons<sup>75</sup> and rightly so. The same reasoning should be applied to novel movement vocabularies such as that of Martha Graham. Nevertheless, in practice, it will remain a delicate judgment to locate the dividing line between non-protectable new steps and an original new combination of steps.

### 3.3.3 *La Chute d’Icare*<sup>76</sup> (Dance Phrases)

Dances are rarely if ever a loose collection of isolated movements. Even if the separate elements are not original, the combination could be so,<sup>77</sup> just as could combinations of (even a few<sup>78</sup>) words, for which there is strong support from decisions involving literary works. Originality then lies in the way a choreographer arranges physical movements, the coordination of the performers in space in relation to each other, and the overall composition of the work.<sup>79</sup> Obviously, not any combination will amount to originality – e.g. a number of pirouettes, which is common in much classical choreography. Originality may be achieved as soon as dance patterns are arranged into an integrated, coherent, and expressive compositional whole. It is indeed suggested that the existence of *a coherent whole* of the bodily movements should constitute an important factor.<sup>80</sup> It is sometimes

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74. Van Camp, *supra* note 5, at 63, referring to Nicholas Arcomano, ‘Choreography and Copyright, Part Two’, *Dance Magazine* (May 1980), 70 (‘Ballet and modern dance vocabularies, after all, do contain basic movements which can be used by anybody and incorporated into an “original choreographic work”’).

75. *Ibid.*, at 63–64.

76. This title refers to a case whereby Maurice Béjart was found liable for infringement of a scene from the ballet *La Chute d’Icare* choreographed by Flamand. The particular scene displayed an almost naked man, with wings tied to his back and television sets at his feet. Court of Appeal Brussels 18 September 1998, *Auteurs&Média* 1999, 60.

77. Cf. TGI Paris 13 May 2016, case no. 14/05221: ‘[b]ien qu’elle soient composées de mouvements simples ..., il n’en demeure pas moins que chaque chorégraphie résulte de choix d’une combinaison de ces gestes et d’un rythme propre en harmonie avec la musique sélectionnée pour les accompagner, qui est également à l’origine de l’inspiration de la chorégraphie.’ See also section 3.2.1 above.

78. CJEU, case C-5/08, ECLI :EU:C:2009:465, Infopaq International.

79. Kathleen Abitabile and Jeanette Picerno, ‘Dance and the Choreographer’s Dilemma: A Legal and Cultural Perspective on Copyright Protection for Choreographic Works’, 27 *Campbell Law Review* (2004), 39 (44); G. Mitchell, ‘Who Controls the Dance: Copyright in the World of Choreography’, *AIPLA Q. J.* (2018), 381 (399).

80. Collova, *supra* note 7, at 91.

added that such whole should be the result of an artistic vision, so as to exclude functionally organised succession of bodily movements as in sports or yoga.<sup>81</sup>

One of the most important features of any choreographer's style is the way in which movement is connected into 'dance phrases'. They are the choreographer's 'signature moves' as it were. To choreograph is to create dance by selecting, inventing, and arranging movement motifs and sequences.<sup>82</sup>

### **3.3.4     *Assemblé (Derivative Nature)***

A particular element to consider, even though it is not exclusive to dance, is the essentially derivative nature of choreographic works and hence the difficulty in distinguishing between new original, original derivative or infringing derivative works.<sup>83</sup> This issue is also addressed below.

## **4.        THIRD ACT**

### **4.1       *Glissée (The Non-Copyright Discourse)***

The jurisprudence on the protectability and scope of protection of choreography is very scarce.<sup>84</sup> True, as was shown above, there are particular difficulties with the requirements of expression and originality; yet the copyright status of these works will in most cases be beyond discussion. One may therefore easily assume they are regularly unlawfully used or copied,<sup>85</sup> especially with the increased exposure of dance works over the internet as was mentioned above.<sup>86</sup> The number of videos disseminated via YouTube, TikTok and other online platforms, with individuals or groups wanting to show how well they can perform the dance steps of people performing in shows like 'Belgium's Got Talent' (I guess so does the Netherlands) or 'So You Think You Can Dance', is uncountable. How then to explain this paucity of case law on dance copyright?

Rather than ignorance, several factors may explain a sort of dysfunction between choreographers and copyright.

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81. Cf. the 9th Circuit in the *Bikram Yoga* case, where it was held that the sequence of yoga poses was designed not as part of a creative objective, but rather to yield physical benefits and a sense of well-being (see *supra* note 69). See, however, as regards yoga, our observations in section 3.3.1 above.

82. Dance Glossary, <https://artsonline.tki.org.nz/Teaching-and-Learning/Pedagogy/Dance/Glossary>.

83. Waelde and Schlesinger, *supra* note 33, at 272–273.

84. *Ibid.*, at 262.

85. In Belgium, I remember the controversy that followed the release of Beyoncé's video for *Countdown* in 2011, which features highly recognisable movements from the works *Rosas Danse Rosas* and *Achterland* of choreographer Anna Teresa de Keersmaeker. Or, and again by Beyoncé, a scene featured in her Formation World Tour (2016) that showed many similarities to choreography by Sidi Larbi Cherkaoui.

86. Yeoh, *supra* note 33, at 207.

First, the disengagement from choreographers with copyright is demonstrated by their *reticence* to pursue cases in court.<sup>87</sup> Inaction often results from a fear of costly, lengthy and uncertain legal proceedings:<sup>88</sup> ‘Many choreographers seem to pass on taking legal action when faced with the daunting task of understanding how to make a claim, and then navigating through entrenched copyright law defences’.<sup>89</sup> Moreover, choreographers are concerned that courts lack the understanding of their field (‘Having judges make dance decisions is like having a History teacher grade a Physics exam’<sup>90</sup>).

Secondly, choreographers are no doubt among those creators for whom ‘the non-pecuniary rewards such as *recognition* and hoped-for immortality through the preservation of the work may be more important than immediate material gain’.<sup>91</sup>

Thirdly, there is the hard reality that choreographers experience, highlighted again during the outbreak of the Covid-19 pandemic in 2020–2021 with a global shutdown of live performances, of *precarious circumstances*. They are concerned with the pressing problems of survival rather than navigating the obscure waters of copyright enforcement.

Fourthly, choreographers find shelter in the *customary rules* that have operated smoothly for a long time.<sup>92</sup> They enjoy a protective environment provided by the good practice adopted by the dance community. Relying on the prerogatives conferred on them by copyright even seems to potentially restrict them from continuing to ‘engage in a dialog with other living dancers or building on inspiring dance moves across communities, and their historical contexts’ as has been the tradition for centuries.<sup>93</sup> In choreography, many, sometimes the majority, of dance phrases are based on existing movements or traditions. For example, if you work within the tradition of a particular choreographer, you borrow from and build upon the particular style and movements of such dance.<sup>94</sup> It is felt that copyright with its expansive property claims might restrict such ‘creative spaces’.<sup>95</sup>

Fifthly, and quite different from the sector of music for example, there is a *lack of a proper organisational framework*. There are hardly any representative bodies to promote the genre, nor are there established unions or specialised collecting societies for choreographers and performers, etc. in the world of dance.<sup>97</sup>

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87. *Ibid.*, at 201.

88. Abitabile and Picerno, *supra* note 79, at 53–54.

89. Krakower, *supra* note 2, at 674.

90. Abitabile and Picerno, *supra* note 79, at 55.

91. Jane Ginsburg, ‘Moral rights in a common law system’ *Entertainment Law Review* (1990), 122. See also Frances Yeoh, ‘Choreographers’ moral right of integrity’, 8 *JILP* (2013), 43.

92. Connelly, *supra* note 63, at 855 (‘custom continues to act as a formidable regulatory force within this field’); Singer, *supra* note 52, at 290.

93. Ravetto-Biagioli, *supra* note 16, at 106.

94. Waelde and Schlesinger, *supra* note 33, at 284–285.

95. Yet, such ‘borrowings’ are not always undisputed as the controversy surrounding Beyoncé’s video *Countdown* demonstrates; see footnote 85 above.

96. Waelde and Schlesinger, *supra* note 33, at 284–285.

97. *Ibid.*, at 262–263.

Lastly, and most importantly, the *suitability of the copyright system* to protect this type of work is questionable, at least in its modern, avant-garde way of expression. It is even argued that the more you try forcing dance into existing modes of copyright, the more it resists.<sup>98</sup>

In the UK an interesting project *Beyond Text: Music and Dance* conducted research into whether experiential, experimental forms of dance are beyond protection by copyright. The conclusion was that they are both *before* copyright and *beyond* copyright.

They are *before* copyright because what matters to the majority of those involved is the process of creation – which itself is constantly evolving – rather than the product – the protected work once fixed. They are *beyond* copyright because key aspects of the performance involve contributions which are not recognised by copyright, and because there is much about the performance which simply cannot be captured in the mechanical sense.<sup>99</sup>

Another aspect where the application of the copyright rules is often problematic is the *question of authorship*. This contribution does not allow me to explore this interesting issue at length, and I limit myself to the following observations. There is no dance without dancers. However, a strict application of copyright rules – the choreography is protected by copyright and the performance by performers' rights – is shortsighted in (at least) the world of modern dance and overlooks the reality of the creation process. While in some choreography the dancer is indeed mainly performing the pattern of steps as arranged by the choreographer, others expect dancers to create the dance; to be 'the catalyst whose presence stimulates the creation of the dance'.<sup>100</sup> This situation is particularly relevant in the case of an improvisation whereby the dancer is his or her own choreographer.<sup>101</sup>

## 4.2 The Black Swan (Unfinished Part)

In recent years, there has been a large growth in the use of artificial intelligence in the dance choreography process. Shiphorst analyses in much detail the development and use by Merce Cunningham of the program Lifeforms to create the dance piece *Trackers* which premiered in March 1991 and in which about one-third of the movement was created by this program.<sup>102</sup> Plone describes the collaboration between Wayne McGregor and the Google Arts and Culture

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98. Ravetto-Biagioli, *supra* note 16, at 101.

99. The results of this study are published in Charlotte Waelde and Philip Schlesinger, 'Music and Dance: Beyond Copyright Text?', 8(3) *SCRIPTed* (2011), 257–291. The study's focus was on experiential, experimental forms of dance (and music).

100. Geraldine Morris, 'Dance Partnerships: Ashton and his dancers', 19 *Dance Research* (2001), 11. Cf. Van Camp, *supra* note 5, at 68; Van Zile, *supra* note 51, at 42; Charlotte Waelde, Sarah Whatley and Mathilde Pavis, 'Let's Dance! But who owns it?', 36 *EIPR* (2014), 217 (219).

101. Waelde and Schlesinger, *supra* note 33, at 264.

102. Schiphorst, 'A Case Study of Merce Cunningham's Use of the Lifeforms Computer Choreographic System in the Making of *Trackers*', Simon Fraser University, March 1993,

Lab that lead to the creation of an AI-driven tool called Living Archive that generates, based on hundreds of hours of video it has been fed, its independent choreography.<sup>103</sup> Another example is the 2016 LuminAI project created at the Georgia Institute of Technology. It involves ‘a computer-controlled dancer, which ‘watches’ the person and improvises its own moves based on prior experiences’.<sup>104</sup> There is not yet the belief that AI will take over the initiative to create art and replace the choreographer, but AI clearly increases creativity through the use the choreographer can make of it.<sup>105</sup>

This is not the place to discuss the challenges of AI-generated (choreographic) works for copyright. Many scholars have already written extensively about it. This Third Act, clearly, cannot be concluded without a reference to a study in this respect, commissioned by the EU, that was carried out by, *inter alia*, Bernt Hugenholtz himself.<sup>106</sup>

## 5. RÉVÉRENCE

In recent decades we have experienced debates on – and pleas in favour of – extending and/or strengthening protection by copyright. With the present choreography, I intended to warn against such a general endeavour and demonstrate that for certain forms of art or in certain sectors,<sup>107</sup> copyright protection does not always succeed in protecting genuine creative achievements and might even harm rather than encourage creativity.

The headings in this essay were not randomly chosen from a ballet dictionary. I have performed (most of) these movements almost every week since before the time I got to know Bernt. It was my pleasure that I could give them a copyright flavour in the honour of such a distinguished copyright scholar. In

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[http://www.sfu.ca/~tschiph0/publications/Schiphorst\\_M.A.Thesis.pdf](http://www.sfu.ca/~tschiph0/publications/Schiphorst_M.A.Thesis.pdf), accessed 4 January 2021.

103. Abby Plone, ‘The Influence of Artificial Intelligence in Dance Choreography’, *IPHS 200: Programming Humanity*. Paper 7 (2019). [https://digital.kenyon.edu/dh\\_iphs\\_prog/7](https://digital.kenyon.edu/dh_iphs_prog/7), 4–5. See on this project also <https://artsandculture.google.com/story/living-archive-creating-choreography-with-artificial-intelligence-studio-wayne-mcgregor/1AUBpanMqZxTiQ?hl=en>, accessed 30 December 2020. See also Jamila Jordon, 21 January 2020, <https://amt-lab.org/blog/2020/1/ai-as-a-tool-in-the-arts>, accessed 30 December 2020.

104. Jason Maderer, ‘You’ll never dance alone with this artificial intelligence project. Research couples co-creativity with AI to develop unique collaborations’, *Georgia Tech News Front Page*, 28 April 2016, accessed 4 January 2021.

105. Plone, *supra* note 103, at 6–7.

106. Bernt Hugenholtz, João Pedro Quintais, Daniel Gervais, *Trends and Developments in Artificial Intelligence: Challenges to The Intellectual Property Framework*, Final Report, 16 December 2020, available at <https://ec.europa.eu/digital-single-market/en/news/trends-and-developments-artificial-intelligence-challenges-intellectual-property-rights-0>, accessed 4 January 2021.

107. I reached similar conclusions in my research dealing with copyright for culinary creations; M-Ch. Janssens, ‘Auteursrechtelijke bescherming voor recepten en gerechten: “Should the belly rule the mind?”’, *Auteurs en Media* (2012), 61 (71–72). Cf. Christopher Buccafusco, ‘On the legal consequences of sauces: should Thomas Keller’s recipes be *per se* copyrightable?’, 24 *Cardozo Arts & Ent. L.J.* (2007), 1121 (1148).

fact, I am grateful for this opportunity as I had planned to write a contribution on copyright and dance since the moment I entered the ‘copyright dance floor’ myself many years ago. It is thanks to Bernt’s retirement that this dream has come true after all.

So, Bernt, you think you can dance now?

NICE  
TRY

BUT I'VE REGISTERED  
THAT OPENING IN MY  
NAME



# A Repetition of Moves

*Gerard Schuijt*

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## 1. INTRODUCTION

A chess player, having considered all other possible moves, thinks that the move he makes offers the best opportunity to win.<sup>1</sup> His opponent, after similarly considering all other possible moves, thinks that his move offers the best chance of winning. Both think that their move will at least draw the game and that any other move will weaken the position to such an extent that it could lead to a loss. The first player sometimes sees no better move than to go back to the previous position. If his opponent does the same and the first player again can think of no other possibility than to repeat the previous move, then one speaks of repetition of moves. If that occurs three times in a row, it is a draw according to the rules of the game on account of repetition of moves.

I feel like such a player at the moment, now that I have absolutely no wish to pass up the opportunity to contribute to this special present for my dear former colleague Bernt Hugenholtz, the more so because the theme chosen for this collection is sports and copyright. That theme is really appropriate for Bernt, who in his wonderful thesis dealt extensively with the ‘concept of work’ in copyright law. This concept of work is also at stake when it comes to the question of whether a chess player has the copyright in games played by him.

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1. I write ‘chess player’ and ‘he’ and ‘his’ here. However, please bear in mind that since long before the popular film *The Queens Gambit*, there have been many and very talented female chess players. Just think of chess master Judith Polgar (1976) with an ELO rating in 2005 of 2735; the strongest Dutch chess player of today, who won several times against the current world champion Carlsen, has an ELO rating of 2776 in 2021. The ‘chess player’ in this contribution is gender neutral.

I have considered this question in the past and have published on it, so it is an obvious topic for me to address now as well.<sup>2</sup> But actually, I do not have many new and better insights than what I have written together with Jaap Haeck – also a former IViR-ian – in the Dutch journal *Auteursrecht* (previously *Informatierecht/AMI*).<sup>3</sup> Anything I might add would risk detracting from the foregoing and thus lead to a loss, while I also see no possibility of arriving at new and better views. At the very best, I can sharpen up some ideas here and there.

In all this, it is also a fact that I have been enjoying my retirement since 2004 and since my seventy-fifth birthday I have no longer been involved in ‘the profession’ at all. But for Bernt, even Heintje Davids comes back.<sup>4</sup> Who among the present Dutch generation still knows who she was? And who I am?

## 2. CHESS AND COPYRIGHT IN LITERATURE

Chess as an object of protection is not a new topic in copyright literature. The German Nestor Josef Kohler wrote about it back in 1908: a chess game is an event and everyone is free to publish about it.<sup>5</sup> In our country, Oskam and Rueb suggested in 1927 in the *Nederlands Juristenblad* that the press and the public should only be granted access to the playing room on condition that nothing would be published about the games without prior permission. Many years later, we saw such a ‘domain monopoly’ become reality with regard to television footage – so-called ‘flashes’ – of football matches. The Dutch Supreme Court confirmed in *NOS v. KNVB* that football clubs, on the basis of their control over access to venues, could impose restrictions on reporting.<sup>6</sup>

Oskam and Rueb sidestepped the copyright problems. For example, what about the fact that there are two co-authors? Is it only the winner who has the copyright (to prevent a veto by the embarrassed loser)? How do we deal with draws? Spoor, Verkade and Visser devote only a few paragraphs to this in the latest edition of their treatise on Dutch copyright, which are broadly in line

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2. Gerard Schuijt, ‘The Van Geet opening, the Niemeijer convention and Piet Keijzer’s scissors’, 3 *Sic Letterkundig Tijdschrift* (1991), 132–140, an essay-like essay in which I tended towards granting copyright to a chess game: ‘Chess players are the poets among sportsmen’.
3. J.F. Haeck and G.A.I. Schuijt, ‘De schaker een maker? On Chess as a Copyright Issue’, 3 *Informatierecht/AMI* (1994), 43–50. We came to the conclusion that there is no copyright on a chess game.
4. Heintje Davids (1888–1975), sister of the popular singer-comedian Louis Davids, was an equally popular singer of humorous songs. After her grand farewell in 1954, she soon made her comeback. She continued to perform well into the 1960s, regularly announcing that this was really the last time.
5. Josef Kohler, ‘Besteht ein Autorschutz an einem Schachspiel’, *GRUR* (1908); J. Kohler, ‘Nochmals das Recht des Schachspielers’, *GRUR* (1910); see also Walter Jung, *Gibt es ein Urheberrecht am Schachspiel*, (diss. 1931), and some other publications which I found in the master’s thesis of G.J. Wildschut, *infra* note 7.
6. See inter alia Dommering, ‘De sportprestatie. Protection and free reporting’, in W.F. Korthals Altes and G.A.I. Schuijt (eds.), *Sport and information monopolies* (Cramwinckel, Amsterdam, 1991), 9–21, and Sven Klos, ‘Sport on the playing field of intellectual property’, 3 *IER* (1997), 81–88.

with what they wrote in earlier editions. They think that the great masters can make choices that testify to a personal stamp, which would argue for granting copyright to the chess player. For them, the reason for rejecting copyright in chess games is not so much that the concept of work is not appropriate, but that the infringement criteria of ‘making public and reproducing’ are not appropriate, i.e. where it concerns a newspaper report or a replay.

Chess player and bridge player Bob van de Velde alerted me to the 1979 doctoral thesis by Gerard Wildschut, ‘The intellectual property of chess games’. An excellent thesis, although I cannot agree with his argument, which is in favour of granting copyright to chess players. More on that later.<sup>7</sup>

Oskam and Rueb themselves were not without merit as chess players and also the (semi-Dutch) grandmaster Lasker, who was also an accomplished draughts player and bridge player, engaged in the subject of rights in games. During a tournament in New York in 1893, the hosting Manhattan Chess Club claimed the right to ‘sell’ the games in order to cover the costs of the tournament. This caused dissatisfaction among the press, but not among the players who had apparently agreed to it. The same happened at an international tournament – also won by Lasker – held in Paris in 1900. Much later on, in 2007, a chess commentator wrote: ‘A few years later, Lasker was once again back in England and trying to earn a living from chess. Did he get the idea from New York 1893?’<sup>8</sup>

Chess players saw mainly opportunities in copyright law to negotiate remuneration for their performances. Nowadays, that is no longer a problem for the top players. There are very large sums involved in prizes and starting fees, even in the internet tournaments of the COVID-19 era. The lesser gods have to make do with little or nothing, but then again, the fact that I have copyright on my Saint Nicholas Day poems does not really make a financial difference either, and my achievements on the sixty-four squares even less so.<sup>9</sup>

### 3. WHAT MOVES THE CHESS PLAYER?

I have said on previous occasions, in a somewhat mocking way, that chess players do not know what copyright is and that lawyers do not know what chess is. Lawyers often have a somewhat romantic idea about chess. This is not so much about the beauty of the game because that is only right, but about the choices a chess player has during a match. He can see the most beautiful combination – queen sacrifice and so on – but if it does not lead to victory, he will not execute it. A failing combination, where the opponent already finds the refutation in the game, is therefore not a possible combination at all.

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7. G.J. Wildschut, ‘The intellectual property of chess games’, Free University, 1979.
8. I have this information from chess player and bridge player Bob van de Velde, who is co-editor of a biography of Lasker.
9. Drs. P will probably have received a fee for his wonderful ‘Het schrijven van een sinterklaasgedicht’ (Writing a Saint Nicholas poem); Drs. P and Ivo de Wijs, *Het rijmschap compleet en nog meer lief en leed* (Bzztôh, The Hague, 1984).

Therefore, one must take the ‘personal style’ as an argument for copyright with a large grain of salt. Certainly, there are chess players with a personal style: either adventurous, or wait-and-see, defensive, or rigid and solidly built, impossible to get through. In his thesis, the aforementioned Gerard Wildschut mentions a small study he conducted among grandmasters. Were they able to identify the players on the basis of a written-out anonymous game? Only two grandmasters said they would be able to, but all the others whom he had asked the question, were at least convinced that their chances of identifying the names were many times greater than the statistical chance of ‘guessing correctly’. For Wildschut, this was an argument to support his proposition that chess games have a personal character.<sup>10</sup> But – and this is my point of view – although a chess player indeed has a choice of many moves, the move he eventually makes is the only one he judges, after extensive calculation, to be the best one at that particular moment, i.e. the one that leads to winning, or at least to not losing. Winning is the (technical) goal and that comes first. The fact that some chess players have their own, even recognisable, style of playing does not alter this. One may play defensively, the other aggressively; one may rely on his pair of bishops, the other on his two knights. It was no different with the famous Michael Tal. It is said of this ‘magician from Riga’ that he did not always make the ‘best’ move (in terms of chess technique); rather, he wanted to complicate the gameplay with his moves. I think that in the end Tal would also make a move that he estimated made his chances of winning better than with another, perhaps more obvious, move. However, for every chess player it is true that if he sees a move, which leads (almost) immediately to a win, he will make that move and he will deviate from his earlier ‘personal’ set-up and style. For the record: a chess player does not always make the best move, he just thinks he does!

Moreover, one has to put ‘ingenuity and beauty’ of often spectacular combinations into perspective. Many combinations are not recognised during the game. That happens, especially in speed chess, often only afterwards during the analyses. Combinations are also seldom prepared and ‘built up’, but more often thrown into the player’s lap by a bad move from the opponent. Suddenly the combination is there; the winner sees it, the loser did not see it coming. If neither sees the combination, it will surface only in the analyses, or it may not. In our 1991 article Jaap Haeck and I reported an incident that occurred during an international tournament in Groningen. In the commentary room, under the direction of Ger Ligterink, there was a fierce discussion with the audience about the best continuation for black, until someone from the audience shouted: ‘Queen takes c3’, a Queen sacrifice! Ligterink, no slouch at chess himself, did not take the suggestion seriously at first, but together and in unison with the audience, he came to the conclusion that this move was indeed an ingenious one that would lead to victory. To the great disappointment of the whole audience, the black player at the board overlooked the combination and the game ended in a draw. Anyhow, combinations, like beautiful combinations in football, remain one of the attractive aspects of the game for the public. Every Saturday I still

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10. G.J. Wildschut, ‘De intellectuele eigendom van schaakpartijen’, Free University, 1979, 8.

try to solve the ‘problem’ (usually a beautiful combination) presented by Dutch chess journalist Hans Ree in the newspaper *NRC Handelsblad*. I rarely succeed, sometimes I can see the first two moves, but not the correct third one, and therefore I often miss the essence.

A chess match is an event, Kohler said. That is also how it was seen by the Federal Court in New York in 2016 in connection with the world championship duel between Carlsen and Karjakin. That duel was followed move by move by American television and internet commentators and the International Chess Federation tried to oppose this. The American judge reasoned ‘It is well-established that sports scores and events, like players’ moves in the Championship, are facts not protectable by copyright.’ Hot news, we could also say here. Incidentally, it is the only court ruling on chess that I have been able to find. A strong argument that already argues against granting copyright to the chess game.<sup>11</sup>

If a chess game is an event, what happens? Well, not much physically, but in the minds of chess players a lot. In a move, the players’ hands move pawns or pieces on the chessboard. There are few variations, but no matter how elegantly or exuberantly the chess player executes his move, it is nothing other than the result of his thinking, which sometimes takes a very long time. That result is: I think this move is the best continuation to lead this game to a win, if not to a draw at least. Even the (alphanumeric) notation of the move on paper (1. E2–E4)<sup>12</sup> says nothing more than from which square to which square the piece has been moved and says therefore the same as the physical moving of a pawn or a piece, namely the result of the chess player’s thinking: this is the best move to win. It says nothing about all the considerations and calculations that led him to that move.

We could call the game of chess not only an event, but also an intellectual battle of ideas. White makes a move and says: ‘With this move, white is better’. Black’s reply is: ‘With this counter-move I have the best defence, it leads to at least a draw’. Whether it is a beginner or a chess grandmaster who makes the move, it is just as much a battle of ideas, carried out with only a small physical movement and put on paper with a tiny alphanumeric formula. Copyright does not prevent another chess player who has found himself in the same position from making the same move because he too has the idea of making the best move. Where ideas are not protected by copyright and lead to copyright protection only through a personal expression – and thus not through the impersonal alphanumeric design or through a move on the chessboard – we should also conclude from this explanation that there can be no question of copyright on a game. We will never know, or only find out after the fact, in the chess player’s analysis of the game, how thoroughly his move has been worked out according

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11. U.S. District Court Southern District of New York 11 Nov. 2016, *Agon v. Chess24*, <https://chess24.com>

12. The chessboard is divided into 64 squares which are alphanumerically represented from A to H and from 1 to 8; so ‘1. E2–E4’ means 1: first move; E2–E4 means that a pawn has moved from square E2 to square E4.

to a plan in his head. But when more is written down, only then does it begin to look like a work in the copyright sense. More on that later.

If a chess game is an intellectual battle of ideas, could one not see it as a dialogue or, even better, a discussion, between two people? Such a discussion also has a purpose: to win the debate.<sup>13</sup> In my first essay-like publication on this subject (in a literary magazine!) I found in this comparison an argument for considering a chess game as a work in the copyright sense, but I later abandoned it, in the article written with Jaap Haeck.<sup>14</sup> Unlike in dialogue – and also unlike musical improvisation – in a chess game idea and expression coincide.

#### 4. BOUNDARIES OF COPYRIGHT

Jaap Haeck and I revisited all the arguments for and against granting copyright to a chess game in our article. Naturally the criteria used to define the concept of work were discussed. What moved the creator to his work? What constitutes the original character and the personal stamp of the maker? Where do the free and creative choices come in? Here, Gerard Wildschut argues at length that a chess game fulfils all these requirements, but he disregards the argument that each move represents an idea. The most appealing to us were the arguments of professors Anton Quaedvlieg and Egbert Dommering. In his dissertation on copyright and technology, Quaedvlieg writes: 'If the result is determined entirely by the laws of nature and is therefore not dependent on the personality of the person who brings about that result', then the choices made are based on inventiveness, not on creativity and originality.<sup>15</sup> An innovative modification of a classical opening<sup>16</sup> is not made because it is 'original', but because the chess player, after extensive study, has come to the conclusion that the new variation is better than the moves hitherto assumed by chess scholars to be the best.

The result of this inventiveness does not meet the requirement of personal character and free creative choice. What is necessary to obtain a technical effect falls outside copyright's originality test. According to Dommering, what is decisive is that a chess game is not aimed at an expression aimed at creation, but at an outcome beyond that, the win.<sup>17</sup>

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13. E.J. Dommering, 'Vormen van handelingen en arbeid een werk?', 3 *Informatierecht/AMI* (1986), 72–76 and 'De sportprestatie. Protection and free reporting', in W.F. Korthals Altes and G.A.I. Schuijt (ed.), *Sport and information monopolies* (Cramwinckel, Amsterdam, 1991), 9–21.

14. Schuijt, *supra* note 2, 132–140.

15. A.A. Quaedvlieg, *Auteursrecht op techniek* (W.E.J. Tweenk Willink, Zwolle, 1987), 21; see also HR 16 June 2006, ECLI: NL:HR:2006:AU8940 (*Lancôme/Kecofa*), NJ 2006, 585 with J.H. Spoor. J.H. Spoor; *Informatierecht AMI* 2006-14 m. nt. A.A. Quaedvlieg.

16. The first moves in a chess game are called the 'opening'; many openings have been given a name: 'French', 'Sicilian', 'Nimzo-Indian', etc. After the first move, a game can go in many directions, which are called 'variations', which have been extensively studied and commented upon in chess literature. These studies often go far beyond the twentieth move.

17. E.J. Dommering, 'Do acts and labour constitute a work?', 3 *Informatierecht/AMI* (1986), 74.

Looking at the case law on the ‘work concept’, we can conclude from the above that a chess game can certainly be called an intellectual creation of two persons, namely the result of diligent intellectual preparation and thinking during the game. The work is also very precise and objectively identifiable.<sup>18</sup> But that is not enough if we take into account the case law of our own Supreme Court, that in order to qualify for copyright protection, a work must also have its own personal character and bear the personal stamp of the author.<sup>19</sup> Similar requirements are also law in countries other than the Netherlands. In my opinion, a chess game does not meet these requirements, because what is necessary to obtain a technical effect – winning – falls outside the work test.<sup>20</sup>

## 5. WHAT CHESS PLAYERS ARE ENTITLED TO

I hope that the attentive reader has noticed that so far I have only discussed the question of whether there is copyright in a chess game. However, one should not think that by answering in the negative, a chess player will be deprived of any source of income other than prizes and starter fees.

I have already mentioned analyses. One finds them for example in newspaper reports, on internet sites, and in chess books. Such analyses explain why a certain move in the game was crucial: a strong move or a very weak move. Based on what could have been played differently, it is then explained how the game would have continued and whether that would have resulted in a win, a draw or a loss. The more detailed the analysis, the more such variations are discussed.

The reader can now follow, re-enact and judge, as it were, the train of thought or the calculation of the idea behind the player’s moves. It goes without saying that interesting games are chosen for analyses. Salon draws, in which a certain opening variation is reproduced, are skipped. There are also many chess players who analyse and comment on their most important games themselves. It strikes me as no problem to consider such analyses as copyright works, of course with the limitation of the right to quote from them. Compare it with the analysis of a poem. Practically the entire chess literature consists of such analyses of the opening variations, of whole games, and of endgames. And there is hardly a top chess player who has not made money from his publications. The textbook *Uncle Jan Teaches His Nephew Chess* by our only world champion (1935–1937)

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18. CJEU 13 November 2018, ECLI:EU:2018:899 (*Levola Hengelo/Smilde Foods*).

19. HR 1 June 1990, NJ 1991, 377 (*Kluwer/Lamoth*); HR 4 January 1991 (*Van Dale/Romme*), NJ 1991, 608 w.n. D.W.F. Verkade; *Ars Aequi* 1992, p. 31 n.n. H. Cohen Jehoram; *Copyright and Media Law* (1991), 177 m.nt. J.H. Spoor; *Computer Law* (1991), 84 m.nt. P.B. Hugenholtz; *IER* (1991), 38 m.nt. F.W. Grosheide. The earlier case-law of the Dutch Supreme Court is generally held to be in keeping with the EU’s Court of Justice on the originality requirement.

20. HR 16 June 2006, ECLI:NL:HR:2006:AU8940 (*Lancôme/Kecofa*). Extensive on the case law mentioned in this and the previous notes: Spoor, Verkade, Visser, *Copyright* (Wolters Kluwer, Deventer, 2019), 70–98.

Max Euwe, was extremely popular well into the twentieth century, until it was succeeded in the 1970s by *The Pawn Diploma* by Berry Withuis.<sup>21</sup>

By the way, it is interesting to consider that a tournament organisation had protection for the notations of the games, through the protection of non-original writings that Dutch copyright granted, until this was abolished because of the EU's Database Directive. In practice there were no problems here. Providing notations was and still is a service to the press and to fellow chess players. Now, after the abolition of protection for non-original writings, the single – alphanumeric – written representation of the game is rightly regarded as information that is in the public domain. This is different from New York 1893 and Paris 1900.

Jaap Haeck and I also saw the possibility for the chess player to oppose the publication of his ‘complete works’.<sup>22</sup> The Dutch Copyright Act contains such protection for parliamentary speeches, for example. A chess player could be successful in an action out of unfair competition or performance protection (tort), because the (collected) performances of a chess player can be equated with those that justify protection by an intellectual property right. However, in my judgment, a positive outcome for the chess player is not yet very certain.

There are also chess players who engage in certain studies: composing ingenious combinations, studying opening variations and endgame studies. The result of this is undeniably protected by copyright. Here too, however, one must take into account copyright limitations and exceptions, notably the right to quote.

Finally, in COVID-19 times, tournaments are played via the internet. That brings me to the chess computer programme. They are there to play via the internet. They are also available to play against or to calculate variations. The design of such a programme seems to me to be protected by copyright (and/or patent law). The game played by a chess robot, however strong it may be, is not protected by copyright as the game of a living being is.<sup>23</sup>

## 6. DATABASES

Especially for Bernt, who is a specialist in the field of database protection, I would like to say the following. By now, all kinds of digital databases of countless chess games have been built.<sup>24</sup> The alphanumeric representation is of course a great advantage and for the users it makes the search for, for instance, opening variations considerably easier than with the earlier card indexes that were compiled

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21. By the way, Euwe’s book is still for sale today: Max Euwe and Albert Loon, *Uncle Jan Teaches his Nephew Chess* (Tirion Sport, Baarn, 2011).
22. See for instance: J. Timman, *Timman’s Triumphs. My 100 Best Games* (New in Chess, 2020).
23. Extensive and interesting in this context: Laurens Buijtelaar and Martin Senftleben, ‘Copyright on robot secretions? An analysis based on the incentive theory’, 3/4 AMI (2020), 77–93; see further on the development of computer chess: H.J. van den Herik, *Computerschaak. Chess world and artificial intelligence* (diss. Delft University of Technology, 1983), and H.J. van den Herik, ‘Intuition can be programmed’, farewell lecture, Tilburg University, 2016.
24. For this paragraph, I thank Prof. D.J.G. Visser and Prof. H.J. van den Herik for some useful suggestions.

with much care and devotion. Such a collection of data is of course subject to the database copyright of the collector, if the selection and arrangement of the content testifies to his own intellectual creation. This seems to me to be the case. The researcher can use various search criteria: chess players, tournaments, openings, variations, endgames, etc. The collector in his turn can include the games as played from chess literature in his database, but for the analysed games he will have to ask permission from the author(s) of the analyses.

Chess players will be able to benefit from such databases and will only have to confess to the collector when copying from the database if it involves such a substantial part of the database that what is original to the collection is copied. If the database is subject to a *sui generis* right, the producer may only oppose copying by a chess player or other party if he gradually ‘milks’ the database by repeatedly taking insubstantial parts, or if he extracts substantial parts of it. Otherwise, users of the database will have to approach the author of the analyses when copying them, unless they can invoke an exemption or limitation such as the right to quote. All this insofar as the right holder of the database has not already given permission on behalf of the authors and is not allowed to do so.

## 7. CONCLUSION

In short, chess players have no copyright in their games. That is a good thing. For the development of the game it is essential to be able to quickly and fully take note of the games of fellow chess players. For a chess player it is not interesting that Giri won over Carlsen, they especially want to know how he managed to do so and they want to study and analyse that in detail. And on those analyses, they can have copyright!



# Tattoos: Control and Ownership of Body Art? Some Cultural Historical, Aesthetical and Legal Reflections

*Thomas Dreier*

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## 1. ***DEDICATIO***

When we were young ..., we could not imagine that the time would come to contribute to Essays in Honour of Bernt Hugenholtz, a book called in German a *Festschrift*. Rather, in those early days, the way was the goal.<sup>1</sup> In our professional lives, Bernt and I went on our parallel ways for a long time, he as the Director of the famous Amsterdam Institute for Information Law, me as Director of the much smaller Institute for Information and Business Law in Karlsruhe. At times, we followed a path together, most notably when co-editing our *Concise European Copyright Law* (I still remember the evening at the Café Schiller on the Rembrandtplein, when I succeeded in persuading a somewhat reluctant Bernt to shoulder his part of this labour-intensive project, which haunts us ever since) and when producing the famous WITTEM code<sup>2</sup> together with friends, most of who later formed the European Copyright Society.<sup>3</sup>

When it comes to sports, however, the parallel between Bernt and me is much less obvious. True, we are both soccer fans, especially – with symmetrically distributed sympathies – when it comes to the classical match between the Dutch and the German teams. But Bernt was the only one who actively played soccer.

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1. Proverb, attributed to Confucius. This old saying itself travels on a path through time, see, e.g., Antonio Machado's 'Caminante, no hay camino, se hace camino al andar', *Proverbios y cantares*, Poema XXIX (Editorial Renacimiento, Madrid, 1912).

2. <https://www.ivir.nl/copyrightcode/introduction>; for a summary and reception in Germany see <https://de.wikipedia.org/wiki/Wittem-Projekt>.

3. <https://europeancopyrightsociety.org>.

So, which subject to write about at the intersection of soccer and copyright? Apart from television rights, copyright law and soccer have little in common. Players' moves are not copyrightable and soccer players don't belong to the category of performers,<sup>4</sup> since they do not perform a literary or artistic work or an expression of folklore. However, one question is who owns the rights to the tattoos soccer players wear on their arms and that are, together with the player, realistically depicted in a videogame?

When the law takes on the issue of tattoos, it is not only the protectability of ornamentation of the body which needs to be discussed (4.). Rather, underlying this discussion are some fundamental aesthetic and cultural-historical issues (2.), which give rise to additional legal issues (3.).

## 2. ON THE HISTORY OF TATTOOS

### 2.1 Tattoos and Culture

Anthropologically speaking, the origins of tattooing date back several thousand years in the history of mankind. In view of the different techniques used, it is assumed that the custom of tattooing developed independently and autonomously in different peoples of the world. The origin of the term 'tattoo' is clearly documented as an adaption of the Tahitian 'tattau' following James Cook's travel reports.<sup>5</sup> The motifs for tattoos are as diverse as their places of origin. They appear in religious ceremonies as well as in initiation rites, they serve purposes of warfare, stigmatisation and, of course, decoration. Tattoos also seem to have been used for therapeutic purposes, as is suggested by the 5,200-year-old 'Ötzi', which was preserved by the ice of the South Tyrolean Alps. In any case, tattoos are not only carved into the skin of the respective wearer, they are likewise deeply inscribed in cultural practices, although subject to change regarding both place and time.

Thus, Greece and Rome attributed tattoos mostly to barbarians.<sup>6</sup> The stigmatisation inherent in them was partly transferred to the marking of slaves, but also to the marking of legionnaires within the Roman army. Interestingly, the Old Testament also contains a ban on tattooing. 'Ye shall not ... print any marks upon you' (Lev. 19:28). Even though tattoos seem to have been quite common among early Christian and later mystical sects as signs of affiliation, as well as amongst crusaders, who wanted to secure a Christian burial in case they died in a foreign country, the negative interpretation largely remained in Christian Europe throughout the Middle Ages. In times of colonisation, tattoos appeared to the Western imperial eye as the epitome of the wild, uncivilised and

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4. On these questions, see e.g. the contributions by Lionel Bently and Séverine Dusollier in this volume.

5. For Omai, the tattooed prince from Tahiti who accompanied James Cook in 1769 on the way back from his second voyage to the South Seas see <https://en.wikipedia.org/wiki/Omai>, and for the portrait by Joshua Reynolds [https://en.wikipedia.org/wiki/Portrait\\_of\\_Omai](https://en.wikipedia.org/wiki/Portrait_of_Omai).

6. In ancient literature, tattoos are often attributed to the Thracians and the Skythians.

exotic, which apparently triggered an – albeit only short-lived – fashion trend in aristocratic circles. Since then, tattoos were widely associated with seamen, prisoners and prostitutes, who for their part had themselves tattooed in deliberate demarcation from the clean bourgeois aesthetic canon. In the twentieth century, tattooing numbers on the forearms of inmates of concentration camps as preparatory measure to their bureaucratically organised physical extermination stood as much in the way of a positive connotation of tattoos as did their demonstrative display by frightening biker gangs in the 1960s. Thus, at least in Germany, it took well into the 1970s, if not the 1980s, before the first social subcultures rediscovered tattoos as a sign of rebellion, and before tattoos were widely accepted in all classes<sup>7</sup> as a more or less narcissistic form of designing the appearance of one's physical body. By now, many athletes and soccer players are indeed tattooed.

## 2.2      **Tattoos, the Self and the Others**

No matter in which function and out of which motivation a tattoo is worn, it is always more than a mere pattern and an isolated graphic design. Engraved on the body, a tattoo affirmatively signals a certain affiliation to a particular group, be it the group of tattooed people as a whole or the group of wearers of an identical or similar tattoo. At the same time, the tattoo distinguishes this group from other groups. Thus, tattoos have both an inclusive and an exclusive effect, which is most visible when the signs are not merely selected according to individual preferences, but as indicating membership of a particular group.<sup>8</sup> Even if the tattoo is only applied narcissistically as decoration for the body or to increase one's own sexual sensation, this shaping of one's own self and identity is at the same time a demarcation of one's own from the self of the others.<sup>9</sup>

In any case, even purely ornamental tattoos as signs have a semantic meaning which is communicated to the outside world if the body part to which the tattoo is attached is not covered by clothing. Far more than mere ornamentation, tattoos are embedded in a context of social communication.

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7. Even the wife of former German President Christian Wulff (2010–2012) wore a tribal tattoo visible to everyone, which, however, gave rise to much criticism particularly in the conservative press; see, e.g., Ulf Poschardt, 'Die Spißigkeit auf der Haut der Bettina Wulff', *Die Welt*, 13 September 2012, <https://www.welt.de/kultur/article109183938/Die-Spiessigkeit-auf-der-Haut-der-Bettina-Wulff.html>.
8. Such as, e.g., the Arian Brotherhood and adherents to the extremist right, whose members bear tattoos such as runic marks, swastikas and other symbols used by the National Socialist party; for a court case see the decision of the Federal Administrative Court (Bundesverwaltungsgericht, BVerwG) 2 C 25.17 of 17 November 2017.
9. For detail see, in German literature, Tobias Lobstädt, *Tätowierung, Narzissmus und Theatralität* (Springer, Berlin, 2011); Henrike Klann, *Tätowierungen als repräsentatives Inszenierungssymbol im Kontext des sozialen Habitus* (Grin, Munich, 2012), available at <https://www.grin.com/document/191449>; for a brief overview see also <https://en.wikipedia.org/wiki/Tattoo>.

### 3. TATTOOS, SOCIAL COMMUNICATION AND THE LAW

#### 3.1 Tattoos and Aesthetics

The legal assessment of tattoos in the context of social communication concerns questions of perception, viewing and interpretation. These are questions of aesthetics, and, more specifically, of legal aesthetics.<sup>10</sup>

From a legal perspective, the question is whether the message communicated by a tattoo is so disturbing that the law should intervene. In Germany, this question has been answered positively for insignia of anti-constitutional organisations as well as to depictions of child pornographic content that may not be publicly shown or even possessed.<sup>11</sup> But which other legally protected interests could lead to a restriction of aesthetic messages sent out by tattoos, the selection of which is, after all, covered by the fundamental guarantee of freedom of expression?

#### 3.2 Aesthetics of Neutrality

Even if it doesn't affect soccer players, one such example is the interest of the State to guarantee the neutrality of persons who represent the State in an official capacity. Concerning tattoos, there are several court cases in Germany which deal with the issue of whether or not police officers should be allowed to visibly wear tattoos. Beyond the issue of individually disturbing signs, the legal question here is whether visible tattoos do as such contradict a policeman's neutrality.

The principle that as a representative of the state, a police officer must be neutral in the performance of his duties, is generally accepted. He should not belong to any political group nor should he distinguish himself from other social groups by a sign.<sup>12</sup> In legal terms, neutrality in visual appearance is considered part of the overall duty to act in a neutral way. The law thus transforms the semantic neutrality of a police officer's behaviour into the symbolic and aesthetic neutrality of his appearance. Since visual neutrality obviously tends to be symbolised by the clean, undecorated surface of the skin, the absence of tattoos is taken to be the rule to which the tattoo forms an exception which hence needs to be justified. But in view of the changing cultural and historical perceptions

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10. For legal aesthetics in German literature see Daniel Damler, *Rechtsästhetik: Sinnliche Analogien im juristischen Denken* (Duncker&Humboldt, Berlin, 2016); Eva Schürmann and Levno von Plato (eds.), *Rechtsästhetik* (Nomos, Baden-Baden, 2020).

11. §§ 86a and 184b together with 11 (3) of the German Criminal Code.

12. See, e.g., BVerwG (*supra* note 8), note 48; Bavarian Parliamentary Document LT-Drs. 17/21474, p. 1. – For length of hair see BVerwG Az. 2 C 3.05 of 2 March 2006, and for a ban on wearing earrings by male customs officers Federal Constitutional Court (Bundesverfassungsgericht, BVerfG) 2 BvR 550/90 of 10 January 1991. – The principle of neutrality also applies to other State representatives such as teachers (where wearing a head scarf is an issue), as well as to representatives of the law (e.g., by way of the robes of judges and lawyers, which conceal the individual form and emphasise the function of its bearer; another symbolic example is the blindfold of justice).

of tattoos outlined above, current changes in the attitude vis-à-vis tattoos must be taken into consideration when a legal determination regarding the effect of tattoos upon the perception by the average citizen of a policeman's neutrality cannot be disregarded.<sup>13</sup>

To the extent that the police in Germany is a matter for the Länder, the normative answers to the question of under which circumstances the requirement of neutrality is violated if police officers wear tattoos differ considerably.<sup>14</sup> In the case recently decided by the Federal Administrative Court,<sup>15</sup> a Bavarian police officer was denied permission by his superiors to tattoo the word 'aloha' (Hawaiian for a friendly greeting) that would be visible when wearing the short-sleeved summer uniform. The decision was taken based on a ministerial decree which contained a general ban on visible tattoos and which was issued based on a statutory provision which empowered the executive to regulate the outer appearance of police officers.<sup>16</sup> The plaintiff, however, asserted his right to free development of his personality and the right to equal access to every public office according to aptitude, qualification and professional performance.<sup>17</sup> In addition, he argued – against the lower courts and utterances in legal literature<sup>18</sup> – that

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- 13. It should be noted that because of the massive abuse, during the time of National Socialism, to justify grossly unjust decisions by way of reference to the formula of the *gesundes Volksempfinden* ('healthy sentiment of the people'), the German courts which are bound by the Grundgesetz to law and justice are particularly reluctant to take account of the *Zeitgeist*.
- 14. While the current Bavarian regulation regarding visible tattoos of police officers is particularly strict, other states such as Baden-Württemberg only prohibit visible tattoos that endanger trust ('*vertrauensgefährdend*').
- 15. Decision of 14 May 2020, Case 2 C 13.19, following the judgement of the Bavarian Constitutional Court (BayVGH) 3 BV 16.2072 of 14 November 2018; for the first instance see Administrative Court Ansbach AN 1 K 15.1449 of 25 August 2016. – Similarly, the Administrative Court of Appeals (OVG) of North Rhine-Westphalia 6 B 540/16 of 14 July 2016; only as regards large area tattoos Constitutional Court of the Land of Hesse 1B 1006/14 of 9 July 2014; additional references also of more generous lower courts at Rebecca Hantke, 'Tätowierungen bei Polizeibeamten: Ansehensminderung oder Spiegelbild der Gesellschaft?' (2013), available at <https://www.veko-online.de/62-archiv/ausgabe-6-13/303-polizeitätowierungen-bei-polizeibeamten.html>.
- 16. Art. 75 (2) of the Bavarian law on Civil Servants (Beamtengegesetz), as amended in May 2018 (GVBl. S.286), and number 3 of the Communication by the Bavarian Ministry of the Interior of 7 February 2000, IC5-0335.1-0 (AllMBL. S. 99), reissued on 7 April 2020 (BayMBL. No. 229). – The Bavarian legislator was convinced that 'civil servants cannot comply with the official duty of appearance because of their tattoos'; LT-Drs. 17/21474 (*supra* note 12), p. 2.
- 17. Arts. 2 (1) and 33 (2) of the Basic Law (Grundgesetz).
- 18. Maximilian Blaßlsberger, 'BayVGH bestätigt Tätowierungsverbot' (26 November 2018), available at <https://www.rehm-verlag.de/beamtenrecht/blog-beamtenrecht/bayvgh-bestätigt-tätowierungsverbot>, and 'Eignung von tätowierten Beamten', *Der Personalrat* (PersR) (2013), 401–404; Jörg-Michael Günther, 'Sichtbare großflächige Tätowierungen kein Einstellungshindernis für Polizeivollzugsbeamte?' *Zeitschrift für Beamtenrecht* (ZBR) (2013), 116–144 (120); see also Thorsten Masuch, 'Der charakterlose Polizist', *Die öffentliche Verwaltung* (DÖV) (2018), 697–709, and Steffen Schmidt, *Das äußere Erscheinungsbild von Beamtenbewerbern* (Nomos, Baden-Baden, 2017).

the attitude towards tattoos as body decoration has changed decisively both in the population and in the police service.

Consequently, attention focused on the demoscopic surveys of how tattoos are perceived by the public. Although a study from 2014 revealed a significant increase in the acceptance of tattoos in the German population as a whole (with rather substantial discrepancies between younger and older age groups as well as between East and West Germans), according to a slightly older study from 2010 a substantial part of the population still considered visible tattoos worn by police officers as 'disturbing or very disturbing' (53.1% of up to 25 year olds, and 73.8% of those over 45 years of age).<sup>19</sup> On the basis of these figures, the Bavarian Constitutional Court (BayVGH) did not object to the denial of applying the tattoo in question, stating that it was not for the case-law to fill in the political discretion of the legislature by its own assessment. Rather the general acceptance should be decided in public debate.<sup>20</sup>

Anyway, in the end the BVerwG was no longer concerned with substantive law questions. Rather, it only had to decide whether the ban on visible tattoos should have been explicitly regulated in the law, and whether the official decree prohibiting visible tattoos issued before the new legislative enabling clause was adopted by Parliament should have been officially re-issued after the legal regulation came into force.

#### 4. TATTOOS AND OWNERSHIP

##### 4.1 The Issue

Other than the administrative law cases just discussed, copyright is surprisingly uninterested in the semantic content of individual tattoos. Nor is copyright really interested in issues of aesthetics, with the notable exception of ascertaining the creativity required to achieve to an author's own individual creation.<sup>21</sup> Rather, when discussing copyright and tattoos, the issues concern the copyrightability of tattoo motives, rights ownership, the uses covered by the exclusive rights and the limitations and exceptions thereto. Likewise, contractual issues come into focus. Ultimately, copyright is not the only legal regime at issue, since – as an integral part of the body – a tattoo forms part of its wearer and hence of his identity and personality.

Other than in Europe, where the depiction of players' tattoos in computer games has hardly been discussed, in the US the District Court for the Southern District of New York handed down a summary judgement in March 2020 on the

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19. Allensbach Study No. 12/2014 v. 8.7.2014; [https://www.ifd-allensbach.de/fileadmin/kurzberichte\\_dokumentationen/PD\\_2014\\_12.pdf](https://www.ifd-allensbach.de/fileadmin/kurzberichte_dokumentationen/PD_2014_12.pdf). – The results of the study of 2010 are cited in LT-Drs. 17/21474 (*supra* note 12), p. 1 et seq.

20. BayVGH (*supra* note 15).

21. When the three Directives which contain the definition of the author's own intellectual creation state that '[n]o other criteria shall be applied to determine their eligibility for that protection', this seems to explicitly exclude aesthetic criteria, unless one sees the aesthetic encapsulated in the creativity of the design of a protected author's own intellectual creation.

issue of who owns the copyright in the tattoos of NBA basketball players.<sup>22</sup> In this case, Solid Oak Sketches, a tattoo licensing company that had itself contracted with the tattoo artists, had sued Take-Two, a major developer and publisher of interactive video games with realistic renderings of different National Basketball Association ('NBA') teams, including lifelike depictions of NBA players and their tattoos.

## 4.2      **Tattoos and German Copyright Law**

In a nutshell, the copyright issues concerning tattoos and their use in computer games can be briefly summarised as follows.

### 4.2.1    *Copyrightability*

Tattoos can only be protected under copyright law as works of visual art provided there is sufficient scope for creative choices in their design, of which the creator has made creative use.<sup>23</sup> Therefore, copyright protection is not available for simple stylisations of ordinary, everyday motifs such as the 'anchor' or the 'heart pierced by an arrow', nor for graphically non-demanding lettering. The result is different, however, when new and even standard motifs are designed in a particularly individual and creative way.

However, the pattern, ornament or symbol in question must not merely be designed in a certain style. This is because a style is considered 'common currency'<sup>24</sup> so that there is no copyright protection for a particular style, despite the fact that differences of styles can be observed in much the same way as styles serve as an instrument of distinction.<sup>25</sup>

### 4.2.2    *Ownership*

The author of a sufficiently creative tattoo is the person to whom the creative design is attributed as his own work. This may be the person who makes the tattoo. However, if the person performing the physical act of tattooing only makes use of a template that can be found in a pattern book, it is the designer of the

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22. *Solid Oak Sketches, LLC v. 2K Games, Inc.*, USDC, S.D. New York 26 March 2020; <https://www.loeb.com/-/media/files/pdfs/solid-oak-v-take-two.pdf>. For a summary by Tal Dickstein and Mary Jean Kim see <https://www.loeb.com/en/insights/publications/2020/04/solid-oak-sketches-v-2k-games>.

23. §§ 2 (1) (4) and 2 (2) of the German Copyright Act (Urheberrechtsgesetz, UrhG).

24. Diego Mantoan, 'Style as a Common Currency and its Aesthetic Consequences', in Julian Blunck and Tanja Michalsky (eds.), *Stil als (geistiges) Eigentum* (Hirmer, Munich, 2018), 141–162.

25. Antonia Putzger, 'Distinktion von Stilen und Stil als Distinktion', in Blunck and Michalsky, *ibid.*, 105–124; see also the contributions by Grischka Petri, 'Über den Stil aus urheberrechtlicher Sicht', *ibid.*, 35–55 and Reinold Schmücker, 'Stil als (geistiges) Eigentum?', *ibid.*, 287–300.

tattoo as shown in the template who is to be considered its author.<sup>26</sup> Similarly, the person commissioning the tattoo can be the sole author, and ultimately, co-authorship may be found if the person who applies the tattoo and the commissioning party have designed the tattoo jointly.

#### 4.2.3 Scope of Protection

Like all protected works, copyrightable tattoos enjoy the full scope of protection against unauthorised exploitation in physical and non-physical form. When tattoos of athletes are depicted in computer games which are played by way of streaming, both the reproduction and the making available rights are touched upon. In contrast, offline versions of computer games, for the manufacturing and distribution of which both the reproduction and the distribution rights are needed, are generally played in private circles, so that in this case, the public communication right is not at stake. This is all rather unspectacular.

More interesting appears to be the question of possible limitations and exceptions. However, on closer inspection it becomes clear that none of them is likely to be relevant. The exception for the reporting of current events is hardly applicable, since – although the game may represent the players of a particular season – it cannot be said that the tattoos are ‘of informative interest to the public’ at the time they are reported, nor that they are ‘reported’ at all.<sup>27</sup> Moreover, the exception for quotations is not applicable, since players’ tattoos are not depicted ‘for the purposes of illustrating an assertion, of defending an opinion or of allowing an intellectual comparison between that work and the assertions of that user’.<sup>28</sup> Likewise, the exception for the incidental inclusion of a work or other subject-matter in other material<sup>29</sup> is also not available, since the tattoo was deliberately and not merely incidentally depicted in the computer game. Even if one were – as did the German Federal Supreme Court<sup>30</sup> – to measure the visual importance of the tattoo towards the totality of what is depicted, the limitation

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26. There also is the issue of cultural appropriation of indigenous visual imagery through tattoos, which is not too uncommon, as many soccer players wear ‘tribal’ tattoos. See Marie Hadley, ‘Mike Tyson Tattoo’, in Claudio Op den Kamp and Dan Hunter, *A History of Intellectual Property in 50 Objects* (Cambridge University Press, Cambridge, 2019), 400–407; on the issue of intellectual property rights for indigenous cultural expressions see Thomas Dreier, ‘Caught between Post- and Neo-Colonialism: IP for Traditional Knowledge, Traditional Cultural Expressions and Indigenous Resources’, in Christine Godt and Matthias Lampert (eds.), *A Critical Mind: Hanns Ullrich’s Footprint in Internal Market Law, Antitrust and Intellectual Property* (Springer, Berlin, forthcoming).
27. Art. 5 (3) (c) InfoSoc Directive; CJEU C-516/17, paras. 66 and 67, ECLI:EU:C:2019:625 – *Spiegel Online*.
28. Art. 5 (3) (d) InfoSoc Directive. – For interpretation see CJEU C-469/17, ECLI:EU:C:2019:623 – *Funke Medien NRW* and C-516/17, para. 78, ECLI:EU:C:2019:625 – *Spiegel Online*.
29. Art. 5 (3) (i) InfoSoc Directive.
30. BGH I ZR 177/13 of 17 November 2014 – *Möbelkatalog*. – In addition, one may argue that if the creative details which represent the work’s originality cannot be seen in the game because of insufficient resolution, the tattoo has not been reproduced, so that no infringement has taken place.

would only be available if the tattoo were merely an insignificant accessory of the computer game or hardly visible at all, but not if the tattoo allows the person playing the computer game to identify the respective athletes depicted.

Finally, even if top athletes may appear as monuments in the collective memory of their fans, they are as such not comparable to the larger-than-life bronze sculptures permanently erected in public spaces which the legislator had in mind with the panorama exception, which allows their reproduction without the author's consent and without remuneration.<sup>31</sup> True, athletes and their tattoos might be visible in publicly accessible stadiums and sports halls, but it can hardly be said that they are permanently located in public places.<sup>32</sup>

#### **4.2.4 *Transfer of Rights***

As far as the designer or the maker of the tattoo is to be regarded as the original author, the question is to what extent the rights have been granted to the commissioning tattooed person. The scope of the transfer of rights can both be individually negotiated and defined in the tattooist's standard terms and conditions. Moreover, since the tattoo becomes an integral part of the person tattooed, one may well assume an implied licence is granted by the tattooist, unless the circumstances indicate otherwise. At first glance this result might seem to be contradicted by the author-protective provision of the German Copyright Act, according to which in the absence of a specification of the different types of use, the scope of use rights is 'determined in accordance with the purpose envisaged by both parties to the contract' (so-called purpose-of-grant-theory).<sup>33</sup> However, this is not a real problem as both parties usually assume from the outset that famous athletes who contract for a tattoo will also exploit it commercially within the scope of marketing their personality.

#### **4.2.5 *Personality Rights and Data Protection***

Discussing the issue of tattoos from a copyright perspective alone is, of course, not the end of the story. True, ownership rights cannot attach to the human body, but only to its parts once they have been separated from the body, such as cut-off hair. Since a tattoo is inseparably connected to the body, copyright is not superimposed by the right of ownership, but rather by the personality right of the person wearing the tattoo.

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31. Art. 5 (3) (h) InfoSoc Directive.

32. According to German interpretation of the exception, it is not required that the copyrighted work is stationary; see BGH I ZR 247/15 of 27 April 2017 – *AIDA* (painting on a cruise ship).

33. § 31 (5) UrhG. –The BGH considers this provision not as a mandatory but as a mere rule of interpretation so that its waiver in standard terms and conditions is not void because it does not violate 'essential basic ideas of the legal regulation' (§ 307 (2) (1) of the Federal Civil Code).

As far as personal images ('*Bildnisse*') are concerned, German law contains a special legal provision in an old law dating back to 1907, according to which the distribution and displaying of a personal image requires the consent of the person depicted.<sup>34</sup> Even if tattoos are not complete personal images, they can still identify the person depicted in the computer game, thus making this form of legal protection applicable.<sup>35</sup> In practice, however, this is not a problem in so far as athletes generally transfer their personality rights – and with them the right to make use of the tattoos applied to the players' skin – for marketing purposes to sports rights agencies who in turn license them – amongst other things – for inclusion of the athlete's image in a videogame.

After entry into force of the European General Data Protection Regulation (GDPR) the issue of the relationship between the personality right of one's own image on the one hand, and data protection on the other came up. After all, both the personal image and a recognisable and widely known tattoo make that person – directly or indirectly – identifiable and are therefore personal data within the meaning of the GDPR.<sup>36</sup> However, according to German understanding, the right to one's own image is not limited to a personality right, but likewise protects the interest of commercially marketing the image,<sup>37</sup> which in turn is not as such addressed by the GDPR, since the GDPR does not grant IP-like protection.<sup>38</sup> The partial overlap of these two legal regulatory schemes can be solved, however, by assuming that the national rules on image protection remain in force under the opening clause of Article 85 (2) GDPR or, alternatively, that the GDPR is only *lex specialis* regarding the isolated processing of personal data, but not regarding the processing of personal data which takes place when commercially exploiting one's own image.

#### 4.3 US Law

In the US, much as in Europe, tattoos that merely replicate known motifs are also not copyrightable, whereas tattoos that are specifically designed for an individual customer may well enjoy copyright protection.<sup>39</sup> Although in some cases it seems that licence fees have been paid in tattoo cases,<sup>40</sup> the recent decision on

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34. §§ 22 et seq. *Kunsturhebergesetz* (KUG).

35. For references to German case law see Thomas Dreier, Gernot Schulze and Louisa Specht, *UrhG* (6th edn., Beck, Munich, 2018) § 22 KUG note 3.

36. See CJEU C-582/14 of 19 October 2016, note 60 and 61, ECLI:EU:C:2016:779 – *Breyer*.

37. For references see Dreier/Schulze/Specht, *supra* note 35, § 22 KUG note 36.

38. Of course, although the GDPR is primarily about the protection of personal data, by making the legitimacy of processing personal data dependent on, e.g., consent (which can be given against payment) or justified interests (thus weighing commercial interests against economic and moral interest of data subject), it indirectly allows for commercial transactions.

39. *Solid Oak Sketches, LLC v. 2K Games, Inc.*, *supra* note 22. – Another question is whether in the case of tattoos a copyright notice is affixed and whether the conditions for depositing tattoos with the Copyright Office are met, the lack of which entails certain negative consequences for the rightholder; Title 17 USC § 401 (d) and §§ 411 and 412.

40. Allegedly, in the confrontation between mixed martial arts fighter Carlos Condit and the producers of the computer game 'UFC Undisputed', a court awarded USD 22,500, and the

NBA player tattoos mentioned above did not have any problem in granting the defendant's motion to dismiss the case in summary proceedings.

First of all, the court concluded an implied licence because the engravers of the tattoos were well aware that their well-known customers<sup>41</sup> would make their tattoos publicly visible when commercially marketing their image amongst others in computer games. Secondly, the court considered the use as *de minimis*. This conclusion was possible since, contrary to German law which only looks at the copyrightability of the part taken, the US test for infringement looks for 'substantial similarities' of the works in question, so that the unauthorised taking of only small parts of another's protected work is not considered as infringing if it is incorporated into a much bigger work. In the case at bar, the court had assumed that even if the players appear in the computer game, 'the display of the tattoos is small and indistinct, appearing as rapidly moving visual features of rapidly moving figures in groups of player figures'. Furthermore, the players and their tattoos were not depicted on the game's packaging, nor had the defendant highlighted them in its advertising or used them for merchandising products.

Moreover, the US court could consider the incorporation of the tattoos in the videogame to be 'fair use'. In Europe, by contrast, an exception to the exclusive rights can in the light of the constitutionally guaranteed freedom of the arts – if at all – only be found by way of interpreting an exception listed in Article 5 (2) or (3) of the InfoSoc Directive.<sup>42</sup> Fair use offers a more flexible approach. According to the four-factor test, the inclusion was considered transformative use, because of the different purposes of the tattoo (expression through body art) and the computer game (identification of the player). In addition, the tattoos were only 'incidental to the commercial value of the game'. Moreover, the tattoos were only of rather limited creativity. Furthermore, in the opinion of the court the copying of a tattoo in its entirety was necessary to make fair use of the image. Finally, the unauthorised use of the tattoos on the secondary market for computer games did not trigger a proven substitution effect on the primary market for original tattoos. And, regarding the market for licensing tattoos to computer games itself, the court saw 'no evidence from which a reasonable fact finder could conclude that a market for licensing tattoos for use in video games or other media is likely to develop'. Of course, the validity of this last argument as a justification for assuming fair use depends on the outcome of the fair use test itself and is therefore circular. Indeed, if the use of tattoos in computer and video games were to be covered by exclusive rights (which is yet to be ascertained), a market would develop and the justification for assuming fair use would no longer apply.

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dispute between the tattoo artist who had decorated the face of boxer Mike Tyson and the producers of the Hollywood comedy *The Hangover* ended in an out-of-court settlement; see Jürgen Kalwa, 'Darum beschäftigen die Tattoos von prominenten Sportlern amerikanische Gerichte', *Neue Zürcher Zeitung* (NZZ), 9 January 2019, <https://www.nzz.ch/sport/nba-gerichtsprozess-wegen-tattoos-prominenter-basketballer-ld.1450062>.

41. NBA players Eric Bledsoe, LeBron James, and Kenyon Martin.

42. For the rather narrow possibilities left to national courts in the EU see CJEU C476/17 of 29 July 2019, ECLI:EU:C:2019:624 – *Pelham*.

## 5. CODA

All in all, as interesting as the cultural history of tattoos may be, it can be concluded that, in terms of copyright, there is not much ado about a tattoo!

# ‘The Portrait of a Gentleman’<sup>1</sup> – The *Cruijff* Case

*Egbert Dommering*

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In this contribution,<sup>2</sup> I would like to discuss portrait rights and their somewhat contrived relationship with copyright law using a landmark decision of the Dutch Supreme Court on the portrait of Johan Cruijff, one of the most famous footballers of all time.<sup>3</sup> Before doing so, I will briefly elaborate the object of copyright law, taking Bernt Hugenholtz’s PhD thesis on copyright in information and the concept of copyright work as my starting point. Using this thesis and some of my own complementary insights, I will show why sporting achievements fall beyond the scope of copyright law. This means that sports players must look for different ways of protecting the commercial value of the combination of their intellectual and physical performance, which in terms of value does not differ from performances that are protected by copyright. A perusal of the typical sport exploitation model leaves only one real option, i.e. to exploit the image of the person in the media (his or her ‘portrait’). This brings me to an analysis of privacy law as a property system intertwined with copyright law. Hugenholtz’s analysis is most useful in that respect. I will show that the Dutch Supreme Court’s ruling is but one step in the right direction: this ruling removed portrait rights from the copyright law context, where they do not belong, but in my view it still fell short of taking this to its final logical conclusion.

Finally, I will continue the line of viewing portraits as a type of ‘intellectual’ property through to the law of personal data in general (given that a portrait is a piece of personal data). That is complicated but not impossible. The analysis

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1. With reference to the novel by Henry James.

2. English translation Nynke Hendriks, a former student of the Institute for Information Law.

3. Dutch Supreme Court 14 June 2013, *Nederlands Jurisprudentie* 2015, no. 112 with commentary by P. B. Hugenholtz. In these proceedings I acted as Cruijff’s lawyer. This may, of course, have influenced my comments in this article but rest assured that it does not detract from my argumentation.

of the ‘intellectual’ property of information is most useful in that respect. This is a task for the Institute for Information Law (IViR), which in my view should return to its roots, i.e. information.

On 24 November 1989, Bernt Hugenholtz obtained his doctorate from the University of Amsterdam with a PhD thesis titled *Copyright in Information*. I was one of his supervisors.<sup>4</sup> I will quote the conclusions of this thesis which I believe are still valid:

According to one of the so-called maxims of copyright, information as such is outside the scope of copyright. The purpose of the study is to examine this maxim critically by applying the concept of information, as it has been developed in semiotics and information theory, to the doctrine of copyright law ... The concept of information is a word too often used, but rarely properly understood by copyright scholars. Basically information can be defined as any message that reduces the uncertainty of its receiver. The amount of information communicated may be described as its ‘surprise value’. Thus, information is, at first glance, a relative and subjective notion, dependent on the receiver’s prior knowledge. However, by adding a standardized code (rules regarding possible messages) information becomes a more or less objective concept. Drawing from semiotics (the theory of signs) two aspects of information are distinguished. The syntactical aspect regards the way in which a message (e.g. letters or words) is configured following the rules by the applicable language system. The semantic aspect deals with the relationship between the message and the object to which it refers; semantical information concerns the ‘meaning’ of the message ...

Freedom of choice exercised by the author is an oft-used standard to determine whether something is an original work. On this freedom, Hugenholtz observes:

In practice the chooser’s level of freedom is determined by the applicable ‘code’. This code is different in each sector of the information industry. Thus, in the world of art a higher level of creative freedom is accepted than in the world of science. Therefore, in the latter world copyright protection is more difficult to obtain than in the former. *Indeed the borderline between unprotected ‘ideas’ and protected ‘expression’ is ultimately drawn on the basis of various social, cultural, economic and technological considerations. In other words, defining the subject matter of copyright is, to a large extent, a question of information policy. ... Applying information theory to copyright law adds to the impression that the idea/expression dichotomy is a fallacy. No natural borderlines divide the domain of copyright and the public domain. The idea/expression dichotomy is, in fact, no more than a slogan that not all information is to be protected by copyright...With respect to news reports, it becomes clear that the copyright system is not at all suitable for the protection of this type of information. The essence of a news report, its ‘news value’, does not fit well into the scheme of literary property.* [Emphasis added]

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4. The other supervisor was Feer Verkade.

So much for Hugenholtz.<sup>5</sup> In other words, he rightly claims it is a myth to assume that the 'essence' of a work determines whether it is a copyrighted work: it is all information and it is the legal context that determines whether a piece of 'information' (either due to its 'content' or its 'form') falls within the scope of protection of copyright law or not. Hugenholtz also rightly refers to social and economic criteria that help to determine whether something is a copyrighted work, although the economic factors fall beyond the scope of his analysis. He refers to the qualification of whether something is a copyright-protected work as 'information politics'. Let's have a brief look at that information politics. Goffman, the US sociologist, developed the theory of the 'frame' to identify the significance of social facts. Nathalie Heinich, the French art sociologist, elaborated on this in *Le Cadre-Analyse d'Erving Goffman*.<sup>6</sup> Briefly put, the 'frame' decides which normative significance we attach to a societal fact. She uses the example, among others, of the Bulgarian artist Christo, known for wrapping famous buildings.<sup>7</sup> In 1985 he wrapped the Pont Neuf in Paris. The bridge thus acquired a different frame and society also began to behave differently towards this public structure. It was a traffic hub (a car route crossing the Seine) with a historical context (architecture from a certain period). By intervening in the political context (Christo received help from the French state and city authorities) and the social context (he deprived the bridge of its transport function), the object lost its societal frame to an artistic frame. The stalls around the bridge no longer sold models of the bridge as souvenirs but instead put 'adaptations' in the form of wrapped chairs in front of the stalls with a notice saying 'wrapped by me'. The wrapping also had legal consequences. The Pont Neuf bridge was no longer a public object that you could freely reproduce as a photo or souvenir because it had become a work of art that Christo had to exploit exclusively in order to cover the costs (the costly project was entirely self-funded by pre- and post-merchandising). There is even a judgment from the Paris court that the Pont Neuf was a copyrighted work for the four weeks during which it was wrapped, and could therefore not be freely photographed by tourists. At the time the 'real' Pont Neuf was still a popular spot for photos of loved ones standing in front of the railings, it has now become a favourite background for selfies.

In short: the social frame determines whether copyright law applies to what I will refer to as an 'information configuration'. There are also social frames in which information either has to be 'free' or 'secret'. The political frame is the best-known example of this. Public information is free because it is a means to gain power. Secret information is a means to stay in power. Democracy therefore,

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5. Hugenholtz did not apply his analysis to moral rights. You can apply the information theory to those rights too. They are intended to protect the authenticity and reliability of disseminated information. They contribute to what Luciano Floridi called the 'triple A' principles of information ethics: 'accuracy', 'accountability' and 'accessibility': Luciano Floridi, *Information. A very short introduction* (Oxford University Press, Oxford, 2010), 7–8. There are also moral sides to this, but I would rather rank those with privacy. I will leave that subject undiscussed in the rest of this article.

6. CNRS Éditions, Paris, 2020.

7. See my '*Christo de inpakker*' [in Dutch], <http://www.egbertdommering.nl/?p=1348>.

seeks to closely monitor those information flows. I am aware that this is an extremely succinct recap of the French Revolution.<sup>8</sup>

From an economic perspective, it is worth noting that information derives its value from the fact that it is shared with many parties (the ‘bestseller’): information often gains in value when it is disseminated widely, just as a network grows in value when more people join it. We refer to this as the network effect of information. This was the subject of extensive analysis in a book by Shapiro, the economist who as a consultant to Google helped develop their business model which exploits the network effect of search engines.<sup>9</sup> A Law Lord who had to decide on the meaning of the Queen Anne Act in eighteenth century England was already well aware of this: ‘Knowledge has no value for the lonely proprietor: to enjoy it, it needs to be communicated’.<sup>10</sup> In other words, so-called exclusivity, that pillar of copyright law, is without value in economic terms.<sup>11</sup> If authors want to profit from it, they must ensure that there is an identifiable link between this use (the network effect) and their own ‘creation’. However, to get the network effect it may also be necessary for this exclusive information to be freely available in a certain form during a certain period. An author can moreover increase the network effect by ‘name and fame’. We are now getting closer to portrait rights and sport. Before embarking on that discussion, I will first analyse the ‘frame’ of football and copyright law.

Copyright law has consistently excluded sports from its frame. There were good and not so good reasons for this. The not so good reason is that the essence of individual sports performances would not be eligible for copyright protection or ‘related’ rights. I discussed this problem at great length in my 1986 Dutch article ‘*Vormen handelingen een werk?*’ (‘Can human acts be a work of copyright?’). There are no valid arguments for not regarding a sports performance as a work. The better argument is that there are practical reasons, mainly to do with the conceptual unpredictability and ephemerality of the sporting act.<sup>12</sup> At the time I concluded as follows: ‘We will have to count the slap in the face that the futurist Marinetti received [at a performance] at the Teatro Constanzi, Cruijff’s unforgettable dribble in the European Cup Winners’ Cup Final and the dramatic d1–b3 by Euwe in the fourth move in the second game in the match with Aljechin in 1935 as the world as it was then and history as it is now, and not as the world

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8. I would like to refer interested parties to chapters 12–16 of my book *Het verschil van mening. Geschiedenis van een verkeerd begrepen idee* [in Dutch] (Prometheus, Amsterdam, 2016).
9. Carl Shapiro and Hal R. Varian, *Information Rules. A Strategic Guide to the Network Economy* (Harvard Business School Press, Boston/Massachusetts, 1999).
10. L. Ray Patterson and Stanley W. Lindberg, *The Nature of Copyright* (The University of Georgia Press, Athens/London, 1991), quote on p. 41. He quoted Flaccus, the Roman satirist, who ascribed it to Socrates: ‘*Scire tuum nihil est, nisi te scire hoc sciatur*’.
11. An inventor has the choice to keep the invention secret which complicates the sale of its application, or to apply for a patent and make the invention public but the profits of the sale exclusive for a fixed period. So the patent right is a compromise between exclusivity and network effect.
12. Ephemerality was a reason for the CJEU not to class an odour as a trade mark, CJEU 12 December 2012, case C-273/00, ECLI:EU:C:2002:748, *Ralf Sieckmann v. Deutsches Patent- und Markenamt*.

of copyright law.<sup>13</sup> With the knowledge we now have about art performances, I believe that Marinetti’s slap in the face would be the most likely candidate for entering the copyright frame.

Lacking copyright protection, football was exploited differently. Match performance was protected by what is also known as the ‘*droit de stade*’: with its right of use, a football club could control access to the stadium and thus exploit the ‘broadcasting rights’ for TV, a million dollar business as the Olympic Games have taught us. The fame of the football player started to be expressed in substantial transfer payments and high salaries. When it comes to legal rights to their own performances however, football players were left empty-handed. The broadcasting rights to the match are held by the club via the exclusive right to use the sports grounds, to which they can control media access. The images of the performances are held by the media via copyrights to photo and film. Portrait rights have changed this to some extent, especially when it comes to a portrait *in combination with* sports performance. Let me therefore now turn to portrait rights.

Portrait rights were added to Dutch copyright law in an endeavour to regulate copyright on portrait photographs, i.e. the photographer’s copyright. Legal scholars have therefore principally treated them as an appendix to copyright law. Portrait rights, however, have nothing to do with the photographer’s copyright. On the contrary, in fact: a copyright in a portrait photo is the appendix to the image of a person, in particular if that person is a famous person. Different copyright statutes regulate the interplay between copyright and portrait rights differently. The Dutch Copyright Act (DCA) is unequivocal about the relationship between the photographer and the portrayed person: the photographer’s copyright forms the basic position. The main rule is that the photographer may only disclose a commissioned portrait photo to the public with the consent of the person portrayed. The infamous Article 21 DCA, however, provides that portraits that were not commissioned may be disclosed to the public without consent, unless the person portrayed has a reasonable interest in opposing disclosure. For a long time this was the basis for the case law on portrait rights in the Netherlands.

The foundation for portrait rights must derive from privacy law rather than copyright law. Here too, portrait rights had an unpromising starting position. The fact is that the first generations of privacy law scholars usually dealt with privacy in the moral setting of the need to protect people’s private lives. One would really need a Hugenholtz-type PhD thesis to place privacy law in the broader setting of the commercial exploitation functions of information relating to the person. As Bernt’s former PhD supervisor I tried to do this, but I did not see a truly broad analysis emerging in legal scholarship.<sup>14</sup>

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13. Included in: Egbert Dommering, *De achtervolging van Prometheus* [in Dutch] (Otto Cramwinckel, Amsterdam, 2008), 223–231.

14. Egbert Dommering, *De Europese informatierechtsorde* [in Dutch] (DeLex, Amsterdam, 2019), ‘Commerciële Privacy’ pp. 202–217 [in Dutch], and ‘Persoonsgegevens als (economisch) zelfbeschikkingsrecht’, pp. 267–281 [in Dutch], both new versions of previous articles that I will draw on in what follows.

Just like in copyright law, one must first describe the piece of information to be ‘identified’ that can lead to the commercial exploitation of the huge network effects that evolve from celebrity. A portrait is a piece of personal data that has sufficient individual characteristics to serve as an object of property. A similar kind of personal data would be one’s name.<sup>15</sup> In terms of information theory, ‘portrait’ and ‘name’ have sufficient syntactic and semantic characteristics. Once a portrait or a name becomes big, the similarity with a well-known trade mark is considerable. It becomes a *distinctive sign* in society and commercial transactions. A famous person’s portrait and name (Elvis Presley, Madonna) become signs in the market (derived from the preceding private and public life of the now famous person) which not only serve to designate the person, but which can also be used to designate a whole range of related (merchandising) products. In the case of a sports person these are his or her sporting ‘creations’ related to his portrait and name. A lookalike imitating someone’s portrait is essentially a form of passing off, similar to profiting from the reputation of a trade mark. Whether the lookalike infringes someone’s portrait rights is therefore a non-issue in my opinion, given that the lookalike clearly benefits from a famous portrait. However, one should exempt the use of a lookalike as parody of a portrait, in essentially the same way as the parody exception in copyright law and trade mark law provide room for free humorous use.

A portrait that becomes a distinctive sign acquires what I refer to as a ‘retro effect’, by which the historical images of the at the time not yet famous person gain in value for the past, the present and the future. Hence, ‘news value’ no longer constitutes the essential characteristic of the portrait.

Commercially exploitable celebrity is also tied up with the ‘free public domain’ of news and historical events. Reporting of sports events and the role of individuals form part of it. The social event of the celebrity appearing in public is another example. As in copyright law, that public domain should be distinguished from subsequent commercial use aspects. The fact is that copyright law distinguishes between the freely reproducible news fact and the restricted right the media have to adopt news facts on the one hand, and the ‘news performance’ of the press and the historical discourse that is subject to a limited right to quote words/images on the other. Similar dividing lines will have to be used in portrait law. This means that the courts should apply the same critical rules they apply in copyright for quotation and newsreporting. The courts should be aware that the use of the famous portraits in publications increases the value of those publications; so they should apply a critical threshold for the re-use of portraits in so-called ‘current’, ‘historical’, ‘biographical’ and ‘anthological’ compilations. It is here that the ‘retro effect’ of valuation plays an important role. This insight is slow to get through to legal scholars and courts, as the Dutch Supreme Court’s ruling in the *Cruijff* case shows.

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15. The fingerprint has a similar distinctive character for distinguishing individuals, but in society is less suitable as a marker of distinction. It does have that identification function in identity documents under constitutional law.

I will now move on to the *Cruijff* case. In the Netherlands, many of the aspects discussed collided in this case. It was about the Dutch photo book *Johan Cruijff – De Ajacied* ['Johan Cruijff – Ajax Player'] published on 5 November 2013. The photos in the book had come from the archive of De Jong, a photographer who had taken the pictures during matches in which Cruijff had played in the 1960s–1970s, when he was still playing for Ajax. In 2013, this was clearly already some time ago. There was some text in the book but the lion’s share was taken up by photos. The Dutch Supreme Court therefore rightly qualified the book as a ‘historical photo book’. The case was about whether Cruijff could stop the exploitation of the book because it hampered his own exploitation of pictures of himself (at the time Cruijff had just turned 65 and was busy preparing all kinds of publications about himself).

In its opening finding (para. 3.4) the Dutch Supreme Court ‘liberated’ portrait rights from copyright law:

It follows from the right to respect for one’s private life, the content of which is in part determined by Article 8 ECHR, that if the disclosure of a portrait to the public infringes such right, the person portrayed in principle has a reasonable interest within the meaning of Art. 21 of the Dutch Copyright Act that opposes such disclosure to the public. Cf. Dutch Supreme Court 1 July 1988, LJN AB7688, NJ 1988/1000 (Vondelpark) and Dutch Supreme Court 2 May 1997, LJN ZC2364, NJ 1997/661 (Discodanser).

Readers will counter that this finding still refers to Article 21 DCA. However, in the Dutch Supreme Court’s interpretation quoted here, Article 21 is situated within the frame of Article 10 of the Dutch Constitution and Article 8 of the European Convention on Human Rights (ECHR), i.e. the privacy Articles of the Dutch Constitution and the European Convention. One could call it a reminder of the privacy nature of Article 21 DCA. The quoted cases refer to earlier cases of the Court on portrait rights in which the Court already hinted at the privacy context.

The Dutch Supreme Court then continued with a long and complex consideration:

The question of whether disclosure to the public is unlawful with respect to the person portrayed must be assessed by weighing up the right to respect for their private life protected by Article 8 ECHR and the right to freedom of expression and information protected by Article 10 ECHR, which rights must be weighed up with due regard to the particular set of circumstances of the given case in order to determine which of the interests involved outweighs the other. In weighing these up, the person of the person portrayed, the place and manner in which the image was created, the nature and degree of intimacy with which the person portrayed is depicted, the character of the image, the context of the publication, the accuracy of other information supplied in the publication, as well as the societal interest, the news value or informative value of its disclosure to the public may be relevant interests. Persons who enjoy fame or public interest may also have legitimate expectations when it comes to respect for their private life (cf. ECHR 24 June 2004, No. 59320/00, LJN AQ6531 , NJ 2005/22 (Caroline von Hannover I)). What is more, the protection that may be derived from

Article 8 ECHR is not limited to private activities but may also extend to activities of a professional or business nature (cf. ECHR 5 October 2010, No. 420/07, LJN BP3541, NJ 2011/566 (Köpke) and ECHR 16 December 1992, No. 13710/88, LJN AD1800 , NJ 1993/400 (Niemietz)).

What is noteworthy in this finding is the lack of precision in determining the content of the essential information elements that I distinguished earlier. There is no precise definition of the term 'news value'. It is also noticeable that the term 'informative value' is used without being defined in more detail. The judgment then goes on to use the equally opaque term 'general news value'. Nor is the link between the significance and restrictions of quotes in a historical context discussed. The fact is that it was not a historical text book but a 'photo book'. The photographer and the publisher raised the defence that it was a 'photo biography'. I am quite sure that, had a historian used photographs in a history book without consent of the photographer, and conducted a defence like that against the photographer's copyright, he would not have got away with it. Nor is a clear distinction made between the commercial and moral side of the expression 'private life'. The end result is a nebulous assessment framework that the Dutch Supreme Court would never have accepted for interpreting commercial intellectual property rights. The Court showed, for example, little understanding of the fact that celebrity is acquired in the public sphere. It found as follows:

As for persons who enjoy fame due to their professional activity, it should however be noted that disclosure to the public of photos that relate to that professional activity and that were made in publicly accessible places, is to some extent inherent to their professional activity and the concomitant fame and interest of the public. Consequently, if the disclosure to the public relates to the professional activity of a person who is famous due to that activity, considerable weight will, as a rule, be attached to factors such as general news value and informing the public compared to that person's mere opposition to the disclosure to the public.

This is actually a contradiction in terms: your portrait has commercial value because you acquired public fame but you cannot exploit that fame because it was acquired in public. This is exactly what Cruijff took issue with: he felt discriminated against compared to less well-known people. He said: 'I'm being punished for my fame.' If we make a comparison with a trade mark, his position is even worse: a famous trade mark gets more protection than an ordinary trade mark.

The Dutch Supreme Court's next finding then swung the other way again:

It is precisely people who are famous due to their professional activity that may have a commercial interest in the disclosure to the public of their portrait. Such interests are also covered by the protection of Article 8 ECHR and can be included in the weighing up against the right to freedom of expression and information protected by Article 10 ECHR. What weight should be attached to the commercial interest claimed by the person portrayed in a given case depends on the specific set of circumstances. If cashable popularity is the only interest at stake for a person portrayed and

there are no circumstances to justify disregarding that interest, the assessment may turn on whether reasonable compensation was offered. What constitutes reasonable compensation in this context must be determined on the basis of the specific set of circumstances. The compensation should, in any event, be commensurate with the degree of popularity or celebrity of the person portrayed and should be in line with the value of the interest that that person has in its commercial exploitation. If it is established or undisputed that reasonable compensation was offered (and the protection of privacy interests is not at issue), there will in principle need to be ancillary circumstances to justify a ruling that disclosure to the public was unlawful with respect to the person portrayed. These circumstances will need to be asserted, with reasons given, by the person portrayed. For example, if publication is detrimental or harmful to the manner in which the person portrayed would like to exploit his or her celebrity.

This finding signals an emancipation of portrait rights from the photographer's copyright to the portrait photo, because the level of the compensation for the use of the photo depends on the exploitation opportunities of one's 'own' celebrity in the here and now, rather than on the exploitation potential of the photo book of the photographer who uses the photos of the celebrity.

All in all, a step has been taken towards developing the commercial side of privacy law as property law. A much more sophisticated analysis of the different relevant elements is, however, required.

Let me conclude with a macro perspective. My colleagues often accuse me of such perspectives, so I don't want to disappoint them here. The development of privacy law as property law will turn out to be only a first step. Given the huge network effects of online information platforms that are exploited by means of personal data, I foresee that this is the direction in which all personal data are headed. Here too, the moral perspective still prevails among privacy scholars, but this is bound to change. The internet has become an individualised mass medium. By using cookies and other tracking technologies, personal data have become currency for the dispatch of targeted advertising to website visitors. These data encompass certain characteristics of persons such as location, education, age, and measured preferences. It is more difficult to construct these as property rights than it is for portrait rights. This means that a whole new category of commercially valuable information is being created that will continue to gain in importance compared to information covered by traditional intellectual property rights. It will become a new (pseudo) property system of information, just like the new system that was created at the time for information in and around the world of sports and sports persons and the pseudo copyright protection of databases.

It is not easy to develop a property right for a (single) piece of personal data. The first objection is that the object is difficult to define. In copyright law terms, one might say that personal data always bear 'the stamp of the author'. This is evident for a portrait, but it is more complicated if a piece of data only relates to a single aspect of the person. What is more, the term will be increasingly interpreted 'in its context' because 'personal identifiability' is inferred from a combination of data that may well be held by more than one party or that may

refer to more than one person.<sup>16</sup> The second problem is that it involves data that only gain value in a modified form in combination with other (personal) data, such as modified profiles or collections of them. Any copyright or database right to a profile or collection of profiles will be vested in the processor of the data rather than the data subject. The data subject has, albeit unwittingly, simply supplied raw materials free of charge: hence, this could lead to a conflict between a commercial privacy right and an intellectual property right to data. The third problem is that personal data increasingly function as important 'steering instruments' in the organisation of our society and should therefore be freely available for use to a number of commercial and public functions. From this perspective personal data has the feature of a collective good.

This is an area that will develop dynamically in the years to come. It is my guess that there will be a similar development as in the domain of the legal protection of investments in databases.

To conclude, this essay shows that the analysis of apparently distinct legal areas – such as the work concept in copyright law, the legal status of sports performances, the portrait concept in privacy law and personal data in data law, the economy of networks, the freedom of expression – based on the concept of 'information' is useful to fine-tune and deepen the definition of the problem of the regulating of information markets and networked (nowadays called platform) markets. That was the basic idea behind the Institute for Information Law at the University of Amsterdam that Hugenholtz and I set up with others in the late 1980s.<sup>17</sup> The founders of IViR developed this vision at the time that the widespread use of computers took effect, the telecommunications market opened up and the introduction of cable and satellite technologies were radically changing the media landscape. After that, the Institute closely analysed in the same perspective the legal aspects of the next phase: the transformation towards the internet in which computers and networks became connected. In the past ten years, which can be seen as the consolidation of the internet era, it has, to my regret, distanced itself from that foundation and in a way became more technology oriented, while the different disciplines again tend to be locked in the old traditional departments of copyright, privacy, freedom of expression and networks. It should return to this fruitful conceptual basis of 'information'. That seems an appropriate wish to end with in this volume of contributions, dedicated as it is to an important 'player' in the domain of information law over the past years.

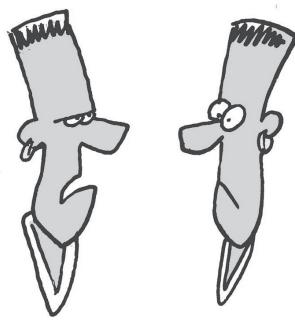
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16. CJEU 20 December 2017, (Nowak, C 434-16), *Nederlandse Jurisprudentie* 2018, 314; CJEU 29 July 2019 (*Facebook ID*, C-40/17), *Nederlandse Jurisprudentie*: 2020, 97.

17. Willem Korthals Altes, Gerard Schuijt, Geert-Jan Kemme and the late Jan Kabel.



SORRY, I'VE GOT  
PORTRAIT RIGHTS  
ON THIS LOOK



# Commercial Rights of Sportspersons in Their Portraits: Better Protection through a ‘Lex Hugenholtz II’?

*D.W. Feer Verkade*

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The author of this essay is 76 years old. He belongs (with Bernt Hugenholtz, now 65) to the generation having experienced how commercial rights in portraits ('commercieel portretrecht') in the Netherlands took shape. Bernt was only 23 when the Dutch Supreme Court gave what is still the landmark decision on this subject, the *Schaep* decision of 1979. However, as a student at Groningen University he was gripped by copyright law.<sup>1</sup> One may assume that this interest included 'portrait law' (*portretrecht*), which in the Netherlands is mainly governed by Articles 19 to 21 of the Dutch Copyright Act (DCA).

How did 'commercial portrait law' develop in the Netherlands? See here an overview, albeit truly short.<sup>2</sup> Since 1912, Article 21 DCA declared the communication of a portrait unlawful 'if there is a reasonable interest in opposing its communication to the public on the part of the person portrayed'. According to the parliamentary records, only 'moral interests' were considered to be 'reasonable interests'. So, could someone oppose the communication of his portrait if he had no other objection against communication than a desire to be *paid* for it? This question was answered by the Dutch Supreme Court in the affirmative in the *Schaep* case,<sup>3</sup> at least as far as (a) portraits of persons 'possessing popularity, ...

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1. As proved by his prizewinning students' thesis *Auteursrecht en information retrieval*, published by Kluwer, 1982. Bernt and I remember that I was engaged as the performer of the *laudatio*. This was the first occasion that Bernt and I met.
2. In 2009, this development has been commented on in 300 pages by some 20 authors, including Bernt Hugenholtz, in D.J.G. Visser (ed.), *Commercieel portretrecht* (DeLex, Amsterdam, 2009).
3. HR, 19 January 1979, *NJ* 1979/383 note Wijchers Hoeth, *BIE* 1979/23, *AMR* 1979, 52 note Spoor.

achieved in the performance of their profession' are concerned, and (b) a kind of use such as a publication in an illustrated book is at stake.

*Ad (a).* Although the *Schaep* decision concerned stage actors, it has generally been accepted that at least also musicians, radio and TV presenters and (competition) sportspersons<sup>4</sup> benefitted from the Supreme Court ruling.

*Ad (b).* A broad consensus exists that a (popular) portrayed person cannot exercise claims in clear cases of *news reporting and commentary*;<sup>5</sup> and, on the contrary, that (s)he can nearly always oppose the communication in the framework of (commercial) *advertising*.<sup>6</sup> As to the domain in between, this requires a more complex assessment weighing the right to privacy against freedom of expression under Articles 8 and 10 of the European Convention on Human Rights (ECHR).<sup>7</sup> Depending on the circumstances, a (popular) person in some cases, e.g., an illustrated book particularly devoted to a particular individual sportsperson, may claim (some) financial compensation. An injunction against (continued) communication, however, will probably not be granted.<sup>8</sup>

In reality, (top) sportspersons may in some ways do even better than what the foregoing summary suggests they are entitled to. Article 10 ECHR should allow free (in any case: direct) *reporting* of sport events, including close-ups of sportspersons. As we all know, this is out of the question. Top sports on broadcast television are generally behind a paywall.

This reality is not the result of copyright or a 'neighbouring right' in sport performances,<sup>9</sup> nor any other statutory intellectual property right. And it is, as far as I know, neither due to the bringing in action of rights in portraits by organised sportspersons. Instead, this result has been realised through keen policies of the greater national and international sport organisations (including the International Olympic Committee) to conclude exclusive contracts with public and private broadcasting organisations. Politicians accepted the outcome, and the courts did not intervene.<sup>10</sup> The – gigantic – revenues obtained in this manner, could and can be increased substantially by advertising income for the sport organisations (with a neutral term: *sponsoring*).

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4. Some initial hesitation with respect to *amateur* sport competitors has readily been overruled.
5. At least: lacking a simultaneous and clear *moral* interest. Example: Pres. Rb. Amsterdam, 18 February 1993, *AMI* 1993, 110 (*Clothing troubles*).
6. The latter applies also to persons *lacking* 'popularity': cf. HR, 2 May 1997, *NJ* 1997/661 note Verkade, *AMI* 1997, 143 note Schuijt (*Disco dancer*).
7. See e.g. Spoor/Verkade/Visser, *Auteursrecht* (4th edn., Wolters Kluwer, Deventer, 2019), paras. 6.14–6.16.
8. The latter was in a fundamental way at stake in: HR, 14 June 2013, ECLI:NL:HR:2013:CA2788, *NJ* 2015/112 note Hugenholz, *AMI* 2014/1 note Pinckaers, *IER* 2013/60 note Geerts, *Mf* 2013/22 note Schuijt (*Cruijff/Tirion*).
9. Legal contemplations on *these* subjects may have been interesting, but they still lack any practical character.
10. Or even boosted it. A Dutch milestone was the judgment of HR, 23 October 1987, *NJ* 1988/310 note Wickers Hoeth, *AMI* 1988, 32 note Schuijt (KNVB/NOS). The system did not meet any significant objection from the part of antitrust law either.

The result has been a very, or at least fairly wealthy organised sports community.<sup>11</sup> And, although the various rake-offs will be considerable, individual sportspersons have profited considerably, some of them even becoming filthy rich, particularly male professional football and tennis players. The exercise of individual rights in portraits against broadcasters of sport events could hardly ever have led to similar results.<sup>12</sup>

Against this background, one may wonder why we are dwelling on the absence of statutory law provisions for commercial rights in portraits, in a book focusing on sports and sportspersons. Happily, this book *In Honour of Bernt Hugenholtz* is an academic book, open for academic questions. And, as will be seen, several sore points can be perceived, calling for provisions to the benefit of (not filthy rich, but) normal professional or amateur sportspersons.

## 1. WHAT KIND OF LEGISLATION IS TO BE CONSIDERED?

As far as claims with respect to 'third parties' are concerned, i.e., claims against persons wanting to publish or reproduce a portrait without a contractual relationship with the portrayed persons, I do *not* see any convincing reason for further legislation, for the Netherlands at least. Established case law, balancing the mutual interests under Articles 8 and 10 ECHR can, by and large be considered as perfectly reasonable. In my opinion it is an advantage rather than a disadvantage that the right to a portrait has no foundation in a (quasi) intellectual property right, but instead is based on a general principle of proper conduct, as laid down in Article 21 DCA<sup>13</sup>

Thus, Dutch law regulates the legal position of a portrayed person with respect to third parties in an appropriate way. But what about the position with respect to 'second parties'? Consider the sponsors of an individual sportsman, assuming such sponsorship is still allowed by his club and league: for example a shoe sponsor. Consider (greedy) managers of individual sportspersons. And consider the relationship of the sportsman to his club (and the league). These entities may snap up various rights, not only through (direct) contracts, but also by way of by-laws laid down by clubs and leagues. Indeed, practice has shown that 'strangling contracts' do exist, or at least that a dubious balance exists in the contractual position of sportspersons and their counterparts.

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11. At least compared with the mid-twentieth century as a reference: at that time TV passed the age of childhood.
12. Still to be honoured is Jean-Marc Bosman, of the *Bosman* judgment of EC Court, 15 December 1995 (case C-415/93). In this decision the balance of powers between clubs and (football) players was considerably adjusted in favour of the players. It has been followed by many other decisions in the same direction.
13. In 1996, a committee of the 'Vereniging voor media- en communicatierecht' (VMC), chaired by Bernt, published a proposal for a statutory (commercial) *property* right in portraits (*Mediaforum*, October 1996, R1). I had to inform forthwith Bernt and his company (most of them: *friends*, so 'with bleeding heart'), that I could 'no way' agree (*Mediaforum* 1996, 124). Such law has thus far not been enacted. In 2009, Bernt did not support it any longer (cf. Hugenholtz, *Het Zwarte Schaep, commercieel portretrecht in de periferie van het recht van de intellectuele eigendom*, in: *Commercieel portretrecht* (2009), 231–242).

What about *existing* statutory rules on the relationship between portrayed persons and exploiting ‘second parties’? Do they offer protection? A few rules exist, notably Articles 19 and 20 DCA. These rules date from 1912. At that time, the making of portraits was an expensive endeavour, also for photographers. The rules deal specifically with the contractual relationship between the maker (i.e. author) of the portrait and the portrayed person in the case of *commissioned portraits*. This legal system is such that both parties (maker and portrayed person) are heavily restricted with respect to each other in their respective powers to exploit the portrait; unless they have agreed otherwise, explicitly or implicitly.<sup>14</sup> In itself, in 1912 this was, and even in 2021 still is, not a bad system.<sup>15</sup>

However, both Articles lack significance in case of a contractual relationship between the portrayed person and the exclusive licensee of portraits, such as a manager, football club or sports union. As far as the exploitation of ‘commissioned portraits’ is concerned, normally the exploiter and probably also the sportsman himself, will (by buying off) insist on minimal (remaining) copyright claims of the portrait’s author. As such, the latter will, after assignment of his copyright, have nothing more than his moral rights (including the right to be credited as author) and the economic minimum remuneration rights of Articles 25b to 25h DCA, to be dealt with below.<sup>16</sup>

It should be noted that in the relationship between the sportsman and his partner in portrait business, it matters little whether a portrait was commissioned or not. In the context of portrait business, non-commissioned portraits can also be at stake, such as those made during matches. Of course, the exploiter should be aware of the copyright of external photographers and filmmakers as well.<sup>17</sup> Thus, since my focus is on the relationship between sportsman and portrait exploiter, Articles 19 and 20 DCA lack relevance. In the following, I put them aside.

Of course, the Dutch Civil Code (DCC) includes some general rules that a sports player can try to invoke against ‘strangling’ contractual clauses, also where the exploitation of portraits is concerned. Depending on the circumstances, certain specific DCC provisions on employment law may also be helpful, and perhaps antitrust law could play a role.<sup>18</sup> Traditionally, in the Netherlands these kinds of rules have been considered to be sufficient for the protection of *authors* with respect to ‘second parties’ such as publishers: until 2015.

However, today they are no longer regarded as really sufficient. Thus, in 2015 a Chapter IA on copyright contracts was added to the DCA (Articles 25b to 25h), as well as some limitations on transfer and exclusive licensing (Article 2). Seeking to strengthen the bargaining position of individual creators, these

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14. A.A. Quaedvleg, ‘Artikel 19 en 20 Aw: in opdracht verzonken portretten’, in *Commercieel portretrecht* (2009), 131–143 (132), speaking about ‘author and portrayed person, together taking the portrait hostage’.

15. *Ibid.*, 143.

16. In the case that the maker of the portrait is employed by a Club or Union etc., the employer is considered author and first owner under Art. 7 DCA.

17. In the case of assignment and buying off, the moral rights (Art. 25 DCA) and the economic minimum rights (Arts. 25b to 25h DCA) of the photographer or filmmaker can, however, not be neglected.

18. Cf. *supra* note 12 (*Bosman* case).

new provisions set forth specific rules for exploitation contracts of copyrighted works in favour of the authors. Insiders may call this copyright reform as the ‘Lex Hugenholtz’, knowing that Bernt played an important role in encouraging and subsequently in drafting it.

Remember, as mentioned above, that in case of commercial exploitation of portraits (renouncing Articles 19 and 20 DCA as the case may be) the minimum rights of the *author* of the portrait must be observed; in this context I already mentioned Articles 25b to 25h DCA. It seems self-evident that the portrayed person be granted (at least) similar minimum rights against a licensee of the rights in the portrait. As far as I know however, the question has never been raised. In other words: isn’t it time for a ‘Lex Hugenholtz II’, granting to portrayed persons a better legal position in the context of contracts for commercial exploitation of portraits? Wouldn’t this be helpful for ‘lesser’ (and maybe also for ‘great’) sportspersons, against powerful or ‘crafty’ counterparties?

Before entering into the challenge of this question in detail, I will raise a few *prealabila*. One is of a substantial nature and concerns physiognomy; then follow some observations on the continuation of this essay and some ‘clerical’ specifications.

By the term ‘physiognomy’ I mean the recognisable looks of a person.<sup>19</sup> In the very context of commercial exploitation of portraits, it should be observed that an exclusive licensee usually will claim entitlement to not just one portrait, or a handful of portraits, but to *all* portraits of the person concerned,<sup>20</sup> including any *future* portraits. In other words: entitlement to the ‘physiognomy’ of the sports(wo)man. As observed above, under Dutch law a portrait is not an object of a transferable (intellectual) property right, and this goes *a fortiori* for somebody’s physiognomy.<sup>21</sup> On the other hand, I am not aware of any impediment *per se* against contractual obligations that include control over a player’s physiognomy in the framework of commercial exploitation of portraits, at least not under Dutch law. A comparison with contractual stipulations by a publisher regarding future works of an author suggests itself; we will see that the ‘Lex Hugenholtz I’ allows them, but subject to restrictions.

## 2. LEX HUGENHOLTZ II

In the second part of this essay, I will set out the articles of the ‘Lex Hugenholtz I’ one by one in the left column. In the column next to it, I will indicate whether these articles (with or without adaptation) could fit into a ‘Lex Hugenholtz II’ on exploitation of another man’s portrait.<sup>22</sup>

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19. I am aware that, according to dictionaries and encyclopedias, several *other* meanings of ‘physiognomics’ are also common.
20. Perhaps excluding portraits of the person under a fixed age, or in specified contexts. However, refraining from publishing rights on such excluded portraits, the exclusive licensee will usually not allow the use of such portraits for (competing) advertising purposes.
21. The latter will hold in many other, if not all (civilised) jurisdictions.
22. I used, gratefully, the translation of the Copyright Act (state 2009) by Mireille van Eechoud, put on internet by IViR. For the adaptations and new articles of 2015, I used, gratefully, the translation of the Act put on internet by Vevam.

It was an intellectual challenge for me (befitting a book like this), to adapt the articles of the ‘Lex Hugenholtz I’ to a ‘Lex Hugenholtz II’. This exercise was not always as simple as it might appear to be, for example due to the complication that Dutch law does not accept the concept of *property* rights of portrayed persons in their portraits. In these less simple cases, the reader will find the two texts next to each other.<sup>23</sup> However, in some other respects the exercise was quite easy indeed.

I have to add some administrative details. I had to mind my word count! According to instructions from the editors I had to limit them to a maximum of 5,000. Well: as the reader will observe, for several articles or subsections of the Lex Hugenholtz II, I could limit myself to simple references. Sometimes I use slightly less simple references: ‘to be adopted *mutatis mutandis*’. In this context ‘*mutatis mutandis*’ means: for author(s), read portrayed person(s); for work, read portrait(s); for copyright, read right to the portrait(s).

Well, let us enter the challenge. As to the outcome, there can be little doubt: a ‘Lex Hugenholtz II’ could be achieved!

**‘Lex Hugenholtz I’ on exploitation contracts of *copyrighted* works  
(Added 2015 to the Copyright Act)**

*Article 2*

1. Copyright passes by succession and is assignable in whole or in part.

2. The author, or his successor in title, may grant a licence to a third party for the whole or part of the copyright.

3. Whole or partial assignment, as well as the grant of an exclusive licence, may only be effected by means of a deed executed for that purpose.

The assignment or the grant of an exclusive licence comprises only the rights that are stated in the deed or that

**Suggested ‘Lex Hugenholtz II’ on contracts with portrayed persons on exploitation of their portraits**

*Article 0002*

[1. *Not to be applied on rights of portrayed persons, since such rights do not qualify as assignable property rights. As to the actual position of surviving relatives see Articles 19, 20 and 21 juncto Art. 25a DCA*]

2. The person portrayed or his surviving relatives in the sense of Article 25a, may grant a licence to a third party for the total commercial exploitation, or partial commercial exploitation, of the whole or part of his portraits.

3. The grant of an exclusive licence may only be effected by means of a deed executed for that purpose.

The grant of an exclusive licence comprises only the rights that are stated in the deed or that necessarily derive from the nature and purpose of the grant

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23. I had to do the puzzle in English, because this contribution is to an English-language book for Bernt. This puzzling has been rather useless as a draft for a *real* ‘Hugenholtz II’ Act, which must of course be in Dutch. Space for a four-column survey (2 x Dutch, 2 x English) was not available.

necessarily derive from the nature and purpose of the title or the grant of the licence.

4. The copyright that vests in the author of a work and, after his death, the copyright in any of his unpublished works that vests in the heir or legatee of the author, is not subject to seizure.

5. The third subsection, second sentence, and the fourth subsection do not apply to an author as referred to in Articles 7 and 8.

#### Chapter/Part IA Exploitation agreements

##### *Article 25b*

1. This Part applies to a contract, the main purpose of which is to grant to another party the right to exploit the author's copyright, unless Article 3.28 of the Benelux Convention on Intellectual Property applies.

2. Article 25f applies to a contract by which the author assigns the copyright in whole or in part, or by which the author grants an exclusive licence.

3. This Part does not apply to the author as referred to in Articles 7 and 8.

4. This Part applies similarly to a natural person who has acquired the copyright as the author's heir or legatee.

##### *Article 25c*

1. The author is entitled to contractually stipulated fair compensation for granting a right of exploitation.

[2. – 5. Subsections concerning administrative proceedings on Governmental powers regarding the fixation of 'fair compensation'.]

6. If the author has granted exploitation rights for a manner of exploitation that is not yet known upon conclusion of the

of the licence.

[4. *No need for implementation: follows from the non-proprietary nature of the rights of portrayed persons.*]

[5. *Irrelevant (rights of employer and similar rights); no reason for inquiry into analogies.*]

#### Chapter/Part 001A Exploitation of rights of portrayed persons

##### *Article 0025b*

1. This Part applies to a contract, the main purpose of which is to grant to another party the right to exploit commercially the rights of a portrayed person in his portraits.

2. Article 0025f applies to a contract by which the portrayed person grants an exclusive licence.

[3. *Irrelevant (rights of employer and similar rights); no reason for inquiry into analogies.*]

4. This Part applies similarly to a natural person who, as a surviving relative in the sense of Article 25a, may grant an exploitation licence to a third party.

##### *Article 0025c*

1. The portrayed person is entitled to contractually stipulated fair compensation for granting a right of exploitation.

[2. – 5. *Could be adopted; practical significance however doubtful.*]

6. *To be adopted mutatis mutandis.*

contract and the other party commences exploitation, the latter will owe the author additional fair compensation for this. If the party with whom the author concludes the contract has assigned these exploitation rights to a third party and that third party commences exploitation, then the author may claim the additional fair compensation from that third party.

*Article 25d*

1. The author may claim additional fair compensation in court from the other party to the contract if, having regard to the performance delivered by both parties, the agreed compensation is seriously disproportionate to the proceeds from the exploitation of the work.
2. If the serious disproportion between the author's compensation and the proceeds from the work's exploitation arises after the other party to the contract with the author assigns the copyright to a third party, the author may issue the claim as referred to in the first subsection against that third party.

*Article 25e*

1. The author may dissolve the contract wholly or in part if the other party to the contract does not sufficiently exploit the copyright to the work within a reasonable period after concluding the contract, or does not sufficiently exploit the copyright after having initially performed acts of exploitation. The preceding sentence does not apply if the failure to sufficiently exploit the copyright within this period is attributable to the author, or if the interest of the other party to the contract in maintaining the contract is so compelling that, according to the standards of reasonableness and fairness, it outweighs the author's interest in that regard.

2. If the copyright vests in several authors and the author's contribution

*Article 0025d*

1. The portrayed person may claim additional fair compensation in court from the other party to the contract if, having regard to the performance delivered by both parties, the agreed compensation is seriously disproportionate to the proceeds from the exploitation of the portrait(s).
2. If the serious disproportion between the compensation of the portrayed person and the proceeds from the exploitation of the portrait(s) arises after the other party to the contract has entrusted his rights from the contract to a third party, the portrayed person may issue the claim as referred to in the first subsection against that third party.

*Article 0025e*

1. *To be adopted mutatis mutandis.*

2. If the right in a portrait vests in several portrayed persons, then a

is not to distinct from the contribution of the others, then the author may only dissolve the contract with the consent of the other authors. If an author withholds his consent and the other authors are disproportionately disadvantaged as a result, the contract may only be dissolved in court.

3. To the extent that exploitation by the other party to the contract is not permanently impossible, the right to dissolve the contract only arises after the author has granted the other party, in writing, a reasonable period to sufficiently exploit the work and no exploitation is made within this period.

4. At the author's request, the other party to the contract will provide him with a written statement about the extent of the exploitation within the period referred to in the third subsection.

5. In accordance with Article 6:267 of the Civil Code, the contract is dissolved by a written statement by the author to the other party to the contract. Upon application by the author, the contract may also be dissolved by a judicial decision.

6. If the other party to the contract has assigned the copyright to a third party, then the author may also exercise the rights arising from the dissolution against that third party after having notified him, in writing, of the dissolution as soon as possible.

7. If the other party to the contract or the third party does not assign the copy-right back within a stipulated reasonable period, then a court may, on application by the author, determine an amount that is reasonable in the circumstances which the other party to the contract or the third party must pay the author, in addition to any compensation due to the author.

#### *Article 25f*

1. A clause stipulating rights to the exploitation of future works of the

portrayed person may only dissolve the contract with the consent of the other portrayed persons. If a portrayed person withholds his consent and the other portrayed persons are disproportionately disadvantaged as a result, the contract may only be dissolved in court.

3. *To be adopted mutatis mutandis.*

4. *To be adopted mutatis mutandis.*

5. *To be adopted mutatis mutandis.*

6. If the other party to the contract has entrusted his rights from the contract to a third party, then the portrayed person may also exercise the rights arising from the dissolution against that third party after having notified him, in writing, of the dissolution as soon as possible.

[7. *Not to be applied on rights of portrayed persons, since such rights do not qualify as assignable property rights.*]

#### *Article 0025f*

1. A clause stipulating rights to the exploitation of future portraits of the

author for an unreasonably long or insufficiently determinate period is voidable.

2. A clause that, having regard to the nature and content of the contract, the way in which the contract was concluded, the reciprocal, cognisable interests of the parties or the other circumstances of the case, is unreasonably onerous for the author, is voidable.

3. If the other party to the contract has stipulated that the contract may be terminated early, the author also has this right under the same conditions.

*Article 25fa.*

[Concerns open access of scientific works.<sup>1]</sup>]

*Article 25g*

[Article concerning Governmental powers to appoint a dispute resolution committee]

*Article 25h*

1. The author may not waive the provisions of this Chapter.
2. Regardless of the law that governs the contract, the provisions of this Chapter apply if:
  - a. the contract is governed by Dutch law when no applicable law has been chosen, or;
  - b. the acts of exploitation take place or should take place wholly or pre-dominantly in The Netherlands.

portrayed person for an unreasonably long or insufficiently determinate period is voidable.

2. *To be adopted.*

3. *To be adopted mutatis mutandis.*

[Irrelevant in the context of rights of portrayed persons.]

*Article 0025g*

[Could be adopted]

*Article 0025h*

1. *To be adopted mutatis mutandis.*
2. *To be adopted.*

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1. This article is rather a 'Lex Visser (Dirk)' than a 'Lex Hugenholtz'.

# Sports Celebrities and Character Merchandising in the United Kingdom

*Paul L.C. Torremans*

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## 1. INTRODUCTION

The topic of character merchandising is one of great commercial significance, also in the domain of football, a sport dear to Bernt Hugenholtz. It is a topic that, as yet, has received only limited legal recognition in the UK.<sup>1</sup> We are concerned with rights in ‘character’ – another vague concept that the law has to struggle to turn into something tangible<sup>2</sup> – and such rights can take two forms. A right in character might be seen as the private right of an individual to develop and protect his or her own character, which is really an issue that falls within the ambit of any tortious protection of privacy, a topic on which tort lawyers wail endlessly and, so far, fruitlessly. It falls outside the ambit of a work such as this, unlike the other forms of character right, which relate to the commercial exploitation of a character and its attributes. Other common law jurisdictions, such as Australia, whose case law is persuasive in the UK, have seen more cases develop in this area and these have helped to shape the legal recognition of character merchandising in the UK.

The commercial exploitation of character is the antithesis of privacy. Far from wishing to keep quiet about one’s character, the character merchandising industry is devoted to its, at times, ruthless exposure. We have come to expect sports celebrities to show up in talk shows and we expect them to share with

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1. See T. Frazer, ‘Appropriation of Personality: A New Tort?’, 99 *LQR* (1983), 281; J. Holyoak, ‘UK Character Rights and Merchandising Rights Today’, *JBL* [1993], 444; H. Carty, ‘Character Merchandising and the Limits of Passing Off’, 13 *LS* (1993), 289.
2. See J. Adams, *Merchandising Intellectual Property* (3rd edn., Tottel, Haywards Heath, 2007); H. Ruijsenaars, *Character Merchandising in Europe* (Aspen, New York, 2003).

us and the media their passion for certain products, whilst commanding fees for showing their homes to the excited readers of *Hello! Magazine*.

As a broad generalisation, it may be argued that the whole development of intellectual property law has been as a response to commercially important activity that has merited legal protection. Thus, patent law grew as a response to growing industrialisation, while copyright's expansion has reflected the growing importance of, and differing forms of, mass media. As yet, however, character merchandising does not have much in the way of specific recognition in UK law in spite of the eloquent arguments of Frazer<sup>3</sup> that there should be a statutory tort giving a right of protection to a victim of the unlawful appropriation for commercial purposes of aspects of character, such as name, image, or voice. Indeed, the latest review of the law on trade marks ahead of the Trade Marks Act 1994, when faced with the opportunity of creating a form of character right, declined so to do, claiming that so to do would create 'legal or administrative difficulties disproportionate to any problems that it would obviate'.<sup>4</sup>

Faced with this refusal to address their concerns directly, the character merchandising industry – because it is an industry – has to seek legal protection in the form of the adaptation of other intellectual property rights and their application to the merchandising field. It may be that statutory protection would be a simpler approach, but, equally, it will be seen that, taken overall, a fair range of protection is provided and we are now at a stage where the number of worthy cases that will slip between the gaps between the various intellectual property rights and torts that may be relevant to a character merchandising situation will be few indeed.

In terms of protection for real persons, and in particular for sports celebrities, the law of trade marks and various torts combine to confer legal protection on character merchandising. There is no space to develop all of this in this paper, so let me focus on the torts as these are more specific to the UK. Our main focus will be on the tort of passing off, but misrepresentation and malicious falsehood will also be touched upon.

## 2. 'PASSING OFF' DEFINED

Attempts to define 'passing off' have been, at times, confusing, particularly after the decision of the House of Lords in *Erven Warnink v. J. Townend & Sons (Hull) Ltd*<sup>5</sup> offered two separate definitions.

That case is worth a moment's pause: the Dutch claimants produced Advocaat, a blend of spirit and eggs (popular in the Netherlands but not so much with Bernt Hugenholtz' generation), while the defendants entered the market with Keeling's Old English Advocaat, a concoction of Cyprus sherry and egg powder. This attracted a lower rate of duty, being wine-based rather than spirit-based. It was found that this was a case of passing off, because, in so far as common

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3. (1983) 99 LQR 281.

4. Cm 1203, 1990, para. 4.43.

5. [1979] AC 731, [1979] 2 All ER 927.

ground could be found between the leading judgments, damage could be caused to the claimant's goodwill by the confusion engendered by the activities of the defendants. This analysis explains, if not defines, the essence of the action.

Various attempts were made to apply this case,<sup>6</sup> but a definitive answer has been provided by the famous *Jif Lemon* case – *Reckitt & Colman Products Ltd v. Borden Inc.*<sup>7</sup> In this case, Lord Oliver offered a clear and concise definition of the three elements that, in his view, were the essential ingredients of the tort:

First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the claimant's goods or services. Second, he must demonstrate a misrepresentation (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the claimant. Whether the public is aware of the claimant's identity as the manufacturer or supplier of the goods and services is immaterial, as long as they are identified with a particular source which is in fact the claimant. For example if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Third, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the claimant.<sup>8</sup>

The three requirements of goodwill, misrepresentation, and damage are the key test. But we have moved a long way from the oldest cases in which the tort was defined as a defendant passing his or her goods off as those of the claimant. The Court of Appeal even went as far as to argue obiter that the tort is perhaps now best referred to as unfair competition.<sup>9</sup>

What is really at the heart of the tort is the fact that goodwill will be protected whenever someone engages in unfair competition or takes unfair advantage of the goodwill by making a misrepresentation. The latter is often nothing more than a false association that is created, even involuntarily, in the minds of part of the public. The modern approach is illustrated well by the example Cross J gave more than three decades ago:

A man who does not know where Champagne comes from can have not the slightest reason for thinking that a bottle labelled 'Spanish Champagne' contains a wine produced in France. But what he may very well think is that he is buying the genuine article – real Champagne – and that, I have no doubt, was the sort

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6. See e.g. *Anheuser-Busch Inc. v. Budejovicky Budvar Narodni Podnick* [1984] FSR 413 (and on this Budweiser litigation also *Re Bud Trade Mark* [1988] RPC 535); *Consorzio del Prosciutto di Parma v. Marks & Spencer plc* [1991] RPC 351, esp. at 386.

7. [1990] 1 All ER 873, [1990] 1 WLR 491.

8. *Jif Lemon*, *supra* note 7, at 880 and 499.

9. *Arsenal Football Club plc v. Reed* [2003] 3 All ER 865, [2003] RPC 696 (CA).

of deception which the judge had in mind. He thought, as I read his judgment, that if people were allowed to call sparkling wine not produced in Champagne 'Champagne', even though preceded by an adjective denoting the country of origin, the distinction between genuine Champagne and 'champagne type' wines produced elsewhere would become blurred; that the word 'Champagne' would come gradually to mean no more than 'sparkling wine'; and that the part of the plaintiff's goodwill which consisted in the name would be diluted and gradually destroyed. If I may say so without impertinence I agree entirely with the decision in the Spanish Champagne case – but as I see it uncovered a piece of common law or equity which had till then escaped notice – for in such a case there is not, in any ordinary sense, any representation that the goods of the defendant are the goods of the plaintiffs, and evidence that no-one has been confused or deceived in that way is quite beside the mark. In truth the decision went beyond the well-trodden paths of passing-off into the unmapped area of 'unfair trading' or 'unlawful competition'.<sup>10</sup>

This is the starting point of the law as it stands now, which we will now analyse in further detail and apply to the case of sports celebrities, who joined this area of law later in the day, once the commercial companies and the stars of the entertainment scene had shown the courts the way. But then Eddie Irvine, as a true racing driver, speeded to the current recognition of the role of this area of the law for sports celebrities.

### **3. PASSING OFF AND CHARACTER MERCHANDISING**

It is only relatively recently that the tort of passing off has come to play a role in this field, having been held back for some time. Previously, there were a number of perceived hurdles, especially for real persons, such as sports celebrities.

#### **3.1 The Common Field of Activity Hurdle**

The main problem previously was that it was generally thought that, for liability to exist, the parties must be working in a common field of activity. So, an action would be between two rival clothing manufacturers, but not between a sports celebrity and a clothing manufacturer, even if the sports celebrity wanted to engage in merchandising activity involving clothing.

This was used to prevent a claim from succeeding in respect of authorised character merchandising as long ago as 1947. In *McCulloch v. Lewis A. May (Produce Distributors)*,<sup>11</sup> the claimant was a well-known children's broadcaster, known as 'Uncle Mac'. As a BBC employee at that time, involvement with anything so sordid as commerce was out of the question, so he was doubly appalled when the defendant began selling 'Uncle Mac's Puffed Wheat' without permission.

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10. *Vine Products Ltd v. Mackenzie & Co. Ltd* [1969] RPC 1 at 23, referring to the decision in *Bollinger J v. Costa Brava Wine Coy Ltd* [1960] RPC 16 and [1961] RPC 116, and cited with approval by Aldous LJ in *Arsenal Football Club plc v. Reed*, *supra* note 9, at 715–716.

11. [1947] 2 All ER 845.

The breakfast cereal was advertised in such a way as to associate closely the product and the celebrity. Wynn-Parry J found against the claimant: he was a broadcaster, not a cereal manufacturer, and there was thus no common field of activity and no passing off claim.

This approach was resolutely adhered to by the UK courts. In *Lyngstad v. Anabas Products*,<sup>12</sup> an attempt to prevent the sale of unauthorised Abba merchandise was unsuccessful on this ground, in spite of the fact that Abba had developed a sizeable merchandising trade alongside their musical activities. Similarly, in *Tavener Rutledge Ltd v. Trexpalm Ltd*,<sup>13</sup> the supposed lack of common field of activity was enough to defeat an attempt to prevent the sale of 'Kojakpops' lollipops designed to evoke the image of Kojak, a popular, lollipop-sucking, television detective. This was especially ironic, because, by being first in the field, the unauthorised trader was able to prevent a properly licensed manufacturer from putting 'Kojak lollies' on the market. Law and commercial reality were not working hand in hand at this stage of the law's development.

### **3.2 A Way Forward Emerges**

The Australian courts soon showed the way forward. In *Henderson v. Radio Corp. Pty Ltd*,<sup>14</sup> the High Court of New South Wales rejected the *McCulloch* approach and allowed two well-known dancers to prevent the unauthorised use of their picture on the cover of a record of dance music. Particularly instructive is *Children's Television Workshop Inc. v. Woolworths (NSW) Ltd*.<sup>15</sup> In this case, the claimants had rights in the characters from *The Muppet Show* and they were able to prevent the sale by the defendants of unauthorised Muppet memorabilia by demonstrating that they had their own merchandising operation, and that, although it was conducted on a licensed basis, they continued to exercise close quality control over it. It was also relevant that the public were aware of the merchandising link and, in particular, of the existence of quality control. By the way, this is a delicate point when it comes to sport celebrities. There is an expectation from the side of the public that they associate themselves with quality products and services, having exercised some form of quality control, but apart from an interest in retaining the trust of the public, sports celebrities find few incentives to focus on the quality control aspect.

Slowly, then, the UK courts have come to grips with the phenomenon of character merchandising. An important first stage was recognition of the practice and, with it, recognition of public awareness. This came in *IPC Magazines Ltd v. Black & White Music Corp. Ltd*,<sup>16</sup> in which the proprietors of a magazine featuring the exploits of Judge Dredd sought protection against the release of a pop record featuring the fabled jurist. Although no injunction was awarded

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12. [1977] FSR 62.

13. [1977] RPC 275.

14. [1969] RPC 218.

15. [1981] RPC 187.

16. [1983] FSR 348.

(damages at full trial being thought to be an adequate remedy), Goulding J was prepared to recognise that the public would assume that the claimants had, in some way, authorised the record. In other words, once it is realised that character merchandising does go on and that the public have realised that, for example, not every Abba sweatshirt was personally knitted by one or other of the Swedish superstars, but that Abba are nevertheless trading in sweatshirts as well as songs, the celebrity has goodwill that the tort of passing off can protect in not only songs and records, but also in sweatshirts. This reflects the modern reality that many films, shows, or items are nowadays launched as a package in which the revenue from merchandising activity is as important as that derived from the entertainment performances. There is no point launching, for example, a new pop group into the world to great acclaim if you have no souvenirs to sell to their excited fans and, in practice, these will be already in the warehouse. That approach also opens perspectives for sports celebrities, even if they are not generally selling their own products, but merely endorsing the products or services of others against payment of a fee. The same applies, of course, to their clubs that link their reputation to products they need to sell to acquire the financial resources to further develop their activities, be it their own products or those of their sponsors.

### **3.3 Recognition of a Role for Passing Off**

The recognition of broader ideas of goodwill in these claims and the more general renewed emphasis on goodwill in the *Jif Lemon* case<sup>17</sup> all help the use of the tort of passing off in character merchandising situations, but formal recognition of its role at last transpired in *Mirage Studios v. Counter Feat Clothing Co.*,<sup>18</sup> in which the use of images of the Teenage Mutant Ninja Turtles on clothing was at issue. The launch of the Turtles was a classic example of the development of an overall product in relation to which sales of merchandise were as significant as sales of the television programmes. It was thus clear that the claimants enjoyed goodwill in the clothing trade, as well as in the entertainment business. The knowledge of the buying public that properly licensed merchandising activity is common meant that there was a misrepresentation in the form of the unauthorised sales and that obvious damage could be envisaged to the trade of the claimants. Thus, the elements of passing off were satisfied and an injunction granted. The earlier Australian cases were approved and the earlier English cases distinguished as being inappropriate to cases in which the claimant has copyright in the character and is already in the business of merchandising. In reality, it is unlikely that the 'no common field of activity' argument has any life in it.

Meanwhile, the Federal Court of Australia has gone yet further in the protection of character merchandising in *Pacific Dunlop Ltd v. Hogan*.<sup>19</sup> Paul Hogan, actor, comedian, and star of the film *Crocodile Dundee*, successfully brought an

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17. *Reckitt & Colman Products Ltd v. Border Inc.* [1990] 1 All ER 873, [1990] 1 WLR 491.

18. [1991] FSR 145.

19. (1989) 14 IPR 398.

action against an advert for shoes that mimicked one particular scene in the film; the Hogan character in the advert wore similar clothes to those worn by Hogan in the film. It was held that Hogan, who himself appeared in many adverts and always in the role of 'a good-natured larrikin'<sup>20</sup> had a right to be protected against the unauthorised use of his character, because it would harm his own marketing opportunities. Hogan was trading not only as an actor and comedian, but as a general all-round celebrity and thus any activity deriving from his fame would be protected by the tort of passing off.

One further development in passing off is also relevant and perhaps accords with the *Hogan* case. The case of *Lego System Aktieselkab v. Lego M Lemelstrich Ltd*<sup>21</sup> allowed Lego to use the tort of passing off against another, but totally unrelated, user of the Lego name on the basis that the fame of Lego is such that anyone seeing the name would automatically assume, whatever the context, that it was the name of the renowned Danish toy brick manufacturer and any defects would be assumed to be its fault, thus risking harm to its reputation. This fits well into the character merchandising field. For example, an unauthorised dealer sells a David Beckham pen that often leaks; the public knows of the practice of character merchandising and thus blames David Beckham for the leaks. This would harm his current merchandising activity, if there were any, but, after *Lego*, the possible harm to any future merchandising activity will also be enough to sustain an action in passing off.

Passing off is a tort bursting with vigour in recent years. Its application to character merchandising shows this well, if perhaps belatedly. The flexibility and adaptability of the common law afforded protection comparable to that which legislation might be expected to provide. However, fresh doubt was cast over the fact that the public is now aware of the practice of character merchandising – but, at the same time, Laddie J seemed to recognise in the *Elvis Presley trade mark case*<sup>22</sup> that it must be possible to use the name of a celebrity to market a product, and to build up a reputation and goodwill in that name in the course of trade.

This point receives additional support from the judgment in the *Alan Clark* case.<sup>23</sup> It was readily accepted in the latter case that Mr Clark had goodwill in his name, and that the passing off of the spoof diaries in the *Evening Standard* newspaper through the false attribution of authorship could lead to substantial damage to his reputation (and earnings) as a columnist and diarist. But Mr Clark had the advantage of a reputation as a writer and not only as a celebrity: it is no doubt still easier to succeed in an action in passing off if the goodwill relates specifically to the merchandising activity or to any other commercial activity, rather than only to the general reputation and goodwill that one acquires as a celebrity.

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20. (1989) 14 IPR 398 at 400.

21. [1983] FSR 155.

22. *Re Elvis Presley Trade Marks* [1997] RPC 543.

23. *Clark v. Associated Newspapers Ltd* [1998] 1 All ER 959.

But the latter is also possible following the *Eddie Irvine* case,<sup>24</sup> in which Laddie J held that it was the purpose of the law of passing off to vindicate the claimant's exclusive right to his goodwill and to protect it against damage. The law would therefore not allow others to use that goodwill so as to reduce, blur, or diminish its exclusivity. It followed from this that it was not necessary to show that the claimant and the defendant shared a common field of activity, or that the sales of products or services would be diminished either substantially or directly, at least in the short term. Instead, the essential point was to show a misrepresentation, because that element was required to enable the defendant to take advantage of the defendant's reputation. The unauthorised manipulation of a photograph of Formula 1 racing driver Eddie Irvine, by means of which a Talksport Radio was put in his hand, and its subsequent use for publicity purposes amounted to such a misrepresentation, because it created the impression that Mr Irvine was endorsing Talksport Radio. This could affect Mr Irvine's goodwill and reputation, and the requirements for passing off were therefore met. In actions relating to sports celebrities this combination of wider goodwill, i.e. trading as a celebrity rather than merely as a sportsman, on the one hand and a misrepresentation on the other hand is therefore required and it forms the key to success in a passing off action. Irvine and his case really opened the path for sports celebrities and firmly laid down the new standard.

The Court of Appeal followed a similar approach when it held that Topshop was liable for passing off when it sold, without the pop-start's consent, T-shirts bearing the image of Rihanna. The application of the photo to the T-shirt resulted in Topshop telling a lie and created the impression of approval or authorisation. This was even more so because Topshop emphasised the star's visits to their shops and Rihanna clearly has a reputation as a fashionista. As a result, the star's followers were confused by the misrepresentation and would want to buy the T-shirt they understood was endorsed by Rihanna.<sup>25</sup> And of course, Rihanna has a broad reputation and goodwill that extend way beyond her professional activities as a recording artist and include the fashion business. The case also adds the important clarification that English law offers no right to prevent the use of a person's image, be they a (sports) celebrity or not. Sports celebrities will have that extended goodwill that characterised the *Irvine* case, but there will have to be the additional element of misrepresentation if the action is to succeed. Admittedly, that hurdle will be more easily taken by a sports celebrity who engages in character merchandising than by a normal person.

#### 4. DEFAMATION

Moving on from passing off, but sticking to the position of sports celebrities the decision in *Tolley v. J. S. Fry Ltd*<sup>26</sup> that an amateur golfer could sue in defamation

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24. *Irvine v. Talksport Ltd* [2002] FSR 943, upheld (while raising the amount of the damages) by the Court of Appeal [2003] 2 All ER 881.

25. *Fenty v. Arcadia Group Brands (t/a Topshop)* [2015] EWCA Civ 3, [2015] FSR 14.

26. [1931] AC 333.

for the unauthorised use of his character in an advert that carried the implication that he had compromised his amateur status is also of note. This is clearly applicable to protect character merchandising activity, but its use is limited to those cases in which reputation is lowered. So it would be defamatory to create a false quote from the dean of the law faculty of a prestigious university apparently endorsing a pornographic magazine, but it was not appropriate for David Frost to use defamation law against a hotel that falsely claimed his endorsement, because no harm was done to his reputation thereby.<sup>27</sup> Such an action could be of limited use to a sports celebrity who was falsely accused of going against his or her role as a role model by endorsing a certain product, but overall it will be of limited use to them. Nevertheless, the *Tolley* case shows that the interaction between sports celebrities and the law is by no means a new phenomenon.

## 5. MALICIOUS FALSEHOOD

If character merchandising activity is already under way, it is easy to see how the unauthorised merchandising of poor-quality goods could be seen by customers as being an attack on that activity by implication and, if false and denigratory, thus actionable in the tort of malicious falsehood. The use of this tort has, however, been considerably enhanced in the context of character merchandising by the notable decision in *Kaye v. Robertson*,<sup>28</sup> in which an injured actor was able to use the tort to prevent the publication of a true story about his condition in hospital after a serious accident. The basis of the decision was that publication would imply that the actor had consented; the tawdry context of the publication would be harmful to his image as a celebrity, but, more particularly, it would harm his own right to sell his story on his own terms for his own gain on his recovery. This loss then forms the necessary damage to complete the grounds for a claim.

The easier availability of injunctive relief was a key to *Kaye*'s success in malicious falsehood rather than defamation. The case shows that malicious falsehood can be used against any falsity that may have the effect of harming the victim's trade and that, after *Kaye*, if the victim is a (sports) celebrity, it will be assumed that he or she is trading not only as, in that case, an actor, but also as a celebrity. This notion neatly parallels that in the *Crocodile Dundee* case. There remain, however, limits on the use of this tort. A sports celebrity who does not trade as such may have difficulty establishing that there is damage; the exception to this requirement, under s. 3 of the Defamation Act 1952, in cases of words calculated to cause pecuniary damage is also of no assistance to a claimant who is not using his or her celebrity status as the base of merchandising activity. The damage requirement is on the other hand much less developed and much less of a hurdle in passing off actions where damage is almost presumed.

More seriously, there is a need to prove malice and this may be difficult if a trader honestly, but without authorisation, puts good-quality character merchandise on the market. In *Kaye*, however, it was asserted by Glidewell LJ that:

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27. Example cited in R. Wacks, *The Protection of Privacy* (Butterworths, London, 1980), 167.

28. [1991] FSR 62.

malice will be inferred if it be proved that the words were calculated to cause damage and that the defendant knew when he published the words that they were false or were reckless as to whether they were false or not.<sup>29</sup>

False words may be equated to the act of merchandising goods falsely, attributing them as being authorised by the character in question, and, on this basis, it would seem that malice will be found to be present at least if the claimant is him- or herself engaged in merchandising activity.

## 6. CONCLUSION

In the context of character merchandising activities, sports celebrities can in the light of the *Irvine* and *Rihanna* case rely on the tort of passing off to protect their position even if there is no absolute right to prevent the use of their image. Malicious falsehood is another tort option that further adds to the limited options in trade mark law that we could for reasons of space not address in this essay.

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29. [1991] FSR 62 at 67.

# The Use of Personal Characteristics in Sports Manager Games

*Thomas Riis*

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## 1. INTRODUCTION

In 2012, a Danish online company developed and launched two websites with so-called sports manager online games. One concerned the European Handball Championship held in Serbia in 2012, the other the handball competition at the 2012 Summer Olympics held in London. The games used the real names of the players of the male national handball teams. Players of the online games could pick a team for each match in the real tournaments and in picking the team, they could choose freely from all handball players in the tournament. The players of the games earned points depending on how well the members of their team performed in the subsequent real matches. Basically, the rationale of the games was to predict what would happen in the real matches and, in this way, the real matches determined the performance of the user's virtual team. Therefore, for the games to work it was necessary to use the real names of the handball players. All members of the Danish national team sued the online company for infringing the rights in their names.

The two handball manager games are examples of so-called fantasy sports that slowly emerged some years after the Second World War and started to boom since the late 1990s, in the internet era.<sup>1</sup> Fantasy sports use personal characteristics of real players. An essential legal challenge is whether such use infringes prospective rights in personal characteristics.

The game based on the European Handball Championship 2012 used the names of 400 different players, including those of sixteen Danish players. The Summer Olympics 2012 game used the names of 200 different players, again

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1. [https://en.wikipedia.org/wiki/Fantasy\\_sport](https://en.wikipedia.org/wiki/Fantasy_sport)

including sixteen Danish players. None of those names were used for marketing the game. No photographs of the handball players were used. However, the name of each player was accompanied by a sketch of a handball player in colour, adapted to the player's particular characteristics, such as colour of skin and hair.

Both the court of first instance and the Eastern Court of Appeal found that the company which had developed and supplied the games was entitled to use the names of handball players who participated in the tournaments. Consent from the players was not required, nor did they have to be paid for the use of their names. In reaching its decision, the Eastern Court of Appeal emphasised that the use of the names was a necessary and natural part of the games, and that neither in the marketing of the games nor in the actual playing of the games, the names, in terms of advertising, were abused or used in a disloyal or unfair way.<sup>2</sup>

Essentially, the Danish court case dealt with the scope of the handball players' personality rights. In the following, I will examine the scope of third parties' personality rights and trade mark rights in the production and marketing of sports manager games in a European perspective. The examination includes case law from various jurisdictions also from outside of the EU in order to illustrate the different approaches to the essential legal conflict.

## 2. PERSONALITY RIGHTS

There is no well-established, clear definition of 'a personality right'. Broadly speaking, personality rights emanate from a natural person's right to self-determination and they could include protection against invasions of one's privacy, against false and defamatory statements to others, and against misuse of one's image or other personal characteristics. For the purpose of this contribution which deals with sports manager games, a personality right refers to the right to prevent others from using one's own persona, image or other personal characteristics in a commercial context.

Personality rights as such have not been harmonised at the EU level and as a consequence, there remains a great divergence in the approaches taken by different Member States.<sup>3</sup> This can be illustrated by a glance at a few European jurisdictions.

In Germany, personality rights include specific statutory personality rights (*besondere Persönlichkeitsrechte*) that grant the rights to one's name and image for example. A general personality right (*allgemeines Persönlichkeitsrecht*) is derived from Articles 1 and 2 of the German Basic law; it has been developed by courts to include various categories of privacy protections, and the protection of other aspects of a person's identity, for instance a person's voice.<sup>4</sup> English

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2. *Ugeskrift for Retsvæsen* 2015.2936 Ø.

3. E.g. Inés Cantero, Dana Feinsohn, Hee-Eun Kim, Stefan Mayr and Edward Rainsford, EIPIN Report 'Exploiting Publicity Rights in the EU', XIth EIPIN Congress London 26–28 February 2010; and Isabel Davies and Tom Scourfield, 'Europe's patchwork approach to image rights', 171 *Managing Intellectual Property* (July/August 2007), 25–27.

4. Franz Hofmann, 'The right to publicity in German and English law', 3 *Intellectual Property Quarterly* (2010), 325–340, 327–331; Daniel Biene, 'Celebrity Culture, Individuality, and Right

law, on the contrary, does not grant individuals rights in the commercial use of their likeness nor a general right for persons to control the use of their image.<sup>5</sup> Thus, in general, the level of protection of personality in England seems low. However, some protection of personality is provided under the torts breach of confidence<sup>6</sup> and passing off.<sup>7</sup> In Denmark, pursuant to the Act on Personal Names, a personal name is protected against use by others of the name in ways that would create a risk of confusion. Apart from that, Danish law does not include statutory provisions on the use of another person's image or other personal characteristics in a commercial context, but case law has for long acknowledged such a non-statutory right.

Despite the Danish image right being non-statutory, it appears to provide stronger protection than the German image right. In the German *Beckenbauer* case, photographs of the famous football player Franz Beckenbauer were taken during a football match between Germany and Greece and used for a wall calendar. The Bundesgerichtshof<sup>8</sup> found that Franz Beckenbauer was a public figure of contemporary history and that the public interest in being informed about the concrete scenes of a specific national football match prevailed over Beckenbauer's general right of personality.<sup>9</sup> In comparison, the Danish Maritime and Commercial Court decided that three photographs taken during matches of one popular player from the national Danish football team published in a weekly magazine without any accompanying text violated the player's image rights. The photographs were printed as posters and placed as the centre pages of the magazines. In this way, buyers of the magazine could take out the poster and mount it on a wall for example.<sup>10</sup> Similarly, the Supreme Court held that two photographs of the Danish national female handball team and the team's goal keepers in poster formats inserted in a weekly magazine violated the players' image rights.<sup>11</sup> A short text relating to the event was printed on the posters. The photographs were taken immediately after the Danish team had won the final

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of Publicity as a European Legal Issue', *IIC* (2005), 505–524, at 510 et seq; Kerstin Schmitt, 'Celebrities, advertisement and commercial exploitation "publicity rights" In German Law', in Nari Lee, Guido Westkamp, Annette Kur and Ansgar Ohly (eds.), *Intellectual Property, Unfair Competition and Publicity. Convergences and Development* (Edward Elgar, 2014), 151f.

5. Tatjana Synodinou, 'Image Right and Copyright Law in Europe: Divergences and Convergences', *3 Laws* (2014), 181–207, at 186; and Yin Harn Lee, 'Putting a face to the game: the intellectual property implications of using celebrity likeness in videogames', *13(2) Journal of Intellectual Property Law & Practice* (2018) 143–153, at 144, 147.
6. *Douglas v. Hello! Ltd.* [2003] EMLR 31 (Ch); [2006] QB 125 (CA); [2008] 1 AC 1 (HL).
7. *Fenty v. Arcadia Group Brands Ltd* (No 2) [2013] EWHC 2310 (Ch); [2015] EWCA Civ 3.
8. BGH 6 February 1979, VI ZR 46/47, *Franz Beckenbauer*.
9. Corinna Coors, 'Celebrity image rights versus public interest: striking the right balance under German law', *9(10) Journal of Intellectual Property Law & Practice* (2014), 835–840, 837 f. However, in an older case the Bundesgerichtshof held that the use of portrait pictures of national league football players for a sticker album was a violation of the players image rights because there was no public interest in the pictures. According to the court, there was exclusively a commercial interest on part of the producer of the sticker album. Cf. BGH, 20 February 1968, VI ZR 200/66, *Ligaspieler*.
10. *Ugeskrift for Retsvæsen* 2003.686 S.
11. *Ugeskrift for Retsvæsen* 2008.1974 H.

against Norway in the European Championship of 2002, when the players posed with the trophy and the gold medals. The Supreme Court argued that irrespective of the text, the fan poster could not be considered as part of the magazine's editorial coverage of the celebration of the championship. Accordingly, in German law, it takes less to demonstrate a public interest that justifies an encroachment on individual image rights.<sup>12</sup>

## 2.1 Sports Games

A few cases concerning sports games from various jurisdictions around the world suggest that the use of player's persona in computer games is a worldwide issue and that diversity in the level of protection exists, also within the EU. However, in general, there are substantial restrictions on such use of a player's persona.

The Japanese entertainment and gambling conglomerate Konami Holdings Corporation had allegedly used the image and personal characteristics of the Brazilian football player Leandro Fahel Matos in the 2013, 2014, 2015 and 2016 editions of the game Pro Evolution Soccer without the consent of the player. The appeal court found that the player was entitled to authorise the use of his image and that the right to the image had been infringed in relation to the 2013 and 2014 editions, but not in relation to the 2015 and 2016 editions. In respect of the 2013 and 2014 editions, the first instance court found that the game developer had used the name, the nickname and physical characteristics of the player in addition to linking the player to his actual club. Taken together the personal characteristics resulted in an equivocal identification of the player in the game. The decision was upheld by the appeal court. The plaintiff's claim in relation to the 2015 and 2016 editions was rejected on the basis that it was not possible to link the claimant's image to the characters of those editions because the alleged personal characteristics of the Brazilian player were insufficient to individualise the claimant and could apply to other players.<sup>13</sup> Brazilian law includes specific provisions on the right to use the images of athletes<sup>14</sup> but arguably, the same result can be reached in jurisdictions with a statutory or non-statutory right to own images and other personal characteristics.

On the occasion of the 2014 World Cup, the game developer Riot Games introduced in its famous League of Legends game four additional character skins

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12. The personality rights protection of personal names is supplemented by article 15 of the International Chamber of Commerce's Advertising and Marketing Communications Code. 'Marketing communications should not portray or refer to any persons, whether in a private or a public capacity, unless prior permission has been obtained; nor should marketing communications without prior permission depict or refer to any person's property in a way likely to convey the impression of a personal endorsement of the product or organisation involved'. Though formally not binding, the Code is typically invoked in cases decided under national unfair competition law.
13. Paula Westenberger, 'Case Comment: the unauthorized use of the image of a football player in videogames as a violation of image rights in Brazil', 1(2) *Interactive Entertainment Law Review* (2018), 119–122.
14. Law No. 9.615 of 1998.

that relate to football. For one character, it was possible to purchase the 'Striker' skin, which resembled the Dutch former professional football player Edgar Davids. Edgar Davids during his active career sported dreadlock style hair, wore characteristic protective glasses during matches and these characteristics make him easy recognisable. The District Court of Amsterdam found that the Striker skin is a portrait of Edgar Davids, because it shares the following characteristics with him: dark skin, sporting posture, aggressive playing style, black dreadlocks, sports glasses and wearing a football kit. Under Dutch law, a person with a reasonable interest can resist the use of his portrait (Article 21 Dutch Copyright Act). A portrait is any image of a person where he or she is recognisable. Since the court found that Edgar Davids has a reasonable interest in opposing the commercial exploitation of his portrait, it was held that Riot Games infringed the right of Edgar Davids by disclosing the Striker skin in the Netherlands.<sup>15</sup>

## 2.2 The Handball Manager Game

Divergence in the national rules on personality rights is particularly unfortunate in respect of sports games because games based on international sport events usually will be of interest for consumers/players in many countries. Minimisation of the legal risk in the development of a sports game then requires the developer to respect the most rigorous protection of personality rights under national laws.

In assessing whether a handball manager game such as the one litigated in Denmark infringes sportsmen's personality rights, a number of issues are crucial. First, infringement requires that the person is identifiable. An image right is not infringed when the small dimensions and very poor quality of an image make it impossible to recognise the individual or when it is impossible to identify the person due to the rapidly changing images.<sup>16</sup> How much it takes before a person is identifiable must be assessed in the specific cases. A rough stylised sketch such as the ones used in the Danish handball manager game was not enough for identification. However, when more personal features are added to make the sketch more distinct, at a certain point, identification is possible.

Secondly, non-infringement in the Danish judgment relied on a necessity criterion. It was necessary to use the name of the players for the game to work. Obviously, it is not necessary to use the exact images of the players and it is not necessary to use the name of the players in commercial communication. 'Necessity' must be seen in light of how intrusive the use of the personal characteristics are. It is possible to develop a computer game the purpose of which is to identify the appearances of famous sportsmen and put names to them. Such a game would probably infringe the sportsmen's personality rights because it is too intrusive.<sup>17</sup>

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15. Kian Hsia and Thijs van den Heuvel, 'Levelling the playing field in eSports – Dutch portrait rights in games', 1(1) *Interactive Entertainment Law Review* (2018), 67–70.

16. Synodinou, *supra* note 5, 183.

17. Cf. the German case on the soccer sticker album. Cf. BGH, 20 February 1968, VI ZR 200/66, *Ligaspielder*.

Thirdly, the balance of public purpose and commercial purpose in the use of personal characteristics has been an important element in German case law. The Danish handball manager game is an example that a use of no apparent public purpose does not necessarily imply infringement. However, if the names of some of the handball players had been used in commercial communication related to the game (advertising, etc.), that use would be seen as a form of marketing activity that infringes the personality rights of the players.

This conclusion seems to be in conflict with the German *Boris Becker* case. A text book about tennis presented an individual method of playing (better) tennis. For that purpose, the books explained and analysed real tennis matches and individual styles of more than fifty well-known tennis players. Images of the tennis players were used inside the book, with description of their individual styles. In addition, an image of one of them, Boris Becker, was placed on the cover of the book. Article 22 of the German *Kunsturhebergesetz* provides a right to one own's image and Article 23 lists exceptions to this right. The court held that the use of the image of Boris Becker inside the book was allowed under Article 23 which exempts from the image right situations where the image is used to convey information to the public.<sup>18</sup> Such an exception on 'information use' makes perfect sense and is also reflected in the Danish case on the handball manager game. However, the Higher Regional Court of Frankfurt interpreted the exception broadly. It allowed the use of images inside the book because that is necessary for explaining the individual styles of the tennis players. It also allowed the use of the image of Boris Becker on the cover. The latter use is strictly speaking not necessary for providing information on the content of the book. Rather, it could be seen as a form of marketing, because the book cover is the book's packaging. Arguably, German law thus provides broader access to use individuals' personal characteristics in commercial communication.

However, there is an upper limit. The name and image of former German goalkeeper Oliver Kahn was used in the computer game *FIFA Soccer Championship 2002*. The court held that the use of Kahn's personal characteristics in the game required his consent because the image was used solely for commercial purposes and there was no public interest in the use of his name or image. Kahn's personal characteristics were also used in a marketing campaign concerning the game.<sup>19</sup>

### **3. TRADE MARK RIGHTS**

#### **3.1 Personal Names**

In addition to personality rights, personal names and images may also be protected by trade mark rights.

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18. Referred from Schmitt, *supra* note 4, 155.

19. OLG Hamburg, 13 January 2004, *Oliver Kahn v. EA Sports*, unreported. Mentioned inter alia in Coors, *supra* note 9, 838.

It is not unusual for celebrities including sports stars to register their picture or name as a trade mark. Furthermore, a number of EU Member States recognise trade mark rights established by use. The Member States in question require varying degrees of market recognition or goodwill to protect trade marks based on use.<sup>20</sup> Nevertheless, prospective unregistered trade mark rights should be taken into consideration when using personal names in online sports games. Trade mark protection requires that the name or image has distinctive character and infringement requires that the name or image is used as an indication of origin which shall be examined in the following in the context of online sports games.

According to Article 4 of the EU Trade Mark Regulation (EUTMR), an EU trade mark may consist of any signs including personal names provided that such signs have distinctive character.<sup>21</sup> The assessment of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out in relation *inter alia* to the products or services in respect of which registration is applied for.<sup>22</sup> In the *Nichols* case, the Court of Justice of the EU (CJEU) rejected that even common names *a priori* lack distinctive character.<sup>23</sup> Normally, a personal name will have the sufficient distinctive character and therefore also the ability to distinguish the products or services concerned. However, if the personal name has an alternative meaning, for instance, Baker, Ball, Cook, Fisher and Rose, the name is devoid of distinctive character for those goods or services the name describes.<sup>24</sup>

Another relatively clear example of lack of distinctive character is cases where the product is so closely connected to a physical person that the ordinary term for the product is the name of that person. The German Trademark Office thus rejected an application to register the family name Wankel as a trademark for engines, especially pistonless rotary engines. Probably the best-known pistonless rotary engine is called the Wankel engine after its inventor Felix Heinrich Wankel. The Court held that the name of Wankel was perceived to be a description of technical features of engines and not an indication of commercial origin.<sup>25</sup>

An open question is whether the name of a famous sports star may be so closely connected to the sport that particular person practices, that the name

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20. Verena von Bomhard and Artur Geier, 'Unregistered Trademarks in EU Trademark law', 107 *Trademark Reporter* (2017), 679, 688 and 690.
21. Cf. Art. 3, EU Trade Mark Directive (EUTMD), Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast), OJ 2015, L 2436.
22. Cf. CJEU, 16 September 2004, case C-404/02, ECLI:EU:C:2004:538, *Nichols plc v. Registrar of Trade Marks*, paras. 30 and 34.
23. *Ibid.*
24. EUIPO Trade Mark Guidelines, Part B.4.3.2.
25. Bundespatentgericht, Beschluss vom 4. April 2007: 28 W (pat) 103/05, cf. P. Anne Lauber-Rönsberg, 'The commercial exploitation of personality features in Germany from the personality rights and trademark perspectives', 107 *Trademark Reporter* (2017), 803–847, at 829. See also CJEU (GC), 9 July 2008, Case T-304/06, ECLI:EU:T:2008:268 (*Paul Reber GmbH & Co. KG v. EUIPO*), where the name of the composer Mozart by German speaker was considered to refer to the confectionary 'Mozartkugeln'.

lacks distinctive character for goods and services related to that sport. The EUIPO Trade Mark Guidelines states that:

Names of famous persons (in particular musicians or composers) can indicate the category of goods, if due to widespread use, time lapse, date of death, popularisation, recognition, multiple performers or musical training, the public can understand them as generic. This would be the case, for example, with respect to 'Vivaldi', whose music is played by orchestras all over the world and the sign 'Vivaldi' will not be understood as an indicator of origin for music.<sup>26</sup>

This statement from EUIPO Trade Mark Guidelines indicates a relatively strict assessment of distinctive character. Distinctiveness is an absolute ground of refusal and, hence, the registration practice of the EUIPO provides an overview of the evaluation of distinctiveness in relation to the names of sports figures.

The world famous tennis player Roger Federer has registered his name as an EU word mark for *inter alia* games, toys and gymnastic and sporting articles in class 28, which includes, among many other things, rackets. The trade mark registration also includes arranging and conducting sports competitions of all sorts; operation of sports centres; training and coaching in the field of sports; and sports activities in service class 41.

The world famous football player Christiano Ronaldo has registered his name as an EU word mark for among other things 'Education, entertainment and sport services' in service class 41. Arguably, online games would be covered by this group of services and Christiano Ronaldo could, on the basis of the trade mark registration, prohibit the use of his name in online games provided the name is used in a way that is perceived to indicate the origin of the service.

It appears from these two examples that the EUIPO finds that the names of even very famous sports figures have distinctive character for goods and services related to the actual sport that each sports figure practises. One can speculate how this is in conformity with the Vivaldi example mentioned in the EUIPO Trade Mark Guidelines. The time lapse in each case may explain the difference. The composer Antonio Lucio Vivaldi who lived from 1678 to 1741 was famous across Europe during his lifetime and has been so ever since.<sup>27</sup> In this way, he has been integrated as a substantial figure in classical musical culture and an icon in baroque music.<sup>28</sup> By comparison, sports figures are normally famous for a short period of time and after they have ended their playing career, in many cases their fame quickly fades. Arguably, a few sports figures have maintained an iconic status in the history of sports comparable to a classical composer. However, in most cases that will not be the case. For the purpose of this article, it suffices to conclude that the personal names of active and famous sports figures, such as

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26. Part B.4.4.2.7.1. In respect of English administrative practice, see Lee, *supra* note 5, 149.

27. See [https://en.wikipedia.org/wiki/Antonio\\_Vivaldi](https://en.wikipedia.org/wiki/Antonio_Vivaldi)

28. The time lapse may also explain why the word mark LADY GAGA (stage name of artist Stefani Germanotta) is registered as an EU trade mark in respect of *inter alia* sound and video recordings, musical-based entertainment and streaming of audio and video material on the internet.

handball players, will have distinctive character in respect of goods and services associated with the sport they are practising and valid trade mark rights can be established in such names. Hence, there is a risk that the use of personal names of sports figure in manager games infringes trade mark rights in those names.

It should be taken into consideration that the trade mark right is forfeited if the trade mark has not been put to genuine use within a period of five years.<sup>29</sup> Genuine use implies that a personal name is actually used in the course of trade, in relation to goods or services, which goes beyond simply stating who the person is.<sup>30</sup>

Trade mark infringement requires that the sign is used as a trade mark, in other words, as a badge of origin. As a starting point, it must be assumed that the use of personal names in a computer game is not perceived by the relevant public as a badge of origin. In the Joined Cases C-236/08 to C-238/08 (*Google AdWords*)<sup>31</sup> the CJEU held that a third party's use of a trade mark can constitute infringement only when the trade mark is used in the third party's own commercial communication. In the Danish handball manager game, the names of the players were not used in the marketing or presentation of the game but merely in a descriptive and functional way, which precludes prospective trade mark infringement. If the names were used in the marketing or presentation of the game, there would have been a risk of infringement. If the relevant public in this case perceived the trade mark protected names of the players as an indication that the game originated from the owners of the trade marks or undertakings that are economically linked to the owners of the trade mark, such as a licensee or subsidiary, the trade marks are infringed.<sup>32</sup>

### **3.2      Names and Logos of Sports Clubs**

It is reasonable to assume that names of sports clubs protected as trade marks shall be assessed in the same way as trade mark protected personal names. It is unlikely, that the name of a famous sports club will be considered to be devoid of distinctive character in respect of goods and services related to the sport in question. Thus, Manchester United Football Club is the proprietor of the word mark MANCHESTER UNITED in respect of articles of sports clothing, football

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29. Articles 18 and 58(1)(a) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, OJ 2017 L 154 (EUTMR).

30. In the *Zappa* case, the heirs of the famous artist and musician Frank Zappa had registered the word mark ZAPPA as an EU trade mark. The German Bundesgerichtshof held that the trade mark had not been put to genuine use notwithstanding, that the heirs used the domain name zappa.com for a website providing information about Frank Zappa, and furthermore also used the sign ZAPPA Records on CD covers and on the iTunes platform. See Birgit Clark, 'Bundesgerichtshof decides in Zappa trade mark dispute – German Federal Court of Justice (Bundesgerichtshof)', 3(3) *Queen Mary Journal of Intellectual Property* (2012), 267–272; and Guido Westkamp, 'Personality trade marks and their limits: Frank Zappa Family Trust Inc. v Arf e.V', 6(5) *Journal of Intellectual Property Law & Practice* (2011), 320–324.

31. Para. 56.

32. CJEU, 25 Jan. 2007, case C-48/05, ECLI:EU:C:2007:55, *Adam Opel*, paras. 24–25.

boots and shoes, sporting articles and footballs, for example. The trade mark registration also includes 'computer software' and 'pre-recorded games on... software' and as such the trade mark can be invoked in relation to sports online and video games.<sup>33</sup> Assessing prospective infringement of trade mark protected club names also corresponds to what has already been mentioned about trade mark protected personal names. As long as the names are not used in the marketing or presentation of the game, infringement is unlikely.

#### 4. FINAL REMARKS

The production of sports manager games involves a number of legal risks. In relation to personality rights and trade mark rights, a producer can minimise the risk of infringement by taking care only to use personal names and trade marks in a descriptive and functional way and only to the extent that is necessary for the game to work. Using personal names and trade marks in commercial communications related to the game increases the risk of infringement substantially.

This contribution has focused on third party's personality rights and trade mark rights. In addition, one could consider to what extent organisers of sports events may have protection of information on sports events and sports results under unfair competition law or the *sui generis* right of the Database Directive.<sup>34</sup> After the European Court of Justice judgments in the *Fixtures* and *British Horseracing Board* cases it seems clear that information on sports events and results are not protectable under the *sui generis* right. In the words of Bernt Hugenholtz and Mark Davidson, in the *Fixtures* and *British Horseracing Board* cases the CJEU seems to have domesticated the wild beast of the *sui generis* right.<sup>35</sup>

Unfair competition law differs considerably between Member States. It is beyond the scope of this contribution to examine possible protection under unfair competition law. However, it cannot be precluded that some protection of the arrangement of sport events is available, at least in some Member States.

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33. See e.g. the recent English judgment *Manchester United Football Club Ltd v. Sega Publishing Europe Ltd et anor*, Judgment of 4 June 2020, [2020] EWHC 1439 (Ch); [2020] E.T.M.R. 44.

34. Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, *OJ* 1996 L 77 (Database directive).

35. Mark J. Davison and P. Bernt Hugenholtz, 'Football fixtures, horseraces and spin offs: the ECJ domesticates the database right', 27(3) *European Intellectual Property Review* (2005), 113–118.

# Part 3

## Sports Clubs:

### Organisational Efforts and Branding



# Sports as Policy Levers in Intellectual Property Lawmaking

*Stef van Gompel*

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## 1. INTRODUCTION

In the academic community, I know only few people who are as fanatic about intellectual property and sports as Bernt Hugenholtz is. Given his love for both, I reckon that he sometimes has difficulties accepting how the development of intellectual property, as he would favour it, is hindered by the way organisers of sporting events want to protect the sports broadcasting business model. His calls for abolishing neighbouring rights (and other intellectual property rights that are based on a misguided investment rationale),<sup>1</sup> against the adoption of a new broadcasting treaty,<sup>2</sup> for removing unnecessary territorial barriers in intellectual property law,<sup>3</sup> and for creating an EU copyright code,<sup>4</sup> are less likely to be followed if sports organisers could decide on the future directions in intellectual property law.

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1. See P.B. Hugenholtz, 'Neighbouring Rights are Obsolete', 50 *IIC* (2019), 1006–1011; and P.B. Hugenholtz, 'De naburige rechten hebben hun tijd gehad', 6 *AMI* (2018), 243–244.
2. See P.B. Hugenholtz, 'The WIPO Broadcasting Treaty: A Conceptual Conundrum', 41(4) *EIPR* (2019), 199–202.
3. See e.g. P.B. Hugenholtz, 'Making the Digital Single Market Work for Copyright. Extending the Satellite & Cable Directive to content services online', in M. Franzosi, O. Pollicino and G. Campus (eds), *The Digital Single Market Copyright: Internet and Copyright Law in the European Perspective* (Diritto e policy dei nuovi media 8, Aracne editrice, 2016), 51–65.
4. Bernt Hugenholtz is one of the founders of the Wittem Group that drafted the European Copyright Code. See Wittem Group, *European Copyright Code* (2010), <https://www.ivir.nl/copyrightcode/introduction/>. See also P.B. Hugenholtz, 'The Wittem Group's European Copyright Code', in: T.E. Synodinou (ed.) *Codification of European Copyright Law: Challenges and Perspectives*, Information Law Series 29 (Kluwer Law International, Alphen aan den Rijn, 2013), 339–354.

Over the years, major sports organisations such as the International Olympic Committee, FIFA, UEFA, Formula One, the International Tennis Federation, 6 Nations Rugby, IAAF Athletics, the Ryder Cup, World Snooker, the Tour de France and many others have been actively engaged in policy debates at the World Intellectual Property Organization (WIPO) and the EU legislative bodies to safeguard the protection of sports events through intellectual property law. For this purpose, these organisations have combined their efforts and formed the Sports Rights Owners Coalition (SROC).<sup>5</sup> The SROC represents over 50 international and national sports bodies and competition organisers and has been established ‘to enable dialogue and sharing of best practices on key legal, political and regulatory issue[s]; to raise awareness of new developments and innovation in sports rights; [and] to take joint action to protect and promote its members’ rights’.<sup>6</sup> Following its core mission to seek proper recognition of the value of sport by governments around the globe and effective protection for sports rights under national and international law, the SROC urges national and supranational authorities, amongst other things, to prevent the piracy of sports event broadcasts and to get the special nature of sport and sports rights fully recognised, protected and promoted.<sup>7</sup>

This chapter discusses recent endeavours undertaken by sports organisers to preserve the broadcast business model for live sports coverage and contrasts them with critical accounts in legal scholarship, including those of Bernt Hugenholtz. This includes attempts to strengthen broadcasters’ rights (section 2), to establish a new right for sports event organisers (section 3) and to prevent the EU legislator from removing national territorial barriers (section 4). A brief conclusion cautions against the effects of a dominant market player influencing intellectual property law and policymaking (section 5).

## **2. THE PROTECTION OF (LIVE) SPORTS EVENTS THROUGH BROADCASTING RIGHTS**

Sports undoubtedly have had an influence on the development of intellectual property law. While sports as such are not protected as subject-matter of intellectual property,<sup>8</sup> legislators around the world have long acknowledged the importance of protecting broadcasting rights to prevent the piracy of telecasts and webcasts of (live) sports events. In 1961, when broadcasting rights were first introduced at the international level by the Rome Convention for the Protection

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5. WIPO, ‘Accreditation of Certain Non-Governmental Organizations’, SCCR/S2/2, Geneva, 29 May 2007, [https://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_s2/sccr\\_s2\\_2.pdf](https://www.wipo.int/edocs/mdocs/copyright/en/sccr_s2/sccr_s2_2.pdf).
6. See Sports Rights Owners Coalition: About, <https://www.sroc.info/about/>.
7. WIPO, *supra* note 5, at 6. Other issues that the SCOR actively engages with are the outlawing of ‘ambush marketing and ticket touting/scalping’ and the creation of ‘a regime for sports betting that enables sport to protect its integrity, and establishes a fair return to sports for the use of their events by betting operators’. These issues will not be further discussed in this chapter.
8. On the protection of sports as subject-matter of intellectual property, see amongst others, the contributions by Bently, Dusollier, Grosheide, Janssens and Synodinou in this volume.

of Performers, Producers of Phonograms and Broadcasting Organizations,<sup>9</sup> the protection of sports events was not yet an issue. However, in those days, there was also no genuine need for such protection, because the market for sports broadcasting was still in its infancy.<sup>10</sup> Indeed, as the *travaux préparatoires* of the Rome Convention reveal, sports organisations were not present at the diplomatic conference in Rome and the question of sports rights was not discussed,<sup>11</sup> other than whether sportspersons could benefit from the protection under the Convention if a Contracting State would extend this protection to 'artists who do not perform literary or artistic works', as permitted under Article 9.<sup>12</sup>

The need for protecting the coverage of (live) sports events by broadcasting rights increased with the economic importance that the broadcasting of major sports events gained in the television market in the last decades of the twentieth century.<sup>13</sup> On some occasions, this need for protection became so strong that a direct impact of sports on intellectual lawmaking initiatives in the field of intellectual property can be witnessed. A perfect example is the enactment of the Neighbouring Rights Act in the Netherlands in 1993. While the need for neighbouring rights protection had already been discussed for several years in Dutch academic literature, plans to adopt such rights never really stood a chance at the policy level. This was due, in part, to resistance from authors, who were afraid that if protection were granted to performers, they would have to share the copyright revenues pie with them. In addition, policymakers were afraid that the introduction of neighbouring rights would be too costly for public broadcasting organisations, as it would require them to also clear rights in performances and sound recordings included in their broadcasts.<sup>14</sup> Dutch policy discussions changed overnight, however, when the Netherlands announced a serious bid to organise the 1992 Summer Olympics. This made Dutch policymakers understand that broadcasters also have a genuine interest of their own in neighbouring rights protection. In 1986, the Minister of Justice and the Minister of Welfare, Health and Culture wrote: '[Neighbouring rights] protection of television broadcasts is vital in order to safeguard the potential financial benefits which the organising committee of the 1992 Olympic Games, which may be held in Amsterdam, may derive from the use of the relevant audiovisual recordings'.<sup>15</sup> Eventually the Dutch

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9. See the authentic text of the Rome Convention at <https://wipolex.wipo.int/en/text/289795>.

10. See H.A. Solberg, 'The Economics of Television Sports Rights: Europe and the US – A Comparative Analysis', 9(2) *Norsk medietidsskrift* (2002), 57–80, <https://doi.org/10.18261/ISSN0805-9535-2002-02-04>.

11. See Records of the Diplomatic Conference on the International Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Rome, 10 to 26 October 1961 (ILO, UNESCO & BIRPI, 1968).

12. *Ibid.* at 87 (point 165), Mr. García-Noblejas from Spain recalling 'the importance of certain means of retransmitting sporting events, such as boxing, for instance' while stating that a boxer would 'not lay claim to the title of artiste, and no one would think of referring to him as such'.

13. Solberg, *supra* note 10.

14. G.J. Heevel, 'Korte terugblik: WNR 1993 vanuit historisch perspectief', 6 *AMI* (2018), 236–242, at 238.

15. *Kamerstukken II* 1985/86, 19435, no. 1, p. 7.

bid was unsuccessful,<sup>16</sup> but the adoption of neighbouring rights protection in the Netherlands was certainly triggered by the prospect of acquiring revenues from the global sale of rights to broadcast a major sports event such as the Olympic Games.<sup>17</sup>

Although this Dutch example may still be seen as an incident of the influence of sports on intellectual property lawmaking, in recent years, organisers of sports events have intervened more structurally in policy initiatives in this area. Since 2007, the SROC has an observer status in sessions of the WIPO Standing Committee on Copyright and Related Rights to monitor the development of the proposed WIPO Treaty on the Protection of Broadcasting Organizations. Greatly concerned by the fight against piracy of sports competitions,<sup>18</sup> SROC members believe ‘that the Treaty could play an important role in the global fight against piracy and they share the concerns of broadcasters over piracy of broadcasters’ signals and the inadequacy of the Rome Convention to deal with that form of piracy.<sup>19</sup> In particular, the SROC calls upon WIPO Member States to adopt a Treaty which is technology-neutral in its application, enabling the combat of piracy of broadcasts of (live) sports events on any relevant technological platform. Furthermore, it believes that the benefits of the protection established by the WIPO Broadcasting Treaty should also be enjoyed by owners of the underlying sports rights, either by respecting the contractual arrangements entered into between sports rights holders and broadcasters, or ‘preferably by a direct recognition of our interests and rights therein’.<sup>20</sup>

But is strengthening broadcasters’ rights by adopting a Treaty to that effect really needed to protect against the piracy of live sports events? Bernt Hugenholtz thinks not. While recognising that ‘[i]llegal streaming of broadcast signals is a serious problem’, he argues that ‘broadcasters in most countries already enjoy solid legal protection against signal piracy and other unauthorised uses’.<sup>21</sup> This is the case even for live sports events that are broadcast in real time. He explains that in most countries of the civil law tradition, where fixation of a work is not a prerequisite for copyright, the ‘live coverage of a sporting event will qualify as a protected audiovisual work if it is the product of creative choices. For example, live coverage of a Champions League football match that involves, at the very least, multiple camera operators, several commentators and a director, will easily

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16. The 1992 Summer Olympics were held in Barcelona.

17. See e.g. D.J.G. Visser, ‘Van James Last tot Berdien Stenberg: tien jaar WNR in vogelvlucht’, 6 *AMI* (2003), 189–193, at 189; G.J. Heevel, ‘Beoogd en daadwerkelijk verkregen profijt van tien jaar WNR’, 6 *AMI* (2003), 194–202, at 196.

18. See *Background Report on Digital Piracy of Sporting Events* (Envisional, Cambridge & NetResult, London, 2008) <https://ininet.org/background-report-on-digital-piracy-of-sporting-events.html>; and *Update on Digital Piracy of Sporting Events*, report commissioned by the SROC (NetResult, London & Envisional, Cambridge, 2011) [https://www.wipo.int/export/sites/www/ip-sport/en/pdf/piracy\\_report\\_2011.pdf](https://www.wipo.int/export/sites/www/ip-sport/en/pdf/piracy_report_2011.pdf).

19. WIPO, *supra* note 5, at 6.

20. SROC Position on the WIPO Broadcasting Treaty, 10 April 2013, [https://www.sroc.info/wp-content/uploads/2018/04/SROC\\_Position\\_on\\_WIPO\\_Broadcasting\\_Treaty\\_-\\_Final.pdf](https://www.sroc.info/wp-content/uploads/2018/04/SROC_Position_on_WIPO_Broadcasting_Treaty_-_Final.pdf).

21. See Hugenholtz, *supra* note 2, 202.

pass this test.<sup>22</sup> But also in countries where copyright requires prior fixation of a work, such as the United States of America and the United Kingdom, broadcasters are not empty-handed, because they ‘may invoke copyright protection for ancillary content such as leaders, graphics, animations, replays and other (pre) recorded audiovisual content included in live sports broadcasts’.<sup>23</sup> Moreover, in many countries, broadcasters can ‘rely on the general law of unfair competition to support claims against signal pirates’, or perhaps fall back on ‘general criminal statutes or special laws on telecommunications secrecy or cybercrime’ that qualify theft of pre-broadcast signals as a criminal act.<sup>24</sup>

Accordingly, while there is need to tackle piracy and other illegal online transmissions of sports event broadcasts, this does not warrant the adoption of a Treaty with extended broadcasters’ rights.

### **3. ESTABLISHING A NEW RIGHT FOR SPORTS EVENT ORGANISERS**

Other than strengthening broadcasters’ rights, sports organisers also want to have their own rights recognised.<sup>25</sup> This is an ambitious proposition, because at least in Europe the status of sports organisers’ rights has not been established.<sup>26</sup> In *Football Association Premier League and Others*, the Court of Justice of the European Union (CJEU) ruled that sports events cannot be protected under copyright, while acknowledging that EU law does not protect them on any other basis in the field of intellectual property.<sup>27</sup> Still, the CJEU confirmed that it is permissible for a Member State to protect sports events by its domestic legislation, including through intellectual property law, specific national legislation (such as the so-called ‘house right’ – an access right to a venue, on the basis of which unauthorised persons and media can be conditionally allowed or denied entry), or contractual arrangements between sports organisers and broadcasters.<sup>28</sup> For sports event organisers, such legal protection is important, since it enables them to grant licences to broadcast the sports events they organise. This represents an important source of income for sports event organisers.

For this reason, the legal protection of sports event organisers is also discussed at the EU policy level. In the legislative process leading to the adoption of the Directive on Copyright in the Digital Single Market, the JURI Committee of the European Parliament proposed a new Article 12a instructing the Member

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22. *Ibid.*, at 202.

23. *Ibid.*, at 202, with reference to CJEU, 4 October 2011, joined cases C-403/08 and C-429/08, ECLI:EU:C:2011:631, *Football Association Premier League and Others*, [2011] ECR I-9083, para. 149.

24. *Ibid.*, at 202.

25. See e.g. SROC Position Paper on the Asser Study on Sports Organisers’ Rights in the European Union, November 2013, [https://www.sroc.info/wp-content/uploads/2018/04/SROC\\_position\\_paper\\_on\\_Asser\\_Study\\_-\\_08\\_11\\_13.pdf](https://www.sroc.info/wp-content/uploads/2018/04/SROC_position_paper_on_Asser_Study_-_08_11_13.pdf), at 8.

26. See e.g. T. Margoni, ‘The protection of sports events in the EU: Property, intellectual property, unfair competition and special forms of protection’, 47 *IIC* (2016), 386–417.

27. CJEU, 4 October 2011, *supra* note 23, para. 99.

28. *Ibid.*, para. 102.

States to provide sports event organisers with the exclusive rights of fixation, reproduction and making available to the public.<sup>29</sup> While the European Parliament approved this amendment on 12 September 2018,<sup>30</sup> the provision did not find sufficient support in the ‘trilogue’ negotiations with the European Commission and the Council and was therefore abandoned. The Commission issued a statement, however, that in view of the importance of sports event organisations and their role in financing sport activities in the EU, it ‘will assess the challenges of sport event organisers in the digital environment, in particular issues related to the illegal online transmissions of sport broadcasts’.<sup>31</sup> This is in line with Article 165 of the Treaty on the Functioning of the European Union (TFEU), according to which the Union shall contribute to the promotion of European sporting issues.

More recently, on 19 May 2021, the European Parliament issued a Resolution with recommendations to the Commission on challenges of sports event organisers in the digital environment. Interestingly, this resolution sets out ‘that the creation in Union law of a new right for sports events organisers will not provide a solution as regards the challenges they face that arise from a lack of effective and timely enforcement of their existing rights’.<sup>32</sup> This echoes the findings of a new report of the JURI Committee of the European Parliament. In line with Hugenholtz’ position outlined above (section 2), which also clearly surfaces in a 2014 study that was conducted under his supervision,<sup>33</sup> this JURI report asserts that there is already a sufficient arsenal of rights protecting the broadcasting of live sports events.<sup>34</sup> The problem therefore is not that sports event organisers have no means to initiate legal action against the unauthorised transmission of live sports events. The real problem is that the economic value

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29. European Parliament, Committee on Legal Affairs (rapporteur: Axel Voss), Report on the proposal for a directive of the European Parliament and of the Council on copyright in the Digital Single Market (COM(2016)0593 – C8-0383/2016 – 2016/0280(COD)), A8-0245/2018, 29 June 2018. The proposal read: ‘Member States shall provide sport event organizers with the rights provided for in Article 2 and Article 3 (2) of Directive 2001/29/EC and Article 7 of Directive 2006/115/EC’.
30. Amendments adopted by the European Parliament on 12 September 2018 on the proposal for a directive of the European Parliament and of the Council on copyright in the Digital Single Market (COM(2016)0593 – C8-0383/2016 – 2016/0280(COD), P8\_TA(2018)0337, Amendment 76.
31. European Commission, ‘Statement on sport event organisers’, annexed to the European Parliament legislative resolution of 26 March 2019 on the proposal for a directive of the European Parliament and of the Council on copyright in the Digital Single Market, OJ C 108/231, 26 March 2021.
32. European Parliament resolution of 19 May 2021 with recommendations to the Commission on challenges of sports events organisers in the digital environment (2020/2073(INL)), P9\_TA(2021)0236, para. 24.
33. B. van Rompuy & T. Margoni (project leader: P.B. Hugenholtz), *Study on sports organisers’ rights in the European Union* (T.M.C. Asser Instituut (Asser International Sports Law Centre) & Institute for Information Law, University of Amsterdam, February 2014), 24–60.
34. European Parliament, Committee on Legal Affairs (rapporteur: Angel Dzhambazk), Report with recommendations to the Commission on challenges of sports events organisers in the digital environment (2020/2073(INL)), A9-0139/2021, 23 April 2021, at 16–17 (explanatory statement).

of many sports events, such as football matches, boxing or cycling races, lies in the ‘live’ broadcast and that it is difficult to instantly enforce rights against pirates of sports events that are broadcast live. As Angel Dzhambazk, the JURI rapporteur, observes:

Unlike other content, such as films, series or books (and possibly some sport events such as ice dance competitions based on choreography which is of interest and that still has value years after the event ends) the main harm is caused during the event and the window for relevant action against piracy is short and is, basically, the duration of the event. Given the specificity of ‘live’ sport event broadcast, the relevant remedy should be the immediate termination of the unauthorised broadcast, before it has lost its value.<sup>35</sup>

Rather than establishing a new right for sports event organisers, therefore, the European Parliament recommends strengthening enforcement measures to enable rightholders to more effectively tackle piracy of live sports event broadcasts. It specifically calls on the Commission to assess the impact and appropriateness of introducing injunction procedures aimed at allowing real-time disabling of access to, or removal of, illegal online live sports event content, based on the model of ‘live’ blocking orders and ‘dynamic injunctions’.<sup>36</sup> It also suggests involving ‘certified trusted flaggers’ in notice and action procedures by requiring content hosting platforms to immediately remove or disable access upon a notification of an illegal broadcast of a live sports event by a certified trusted flagger.<sup>37</sup>

Such measures may indeed be more effective to fight online piracy of live sports event broadcasts than the creation of a new intellectual property right. However, as the CULT Committee of the European Parliament also emphasises, this should be accompanied by adequate safeguards to prevent that such measures affect ‘press freedom, the news media’s ability to inform citizens or to access information, freedom of expression and consumer privacy online’.<sup>38</sup> For this reason, the Resolution underlines that it must be ensured that real-time blocking measures strictly target illegal content only and do not lead to the arbitrary, excessive and collateral blocking of legal content.<sup>39</sup> Moreover, the enforcement measures must be transparent, respect the ban on general monitoring, safeguard

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35. *Ibid.*, at 15–16.

36. European Parliament resolution of 19 May 2021, *supra* note 32, para. 20.

37. *Ibid.*, paras. 16–17.

38. European Parliament, Opinion of the Committee on Culture and Education (rapporteur: Tomasz Frankowski) for the Committee on Legal Affairs with recommendations to the Commission on challenges of sports events organisers in the digital environment (2020/2073(INL)), 28 January 2021, para. 13.

39. European Parliament resolution of 19 May 2021, *supra* note 32, para. 21, pointing to the case-law of the European Court of Human Rights (ECtHR) according to which the illegal nature of specific content does not justify the collateral blocking of legal content hosted by the same website or server (see e.g. ECtHR (Second Section) of 1 December 2015, *Cengiz and Others v. Turkey*, Appl. nos. 48226/10 and 14027/11, paras. 54–56; ECtHR (Third Section) of 23 June 2020, *OOO Flavus and Others v. Russia*, Appl. nos. 12468/15, 23489/15 and 19074/16, para. 38; and ECtHR (Third Section) of 23 June 2020, *Vladimir Kharitonov v. Russia*, Appl. no. 10795/14, para. 46).

the protection of fundamental rights and personal data, offer effective judicial remedies, and include adequate complaint and redress mechanisms in notice and action procedures.<sup>40</sup>

Providing customers with sufficient legal alternatives to access live sports event broadcasts may be more important, however, to effectively tackle online piracy.<sup>41</sup> In this light, the CULT Committee in its opinion calls on the Member States to support the broadcasting of major sport events such as the FIFA World Cup or the Olympic Games on free-to-air television ‘as a form of popular culture that plays an important part in the lives of citizens’.<sup>42</sup> But policymakers could do more to encourage sports event organisers to offer consumers affordable, convenient and diverse access to live broadcasts of sports events. As Quintais and Poort argue, they ‘ought to shift their focus from repressive approaches to tackle online infringement towards policies and measures that foster lawful remunerated access to copyright-protected content’.<sup>43</sup> In this respect, the European Parliament could have more strongly emphasised that sports event organisers also have a responsibility of their own to increase the availability of affordable legal content in a way that meets the demands of sports consumers.

#### **4. PRESERVING THE TERRITORIAL LICENSING MODEL OF (LIVE) SPORTS BROADCASTS**

Sports event organisers have also been actively engaged in excluding (live) sports broadcasts from legislative actions at EU level aimed at removing national territorial barriers to the digital single market. In 2015, the SROC urged:

the European Commission to dismiss any overly far-reaching initiatives, which could negatively jeopardise the financing models of sports and the ability of sports bodies to fulfil their functions as sports events organisers and guardians of our sports. This is especially true of any potential general ban on territorial restrictions which SROC members believe would be extremely detrimental to European sports, to local broadcasting businesses and to the vast majority of European consumers.<sup>44</sup>

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40. *Ibid.*, paras. 13, 17 and 22.

41. J.P. Quintais and J. Poort, ‘The Decline of Online Piracy: How Markets – Not Enforcement – Drive Down Copyright Infringement’, 34(4) *American University International Law Review* (2019), 807–876. See also J. Poort and J. Weda, ‘Elvis Is Returning to the Building: Understanding a Decline in Unauthorized File Sharing’, 28(2) *Journal of Media Economics* (2015), 63–83, DOI: 10.1080/08997764.2015.1031904.

42. European Parliament, Opinion of the Committee on Culture and Education on challenges of sports events organisers in the digital environment (2020/2073(INL)), 28 January 2021, *supra* note 38, para. 15.

43. Quintais & Poort, *supra* note 41, 876. Insofar as piracy concerns the live event, which as such may fail to meet copyright’s originality test, this guideline applies by analogy.

44. SROC Paper on the territoriality, cross-border access to content and portability issues, 22 May 2015, [https://www.sroc.info/wp-content/uploads/2018/04/SROC\\_position\\_paper\\_on\\_teritoriality.pdf](https://www.sroc.info/wp-content/uploads/2018/04/SROC_position_paper_on_teritoriality.pdf), 7.

In this respect, sports event organisers successfully managed to exclude '[a]udio-visual services, including services the principle purpose of which is the provision of access to broadcasts of sports events and which are provided on the basis of exclusive territorial licenses' from the scope of EU Regulation 2018/302, which prohibits unjustified geoblocking and other forms of discrimination based on customers' nationality, place of residence or place of establishment in cross-border transactions within the EU.<sup>45</sup> They further achieved that the country of origin rule in the 2019 Online Broadcasting Directive, which aims to facilitate licensing by establishing that rights for broadcasters' 'ancillary online services' (such as simulcasting and catch-up services) only need to be cleared in the broadcasters' country of establishment, does not apply to television broadcasts of sports events and works and other protected subject matter included in them.<sup>46</sup>

As a result, broadcasting rights for sports events can still be licensed on an exclusive territorial basis. Broadcasters wishing to make sports event broadcasts available over the internet therefore require licences from all relevant right holders in all countries where access to the broadcasts is provided or otherwise they must apply geoblocking technologies to prevent their online services being accessible across borders.<sup>47</sup> One exception applies, however, for the cross-border portability of online content services that are subscription-based. The 2017 EU Portability Regulation requires providers of such services to provide subscribers who are temporarily travelling within the EU continued access to the online content services to which they have subscribed in their country of residence. To prevent that providers of such online services have to clear rights for this type of use in all the EU Member States, the Regulation introduces the legal fiction that the provision of the service 'shall be deemed to occur solely in the subscriber's Member State of residence'.<sup>48</sup> These portability rules also apply to online content services offering access to sports events,<sup>49</sup> which the SROC did not oppose.<sup>50</sup>

But can exclusive territorial licensing of broadcasting rights for sports events be justified? On the one hand, there may be good reasons for sports event

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45. Regulation (EU) 2018/302 of the European Parliament and of the Council of 28 February 2018 on addressing unjustified geo-blocking and other forms of discrimination based on customers' nationality, place of residence or place of establishment within the internal market and amending Regulations (EC) No 2006/2004 and (EU) 2017/2394 and Directive 2009/22/EC, *OJ L* 60/1, 2 March 2018, recitals 6 and 8.

46. Directive (EU) 2019/789 of the European Parliament and of the Council of 17 April 2019 laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of television and radio programmes, and amending Council Directive 93/83/EEC, *OJ L* 130/82, 17 May 2019, Art. 3(1).

47. See e.g. H. Ruijsenaars, 'De Richtlijn online omroepdiensten: een brug te kort', 1 *Auteursrecht* (2021), 10–19, at 17 et seq., calling the 'unnecessary restrictions of the country of origin rule' in the 2019 Online Broadcasting Directive a 'missed opportunity'.

48. Regulation (EU) 2017/1128 of the European Parliament and of the Council of 14 June 2017 on cross-border portability of online content services in the internal market, *OJ L* 168/1, 30 June 2017, Art. 4.

49. *Ibid.*, recitals 1, 5 and 6.

50. SROC, *supra* note 44, 7.

organisers to sell rights to broadcast sports events on a territory-by-territory basis. Especially in Europe, most broadcasters operate nationally and there is not automatically a high demand to deliver sports content outside national broadcasting markets.<sup>51</sup> Moreover, the popularity of sports differs between Member States and sports consumers in different countries often have different cultural and linguistic preferences when watching sports competitions and events. It would be difficult to cater to all such domestic demands if sports were broadcast on a pan-European level.<sup>52</sup> Territorial licensing further enables sports event organisers to engage in price discrimination between Member States, according to the value that consumers in various countries attach to the relevant sports event and the average income in those countries.<sup>53</sup> Exclusive territorial licensing also ensures that broadcasters investing in rights to broadcast sports events can maximise the value proposition associated with the relevant sports in the home market, while allowing sports bodies to seek new platforms to monetise their competitions outside of the home market.<sup>54</sup>

On the other hand, territorial exclusivity of sports event broadcasting may also conflict with market forces, as it prevents sports consumption shifting towards platforms that operate on a pan-European level.<sup>55</sup> It may further be at odds with consumer expectations, especially since many EU citizens live in another EU Member State and territorial restrictions may bar them access to sports competitions in their home country.<sup>56</sup> Territorial exclusivity thus also enhances the risk that consumers will revert to online piracy to gain access to (live) sports event broadcasts.<sup>57</sup> Finally, exclusive territorial licensing runs foul of EU competition law, if it has the effect or object of preventing or restricting distribution or distorting competition on the market.<sup>58</sup> This is the case, for example, if an exclusive licence for a pay TV service for sports prevents or restricts ‘passive’ sales in non-licensed territories,<sup>59</sup> by obliging the pay TV operator not to supply decoding devices to users outside the licensed territory.<sup>60</sup>

The latter was the outcome of the CJEU’s *Premier League* decision of 2011, which forced the Premier League to renegotiate its licensing agreements with

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51. *Ibid.*, 4–5, explaining that in the past, attempts were made to sell the rights to broadcast the English Premier League on a pan-European basis, but this ‘did not attract a single bid’.

52. *Ibid.*, 4.

53. *Ibid.*, 2–3.

54. *Ibid.*, 3.

55. See, in relation to films, P.B. Hugenholtz and J. Poort, ‘Film Financing in the Digital Single Market: Challenges to Territoriality’, 51 *IIC* (2020), 167–186, at 170.

56. *Ibid.*, 170–171.

57. *Ibid.*, 170.

58. See European Court of Justice (ECJ), 6 October 1982, case 262/81, ECLI:EU:C:1982:334, *Coditel v. Ciné Vog Films (Coditel II)*, [1982] ECR 3381, paras. 14 to 16, stating that an exclusive territorial licence in respect of film distribution may be, but is not, in itself, anti-competitive.

59. Hugenholtz and Poort, *supra* note 55, 177–178.

60. CJEU, 4 October 2011, *supra* note 23, paras. 134–146.

all broadcasters in the EU.<sup>61</sup> The new licensing terms disallow licensees outside the UK and Ireland to offer an optional English language feed to its consumers. To respect the UK blackout rule that prohibits the broadcasting of live football matches on Saturday from 2.45pm to 5.15pm, they further disallow licensees outside the UK to transmit more than one live Premier League match on Saturday afternoon.<sup>62</sup> Van Rompuy therefore maintains that Premier League fans in Europe are worse off after the *Premier League* decision, since they have to accept ‘less live Premier League matches and no more English commentary’.<sup>63</sup> He further argues that a blackout rule, especially if it is contractually imposed on broadcasters in other countries, has clear anti-competitive effects that are not outweighed by any possible justification.<sup>64</sup>

If it can conclusively be established that there are legitimate reasons based on the special economic characteristics of the sports broadcasting industries to allow temporary territorial exclusivity of sports event broadcasting, then recourse can perhaps be sought in ‘block exemptions’ issued by the European Commission.<sup>65</sup> Such block exemptions provide generic exemptions to the EU competition law rules for specific economic sectors or particular types of business practices, which may permit temporary territorial exclusivity in certain well-defined cases. As Hugenholtz observes, such block exemptions could be supplemented or substituted by guidelines based on the general rule of non-discrimination in Article 18 TFEU, which ‘could take the shape of “black” and “grey” lists well known from the field of consumer law’ to define which specific types of geoblocking and geographical discrimination based on territorial licensing are prohibited or conditionally permitted.<sup>66</sup> Otherwise, exclusive territorial licensing might have a hard time passing the test of EU competition law.

## 5. CONCLUSION

As this chapter demonstrates, sports organisations, which have been united in the SROC for the past decade-and-a-half, have actively lobbied at the international and EU levels to protect the business model for broadcasting (live) sports events through intellectual property law. For this purpose, they have called for extended rights for broadcasting organisations, for the introduction of a new right for sports event organisers, and for preserving their exclusive territorial licensing business model.

Many scholars, including Bernt Hugenholtz, on the other hand, have warned against a needless expansion of intellectual property rights. They have expressed

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61. Ben van Rompuy, ‘Premier League fans in Europe worse off after Murphy judgment’, *Kluwer Competition Law Blog*, 6 May 2014, <http://competitionlawblog.kluwercompetitionlaw.com/2014/05/06/premier-league-fans-in-europe-worse-off-after-murphy-judgment>.

62. *Ibid.*

63. *Ibid.*

64. *Ibid.*

65. Hugenholtz and Poort, *supra* note 55, 180, in respect of exclusive territorial licensing for films.

66. Hugenholtz, *supra* note 3, 64–65.

concerns that an extended protection or a new intellectual property right may impede access to culture, restrict freedom of expression and impact consumer rights. As Hugenholtz asserts: ‘Obviously, granting IP rights for no good reason can have serious consequences, both for the economy and for society at large. The temporary monopoly that an IP right entails does not only create an obstacle to freedom of competition.’<sup>67</sup>

Lawmakers should therefore exercise caution when specific interest groups try to influence the policy debate for their own good. They must critically assess whether there is truly a need for an extended protection and whether this does not lead to overprotection, with all the associated risks and societal costs. Although this seems like stating the obvious, over the past decades, we have witnessed various proposals for extended intellectual property protection passing into law, despite fierce criticism from the academic community.<sup>68</sup> Irrespective of his obvious love for sports, I doubt whether the described attempts to strengthen the protection of live sports broadcasts can meet Bernt’s approval, given his consistent scholarly quest for a ‘balanced’ intellectual property framework.

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67. Hugenholtz, *supra* note 2, 201.

68. See e.g. S.J. van Gompel, ‘Copyright, Doctrine and Evidence-Based Reform’, 8 *JIPITEC* (2017), 304–310.

# Football, Copyright ... and the Art of 'Tiki-Taka'?

*Raquel Xalabarder*

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## 1. INTRODUCTION

Messi is an artist, not an author (as far as we know!). He is not even a performer, for the purposes of copyright law. Sports events (and football matches) have consistently been denied copyright protection as *works* in the EU *acquis* and under national laws, disqualifying most athletes from related rights protection. However, audiovisual recordings and broadcastings of sports events (played by athletes) may be protected under copyright laws.

In addition, most national laws recognise 'house rights' (derived from property and access control of the physical venues where the sports event takes place) in favour of sports event organisers. Lacking a uniform definition, this may be either the sports competition organiser (e.g. FIFA, UEFA Champions League, or La Liga in Spain), the sports club (e.g. Ajax or Barça), or a combination of both.

Solutions vary according to national laws and contracts become paramount in navigating this complex world of exclusive rights, and of a different nature. As a result, the exploitation of sports events relies on several layers of exclusive rights owned by different stakeholders and requiring a complex contractual architecture ... a legal 'tiki-taka' of sports event organisers, audiovisual producers and broadcasters, where athletes are forgotten.

## 2. SPORTS EVENTS AND EXCLUSIVE RIGHTS

The organisation and exploitation of sporting events tend to accumulate several layers of vested rights.<sup>1</sup>

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1. For a comparative law survey of rights vested in sports events within the EU (including unfair

On the one hand, there are traditional ‘property rights’. To the extent that sports events take place in specific venues owned or controlled by a sports club or a sports event organiser, a right coming close to a ‘property right’ naturally results from the power to control access to it: to authorise or prohibit it and to set specific terms and conditions for it. As a result, despite not always formally granted by law, ‘house rights’ are widely recognised and enforceable in all EU countries.<sup>2</sup> In addition, a few laws formally grant an exclusive right to obtain financial reward from the ‘audiovisual exploitation’ of sports events. The nature and scope of this additional layer of protection varies from one country to another. Often, it is envisioned as an independent (non-copyright) exclusive right, similar to ‘house rights’ and, like them, subject to contracts and civil law agreements. However, in other countries, this exclusive ‘audiovisual right’ is expressly or implicitly regarded as a related right (under copyright laws). ‘House rights’ – including, where formally granted, ‘audiovisual rights’ – usually vest in the sports event organiser (be it the sports club, the competition organiser, or a combination of both). More recently, ‘house rights’ have also been used to justify a right to consent to bets, as a new means to enhance the financial return for sports events.<sup>3</sup>

On the other hand, there are ‘proper’ intellectual property rights – namely, copyright. Authors’ rights and related rights may be granted not so much in the sport event *per se*, but clearly on its recording and broadcasting. Intellectual property rights in sports events usually vest in the hands of media operators and broadcasters and not so much the sports event organisers, but they must rely on the previous layer of exclusive rights (‘house rights’ and ‘audiovisual rights’) forming a complex architecture of rights and contractual arrangements.

Sporting events may also enjoy protection under intellectual property laws.

## 2.1 Sports Events as Works of Authorship

Sports events do not qualify as ‘works of authorship’, for copyright law purposes. No surprises there. The CJEU concluded so in the *Premier League* case,<sup>4</sup> and the rule remains unaltered.

In order to be protected as a work, it needs to be original in the sense that it is its ‘author’s own intellectual creation’<sup>5</sup> and that ‘the author was able to

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competition law), see T.M.C. Asser Instituut, Institute for Information Law (IViR) University of Amsterdam, *Study on Sports Organisers’ Rights in the European Union*, European Commission – DG Education and Culture, February 2014 (EAC/18/2012): [https://ec.europa.eu/assets/eac/sport/news/2014/docs/study-sor2014-executive-summary-gc-compatible\\_en.pdf](https://ec.europa.eu/assets/eac/sport/news/2014/docs/study-sor2014-executive-summary-gc-compatible_en.pdf)

See also Thomas Margoni, ‘The protection of sports events in the EU: Property, intellectual property, unfair competition and special forms of protection’, 47(4) *IIC – International Review of Intellectual Property and Competition Law* (2016), 386–417, <https://link.springer.com/content/pdf/10.1007/s40319-016-0475-8.pdf>

2. See Asser, *supra* note 1, at 25–29; see Margoni, *supra* note 1, at 391–394.

3. See *ibid.*, at 122 et seq.

4. CJEU (Grand Ch.), 4 October 2011, C-403/08 and 429/08, ECLI:EU:C:2011:631, *Football Association Premier League*, para. 98.

5. See the concept of originality provided computer programs, photographs, and databases (see for Art. 6 Term Directive 2006/116/EC of the European Parliament and of the Council

express his creative abilities in the production of the work by making free and creative choices.<sup>6</sup> Instead, 'football matches, which are subject to rules of the game, [leave] no room for creative freedom for the purposes of copyright ... [and] cannot be protected under copyright'.<sup>7</sup>

Sporting events are not envisioned as subject matter protected under related rights in the EU *acquis*, either.<sup>8</sup>

Having said that, the possibility that in some specific cases, the production of an audiovisual recording of a sporting event may achieve the minimal threshold of originality required to be a work of authorship should not be completely dismissed. On the one hand, 'it could be speculated whether under certain specific circumstances some particular sports, such as gymnastics, figure skating, synchronised swimming, or other events that strictly follow a script, could be seen as artistic works subject to copyright protection by virtue of their similarities with, for example, choreographic or dramatic works'.<sup>9</sup> On the other, as proven by Professor Lionel Bently at the IViR 25th Anniversary Conference, the argument that football matches offer no room for free and creative choices should be challenged.<sup>10</sup> In this scenario, the paramount problem becomes deciding on the authorship status: 'the player executing the trick, all the players involved in an action as joint authors, or the coach as the director of players' performance'?<sup>11</sup>

Far less problematic in theory, but still rare in practice, the audiovisual production of a sporting event may qualify as an audiovisual work *per se*. In theory, the very complex process of creating the audiovisual sports event production<sup>12</sup> offers plenty of opportunities for free and creative choices made by an author (its director), that go beyond mere skilful execution and will constitute

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of 12 December 2006 on the term of protection of copyright and certain related rights (codified version) ELI: <http://data.europa.eu/eli/dir/2006/116/oj>), and later extended to all kind of works by the CJEU (Fourth Ch.), 16 July 2009, C-5/08. ECLI:EU:C:2009:465, *Infoqaq*, para. 37.

6. CJEU (Third Ch.), 1 December 2011, C-145/10, ECLI:EU:C:2011:798, *Painer*, para. 89.
7. See CJEU, *Premier League*, paras. 98–99. See also Eleonora Rosati, *Originality in EU Copyright: Full Harmonization through Case Law* (Edward Elgar, Cheltenham, 2013), 137–142.
8. Under EU *acquis*, related rights protection is granted to performances, sound recordings, first fixations of films and broadcastings.
9. See Margoni, *supra* note 1, at 390.
10. See Thomas Margoni, 'Who owns the World Cup? The case for and against (intellectual) property rights in sports' (report on the IViR 25th Anniversary Conference), *Kluwer Copyright Blog*, 13 October 2014: <http://kluwercopyrightblog.com/2014/10/13/who-owns-the-world-cup-the-case-for-and-against-intellectual-property-rights-in-sports/>
11. *Ibid.*
12. The recording (and broadcasting) of a sporting event may involve multiple video recording cameras, strategically located in different places, to record different angles and perspectives from the general play to small close-up details (such as players' image, facial expression and body movements). Often, images are obtained from helicopters and drones overflying the event. All these images are combined into an audiovisual recording (that is usually broadcast, live or deferred) and that may also include other added contents (not recorded from the sports event), such as extra information and statistics or 3D animations to show specific plays or strategies.

her own intellectual creation. The CJEU ruling in *Painer* (regarding a photograph) confirms that. As explained by the CJEU,

the photographer can make *free and creative choices in several ways and at various points in its production*. In the *preparation* phase, the photographer can choose the background, the subject's pose and the lighting. When *taking* a portrait photograph, he can choose the framing, the angle of view and the atmosphere created. Finally, when *selecting* the snapshot, the photographer may choose from a variety of developing techniques the one he wishes to adopt or, where appropriate, use computer software. *By making those various choices, the author of a portrait photograph can stamp the work created with his 'personal touch'*.<sup>13</sup>

Phases and choices that may be easily transported to the complex process of 'creating' an audiovisual production of the sporting event.<sup>14</sup>

In 2012, the Madrid Court of Appeal clearly pointed in that direction. After concluding that the mere broadcasting of a sporting event does not *per se* qualify as an audiovisual work, lacking a sufficient degree of originality,<sup>15</sup> the Court stated that 'we do not rule out that the fact of interspersing reports, interviews, etc., could, perhaps, contribute to climbing that step of creative height, ... necessary to reach such a legal qualification,' adding that 'what is relevant is the creative aspect and not the technical deployment made or the size of the economic investment made'.<sup>16</sup>

In summary, most sporting events will hardly qualify as audiovisual works, but their production, audiovisual recording and broadcasting will, at least, qualify for related rights protection under national laws.

## 2.2 Sports Events as Audiovisual Recordings

Neither the Rome Convention of 1996, nor the WIPO Performances and Phonograms Treaty (WPPT) of 1996, nor the Beijing Treaty of 2012 grant related rights

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13. See CJEU (Third Ch.), 1 December 2011, C-145/10, ECLI:EU:C:2011:798, *Painer*, paras. 90–92 (emphasis added).

14. For a more detailed analysis, see Margoni, *supra* note 1, at 396–400.

15. See Audiencia Provincial de Madrid, 24 February 2012, *Telecinco v. Marca*, FJ5. ECLI: ES:APM: 2012:2736. In this case, the Formula 1 Grand Prix held in Brazil in 2007 and broadcast in Spain by Telecinco (exclusive owner of all 'audiovisual rights' for Spain) was further retransmitted by MARCA (a Spanish newspaper) without Telecinco's consent, to a venue in Madrid with over 10,000 people. Telecinco sued MARCA for copyright infringement and the court rejected its claim arguing that Telecinco's broadcast was not a *work of authorship*. Had Telecinco claimed for an infringement of *related rights* in the audiovisual recording, its claim might have been successful; as explained by the court: 'the non-existence of a work ... does not exclude ... the exclusive right of public communication that is granted by law to producers of audiovisual recordings (article 122.1 TRLPI), insofar as in this area it is not essential that they also deserve the classification of audiovisual works (article 120.1 TRLPI)'.

16. See *ibid*.

protection to producers of audiovisual recordings.<sup>17</sup> However, the EU *acquis*, as well as most national laws, do so and do so in a broad manner.

Under the EU *acquis*, protection is granted to the 'first fixation of a film', defined broadly as 'a cinematographic or audiovisual work or *moving images*, whether or not accompanied by sound'<sup>18</sup> and being irrelevant whether the images embodied in them qualify as a work, at all.<sup>19</sup> Similarly, Article 2(b) Beijing Treaty (2012) defines 'audiovisual fixation' as 'the embodiment of moving images, whether or not accompanied by sounds or by the representations thereof, from which they can be perceived, reproduced or communicated through a device.'

An audiovisual production of a sporting event will easily qualify as an audiovisual recording. Exclusive rights will be granted to its 'producer', justified by the 'high and risky'<sup>20</sup> entrepreneurial and financial investment taken by him for the making of the audiovisual recording.

Exclusive rights granted under the EU *acquis* include the exclusive right to authorise or prohibit direct or indirect reproduction, by any means and in any form, in whole or in part; the exclusive right to distribute (in tangible copies) by sale or otherwise; and the exclusive right to authorise or prohibit the making available to the public, by wire or wireless means (interactive, on demand access). The EU *acquis* does not grant audiovisual producers an exclusive right to authorise or prohibit communication to the public of these fixations/recordings but national laws may do so,<sup>21</sup> based on the subsidiarity principle that underlies the harmonisation of EU copyright law.

## 2.3 Broadcasting of Sports Events

Broadcasting organisations enjoy related rights protection over their broadcasting signals, regardless of whether these signals carry works of authorship, related rights-protected subject matter or non-protected subject matter. As with audiovisual recordings, broadcasting rights are granted regardless of any copyright in the broadcast content.

Exclusive rights granted under the EU *acquis* to broadcasting organisations include the right to authorise or prohibit the re-broadcasting of their signals, as well as their reproduction and communication to the public, for a term of fifty years since the broadcast took place (all terms are counted as of the end of that year).

17. Indirectly, the Beijing Treaty grants protection to audiovisual performances that may be fixed in audiovisual recordings and offers a definition (Art. 2).

18. See Art. 2.1c) Directive 2006/115/EC (codified).

19. See, for instance, in Spain Art. 120(1) TRLPI: 'Audiovisual recordings means fixations of a scene or a sequence of images, with or without sound, whether or not they constitute creations susceptible of qualifying as audiovisual works within the meaning of Article 86 of this Law.'

20. See Recital 5 Directive 2006/115/EC (codified)

21. See, for instance, in Spain Art. 122 TRLPI granting the full scope of the exclusive right of communication to the public (as granted to authors under Art. 20 TRLPI), but subject to specific rules for the exercise of some modes of exploitation.

A possible enlargement of the international protection granted to broadcasters has been considered by WIPO Member States over the years. The main controversies include a technologically neutral expansion of the scope of exclusive rights (to cover live webcasting, as well as on-demand video services, and transmission to mobile phones and tablets, etc.) and a term extension beyond the ‘initial’ twenty years.

As far as football events are concerned, the broadcasting organisation may be either a sports club or competition organiser<sup>22</sup> or, more likely, a broadcasting entity which has acquired the exclusive audiovisual rights to broadcast an event. Contracts become paramount in regulating the vesting and assignment of intellectual property rights in the broadcast (see section 3).

## 2.4 Specific Neighbouring Rights for Sports Events?

As we have seen, the subsequent recording and broadcasting of sports events may qualify as protected subject matter for purposes of related rights protection under most national laws in the EU; namely, as audiovisual recordings and as broadcasting signals. But some countries have gone further, designing specific protection for sporting events: either as a formal related right in copyright law, or under specific legislation relating to sports.

### 2.4.1 Italy: A Related Right for Sports Events

In *Premier League*, the CJEU left open the possibility that national laws may grant sporting events specific intellectual property protection.<sup>23</sup> The most notable example seems to be Italy.<sup>24</sup> In 2007, the Italian Copyright Act was amended to introduce an Article 78-*quater* entitled ‘Audiovisual Sports Rights’. This exclusive right, protected for fifty years from the date of the sports event, convey the power to authorise or prohibit the *fixation* of the event, its *reproduction* live or delayed, temporal or permanent, in any manner or form, its *communication and making available to the public*, its *distribution* (including rental and lending rights), as well as the making, fixation and reproduction of its *broadcasting*. The organiser of the sports competition and the event organiser (that is, the club) are joint owners of the ‘Audiovisual Sports Rights’. Quite surprisingly, when original ownership of ‘Audiovisual Sports Rights’ (Art. 78-*quater*) and original ownership of related rights in the audiovisual recording (Art. 78-*ter*) do not coincide in the same entity or person, Italian law expressly sets aside the latter in favour of the

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22. In the rare instances when they, themselves, produce and broadcast these events.

23. See CJEU, *Premier League*, para. 100: ‘None the less, sporting events, as such, have a unique and, to that extent, original character which can transform them into subject-matter that is worthy of protection comparable to the protection of works, and that protection can be granted, where appropriate, by the various domestic legal orders.’

24. See Margoni, *supra* note 1, at 412–414.

former: the sports event organiser.<sup>25</sup> As we will see below, the opposite solution applies in Spain, where ownership of the so-called 'Audiovisual Exploitation Rights' is independent of related rights vested in the audiovisual recording or broadcasting, making contracts even more important.

#### **2.4.2 Other Sport-Related Regulations**

A few countries grant specific protection for sports event organisers, outside copyright laws.

In France, since 1984 (Art. L.333-1 French Sports Code), sports federations and sporting event organisers are joint owners of exploitation rights in the sports events they organise. Despite its unclear nature (a property right or a related right), this exclusive right has been broadly interpreted by courts to include the right to *authorise the recording* of all images and pictures taken involving the sports event, as well as the *publishing of a book* on the event and, more recently, the right to *authorise bets*.<sup>26</sup>

In similar terms, Bulgaria, Greece, Hungary, and Romania grant specific statutory rights to sports event organisers, within the context of sports regulations.<sup>27</sup> At least until 2007, Portugal also granted some sort of 'related rights' protection to organisers of sporting events; but the nature of this right remains unclear.<sup>28</sup>

#### **2.4.3 Spain**

In Spain, 'audiovisual exploitation rights', traditionally vested in football clubs, are mandatorily owned and managed by La Liga and RFEF.<sup>29</sup> These 'audiovisual rights' do not have an 'IP' nature, but they co-exist with any IP rights that may be granted on the recording and broadcasting of the sport event. In 2013, the Spanish Supreme Court<sup>30</sup> had the opportunity to neatly distinguish both sets of exclusive rights in football matches. In this case, RFEF had granted GSM

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25. See Margoni, *supra* note 1, at 413: to the extent that the specific, Italian-made, related right in sports events (Art. 78-*quater*) prevails over the harmonised related right in audiovisual recordings (Art. 78-*ter*), Margoni questions its compatibility with EU *acquis*.

26. See Margoni, *supra* note 1, at 410-411.

27. See Asser, *supra* note 1, at 31-32; see Margoni, *supra* note 1, at 412.

28. See Asser, *supra* note 1, at 31-32.

29. Royal Decree-law 5/2015, of 30 April 2015, established an *ex lege* (compulsory) transfer of these rights to the football competitions' organisers: La Liga (National Professional Football League) regarding the First and Second Division National Leagues and the RFEF (Royal Spanish Football Federation) regarding the King's Cup and Spanish Super Cup (RFEF). For more information on the Spanish regime, see Vanessa Jiménez-Serranía and R. Xalabarder, 'Spanish Report', for the *Study EPRS: Challenges of Sports Events Organisers in the Digital Environment: A Legal Analysis*, Legance Avvocati Associati, commissioned by the European Parliamentary Research Service (PE 654.205 – December 2020): [https://www.europarl.europa.eu/RegData/etudes/STUD/2020/654205/EPRS\\_STU\(2020\)654205\\_EN.pdf](https://www.europarl.europa.eu/RegData/etudes/STUD/2020/654205/EPRS_STU(2020)654205_EN.pdf)

30. See Tribunal Supremo (Civil ch.) 25 June 2013, no. 439/2013, ECLI:ES:TS:2013:3872 <https://www.poderjudicial.es/search/documento/TS/6810924/Propiedad%20intelectual/20130729>.

the ‘assignment, sale and transfer’, on an exclusive basis, of audiovisual rights in certain sporting events. According to the Court, ‘the fact that RFEF, by the contract at issue, assigned certain rights to GSM “exclusively” does not mean that this contract gave rise to “exclusive rights”, in the legal sense of the term, giving GSM a “ius prohibendi” in relation to the images and sound of certain football matches’.<sup>31</sup> GSM was indeed entitled to produce audiovisual recordings of certain football matches; but since GSM had transferred its ‘audiovisual rights’ to the Spanish TV channel TVE (who produced the audiovisual recording), the Supreme Court denied GSM the status of audiovisual producer.<sup>32</sup> In summary, related rights ownership derives from copyright law,<sup>33</sup> not from any contract assigning ‘audiovisual rights’.

### **3. WHAT ABOUT ATHLETES?**

Beyond audiovisual recordings and broadcasts, let’s now examine another form of related rights protection granted to performers, and assess its application to sporting events and athletes.

#### **3.1 Messi is not a Performing Artist**

Messi is an artist, indeed. But he is not a performing artist for copyright purposes. From a purely economic perspective, he may not need to be so. Athletes’ income depends on the licensing of their image rights,<sup>34</sup> not so much on any copyright or neighbouring rights resulting from their athletic activity. But this, *per se*, should not justify denying them or, at least, rejecting considering their protection under copyright laws.

A performer is someone who performs a literary or artistic work.<sup>35</sup> According to Article 3(a) Rome Convention ‘performers’ means ‘actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works.’ Similar definitions (and, specifically, the requirement to perform ‘a work’) are retained in Article 2(a) WPPT of 1996<sup>36</sup> and Article 2(a) Beijing Treaty on Audiovisual Performances of 2012. In short,

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31. See *ibid.*, FJ6 at 8.

32. See *ibid.*, FJ7 at 8–9.

33. According to Art. 120(2) TRLPI ‘the producer of an audiovisual recording is the natural or legal person who has the initiative and takes the responsibility for the making of such recording’.

34. See Asser, *supra* note 1, at 42–51: image rights are protected under multiple variants (publicity rights, privacy, and personality rights, etc). See also Nerea Sanjuan, ‘Derechos de imagen y derechos audiovisuales en el deporte profesional’, 12 *Revista jurídica de deporte y entretenimiento: deportes, juegos de azar, entretenimiento y música* (2004), 277–310.

35. See Paul Goldstein, Bernt P. Hugenholtz, *International Copyright Law, Principles, Law and Practice* (2nd edn., Oxford University Press, Oxford, 2010), 234: the work may be protected or in the public domain, but the object of the performance must be a ‘work’.

36. The WPPT extended the Rome Convention definition of performers with ‘expressions of folklore’.

Messi cannot qualify as a performer because football matches do not qualify as works of authorship.

Under this rule, very few athletes may enjoy related rights protection: only when their execution involves some pre-existing work or protected subject matter, such as in figure skating, gymnastics (namely, the 'free' exercises), and similar dance-related sports.<sup>37</sup> Perhaps we should not be satisfied with this outcome.

Under the very visual (and non-exhaustive) title 'Variety and Circus Artists', Article 9 Rome Convention allows contracting parties to 'extend the protection provided for in this Convention to artists who do not perform literary or artistic works'. Lacking a formal definition of 'performer', the EU acquis also leaves it to Member States.<sup>38</sup> Some national laws are more generous with the types of performances that may obtain protection. For instance, French law (Art. L.212-1) also offers protection to persons who perform 'variety, circus or puppet acts'. Spanish law (Art. 105 TRLPI) includes 'scene directors and orchestra directors' in its definition of performers (*Artistas intérpretes o ejecutantes*) which traditionally requires 'enacting, singing, reading, reciting, performing or playing a work, in any form' (Art. 105 TRLPI).

Despite the straightforward language of national provisions (which 'simply' require performing *a work*), caselaw and scholarly doctrine tend to add another requirement: a 'personal imprint to the artistic performance'.<sup>39</sup> In order to be protected, a performer must do 'something more' than just sing, read, or recite *a work*. Following that approach, a recent ruling by the Court of Appeal in Madrid<sup>40</sup> denied the status of performer to a person who regularly contributed as 'an expert' to a TV show on the grounds that he did not play an actor's role, but was merely acting as a presenter: he had to memorise pre-existing texts (protected works, indeed), but he was not conveying a 'personal artistic performance'.<sup>41</sup> Similarly, over the years, Spanish courts have ruled against a variety of candidates seeking performing rights protection: a gymnastics trainer,

37. See Asser, *supra* note 1, at 31.

38. 'And national legislation in Rome Convention countries generally conforms to the minimum standards implicit in the Convention's definition of performance.' See *ibid.*

39. For instance, France requires a performance with a 'personal character'; see André Lucas, Henri-Jaques Lucas, *Traité de la propriété littéraire et artistique* (3rd edn., Litec, Paris, 1994), 966.

40. See Audiencia Provincial de Madrid (sec. 28), 6 November 2020, ECLI:ES:APM:2020:12989, *Cifras & Letras*. For an analysis of this case, see Ramon Casas Vallés, '¿Quién es "artista" (actor)? El caso "Cifras y Letras": SAP de Madrid, sec. 28<sup>a</sup>, de 6/11/2020', *Blog de ALADDA*, 21 January 2021, <http://aladda.es/quien-es-artista-actor-el-caso-cifras-y-letras-sap-de-madrid-sec-28a-de-6-11-2020/>

41. The claimant sued AISGE, Spanish CMO for Performing Artists/Actors, seeking remuneration for communication to the public of his performances. According to AISGE's Regulation for Revenues Distribution, the concept of 'protected artistic performance' requires that 'the artist, with his personal expression (with gestures, voice, tones, silences) makes a very personal contribution which conveys a personal imprint to the artistic performance, making it different from any other.' Instead, the first instance court dismissed the relevance of AISGE's regulation and granted performing rights to the claimant, taking into account that he had signed a contract with the TV producer transferring any intellectual property rights he may have in his performance.

a TV weather forecast presenter, several TV news presenters and reporters, a director and presenter of a TV program on religion, a sports program presenter, a drummer with a municipal marching band.<sup>42</sup>

### 3.2 Bullfighters are neither Authors nor Performers

Bullfighters have also been denied authorship, as well as performer status in their *faenas* (in bullfighting terms, their ‘*works*’). Recently, a claim was brought by a bullfighter, seeking copyright protection for his *faena* consisting of ‘two ears and petition of tail of the bull named ‘Curioso’ n. 94, of 539 kg, born on February 2010, cattle ranch Garci Grande, Feria de San Juan de Badajoz, on 22 June 2014’ and described as follows: ‘natural left hand changing hands at the back without moving. Afterwards he [bullfighter] links a reversed bull passing at the back and allows a passing [of the bull] on the right. The bull breaks loose, and the bullfighter goes to it allowing a high right hand passing’.<sup>43</sup> Both the Copyright Registrar and the courts in Badajoz<sup>44</sup> rejected his claim. The instance court concluded that a bullfighter cannot be a creator (an author) and a performer at the same time, because ‘the performance requires the pre-existence of a work’ (that is being performed) and because the performance must be something other than the ‘mere execution of a series of predetermined passes and sets’. On appeal, the court used a different argument to also reject the claim:

despite the fact that the possibilities for free and creative choices in a bullfighting *faena* are multiple and unlimited, a specific *faena* cannot be described in a manner that could not be executed by another bullfighter. The description of a *faena*, regardless of how precise and detailed it may be, will always lead to difficulties in distinguishing it from other similar ones... the freedom of a bullfighter cannot be restricted (in such a dramatic moment) by the fear of an eventual claim of damages. Lastly, it cannot be allowed that each and every bullfighter register any *faenas* they please because that would be as much as putting an end to bullfighting.

I will refrain from commenting on the several (wrong) assertions included in this wording, but I would like to draw attention to the reminiscence of the CJEU’s *Levola* ruling, requiring that the protected subject matter could be ‘expressed in a precise and objective manner’.<sup>45</sup>

Interestingly, when bullfighters are listed among the several non-protected performers (including presenters, variety and circus artists, and so on), a few

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42. See Casas Vallés, *supra* note 40, paras. 8–9, arguing in favour of the pre-existence of a work (that is being performed) and the contribution of a ‘personal artistic performance’.

43. See *ibid.*: ‘mano izquierda al natural cambiándose de mano por la espalda sin moverse. Luego liga pase cambiado por la espalda y da pase por la derecha. El toro sale suelto y el torero va hacia él dando pase por alto con la derecha’.

44. See Juzgado Mercantil n. 1 Badajoz, 10 April 2017; Audiencia Provincial de Badajoz (sec. 2), 22 January 2018, ECLI:ES:APBA:2018:50, [https://www.todanelo.com/sites/default/files/common/170419\\_pi\\_-sentencia\\_toreo.pdf](https://www.todanelo.com/sites/default/files/common/170419_pi_-sentencia_toreo.pdf). See Casas Vallés, *supra* note 40.

45. See CJEU (Grand Ch.), 13 November 2018, C-310/17, ECLI:EU:C:2018:899, *Levola*.

Spanish scholars dare to express their concerns arguing that a bullfighter's performance is 'eminently artistic and creative'.<sup>46</sup> Unfortunately for them, they do not perform *a work*.

### **3.3 And what about e-Sports Gamers?**

As copyright markets and products evolve, excessively restrictive definitions of performing artists in national laws may lead to inconsistent results. The emerging market of e-sports gaming<sup>47</sup> offers an excellent example to start revising some historical assumptions for the protection of performers.

As the market for online video games expands, a new market is evolving for the exploitation of 'e-sports' outputs where consumers are not playing the videogame themselves, but are passively enjoying (watching) someone else's gaming. 'Gamers' are becoming rock stars and economic revenues from this new market are growing fast. E-sports events are being organised online and the e-games matches are recorded for subsequent exploitation. Gamers assign to the event organiser any rights they may have in the resulting recording. Contracts, once again, become paramount.

E-gamers might qualify as 'performers' to the extent that they are 'performing' *a work* (a videogame), and benefit from related rights protection under copyright laws; Messi (whose image, movements and 'performance' is at the core of this videogame) will not.

### **3.4 Is This an Optimal Outcome?**

As a matter of positive law, the answer is clear: national laws retain the restrictive definitions (and requirements) of performances envisaged in the nineteenth century for the copyright markets existing at that time.<sup>48</sup> From a normative perspective, however, and seeing the amount of revenues that the production and broadcasting of their 'sporting performances' entail, one can at least question if denying athletes any intellectual property protection is the optimal outcome.

Seeing that the Rome Convention expressly left the door open for national laws to grant protection 'to artists who do not perform literary or artistic works', one wonders why the national lists of protected performers remain so restrictive. Over the years, as copyright markets evolved and copyright products expanded,

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46. See Abel Martín Villarejo, Art. 105 TRLPI, *Comentarios a la Ley de Propiedad Intelectual (J.M. Rodríguez Tapia)* (2nd edn., Civitas, Madrid, 2009), 631 et seq.

47. Stephen Townley, Annie Townley, 'eSport: everything to play for', 1 *WIPO Magazine*, February 2018, [https://www.wipo.int/wipo\\_magazine/en/2018/01/article\\_0004.html](https://www.wipo.int/wipo_magazine/en/2018/01/article_0004.html).

48. Related rights protection of performers in national laws predates the 1961 Rome Convention; see Sam Ricketson and Jane C. Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond* (2nd edn., Oxford University Press, Oxford, 2006), para. 19.05. At a national level, the Austrian law of 1936 and the Italian law of 1941 are often mentioned as examples of early related rights protection granted to performers; see Rafael Sánchez Aristi, 'Comentario al Art. 105 TRLPI', *Comentarios a la Ley de Propiedad Intelectual (R. Bercovitz)* (4th edn., Ed. Tecnos, Madrid, 2017), 1545–1575, at 1539.

the scope of related rights protection granted under national laws has substantially increased, beyond the reduced scope of protection granted in 1961 (audiovisual recordings, sound recordings which are not phonograms, *sui generis* rights in databases, etc.). Yet, as for performers, protection seems to have frozen in time. Especially so in continental Europe, and in sharp contrast with the more welcoming protection granted to all kinds of performances in common law regimes.<sup>49</sup>

Athletes' performances in sports events must abide by the (non-protected) rules of the game – this much is true. But it is no less true that athletes make a personal and skilful contribution (at least, as skilful as musicians playing in an orchestra), often with an artistic imprint – not far from the artistic imprint that dancers and musicians bring to interpreting and performing a work. Seeing the degree of imagination that EU and national legislators have deployed to justify new forms of related rights protection under copyright (e.g. *sui generis* right in databases), finding a rationale to justify the granting of related rights to athletes should not be difficult, after all. Especially so when international instruments have already paved the way.

#### 4. CONCLUSION

The combination of 'house rights', including 'audiovisual rights' where existing, with several layers of intellectual property protection (at least, as audiovisual recordings and broadcasting) 'allows sports event organisers complete ownership and/or control over the audiovisual rights in sports events'.<sup>50</sup> Audiovisual producers and broadcasters may also obtain related-rights protection in the production and broadcasting of a sport event.

It is difficult to reconcile the generosity of national laws in granting exclusive rights protection to sports events, as well as IP rights to audiovisual recordings and broadcastings of these sports events, with the stringency that these same laws apply to convey (rather, deny) protection to the persons performing these sports events, especially so when requiring something that is not mandated by international law: that the performance be connected to a work.

Perhaps IP laws should start considering the opportunity to open the door to a few new players? Otherwise, one might argue that copyright laws do a better job at protecting entrepreneurial and financial investments, than at protecting artistic (and creative) inputs of performers ... especially of those whose performance does not involve a pre-existing work.

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49. See Goldstein and Hugenholtz, *supra* note 35, at 235.

50. See Asser, *supra* note 1, at 178.

# Do We Need More Copyright Protection for Sports Events?

*João Pedro Quintais*

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## 1. INTRODUCTION

This contribution discusses the protection of sports events by copyright and related rights in EU copyright law and asks a simple question: do we need more of it? Broadly speaking, it is possible to consider the protection of sports events along a spectrum of commercial exploitation: the event ‘as such’, its recording, and subsequent off/online transmission.<sup>1</sup> The focus of this contribution is on the ‘beautiful game’ of football, which is not only Bernt Hugenholtz’s favourite sport but also particularly popular in Europe. Significant economic importance is attached to this popularity, with transmissions of matches being subject to commercial exploitation in myriad ways. At the centre of these exploitation models is the live transmission of football matches, either through traditional broadcasting or the internet. Sports events are also of immense social-cultural value, as attested by their inclusion in Member States’ lists of ‘events of major importance’ for society, subject to specific medial law rules.<sup>2</sup>

It is therefore unsurprising that the legal protection of ‘sports transmissions’ has been subject to much legal debate, both as regards the legal basis for protection and available remedies against unauthorised (re)transmissions. In fact, copyright policy discussions regularly feature calls for additional protection

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1. See Thomas Margoni, ‘The Protection of Sports Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection’, 47 *IIC – International Review of Intellectual Property and Competition Law* (2016) 386; Lauro Panella and Matteo Firrito, ‘Challenges Facing Sports Event Organisers in the Digital Environment’ (European Parliamentary Research Service 2020) Study for European Parliament, [https://www.europarl.europa.eu/thinktank/en/document.html?reference=EPKS\\_STU\(2020\)654205](https://www.europarl.europa.eu/thinktank/en/document.html?reference=EPKS_STU(2020)654205), accessed 24 June 2021.

2. Margoni, *supra* note 1, 388.

of transmissions of sports events – or the events themselves – by copyright and related rights. This contribution argues that these calls are misguided and unjustified, at least from the perspective of EU law and as regards new rights. On the one hand, there already appears to be sufficient legal protection for sports events and transmissions. On the other hand, from a normative standpoint, it is difficult to justify an extension of copyright protection beyond the current levels, especially considering available and proposed enforcement measures.

The analysis proceeds as follows. After this introduction, section 2 discusses sports transmissions as an object of protection by copyright and related rights under EU copyright law, as interpreted by the Court of Justice of the European Union (CJEU or Court). Section 3 then highlights different enforcement avenues through which the copyright *acquis* enables the protection of sports events and transmissions. Both sections briefly map recent attempts to further strengthen the protection of sports events in EU law, either through the (failed) introduction of new exclusive rights or via additional enforcement measures. Building on the previous analysis, Section 4 concludes by arguing against the recognition of new layers of protection for sports events and offering a word of caution against additional enforcement measures.

## **2. SPORTS EVENTS, RECORDINGS AND TRANSMISSIONS AS OBJECTS OF PROTECTION**

### **2.1 No Copyright Protection for Sports Events ‘as Such’<sup>3</sup>**

In EU law, copyright and related rights are protected through a two-tier system. On a first tier, copyright protection is recognised for authorial works, including original photographs, databases and computer programs; protection is afforded to authors.<sup>4</sup> On a second tier, related rights protection is recognised for a closed list of ‘other subject matter’: fixations of performances, phonograms, films (originals and copies), and press publications.<sup>5</sup> Protection is afforded to (respectively) performers, phonogram producers, producers of first fixations of films, broadcast organisations, and press publishers.<sup>6</sup>

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3. This section partly relies on prior work with Bernt Hugenholtz. See P. Bernt Hugenholtz et al., ‘Trends and Developments in Artificial Intelligence: Challenges to the Intellectual Property Rights Framework’, (IViR and JIIP 2020), Final Report for the European Commission.
4. See, e.g., Arts. 2–4 Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167 (‘InfoSoc Directive’), Art. 6 Directive 2006/11/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version) OJ L 372, 27.12.2006 (‘Term Directive’), Arts.1–2 Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (Codified version) (‘Computer Programs Directive’).
5. Depending on the legal qualification, it is arguable that (*sui generis*) databases can be included in this list.
6. See, e.g., Arts. 2–3 InfoSoc Directive and Art. 15 Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital

For the most part, what constitutes a work of authorship is not harmonised in EU legislative texts. The only explicit exceptions to this are computer programs, photographs, databases, and (possibly) works of visual art.<sup>7</sup> For these categories, the legal provisions at issue condition protection on the requirement that the work be original in the sense of expressing the ‘author’s own intellectual creation’.

Until 2009, it was generally accepted that outside the specific subject matter covered by the rules on computer programs, photographs and original databases, Member States were free to determine the concept of work of authorship.<sup>8</sup> After 2009, the CJEU seized on the legislative language mentioned in the earlier specific subject matter Directives to gradually harmonise the concept of work of authorship, extending it to all types of works. This judicial harmonisation process played out in a number of cases spanning different types of subject matter: *Infopaq*; *Football Dataco*; *SAS Institute*; *Premier League*; *Levola Hengelo*; *Funke Medien*; and *Cofemel*.<sup>9</sup>

In general terms, it emerges from these cases that subject matter may be protected by copyright if it is original in the sense that it is ‘the author’s own intellectual creation’, meaning in addition that the author must make personal creative choices that are expressed in the subject matter.<sup>10</sup> The application of this test by the Court has led to a somewhat low threshold for originality, which enables the protection of a broad array of subject matter, possibly including that resulting from any minimally original selection and arrangement thereof. Conversely, protection has only been explicitly rejected by the Court thus far in relation to individual words (*Infopaq*), sporting events as such (*Premier League*), and the taste of food in *Levola Hengelo* (at least at the current state of technology).

As argued elsewhere, these exclusions can be understood as flowing from the originality test.<sup>11</sup> By requiring that ‘the author was able to express his creative abilities in the production of the work by making free and creative choices’,<sup>12</sup> the originality test makes it necessary to identify the parameters of the creative choices. These parameters can be configured as a series of external constraints on the assessment of originality: rule-based, technical, functional, and informational.<sup>13</sup> The existence of such constraints reduces the author’s margin for creative freedom, sometimes below the originality threshold.

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Single Market and amending Directives 96/9/EC and 2001/29/EC (‘CDSM Directive’).

7. Art. 1(3) Computer Programs Directive; Art. 3(1) Database Directive; Art. 6 Term Directive; Art. 14 CDSM Directive (on works of visual art in the public domain).
8. Commission Staff Working Paper on the review of copyright, SEC(2004)995, p. 14.
9. CJEU, 16 July 2009, case C-05/08, ECLI:EU:C:2009:465, *Infopaq International (Infopaq)*; CJEU, 1 March 2012, case C-604/10, EU:C:2012:115, *Football Dataco*; CJEU, 12 May 2012, case C-406/10, EU:C:2010:259, *SAS Institute*; CJEU, 4 October 2011, Joined Cases C-403/08 and C-429/08, ECLI:EU:C:2011:631, *Football Association Premier League and Others (Premier League)*; CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, *Levola Hengelo*; CJEU, 29 July 2019, case C-469/17, ECLI:EU:C:2019:623, *Funke Medien*; CJEU, 12 September 2019, case C-683/17, ECLI:EU:C:2019:721, *Cofemel*.
10. See e.g., CJEU, *Levola Hengelo*, para. 36, and CJEU, *Cofemel*, para. 29.
11. Hugenholtz et al., *supra* note 4.
12. CJEU, *Funke Medien*, para. 19; CJEU, 1 December 2011, case C-145/10, ECLI:EU:C:2011:798, *Painer*, paras. 87–88.
13. Hugenholtz et al., *supra* note 4.

For our purposes, *ruled-based* constraints are the most relevant. They are expressed in the *Premier League* judgment, which excludes sporting events 'as such' from copyright protection. In this case, the Court clarifies that football 'matches themselves ... cannot be classified as works'.<sup>14</sup> This is because the subject matter at issue 'would have to be original in the sense that it is its author's own intellectual creation'.<sup>15</sup> As the Court states,

sporting events cannot be regarded as intellectual creations classifiable as works within the meaning of the Copyright Directive. That applies in particular to football matches, which are *subject to rules of the game, leaving no room for creative freedom for the purposes of copyright*.<sup>16</sup>

As a result, such events 'cannot be protected under copyright', being 'undisputed that European Union law does not protect them on any other basis in the field of intellectual property'.<sup>17</sup>

Whereas scholars may disagree on the extent to which a finding of originality may be excluded *de toto* for all sports events, after *Premier League* there seems to be little to no space available for such protection *under EU law*, at the very least as it relates to football matches. To be sure, this portion of the ruling raised concerns, especially among sports events organisers, that it would undermine their exclusivity-based business models, leading to calls for legislative action.<sup>18</sup> But those concerns do not appear justified, either because protection by copyright is normatively unwarranted below the threshold of originality, or due to the myriad alternative protection instruments available for sports events, as discussed below.

## 2.2 Some National Protection for Sports Events as Such

This is immediately clear from the *Premier League* judgment itself. After rejecting copyright protection of sports events as such, the Court is quick to point out that the 'unique character' of sporting events allows for the possibility that Member States may, in their national laws, provide for protection 'comparable' to that of copyright.<sup>19</sup> Subject to the requirements of EU law, this can be done for instance through an intellectual property (IP) regime or through 'protection conferred upon those events by agreements concluded between the persons having the right to make the audiovisual content of the events available to the public and the persons who wish to broadcast that content to the public of their choice'.<sup>20</sup>

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14. CJEU, *Premier League*, para. 96.

15. *Ibid.*, para. 97.

16. *Ibid.*, para. 98 (emphasis added).

17. *Ibid.*, para. 99.

18. Margoni, *supra* note 1, 387. See also *infra* at 2.4 and 3.3.

19. CJEU, *Premier League*, para. 100.

20. *Ibid.*, paras. 102–105 (cit. 102).

In other words, the Court opened the door for other (non-copyright) types of protection *under national law*, which may include related rights or special regimes.<sup>21</sup> These alternative regimes come in different flavours and shapes.<sup>22</sup>

One such category is often referred to as ‘house right’, a hybrid construction that merges legal entitlements derived from the property rights on the venue with contractual arrangements governing access and commercial exploitation of the venue and event.<sup>23</sup> The owner or exclusive user of such entitlements can then impose downstream conditions for the use and exploitation of the sports event on third parties, such as media companies or attendants.<sup>24</sup>

A different type of protection is afforded by *specific related rights* in relation to sports events. As noted, EU law contains an exhaustive list of related rights for certain beneficiaries. Although film producers and broadcasting organisations might enjoy some protection as it relates to recordings and transmissions of sports events, only performers could plausibly claim an interest in protection of their performances in the context of the sports event *as such*.

However, most national laws condition the protection of performers on performances *of a work*.<sup>25</sup> Since sports events ‘as such’ do not qualify as works of authorship, it follows that a performance of a sports event does not qualify for related rights protection. One notable exception is the Portuguese version of the event organiser’s right: the ‘*direito ao espectáculo*’. The legal basis for this right has changed over time, casting some doubt on its existence.<sup>26</sup> However, both influential Portuguese scholarship and ultimately the Portuguese Supreme Court have recognised the validity of the right on the basis of its customary nature and the need to reward the investment of organisers of sports events on a par with organisers of other events, such as concerts.<sup>27</sup> Other than Portugal, only France appears to recognise a specific legal entitlement consisting of exploitation rights over sports events.<sup>28</sup>

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21. Margoni, *supra* note 1, 389.

22. For a detailed description, see Panella and Firrito, *supra* note 1.

23. Margoni defines it as a ‘common hermeneutic construction’ used to encapsulate ‘the property based power to control admission (a *jus excludendi* alias from the sport event venue) and the contractual based faculty to establish entrance conditions.’ Margoni, *supra* note 1, 391. Citing Opinion of Advocate General Jaaskinen delivered on 12 December 2012 in Cases C-201/11 P, C-204/11 P and C-205/11 PUEFA, *FIFA v. European Commission*, paras. 33–45.

24. For further details, see Panella and Firrito, *supra* note 1. The Achilles heel of the ‘house right’ as regards effective protection is its *inter partes* effect, which does not extend to third parties, especially those in good faith. See Margoni, *supra* note 1, 392–393 (exemplifying with a third-party online platform used to transmit a football match by a user not authorised by the sports event organiser).

25. Margoni, *supra* note 1, 394–395.

26. See the detailed discussion in Margoni, *supra* note 1, 395–396. The surviving legal basis is found in Art. 117 of the Portuguese Copyright Act.

27. See in particular Portuguese Supreme Court, No. 4986/06.3TVLSB.S1, of 21 May 2009.

28. But see Panella and Firrito, *supra* note 1 (noting also that most Member States recognise some form of ‘domestic media rights’ for the ‘exploitation, by any media, of the controlled sports event’).

## 2.3 Protection for Recordings and Transmission of Sports Events

In addition to the above, EU copyright law recognises protection for recordings and transmissions of sports events. First, audio-visual recordings of sports events are subject to copyright protection if they meet the required threshold of originality, explained above. In fact, this relatively low threshold might not be so challenging for the sophisticated recording of major sports events, such as economically significant football matches at EU level. The live recordings of such events are subject to complex contractual arrangements with detailed technical descriptions and ample opportunity for creative choices at different stages of the production process.<sup>29</sup>

Even where a recording fails to cross the originality threshold, it may still benefit from related rights protection for the producer of the first fixation of films.<sup>30</sup> This form of investment protection is in addition to and independent of any copyright in the recording as an audio-visual work. In this case, the joint operation of the Rental and Lending Rights Directive and the InfoSoc Directive grants producers of first fixations protection that is similar to the protection enjoyed by authors, with the exclusion of the broad right of communication to the public (but including making available online).<sup>31</sup>

In addition, broadcasting organisations enjoy exclusive rights over fixations of their broadcasts of sports events, their communication to the public, making available online, and public distribution.<sup>32</sup> Again, these rights are in addition to and independent of copyright protection of the event being broadcast. Furthermore, such broadcasts are typically subject to detailed contractual arrangements specifying the rights and remuneration of all parties involved. The multiple tiers of protection available to broadcasting organisations are well illustrated in two CJEU cases. First, in *Premier League*, where the Court clarifies the range of copyright and related rights available to broadcasters in relation to their broadcasts, namely fixation, reproduction, and communication to the public.<sup>33</sup> Secondly, in *ITV Broadcasting*, where the Court looked at the near real-time distribution of television broadcasts over the internet,<sup>34</sup> concluding that the unauthorised live streaming by a third party over the internet of signals from commercial television broadcasters constitutes an infringement of their right of communication to the public.

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29. For a detailed argument, see e.g. Margoni, *supra* note 1, 397–400.

30. Art. 2(1)(c) Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (codified version) OJ L 376, 27.12.2006 ('Rental and Lending Rights Directive').

31. See Arts. 9(1)(c) Rental and Lending Rights Directive and 2(d) and 3(2)(c) InfoSoc Directive.

32. See: Arts. 7–9 Rental and Lending Rights Directive; Arts. 2(e) and 3(2) Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission OJ L 248, 6.10.1993, p. 15–21; and Arts. 2(e) and 3(2)(d) InfoSoc Directive.

33. CJEU, *Premier League*, paras. 147–207.

34. CJEU, 7 March 2013, case C-607/11, ECLI:EU:C:2013:147, *ITV Broadcasting*.

Finally, although the topic is outside the scope of this contribution, it should be noted that the transmission of sports events may enjoy a limited level of protection under national unfair competition law regimes, as well as ‘special forms of protection’ created ad-hoc in national laws.<sup>35</sup>

## 2.4 Failed Attempt for Related Rights Protection in the CDSM Directive

Against this rich tapestry of available legal forms of protection, there has nevertheless been a constant push for new rights for sport organisers in EU law. Perhaps the most prominent example of such a push came in the context of the legislative process of the CDSM Directive. Although the Commission’s original proposal did not contain any provision in this respect, the Legal Affairs (JURI) Committee advanced the following text for a new Article 12a on the ‘Protection of sport event organizers’:

Member States shall provide sport event organizers with the rights provided for in Article 2 [reproduction] and Article 3 (2) [making available] of Directive 2001/29/EC and Article 7 [fixation] of Directive 2006/115/EC.<sup>36</sup>

The provision aimed to introduce new exclusive related rights of fixation, reproduction and making available for sport event organisers. These new rights would be layered on top of existing copyright and related rights protection for sports events and transmissions described above, thereby elevating sports organisers to a standalone category of related rights holders in the *acquis*.

There is remarkably little information about the origin of Article 12a. Since it was not part of the initial Commission proposal, it was also not accompanied by an impact assessment. Despite that, Article 12a was narrowly adopted by the JURI Committee by majority vote,<sup>37</sup> before being dropped during the trilogue negotiations. Due to the obscure nature of these negotiations, it is difficult to ascertain the true reason for the rejection of the new right. The few reports available note *inter alia* the absence of a clear justification for a new right for sports organisers (unsurprising given the lack of an impact assessment), as well as the problems it would cause for otherwise lawful activities of fans at sports events.<sup>38</sup> Interestingly, however, Article 12a was subject to the following statement by the Commission in the final plenary debate:<sup>39</sup>

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35. Margoni, *supra* note 1, 405–414. See also the analysis by Ansgar Ohly elsewhere in this book.

36. See Amendments adopted by the European Parliament on 12 September 2018 on the proposal for a directive of the European Parliament and of the Council on copyright in the Digital Single Market (COM(2016)0593 – C8-0383/2016 – 2016/0280(COD))(1).

37. *Ibid.*

38. Julia Reda, ‘EU Copyright Reform Will Spell Disaster for Sports Fans’, *Julia Reda*, 9 April 2018, <https://juliareda.eu/2018/09/copyright-sports-fans/>, accessed 23 June 2021.

39. A8-0245/272, Statement of the Commission (20.3.2019), Declaration on Sports Events Organisers [https://www.europarl.europa.eu/doceo/document/A-8-2018-0245-AM-272-272\\_EN.docx](https://www.europarl.europa.eu/doceo/document/A-8-2018-0245-AM-272-272_EN.docx)

The Commission acknowledges the importance of sports events organisations and their role in financing of sport activities in the Union. In view of the societal and economic dimension of sport in the Union, the Commission will assess the challenges of sport event organisers in the digital environment, in particular issues related to the illegal online transmissions of sport broadcasts.

The subsequent political process eventually led to a study<sup>40</sup> and a report with recommendations to the Commission on the ‘challenges of sports events’ organisers in the digital environment.<sup>41</sup> This report states that although some national laws provide for ‘specific rights for sports events organisers in their legislation, including a new ‘neighbouring right’ to copyright’, ‘the creation in Union law of a new right for sports events organisers will not provide a solution as regards the challenges they face that arise from a lack of effective and timely enforcement of their existing rights’.<sup>42</sup> This rejection is confirmed in the follow-up 2021 European Parliament (EP) resolution with the same title.<sup>43</sup>

With this, the focus of the protection of sports organisers at EU level moves away from new rights to stronger enforcement measures in the digital environment.

### **3. ENFORCEMENT AVENUES**

#### **3.1 Blocking Injunctions**

In EU law, the principal legal basis for the enforcement of copyright as regards transmissions of sports events is found in Article 8 InfoSoc Directive.<sup>44</sup> Under this provision, Member States are required to adopt appropriate, effective, proportionate and dissuasive sanctions in respect of infringements of exclusive rights, technological protection measures and rights management information.<sup>45</sup> Member States must also ensure that right holders whose rights are affected in their territory bring actions for damages and/or apply for injunctions and

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40. Panella and Firrito, *supra* note 1.

41. Report with recommendations to the Commission on challenges of sports events organisers in the digital environment (2020/2073(INL)) Committee on Legal Affairs, Rapporteur: Angel Dzhambazki, A9-0139/2021, 23.4.2021, [https://www.europarl.europa.eu/doceo/document/A-9-2021-0139\\_EN.html](https://www.europarl.europa.eu/doceo/document/A-9-2021-0139_EN.html).

42. *Ibid.* paras. 23–24.

43. European Parliament resolution of 19 May 2021 with recommendations to the Commission on challenges of sports events organisers in the digital environment (2020/2073(INL)) ('EP Resolution Sports Events Organisers 2021'), paras. 23–24.

44. This provision implements the light obligations arising from the WIPO Treaties in this respect (Articles 14(2) WCT and 23(2) WPPT). The more detailed international provisions on enforcement laid out in TRIPS are implemented in the acquis by the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Enforcement Directive) [2004] OJ L157 ('Enforcement Directive').

45. Art. 8(1) InfoSoc Directive. NB additional obligations in this respect arise from the Enforcement Directive.

seizures.<sup>46</sup> Most relevant for our purposes, Article 8(3) obligates Member States to ensure that rights holders can apply for injunctions against intermediaries whose services are used by a third party to infringe copyright. This possibility should be available even if the intermediary is not itself directly liable for infringement.<sup>47</sup>

Article 8(3) InfoSoc Directive has played a significant role in the development of intermediary liability in the EU, in articulation with the liability exemptions or safe harbours in the e-Commerce Directive.<sup>48</sup> In particular, although it is up to national law to determine the scope and procedures to seek injunctions, the same is limited *inter alia* by the operation of fundamental rights recognised in the EU Charter. This implies that an injunction must strike a fair balance between conflicting fundamental rights in the Charter: to copyright as property, on the one hand (Article 17(2)); and to the protection of personal data and privacy of internet users, their freedom to receive information, and intermediaries' freedom to conduct a business (Articles 7, 8, 11 and 16) on the other.<sup>49</sup>

It is in the shadow of this legal regime and the Court's interpretation thereof that national laws have developed different flavours of blocking injunctions – static, dynamic and live – using several techniques and subject to varying legal requirements.<sup>50</sup> In some Member States, blocking injunctions are issued by administrative authorities, while in others they are issued pursuant to soft law arrangements, such as Codes of Conduct or self-regulatory measures.<sup>51</sup>

In this evolving landscape, rightholders in some Member States have been able to increasingly rely on *live* blocking injunctions (a subspecies of dynamic

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- 46. Art. 8(2) InfoSoc Directive. According to the CJEU, these provisions do not impose nor prevent member states from mandating Internet Service Providers (ISPs) to disclose personal data of their subscribers in the context of copyright infringement proceedings. See also CJEU, 17 June 2021, case C-597/19, ECLI:EU:C:2021:492, *M.I.C.M.*
- 47. See recital 59 InfoSoc Directive. NB Art. 8(3) remains applicable despite the existence of a provision on injunctions in Art. 11 Enforcement Directive, as clarified by recital 23.
- 48. See generally Martin Husovec, *Injunctions against Intermediaries in the European Union: Accountable but Not Liable?* (Cambridge University Press, 2017); Christina Angelopoulos, *European Intermediary Liability in Copyright: A Tort-Based Analysis* (Kluwer Law International, 2016). NB the availability of injunctions in the scheme of the e-Commerce Directive is clarified by Arts. 14(3) and 18(1).
- 49. For a description of the relevant case law, see e.g. Husovec, *supra* note 48; Christina Angelopoulos, 'Harmonising Intermediary Copyright Liability in the EU: A Summary' (Social Science Research Network, 2019) SSRN Scholarly Paper ID 3685863, <https://papers.ssrn.com/abstract=3685863>, accessed 26 May 2021; Christina Angelopoulos, 'Study on Online Platforms and the Commission's New Proposal for a Directive on Copyright in the Digital Single Market' (Greens/EFA Group 2017) Report, <https://www.repository.cam.ac.uk/handle/1810/275826>, accessed 28 May 2021; Giancarlo Frosio and Oleksandr Bulayenko, 'Website Blocking Injunctions in Flux: Static, Dynamic, and Live' 16 *Journal of Intellectual Property Law & Practice* (2021), <https://papers.ssrn.com/abstract=3848063>, accessed 23 June 2021.
- 50. Frosio and Bulayenko, *supra* note 49 (identifying the techniques of 'address blocking, Domain Name System (DNS) blocking, Uniform Resource Locator (URL) filtering, deep packet inspection, domain name-related measures, and ingress and egress filtering').
- 51. Frosio and Bulayenko, *supra* note 49. The authors provide as examples of the first the regimes available in Greece, Italy, Lithuania, and Spain; examples of the second are found e.g., in Denmark, UK, Germany and Finland.

injunctions) to prevent ‘illegal broadcasting of live (sports) events, including online transmission (internet protocol TV or IPTV)’.<sup>52</sup> In essence, these orders take effect at a specific period of time when a sports event is being broadcast, and allow for the recurrent, periodic and time-limited blocking of new servers to prevent continued infringements.<sup>53</sup>

Moreover, the available soft-law and self-regulatory measures in different countries are often used to issue blocking injunctions regarding sports events, mostly football matches. One prominent example is that of Portugal, one of the leading countries in the world in website blocking.<sup>54</sup> This status is the result of two Memoranda of Understanding (MoU). The first was signed on 30 July 2015 by some public bodies and private stakeholders in order to facilitate the blocking of copyright-infringing websites.<sup>55</sup> This was followed in December 2018 by a second MoU to facilitate the temporary blocking of illegal transmissions of sports events on the internet, especially of football matches.<sup>56</sup> The latter MoU provides a streamlined procedure for what are in essence live blocking injunctions for illegal streams of national football championship matches, with thousands having been ordered since its coming into force. One main point of criticism of the Portuguese scheme from the outset – amplified by its ongoing large-scale deployment – has been its secretive nature, which makes it difficult to assess the inherent risk that its potential for over-blocking poses to freedom of expression and due process online.<sup>57</sup>

### 3.2 Article 17 CDSM Directive

In addition to the above, it is important to note that Article 17 CDSM Directive provides some level of protection against unauthorised making available of sports events, despite it not aiming at preventing the illegal streaming of sports events.<sup>58</sup> In simple terms, Article 17 states that online content-sharing service providers (OCSSPs) carry out acts of communication to the public when they give access

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52. Frosio and Bulayenko, *supra* note 49. The Member States in question are Greece, Ireland, Spain, the Netherlands and the UK.

53. Frosio and Bulayenko, *supra* note 49.

54. See ‘Intervention of the Motion Picture Association of America Before the...’, <https://torrentfreak.com/images/mpa-can.pdf>. See also ‘Portugal: “Voluntary” Agreement against Copyright Infringements’ (*European Digital Rights (EDRI)*), <https://edri.org/our-work/portugal-voluntary-agreement-against-copyright-infringements/>, accessed 23 June 2021.

55. A copy of the MoU is available at: [http://www.apel.pt/gest\\_cnt\\_upload/editor/File/apel/direitos\\_autor/memorando\\_APTELIGAG\\_MAPINET.pdf](http://www.apel.pt/gest_cnt_upload/editor/File/apel/direitos_autor/memorando_APTELIGAG_MAPINET.pdf).

56. A copy of the MoU is available at: <https://www.direitosdigitais.pt/media/ficheiros/memorando2.pdf>.

57. EDRI, ‘Portugal: “Voluntary” Agreement against Copyright Infringements’ (*European Digital Rights (EDRI)*, 8 December 2015), <https://edri.org/our-work/portugal-voluntary-agreement-against-copyright-infringements/>, accessed 25 June 2021; EDRI, ‘Portugal: Privatised Copyright Law Enforcement Agreement Now Public’ (*European Digital Rights (EDRI)*, 9 September 2015), <https://edri.org/our-work/portugal-privatised-copyright-law-enforcement-agreement-now-public/>, accessed 25 June 2021.

58. Arguing for the limited use of Art. 17 CDSM Directive in this context, see Panella and Firrito, *supra* note 1.

to works/subject matter uploaded by their users. As a result, these providers become directly liable for their users' uploads. They are also expressly excluded in paragraph (3) from the hosting safe harbour for copyright relevant acts, previously available to many of them under Article 14(1) e-Commerce Directive.<sup>59</sup>

The provision then introduces a complex set of rules to regulate OCSSPs, including a liability exemption mechanism in paragraph (4), and a number of what can be referred to as mitigations measures and safeguards. The liability exemption mechanism is comprised of 'best efforts' obligations for preventive measures, including those aimed at filtering content *ex ante*, notice and stay-down, and notice and takedown.<sup>60</sup>

Sports events are protected at two levels in this provision. First, Recital 62 CDSM Directive clarifies that piracy websites can qualify as OCSSPs but are subject a stricter regime, since they cannot benefit from the special liability exemption mechanism in Article 17(4). In other words, such websites – including those dedicated to unauthorised dissemination of sports events – will be strictly liable once they fulfil the definition of OCSSP, without the possibility of any exemption.<sup>61</sup>

The second level of protection follows from the Commission's Guidance on Article 17, published in June 2021.<sup>62</sup> In this Guidance, the Commission states that automated content filtering or blocking in OCSSPs' platforms are only possible for two categories of content: 'manifestly infringing' and 'earmarked'. The latter category is a new concept advanced by the Commission to encompass content that, while not manifestly infringing, 'could cause significant economic harm to rightholders' and 'is particularly time sensitive (e.g. pre-released music or films or highlights of recent broadcasts of sports events)'.<sup>63</sup> Disregarding here the problematic nature of the concept, the upshot is that in relation to the uploading of recordings of broadcasts of sports events, the Guidance strengthens rights holders' level of protection by allowing them to 'earmark' content for automatic blocking on the platform of an OCSSP, without having to demonstrate its manifestly infringing nature.<sup>64</sup> In other words, should the Guidance be considered valid on

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59. The corresponding provision in the DSA proposal is Art. 5.

60. Art. 17(4) (b) and (c) CDSM Directive.

61. Martin Husovec and João Pedro Quintais, 'How to License Article 17? Exploring the Implementation Options for the New EU Rules on Content-Sharing Platforms under the Copyright in the Digital Single Market Directive', *GRUR International* (2021), <https://doi.org/10.1093/grurint/ikaa200>, accessed 3 May 2021.

62. COM(2021) 288 final (4.06.2021), Guidance on Article 17 of Directive 2019/790 on Copyright in the Digital Single Market ('EC Guidance Art. 17').

63. *Ibid.*, 23.

64. For early criticism, see Julia Reda and Paul Keller, 'European Commission Back-Tracks on User Rights in Article 17 Guidance', *Kluwer Copyright Blog*, 4 June 2021, <http://copyrightblog.kluweriplaw.com/2021/06/04/european-commission-back-tracks-on-user-rights-in-article-17-guidance/>, accessed 24 June 2021; Bernd Justin Jütte and Christophe Geiger, 'Op-Ed: "The EU Commission's Guidance on Article 17 of the Copyright in the Digital Single Market Directive" by Bernd Justin Jütte and Christophe Geiger', *EU Law Live*, 7 June 2021, <https://eulawlive.com/op-ed-the-eu-commissions-guidance->

this point, these rights holders benefit from preferential treatment in using the preventive measures in Article 17 CDSM Directive.

### **3.3 The 2021 European Parliament Resolution on Challenges of Sports Events Organisers in the Digital Environment**

The justification for the EP Resolution of May 2021 is the economic harm resulting from the illegal transmission online of live sports events.<sup>65</sup> It states that the value of such events lies in their live nature and that illegal streaming is ‘most harmful in the first thirty minutes of its appearance online’.<sup>66</sup> Whilst recognising existing enforcement measures in EU law, these are considered to ‘not always sufficiently guarantee an effective and timely enforcement of rights to remedy the illegal broadcast of live sports events’.<sup>67</sup>

The Resolution therefore calls on the Commission to take legislative action, advancing proposals for amendments to the Enforcement Directive and, to a lesser extent, some inclusions in the draft Digital Services Act (DSA).<sup>68</sup> On the latter, it appears to ignore its potential application to OCSSPs as online platforms, namely as regards rules on notice and action and trusted flaggers/notifiers.<sup>69</sup>

The main proposal is for new rules that enable ‘real time takedown’ of infringing live sport broadcasts by online intermediaries. Concretely, this would entail removal of, or the disabling of access to, such transmissions ‘no later than within thirty minutes [*from*] the receipt of the notification from rightholders or from a certified trusted flagger’.<sup>70</sup> This would entail, for instance, a legal clarification of the notion of acting ‘expeditiously’ upon receiving a notice in Article 14(1)(b) e-Commerce Directive, to the effect that providers would have to act within the thirty-minute time-frame.<sup>71</sup> One important weak spot in this proposal is that although it pays lip service to the need to avoid a general monitoring

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on-article-17-of-the-copyright-in-the-digital-single-market-directive-by-bernd-justin-jutte-and-christophe-geiger/, accessed 24 June 2021.

65. EP Resolution Sports Events Organisers 2021, *supra* note 43, 6. The text and recommendations of the resolution appears to rely heavily on the study by Panella and Firrito, *supra* note 1.

66. EP Resolution Sports Events Organisers, 2021, *supra* note 43, pp. 4, 6.

67. *Ibid.*, 6–7.

68. *Ibid.*, 12 (referring explicitly to amendments to the Enforcement Directive). Proposal for a Regulation of the European Parliament and of the Council on a Single Market for Digital Services (Digital Services Act) and amending Directive 2000/31/EC, COM/2020/825 final (DSA). NB that the Resolution does not go as far as the suggestion to adopt ‘an ad hoc EU Regulation which, while leaving unchanged the general enforcement regime envisaged by the Enforcement Directive, can put in place a specific legal instrument to aggressively tackle online piracy (a sort of “EU Antipiracy Act”), as suggested in Panella and Firrito, *supra* note 1.

69. On this topic, see João Quintais and Sebastian Felix Schwemer, ‘The Interplay between the Digital Services Act and Sector Regulation: How Special Is Copyright?’, <https://papers.ssrn.com/abstract=3841606>, accessed 9 May 2021.

70. EP Resolution Sports Events Organisers 2021, *supra* note 43, p. 6.

71. *Ibid.*, 11.

obligation<sup>72</sup> – which would be inconsistent with Article 15 e-Commerce Directive and Article 17(8) CDSM Directive – it provides few details as to how that would be possible.<sup>73</sup>

In addition, the Resolution calls for the introduction of injunction procedures in the Enforcement Directive around the model of ‘dynamic’ and ‘live’ blocking injunctions discussed above.<sup>74</sup> The rationale appears to be a push for further harmonisation of cross border enforcement of rights with measures that take into account the specific nature of live sports event broadcasts, leading to increased legal certainty for rights holders.<sup>75</sup> Still, the text offers little in the way of substantive and procedural safeguards to offset the potential risks arising from the introduction of such measures, including as regards fundamental rights of users and intermediary service providers.<sup>76</sup>

Finally, the Resolution endorses co- and self-regulation in this field, calling for cooperation between Member States, intermediaries and rightholders, including by promoting the conclusion of MoUs that could provide for a specific notice and action procedure.<sup>77</sup> Here, again, there is no discussion of potential (fundamental rights) risks which, as noted above, may arise from such mostly private enforcement mechanisms.<sup>78</sup>

#### 4. CONCLUSION

This contribution examined the protection of sports events by copyright and related rights in EU law, especially vis-à-vis unauthorised online transmissions. The portrait that emerges is one where sports events enjoy multi-tiered but fragmented protection. Different facets of the commercial exploitation are protected by copyright and related rights, and specific national legal regimes. Moreover, rights holders benefit from various enforcement measures, such as notice and action procedures, and blocking injunctions. While attempts to recognise new rights for sports organisers have thus far failed, there is a renewed impetus for the introduction in EU law of far-reaching ad hoc enforcement measures, targeted at unauthorised transmissions of sports events. Regrettably, these proposals neglect adequate substantive or procedural safeguards for due process and freedom of expression.

To be sure, there are legal gaps in the protection of sports events. But it is not obvious whether they should be filled by introducing new rights and enforcement measures in EU copyright law. Rather, there are strong arguments against

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72. *Ibid.*, 7.

73. On the topic of general monitoring at the intersection of IP law, the e-Commerce Directive and the DSA proposal, see Christina Angelopoulos and Martin Senftleben, ‘An Endless Odyssey? Content Moderation Without General Content Monitoring Obligations’ (IViR; CIPIL 2021), <https://papers.ssrn.com/abstract=3871916>, accessed 24 June 2021.

74. EP Resolution Sports Events Organisers 2021(n.43), pp. 8–10.

75. *Ibid.*, 6.

76. *Ibid.*, 8 (para. 22).

77. *Ibid.*, 12 (cit.), as well as p. 9, para. 25

78. See *supra* at 3.1

it. First, there is no plausible justification for why recordings or transmissions of a sports event that fail to meet the originality threshold should attract copyright protection. At the same time, as apparently recognised by the EU legislature, the introduction of a new related right for sports organisers, based on technological and financial investment, is unwarranted. As rightly noted by Bernt Hugenholtz in relation to the ‘obsolete’ phonographic, broadcasters’, and film producers’ rights before it, a new right for sports organisers would ‘not provide a threshold test and corresponding rule of scope’, making it ‘inherently unbalanced’.<sup>79</sup> If this is accepted, then it is doubtful whether ad hoc enforcement measures tailored specifically for sports organisers should be introduced in the EU *copyright* framework. In other words, if it is not justified to extend substantive copyright and related rights protection to accommodate the specific needs of sports events organisers, policy makers should consider with caution whether it is sensible to put in place stricter *copyright* enforcement measures tailored to those needs. This is particularly advisable where such measures carry risks to fundamental rights of third parties. ‘More copyright’ is not always the right answer.

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79. Hugenholtz, *supra* note 3.





# Exclusive Rights to Carnival Parades: In Comparison with Professional Football

Thomas Hoeren

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## 1. INTRODUCTION

Bernt is not only an avid football fan (of Ajax Amsterdam, of course), but also has a hidden passion for carnival. That's why I'm all the more pleased that I can do justice to both passions in his *Festschrift*. Are there exclusive rights to the German 'Rosenmontagszug'? Why is carnival something fundamentally different from football?

## 2. CARNIVAL

Since 1823, so-called Rose or Shrove Monday parades have been held in the centre of Cologne as part of the annual carnival days.<sup>1</sup> These parades are the main event of the Cologne Carnival. They take place outdoors; traditionally, everyone is free to watch the procession. As a result, no entrance fees are charged for participation in the procession. Since 1950, the number of spectators has always exceeded one million.<sup>2</sup> The procession is organised by the Festkomitee des Kölner Karnevals von 1823 e.V. (hereinafter: Cologne Carnival Festival Committee or Festival Committee), an association of all the larger Cologne carnival societies.<sup>3</sup> The Festival Committee sets a fixed motto for each procession. Individual floats are decorated according to this motto by order of the Festival Committee; there are elaborate backdrops, especially with political caricatures of the day. In addition,

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1. Cf. Peter Fuchs and M.L. Schwering & Klaus Zöller, *Kölner Karneval* (Greven Verlag, Cologne, 1987), 180.
2. Joseph Klersch, *Die Kölnische Fastnacht von ihren Anfängen bis zur Gegenwart* (J.P. Bachem Verlag, Cologne, 1961), 197.
3. On the membership structure, see Klersch, *supra* note 2, at 207 f.

individual floats, especially princes' floats, are decorated more simply. Bands of musicians and costume groups march between the floats. Today, about 8000 people take part in the 7 km long procession, including 85 music bands and about 70 groups with just as many festive and pageant floats.<sup>4</sup>

This 'people's festival', which costs<sup>5</sup> around EUR 1 million, is financially supported by the City of Cologne and the 'Great Senate of the Cologne Carnival', an association of business sponsors. In addition, the associations participating in the procession pay a flat fee to the Festival Committee, which also covers the loan of costumes by the Festival Committee. Since 1953, the Cologne Rose Monday procession has been broadcast on television by the Westdeutscher Rundfunk (WDR).<sup>6</sup> The content of the written agreements between the WDR and representatives of the Cologne Carnival are not known. What does the WDR pay for? Could other broadcasters record and transmit the parade on Shrove Monday to the public freely without entering into an agreement?

The recording and broadcasting of the procession could conflict with copyright and neighbouring rights of the parties involved.<sup>7</sup> A transmission of the Rose Monday procession to the public could interfere with a number of copyrighted positions (section 2.1), so that consent of the rights holders is required (section 2.2).

## 2.1 Intervention

In the context of the Shrove Monday procession, a number of performances worthy of copyright protection come into play:

- insofar as the motto of the procession is creatively implemented on individual floats, they could be works of visual art (§ 2(1) no. 4 of the German Copyright Act (hereinafter: Urheberrechtsgesetz or UrhG), for the copyright protection of which, according to the decision of the German Federal Supreme Court (hereinafter: Bundesgerichtshof or BGH) in *Birthday Procession*,<sup>8</sup> no higher requirements apply than for works of art without a specific purpose. From the point of view of the average observer who is appreciative of art,<sup>9</sup> these floats are regularly artistic achievements in which an individual statement is implemented with creative forms of expression. The situation is different for the floats that do not serve to implement the motto. Although these are lightly

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4. For figures, see Ilse Prass, *Treffpunkt Karneval* (J.P. Bachem Verlag, Cologne, 1995), 292.

5. Klersch, *supra* note 2, at 201.

6. Klersch, *supra* note 2, at 197.

7. Copyright issues are to be examined with priority over broadcasting law, at least as far as the right to short reporting is concerned; see Section 4(2).

8. BGH, Judgment of. 13.11.2013 – I ZR 143/12 = *GRUR* 2014, 175.

9. Cf. OLG Schleswig, Judgment of 12.02.1985 – 6 U 64/8 = *GRUR* 1985, 289 (291) – *Tonfiguren*; OLG München, Judgment of 18.09.1986 – 29 U 3498/85 = *GRUR* 1987, 290 (291) – *Wohnanlage*; Nicole Fallert, 'Definitionskompetenz – Wer entscheidet, was als Kunst gilt?', *GRUR* (2014), 719 (721).

decorated, the decoration is usually within the realm of usual and regular craftsmanship, so that copyright protection can be disregarded in this respect;

- disguises may also enjoy similar protection as works of visual art. This does not apply to standard uniforms which, as purely handcrafted, do not meet the originality requirements of copyright law. However, protection can be considered for individually designed costumes and masks, insofar as they are subject to copyright protection by reaching the requisite degree of free, creative choices;<sup>10</sup>
- the music played during the procession could also be relevant under copyright law. Here it depends on the individual circumstances of the case. Often a carnival hit is popular music for which the copyrights have already expired according to § 64 UrhG. However, there are also hit compositions which are still subject to copyright. In this case,<sup>11</sup> however, it must be noted that the rights of the television broadcast<sup>12</sup> are not administered by the composers (or their heirs) themselves, but by the German collecting society GEMA, which typically grants the broadcasting organisations the broadcasting rights based on framework agreements;
- insofar as a carnival song is or was eligible for copyright protection,<sup>13</sup> the carnival performers are to be regarded as performing artists within the meaning of § 73 UrhG;
- in addition, the Festival Committee could be classified as an organiser within the meaning of § 81 in conjunction with § 76(1) UrhG. According to these provisions, the radio broadcast requires not only the consent of the performing artist but also the consent of the owner of the company organising the performance. The committee has the organisational management and bears the economic responsibility. From this perspective, it is to be regarded as the organiser. The only question is whether the artistic performance must be in the foreground for § 81 UrhG to apply.<sup>14</sup> This is contradicted by a ruling of the Regional Court of Cologne, which subsumes an A-level ('Abitur' in German) party in a discotheque, at which only the reproduction of sound recordings with artistic perfor-

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10. Schricker, Loewenheim and Grünberger, *Urheberrecht* (6th edn., C.H. Beck, Munich, 2020), Section 73 UrhG marginal no. 16.

11. This applies, for example, to the compositions of Jupp Schmitz ('Es ist noch Suppe da'; 'Am Aschermittwoch ist alles vorbei'); Willi Ostermann ('Einmal am Rhein'), Jupp Schlösser ('Kornblumenblau') or the Bläack Fööss; see also Peter Fuchs and M.L. Schwering, *Kölner Karneval. Zur Kulturgeschichte der Fastnacht*, vol. 1 (Greven Verlag, Cologne, 1972), 100 and 154 ff.

12. § 1 lit. d) of the Deed of Assignment as amended on 24/25 May 2019, cited in 20 *GEMA Yearbook* (2019), 216 et seq.

13. For Section 73 UrhG, it is sufficient that the work would be worthy of protection under Section 2 UrhG; the fact that it later became public domain is not harmful. See Schricker, Loewenheim and Grünberger, *supra* note 10, at § 73 UrhG marginal no. 13.

14. In this sense Schricker, Loewenheim and Grünberger, *supra* note 10, at § 81 UrhG marginal no. 16.

mances took place, under the concept of event in § 81 UrhG.<sup>15</sup> In my opinion, however, this dispute can be left here. At the Shrove Monday procession, music is not merely an accessory; rather, the music played by participants in the procession is of central importance to the spectators. They come not only to see costumes and floats, but equally to hear the carnival music of the individual music groups. Therefore, the Festival Committee also enjoys ancillary copyright as the organiser of the musical performances;

- spectators and participants could invoke a right to their own image. In this case, however, it is to be assumed that § 23(1) no. 3 of the German Law on Copyright in Works of Fine Arts and Photography (hereinafter: Kunsturhebergesetz or KUG) applies, according to which images of meetings, processions and similar events in which the persons depicted have participated may be disseminated and displayed without their consent.

As a result, the WDR requires the consent of all the above-mentioned authors and ancillary rights holders for the broadcast of the procession. According to § 50 UrhG, an exception only applies to the area of short reporting. According to this provision, the transmission of works to the public is permitted to the extent required by the purpose. § 50 UrhG is interpreted narrowly as an exception provision to the extent that regularly only small extracts of the works presented may be broadcast.<sup>16</sup> Therefore, the right to short reporting does not cover the broadcasting of larger parts of the Shrove Monday procession.

## 2.2 Implicit Consent

Consequently, a broadcast outside of the short reporting privilege is only permitted if the authors of the floats, the costumes and the music as well as the performing artists have given their consent. No explicit declarations have been made in this regard. None of the parties concerned have so far – as far as it is known – commented on granting a simple broadcasting right to broadcasters other than the WDR. However, the parties involved could have implicitly – by the fact of their participation in the procession – waived the exercise of their rights with regard to communication to the public.

The Shrove Monday procession is a public event open to everyone in the open air. Those who take part in such an event want to be noticed by as many people as possible. They are not interested in transferring exclusive rights to an individual exploiter who may limit access to a more specific audience. Within the

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15. LG Köln, Judgment of 14.7.2010 – 28 O 93/09 = *ZUM* (2010), 906 (908).

16. BGH, Judgment of 1.7.1982 – I ZR 118/80 = *GRUR* (1983), 25 (27) – *Presseberichterstattung und Kunstwerk I*; OLG Frankfurt, Judgment of 20.9.1984 – 6 U 142/83 = *GRUR* (1985), 380 (382) – *Operneröffnung*; LG Hamburg, Urt. 24.6.1988 – 74 S 5/88 = *GRUR* (1989), 591 (592) – *Neonrevier*. Similarly Otto-Friedrich Freiherr von Gamm, *Urheberrechtsgesetz* (C.H. Beck, Munich, 1968), Section 50 marginal no. 6; Schricker, Loewenheim and Grünberger, *supra* note 10, Section 50 UrhG marginal no. 32.

framework of this folk festival, their costumes, their music, their floats should be seen and heard by everyone. Within the limits of existing moral rights, the works contained in the float may therefore be compared with works in the public domain, intended for direct perception by everyone. As the director of the WDR, Fritz Pleitgen, rightly explained to the press, the procession is ‘a public event on public streets ... , anyone can set up cameras’.<sup>17</sup> This attitude also corresponds to the regulation in the above-mentioned § 23(1) no. 3 KUG, according to which pictures of assemblies, processions and similar events may be disseminated and displayed without consent. This provision refers to the implied consent of every participant in public events: those who take part ‘must expect to be depicted in pictures of the event – together with other participants’.<sup>18</sup> However, only such depictions are permissible that show the procession as such and not only single individuals; it must be a representative section.<sup>19</sup> In the case of photographs of demonstration marches *von Münch* points out that the person who ‘wants to draw the public’s attention to his political views ... cannot at the same time demand to remain unrecognised’.<sup>20</sup> However, this view is not convincing when it is a matter of individual pictures of a person who merely wants to support the aims of the demonstration by taking part in it.<sup>21</sup>

Something else could result from the fact that the WDR pays for the broadcast. The agreements that have existed with the WDR for decades could be understood to imply that the Cologne Carnival Festival Committee only wants to conclude exclusive agreements in the copyright-relevant area with a single broadcaster. Irrespective of whether such an attitude on the part of the Festival Committee should not be interpreted as a *protestatio facto contrario* (see below), the content of the agreements between the Festival Committee and the WDR already speaks against such an interpretation. It is true that the content of the contracts is neither known nor accessible, especially since there have probably been verbal agreements up to now. But from the press one can learn something about the content of the agreements. For example, in a press release published in September 1995, the WDR spokesman Jürgen Bremer pointed out<sup>22</sup> that the WDR had ‘for a long time and successfully put together an overall carnival package’ with the Festival Committee. As part of this package, the WDR paid DEM 80,000 (the national German currency prior to the introduction of the euro) for various TV and radio broadcasts of carnival meetings.<sup>23</sup> Thus, neither the WDR nor the Festival Committee were concerned with the granting of exclusive rights to the

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17. Quoted from Peter Limbach, ‘Ausverkauf der kölschen Seele?’, *Kölner Stadt Anzeiger*, 14 September 1995.

18. Schricker, Loewenheim and Grünberger, *supra* note 10, § 23 KUG marginal no. 88.

19. Dreier, Schulze and Specht, *Urheberrechtsgesetz* (6th edn., C.H. Beck, Munich, 2018), Section 23 KUG marginal no. 40.

20. Ingo von Münch, ‘Die photographierenden Verfassungsschützer’, *JuS* (1965), 404 (406).

21. OLG Frankfurt am Main, Judgment of 21.4.2016 – 16 U 251/15 = ZUM-RD (2016), 573 (574f.).

22. Quoted from N.N., ‘Werbung, wenn der Zog ein Loch hat’, *Kölner Rundschau*, 15 September 1995.

23. See Stefan Volberg, ‘Fernsehschlacht, wer 1996 beim Zug kommt’, *Kölner Rundschau*, 13 September 1995.

Rose Monday procession in their agreements. Rather, the rights for carnival sessions were to be compensated; with regard to the Rose Monday procession, it was at most a matter of a ‘small assistance for the Festival Committee’.<sup>24</sup>

This view is also in line with a judgement of the Regional Court of Magdeburg, which assumed that when exclusive contractual rights are granted, the right to the pictorial marketing pursuant to §§ 22, 23 KUG cannot relate to an entire event, but only to individuals. In the underlying case, copyright protection of the event itself was out of the question.<sup>25</sup>

Finally, implied consent could be ruled out by the fact that the Cologne Carnival Festival Committee negotiated with another broadcaster – RTL – in autumn 1995 about granting ‘exclusive rights’ to broadcast the procession and ultimately broke off these negotiations in favour of the WDR. The fact that a refusal of consent can be inferred from the termination of negotiations presupposes, first of all, that the Festival Committee is responsible for granting rights of use. This seems problematic considering the absence of contractual agreements. However, one could argue in the light of § 31(5) UrhG that each contributor has impliedly assigned his or her rights of use to the respective carnival society and the latter, in turn, to the Festival Committee by virtue of its membership. Even if one relies on this implicit transfer for the purpose of bundling rights in the hands of the Festival Committee, however, the failure of negotiations does not mean a rejection with regard to the broadcast. The negotiations between RTL and the Festival Committee covered a special, privileged exclusive position of RTL in the broadcast. This would have made it possible for RTL to obtain special information about the line-up of the procession and the participants. At the same time, the Festival Committee could have been obliged to do its part to ensure that other broadcasters did not broadcast the procession. By breaking off the negotiations and concluding an agreement with the WDR, this ‘exclusive’ position was given to the WDR. However, the Festival Committee has not yet taken a position on how it views a general broadcast of the procession by broadcasters other than the WDR.

Finally, the implied consent could be thwarted by the fact that the Festival Committee explicitly rejects a transmission by RTL and tries to prevent it with all its might. In such a case, however, the rules of *protestatio facto contrario* would apply. It follows from this that ‘one cannot unilaterally withdraw from an obligation which one has assumed through other, regularly concluding conduct ... cannot be unilaterally discharged by declaration’.<sup>26</sup> According to case law, this rule also applies if the custody takes place before or in parallel with the implied conduct.<sup>27</sup> In fact, when interpreting implied declarations of intent, the will of

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24. Cited in the *Kölner Rundschau*, 15 September 1995.

25. LG Magdeburg, Judgment of 23.3.2006 – 7 O 2740/05 = *BeckRS* (2011), 11672.

26. Rietzler, *Venire contra factum proprium* (Duncker & Humblot, Berlin, 1912), 119. Cf. on this also Arndt Teichmann, ‘Die protestatio facto contraria’, in Hans-Martin Pawlowski and Franz Wieacker (eds.), *Festschrift für Karl Michaelis zum 70. Geburtstag* (Vandenhoeck & Ruprecht, Göttingen, 1972), 294 ff.

27. Thus already RG, Judgment of 29.9.1925 – VI 182/125 = *RGZ* 111, 310 (312); BGH, Judgment of 16.12.1964 – VIII ZR 51/63 = *NJW* (1965), 387 (388 f.); BGH, Judgment of 4.12.1967

the individual is not important; what is decisive is the typical meaning of the conduct from the point of view of the recipient of the declaration. Thus, as long as the organisers of the Shrove Monday procession go out in public with the participants, this behaviour can only be interpreted from the point of view of any broadcasting organisation to the effect that anyone can record the procession on video and audio media and communicate it to the public.

### **2.3      Interim Result**

It is true that a broadcast of the Shrove Monday procession encroaches on a number of rights of exploitation under copyright and neighbouring rights law. However, broadcasters that have not concluded an agreement with the Festival Committee, such as RTL, may nonetheless broadcast the Shrove Monday procession without the separate consent of the rights holders, in particular also against the will of the Festival Committee. The participants in the procession have impliedly consented to a broadcast by the fact of their participation. A ban on broadcasting by broadcasting organisations that have not entered into an exploitation agreement with the Festival Committee would be an irrelevant *protestatio facto contraria*.

## **3.      PROFESSIONAL FOOTBALL**

The situation is different in professional football. Here, the German football association (DFB) and the European football association (UEFA) claim exclusive authority to conclude contracts with television and radio broadcasters for television and radio broadcasts of football matches. As Hugenholtz pointed out in his comprehensive study on Sports Organisers' Rights in the EU, this is not only the case in Germany but throughout the EU.<sup>28</sup> But as strange as the question may sound, what are these 'broadcasting rights'? And if they exist, are they transferable?

### **3.1      Legal Nature of Broadcasting Rights**

The first problem can perhaps be solved easily. Referring to the judgement of the European Court of Justice (hereinafter: EuGH or CJEU) (*Football Association Premier League Ltd and Others v. QC Leisure and Others* (C-403/08) and *Karen*

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– VIII ZR 178/65 = WM (1968), 115 (117); AG Hamburg, Judgment of 3.10.1957 – 51 C 207/57 = MDR (1958), 241; Werner Flume, *Allgemeiner Teil des Bürgerlichen Rechts, Zweiter Band: Das Rechtsgeschäft* (Springer Verlag, Berlin, 1965), § 5/5; BGH, Judgment of 14.7.1956 – V ZR 223/54 = JZ (1957), 61 m. Franz Wieacker; *idem.*, 'Willenserklärung und sozialtypisches Verhalten', *Göttinger Festschrift für das Oberlandesgericht Celle* (Verlag Otto Schwartz und Co., Göttingen, 1961), 263, 268 ff.

28. Bernt Hugenholtz, *Study on Sports Organisers' Rights in the EU* (T.M.C. Asser Instituut/Asser International Sports Law Centre/Institute for Information Law – University of Amsterdam, 2014), 70.

*Murphy v. Media Protection Services Ltd* (C-429/08), marginal no. 96–99) sports clubs cannot claim copyright in football matches themselves, because they cannot be classified as works. Football matches are subject to rules, so that there is no room for an author's own intellectual creation as a condition for being protected under copyright. The same applies to plays by a team or moves by an individual player during the match. Furthermore sports clubs are not entitled to organiser rights within the meaning of § 81 UrhG, as these rights are limited to the organisation of music concerts.<sup>29</sup> The alleged 'broadcasting rights' are a consequence of a sports club's house rights, insofar as it is the owner of the stadium grounds pursuant to § 903 of the German Civil Code (hereinafter: Bürgerliches Gesetzbuch or BGB) and thus also of the stadium itself pursuant to §§ 93, 94(1) BGB.<sup>30</sup> As the owner, the club can exclude others from using the property according to § 903 BGB. This exclusive right also includes what the BGH<sup>31</sup> calls the 'natural prerogative of the owner' to 'claim for himself the commercial benefit that can be derived from his property, which is only accessible with his permission'. This gives rise to the right to injunctive relief under § 1004 BGB and the criminal offence of § 123 of the German Criminal Code (hereinafter: Strafgesetzbuch or StGB). The same applies to the right of possession (§§ 861, 862 BGB) which exists parallel to ownership; the holder of actual control of the property is authorised to prevent others from encroaching on his or her dominion without authorisation. In contrast, the construction of an established and exercised business which would be protected under § 823(1) BGB,<sup>32</sup> and the application of § 1 of the German Act Against Unfair Competition (hereinafter: Gesetz gegen den unlauteren Wettbewerb or UWG) are secondary in importance. The 'transfer rights' are primarily to be regarded as an exponent of (immovable) property rights. If a third party from outside were to be able to see into a stadium, this would not infringe the club's broadcasting rights. For example, an English court has found it unobjectionable for someone to rent standing room outside

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29. So also OLG München, Judgment of 20.3.1997 – 29 U 4573/96 = *NJW-RR* (1997), 1405 (1406); OLG Hamburg, Judgment of 11.10.2006 – 5 U 112/06 = *GRUR-RR* (2007), 181 (184); Dreier, Schulze and Dreier, *supra* note 19, § 81 UrhG marginal no. 3; Hugenholtz, *supra* note 28, at 30.
30. The wording of the BGH, which speaks of ownership of the 'venue', is imprecise; see, for example, BGH, Judgment of 14.3.1990 – KVR 4/88 (KG) = *NJW* (1990), 2818. The Dutch Hoge Raad also assumes ownership in the *KNVB/Nos* judgement, see *NJ* (1988), No. 310 with comment by Wicher Hoeth = *GRUR Int.* (1988), 784 and m. discussion by Ruijschnars, *GRUR Int.* (1988), 764ff., Hugenholtz, *supra* note 28, at 25 ff.
31. BGH, Judgment of 20.9.1974 – I ZR 99/73 = *NJW* (1975), 778 = *JZ* (1975), 491 with comment by Baur. Critically, however, Gerauer, 'Der Unterlassungsanspruch des Eigentümers bei gewerblichem Fotografieren', *GRUR* (1988), 672; OLG Frankfurt am Main, Judgment of 11.2.2019 – 16 U 205/17 = *GRUR-RR* (2019), 422.
32. Thus BGH, Judgment of 29.4.1970 – I ZR 30/68 = *NJW* (1970), 2060, which, however, focuses narrowly on the operational nature of the interference and restricts this narrowly to organisational work.

the stadium with a view of the stadium.<sup>33</sup> The same would apply if someone were to record a football match from a helicopter.<sup>34</sup>

The BGH,<sup>35</sup> therefore, rightly summarises that the organiser's permission to televise a sporting event 'does not constitute a transfer of rights in the legal sense, but rather consent to interventions, which the organiser could prohibit on the basis of the aforementioned legal positions'. This approach has become established case law of the BGH.<sup>36</sup>

### **3.2 Legal Nature of the Transfer of 'Transmission Rights'**

Consequently, transfer rights are not about the granting of rights of use in the sense of the classical dogmatics of intellectual property law. Rather, the dispute is about the scope of material rights of dominion. On the face of it this is surprising because the contracts which the DFB concludes with television broadcasters are written in the terminology of intellectual property law and give the impression of dealing with the transfer of powers relevant to copyright or at least ancillary to copyright.

In the background, however, the much more important question arises as to why the DFB should be the holder of 'broadcasting rights'. This would presuppose that the consent of individual sports clubs to an encroachment on their domiciliary rights as transferable to third parties. In the literature on sports law, life is made easy. If the question of transferability is addressed at all, it is stated succinctly: 'This position is transferable and subject to economic traffic; the organiser issues a licence'.<sup>37</sup> As will be shown below, this statement does not correspond to legal reality.

#### **3.2.1 Transfer of the Rights to Injunctive Relief?**

It is easy to clarify in advance that the claims for injunctive relief under §§ 862, 1004 BGB cannot be assigned to the DFB or UEFA. This is the case because these claims are inextricably linked to possession or ownership and therefore cannot be assigned independently. The DFB is also not entitled to assert claims

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33. *Victoria Park Racing and Recreation Grounds Co. Ltd. v. Taylor* (1937) 58 CLR 4798. See also Kevin Gray, 'Property in Thin Air', 40(2) *Cambridge Law Journal* (July 1991), 252, 264 ff., and the contribution of Ansgar Ohly elsewhere in this volume. However, see also the different approach taken by US District Court of Pennsylvania, 24 F Supp. 490 (1938), *Pittsburgh Athletic Co. C. KQV Broadcasting Co.*

34. See BGH, Judgment of 9.3.1989 – I ZR 54/87 = *NJW* (1989), 2251; OLG Bremen, Judgment of 27.1.1987 – 1 U 58/86 (a) = *NJW* (1987), 1420; OLG Oldenburg, Judgment of 12.10.1987 – 13 U 59/87 = *NJW-RR* (1988), 951; OLG Celle, Judgment of 28.9.1979 – 13 U 86/79 = *MDR* (1980), 311.

35. BGH, Judgment of 14.3.1990 – KVR 4/88 = *NJW* (1990), 2815 (2817).

36. BGH, Judgement v. 8.11.2005 – KZR 37/03 = *NJW* (2006), 377 (379); BGH, Judgment of 28.10.2010 – I ZR 60/09 = *ZUM* (2011), 494 (496).

37. Martin Stopper, *Ligasport und Kartellrecht* (Erich Schmidt Verlag, Berlin, 1997), 78; Also proven as common approach in Hugenholtz, *supra* note 28, at 70 ff.

for protection of possession as an indirect owner. According to § 868 BGB, this would require that the DFB is connected to the football clubs by an intermediary possession relationship that secures the DFB a claim for restitution against the club and the club a temporary right of possession comparable to a loan or lease. However, the situation is at best the other way round: the DFB acts for a limited period of time; if at all, the club has a claim to surrender. The reverse is also not the case. The DFB is not to be seen as a direct third-party owner in relation to the football club. This is because direct control over the stadium remains with the relevant club.

### **3.2.2 Transfer of Consent?**

The claims mentioned so far are characterised by the fact that they refer to the possibility of consent as a ground for justification. Thus, consent could also be the subject of the transfer of rights between the DFB and the football club, as is sometimes argued in the literature.<sup>38</sup> Consent in rem is not to be confused with the consent mentioned in § 183 BGB.<sup>39</sup> The latter is a legal transaction, the former is not. Consent to legal interests in rem is always highly personal. At most, in the case of minors or organs of legal persons, it could be considered to apply the law of representation.<sup>40</sup> This also applies to § 858(1) BGB which is based exclusively on the will of the direct owner.<sup>41</sup> Representation can only be considered there if the acquisition of ownership takes place through a legal transaction (i.e. in the case of §§ 854(2) and 870 BGB).<sup>42</sup> In the present case, such a construction is therefore out of the question; the consent itself cannot be the subject of legal transactions.

### **3.2.3 Authorisation Based on Application of § 185(1) BGB by Analogy?**

However, it would be conceivable to authorise the club to take legal action in its own name, provided that the authorised party can prove that it has an interest in taking legal action.<sup>43</sup> In this respect, the granting of 'broadcasting rights' could be reinterpreted as an authorisation to assert injunctive claims of the individual

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38. Without further justification, for example, Jörg Rodelwald, 'Die Bilanzierung von Rechten zur Berichterstattung und Übertragung von Sportereignissen im Fernsehen', *BB* (1995), 2103 (2104): 'Consent in the sense described above is a suitable object of a contract of sale ...'
39. Erman and Schiemann, *BGB*, vol. 2 (14th edn., ottoschmidt, Cologne, 2014), § 823 BGB marginal no. 147.
40. BGH, Judgment of 16.11.1971 – VI ZR 76/70 = *NJW* (1972), 335; Kothe, 'Die rechtfertigende Einwilligung', 185 *AcP* (1985), 105 ff.
41. Soergel and Stadler, *BGB*, vol. 14 (13th edn., Kohlhammer, Stuttgart, 2002), § 858 BGB marginal no. 9.
42. Staudinger and Gutzeit, *BGB, Sachenrecht*, vol. 3 (Sellier & de Gruyter, Berlin, 2018), § 854 BGB marginal no. 52.
43. RG, Judgment of 14.3.1941 – II B 7/40 = *RGZ* 166, 283; BGH, Judgment of 14.2.1952 – IV ZR 137/51 = *BGHZ* 5, 164.

football club, for example under § 1 UWG. However, such an interpretation fails to take into account the scope of the agreements between the DFB and the individual football clubs. These agreements are not intended to authorise the DFB to assert claims by way of legal action. Rather, the DFB is to be granted a substantive power which also, and in particular, includes the marketing of the so-called 'sports rights'. Moreover, the current agreements do not assume that the DFB administers third-party rights, but rather acts as the owner of its own derived rights when marketing them. For this reason, the classification as a litigant does not do justice to the will and the interests of the parties.

Hausmann<sup>44</sup> sees an analogous application of § 185(1) BGB as justified on other grounds. He refers to § 3 no. 2 of the DFB's Statute for Licensed Players and sees this as a binding authorisation under association law to exercise the right of consent. However, this seems questionable for several reasons: the granting of consent in the sense of §§ 862, 1004 BGB does not involve a disposition. Moreover, it is not possible to rely on the analogous applicability of § 185 BGB in the case of a transfer of possession. It is true that the prevailing opinion also applies § 185 BGB to the case where a non-entitled person grants rights of possession and use to objects.<sup>45</sup> In the present case, however, precisely no rights of use are granted, but at most the assertion of prohibition claims is waived. This non-action is not to be equated with the positive allocation of rights of use. Moreover, Hausmann's construction would amount to undermining the binding of possession to the owner's will to possess and, in parallel that of ownership to the owner's will to own.

### **3.2.4      *Contract for the Benefit of Third Parties***

A solution will only be found by observing the specific requirements of possession and property law. With regard to an obligation to tolerate under § 1004 BGB, reference could be made to the agreement between the DFB and the football club. This agreement, as a contract of acquiescence under the law of obligations, excludes the illegality of future encroachments (§ 1004(2) BGB). However, in order for a third party, in particular a broadcaster, to derive rights from it against the football club, the agreement would have to be a contract for the benefit of third parties within the meaning of § 328 BGB. In this case, however, the third party must at least be identifiable at the time of the conclusion of the contract.<sup>46</sup>

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44. Friedrich Ludwig Hausmann, 'Der Deutsche Fußball Bund (DFB) – Ein Kartell für "Fernsehrechte"?' , *BB* (1994), 1089 (1092).

45. Cf. RG, Judgment of 15.9.1912 – Rep. III 309/12 = *RGZ* 80, 395 (399); OLG Karlsruhe, B. v. 10.2.1981 3 RE-Miet 1/81 = *NJW* 1981, 1278; Frank Bayreuther, *Münchener Kommentar Bürgerliches Gesetzbuch* (8th edn., C.H. Beck, Munich, 2018), § 185 BGB Rn. 8; Soergel and Leptien, *BGB*, vol. 2 (13th edn., Kohlhammer, Stuttgart, 1999), § 185 BGB marginal no. 9; Karl-Heinz Gursky, 'Kündigungsschutz zwischen Wohnungseigentümer und Untermieter', *JR* (1983), 265; Ekkehart Reinelt, 'Der Räumungsschutz des gutgläubigen Untermieters', *NJW* (1984), 2869.

46. BGH, Judgment of 17.1.1985 – VII ZR 63/04 = *BGHZ* 93, 274; BGH, 16.11.2007 – V ZR 208/06 = *NJW-RR* (2008), 683 (684); BGH, Judgment of 5.3.2015 – IX ZR 133/14 = *NJW*

A determination on the basis of factual moments – for example in favour of the relevant owner of a certain plot of land – is permissible;<sup>47</sup> here a resolutory condition is coupled with the contract in favour of third parties.<sup>48</sup> However, at least the factual category as such must be sufficiently determined. However, this is not the case at the present time, since all the DFB's regulations merely provide that the DFB is the owner of the transfer rights, without containing regulations on the specifics of the further transfer of this right. The Statute for Licensed Players assumes that the DFB is the original holder of the broadcasting rights and that a contract is not already concluded in favour of third parties in the relationship between the football club and the DFB. This intention of the parties can hardly be disregarded – even in the context of a reinterpretation. Moreover, the construction of § 328 BGB is not applicable with regard to the football club's ownership claims. Thus, the assumption of a contract in favour of third parties is not very convincing.

### **3.2.5 Assignment of the Claim to Acquiescence**

A singular succession is also permitted within the framework of § 823(1) and § 1004 BGB in the form that the contractually anchored claim to acquiescence is assigned to third parties.<sup>49</sup> However, this construction does not apply within the framework of claims for protection of possession. Moreover, the number of creditors of the claim to acquiescence would multiply in the case of several exploitations of rights. It would no longer be possible for the individual football club as a debtor to determine who is actually the creditor of the claim to acquiescence and to what extent. In my opinion, this cannot be justified in terms of assignment law.

The construction of an advance consent of the football club comes into consideration for all bases of a claim. The club agrees in advance to tolerate the broadcasting activities in the stadium of any broadcaster named by the DFB. Thus, for example, within the framework of § 858 BGB, the offence of prohibited interference with one's own power exists if the interferer acts without the owner's will. The same also applies in the context of § 1004 BGB, where actual consent also excludes the illegality of the interference.<sup>50</sup> However, both the owner's and the owner's consent can be revoked at any time. At most, a commitment can be justified via § 242 BGB in the case of special circumstances of trust. The same applies to consent under § 823(1) BGB. Here, at least in the case of consent to violations of property rights, an analogous application of § 183, sentence 1 BGB

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(2015), 1672 (1676).

47. BGH, Judgment of 3.3.1983 – III ZR 93/81 = *BGHZ* 87, 78 f.; similarly already RG, Urt. 3.5.1930 – V B 6/30 = *RGZ* 128, 246; See also Erman and Westermann, *BGB*, vol. 1 (14th edn., ottoschmidt, Cologne, 2014), § 328 BGB marginal no. 6.

48. RG, Judgment of 31.3.1930 – VI 599/29 = *RGZ* 128, 346.

49. Erman and Ebbing, *BGB*, vol. 2 (14th edn., ottoschmidt, Cologne, 2014), § 1004 BGB marginal no. 45.

50. Cf. Erman and Ebbing, *supra* note 49, at § 1004 BGB marginal no. 32; on this also BGH, Judgment of 11.11.2014 – VI ZR 9/14 = *NJW* (2015), 1450.

is advocated.<sup>51</sup> Thus, consent is freely revocable until the act is performed (§ 183, sentence 1 BGB). However, the irrevocability may exceptionally result from the legal transaction underlying the consent or from an express and tacit waiver of revocation by the consenting party.<sup>52</sup>

So far, the focus of the analysis has been on in rem solution models. However, a purely contractual approach would also be conceivable. In this case, the club would commit itself to the DFB under the law of obligations to tolerate the disturbance of possession or ownership by the DFB and anyone appointed by the DFB. The DFB would thus have a claim to acquiescence to the effect that the club is obliged not to make use of its existing rights of defence. The association would then not be prevented from continuing to exercise its rights of defence against everyone. However, the club would then be in breach of contract with the DFB and would have to compensate the DFB for this breach of contract.

### 3.3 Consequences for Antitrust Practice

These dogmatic considerations only prove their importance when it comes to the question of how the marketing of broadcasting rights is to be organised in the future in a way that complies with the requirements of cartel law. In the decision *Europapokalheimspiele*, the BGH put an end to the consideration of the law of obligations as set out above under section 3.2.5.<sup>53</sup> It would therefore have to be examined whether the other approaches – orientated towards property law – are more helpful in terms of antitrust law. In its decision, the BGH assumes, without explicitly mentioning this, that the marketing of the ‘broadcasting rights’ by the football clubs is in the interest of the ‘buyers’.

In the more recent *Hörfunkrechte* ruling on radio broadcasting rights for football matches, the BGH did not have to deal with the transfer of broadcasting rights, as the plaintiff, a private radio broadcaster, already demanded that the football clubs grant it the opportunity to broadcast the football match via radio.<sup>54</sup> In the *Hartplatz-Helden.de* ruling, the BGH did not deal with the question of whether and in what way the broadcasting rights to the amateur football match were transferred to the Württemberg Football Association either, as the latter did not claim a violation of the house right.<sup>55</sup>

The consideration of an antitrust analysis is of central importance. Thus, decentralised marketing by the football clubs in the marketing interest of the association which ensures central, fiduciary coordination by the DFB would be ideal for all parties involved. In order to realise this goal, § 183, sentence 1 BGB could now prove to be a central point of departure. This provision allows the club to consent to the marketing of the ‘broadcasting rights’ via the DFB, but at

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51. Erman and Schiemann, *supra* note 39, at § 823 BGB marginal no. 147.

52. Erman and Maier-Reimber, *BGB*, vol. 1 (14th edn., ottoschmidt, Cologne, 2014), § 183 BGB marginal no. 6.

53. BGH, Judgment of 11.12.1998 – KZR 7/96 = *ZUM* (1998), 155 (157).

54. BGH, Judgment of 8.11.2005 – KZR 37/03 = *NJW* (2006), 377.

55. BGH, Judgment of 28.10.2010 – I ZR 60/09 = *ZUM* (2011), 494 (496).

the same time guarantees the autonomy of the clubs through the element of free revocation. The DFB's regulations could therefore be amended to the effect that the individual club authorises the DFB to assert 'broadcasting rights' but retains the right of revocation until a corresponding contract is concluded. One will have to wait and see whether the DFB and the German football clubs consider such alternatives. In any case, legal creativity is required to organise the marketing of football rights as efficiently and at the same time as competitively neutrally as possible in the interest of all parties involved.

#### **4. CONCLUSION**

The result of the foregoing analysis may come as a surprise. There are property rights to the Rose Monday procession with regard to individual scales and costumes, but the participants have tacitly waived them. The football clubs claim broadcasting rights, but these are difficult to justify. In professional football, copyright protection is sought in vain. For Bernt, the news may be hard to digest. In any case, Ajax Amsterdam totally deserves to take a bow in terms of creativity and football.

# Organisers of Sport Events: A Neighbouring Right?

*Antoon Quaedvlieg*

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## 1. INTRODUCTION

For decades, Bernt Hugenholtz and his publications have served as a lighthouse offering a beacon to IP sailors on the ocean. Bernt has an infallible nose for important new developments and used to be one of the first to put them on the agenda. His retirement means that a name of great reputation takes its leave from the University.

It has always been an extraordinary pleasure to meet Bernt at home or abroad, to exchange ideas with him, to share a beer. His conversation invariably was witty and spicy.

Bernt was critical however as to the creation of new exclusive rights and the extension of the term of protection of existing ones. For a long time therefore, it worried me that the following opinion, which proposes the creation of *two* new rights, might be a farewell present of a rather dubious character. It finally occurred to me that it might equally please him. Whereas it is found that the creation as such of exclusive rights for athletes as well as for sports organisers can be agreed upon, this creation will inevitably be preceded by a critical assessment as to the scope that should be given to the right as well as its duration. As a consequence, the exclusive right to possibly grant may be much slimmer than the potential scope of the right presently invoked (and granted) under various titles. Only that gives me the courage to propose a neighbouring right for sports organisers.

Two leading studies about the protection of sports organisers rights have been published in the EU since the turn of the new century: one from the prominent German authors Reto Hilty and Frauke Henning-Bodewig and another, eight years later, from the Asser Institute and IViR. Much more has been published

concerning this problem;<sup>1</sup> this contribution however will focus mainly on the content of the two reports mentioned.

## 2. THE GERMAN REPORT OF 2006

In 2006, Reto Hilty and Frauke Henning-Bodewig wrote the working paper *Rechtsgutachten 'Leistungsschutzrecht für Sportveranstalter'*. Their advice strongly promotes the introduction of a new regime for the protection of the investments of sports organisers against use by third parties.

The authors state that although, in practice, it has become widespread to speak of an organiser's right, legally speaking, such a right does not exist.<sup>2</sup> When an organiser's right is mentioned, in reality it refers to a 'conglomerate' of relief constructions which go beyond the core problem. These relief constructions may combine actions based on either ownership (the 'house right' in the stadium), on unfair competition law, or on contractual arrangements. In this last case, the contract only has binding power between the parties. As a consequence, the present constructions could either lead to a level of protection that would be too high, or to one that would be suboptimal.<sup>3</sup> An example is given of the right of radio broadcasting based on the property of the stadium. In the present situation, this right is based on the house right, whereas from a legal point of view, it is very much the question of whether the property in the venue could or should serve as a basis for an exclusive right concerning the provision of information.<sup>4</sup>

Consequently, the protection provided by the present system is inadequate, and may thereby cause market failure by disturbing the balance between free competition and the protected domain, or lead to a situation which goes against the principle of systemic clarity as well as legal certainty.<sup>5</sup> The creation of a new IP right must be preferable. The study finds that where the use of relief constructions leads to a risk of distortion of the legal system, this will in itself provide justification for the creation of an IP right.

Nonetheless, the creation of a new form of protection by IP rights is subject to a number of basic conditions. Here, some elements of the reasoning may raise questions. Let us follow the reasoning in the Report.

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1. See inter alia Isabel Kainer, *Sportveranstalterrecht – Ein neues Immaterialrecht?* (Mohr Siebeck, 2014); Thomas Margoni, 'The Protection of Sports Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection', *IIC* (2016), 386–416; Peter P. Heermann, 'Leistungsschutzrecht für Sportveranstalter de lege ferenda?', *GRUR* (2012), 791–799; *idem.*, 'Neues zum Leistungsschutzrecht für Sportveranstalter', *GRUR* (2015), 232–240.
2. Reto Hilty and Frauke Henning-Bodewig, Working Paper *Rechtsgutachten 'Leistungsschutzrecht für Sportveranstalter'* (2006), 64.
3. *Ibid.*, 51, 64, 82–84.
4. *Ibid.*, 42–43, 48, 51 are reticent about this and, in the end, rather negative, although it is acknowledged that 'specific aspects' of the entrepreneurial performance of the organiser of a sports event may satisfactorily be protected by the 'house right' (p. 43). The IViR Report is much more optimistic in this regard; see para. 1.2.1 p. 25–27; p. 60; p. 178.
5. Hilty and Henning-Bodewig, *supra* note 2, 83 ff., also 88.

## **2.1 Condition of Important Investments Made**

The Report deals extensively with the aspect of investments made in the organisation of sporting events. It states that the organisation of sports matches presupposes actions of considerable commercial value, in terms of financial and organisational investment, the provision of professional workers, freelancers, etc.<sup>6</sup> Although it is a condition therefore that investments of considerable importance must have been made,<sup>7</sup> this alone will not justify the creation of an IP right, however high these investments might be. Apart from this, the object of protection must serve the public interest, as will be discussed next.

## **2.2 The Public Interest of Sports Activities**

An exclusive right has always to be in the general interest.<sup>8</sup> In the case of the organisers of sports events, the Report stresses the symbiotic relationship between professional and amateur sports;<sup>9</sup> both need each other. These efforts are in the general interest. Sports events are highly esteemed in public life; they are the object of communication; and, in sum, they form part of 'public policy issues'. Sports are an important factor in entertainment; they stimulate cultural identity and integration; popular and amateur sports promote health care and help prevent sickness. In all these and in other factors, there is a strong relationship between professional activities and activities at amateur (non-professional) level.

Nonetheless, a question arises. Most of the social benefits of sports seem to result from efforts made at the level of amateur sports involving a range of the population, whereas the protection of sport events might mainly be in the interest of the organisation of professional matches. Will the symbiotic relation between the two suffice to justify that protection? The Report itself seems to leave room for doubt, finding that there is insufficient concrete evidence that the creation of an IP right for organisers of sports events would foster aspects of the sports that fire general interest, such as sports at general and amateur level and the employment of young people.<sup>10</sup>

## **2.3 The Risk of Market Failure**

The concept of general interest is in particular defined by rules of EU law. While there is a wide range of imperative grounds of general interest, the Report considers that in the first place, imperative grounds are commercial grounds, especially the freedom and fostering of competition.<sup>11</sup> It states that the justification of IP rights is mainly sought in their function of providing an incentive. At

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6. *Ibid.*, 78 ff.

7. *Ibid.*, 74.

8. *Ibid.*, 75; 89.

9. *Ibid.*, 78–80.

10. *Ibid.*, 83.

11. *Ibid.*, 75.

the same time, the ‘incentive theory’ is not uncontroversial; it has for example been criticised by the European Commission.<sup>12</sup> The study concludes that the mere assumption that an exclusive right might enhance investment is no longer sufficient. New forms of protection will only be justified if without these new exclusive rights market mechanisms are not able to guarantee that investment in the general interest is sufficiently made.<sup>13</sup> A condition for the creation of a new IP right is therefore that, in the absence of such right, *market failure* may occur.<sup>14</sup>

As to the question of whether the creation of an IP right serves the public interest, the German study lays great emphasis on the question of whether the exclusive right is necessary in order to prevent market failure. In this respect, this is the decisive element. The Report very much deals with it as an independent condition, although it follows from the condition that the investments must be in the public interest.

A market failure will happen in one of two situations. Either the existing protection is insufficient, thereby causing a risk that there will be no investments in the general interest; or the protection that is provided relies on norms providing too much or inadequate protection. Only this second element is finally found to apply in the case of sports organisers. The two forms of market failure are now dealt with in detail.

### **2.3.1     *Market Failure by Absence of Investment***

Insufficient legal protection creates the risk that investments in useful achievements are not made, although they would be in the general interest. This is the case where achievements realised at the cost of considerable investment can be copied by third parties at a fraction of those costs, which would enable those third parties to compete with first investor on much better (cheaper) conditions.<sup>15</sup> Thus, a benefit would be granted to parties who do not engage in the development of new products but simply copy products of others once these have proven to be successful. In principle, the Report seems to confirm the existence of this danger.<sup>16</sup> An example is given of the broadcasting of a sports event by television, the costs of which will be minor in comparison to the costs involved in organising the

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12. *Ibid.*, 76 and 83, referring to statements made in the ‘First evaluation of Directive 96/9/EC on the legal protection of databases’ of 12 December 2005.

13. *Ibid.*, 76.

14. In this regard, Hilty and Henning-Bodewig, *supra* note 2, refer to Hilty, ‘Leistungsschutz – made in Switzerland? Klärung eines missverständnisses und Überlegungen zum allgemeinen Schutz von Investitionen’, in *Festschrift Ullmann* (2006); and Stanley M. Besen and Leo J. Raskind, ‘An Introduction to the Law and Economics of Intellectual Property’, 5 *Journal of Economic Perspectives* (1991), 5. Whereas here the emphasis is laid on economic factors, the question could be justified as to whether this justification sufficiently takes into account sociological and even psychological factors; but that is a question which might concern research in IP as a whole. The reasoning based on market failure will for the moment be followed here but it is not certain that it could not turn out, one day, to be somewhat one sided.

15. Hilty and Henning-Bodewig, *supra* note 2, 77.

16. *Ibid.*, 80–81.

event itself. Likewise, the merchandising of fan products or the free use of match schedules for the purpose of betting activities will be possible at a fraction of the costs and thereby offering the possibility of taking advantage of investments made by the organiser of the sports event.

In the end, the Report finds that it is unlikely that an absence of protection would lead to market failure.<sup>17</sup> It is not specified however whether the same conclusion would still apply in case *no* ‘relief construction’ as presently in use would be available, based on the mix of the property right in the venue, actions based on unfair competition and on breach of contract. In that case, would the risk that investments in sports events are omitted or reduced still be illusionary?

### **2.3.2    *Market Failure Caused by Too Much or Inadequate Protection***

According to the Report, market failure may still occur in a second scenario. This is when either too much protection is granted, or when the protection is based on a norm that is inadequate.<sup>18</sup> If there is too much protection, this will lead to a disruption in the legal balance between the principle of freedom of competition on the one hand and its limitations on the other hand.<sup>19</sup> In turn, inadequate forms of legal protection may obscure the clarity of the law and the aim of legal security.

The Report considers that in the case of the protection of sports organisers, this form of market failure is likely to happen. The protection presently offered is wrongly directed. The right of ownership ('house right') and remedies derived from laws of unfair competition are not meant to serve to protect sports events. If they are nevertheless applied for this purpose, they are used to reach goals which, in reality, aim at the protection of investments. Therefore, the sports organisers' rights lack any basis in law. They are nevertheless fully recognised in practice, aggravated by attempts in legal science to create a basis for an exclusive right in the law of unfair competition or copyright. As a result of the commercial position and the bargaining power of the 'right holders' that are thus recognised, their rights may be given a scope of protection which is even larger and may encompass such uses as should remain in the general interest.<sup>20</sup> This risk of market failure will primarily need to be averted by an intervention by the legislator.<sup>21</sup>

## **2.4    Conclusion**

The German Report convincingly arrives at the conclusion that the present system of protection is wrongly directed. The same is less certain when it comes to the underpinning of the need for protection. Investment in sports events is

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17. *Ibid.*, 83.

18. *Ibid.*, 77.

19. *Ibid.*, 83 ff.

20. *Ibid.*, 84; 88.

21. *Ibid.*, 88.

considered to be in the general interest, but that is not enough. Decisive for creating protection is that market failure may result from the fact that the protection presently offered by the law is wrongly directed. However, this presupposes that protection as such of the organisation of sports events would be justified; and such justification does not unequivocally follow according to the Report.

The German study concentrates on the protection of sports organisers alone. Apart from a short reference to the image right of sportspeople in Brazil, it does not consider the problem viewed from the angle of the athletes and players who deliver the performance.<sup>22</sup> An approach from this side however might make it easier to justify the creation of an IP right; the interests of the sports organisers might subsequently find protection by creating a neighbouring right on their behalf. This will be the object of the next part of the study.

### **3. THE STUDY BY THE ASSER INSTITUTE AND IVIR OF 2014**

Another approach was followed some years later in a *Study on Sports Organisers' Rights in the European Union*. It concerns an elaborate report prepared for the European Commission by the Asser Institute and the Institute for Information Law.<sup>23</sup> One prominent aim of the study was to provide recommendations on the opportunity for EU action to address problems that would be identified in relation to sports organisers' rights.<sup>24</sup> The scope of this study was large. It covers the whole of the EU. It addresses the protection of sports organisers' rights, as well as sports organiser's rights management in the field of the media and in the field of gambling.

#### **3.1 The Approach in the Asser/IViR Report Differs from the German Report**

The report finds no need for future EU action. However, in order to support this conclusion it limits itself to an assessment from the viewpoint of sports organisers. Viewed from that angle, the present legal framework is found to be satisfactory. Organisers of sports events are 'fairly well protected' as a matter of substantive law on the basis of the combination of the 'house right', the law of contract, and original or derivative rights of IP in audio-visual recordings and broadcasts.<sup>25</sup>

the combination of house right, media contract(s), and intellectual property protection of the audio-visual recording and broadcast effectively allows the sports event organisers to enjoy complete ownership and/or control over the audio-visual rights in the sports events. The case often made by

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22. On p. 62, in the context of the Brazilian arena right.

23. T.M.C. Asser Instituut/Asser International Sports Law Centre; Institute for Information Law – University of Amsterdam, *Study on Sports Organisers' Rights in the European Union*, February 2014. The primary authors were Prof. Dr. Ben van Rompuy (Asser) and Dr. Thomas Margoni (IViR). The project was led by Bernt Hugenholtz.

24. *Ibid.*, 14.

25. *Ibid.*, no. 6.1 p. 178.

sports organisers for express recognition of a ‘sports organisers’ right’ which would take the form of a special neighbouring right or *sui generis* right, is therefore not very strong.<sup>26</sup>

The real problem for the sports organisers, the study concludes, seems to be the lack of immediate and effective enforcement remedies that can effectively and rapidly terminate acts of unauthorised live streaming of events; issues of enforcement however were outside the scope of the study.<sup>27</sup>

### **3.2 Conclusion**

Therefore, the conclusion to the Asser/IViR report of 2014 does not as such refute the argument raised by Hilty and Henning-Bodewig that from the larger viewpoint of the *general* interest, the protection offered by the ‘conglomerate’ of legal instruments used presently is wrongly directed and unstable. Further, in this regard, Hilty and Henning-Bodewig warned that the bargaining power of the organisers might lead others to accept a scope of protection which is too large.

This question of the general interest is barely touched upon in the report of 2014. It considers that under the present national regimes across the EU, organisers of sports enjoy ‘complete ownership and/or control’. According to the Report, this makes the case for express recognition of a sports organisers’ right not very strong. However, it is exactly this *complete* ownership and/or control that might be a potential source of problems. It is more than is desirable from a social point of view or than is needed by (reasonable) organisers. Furthermore, there might be a reason for the creation of an IP right from a viewpoint of transparency as well as legal security.

However, as we saw in section 2, the *justification* of a new IP right for sports organisers may meet with complications. That leads to the question as to whether it might be more feasible to create a new IP right for *athletes and players*, and to have this right accompanied by a new neighbouring right for sports organisers. This will now be addressed.

## **4. THE PERFORMANCE OF THE ATHLETES AND PLAYERS AS A BASIS FOR PROTECTION?**

As is clear from their titles, in the Asser/IViR study as well as in the German report of 2006, the position of the sports organiser is central. The Asser/IViR report nevertheless also considers the position of athletes and players, in very benevolent terms.<sup>28</sup> They are considered as the ‘lifeblood of the sports event’ and their role is ‘essential’.<sup>29</sup> It could not be pretended therefore that the Asser/IViR Report fails to recognise the importance of their role, even if little of this

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26. *Ibid.*, no. 6.1 p. 178.

27. *Ibid.*, no. 6.1 p. 179.

28. See also *ibid.*, 19, 24, 42–51, 60, 178–179.

29. *Ibid.*, 18.

generous recognition remains when it comes to the question of the legal position of athletes and players. It refers to a feeling which might be widely shared: it is felt that the protection provides a *just reward*.

In this regard, the performance of athletes or players might be considered as a basis of protection. Several factors could corroborate this. To excel in sporting performances at a professional level requires extraordinary talent, as well as considerable effort and sacrifice in terms of life style and discipline. It is the professional players in the first place who provide the basis for the vast popularity of sports events. Furthermore it is the performance of the athletes or the players that constitutes the element used to generate money. It is this element that is filmed and broadcast by third parties. Athletes and players should therefore be allowed to share of the proceeds.

Of course, there may be practical reasons to object to the creation of an exclusive right for athletes and players. Professional football players are already well compensated for their efforts in their salary and other rewards, at least where it concerns players at the top of the competition. They already share in the wealth created by the popularity of the field. In those cases, a new right should only change the basis of certain payments, not their amount. In other cases, the proceeds to be expected may be insignificant. The impression nevertheless remains of fragmented and haphazard regulation in a field where transparency and logic would be welcome.

#### **4.1      Whether a New IP Right for Performers and Players is in the General Interest**

As much as it may be felt that the protection awarded by an IP right is fair, the protection will still have to be in the general interest. Here, reasons could be invoked which are put forward by the German report where it emphasises the symbiotic relationship between sports at the professional and the amateur levels, and the various beneficial effects sports has in sociological terms as well as in its effects on health care and promotion.

There is more. In the case of the protection of sports performances, the question arises as to why a claim for protection should not rather be justified if raised by the athletes themselves. In principle, such a claim might strike a sympathetic note to many in the sense of justice. This happens although strictly speaking, the rights invoked are non-existent, as concisely formulated in the German report. Apart from this, sports and the activities based on them have grown into a social branch of primary importance and of considerable economic impact which needs regulation. At some point, the burden of proof seems inclined to shift. Normally, it may be expected that a party that claims legal protection provides proof of the useful effects of its activities. This seems different in the case of spontaneous forms of protection emerging in important fields. In that case, the usefulness of the object of protection is almost presupposed until it is proven the *contrary*. This might also apply in the case for the protection of sports performances.

#### **4.2 The Risk of Market Failure**

The condition that the absence of protection will create a risk of market failure played a prominent role in the German advice of 2006 about the question of whether there was a ground to create protection for sports organisers. It is felt that it will not be, or be of much less, importance in case of the protection of athletes and players. Unlike sports organisers, athletes and players do not invoke protection for mere investment, but for their personal performance. For justification for protection of personal achievements, there must be emphasis on the uniqueness and the quality of the achievement.

#### **4.3 Image Rights: A Heterogeneous, Unstable Form of Protection**

The protection presently offered to athletes and players has a variable and very unstable legal basis. It would, in most systems, be based on the basis of so-called ‘image rights’.

As the Asser/IViR report of 2014 states, athletes and players ‘may derive some legal protection’ from their ‘image rights’. Protection cannot be guaranteed therefore; at least not in all Member States. Image rights include the various rights of privacy, personality and publicity one finds protected heterogeneously across the EU in different national systems.<sup>30</sup> Doubts as to the usefulness of the image right for the purpose of providing sufficient protection for athletes and players are confirmed in the Report of 2014. Image rights offer only limited legal certainty; they are not harmonised and they vary depending on the country. The Report nevertheless concludes that there is no urgent need for a harmonisation initiative.<sup>31</sup>

Rather, the image rights offer one more example of wrongly directed protection. The image right is invoked in order to correct the absence of protection based on more adequate grounds. Rights of privacy, personality and publicity are not the main reason why an IP right for players is justified. Sports events are public events; athletes take a central role in such events. As long as the image of the athlete, or other aspects concerning the athlete’s personality, are used in a proportional way, that use must be allowed. Reward for sports performances, often of an extraordinary kind, rather than respect of image rights should be the basis of the protection.

#### **4.4 No Neighbouring Right for Athletes and Players as Performers**

The Asser/IViR report shortly considers whether neighbouring rights for performers could be relevant with regard to sports events. The idea is quickly (and rightly) rejected: performers can only enjoy a related right where it concerns the performance of a work of authorship, and that is not the case for sports events.<sup>32</sup>

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30. *Ibid.*, 42.

31. *Ibid.*, 178.

32. *Ibid.*, p. 31.

That does not mean however that there is no reason to create a new alternative IP right for athletes and players. On the contrary, it makes that question more urgent. As was alleged above at the beginning of section 4, it is felt that the creation of a new IP right in their favour would be justified. Whereas it is rightly stated that, in the absence of any work of literature or art that is performed, there can be no question of neighbouring right for athletes as performers, the central importance of their role in sports is acknowledged and the often extraordinary quality of their performance would justify a reward.<sup>33</sup>

#### 4.5 A Neighbouring Right for Sports Organisers?

The question then is whether the creation of protection for athletes and players would leave room for a separate right for sports organisers. It is believed that it does. The answer might be in the creation of a *neighbouring* right for sports organisers.

The 2014 study briefly refers to the Portuguese *direito ao espectáculo*, but finds no ground to pursue that path.<sup>34</sup> There might nevertheless be such a ground, once protection is created for the performances of athletes and players.

Neighbouring rights will typically be created for the protection of the results of entrepreneurial activities supporting the creation and distribution of copies of works protected by copyright. Phonogram producers and film producers enjoy protection by neighbouring rights.<sup>35</sup> The same applies to producers of databases.

Which aspect of the entrepreneurial activity more specifically justifies the protection? The Database Directive, as well as the WPPT, provide elements of an answer. Recital 41, second sentence, of the Database Directive<sup>36</sup> defines the owner of the neighbouring right in databases as follows: 'whereas the maker of a database is the person who takes the initiative and the risk of investing'. The term 'investing' here is not to be understood in an exclusively financial way: the investment includes *professional* investment.<sup>37</sup> As is confirmed explicitly by Recital 40, it may consist of the deployment of financial resources and/or the expenditure of time, effort and energy. It might all be summarised by one phrase: the organisation, by the entrepreneur, of the realisation of a product ready for

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33. See *ibid.*, 18: 'Athletes are the lifeblood of the sports event'.

34. *Ibid.*, 31–32.

35. Phonogram producers: WIPO Performances and Phonograms Treaty (WPPT) 1996, Articles 2(d), and 11–15; Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations of 1961, Articles 3, 5, 10; Phonograms Convention of October 1971 for the protection of producers of phonograms, Articles 1 and 2; Directive 2006/115, Articles 8 and 9; film producers: Directive 2006/115, Article 9.

36. Directive 96/9/EC of 11 March 1996 on the legal protection of databases, Official Journal L 77/20.

37. Recital 39 reads, in full: 'Whereas, in addition to aiming to protect the copyright in the original selection or arrangement of the contents of a database, this Directive seeks to safeguard the position of makers of databases against misappropriation of the results of the financial and professional investment made in obtaining and collecting the contents by protecting the whole or substantial parts of a database against certain acts by a user or competitor;'

the market. In a similar fashion, Article 2(d) of the WPPT defines phonogram producers as follows: “producer of a phonogram” means the person, or the legal entity, who or which takes the initiative and has the responsibility for the first fixation of the sounds of a performance or other sounds, or the representations of sounds’.

The ‘technological investment’ rationale underlying the neighbouring rights has recently been heavily attacked by Bernt Hugenholtz.<sup>38</sup> He is of the opinion that neighbouring rights such as the phonographic right, the broadcaster’s right and the film producer’s right, are ‘outdated and inherently unbalanced’. The large investments once required for their production would not be needed anymore and would no longer provide a sufficient justification for the existence of the exclusive right. It is felt however that in the case of sports events, the argument would not apply. Their realisation will still require huge investment, in staff, in facilities, in organisation.

In the case of neighbouring rights, therefore, the element of the entrepreneurial *initiative* and professional *investment* or *responsibility* are supposed to provide the justification for the protection for the entrepreneur. This is exactly the position of sports organisers: they deliver the entrepreneurial activity that allows the performance of the athletes and players to be turned into a market-oriented product. It creates the right conditions, context and surroundings.

## 5. CONCLUSION

A new IP right for athletes based on their performances might be the natural reward for the general recognition of their essential role in sports. The extraordinary effort, talent and sacrifice often required to be able to take part in sporting events broadcast by the media might serve as a convincing justification for the creation of such a right. Such an IP right of athletes and players could further be accompanied by a new neighbouring right of sports organisers as entrepreneurs. This neighbouring right would be based on a reasoning of investment protection, subject to less scrutiny than the test applied to the creation of a new IP right. Both rights would thus have their own justification. A very short term of protection should suffice, thereby reducing the risks of collision with fundamental rights of others, including freedom of information. The system could be transparent and logical, and at the same time prevent legal protection being wrongly directed.

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38. P. Bernt Hugenholtz, ‘Neighbouring Rights are Obsolete’, *IIC* (2019), 1006–1011.



# Sui Generis Rights: From *Geschriftenbescherming* to the Protection of Sport Event Organisers

*Dirk Visser*

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## 1. INTRODUCTION

Bernt and I have worked together on various research projects for thirty years, starting with a project on copyright and document delivery in 1991 and most recently on a project on copyright contract law in 2020. We also worked together at the law firm Stibbe from 1996 to 1998. Together with Antoon Quaedvlieg, we founded the Wittem Group in 2002, whose work resulted in 2010 in the European Copyright Code, an academic proposal for unified EU copyright law.<sup>1</sup> Our joint work in the Wittem Group led to several memorable dinners, including a few at Wittem castle.<sup>2</sup> We also organised several other academic events together, including the conference on the centennial of the Dutch Copyright Act in 2012 at which Francis Gurry, Director General of WIPO, spoke. I probably first got to know Bernt during the ALAI conference ‘Aegean Sea II’ which took place thirty years ago, from 19 to 26 April 1991, and which Bernt still rightly qualifies as ‘legendary’. Before the lockdown, which at the time of writing this contribution seems to go on forever, we also met regularly at the Oysterbar and other Amsterdam restaurants to enjoy seafood together.

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1. <https://www.ivir.nl/nl/copyrightcode/european-copyright-code/>.  
2. <https://www.chateauwittem.com/>.

## 2. A NEW PROBLEM

Whenever an intellectual property (IP) lawyer is confronted with ‘a new problem’ there are, at a legislative policy level, three options. Before discussing these three options we have to clarify what an IP lawyer means by ‘a new problem’. ‘A new problem’ to an IP lawyer is some kind of recurring behaviour in the marketplace that may be characterised as ‘parasitic’. This undesirable behaviour, however, is not clearly covered by one of ‘the big three’ internationally recognised and over a hundred year-old IP rights. In this context, ‘the big three’ IP rights are: copyright law, patent law and trademark law. ‘Parasitic’ to an IP lawyer is any kind of behaviour that seems to take ‘unfair advantage’ of somebody else’s efforts. Usually, this advantage takes the shape of ‘slavishly’ copying somebody else’s product, service, or behaviour. And ‘unfair’ is something that just does not feel right to an IP lawyer. The Germans seem to have invented the most attractive word for this type of ‘new problem’. They call it a ‘Schutzlücke’: a gap in the system of IP protection, or a loophole. To be clear, the behaviour that is considered to pose a new problem in the described sense need not be new at all. New, however, is the fact that those who consider themselves to be the victim of the perceived problem, are now able to get the attention of an IP lawyer or an influential member of a legislative body.

## 3. THE THREE OPTIONS

So what are those three options at a legislative policy level to deal with a new problem?

Option number one is bringing the behaviour under one of the big three IP rights. By stretching, changing, or reinterpreting some of the requirements for protection under copyright, patent or trademark law, it may become possible to cover the behaviour causing the new problem. A prime example of this option was including computer software under copyright protection in the 1980s, as supported by Bernt Hugenholtz and most copyright scholars at the time.<sup>3</sup>

Option number two is leaving it to unfair competition law. This means making or deeming the behaviour actionable on the basis of either general tort law<sup>4</sup> or specific unfair competition laws, without qualifying it as covered by an existing or new IP right. In line with the Paris Convention, ‘[a]ny act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition’.<sup>5</sup> The famous old Dutch examples are bribing the employees of your competitor to get at a trade secret and copying a crane. Bribing the employee of a competitor was the topic of the first case in which the Dutch Supreme Court ruled, in 1919, that such behaviour was unlawful, although it

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3. See P.B. Hugenholtz and J.H. Spoor, *Auteursrecht op software* (Otto Cramwinckel, Amsterdam, 1987).

4. For instance, Art. 1382 of the French Civil Code or Art. 1401 (old) or Art. 6:162 (new) of the Dutch Civil Code.

5. Article 10bis(2) Paris Convention for the Protection of Industrial Property of 20 March 1883.

was not explicitly forbidden by any written law – a decision that, according to one of the leading legal scholars of the time, had the same impact as introducing an entire new book in the Civil Code would have had.<sup>6</sup> The copying of a crane was held not to be unlawful in 1956, but in ruling so, the Dutch Supreme Court did introduce a test for unlawful slavish imitation that still applies to this day.<sup>7</sup> Nowadays, both kinds of behaviour are covered by *sui generis* rights, i.e. EU trade secret protection<sup>8</sup> and design protection<sup>9</sup> respectively.

This is a recurring phenomenon: protection against acts which judges first grant on the basis of general unfair competition law is later codified in specific IP legislation. And this brings us to option number three, the topic of this contribution.

#### 4. SUI GENERIS RIGHTS

Option number three is creating a new ‘*sui generis*’ (intellectual) property right. What do we mean by a ‘*sui generis* right’? There is no official definition of this concept. Here we take a *sui generis* right to be a more or less exclusive right, laid down in a specific piece of legislation, that creates a (temporary) monopoly and allows the rightholder to prohibit or permit a certain kind of behaviour, usually copying of some kind, *apart from* ‘the big three’, copyright, patent and trademark law. The main characteristic of a *sui generis* right is that it is very much *like* one of these big three well-known IP rights, but that its subject matter, for whatever reason, falls outside their scope. The term ‘*sui generis*’ in itself is obviously rather neutral. It only indicates that it is a right ‘of its own kind’ and not part of another right. An important reason for emphasising this *sui generis* character of some rights is that because these rights are not covered by one of the three main IP rights, they do not fall under the ‘equal treatment’ or assimilation principle that is at the core of the important international treaties on those rights, namely the Berne Convention for the Protection of Literary and Artistic Works and the Paris Convention for the Protection of Industrial Property.

For some *sui generis* IP rights, the similar rather non-descriptive term ‘neighbouring rights’ is also used. This term stresses the fact that the right at hand is ‘neighbouring’, that is to say similar to copyright.

In the EU, the most well-known *sui generis* right is the specific protection regime for databases.<sup>10</sup> In 2016, Bernt called this specific form of database

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6. HR 31 January 1919, NJ 1919, 418 (*Lindenbaum/Cohen*).

7. HR 26 June 1953, NJ 1954, 90 (*Hyster Karry Krane*).

8. Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure.

9. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

10. Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.

protection ‘the *non plus ultra* of *sui generis* rights’.<sup>11</sup> But there are many more examples of rights which could be characterised as *sui generis* rights or have some of the same characteristics.

In this contribution we aim to give an overview of most (but not all<sup>12</sup>) *sui generis* rights and try to draw some conclusions as to their necessity, success, or failure. We will deal with these *sui generis* rights in the temporal order of their creation in the Netherlands.

## 5. **GESCHRIFTENBESCHERMING (NINETEENTH CENTURY)**

We start with the *geschriftenbescherming*, because it is indeed probably the oldest of the *sui generis* rights,<sup>13</sup> developed in the nineteenth century. Moreover, it is one of Bernt’s favourites. In fact, *geschriftenbescherming* is probably not really a *sui generis* right at all. It is, or rather was, a kind of pseudo-copyright<sup>14</sup> which the Dutch legislator abolished in 2015 in the light of CJEU jurisprudence which left no room for its maintenance. *Geschriftenbescherming* was pseudo-copyright protection of non-original writings. However, its protection requirements and its scope of protection have never become entirely clear. In practice, its main purpose in the second half of the twentieth century was to protect the monopoly of the Dutch public broadcasting organisation in radio and television programming information.<sup>15</sup> In fact, because it was not a proper *sui generis* right, but instead a peculiar interpretation of the words ‘all other writings’ in Article 10(1) under 1 of the Dutch Copyright Act, as in force prior to the abandonment of *geschriftenbescherming*, it was inevitable that it had to be abolished after the CJEU had ruled that the EU Database Directive did not allow any other standards for the grant of copyright protection for (collections of) writings other than (the CJEU’s

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11. P.B. Hugenholtz, ‘Something Completely Different: Europe’s *Sui generis* Database Right’, in S. Frankel and D. Gervais (eds.), *The Internet and the Emerging Importance of New Forms of Intellectual Property*, Information Law Series, vol. 37 (Kluwer Law International, 2016), 205–222. I am not sure whether he still agrees with this statement, as the new *sui generis* right for publishers of press publications contained in Art. 15 of Directive (EU) 2019/790 of 17 April 2019 on copyright and related rights in the Digital Single Market seems a serious contender for taking things a step further as far as *sui generis* rights are concerned.
12. Plant variety protection, supplementary protection certificates and indications of geographical origin are for instance not dealt with in this contribution. The same goes for trade name protection and design protection.
13. See for an elaborate description in English: A. Beunen, ‘Geschriftenbescherming: “The Dutch Protection for Non-original Writings”’, in P.B. Hugenholtz, A.A. Quaedvlieg and D.J.G Visser (eds.), *A Century of Copyright Law* (DeLex, Amsterdam, 2012), 57–97.
14. An early derogatory comment on *geschriftenbescherming* can be found in one of Bernt’s earliest publications *Auteursrecht en Information retrieval: verveelvuldiging en openbaarmaking in het computertijdperk* (Post Scriptum Reeks, Deventer, 1982), 24: ‘If the more or less arbitrary “raking together” of separate data ... can give rise to a pseudo-copyright, why should we not conclude that the same applies to the arbitrary gathering of documents?’
15. See P.B. Hugenholtz, ‘Het einde van het omroepbladenmonopolie nadert’, *7/8 Mediaforum* (1995), 82–87.

own definition of) originality.<sup>16</sup> *Geschriftenbescherming* did serve its purpose once, just like the printing privileges of previous centuries, when printing required a large investment which had to be recouped and therefore required some kind of protection in order to create a willingness to invest in it. As those days are long gone, the *geschriftenbescherming* was rightly abolished.

## 6. SEMICONDUCTOR CHIP PROTECTION (1987)

In 1987 the *sui generis* protection for the integrated circuit layout or ‘topography’ of semiconductor products or ‘computer chips’ was introduced in the Netherlands to implement the European Council Directive 1987/54/EEC of 16 December 1986.<sup>17</sup> This Directive was a direct reaction to the reciprocity clause in the US Semiconductor Chip Protection Act of 1984, which only provided protection to nationals of countries that provided the same kind of *sui generis* protection. The right only extends to ‘slavish copying’ of the layout and not to the functionality or the information stored and allows reverse engineering. This kind of protection is hardly used at all. There are very few registrations and no court cases at all in the Netherlands, as in most other countries. Apparently, there is no demand for this kind of protection. If this *sui generis* right were abolished, nobody would even notice. Very few people are even aware of its existence. But it cannot be abolished, as the WTO TRIPS agreement requires member states to provide for such protection (in Section 6 of Part II).

## 7. NEIGHBOURING RIGHT OF THE PERFORMER (1993)

The neighbouring right of the performing artist was introduced as a *sui generis* right in the Netherlands as late as 1993. A few years before, the Hoge Raad had recognised protection for performers on the basis of unfair competition law, labelling their performance as ‘an achievement of such a nature that it can be placed on the same level as the achievement which justifies copyright protection, and that therefore protection can be granted to it on the basis of unfair competition law’.<sup>18</sup> This ruling was rendered in view of the fact that the Netherlands was about to join the Rome Convention of 1961. This reasoning by the Hoge Raad shows that it would have made perfect sense to recognise performing artists as authors and bring them under copyright protection as well.<sup>19</sup> The reason why this did not

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16. CJEU, 1 March 2012, case C-604/10, ECLI:EU:C:2012:115 (*Football Dataco*), published with case note by P.B. Hugenholtz in *NJ* 2012/433, 4928–4937.

17. See: P.B. Hugenholtz, ‘Juridische bescherming van chips’, *BIE* (1985), 127–134.

18. HR 24 February 1989, ECLI:NL:HR:1989:AD0647 (*Elvis Presley*).

19. This has been suggested by many Dutch scholars prior to 1993, including P.B. Hugenholtz: E.D. Hirsch Ballin, *Maken en vervaardigen. Over ontaardingsverschijnselen in het recht van de scheppende mens* (Scheltema & Holkema, Amsterdam, 1959); A. Komen and D.W.F. Verkade, *Compendium van het auteursrecht* (Kluwer, Deventer, 1970), 44 (welk boek?); H. Cohen Jehoram, case note with HR 16 January 1970, AA 1970, 377 (*Ja zuster, nee zuster*); J.H. Spoor, *RM Themis* 1973, p. 324; R. Du Bois, *AMR* 1978, p. 62; Th. C.J.A van Engelen, *AMR* 1985, p. 83, H. Cohen Jehoram, ‘The Nature of Neighbouring Rights of Performing

happen was that a different choice had been made on the international level by introducing the so-called neighbouring rights in the Rome Convention of 1961. This, in turn, was the direct result of copyright holders, especially the musical collecting societies, who successfully lobbied to keep performers outside the scope of copyright protection, because extending the protection to them would mean less money for the authors. In hindsight it would have been a great idea to simply recognise performers as the authors of their performances and give them a copyright in the recordings and broadcasts of the performances.

## **8. NEIGHBOURING RIGHT OF THE PHONOGRAM PRODUCER (1993)**

The neighbouring right of the phonogram producer was introduced in Dutch legislation in 1993 as well, as part of the implementation of the Rome Convention, after the Hoge Raad had also recognised the right of the phonogram producer as a derivative of that of the performing artist in the same judgment. This neighbouring right was the direct result of the successful lobbying of the phonographic industry to not only create a neighbouring right for performers, but also a separate right for themselves as investors in the recordings. Here, too, a different choice could have been made earlier on. Phonogram producers could have been recognised as owners of the copyright in a sound recording,<sup>20</sup> as is the situation in the United States. Phonogram producers could also have acquired a position comparable with music publishers whose position is defined by the publishing agreement with an author. As suggested by Bernt Hugenholtz, there is less justification or need for a separate neighbouring right for phonogram producers now than there was sixty years ago.<sup>21</sup> But as the neighbouring right of the phonogram producer is laid down in several international treaties, it is unlikely that there are going to be any changes here either.

## **9. NEIGHBOURING RIGHT OF THE BROADCASTER (1993)**

The neighbouring right of the broadcaster was also introduced in 1993 in the Netherlands, as part of the implementation of the Rome Convention. This neighbouring right was a consolation prize, or ‘pacifier’,<sup>22</sup> for the entities that were going to be paying more following the introduction of the neighbouring rights of performers and phonogram producers.<sup>23</sup> The suggestion was that such

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Artists, Phonogram Producers and Broadcasting Organizations’, 144 *RIDA* 80 (April 1990); and P.B. Hugenholtz and M.T.M. Koedoorder, ‘Klankjatten: juridische aspecten van sound sampling’, *NJB* (1987), 1511 (1512).

20. See for early suggestions: D.H.M. Peeperkorn and H. Cohen Jehoram, ‘Een auteursrecht voor de fonogrammenproducent?’, 7 *AMI* (1994), 127–130.

21. P.B. Hugenholtz, ‘De naburige rechten hebben hun tijd gehad’, 6 *AMI* (2018), 243.

22. ‘*Fopspeen*’ in Dutch.

23. ‘Many broadcasters vehemently opposed international recognition of neighbouring rights. Broadcasters were generally afraid of the extra costs that rights for performing artists and phonogram producers (record companies) would entail for broadcasting. In the end, they

a right would help broadcasters in their negotiations with cable distributors and allow them to combat signal piracy. In truth, the introduction of this neighbouring right was not necessary at all. The underlying copyrights and the contractual arrangements based on those copyrights were already quite sufficient for that purpose. As Bryan Khan has demonstrated in his excellent thesis, there is neither a need nor an economic justification for the neighbouring right of broadcasters.<sup>24</sup> There is no need for such a right, as copyright can provide the necessary exclusivity and no protection of investment is necessary. Nowadays this neighbouring right forms the basis of the broadcaster's claim to a part of the private copying levy in the Netherlands.

#### 10. NEIGHBOURING RIGHT OF THE PRODUCER OF THE FIRST FIXATION OF A FILM (1995)

In 1995, producers of the first fixations of films were given a separate, slightly limited neighbouring right in their films on top of the copyright that is usually transferred to them. This was necessary as part of the implementation of Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of IP. It is not quite clear why this neighbouring right was introduced. According to a recital of the Directive, 'the investments required particularly for the production of phonograms and films are especially high and risky; [and] the possibility for securing that income and recouping that investment can only effectively be guaranteed through adequate legal protection of the rightholders concerned'. Apparently, the idea was 'that their achievements were comparable to those of phonogram producers and the then existing presumptions of transfer of author's rights in favour of film producers would not always provide sufficient protection'.<sup>25</sup> As Bernt has explained:

Most likely they owe this right to the *Gründlichkeit* of the officials and scholars involved in drafting the Directive. 'Laufbilder' (non-original films) already enjoyed neighbouring rights protection in Germany in the years preceding the Directive. Much like the phonographic right, this is a right based on the idea that investment in recording technology merits protection of the recorded content.<sup>26</sup>

The justification for these rights is (therefore) just as weak as the justification for the neighbouring right of phonogram producers. Proper contractual arrangements

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were lured into supporting the Rome Convention with the promise of a new right of their own – the broadcaster's neighboring right', P.B. Hugenholtz, 'The WIPO Broadcasting Treaty. A Conceptual Conundrum', KEI Seminar, *Appraising the WIPO Broadcast Treaty and its Implications on Access to Culture*, Geneva, 3–4 October 2018.

24. B.K. Khan, *An Economic Analysis of the Intellectual Property Rights of Broadcasting Organisations* (Doctoral Thesis, Rotterdam, October 2018).

25. S. von Lewinski, in M. Walter and S. von Lewinski (eds.), *European Copyright Law – A Commentary* (Oxford University Press, Oxford, 2010), 274, citing the Commission's Green Paper of 1988.

26. P.B. Hugenholtz, 'Neighbouring Rights are Obsolete', 50 *IIC* (2019), 1006–1011.

with authors and performers would suffice. Nowadays this neighbouring right forms the basis of film producers' claim to a share in the proceeds of the private copying levy in the Netherlands. This was the consequence of the *Luksan/Van der Let* decision by the CJEU,<sup>27</sup> which does not allow the transfer of the entitlement to private copying remuneration from authors to film producers.

## 11. DATABASE SUI GENERIS RIGHT (1999)

In 1999 the (in)famous *sui generis* database right was introduced as implementation of the European database directive.<sup>28</sup> Bernt Hugenholtz has always opposed this right and has written extensively about it.<sup>29</sup> The idea behind the introduction of this right was that it would stimulate the production of databases in Europe and give European database producers a competitive edge against their American competitors. As is apparent from subsequent evaluations,<sup>30</sup> this right failed utterly in this respect. As is well known, the US database producers have been and still are dominant, despite the fact that the US Supreme Court denied protection to databases in the *Feist* case.<sup>31</sup> The database right was specifically drafted as a *sui generis* right, and not as copyright, to avoid the assimilation requirements of the Berne Convention. US database producers were thereby explicitly excluded. According to some, this was the EU's revenge for the reciprocity clause in the US Semiconductor Chip Protection Act of 1984. As is often the case, this revenge did not play out that well. For instance, the dominant producer of a database containing sports information is Gracenote Sports, an American company with which all Dutch sports media have contracts. Obviously, those contracts do not refer to any EU *sui generis* right in the data involved, as US companies cannot own such a right, but apparently they provide enough protection for the company to thrive regardless.

## 12. TRADE SECRET PROTECTION (2018)

In 2018 the Trade Secret Act came into force in the Netherlands, which is the implementation of the EU Trade Secret Directive<sup>32</sup> and ultimately of Article 39 TRIPS. Trade secrets had already been protected for almost a hundred years in the

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27. ECJ, 9 February 2012, case C-277/10, ECLI:EU:C:2012:65 (*Luksan/Van der Let*).

28. Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.

29. Hugenholtz, *supra* note 11 and many other publications mentioned on the IViR website: <https://www.ivir.nl/nl/medewerker/hugenholtz/>.

30. European Commission, DG Internal Market, 'First evaluation of the Directive 96/9/EC on the legal protection of databases' (2005) and European Commission, DG Internal Market, 'Evaluation of Directive 96/9/EC on the legal protection of databases', Brussels, 25 April 2018.

31. *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

32. Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure.

Netherlands on the basis of judge-made unfair competition law. The new trade secret protection is not really a *sui generis* right, because it is not an exclusive right. It is probably not transferable either. It is more like a list of forbidden acts against ‘unlawful’ use. The right can be exercised by the ‘trade secret holder’, who is defined as ‘any natural or legal person lawfully controlling a trade secret’. However, the rights granted to this holder include some far-reaching enforcement instruments, also against ‘infringing goods’, which strongly resemble those of exclusive IP rights. It is yet too early to tell whether this transfer from unfair competition to pseudo-IP right will make much difference in practice.

### **13. NEIGHBOURING RIGHT FOR PUBLISHERS OF PRESS PUBLICATIONS (2021)**

On 7 June 2021, the new neighbouring right for publishers of press publications entered into force in the Netherlands as implementation of Article 15 of the CDSM Directive. This is currently the latest *sui generis* right which most commentators believe is completely superfluous. This right was intended to enable news publishers to get a better bargaining position vis-à-vis Google and Facebook for example. But it will not, because the underlying problem is the dominant position of these ‘information society service providers’ in the marketplace, not a lack of rights on the part of the publishers. Publishers can have just as strong a position on the basis of contractual arrangements based on copyright. If the dominant ‘information society service providers’ abuse their position, it is for competition law to deal with this situation. The introduction of a new neighbouring right does not solve anything.

### **14. NO SUI GENERIS RIGHT (YET): SPORT EVENT ORGANISERS**

In the Netherlands and in many other countries, sports organisers are somewhat protected on the basis of unfair competition law. And, in the Netherlands, also on the basis of property right: sports organisers can forbid the making of recordings within their stadiums as a condition (e.g. in general conditions applicable to tickets) of granting access to the stadium, and violating these conditions also is a tort.<sup>33</sup>

In 2014 an EU-wide study co-authored by Bernt concluded:

While the calls of the sports organisers for effective enforcement remedies are comparable to those of the traditional content and information industries, the case for expedient remedies is arguably somewhat stronger here, given the highly perishable media value of many sports events, which is usually exhausted immediately with the live coverage of the event. What sports organisers, therefore, ideally want are enforcement remedies that can effectively and rapidly terminate acts of unauthorized live streaming of events. While issues of enforcement are outside the scope of the present

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33. HR 23 October 1987, NJ 1988, 310 (NOS/KNVB).

study, and it is doubtful that such remedies can realistically be conceived, it is recommended that these demands be assessed and evaluated in the context of a general review of the EU IP Enforcement Directive.<sup>34</sup>

In 2018, there was an amendment proposed in the European Parliament to introduce a new *sui generis* right for sport event organisers,<sup>35</sup> which did not make it into the final version of the CDSM Directive. So, no change there for the time being. But who knows what the future brings.

## 15. CONCLUSION

What can we conclude from this overview of *sui generis* rights? And what is Bernt's position regarding these rights? If one looks at all those *sui generis* rights in succession, there is no escaping the conclusion that they are not what one would call success stories. In fact, they seem to be a warning for legislators everywhere not to choose the option of introducing such rights too quickly.

In general, it seems better to leave it to the courts to decide whether some activity ('a new problem') should be covered by unfair competition law or by one of the big three IP rights, rather than create a new *sui generis* right for every new phenomenon. Of course, leaving it to unfair competition law lacks legal certainty, and in the EU there is no harmonisation of unfair competition law in general at the EU level, and overstretching the big three IP rights also can show clear disadvantages. Bernt was in favour of copyright protection for computer software in the 1980s, but in 2009 he suggested that *sui generis* protection might have been better.<sup>36</sup>

Considering this latter statement an exception to the rule, Bernt's opinion regarding most *sui generis* rights is quite clear. He has always opposed *geschriftenbescherming* and the *sui generis* database right as an unjustified threat to the free flow of information. Recently, he has argued that the neighbouring rights of broadcasters, film producers and phonogram producers should be abolished or severely curtailed because their investments and corresponding risks have diminished. He has announced 'The End of "Technological Investment"' as a valid ground for neighbouring rights. He has also mentioned the lack of a threshold for protection, making reference to the CJEU decision in *Pelham*:<sup>37</sup> phonogram producers have a right in any recording, without any creativity threshold, which means that they have actually *more* rights than authors and

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34. T.M.C. Asser Instituut/Asser International Sports Law Centre and Institute for Information Law – University of Amsterdam (2014), *Study on sports organisers' rights in the European Union*, EAC/18/2012, 179.

35. 'Member States shall provide sport event organizers with the rights provided for in Article 2 and Article 3 (2) of Directive 2001/29/EC and Article 7 of Directive 2006/115/EC.' REPORT on the proposal for a directive of the European Parliament and of the Council on copyright in the Digital Single Market (COM(2016)0593 – C8-0383/2016 – 2016/0280(COD)), Amendment proposed by the European Parliament for an article 12a (Protection of sport event organizers).

36. P.B. Hugenholtz, 'Guy Vandenberghe had gelijk', *Computerrecht* (2009), 91.

37. CJEU, 29 July 2019, case C-476/17, ECLI:EU:C:2019:624 (*Pelham and Others*).

performers.<sup>38</sup> He has opposed the new neighbouring right for press publishers for the reasons mentioned above, calling it ‘an inherently unbalanced right in the bad-old tradition of no-threshold neighbouring rights’.<sup>39</sup> He has also argued again that performers should be protected under copyright law, just like authors.

Bernt has also opposed a possible new ‘data producer’s right’ (on top of the *sui generis* database right):

[i]ntroducing a property right in machine-generated data would seriously compromise the system of intellectual property law that currently exists in Europe. It would also contravene fundamental freedoms enshrined in the European Convention on Human Rights and the EU Charter, distort freedom of competition and freedom of services in the EU, restrict scientific freedoms and generally undercut the promise of big data for European economy and society.<sup>40</sup>

Neighbouring rights are obsolete, according to Bernt. Bernt and others have announced for decades<sup>41</sup> that *geschriftenbescherming* was about to be abolished. That did happen in the end. ‘*Frappez toujours*’ is one of the important roles of the academic. Bernt did a lot of ‘*frapper*’ in the direction of *sui generis* rights and he will undoubtedly continue to do so. Hopefully also in my presence at a nice restaurant in Amsterdam over some oysters.

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38. Hugenholtz, *supra* note 21 and Hugenholtz, *supra* note 26.

39. P.B. Hugenholtz, ‘Say Nay to the Neighbouring Right!’, *Kluwer Copyright Blog*, 14 April 2016.

40. P.B. Hugenholtz, ‘Against “data property”’ (Chapter 3), in H. Ullrich, P. Drahos and G. Ghidini (eds.), *Kritika: Essays on Intellectual Property* (Edward Elgar Publishing, Cheltenham, 2018).

41. P.B. Hugenholtz, ‘Het einde van het omroepbladenmonopolie nadert nog steeds (maar doet er weinig meer toe)’, in M.J. Geus, A.W. Hins, Q.R. Kroes, A.J. Nieuwenhuis, E.C. Pietermaat, C.J. Turner and D. Voorhoof (eds.), *25 jaar Mediaforum* (Otto Cramwinckel, Amsterdam, 2013).



# Is the Unauthorised Commercial Exploitation of Sports Events Unfair?

*Ansgar Ohly*<sup>1</sup>

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## 1. INTRODUCTION: FROM ‘ELEVEN FRIENDS’ TO ‘BIG BUSINESS’

The days when football was only about eleven friends playing ball are long gone by, whether we regret it or not. Football and other popular spectator sports have become big business. Before the end of the transfer window in early October 2020, clubs in the top five European leagues had completed 1370 deals worth more than EUR 3 billion.<sup>2</sup> The sums paid for broadcasting rights and the amounts raised by sponsoring and merchandising are enormous. But, at least in jurisdictions without *sui generis* legislation, the legal basis of these rights is as murky as they are valuable.

Rather than trying to answer the big question of whether we need sports organisers’ rights at the national or the EU level,<sup>3</sup> this chapter looks into one area of law on which sports associations and clubs have repeatedly relied in the past: unfair competition law. We will first focus on four jurisdictions: Anglo-Australian, US, German and French law (section 2). As there is not enough space for a full comparison, the discussion will focus on one paradigmatic judgment for each respective system. Afterwards the opportunities and limitations of unfair

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1. Dr. jur. (Munich), LL. M. (Cantab.), Professor of Private Law, Intellectual Property and Competition Law, Ludwig Maximilian University Munich, Visiting Professor, University of Oxford. I am grateful to Agnès Lucas-Schloetter for providing information on French law and to Joost Poort and Martin Senftleben for their comments on a draft of this chapter. All websites cited in this chapter were last visited on 25 February 2021.
2. <https://www.theguardian.com/football/ng-interactive/2020/jul/30/transfer-window-summer-2020-all-deals-europe-premier-league-la-liga-bundesliga-ligue-1-serie-a>.
3. See the study commissioned by the EU Commission and conducted by the Asser Institute and the Institute for Information Law, *Study on sports organisers’ rights in the European Union* (2014), available at [https://www.asser.nl/media/2624/final-report\\_sor-2014.pdf](https://www.asser.nl/media/2624/final-report_sor-2014.pdf).

competition law as part of the mix of legal rules protecting sports organisers will be analysed (section 3).

## **2. MISAPPROPRIATION AND SPORTS EVENTS IN FOUR JURISDICTIONS**

### **2.1 Rejecting a Misappropriation Doctrine: *Victoria Park Racing (Australia and England)***

The oldest case in our analysis takes us back to the pioneering days of broadcasting. The claimant operated a racecourse on the outskirts of Sydney and earned its money not only by collecting entrance fees, but also by allowing representatives of betting companies in on a contractual basis. The defendant erected a structure on an adjacent piece of land which was high enough to see the races with binoculars. This allowed a reporter for one of the early radio stations to broadcast the races, which, in turn, reduced the claimant's profits from the betting contracts. The claimant relied on copyright, on the right of privacy, on the tort of nuisance and invited the court to follow the lead of the US Supreme Court, which had recognised a misappropriation doctrine in *INS v. AP*,<sup>4</sup> a judgment to which we will return in the next section.

The Supreme Court of New South Wales denied the injunction. The claimant appealed. By a narrow majority, the High Court of Australia dismissed the appeal.<sup>5</sup> According to the majority, there was no property right in a spectacle, the results on the notice boards were not protected by copyright and if there was a right of privacy at all, it did not prevent neighbours from looking over the fence of their land. Most notably, Dixon J. was not prepared to import the US misappropriation doctrine into Australian law: courts of equity had not 'thrown the protection of an injunction around all the intangible elements of value', and English law preferred 'special heads of protected interest' to 'wide generalizations'.<sup>6</sup>

Although the case was decided more than eighty years ago, it still represents the approach of modern English law. Outside the statutory intellectual property rights and the *sui generis* protection for Olympic symbols and events, and absent any misrepresentation as to origin or quality,<sup>7</sup> there is no tort of misappropriation in English law.<sup>8</sup> The technical reason is that such a broad kind of protection can neither be based on statute nor on precedent. The policy reasons are that the

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4. *Infra* note 9.

5. *Victoria Park Racing & Recreation Grounds Co Ltd v. Taylor* (1937) 58 CLR 479.

6. *Ibid.* at 509.

7. Which is actionable under the tort of passing off, see *BBC v. Talksport* [2001] FSR 6; for an overview see L. Bently, B. Sherman, D. Gangjee and P. Johnson, *Intellectual Property Law* (5th ed., 2018), 865–927.

8. *Hodgkinson & Corby Ltd. v. Wards Mobility Services Ltd.* (No. 1) [1995] FSR 169, 175 per Jacob J.: 'There is no tort of making use of another's goodwill as such'.

limits of such a right would be unclear, that it would not be for judges to create it and that 'monopolies should not be so readily created'.<sup>9</sup>

## **2.2      Restricting the Misappropriation Doctrine through Copyright Pre-emption: *National Basketball Association v. Motorola (USA)***

Had this chapter been written 100 years ago, the United States would have been presented as a jurisdiction which grants remedies against misappropriation rather liberally. In its seminal judgment in *INS v. AP*,<sup>10</sup> the US Supreme Court allowed an action for misappropriation. International News Service (INS) was owned by William Randolph Hearst, a colourful media tycoon with open sympathies for the Germans in the First World War. Therefore, INS's correspondents were denied access to the allied war sites. In order to gather up-to-date information at least for the INS newspapers on the West Coast, INS reporters read the morning papers on the East Coast and cabled the news to the West, where it would arrive in time for the morning papers. AP could not protect the information by copyright, so it complained of unfair competition. By a majority, the US Supreme Court held that INS had 'reaped where it had not sown', and that a court of equity should not hesitate to enjoin this unfair practice.<sup>11</sup> In two forceful votes, however, Justices Brandeis and Holmes dissented. Justice Brandeis, in particular, stressed the freedom of imitation and information outside the scope of copyright protection.<sup>12</sup>

For several reasons, the rule in *INS v. AP* has not been successful over the decades. Some years later, the Supreme Court held that the federal courts did not have the power to develop a federal common law.<sup>13</sup> Thus, the misappropriation doctrine could only survive in state law. There, however, it is subject to the doctrine of federal pre-emption: it must not conflict with the policy of federal statutes, particularly with federal IP statutes. Subsequently, state doctrines of unfair copying were struck down by the Supreme Court as being inconsistent with federal copyright, patent and design protection on several occasions.<sup>14</sup> But a narrow remnant of the INS misappropriation doctrine has survived at state level: the 'hot news' doctrine. It allows claimants to take action against misappropriation if (1) they gather news at a cost, (2) the value of the information is highly time-sensitive, (3) the defendant's use of the information constitutes free-riding on the claimant's investment in gathering it, (4) the defendant's use of the information is in direct competition with a product or service offered by the claimant; and (5) the ability of other parties to free-ride on the efforts of the

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9. *Elvis Presley Trade Marks*, [1999] RPC 567, 598 per Simon Brown L.J. (with respect to image rights); *L'Oréal SA v. Bellure NV*, [2007] EWCA Civ 968, paras. 135–141.

10. *International News Service v. Associated Press* 248 U.S. 215 (1918).

11. *Ibid.* at 240.

12. *Ibid.* at 259.

13. *Erie Railroad Co. v. Tompkins* 304 U.S. 64 (1938).

14. *Sears, Roebuck & Co v. Stiffel & Co* 376 U.S. 225 (1964); *Bonito Boats v. Thunder Craft Boats* 489 U.S. 141 (1989).

claimant would reduce the incentive for the claimant to produce the product or service such that its existence or quality would be substantially threatened.<sup>15</sup>

This doctrine has been relied upon not only by news agencies and by banks which provide stock market information,<sup>16</sup> but also by sports organisers. After all, sports events are newsworthy. Fans are interested in the results, and betting operators also rely on them. As far as can be seen, however, sports organisers have not been successful in stopping the unauthorised use of information concerning their events. In *National Basketball Association v. Motorola*,<sup>17</sup> the NBA tried to prevent the defendant from making information about basketball matches available via live tickers. The Second Circuit distinguished between three products provided by the NBA: the basketball game, live broadcasts and factual information about these products. The defendant's service in no way reduced the attractiveness of the games or the broadcasts. And with respect to the transmission of factual information about the games, the Court held that the defendant did not 'free-ride', as it produced and transmitted this information at its own cost.<sup>18</sup> So, while the 'hot news doctrine' still fuels the fantasy of both lawyers and academics, there are only few instances in which it has been invoked successfully. In particular, it has been of little help to sports organisers.

### **2.3      The Limitations of a Narrow Misappropriation Doctrine: *Hard Pitch Heroes* (Germany)**

While the common law is sceptical about broad misappropriation doctrines, Continental European jurisdictions such as France, the Netherlands<sup>19</sup> and Germany have traditionally been more open to allowing causes of action against what is often metaphorically described as 'reaping without sowing', 'riding on the coat-tails' or 'sailing in the wake' of a competitor.

In the early years of unfair competition law, German courts were often prepared to regard the exploitation of a competitor's efforts as unfair. Adolf Lobe, an early commentator known for his vivid metaphors, not only compared unfair competition to the use of an engine in a rowing race,<sup>20</sup> but also considered 'plowing with someone else's calf' as unfair.<sup>21</sup> In one of the early cases, the German Reichsgericht held, before the introduction of sound recording rights,

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15. *National Basketball Association v. Motorola, Inc.* 105 F.3d 841, 852 (2d Cir. 1997); *Barclays Capital Inc. v. Theflyonthewall.com, Inc.* 650 F.3d 876, 898 (2d Cir. 2011).

16. *Financial Information, Inc. v. Moody's Investors Service, Inc.* 808 F.2d 204 (2d Cir. 1986); *Barclays Capital Inc. v. Theflyonthewall.com, Inc.* 650 F.3d 876 (2d Cir. 2011).

17. *National Basketball Association v. Motorola, Inc.*, 105 F.3d 841, 852 (2d Cir. 1997).

18. *Ibid.* at 854.

19. For the potential and limitations of the protection against unfair competition granted by Dutch law on the basis of Art. 6:162 Burgerlijk Wetboek see the Asser Institute Study, *supra* note 3, at 35–36.

20. A. Lobe, 'Die Generalklausel des neuen Wettbewerbsgesetzes', *GRUR* (1910), 3, 5.

21. A. Lobe, 'Der Hinweis auf fremde gewerbliche Leistung als Mittel zur Reklame', *XVI MuW* (1916/17) 129.

that copying records amounted to unfair competition.<sup>22</sup> Over the decades, the courts became more sensitive to the steadily extending intellectual property law and established a rule under which anti-copying protection outside intellectual property law could only be granted if additional factors of unfairness were present. This rule was codified in the 2004 reform of the Act against Unfair Competition (UWG). Pursuant to § 4 No. 3 of the Act, offering for sale an imitated product is unfair if (a) it causes an avoidable likelihood of confusion, (b) if it takes unreasonable advantage or causes unfair damage to the reputation of a competitor's product or (c) if the means for copying have been obtained by unfair means. But outside the area of product imitation, it remains unclear if taking unfair advantage of a competitor's efforts can be considered as unfair under the general tort of unfair competition (§ 3(1) Act against Unfair Competition), at least in exceptional cases.<sup>23</sup>

This possibility was tested in the *Hartplatzhelden* (*Hard Pitch Heroes*) case.<sup>24</sup> The defendant operated a website which allowed users to upload video clips of amateur football matches, such as spectacular goals or other remarkable scenes. The website, which was financed by advertising, was nicely presented, in particular a jury of well-known football players chose a 'goal of the month'. The operators were sued by one of Germany's regional football associations. It claimed that Hard Pitch Heroes took unfair advantage of the football associations' efforts in organising the leagues and training the referees. Given that amateur sports were only possible because of the enthusiasm of amateurs, who were prepared to invest their time, all financial returns should go to the football associations and, hence, indirectly to the amateurs.

The Bundesgerichtshof noted that neither an imitation in the sense of § 4 No. 3 UWG nor the factors of unfairness listed in that provision were present in the case.<sup>25</sup> But the court was prepared to consider the possibility of granting anti-misappropriation protection on the basis of § 3(1) UWG, which simply states: 'Unfair commercial practices are illegal.' The court left open whether such protection could be granted in theory. If at all, it was subject to strict conditions: other means of protection such as property law or intellectual property law had to prove insufficient, there had to be the risk that investments such as the claimant's would not be made without additional protection, and a balancing of the interests of both competitors and of the general public had to come down in

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22. RGZ 73, 294; see also A. Ohly, 'Urheberrecht und UWG', *GRUR Int.* (2015), 693, 694–696.

23. For: W. Büscher, 'Aus der Rechtsprechung des EuGH und des BGH zum Lauterkeitsrecht seit Ende 2015', *GRUR* (2017), 105, 106; A. Ohly, 'Hartplatzhelden.de oder: Wohin mit dem unmittelbaren Leistungsschutz?', *GRUR* (2010), 487, 494; B. Schröer, *Der unmittelbare Leistungsschutz* (2010), 185–312; for sports rights R. Lochmann, *Die Einräumung von Fernsehübertragungsrechten an Sportveranstaltungen* (2005), 216–243; J. Zinnecker, *Audiovisuelle Medienrechte an Profisportveranstaltungen am Beispiel der Deutschen Fußballbundesliga* (2019), 559–595; against: H. Köhler, in: H. Köhler, Bornkamm and J. Feddersen, *UWG* (39th ed., 2021), § 3 para. 2.28; H. Nemeczek, 'Rechtsübertragungen und Lizenzen beim wettbewerbsrechtlichen Leistungsschutz – Zugleich ein Beitrag gegen den unmittelbaren Leistungsschutz', *GRUR* (2011), 292–295.

24. BGH GRUR 2011, 436 – *Hartplatzhelden.de*.

25. *Ibid.* at paras. 14–18.

favour of the claimant.<sup>26</sup> With respect to amateur football, the Bundesgerichtshof noted that the clubs could exercise their ‘house right’ by prohibiting video recordings.<sup>27</sup> Also, in a balancing of interests, the freedom of information and the freedom of expression of the platform users, who did not have any other means of seeing videos of amateur matches or of making them available, had to be taken into account.<sup>28</sup>

Thus, the reasoning in *Hard Pitch Heroes*, despite starting from a different unfair competition doctrine, bears striking similarities to the US ‘hot news’ test. Unfair competition protection is subsidiary to intellectual property law, it is not granted when the claimant wants it, but when there is a risk of market failure, and countervailing interests of the public are taken into account.

## 2.4 The Limitations of a Broad Misappropriation Doctrine: *FFR v. Fiat (France)*

France is one of the few European countries which provides for a sports organisers’ right.<sup>29</sup> French law is also one of the most protective jurisdictions when it comes to the misappropriation of a competitor’s investments. In particular, French law allows traders a cause of action for ‘parasitic competition’ against traders who ‘intrude into the wake of another in order to take advantage, without own expenses, of that trader’s efforts, investments and notoriety’.<sup>30</sup>

The possibilities and limits of both the sports organiser’s right and of the law against unfair and parasitic competition were tested in the great sports year of 2014. On the day after a match between France and England in the Six Nations rugby cup, Fiat published an advertisement with the slogan ‘France 13, England 24. The FIAT 500 congratulates England on its victory and looks forward to meeting the French team on 9 March for the match France v. Italy’, followed by a picture of the FIAT 500 with the caption ‘Italy 500’. This advertisement is an example of a practice often referred to as ‘ambush marketing’.<sup>31</sup> Indeed, the French Rugby Federation took action against Fiat for infringement of its sports organiser’s right, for unfair competition by causing confusion, and for parasitism.

But the Rugby Federation lost before the Cour de Cassation.<sup>32</sup> While, under French law, a sports organiser has a broad right<sup>33</sup> to prevent others from making

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26. *Ibid.* at paras. 24–28.

27. *Ibid.* at para. 27.

28. *Ibid.* at paras. 25, 27.

29. Art. L. 333-1 Code du sport.

30. ‘Se placer dans le sillage d’un autre, afin de tirer profit sans bourse délier, de ses efforts et investissements, de sa notoriété’, see *infra* note 31 and P. Le Tourneau, ‘Parasitisme’, *JCL, Conc. Cons., Fasc.* (2013) 227; S. Nérisson in F. Henning-Bodewig, *International Handbook on Unfair Competition* (2013), § 11 paras. 62–69.

31. On the problematic nature of this term, see *infra*, section 3.4.

32. Cass. com. 20.5.2014, no. 13-12.102, *Fédération Française de Rugby v. Sté Auto Picardie*; see the comment by L. Corvisier and A. Vichnevsky, ‘Ambush marketing: la Cour de Cassation siffle la fin du match’, *Sem. Jur.* (2014), 1519.

33. The Court noted that, since the law lacks precision with respect to the types of exploitation covered by the right, every commercial act which could not have happened but for the

a profit by deriving financial returns from a sports event, the mere publication of publicly known facts such as game results without a direct reference to the Rugby Federation did not amount to such an exploitation. The Court also held that there was no likelihood of confusion, as Fiat did not purport to be an official sponsor. Finally, the Court rejected the plea for parasitic competition with a reasoning consistent with the part of the judgment which concerns the sports organiser's right: the Federation had not shown that Fiat had captured the economic flow of the sports event.

### 3. ANALYSIS

#### 3.1 Common Ground and Disparity

Our short foray through four jurisdictions has shown agreement with respect to misrepresentation and disparity with respect to misappropriation.

All jurisdictions provide traders with causes of action against competitors who cause a likelihood of confusion, as, indeed, Article 10<sup>bis</sup>(3)(i) of the Paris Convention requires. Despite all differences in detail, the common law tort of passing off,<sup>34</sup> the anti-confusion protection granted by the Lanham Act in US law,<sup>35</sup> 'confusion' as one of the established categories of concurrence déloyale in France<sup>36</sup> and § 4 No. 3(a) of the German UWG are similar in this respect. Side by side with these economic torts, consumers are usually protected against misleading practices, be it by unfair competition law, be it by consumer protection legislation.

There is much less international consensus about whether there should be a general cause of action against misappropriation.<sup>37</sup> Our overview of the four jurisdictions has shown the full range of approaches: no protection outside intellectual property law and passing off in England and Australia, a limited misappropriation doctrine, which has become narrower and narrower over the decades, in the US, protection against taking advantage and, potentially, misappropriation as a general category of unfair competition in Germany, which has been hedged in carefully by the courts, and parasitism in France. But in the area of sports, misappropriation doctrines have turned out to be of little use to organisers. In the US, the conditions of free-riding and risk of market failure are difficult to meet. In Germany, taking advantage of sports events does not fall under the established category of unfair product imitation, and the German Federal Supreme Court tends to regard the possibility of exercising the property

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sports event falls within the scope.

34. *Supra* note 7.

35. 15 U.S.C. § 1125(a)(1)(A).

36. Nérisson, *supra* note 30, paras. 70–71.

37. See A. Kamperman Sanders, *Unfair Competition Law* (1997), 6–76 and *passim*; W. Gordon, 'On Owning Information: Intellectual Property and the Restitutive Impulse', 78 *Va. L. Rev.* (1992) 149; A. Ohly, 'The Freedom of Imitation and Its Limits – A European Perspective', 41 *IIC* (2010) 506, 515–524; specifically for sports see the Asser Institute Study, *supra* note 3, at 33–38.

right in the stadium as sufficient and, hence, to consider additional protection as unnecessary. In France, the parasitism test is easier to satisfy, but it is difficult to see what it could add to the intellectual property rights of sports organisers.

### **3.2 The Major Football Clubs' Main Revenue Streams**

One lesson to be learned from *National Basketball Association v. Motorola*<sup>38</sup> is that it is important to distinguish between the different services offered by sports organisers. The four cases discussed above all concerned different aspects of sports organisers' activities. In *Victoria Park Racing* the claimant tried to prevent live coverage of races in order to control the betting market. The NBA also tried to prevent the live news coverage of its games, but not with relation to betting. *Hard Pitch Heroes* is the only case about the making available of audio-visual recordings, but the case concerned neither professional sports nor the full coverage of football matches. The *Fiat* case was a case of 'ambush marketing'.

Given these differences, it makes sense to look at the main revenue streams of sports organisers and to ask what role unfair competition law plays and ought to play in securing each of them. For the sake of simplicity, the analysis will be limited to the leading European professional football clubs, about which data are readily available.<sup>39</sup>

Leaving transfers of players aside, the top 'Money League' clubs usually earn between 40 and 50% of their profits from sponsorship contracts and merchandising activities. The second revenue stream is broadcasting rights, which usually account for 30 to 40% of all profits. This figure depends on the league. It tends to be higher in England and Spain than elsewhere. Finally, 10 to 20% of revenues are labelled 'matchday' profits, which are mainly derived from the sale of tickets.<sup>40</sup>

### **3.3 Ticket Sales and Provisions against Resale**

'Matchday' revenues result from a simple combination of property and contract law. The 'house right' to the stadium, which derives from the property right in the stadium or a use right such as a lease, allows the clubs to exclude the public, and to only grant access on a contractual basis. Unfair competition law only plays a marginal role in this respect: it can help to enforce contractual clauses

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38. *Supra* note 15.

39. See the Deloitte report *Football Money League*, available at <https://www2.deloitte.com/content/dam/Deloitte/uk/Documents/sports-business-group/deloitte-uk-deloitte-football-money-league-2020.pdf>.

40. The figures for 2019, according to the Deloitte report, *supra* note 39, are: FC Barcelona: 46%, 35% and 19%; Manchester United: 45%, 38% and 17%; Bayern Munich: 54%, 32% and 14%; Paris Saint-Germain: 57%, 25% and 18%. Unfortunately, the report only lists the top 20 'Money League' clubs, whereas Ajax Amsterdam, according to the report, came twenty-third on this list.

which prohibit the commercial resale of tickets<sup>41</sup> and to protect consumers who buy such tickets without knowing that the ticket may not be accepted.

When the Unfair Commercial Practices Directive was amended in 2019,<sup>42</sup> a new No. 23a was added to the Annex I ‘Black List’, which prohibits the resale of ‘events tickets to consumers if the trader acquired them by using automated means to circumvent any limit imposed on the number of tickets that a person can buy or any other rules applicable to the purchase of tickets’. While, technically, this is a sub-category of misleading practices, this provision at least indirectly also protects the commercial interest of events organisers in drying out secondary ticket markets.

### 3.4 Sponsorship and ‘Ambush Marketing’

The legal basis of the most important revenue stream, namely profits from sponsorship and merchandising, is, again, mostly contractual. In addition, the names and logos of sports clubs and associations are usually protected as trade marks. Unfair competition law can also assist to some extent. Sponsorship contracts allow the sponsors to use the sports club’s or event’s attraction as an advertising tool. As the *Fiat* case shows, non-sponsors sometimes invoke an association with attractive sports events in their advertising. This practice is often referred to as ‘ambush marketing’.<sup>43</sup> But from the perspective of unfair competition law, this term is problematic because it blurs the distinction between its two fundamental categories, namely misrepresentation and misappropriation.<sup>44</sup>

Misleading consumers about sponsorship relationships is unfair, both under causes of action such as passing off which protect the reputation of traders against ‘unfair competition by misrepresentation’<sup>45</sup> and under consumer protection provisions against misleading practices. The EU Unfair Commercial Practices Directive of 2005<sup>46</sup> not only prohibits misleading practices in general, but explicitly proscribes misleading statements in relation to direct or indirect sponsorship (Article 6(1)(c) of the Directive). But actions for confusion or misleading practices fail when it is clear to the consuming public that no such relation exists, and that the trader is merely alluding to the sports event. Indeed,

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41. See the German case BGH GRUR 2009, 173 – *bundesligakarten.de*. According to the BGH, a reseller of football tickets acted unfairly according to § 4 No. 4 UWG (unfair obstruction), when it passed itself off as a consumer when buying tickets. But the court denied a claim for inducing breach of contract, because the resellers only offered ticket holders the opportunity for a breach without inducing it.

42. By means of Directive (EU) 2019/2161, OJ L 328/7.

43. For an overview of ‘ambush marketing’ techniques, see S. Ericson, ‘Ambush Marketing: Examining the Development of an Event Organizer Right of Association’, in N. Lee, G. Westkamp, A. Kur and A. Ohly (eds.), *Intellectual Property, Unfair Competition and Publicity Convergences and Development* (2014), 165, 167–169.

44. On misrepresentation and misappropriation as two basic concepts and ‘moral feelings’ of unfair competition law see D. Visser, ‘Misrepresentation and Misappropriation’, in A. Ohly (ed.), *Common Principles of European Intellectual Property Law* (2012), 247–254.

45. This is the subtitle of C. Wadlow’s treatise *The Law of Passing-Off* (5th edn., 2016).

46. Directive 2005/29/EC, OJ L 149/22.

skilful ‘ambushers’ make sure that they stay on the right side of the line between truth and deception.<sup>47</sup> In the *Fiat* case, the confusion claim was arguably the easiest one to reject for the French courts, and examples from many jurisdictions can be found where confusion claims brought by sports organisers against ‘ambushers’ turned out to be weak.

Whether unfair competition law can and should prevent forms of ‘ambush marketing’ in which nobody is deceived, is a much more controversial question. If the test of misappropriation is a ‘market failure test’, as will be suggested below, it is difficult to see why unfair competition law should step in. Trade mark law and the prohibition of confusion protect the integrity of the sponsorship relationship. While the ‘house right’ may not be an adequate basis for broadcasting rights, it rightly allows sports organisers to ban unauthorised marketing activities on their premises.<sup>48</sup> Thus, at least in US and German law,<sup>49</sup> misappropriation doctrines are likely to fail. Even the French courts hesitate to prevent all references to sports events, as the *Fiat* case shows. Indeed, while sponsors and sports organisers will argue that they suffer damage because the exclusive position of sponsors risks being compromised, there is little evidence that ‘ambush marketing’ which does not cause confusion results in a market failure, in particular that it might undermine the practice of sports sponsorship.

### **3.5      Unfair Competition Law as the Legal Basis of ‘Broadcasting Rights’?**

Although the major football clubs derive a significant part of their revenues by granting broadcasting rights, the legal basis of these deals is far from clear. While the audio-visual recording and the broadcast are protected by neighbouring rights, the event itself is not copyrightable, even if the reason given by the CJEU in the *Premier League* and *Murphy* cases<sup>50</sup> – that football is determined by rules negating space for creative freedom – may not be entirely convincing.<sup>51</sup> The CJEU also played a through pass to the national European legislators by pointing out that

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47. Ericson, *supra* note 43, at 173.

48. As happened in the ‘Dutch lederhosen’ case during the Football World Cup of 2006: the Bavaria brewery handed out orange lederhosen to Dutch fans and encouraged them to wear the pants in the stadium. But the FIFA reacted by denying entry into the stadium to fans in orange lederhosen. See <https://www.theguardian.com/media/2006/jun/19/marketingandpr.worldcup2006>. During the World Cup of 2010, another Bavaria ambush action became known: thirty-six female football fans watched one of the matches, wearing orange dresses given to them as part of a Bavaria gift pack. They were ejected from the match after the first half, and two of them faced criminal charges, see <https://www.playthegame.org/news/news-articles/2010/bavaria-beer-ambush>.

49. See P. Heermann, *Ambush Marketing bei Sportveranstaltungen* (2011), 92–100; N. Melwitz, *Der Schutz von Sportgroßveranstaltungen gegen Ambush Marketing* (2007), 155–219.

50. CJEU, joined cases C-403/08 and C-429/08, *Football Association Premier League v. QC Leisure and Murphy v. Media Protection Services*, [2011] ECR I-9159, paras. 96–98.

51. As Lionel Bently brilliantly showed at an IViR symposium on 4 July 2014, the very basic rules on penalties do leave ample room for creative choices. Ironically, although Lionel Bently argued in favour of copyright protection for (parts of) football matches, the presentation

they were free to introduce sports organisers' rights into their IP systems,<sup>52</sup> but only few European countries, most notably France, have accepted this pass and scored. As a study commissioned by the European Commission and conducted, under the leadership of Bernt Hugenholtz, by the Asser International Sports Law Centre and the Institute for Information Law of the University of Amsterdam shows, sports organisers are presently protected by a rather murky mix of property and contract law doctrines.<sup>53</sup>

The 'house right', which is derived from property law, gives sports organisers the power to conclude licensing agreements. The wooden structure overlooking the racecourse in the old *Victoria Park* case would have to be extremely high to allow a camera team to broadcast matches from the Johan Cruyff Arena or the Allianz Arena. Although this legal construct seems to work well in practice, it is a doctrinal insult to intellectual property lawyers, who are accustomed to distinguishing clearly between property rights in land and movables on the one hand and IP on the other. It also fails practically in several respects. On the one hand, protection is insufficient against third parties who do not enter the stadium, and in the case of sports such as bicycle racing which take place outside stadiums. On the other hand, the 'normative power of the factual' allows sports organisers to dictate their terms without any limitations imposed by the law.

Would unfair competition law be a better basis for sports broadcasting rights? This, of course, depends on the jurisdiction in question. For England and Australia, the answer is 'no'. But in Continental Europe and, to a limited extent, in the USA, a remedy against misappropriation is conceivable. It would go too far to discuss the merits and disadvantages of a misappropriation doctrine here.<sup>54</sup> Suffice it to say that there are sound reasons for allowing unfair competition remedies if (1) intellectual property law neither grants nor pre-empts protection and if (2) without legal intervention there would be the risk of market failure in that (i) the claimant offers products or services for which there is consumer demand, (ii) the defendant takes advantage of the claimant's investments without incurring significant costs, (iii) without legal protection neither the claimant nor other traders would offer the products or services in question in the future and (iv) there are no countervailing interests which trump the interest in protection.<sup>55</sup> In jurisdictions without sports organisers' rights, condition (1) is satisfied: there is no intellectual property right in sports events as such, but IP policy does not militate against such a right either. As for the risk of market failure, it all depends on whether a situation in which unfair competition protection is available is compared to a hypothetical scenario in which no protection exists, or

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was temporarily blocked by YouTube at the instance of FIFA, but it is available again at <https://www.youtube.com/watch?v=bm86FavgKxg>.

52. *Supra* note 50, para. 102.

53. *Supra* note 3, at 59–60.

54. See the references *supra* notes 23 and 37.

55. A. Peukert, 'hartplatzhelden.de – Eine Nagelprobe für den wettbewerbsrechtlichen Leistungsschutz, WRP 2010, 316, 320; Ohly, *supra* note 37, at 494; Schröer, *supra* note 23, 362–381.

to the present-day model of ‘house rights’. Since the current practice is working reasonably well, at least in professional football, one could argue that there is no need for any extra protection. On the other hand, one might consider a factual position without any legal limits as creating a ‘normative market failure’ which calls for *sui generis* legal protection with an adequate scope and adequate limits.<sup>56</sup>

But unfair competition law is ill-equipped to provide a more stable legal basis for sports broadcasting rights. First, the strength of unfair competition law is its flexibility and fact-sensitiveness. Unfair competition protection can be granted when the interests in an individual case warrant protection, and its remedies can be tailored to the individual case. The *Flyonthewall* case,<sup>57</sup> in which the defendant had allegedly misappropriated stock market information and made it available online, is an example in point: the District Court for the Southern District of New York applied the ‘hot news misappropriation’ doctrine and granted an injunction. However, the injunction lapsed not seventy years after the death of the author, but one hour after the opening of the stock exchange. Although the defendant’s appeal was successful, the District Court judgment shows the potential of unfair competition law to allow solutions which are tailored to the case at hand. But the market for broadcasting rights requires certainty and well-defined entitlements, not flexible solutions in individual cases. Secondly, unfair competition law does not normally provide for well-defined exceptions. The limits of protection are determined by balancing the interests of all parties involved. Again, this is not the legal certainty that, for example, broadcasters require for short-term reporting. Finally, the part of unfair competition law which protects competitors (as opposed to consumers) has, with few exceptions, not been harmonised in the EU, and the harmonisation of the law of misappropriation will be a difficult task, if it will ever be achieved at all. In an age of cross-border sports marketing, twenty-seven different national solutions in the EU member states are inadequate.

#### 4. CONCLUSIONS

Unfair competition law is strong when it prevents misrepresentation. In this respect, it has an important role to play when safeguarding sports organisers’ rights and when protecting the interests of fans. It prohibits the sale of black-market tickets when consumers are deceived into thinking that the ticket is valid when it is not, thereby indirectly protecting the sports organisers’ interest in drying out black markets. Unfair competition law can also protect clubs and sponsors against outsiders who create the false impression of sponsorship.

But when it comes to misappropriation, unfair competition law is weak. There is a lack of international consensus. While there are good reasons for accepting a narrow misappropriation doctrine which only allows actions that are

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56. As argued by R. Hilty and F. Henning-Bodewig, *Leistungsschutzrechte für Sportveranstalter?* (2007), 79 et seq. A parallel argument is made for trade secrecy law by M. Lemley, ‘The Surprising Virtues of Treating Trade Secrets as IP Rights’, 61 *Stanford L. Rev.* (2008) 311–353.

57. *Supra* note 15.

not pre-empted by intellectual property law and which only applies to prevent market failures, this doctrine is flexible and case-sensitive, and hence not suitable as a basis of markets for broadcasting rights.

So unfair competition law does not offer a way out of the legal dilemma: should sports lawyers and fans accept the present situation, in which broadcasting rights are based on a murky mix of property and contract law, or should the EU Commission and, possibly, the Council and the Parliament accept the pass played by the CJEU and create a sports organiser's right? Bernt Hugenholtz will be sceptical, and he will also have his own views about whether there is too much money in football and whether the concentration of big money in the major European football leagues – at the expense of leagues like the Eredivisie – is healthy. But there is a clear consumer demand for high-level sport events. If, as Jeremy Bentham famously wrote, push-pin is as good as poetry from a utilitarian perspective,<sup>58</sup> it is hard to see why investment in movies, music and literature needs legal incentives whereas investment in sports events does not. While a broad sports organisers' right as provided by French law is uncertain in scope and hence creates new legal uncertainty, an exclusive right to broadcasting and making available sports events with well-defined exceptions might balance the necessary incentives and the freedoms of information and expression better than the present law does. But that is a question for another day.

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58. J. Bentham, *The Rationale of Reward* (1825), 206, available at Google Books. To be precise, the original quote is 'Prejudice apart, the game of push-pin is of equal value with the arts and sciences of music and poetry.' The short version in the text is a reformulation by J.S. Mill, who disagreed with Bentham on this point, see the Wikipedia entry for Push-pin (game).



# An Economic Note on Reselling Tickets

*Joost Poort*

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## 1. INTRODUCTION

It was not the dramatically lost Champions League semi-final against Tottenham Hotspur. Nor was it goalkeeper Onana popping his wife's pills and being suspended for the rest of his contract. It was not even the acquisition of Feyenoord star Berghuis in the summer of 2021. By the end of the day, it was the realisation that poor investments and infinitesimal interest rates had caused his APB retirement allowances to evaporate, that made Bernt Hugenholtz decide to try and sell his season ticket for Ajax on Marktplaats<sup>1</sup> for a handsome profit. Only to discover that this was not allowed.

Ticket resale or secondary ticketing – derogatorily referred to as touting or scalping – is probably as old as tickets themselves and may occur for various reasons. The focus of this contribution is the resale of tickets for sports events and cultural events such as concerts and theatre performances with the aim of making a profit over the original price – the face value – of the ticket. Below I analyse the economics of ticket resale and the reasons for event organisers to oppose it. In the last section, I discuss some efforts by event organisers to control the secondary market.

## 2. THE ECONOMIC LOGIC OF TICKET PRICING AND TICKET RESALE

Sports events and cultural events such as concerts and theatre performances are perishable goods with low marginal costs, and limited capacity. Sports arenas and concert halls have a fixed maximum capacity while some of the seats offered have higher quality than others as they offer a better view of the field or stage.

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1. The Dutch equivalent of Ebay.

An unsold ticket for tonight's game or show has lost all its value by tomorrow, while the marginal costs of servicing an additional spectator are very small. Although these aspects make events different from most goods and services, they are far from unique. Airline tickets and hotel rooms for instance, share these same characteristics. In these industries, price setting is a highly important and intricate issue. One could almost say price setting in such industries is an art in itself, which makes the difference between making a profit or making a loss.

Against this background, it may be surprising that there is quite some (older) literature that indicates that the demand for performing arts tickets is generally inelastic, implying that organisers of such events can increase their revenues and thus their profits – or in case of subsidised arts: reduce their deficit – by raising their prices.<sup>2</sup> Moreover, the literature repeatedly found that concert organisers benefit from price discrimination, while for a long time, most venues have sold at uniform prices and some still do.<sup>3</sup> On the other hand, ticket prices for concerts have increased by much more than the general inflation rate of the past decades, particularly since the late 1990s, while differentials between the lowest and highest priced tickets have increased.<sup>4</sup> Thus, one may conjecture that event organisers have by now learned the ropes of optimal pricing and know how to extract maximum value out of their attendees.

## 2.1 Why is Ticket Resale so Persistent?

What these rapidly increasing prices and price dispersion have not eradicated, however, is ticket resale. In 2002, Krueger estimated between 20 and 25% of tickets for a Bruce Springsteen concert in the US had been bought through a 'scalper', ticket broker or 'over the web'.<sup>5</sup> Courty quotes a slightly lower but still substantial figure of 10%, going up to 20–30% for top-tier seats.<sup>6</sup> And in 2020, Behr and Cloonan mention 25% of respondents in a UK survey buying from the secondary market.<sup>7</sup>

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2. E.g. see M.V. Felton, 'On the assumed inelasticity of demand for the performing arts', 16 *Journal of Cultural Economics* (1992) 1–12 and references therein. Felton nuances that statement, by pointing out that it is true on average, but not always.
3. P.A. Huntington, 'Ticket pricing policy and box office revenue', 17 *Journal of Cultural Economics* (1993), 71–87. L. Volpano, 'A proposal to rationalise entertainment ticket pricing using price discrimination', 1 *Journal of Revenue and Pricing Management* (2003), 379–382. P. Leslie, 'Price Discrimination in Broadway Theater', 35(3) *The RAND Journal of Economics* (2004), 520–541.
4. M. Connolly and A. Krueger, 'Rockonomics: The Economics of Popular Music', in V.A. Ginsburgh and D. Throsby (eds.), *Handbook on the Economics of Art and Culture*, vol. 1 (2005), 667–719; A. Behr and M. Cloonan, 'Going spare? Concert tickets, touting and cultural value', 26(1) *International Journal of Cultural Policy* (2020), 95–108.
5. Connolly and Krueger, *supra* note 4.
6. P. Courty, 'Some Economics of Ticket Resale', 17(2) *Journal of Economic Perspectives* (2003), 85–97.
7. Behr and Cloonan, *supra* note 4.

So how can this situation exist and persist? Several explanations have been provided in the literature.<sup>8</sup> Uncertainty about demand and positive social externalities of a sold-out event cause event organisers to prefer underpricing to overpricing. They would rather miss out on revenue than not be sold out. Moreover, externalities for the organiser may result from selling complementary goods and services, such as merchandise, making a degree of underpricing a profit-maximising strategy.<sup>9</sup> It has been suggested that the insight from behavioural economics that consumers value being treated fairly may also offer part of the explanation: market clearing prices may be considered unfair and alienate fans from the band or sports team they want to watch.<sup>10</sup>

But all these explanations are partial and unsatisfying. Concerns over fairness did not stop event organisers from increasing prices systematically at rates that are significantly above inflation levels over the last decades. Yet ticket reselling persisted at high levels. Moreover, ticket resellers often charge several times the face value for tickets. Even a ten-fold price increase is not unheard of, and it is hard to believe it is part of a deliberate strategy by event organisers to forego such enormous additional profits.

An important contribution to understanding why ticket resale is so persistent was offered by Courty.<sup>11</sup> Borrowing from the literature on airline ticket pricing, the author does not buy into the fact that organisers deliberately underprice but conjectures that ticket resale offers intertemporal price discrimination (i.e., price variation over time), which is not offered by event organisers themselves. Consumers gain new information about their demand over time, and some consumers will only know quite late that they will be willing and able to visit a sports match or concert, while others prefer to plan in advance. Amongst those who postpone their decision to buy a ticket, some will have a high valuation as the event draws near. However, an event organiser who puts all tickets on sale at once will not be able to extract that extra willingness to pay from late deciders.

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On a sidenote: the distinction between these two stylised types of visitors is often framed in terms of ‘real fans’ versus ... well, versus what?<sup>12</sup> Bernt may hate me for saying this, but for an economist, it is hard to swallow that someone with a busy agenda and probably higher opportunity costs of time, who is willing to pay more than people with an emptier agenda, is not a ‘real fan’. On the contrary! These people put their money where their mouth is.

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8. See Connolly and Krueger, *supra* note 4 and Courty, *supra* note 6 for a short discussion.
9. D.R. Marburger, ‘Optimal ticket pricing for performance goods’, 18(5) *Managerial and Decision Economics* (1997), 375–381.
10. D. Kahneman, J. Knetsch and R. Thaler, ‘Fairness as a Constraint on Profit Seeking: Entitlements in the Market’, 76(4) *The American Economic Review* (1986), 728–741.
11. Courty, *supra* note 6.
12. E.g. see Behr and Cloonan, *supra* note 4.

But then again, economists are not like normal people. In a study by Kahneman et al., a majority was found to consider a queue the fairest way to allocate sports tickets, followed by a lottery. Only 4% thought that an auction – the price mechanism – was fairest.<sup>13</sup> In economic terms, a queue for selling tickets equates to an auction in which time is the currency that determines allocation, while the proceeds of the auction are destroyed instantly. Conversely, a monetary action allocates tickets based – at least partly – on the value consumers derive from it, while no welfare is destroyed in the allocation process.

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The logic of intertemporal price discrimination becomes most prominent when the act starring in an event is not known in advance. This is the case for matches in sports tournaments – say a world championship soccer final – where at the time tickets are to be sold, no-one knows which two teams will play. For most aspiring visitors, their willingness to pay will depend heavily on which teams will play. This implies that any allocation of tickets before this information is available will be extremely inefficient, while the receipts will be a fraction of what they could have been. Needless to say that this is a recipe for ticket resale on a massive scale.

Whether it is a sense of fairness on behalf of event organisers, underpricing in the face of uncertainty, or intertemporal price discrimination, the consequence is the same: it creates lucrative opportunities for market arbitrage by reselling tickets. Note that this activity is not without risk. Ticket brokers are often also active in events that do not sell out and are sometimes left with unsold tickets themselves.<sup>14</sup>

## 2.2 Why Do Organisers Resent Resale?

From a welfare-economic viewpoint, the case can be made that ticket brokers improve welfare by improving the allocation of event tickets. They help them land in the hands of those spectators who value them most. From a business perspective, one could argue they help optimise the marketing of event organisers, offering additional points of sale and reaching other customer groups. What is more, they take over some of the risk involved in planning an event by buying tickets in advance. Hence, if demand uncertainty were the primary reason for underpricing tickets and by doing so fuelling the secondary market, one would expect event organisers to applaud ticket reselling or at least accept it as a useful phenomenon. In fact, this may have been behind the long-standing pact between West End theatres and tickets booths throughout London selling to tourists at inflated prices.

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13. D. Kahneman, J.L. Knetsch and R.H. Thaler, 'Fairness and the assumptions of economics', 59(4) *Journal of Business* (1986), 285–300.

14. Courty, *supra* note 6.

In general, however, event organisers condemn secondary ticketing and try to prevent it – or say they do. Why so? One explanation is that event organisers are ‘caught in the middle’ between ticket brokers and consumers:<sup>15</sup> brokers extract surplus from consumers by improving the allocation of tickets, but they also ration supply by taking tickets from the market in order to resell them later. Consumers will consider what they pay above the face value of a ticket a rip-off, even if they are willing to pay it, and may ask organisers to intervene on their behalf.

A second explanation offered by Courty is that event organisers may want to deter brokers as they want to capture the rents in the secondary market themselves. I have named this desire to control aftermarkets and to expropriate the rents that may be generated in it a ‘jealousy tax’ in the context of copyrighted works.<sup>16</sup> Put more friendly, the argument would be that event organisers prefer any rents they cannot extract from selling tickets themselves to stay in the pockets of their spectators – framed as the ‘real fans’ – rather than to land in the pockets of brokers, even if it leads to suboptimal allocation of tickets from a welfare-economic perspective.

### 3. DISCUSSION: COMBATTING RESALE

Event organisers have made several efforts to prevent ticket resale. The most straightforward approach – alluded to in the introduction – is simply to print on a ticket that it cannot be resold. This opens the debate as to whether a ticket is a piece of property owned by the buyer – an analogy with exhaustion of copyright comes to mind – or perhaps a token signifying a service contract between the organiser and a buyer.<sup>17</sup> Although the validity of this approach is debatable, it is hard to enforce in practice. It requires careful scrutiny of ID cards when thousands of attendants enter a concert hall or stadium within a short time span, and also makes it impossible (at least in theory) to give your ticket to your neighbour if you have a headache on the night of a show or game.

Attempts in the UK to pass legislation to the effect of banning ticket resale have failed by being watered down from a ban, to a financial cap on the markup on the face value of a ticket, to transparency requirements.<sup>18</sup>

Given the strong economic logic behind ticket resale explained above, fighting it is like arm-wrestling with Adam Smith’s invisible hand. Where money is left on the table, entrepreneurs will strive to pocket it. Therefore, the most successful ways to deal with ticket resale are to play along with the market. In the case of selling tickets for sports events with yet unknown teams, this has been done by selling options instead of tickets in advance. These options can be exercised only if your team will be playing the match. In this way, organisers are

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15. Courty, *supra* note 6.

16. J. Poort, ‘Borderlines of Copyright Protection: An Economic Analysis’, in P.B. Hugenholtz (ed.), *Copyright Reconstructed. Rethinking Copyright’s Economic Rights in a Time of Highly Dynamic Technological and Economic Change* (Kluwer Information Law Series, Alphen aan den Rijn, 2018), 283–338.

17. Behr and Cloonan, *supra* note 4.

18. Behr and Cloonan, *supra* note 4.

able to extract much more consumer surplus from the market and leave much less for resellers. A second strategy was pursued by Ticketmaster when it bought the reselling website GetMeIn in 2008.<sup>19</sup> If you cannot beat them, buy them.

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19. Behr and Cloonan, *supra* note 4.

# Ethnic References in Branding and Artificial Intelligence Content Moderation: From the Ajax ‘Jews’ to the Washington Redskins and Beyond

*Neil Weinstock Netanel*

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## 1. INTRODUCTION

Sports teams sometimes adopt names – and fans sometimes adopt team nicknames – that might be viewed as derogatory epithets targeting a particular racial, ethnic, or religious group, but which serve as a badge of honour for team fans or even for members of the targeted group. How does and should trademark law address such uses, particular uses of derogatory epithets that are ‘reclaimed’ as badges of honour by a minority group? How do AI content moderation tools account for social media user postings that feature hate speech or reclaimed epithets, whether as sport team names or otherwise? And, to put those questions into their broader framework: how is regulation, whether through formal law or AI, to account for semiotic fluidity, the variable meaning of words over different temporal, spatial, and social contexts?

My essay is inspired by the Ajax ‘Jews’, a phenomenon that Bernt Hugenholtz brought to my attention some twenty-five years ago.

## 2. AJAX

Ajax, a club based in Amsterdam and founded in 1900, has long dominated football competition in the Netherlands.<sup>1</sup> Ajax has no direct connection with

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1. See AFC Ajax, Wikipedia, [https://en.wikipedia.org/wiki/AFC\\_Ajax](https://en.wikipedia.org/wiki/AFC_Ajax).

Jewish organisations or the Jewish community of Amsterdam.<sup>2</sup> Nonetheless, in recent decades, fervent Ajax supporters have come to call themselves ‘Jews.’ In so doing, the supporters – very few, if any, of whom are actually Jews – have enthusiastically embraced a self-styled ‘Jewish’ identity. At Ajax matches, they waive Israeli flags, chant a version of the Israeli folk song, *Hava Nagila*, and proclaim, with great gusto, that they are ‘Joden’ (Jews) or ‘Superjoden’ (Super Jews). Many also sport Star of David pendants and tattoos.

Ajax’s association with Jews apparently stems from the fact that Ajax’s pre-World War II stadium was located adjacent to Jewish neighbourhoods in east Amsterdam. According to Ajax’s club historian: ‘The supporters of Ajax’s opponents used to arrive at Weesperpoort Station, where there were a lot of Jewish street vendors. So they would say, “We’re going to the Jews”’.<sup>3</sup> Dutch football fans’ labelling of Ajax as a Jewish team might also derive from the Dutch view of Amsterdam as having a Jewish flavour. Amsterdam has been home to a sizeable Jewish community since the early sixteenth century. On the eve of World War II, some 80,000 Jews lived in Amsterdam, comprising roughly ten percent of the city’s population.<sup>4</sup> Finally, in the 1950s several Jewish Holocaust survivors played on the team or served in its management, helping to turn Ajax into a highly successful football club.<sup>5</sup>

In any event, by the 1960s fans of opposing clubs came to derisively call Ajax a ‘Jew club’.<sup>6</sup> In response, Ajax supporters embraced the attempted insult, recasting the ‘Jews’ label as a badge of honour. And as Ajax supporters have ardently celebrated their ersatz Jewish identity through a variety of Jewish symbols and tropes, opposing fans regularly counter by chanting anti-Semitic slogans, including calls to send the ‘Jews’ to the gas chambers. The back and forth between Ajax supporters and opponents became more virulent following the emergence of football hooliganism in the Netherlands in the 1970s. Ajax fans began to wave the Israeli flag in the early 1980s, and opposing fans increasingly invoked Nazi symbols and references to the Holocaust.<sup>7</sup>

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2. I draw upon a number of sources in this section. They include: David S. Winner, ‘Don’t Blame Soccer’s “Jewish” Teams for Anti-Semitism’, *Foreign Policy*, 10 May 2019, <https://foreignpolicy.com/2019/05/10/dont-blame-for-anti-semitism-in-soccer-tottenham-hotspur-spurs-ajax-amsterdam/#>; Amir Vodka, ‘Superjews: Thoughts on Ajax and the Jews following Nirit Peled’s Documentary Film’, *Springerin*, February 2014, <https://www.springerin.at/en/2014/2/die-super-joden-von-ajax>; Eric Collier, ‘Ajax and the Jewish Issue’, *Le Monde*, 16 February 2005, translated by Bertrand Chardon, *Ajax USA Archives*, <http://ajaxusa.blogspot.com/2005/02/ajax-and-jewish-issue.html>; Craig Smith, ‘A Dutch Soccer Riddle: Jewish Regalia Without Jews’, *N. Y. Times*, 28 March 2005, <https://www.nytimes.com/2005/03/28/world/europe/a-dutch-soccer-riddle-jewish-regalia-without-jews.html>; I also draw upon Nirit Peled’s documentary film *Superjews* (2013).
3. Simon Kuper, *Ajax, the Dutch, The War: The Strange Tale of Soccer During Europe’s Darkest Hour* (Bold Type Books, 2012), 18 (quoting Ajax club historian Evert Vermeer).
4. Peter Tammes, ‘Surviving the Holocaust: Socio-demographic Differences Among Amsterdam Jews’, *30 Eur. J. Population* (2017) 293, 294, 299.
5. Kuper, *supra* note 3, at 187.
6. *Ibid.* at 194.
7. *Ibid.* at 222.

For real Jews, the phenomenon of the Ajax ‘Jews’ evokes a range of responses. Some are bemused. Jewish Israelis are said to ‘love the chants and symbols of Ajax supporters, whom they assume to be philosemites.<sup>8</sup> But some Amsterdam Jews experience painful discomfort at Ajax fans’ appropriation of Jewish symbols to serve as unofficial emblems for a football team – and, on occasion, football hooligans. For them, the Ajax ‘Jews’ amounts to an unthinking usurpation of Jewish identity, particularly in the wake of the murder of some 65,000 Amsterdam Jews – three-quarters of the prewar population – at the hands of the Third Reich and its Dutch collaborators.<sup>9</sup> Dutch Jews also blame Ajax fans’ self-proclaimed ‘Jewish’ identity for provoking opponents’ raucous calls to send Jews to the gas chambers. Many Jewish Ajax fans have stopped going to matches as a result.<sup>10</sup>

For their part, Ajax’s management has reacted ambivalently to its fans’ ardent cultivation of the club’s ‘Jewish’ brand. At one point, ringtones of *Hava Nagila* could be downloaded from the club’s official website. But Ajax management has since downplayed its historic Jewish links and generally sought to discourage Ajax fans’ appropriation and refashioning of Jewish songs, chants, and symbols, especially as Ajax fans’ enthusiastic embrace of ‘Jewish’ identity has elicited virulent anti-Semitic retorts from opposing fans. Ajax’s avid supporters have responded that their decades-old self-branding as Ajax Jews has become an irrevocable part of their own identity.

### 3. ETHNIC REFERENCES AS SPORTS TEAM BRANDS

The phenomenon of the Ajax ‘Jews’ is not entirely unique. Another football team, Tottenham Hotspur, located adjacent to an Orthodox Jewish neighbourhood in north London, has experienced a similar clash of tropes. Opposing fans call Tottenham ‘Yids’ as an anti-Semitic insult and Tottenham supporters tout the label as a badge of honour.<sup>11</sup> In addition, the Ghent football club, KAA Gent, features an image of a Native American chieftain as its logo, a practice that hearkens back to 1906, when the American Barnum & Bailey Circus, starring William ‘Buffalo Bill’ Cody and his ‘Wild West Show’, visited the city.<sup>12</sup> Aside from those examples, I’m not aware of other instances of ethnic references being employed as football team brands, whether official or unofficial, in Europe or the United Kingdom.

By contrast, in the United States thousands of professional, collegiate, and high school sports teams have long used Native American references for team names and Native American imagery for team mascots. Common team names that refer to Native Americans have included Indians, Braves, Chiefs, Warriors,

8. *Ibid.* at 226.

9. See Tammes, *supra* note 4, at 305; History of the Jews in Amsterdam, Wikipedia, [https://en.wikipedia.org/wiki/History\\_of\\_the\\_Jews\\_in\\_Amsterdam](https://en.wikipedia.org/wiki/History_of_the_Jews_in_Amsterdam).

10. Kuper, *supra* note 3, at 226.

11. See Winner, *supra* note 2.

12. See KAA Gent, Our Club, <https://www.kaagent.be/en/our-club/logo>.

Redskins, and Squaws. Team names also include the names of Native American tribes, including Sioux, Illini, and Seminole, and storied warriors, such as Black Hawk. In most cases, the names and images have been officially adopted by the team, but fans have sometimes added their own Native American references as nicknames and mascots.

The terms Redskins and Squaws have long served as derogatory racist slurs. Many Native Americans – and non-Native Americans – thus find those terms deeply offensive. The remaining common team names enumerated above do not have derogatory lexical meanings. But for many Native Americans, the use of Native American names and images for sports logos, mascots, and fan chants is inherently disparaging and dehumanising. Critics charge that such uses ‘remove humane characteristics from Native Americans, depicting them instead as objects, cartoon characters, and savages.’<sup>13</sup> Further, they insist, the use of Native American symbols ‘for purely entertainment purposes has a particularly deleterious effect because it trivializes the very basis of many cultural and religious beliefs.’<sup>14</sup>

At the same time, some Native Americans appear to embrace sports teams’ use of Native American tropes, at least in ways that, they perceive, honour Native American heritage.<sup>15</sup> Moreover, it is probably fair to say that for the vast majority of sports team fans, the team name and mascot have traditionally stood for their favourite team and virtually nothing else. To the extent logos have expressed anything relating to Native Americans, they invoke stereotypical characteristics, like bravery and physical prowess, that are regarded as laudable attributes for athletes. It seems plausible, therefore, that, for decades, team fans boisterously chanted Native American references, cheered cartoonish Native American mascots, and wore clothing featuring Native American images with no conscious intention to disparage or dehumanise – perhaps like Ajax fans’ self-proclaimed identity as ‘Jews’.

In recent years, however, it is hard to imagine that American fans remain unaware that many Native Americans find sports teams’ reference to Native Americans deeply offensive. Following decades of protests and pressure from various Native American groups, dozens of collegiate and high school teams have dropped their Native American names and mascots. Within the last two

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13. Jeff Dolley, ‘The Four R’s: Use of Indian Mascots in Educational Facilities’, 32 *J.L. & Educ.* (2003) 21, 26.
14. Justin G. Blankenship, ‘The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend?’, 72 *U. Colo. L. Rev.* (2001) 415, 424.
15. A group of academic co-authors and activists levelled a devastating critique of the framing and methodology of a poll, published by the popular sports magazine *Sports Illustrated*, that purported to show that the vast majority of Native Americans support the use of Native American mascots in sports. Nonetheless, the co-authors acknowledged that at least ‘some Native Americans not only endorse but also defend the use of Indianness in athletics.’ C. Richard King et al., ‘Of Polls and Race Prejudice; Sports Illustrated’s Errant “Indian Wars”’, 26(4) *J. Sport & Social Issues* (Nov. 2002), 381–402, at 381. Some tribes have also partnered with sports teams bearing Native American references, including the Eastern Band of Cherokee Indians (with the Atlanta Braves) and the Seminole Tribe of Florida (with the Florida State University Seminoles).

years, so have the professional football team previously named the Washington Redskins (now the Washington Football Team) and the professional baseball team previously named the Cleveland Indians (now the Cleveland Guardians).

#### 4. ETHNIC REFERENCES AS TRADEMARKS

To my knowledge, neither Ajax management nor Ajax fan clubs have sought to register a trademark for 'Joden', 'Superjoden', or any related words or symbols in connection with Ajax or football.<sup>16</sup> But KAA Gent holds registered E.U. trademarks that feature its Native American chieftain logo.<sup>17</sup> And in the United States, a number of American professional and collegiate sports teams hold registered trademarks that feature Native American-related symbols. The professional teams include the Washington Football Team, Cleveland Guardians, Atlanta Braves, Kansas City Chiefs, and Chicago Blackhawks, all of which hold trademarks in their names and mascots – or, with respect to Washington and Cleveland, their former names and mascots.

In the United States, Section 2(a) of the Lanham Act provides that trademarks may be refused registration if the trademark 'comprises immoral, deceptive, or scandalous matter; or matter which may disparage ... persons ..., institutions, beliefs, or national symbols, or bring them into contempt, or disrepute'.<sup>18</sup> In 2014, following some fifteen years of administrative proceedings and litigation, the Trademark Trials and Appeals Board ordered the cancellation of the Washington Redskins trademarks on the grounds that they disparage Native Americans.<sup>19</sup> The next year, a federal district court granted a summary judgment upholding the cancellation, citing evidence that the 'Redskins' marks may disparage Native Americans.<sup>20</sup>

However, in 2017, in *Matal v. Tam*, the Supreme Court ruled that the disparagement clause of the Lanham Act is facially invalid under the First Amendment's protection of freedom of speech.<sup>21</sup> In 2018, the Fourth Circuit accordingly vacated the District Court's summary judgment upholding the cancellation of the Redskins trademark and the Trademark Office then dismissed the Native Americans' petition for cancellation.<sup>22</sup> Subsequently, in 2019, in *Iancu v. Brunetti*, the Supreme Court ruled that the statutory bar on trademarks containing 'immoral

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16. No such trademark appears on the European Intellectual Property Office's trademark registry. There is only a registered trademark for the official logo of Ajax Amsterdam. TM No. 000424036, registered 23 September 2002.

17. European Union Intellectual Property Office, Trademark Nos. 010316371, 011636248, and 011636289, <https://euipo.europa.eu/eSearch/#details/owners/476669>.

18. 15 U.S.C. §1052(a).

19. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (2014).

20. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D.Va. 2015).

21. *Matal v. Tam*, 137 S.Ct. 1744 (2017).

22. *Pro-Football, Inc. v. Blackhorse*, 709 Fed. Appx. 182 (4th Cir. 2018); Trademark Trial and Appeal Board, *Blackhorse v. Pro-Football, Inc.*, Cancellation No. 92046185 (April 9, 2018), <https://ttabvue.uspto.gov/ttabvue/v?pno=92046185&pty=CAN&eno=202>

or scandalous matter' is also facially invalid under the First Amendment.<sup>23</sup> In short, following *Matal* and *Iancu*, the Trademark Office may no longer refuse to register a trademark on the grounds that the trademark is either generally offensive or otherwise disparages a racial or ethnic group or a religious belief.

By contrast, in the European Union, blasphemous, racist, discriminatory, or insulting words or phrases may not be registered as trademarks. Such marks are understood to fall within the absolute prohibition on registration of 'trade marks which are contrary to public policy or to accepted principles of morality' set out in Article 7(1)(f) of the European Community Trademark Regulation.<sup>24</sup> Pursuant to the Regulation, such marks may be invalidated and cancelled at any time, although the relevant date for determining whether a mark contravenes the Article 7(1)(f) prohibition is the date of the application for the trade mark, not the date of a petition for cancellation.<sup>25</sup> Moreover, any person – even someone who is not an EU national – may apply to invalidate a Community Trademark on those grounds.<sup>26</sup> The absolute prohibition against registering racist or discriminatory trademarks is understood to be a matter of the general public interest, not just that of members of the targeted group.

The European Union Intellectual Property Office (EUIPO) has applied Article 7(1)(f) to deny registration to marks such as NOT MADE IN CHINA,<sup>27</sup> SUDACA,<sup>28</sup> and PAKI.<sup>29</sup> The leading European judicial ruling in this area is *PAKI Logistics GmbH v. OHIM*. In *PAKI*, the European General Court upheld the EUIPO's refusal to register the word 'PAKI' as a trademark.<sup>30</sup> The Court agreed that the term contravenes accepted principles of morality and public order. PAKI, the Court found, is perceived by the English-speaking public in the European Union as a racist term, a word that connotes a derogatory, insulting designation of a Pakistani who lives in the United Kingdom.

European Union law is not unmindful that the ban on registering offensive trademarks may conflict with freedom of expression. Indeed, in its Judgment of 27 February 2020, *Constantin Film Produktion GmbH v. EUIPO*, the Court of

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23. *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

24. Council Regulation (EC) No. 207/2009.

25. Judgment of 3 June 2009, T-189/07, 'Flugbörsen'; confirmed by Order of 23/04/2010, C-332/09 P, 'Flugbörsen'.

26. See Susan Snedden, 'Immoral Trade Marks in the UK and at OHIM: How would the Redskins Dispute be Decided There?', 11 *J. Intellectual Property L. & Practice* (2016) 270, 272. See also Mark J. Randazza, 'Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights', 16 *Nev. L.J.* (2015) 107.

27. EUTM Refusals 004631305, 004688561, 004631966 (noting that the proposed mark 'casts an unpleasant slur upon the reputation of Chinese workmanship').

28. EUTM Refusals 004118915 (SUDACA), 010971752 (SUDAKA). Sudaca is a disparaging term used in Spain to refer to a South American.

29. EUTM Refusal 005148581 (PAKI). For discussion of denials of registration to racial slurs and disparaging terms, see Colin Edward Manning, 'Moral Bars on Trade Mark Registration', (September 2016), at 52–56, [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2875687](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2875687).

30. *PAKI Logistics v. OHIM*, Case T-526/07 (General Court, 5 October 2011). Prior to March 2016, the EUIPO was named the Office for Harmonization in the Internal Market as was commonly referred to as OHIM.

Justice of the European Union held that ‘freedom of expression, enshrined in Article 11 of the Charter of Fundamental Rights of the European Union must ... be taken into account when applying Article 7(1)(f).’<sup>31</sup> But unlike the US Supreme Court in *Matal* and *Iancu*, the CJEU did not rule that prohibitions on registering morally offensive trademarks are facially invalid. Instead, the CJEU set out a high substantive and procedural threshold that must be met for the absolute prohibition on registration to apply.

To meet that threshold, the Court held, the mark must, at the time of the EUIPO examination, ‘be perceived by the relevant public as contrary to fundamental moral values and standards of society as they exist at that time’.<sup>32</sup> It is not enough that the mark merely be regarded as being in bad taste. In addition, an Article 7(1)(f) prohibition must rest on a factual inquiry ‘based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered and where appropriate, the particular circumstances of the part of the [European] Union concerned.’<sup>33</sup> ‘To that end,’ the CJEU continued, ‘elements such as legislation and administrative practices, public opinion and, where appropriate, the way in which the relevant public has reacted in the past to that sign or similar signs, as well as any other factor which may make it possible to assess the perception of that public, are relevant.’<sup>34</sup>

It is unclear the extent, if any, that *Constantin Film* would apply to racially disparaging marks. *Constantin Film* involved a proposed mark that featured a vulgar phrase, not a racially disparaging mark. Further, the EUIPO refused to register the vulgar mark on the sole ground that the mark would be contrary to accepted principles of morality, while racially disparaging marks are understood to be contrary to public policy as well as to accepted principles of morality.<sup>35</sup>

In any event, the *Constantin Film* ruling would seem to countenance an absolute prohibition against registering marks that the relevant public perceives to be racially disparaging, even taking freedom of expression into account. First, the Article 7(1)(f) ban on racially disparaging marks is understood to rest on the general prohibition against discrimination, which, like the right to freedom of expression, is enshrined in the Charter of Fundamental Rights of the European Union.<sup>36</sup> Secondly, unlike in the United States, European law does not generally view prohibitions of racially disparaging speech as an impermissible abridgement of freedom of expression. Indeed, European countries typically make various forms of hate speech, including group defamation, neo-Nazi

31. Case C-240/18, EU:C:2020:118, ¶56.

32. *Ibid.*, ¶41.

33. *Ibid.*, ¶42.

34. *Ibid.*

35. For further discussion of the conceptual boundaries and legal tests for the public policy and morality exclusions, including with regard to the *Constantin Film* ruling, see, generally, Alvaro Fernandez-Mora, ‘Inconsistencies in European Trade Mark Law: The Public Policy and Morality Exclusions’, 4 *IP Quarterly* (2020) 271.

36. *PAKI Logistics*, *supra* note 31, ¶15; Charter of Fundamental Rights of the European Union, Art. 21.

speech, and holocaust denial, a criminal offence.<sup>37</sup> European law recognises that individuals' freedom of expression must give way to regulations designed to protect democracy, including by combatting racial hatred through criminalising hate speech.<sup>38</sup>

Of particular relevance to our discussion, the UK Football (Offences) Act 1991 makes it a criminal offence to engage in chanting that is 'threatening, abusive, or insulting to a person by reason of his colour, race, ... or ethnic or national origins' at a football match.<sup>39</sup> Spain's Law 19/2007 of July 11, Against Violence, Racism, Xenophobia and Intolerance in Sport contains a similar provision.<sup>40</sup> More broadly, Article 137c of the Dutch Penal Code provides that '[a] nyone who publicly ... intentionally insults a group of people because of their race, their religion or belief, [or] their heterosexual or homosexual orientation ... will be punished [with imprisonment of] up to one year or a fine.'<sup>41</sup>

Yet how are regulatory authorities to determine whether a trademark is disparaging to persons by reason of their race, ethnicity, or national origin? Must the trademark applicant intend to disparage? Must the mark be disparaging when used in connection with the applicant's goods or services? Must the mark be perceived as disparaging by the public at large, relevant consumers of the applicant's goods or services, or just the targeted group? What if the trademark is perceived as disparaging by some members of the targeted group and not others? What if a word or phrase appearing in the trademark in question has multiple meanings or if its meaning is in flux?

Those questions were addressed in both the Washington Redskins case in the United States and in *PAKI Logistics* in the European Union. In its ruling in *Pro-Football, Inc. v. Blackhorse*, the Eastern District of Virginia emphasised that the Lanham Act barred registration for marks that 'may disparage' 'a substantial composite' of Native Americans.<sup>42</sup> The 'may disparage' standard the Court held, does not require a finding that the mark necessarily disparages. It only requires that members of the targeted group *might* find the mark disparaging or offensive. Nor does the 'may disparage' standard require that the mark holder possess an intent to disparage.<sup>43</sup> Further, the Court held, when determining whether the term 'redskins' 'may disparage' Native Americans, courts must look to the views of Native Americans, not those of the general public. Finally, the Court

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37. See Ioanna Tourkochoriti, 'Should Hate Speech Be Protected? Group Defamation, Party Bans, Holocaust Denial and the Divide between (France) Europe and the United States', 45 *Colum. Hum. Rts. L. Rev.* (2014) 552 (presenting a breakdown of EU hate speech legislation).

38. See, e.g., Council Framework Decision 2008/913/HA of 28 November 2008 on Combating Certain Forms and Expressions of Racism and Xenophobia by Means of Criminal Law, ¶(1); Art. I (defining racism as a violation of democratic principles and requiring European Union countries to punish intentional 'inciting to ... hatred directed against persons by reference to race, colour, religion, decent, or national or ethnic origin').

39. Football (Offences) Act 1991, §3.

40. Law 19/2007 of July 11, Article 2.

41. Dutch Penal Code, Article 137, <https://wetten.overheid.nl/BWBR0001854/2020-07-25/#>

42. *Pro-Football, Inc. v. Blackhorse*, 112 F.Supp.3d 439, 468 (E.D. Va. 2015).

43. *Ibid.* at 472.

held, ‘a substantial composite is not necessarily a majority.’<sup>44</sup> In that regard, the Trademark Office need not conduct a poll of the targeted group to determine how members of that group might perceive the mark. Rather, it may look to whether dictionary definitions, media references, and statements of leading members of the targeted group support the view that the mark is disparaging.<sup>45</sup>

In assessing that evidence, the Court found that the Redskins marks met the standard for ‘may disparage’ ‘a substantial composite’ of Native Americans, despite evidence presented by the mark owner that some Native Americans do not find the term ‘redskins’ disparaging.<sup>46</sup> Accordingly, the Court granted Blackhorse’s motion for summary judgment for cancellation of the Redskins marks, a summary judgment that was later vacated after the Supreme Court ruled that the Lanham Act’s ban on disparaging marks violated the First Amendment.

In *Paki Logistics*, the European General Court rejected the applicant’s argument that its proposed mark, ‘PAKI’, did not contravene public order or morality.<sup>47</sup> The applicant argued that the Article 7(1)(f) prohibition should apply only to marks that are understood exclusively as a racist insult. In particular, the applicant argued that, even if a word mark would be perceived as racist and derogatory when used to refer to a given group of people, the Article 7(1)(f) prohibition should not apply when the word has no such meaning when employed as a trademark for the applicant’s goods and services. In this case, the applicant argued, it marketed its services only to logistics companies and forwarding agents who would not view the ‘PAKI’ mark as having any racist or derogatory connotation.

In rejecting the applicant’s argument, the Court held that marks consisting of racial slurs are inherently contrary to morality or public order regardless of the goods or services for which they are sought to be registered.<sup>48</sup> The Court further found, relying on evidence submitted by OHIM and the UK Government, that English speakers in the EU would generally understand the PAKI mark as an offensive, racial insult. Notably, the Court looked to whether the mark would generally be understood as a racial insult among English speakers in the EU, not, like the US court in *Pro-Football, Inc.*, whether the targeted group would itself understand the mark in that way.<sup>49</sup> Indeed, the Court dismissed evidence that Pakistanis had begun to use the term ‘Paki’ to refer to themselves, although it granted that, in principle, a word that originally constituted a racial insult might evolve into a term that is no longer considered offensive.<sup>50</sup>

What, then, if the Ajax management were to reverse course and apply to register a trademark for Ajax Joden or Superjoden, or for a graphic blue-and-white Star of David superimposed over the current Ajax logo? Would such marks be prohibited under Article 7(1)(f)? Under *PAKI Logistics* the answer would depend

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44. *Ibid.* at 468.

45. *Ibid.* at 473.

46. *Ibid.* at 485.

47. *PAKI Logistics*, *supra* note 31, ¶¶14, 18.

48. *Ibid.* at ¶15.

49. *Ibid.* at ¶¶27–28.

50. *Ibid.* at ¶¶16, 25–26.

on whether the word marks would be understood as offensive, racial insults by Dutch speakers and whether the graphic mark would be thus understood by those Europeans who would likely view the mark. By contrast, if we were to apply the *US Pro-Football, Inc.* test for marks that may be disparaging, we would look to whether a substantial composite of Jews perceive those marks as an offensive, racial insult. The mark owner's intent is not relevant under either test, except for perhaps as evidence of how the relevant publics might view the mark.

The word marks Joden and Superjoden, and the graphic blue-and-white Star of David mark, whether standing alone or in conjunction with Ajax, would not seem to be inherently offensive. The word Joden is simply the neutral dictionary term for Jews in Dutch. And the blue-and-white Star of David sported by Ajax fans is, for most Jews, a sign of national pride, drawn from the Israeli flag. Indeed, numerous Jewish athletes and teams have proudly displayed the Star of David in sports competitions. Nor does use of such marks by Ajax fans necessarily carry the connotation of a negative, derogatory reference to Jews.

Nonetheless, the EUIPA Board of Appeals has noted that a trademark need not necessarily have an inherently negative connotation to be offensive. Rather, 'the banal use of some signs with a 'highly positive' connotation can also be offensive.'<sup>51</sup> In *Republic of Turkey v. Yaqub*, the Board found that the banal, commercial appropriation of the name of Mustafa Kemal Atatürk, the founder of modern Turkey, would be highly offensive to the European public of Turkish origin, whose reverence for Atatürk has strong national, cultural, ideological, and even religious connotations.<sup>52</sup> Accordingly, the Board ruled, the proposed mark 'Ataturk' may not be registered under Article 7(1)(f).<sup>53</sup> As the Board observed: 'Signs which severely offend the religious sensitivities of a substantial group of the population are ... best kept off the register, if not for moral reasons, at least for reasons of public policy, namely the risk of causing public disorder.'<sup>54</sup> Similarly, a UK trademark appeals body upheld the denial of registration for Jesus for clothing, noting that the very idea that the name of Jesus may be appropriated for commercial use as a trademark would be anathema, both to believers and to others who adhere to the view that religious beliefs should be treated with respect.<sup>55</sup>

Perhaps Ajax's commercial appropriation of the Star of David symbol would be deemed offensive on similar grounds even if not intended or generally perceived as an ethnic or religious insult. It would arguably constitute a banal commercialisation of a symbol of national and religious identity. In that regard,

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51. *Republic of Turkey v. Yaqub*, Case R 2623/2011-2, EUIPA Board of Appeal, 17 September 2012, ¶31.

52. *Ibid.* at ¶¶32-33

53. *Ibid.* at ¶36.

54. *Ibid.* at ¶7. Somewhat similarly, the US Trademark Trials and Appeals Board upheld a denial of registration for KHORAN, referring to the Islamic holy text, for use for wine, as disparaging the religion and beliefs of Muslim-Americans. See *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010).

55. See Basic Trademark SA's Trade Mark Application, [2005] RPC 25, discussed in Snedden, *supra* note 26, at 276-277.

moreover, the fact that Jewish athletes and sports teams have displayed the Star of David to represent their national identity would not undermine the argument against the symbol's registration as a trademark. In *Republic of Turkey*, the EUIPA Board of Appeals distinguished the trademark application in question from the widespread use of the name and image of Mustafa Kemal Atatürk on T-shirts, stickers, and commemorative items in Turkey, where they serve as a reference to the admired Turkish statesman rather than as a brand for a particular manufacturer.<sup>56</sup>

## 5. RECLAIMED EPITHETS

As we have seen, the trademark owner's benign intent does not save an otherwise disparaging mark from falling within the absolute prohibition on registration. But what if members of a targeted group seek to adopt and register a disparaging mark to reclaim the insult as a badge of honour? Prior to the Supreme Court's ruling in *Matal v. Tam*, there were several cases in the United States in which referenced groups sought to register insulting terms as their own trademarks. *Maytal v. Tam* is, itself, a prime example. In that case, an all-Asian-American rock band adopted and sought to register the name, 'The Slants', in order to reclaim that ethnic slur of Asians as a badge of honour. Other examples of targeted groups seeking to appropriate slurs and thus to disarm their derogatory force include Blacks seeking to register 'N.I.G.G.A.' and Jews seeking to register 'Heeb'.<sup>57</sup> In such cases, as in its ruling on The Slants, the US Trademark Office and Trademark Trials and Appeals Board have repeatedly rejected registration of such marks. They have found in each case that the fact that a substantial composite of the referenced group might find the term objectionable outweighs both the trademark applicant's salutary intentions and support for, or at least a lack of objection to, the reclaimed use among other members of the referenced group.<sup>58</sup> On the other hand, the Trademark Office initially denied a lesbian group's application to register 'Dykes On Bikes' on the grounds that the mark was disparaging, but the Office eventually allowed registration upon reviewing

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56. *Ibid.* at ¶12. The Star of David may be part of a registered trademark in the United States. It might have informational or descriptive significance, however, in which case it cannot serve as a trademark absent a showing of acquired distinctiveness. See US Patent and Trademark Office, Trademark Manual of Examining Procedure, §1202.17(e)(iv) (October 2018).

57. See Todd Anten, 'Note, Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act', 106 *Colum. L. Rev.* (2006), 388.

58. See, e.g., *In re Tam*, 108 U.S.P.Q.2d 1305 (TTAB 2013) (upholding denial of registration for THE SLANTS); *In re Heeb Media LLC*, 898 U.S.P.Q.2d 1071 (TTAB 2008) (upholding denial of registration for HEEB for various consumer goods even though the Trademark Office had approved the mark for a Jewish culture magazine); Serial No. 76/639,548, filed 25 May 2005 (Trademark Office rejection of a Black actor's application for N.I.G.G.A., finding the mark to be both disparaging and scandalous).

significant evidence showing that the term's meaning had changed from an insult to a source of lesbian pride.<sup>59</sup>

Similarly to the Trademark Office's reconsidered ruling regarding 'Dykes on Bikes', the EUIPO Board of Appeals approved registration for a trademark for 'Jewish Monkeys' for a satiric, contemporary klezmer band.<sup>60</sup> In approving registration, the Board took into account that the applicant was the band's lead singer, who, like other band members, is Jewish. The Board also considered the context in which the mark would likely be used. The Board concluded that, while the term 'Jewish Monkeys' is highly offensive when used by anti-Semites, it is unlikely to cause offense as used by a Jewish musical group that combines elements of Yiddish folklore and pop music and regularly performs at Jewish music festivals.

Under that approach might the Board approve an application by Ajax or a group of Ajax fans for a 'Joden' or 'Superjoden' trademark as a reclaimed epithet? Perhaps the Board would distinguish Ajax fans' enthusiastic, seemingly philo-Semitic, self-labeling as 'Jews' from opposing fans' anti-Semitic chants. But, of course, unlike the members of the Jewish Monkeys, Ajax management and fans are not actually Jews. Further, even if Ajax fans constructed a pseudo-Jewish identity as their badge of honour in response to opposing fans' anti-Semitic derision, it is hard to say that Ajax fans have done so on behalf of real Jews. Certainly, real Jews have played no active role in this rhetorical battle and do not generally view Ajax fans' display of Jewish symbols as an affirmation of their own Jewish identity and pride. It would thus be a stretch to treat a hypothetical application for a 'Joden' trademark by Ajax or its fans as a reclaimed use by a targeted ethnic group.

Moreover, the Board's focus in 'Jewish Monkeys' on the identity of the applicant, likely context of trademark use, and intended audience seems out of step with the General Court's ruling in *Paki Logistics* and other European cases that marks consisting of racial slurs are inherently contrary to morality or public order regardless of the goods or services for which they are sought to be registered and whether purchasers would understand the mark as a racial insult.<sup>61</sup> Accordingly, as one commentator has recently observed, it is unlikely that the Board's approach in 'Jewish Monkeys' toward permitting registration of a reclaimed epithet 'will take hold in Europe, at least for the time being'.<sup>62</sup>

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59. See Sonia Katyal, 'Trademark Officials Must Distinguish Between Irony and Offense', *N.Y. Times*, 4 May 2016, <https://www.nytimes.com/roomfordebate/2016/05/04/redskins-and-other-troubling-trademarks/trademark-officials-must-distinguish-between-irony-and-offense>.

60. R 519/2015-4, *Josef Reich*, 2 September 2015 (EUIPO Board of Appeal).

61. See *supra* notes 49–52 and accompanying text.

62. See Fernandez-Mora, *supra* note 36, at 290.

## 6. SOCIAL MEDIA CONTENT MODERATION AND ARTIFICIAL INTELLIGENCE

As we have seen, the determination of when ethnic references in trademarks generally should be viewed as offensively disparaging raises multiple questions. Does it matter whether the trademark user acts without intent to disparage? Who is the relevant public for measuring offensiveness? What percentage of the relevant public must be offended? Does the trademark user's identity matter? How offensive must the mark be to support denying registration? Must a determination of undue offensiveness rest on empirical evidence of offense or may offensiveness be presumed from dictionary definitions? May a seemingly non-disparaging term nonetheless be denied registration because the banal, commercial use of the term causes offense? European regulators and courts must grapple with such complex questions, taking care to balance prohibitions against ethnic and religious discrimination with freedom of expression. In the United States, following *Matal v. Tam*, such issues no longer impact trademark registration practice, but they continue to arise in debates surrounding the propriety of ethnic references in branding.

The widespread use of ethnic references in social media, both in branding and non-commercial speech, complicates the issue even further. The immense volume of linguistically and culturally diverse content posted on social media, and the speed at which that content is posted, greatly magnify the challenges of defining grossly offensive insults and determining whether particular posts constitute such insults. In that regard, leading social media platforms, including Facebook, Instagram, Twitter, YouTube, and, most recently, TikTok, have agreed to be bound by the European Commission's Code of Conduct on Countering Illegal Hate Speech Online.<sup>63</sup> The Code requires that platforms expeditiously assess notifications of illegal hate speech, including racial and ethnic insults, and remove content that they determine constitute such speech. According to the most recent Commission Report, on average 90% of the notifications are reviewed within 24 hours and 71% of the content is removed.<sup>64</sup>

As Facebook has reported, platforms increasingly rely on AI systems to detect and remove hate speech at scale. Facebook proudly proclaims that, as of the final three months of 2020, '97% of hate speech taken down from Facebook was spotted by our automated systems before any human flagged it, up from 94% in the previous quarter and 80.5% in late 2019.'<sup>65</sup> But social media platforms face multiple layers of difficulty in such automatic detection of hateful and/or

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63. Code of Conduct on Countering Illegal Hate Speech Online, 30 June 2016, [https://ec.europa.eu/info/policies/justice-and-fundamental-rights/combatting-discrimination/racism-and-xenophobia/eu-code-conduct-countering-illegal-hate-speech-online\\_en#theeucodeofconduct](https://ec.europa.eu/info/policies/justice-and-fundamental-rights/combatting-discrimination/racism-and-xenophobia/eu-code-conduct-countering-illegal-hate-speech-online_en#theeucodeofconduct)

64. European Commission, Countering Illegal Hate Speech Online; 5th Evaluation of the Code of Conduct, June 2020.

65. Mike Schroepfer, 'Facebook Chief Technology Officer, Update on our Progress on AI and Hate Speech Detection', 11 February 2021.

offensive speech.<sup>66</sup> Words can be obfuscated in many different ways, whether to avoid automatic content moderation or simply to abbreviate language for rapid communication. In addition, as we have seen, words might be highly offensive slurs in some contexts, but not others, or may evolve over time from being innocuous to offensive or visa-versa. Accounting for these variations and contexts requires highly sophisticated, constantly updated machine learning – coupled with a mechanism for human review to supplement, and sometimes correct, AI determinations. Of note, in upholding Facebook's removal of a Russian language post that included an allegedly derogatory term for Azerbaijanis, the Facebook Oversight Board relied on independent linguistic analysis and thirty-five public comments to confirm Facebook's understanding of the term as a 'dehumanizing slur attacking national origin'.<sup>67</sup>

In my own informal review of Facebook and Instagram, I found numerous Ajax fan accounts under the label 'Superjoden'. Almost all are devoted entirely to celebrating Ajax, with no references to Jews other than the Superjoden label or the word 'mokum', a word of Yiddish origin that refers to Amsterdam. Yet one Facebook account includes an arguably offensive video posted by a user under the tag Facebook#AjaxHumor that depicts a group of ultra-Orthodox Jews sitting around a table, presumably singing religious songs but overdubbed with a soundtrack of Ajax fans shouting a football chant. I have no way of knowing what posts from Ajax fans – or opposing fans – Facebook and Instagram might have removed.

Facebook's Community Standards define prohibited 'hate speech as a direct attack against people on the basis of ... race, ethnicity, ... [or] religious affiliation'.<sup>68</sup> The Standards define 'attacks as violent or dehumanizing speech, harmful stereotypes, statements of inferiority, expressions of contempt, disgust or dismissal, cursing and calls for exclusion or segregation'.<sup>69</sup> The Standards would pretty clearly prohibit posts featuring anti-Semitic chants by fans who oppose Ajax, even if those fans do not primarily intend to attack real Jews. Might Ajax fans' self-branding and intended humorous appropriation of Jewish symbols and images also constitute 'hate speech' under the Standards? For what it's worth, the Royal Dutch Football Association prohibits the opposing fans' anti-Semitic chants, but not Ajax fans' self-branding.<sup>70</sup> It's an open question whether that same dichotomy should obtain in the broader context of social media use and trademark registration.

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66. See György Kovács, Pedro Alonso, and Rajkumar Saini, 'Challenges of Hate Speech Detection in Social Media; Data Scarcity and Leveraging External Resources', *SN Computer Science* (2021) 2:95.
67. Facebook Oversight Board, Case Decision 2020-003-FB-UA, 28 January 2021, <https://about.fb.com/news/2021/02/update-on-our-progress-on-ai-and-hate-speech-detection>.
68. [https://www.facebook.com/communitystandards/hate\\_speech](https://www.facebook.com/communitystandards/hate_speech).
69. *Ibid.*
70. See Chris McLaughlin, 'How Dutch football Has Tackled Fan Trouble', *BBC News*, 4 April 2019, <https://www.bbc.com/news/uk-scotland-47809392> (reporting that Utrecht was required to close the section of its stands in which fans shouted anti-Semitic chants against Ajax).



NOT TO SPEAK  
ABOUT THAT  
SECOND  
/ NEW MEANING  
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# Sacrificing the Gods on the Altar of Sports: The Redefinition of Cultural Symbols in the Sports Sector

*Martin Senftleben*

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## 1. INTRODUCTION

In the area of sports, I have always been a big disappointment to Bernt Hogenholtz. When I applied for the position of a junior researcher at IViR twenty years ago, he did not raise the issue of my participation in the IViR football team during the job interview. Most probably he simply assumed – considering my German passport – that I would be an asset for the team and more than happy to join. To this day, it remains unclear whether strategic considerations of this nature (rather than academic credentials) tipped the scales in my favour and led to the decision to offer me the job and an entrance door to an academic career.

Be that as it may, I never lived up to Bernt's expectations in sports and, more specifically, on the football pitch. Instead of becoming one of the greatest strikers, I refused to join the IViR football team declaring that I had neither football skills nor any football interests (which, by the way, was conducive to my integration into Dutch society – I did not even have a clue about the 1974 FIFA World Cup final). After several legendary matches against law firm teams, the IViR team was dissolved at some point. Honestly speaking, I firmly believe that the decline of the team would have been faster if I had decided to join. But I am not sure whether Bernt shares this view. I also have serious doubts that I will manage to appease him and repair the damage with the following essay. But I hope that at least from an academic perspective, he will enjoy the analysis.

## 2. SPORTS AND GODS

In her article ‘The Dilution of Culture and the Law of Trademarks’,<sup>1</sup> Katya Assaf provides the following example of cultural signs losing their primary cultural meaning as a result of use in commerce and the impregnation of the sign with marketing messages:

Consider the trademark ‘Nike.’ The initial significance of the cultural sign ‘Nike’ was as the name of the Greek Goddess of Victory. The sign was chosen to serve as a trademark for its ability to convey the message of success, overcoming adversity and victory, stated succinctly by the phrase ‘Just Do It.’ The trademark grew so strong that it turned into the sign’s primary meaning while its original significance grew weaker and became a kind of secondary meaning.<sup>2</sup>

While it is generally known that there is no weapon enabling humans to kill a god, the extinction of knowledge about the god is a death blow. A cult that sinks into oblivion, is a dead cult. In the following discussion, I will raise the question of whether a similar conclusion can be drawn with regard to cultural symbols. Does a sign stemming from the literary and artistic domain lose its value for cultural creativity – its capacity to serve as a source of inspiration and basis for new literary and artistic productions – if it is no longer primarily perceived as a cultural sign? Katya Assaf rightly points out that safeguards against the erosion of cultural meaning are sought in vain in trademark law:

cultural signs are generally not protected from alteration of their meaning due to their adaptation into trademarks. Thus, Nike, the Greek Goddess, was not protected from the additional meaning imposed on it through a brand of shoes.<sup>3</sup>

Evidently, Nike is not the only deity that the ingenuity of modern marketers has driven out of the Pantheon. Further examples can easily be found in the sports sector. Katya Assaf mentions several commercial meanings of the Greek hero Ajax,<sup>4</sup> son of king Telamon and Periboea, great warrior in the Trojan War.<sup>5</sup> Most probably, Bernt and other aficionados of Dutch football will immediately think about a certain football club in the Amsterdam region (even I have learned to associate the name with the football club) and not about its mythological origin.<sup>6</sup> The Wikipedia entry reflects this shift:

Amsterdamsche Football Club Ajax (Dutch pronunciation: [‘a:jaks]), also known as AFC Ajax, Ajax Amsterdam, or simply Ajax, is a Dutch

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1. Katya Assaf, ‘The Dilution of Culture and the Law of Trademarks’, 49 *IDEA: The Intellectual Property Law Review* (2008), 1.

2. *Ibid.*, 11.

3. *Ibid.*, 45.

4. *Ibid.*, 12.

5. See [https://en.wikipedia.org/wiki/Ajax\\_the\\_Great#Trojan\\_War](https://en.wikipedia.org/wiki/Ajax_the_Great#Trojan_War).

6. As to the history of the football club, see <https://english.ajax.nl/club/history/#>.

professional football club based in Amsterdam, that plays in the Eredivisie, the top tier in Dutch football.<sup>7</sup>

In other words, the Trojan War hero is in danger of falling prey to the marketing efforts of an immensely popular sports undertaking in the Netherlands. In the minds of football fans, 'Ajax' primarily signifies the football club ('or simply Ajax'). The heroic cultural past, at best, constitutes a secondary meaning.

The central question, then, is whether this development is problematic. Resisting the temptation to answer 'no, of course not' without hesitation in this book in honour of Bernt Hugenholtz, the following analysis sheds light on considerations that may raise doubts about the appropriateness of cultural heritage branding. To lay the groundwork, it is important to point out first that the scope of trademark rights has been expanded considerably during recent decades. The nature of the right has changed: trademark protection is no longer limited to the core function of indicating the commercial origin of goods or services. Instead, trademark law protects the sign 'Ajax' as a communication tool. Trademark owners, such as the football club,<sup>8</sup> can exert far-reaching control over the communication process surrounding the protected sign (section 3). The use in product marketing may also be problematic from a conceptual perspective. Marketing messages may tarnish the name 'Ajax' and render the cultural sign less attractive as a basis for new literary and artistic productions (section 4). The decision on the grant of trademark rights, thus, requires a careful analysis of potential obstacles to free expression (section 5).

### **3. TRADEMARKS AS COMMUNICATION TOOLS**

Trademark law aims at market transparency to ensure fair competition, consumer protection and the proper functioning of markets. Trademark rights concern the exclusive link which a trademark establishes between the trademark owner and the goods and services offered under the mark. Hence, trademark rights are not designed as exploitation rights. They have a rather defensive character. Taking traditional trademark theory as a starting point, the Court of Justice of the European Union (CJEU) refers to:

the essential function of the trade mark, which is to guarantee the identity of the origin of the trade-marked product to the consumer or final user by enabling him to distinguish without any possibility of confusion between that product and products which have another origin.<sup>9</sup>

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7. See [https://en.wikipedia.org/wiki/AFC\\_Ajax](https://en.wikipedia.org/wiki/AFC_Ajax).

8. As to the word mark AJAX, see Benelux registrations 850058, 875974, 846441. As to the Ajax logo and the Ajax Amsterdam logo, see European Union Trade Mark registration 000424036 and Benelux registrations 757053, 943415, 875975, 757054, 850056.

9. For an early use of this formula, see CJEU, 3 December 1981, case C-1/81, *Pfizer/Eurim-Pharm*, para. 8. As to the reappearance of the same formula in later judgments, see CJEU, 12 November 2002, case C-206/01, *Arsenal/Reed*, para. 48. Cf. I. Simon Fhima, 'How Does "Essential Function" Doctrine Drive European Trade Mark Law?', 36 *International Review of Intellectual Property and Competition Law* (2005), 401.

This traditional protection against ‘any possibility of confusion’ gives trademark owners only limited control over communication concerning their marks – control that only covers the identification and distinction of the goods or services they offer in the marketplace. Protection against confusion can be understood to serve the defensive purpose of preventing competitors from use that would interfere with the basic communication of information about the commercial origin of goods and services offered by the trademark owner.<sup>10</sup> However, the scope of trademark protection becomes broader with every additional trademark function – and every additional basis for infringement claims – that is recognised in trademark law. The inclusion of additional trademark functions may follow from strategic use of basic protection against confusion. To allow trademarks to convey reliable information on the commercial origin of goods and services, it is indispensable to reserve use of the trademark exclusively for the trademark owner in all market segments where use of identical or similar signs could lead to confusion.<sup>11</sup> As a result, the trademark owner obtains an exclusive channel of communication in all areas of the market where she is active. In principle, only the enterprise holding trademark rights is entitled to convey information to consumers via the trademark in these protected areas.<sup>12</sup>

Investing in advertising, the trademark owner can use this exclusive communication channel to add messages that are unrelated to the underlying objective of ensuring accurate information about the commercial source of goods or services. In particular, an enterprise can launch advertising campaigns to educate consumers to associate a certain attitude or lifestyle with the trademark.<sup>13</sup> The moment a trademark ‘speaks’ to consumers about a particular image that

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10. CJEU, 18 June 2009, case C-487/07, *L'Oréal/Bellure*, para. 59; CJEU, 11 November 1997, case C-251/95, *Puma/Sabel*, paras. 16–26.
11. In the case of collective marks, this exclusive reservation of a sign concerns an association of enterprises who use the trademark in trade. The basic mechanism, however, remains unchanged. The information conveyed via the trademark, by contrast, will focus on certain product characteristics rather than one particular commercial origin. See Articles 74(1) and 83(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, *Official Journal* 2017 L 154, 1 (EUTMR). Cf. CJEU, 8 June 2017, case C-689/15, *Gözze Frottierweberei*, para. 50.
12. As in other fields of intellectual property protection, it is indispensable to set certain limits to the exclusive rights of trademark owners. The principle of an exclusive communication channel, therefore, is limited in several respects. See the general limitations set forth in Article 14 EUTMR and Article 14 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, *Official Journal* 2015 L 336, 1 (TMD). With regard to comparative advertising, see CJEU, 12 June 2008, case C533/06, *O2/Hutchison*, para. 45; CJEU, 18 June 2009, case C-487/07, *L'Oréal/Bellure*, para. 54.
13. Cf. Assaf, *supra* note 1, 13–14; A. Griffiths, ‘A Law-and-Economic Perspective on Trade Marks’, in L. Bently, J. Davis and J.C. Ginsburg (eds.), *Trade Marks and Brands – An Interdisciplinary Critique* (Cambridge University Press, Cambridge, 2008), 241 (255); R.S. Brown, ‘Advertising and the Public Interest: Legal Protection of Trade Symbols’, 108 *Yale Law Journal* (1999), 1619 (1619–1620); K.H. Fezer, ‘Entwicklungslinien und Prinzipien des Markenrechts in Europa – Auf dem Weg zur Marke als einem immaterialgüterrechtlichen Kommunikationszeichen’, *Gewerblicher Rechtsschutz und Urheberrecht* (2003), 457 (461–462).

can be associated with the trademarked product, consumers no longer simply purchase products from a particular commercial source. They also buy the respective 'trademark experience' and 'brand image'.<sup>14</sup>

Inevitably, the exclusive rights necessary to ensure protection against confusion, therefore, also protect the investment made in the creation of a favourable trademark image. Basic protection against confusion safeguards the exclusive link between an enterprise and its trademark. However, it also offers legal security for substantial investment in the evocation of brand-related associations in the minds of consumers. This protection reflex<sup>15</sup> may be elevated to an independent subject matter of protection. In *L'Oréal/Bellure*, the CJEU held that the circle of protected trademark functions was not limited to the basic function of indicating the commercial origin of goods or services. By contrast, these functions:

include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services, but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.<sup>16</sup>

Hence, the Court expressly recognised brand image protection as an independent objective of EU trademark law.<sup>17</sup> Communication, investment, and advertising functions are typically fulfilled by marks with a reputation: marks with a strong

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14. A. Peukert, 'Vom Warenzeichen zum Markeneigentum. Ein polanyischer Erklärungsversuch', in W. Büscher, J. Glöckner, A. Nordemann, C. Osterrieth and R. Rengier (eds.), *Marktkommunikation zwischen Geistigem Eigentum und Verbraucherschutz. Festschrift für Karl-Heinz Fezer zum 70. Geburtstag* (C.H. Beck, Munich, 2016), 405 (412–414); J.E. Schroeder, 'Brand Culture: Trade marks, Marketing and Consumption', in L. Bently, J. Davis and J.C. Ginsburg (eds.), *Trade Marks and Brands – An Interdisciplinary Critique* (Cambridge University Press, Cambridge, 2008), 161.

15. See WTO Panel, 15 March 2005, WTO Document WT/DS174/R, European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, para. 7.664, based on a complaint by the US. A second and almost identical report, WTO Document WT/DS290/R, deals with a parallel complaint by Australia. For a discussion of the reports, see M.R.F. Senftleben, 'Towards a Horizontal Standard for Limiting Intellectual Property Rights? – WTO Panel Reports Shed Light on the Three-Step Test in Copyright Law and Related Tests in Patent and Trademark Law', 37 *International Review of Intellectual Property and Competition Law C* (2006), 407.

16. CJEU, 18 June 2009, case C-487/07, *L'Oréal/Bellure*, para. 58.

17. A. Kur and M.R.F. Senftleben, *European Trade Mark Law – A Commentary* (Oxford University Press, Oxford, 2017), paras. 1.20–1.39. For a positive assessment of this development, see H. Sun, 'Reforming Anti-Dilution Protection in the Globalization of Luxury Brands', 45 *Georgetown Journal of International Law* (2014), 783 (794–795); A. Griffiths, 'Quality in European Trade Mark Law', 11 *Northwestern Journal of Technology and Intellectual Property* (2013), 621 (635–637); A. Machnicka, 'The Perfume Industry and Intellectual Property Law in the Jurisprudence of the Court of Justice of the European Union and of National Courts', 43 *International Review of Intellectual Property and Competition Law* (2012), 123 (138–139). For critical comments, see I. Simon Fhima, 'Trade Mark Law and Advertising Keywords', in A. Savin and J. Trzaskowski (eds.), *Research Handbook on EU Internet Law* (Edward Elgar, Cheltenham, 2014), 143 (161); A. Banerjee, 'Non-Origin Infringement – Has Trade Mark Law Gone Too Far?', 43 *International Review of Intellectual Property and Competition Law* (2012), 555; M.R.F. Senftleben, 'Trade Mark Protection – A Black Hole in the Intellectual

brand image capable of conveying lifestyle messages that are the result of substantial investment in advertising. Protection of a trademark's communication, investment, and advertising functions is protection of the investment in the creation of a favourable brand image and the brand communication based on this image. The extension of trademark protection to these functions transforms trademark rights into brand exploitation instruments.<sup>18</sup>

On its merits, the grant of brand image protection thus leads to protection of a trademark as an individual communication product.<sup>19</sup> The recognition of a trademark's economic and communication value means that trademarks enjoy protection not only as identifiers of commercial source but also as communication tools. Communication, however, also lies at the core of cultural processes of reuse and remix. The extension of trademark protection to communication, investment and advertising functions is thus particularly worrisome when assessing potential risks for cultural follow-on innovation. Once the economic and communication value of a trademark is recognised as an independent subject matter of protection, it is no longer accurate to confine the analysis to the question of a likelihood of confusion. In trademark systems, such as the EU system, that offer protection of a trademark's communication, investment and advertising functions, an unauthorised user of a protected sign cannot escape an infringement claim by

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Property Galaxy?', 42 *International Review of Intellectual Property and Competition Law* (2011), 383.

18. Cf. Peukert, *supra* note 14, 421–422; Fezer, *supra* note 13, 461–462; J. Moskin, 'Victoria's Big Secret: Wither Dilution Under the Federal Dilution Act', 93 *The Trademark Reporter* (2004), 842 (843–844), refers to 'the expansion of trademark rights from a tort-based theory preventing direct diversion of sales between competitors to a broader set of rights resting on a recognition that trademarks themselves possess economic value.'
19. Kur and Senftleben, *supra* note 17, paras. 1.29–1.39; Peukert, *supra* note 14, 421–422; J.C. Ginsburg, 'Licensing Commercial Value: from Copyright to Trademarks and Back', in I. Calboli and J. de Werra (eds.), *The Law and Practice of Trademark Transactions – A Global and Local Outlook* (Edward Elgar, Cheltenham, 2016), 53 (75–77); M.R.F. Senftleben, 'The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law', 40 *International Review of Intellectual Property and Competition Law* (2009), 45 (48–49); L. Bently, 'From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property', in G.B. Dinwoodie and M.D. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar, Cheltenham, 2008), 3 (15–41); Schroeder, *supra* note 14, 161; R.G. Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law', 86 *Boston University Law Review* (2006), 547 (549); Moskin, *supra* note 18, 843–844; G.B. Dinwoodie, 'Trademark and Copyright: Complements or Competitors?', in J.C. Ginsburg and J.M. Besek (eds.), *Adjuncts and Alternatives to Copyright – Proceedings of the ALAI Congress June 13–17, 2001* (Kernochan Center for Law, Media and the Arts, Columbia University School of Law, New York, 2002), 498 (503–504); Fezer, *supra* note 13, 461–462; S. Casparie-Kerdel, 'Dilution Disguised: Has the Concept of Trade Mark Dilution Made its Way into the Laws of Europe?', *European Intellectual Property Review* (2001), 185 (185–186); G.S. Lunney, Jr, 'Trademark Monopolies', 48 *Emory Law Journal* (1999), 367 (437–439); M.A. Lemley, 'The Modern Lanham Act and the Death of Common Sense', 108 *Yale Law Journal* (1999), 1687 (1694–1698); Brown, *supra* note 13, 1619–1620; M. Lehmann, 'Die wettbewerbswidrige Ausnutzung und Beeinträchtigung des guten Rufs bekannter Marken, Namen und Herkunftsangaben – Die Rechtslage in der Bundesrepublik Deutschland', *Gewerblicher Rechtsschutz und Urheberrecht – International* (1986), 6 (14–17).

simply arguing that her use would not mislead consumers into believing that there was a connection with the trademark owner. In addition, the trademark proprietor has the argument at her disposal that – even in the absence of origin confusion – the use amounts to infringement because it damages or derives unfair benefits from the economic and communication value of the trademark.<sup>20</sup>

In other words, the grant of trademark rights gives the trademark proprietor an elevated position in the discourse about the registered cultural sign. The broader the scope of trademark protection as a result of investment in advertising and marketing, the stronger the influence of Ajax Amsterdam on the communication surrounding the cultural sign 'Ajax'.<sup>21</sup> Given the immense popularity of Ajax sports events and merchandising articles, there can be little doubt that the football club's word and figurative marks built on 'Ajax'<sup>22</sup> constitute marks with a reputation that enjoy broad protection against confusion (including confusion as to affiliation and sponsorship) and additional protection against dilution.<sup>23</sup> In EU trademark law, protection against dilution covers all types of goods and services ('in relation to goods or services which are identical with, similar to, or not similar to...').<sup>24</sup> Goods and services in the cultural sector thus fall within the scope of protection.<sup>25</sup>

This expansion of communication power entails the risk of censorship. Intentionally or unintentionally, Ajax Amsterdam will bring trademark claims against forms of unauthorised use which, from the club's point of view, denigrate the trademarked cultural sign (and, therefore, damage the reputation of the football brand), whereas Ajax Amsterdam is likely to refrain from taking action against forms of use that do not interfere with the club's own strategy for the development of the message and meaning of the sign (and, thus, are no threat

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- 20. Cf. S. Jacques, 'A Parody Exception: Why Trade Mark Owners Should Get the Joke', 38 *European Intellectual Property Review* (2016), 471 (473); M.P. McKenna, 'An Alternate Approach to Channeling?', 51 *William and Mary Law Review* (2009), 873 (883–884 and 895).
- 21. For a discussion of the growing impact of trademark rights on communication based on the protected sign, see Senftleben, *supra* note 17, 383; L.P. Ramsey, 'Descriptive Trademarks and the First Amendment', 70 *Tennessee Law Review* (2003), 1095; R.C. Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation', 65 *Notre Dame Law Review* (1990), 397 (397–398).
- 22. Benelux registrations 850058, 875974, 846441 (word mark AJAX). As to the Ajax logo and the Ajax Amsterdam logo, see European Union Trade Mark registration 000424036 and Benelux registrations 757053, 943415, 875975, 757054, 850056
- 23. For a detailed discussion of the scope of protection against confusion and dilution in cases of cultural heritage branding, see M.R.F. Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Kluwer Law International, The Hague/London/New York, 2020), 141–190.
- 24. Article 9(2)(c) EUTMR; Article 10(2)(c) TMD.
- 25. Cf. Senftleben, *supra* note 23, 141–200. The fact that other companies may have acquired trademark rights with regard to the name 'Ajax' in good faith (cf. CJEU, 11 March 2003, case C-40/01, *Ajax/Ansul*, with regard to use of the name for fire extinguishers) does not prevent the football club from bringing claims against unauthorised third parties without such earlier rights.

to the value and renown of the football brand).<sup>26</sup> This enforcement behaviour is a corollary of the registration of a cultural sign as a trademark and subsequent use as a tool to convey marketing messages. In extreme cases, the assertion of trademark rights against use that is undesirable from the perspective of a brand owner may even impact communication processes in the literary and artistic domain – the societal subsystem that made the evolution of the sign possible in the first place.<sup>27</sup>

#### 4. SIGN DEVALUATION

In addition to censorship risks, the adoption of a cultural sign as a trademark and marketing tool may devalue the sign as a basis for cultural follow-on innovation because it leads to the attachment of commercial marketing messages.<sup>28</sup> Due to the configuration of the trademark system, use of the cultural sign as a marketing instrument is inevitable once trademark rights are awarded. To maintain trademark rights, Ajax Amsterdam must make genuine use of the Trojan War hero in the sense of trademark law. Otherwise, the trademark registration is exposed to the risk of cancellation after an uninterrupted non-use period of five years.<sup>29</sup> The requirement of genuine use has two facets. On the one hand, the trademark proprietor is obliged to use the trademark to create or preserve an outlet for goods or services, in respect of which the mark is registered.<sup>30</sup> On the other hand, the use must be in accordance with the essential trademark function of indicating the commercial origin of these goods or services.<sup>31</sup> Once a cultural sign is registered as a trademark, the owner of the registration is bound to develop the sign as a badge of origin and marketing tool for the goods and services involved. As already pointed out, marketing efforts are capable of blurring cultural connotations which the sign had prior to the acquisition of trademark rights. They may even gradually supersede the sign's cultural meaning.<sup>32</sup>

In the light of an economic analysis of the interplay between intellectual property protection and the public domain, this development may seem

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26. Cf. M.R.F. Senftleben, 'Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain', 48 *International Review of Intellectual Property and Competition Law* (2017), 683 (688–689).

27. For example, see Benelux Court of Justice, 14 October 2019, case A2018/1/8, *Moët Hennessy/Cedric Art*, para. 9; Court of Appeals of Amsterdam, 13 September 2011, case ECLI:NL:GHAMS:2011:BS7825, *Mercis and Bruna/Punt*, AMI 2012, 28, para. 4.19; District Court of The Hague, 4 May 2011, case LJN BQ3525, *Nadia Plesner/Louis Vuitton*, paras. 2.1–2.8. Cf. Senftleben, *supra* note 23, 171–174, 191; Peukert, *supra* note 14, 424; D.J.G. Visser, 'Darfurnica: modelrechten versus kunstvrijheid', *Nederlands Juristenblad* (2011), 740 (740–742).

28. Cf. Assaf, *supra* note 1, 21–23.

29. Cf. Kur and Senftleben, *supra* note 17, paras. 6.176–6.182. Article 19(1) TRIPS sets forth an international minimum standard of 'at least' three years of non-use.

30. CJEU, 11 March 2003, case C-40/01, *Ajax/Ansul*, paras. 36 and 43. Cf. Kur and Senftleben, *supra* note 17, para. 6.154.

31. CJEU, 8 June 2017, case C-689/15, *Gözze Frottierweberei*, para. 42. Cf. Kur and Senftleben, *supra* note 17, para. 6.156.

32. Assaf, *supra* note 1, 11–12 and 21–23.

unproblematic at first glance: the more complex and diverse a sign's denotations, the higher might be its value. In *The Future of the Public Domain – Identifying the Commons in Information Law*<sup>33</sup> – edited by Lucie Guibault and Bernt Hugenholtz – Eli Salzberger describes this potential positive effect as follows:

Let us assume that the government changes the designation of particular common land into private property, this piece of land is subsequently purchased by an individual on which she builds an architectural masterpiece. This new building is privately owned in the sense that no one can enter the building, use it, sell it, or eliminate it save its private owner or under her permission. But the pleasure of viewing the building for the rest of the community, the inspiration it creates, its contribution to future architectural plans can be regarded as an enlargement of the public domain.<sup>34</sup>

In this vein, it might be argued that the grant of trademark protection enriches a sign in the public domain because it offers incentives to add complex commercial meanings to a formerly undeveloped sign.<sup>35</sup> In the case of an undefined sign which the trademark owner charges with source-identifying and lifestyle messages, the branding process may lead to an enhancement of language tools and rhetoric devices.<sup>36</sup>

However, a different scenario arises when branding initiatives concern signs which already have complex meanings because of their evolution in the cultural domain.<sup>37</sup> The name 'Ajax', for instance, is pre-defined: referring to one of the main characters in Homer's *Iliad*,<sup>38</sup> it has complex cultural meanings and connotations: an aura of its own. The question, then, is whether potential benefits accruing from the grant of trademark protection outweigh the detriment flowing from the risk of losing these cultural connotations.<sup>39</sup> With regard to cultural material in the public domain, such as the iconic name 'Ajax', it is doubtful

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33. Lucie Guibault and Bernt Hugenholtz (eds.), *The Future of the Public Domain – Identifying the Commons in Information Law* (Kluwer Law International, The Hague/London/New York, 2006).

34. E.M. Salzberger, 'Economic Analysis of the Public Domain', in Guibault and Hugenholtz, *ibid.*, 27 (55).

35. Cf. M. Richardson, 'Trade Marks and Language', 26 *Sydney Law Review* (2004), 193 (193), who argues for the adoption of an incentive rationale in trademark law that seeks to stimulate popular brand culture and the creation of new brand language.

36. Cf. R.C. Dreyfuss, 'Cultural Heritage and the Public Domain: What the US's Myriad and Mayo can Teach Oslo's Angry Boy', in Niklas Bruun et al. (eds.), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press, Cambridge, 2020), 322 (325–331).

37. Cf. W.M. Landes and R.A. Posner, 'The Economics of Trademark Law', 78 *The Trademark Reporter* (1988), 267 (272–273), who recognise benefits accruing from incentives to invest resources in the invention of 'new words.' Arguably, the same argument cannot be made with regard to the recoding of signs which already have a rich spectrum of meanings. However, see Richardson, *supra* note 35, 213, for a positive assessment of recoding because of additional connotations.

38. For an overview of the contents and main characters of this work, see <https://en.wikipedia.org/wiki/Iliad>.

39. Cf. Assaf, *supra* note 1, 77.

that branding will enrich language and offer additional rhetoric devices. The sign already has a whole heroic tale attached to it.<sup>40</sup> It can hardly be compared with the undeveloped common land which Salzberger takes as a starting point in his explanation of potential positive effects. If the complex meanings and rich connotations evoked by a cultural sign are blurred or even suppressed as a result of the acquisition of trademark protection and the attachment of marketing messages,<sup>41</sup> the sign's expressive value may be reduced rather than being enhanced. The attachment of marketing messages may devalue the sign.<sup>42</sup>

Admittedly, a fine line is to be walked here. In the absence of empirical evidence, it is unclear whether commercial messages added by Ajax Amsterdam interfere with the discourse surrounding the Greek hero Ajax as a literary and artistic symbol. Inevitably, the attachment of football marketing and merchandising messages influences the perception of the public: the sign is no longer exclusively seen as a literary and artistic symbol but also as an identifier of commercial source and an exponent of lifestyle messages conveyed by Ajax Amsterdam. However, I hear Bernt saying that, on several occasions, Ajax Amsterdam players have acted as heroically on the football pitch as Ajax in the Trojan War (and perhaps even adding that the Greek warrior is fortunate to have football heroes following in his footsteps).

To better illustrate the potential harm flowing from use in product marketing and the attachment of commercial messages, other transformations of the name 'Ajax' into trade symbols can be brought into focus. The use of 'Ajax' as a trademark for cleaning products by Colgate-Palmolive<sup>43</sup> adds connotations that give rise to greater concerns about a devaluation of the sign for artistic discourse.<sup>44</sup> For example, the Colgate-Palmolive trademark portfolio includes the marks AJAX WC POWER and AJAX EXPERT WC.<sup>45</sup> Even from a trademark perspective, these connotations are problematic. In the landmark decision *Claeryn/Klarein*, the Benelux Court of Justice confirmed more than forty years ago that use of a sign similar to an iconic gin brand for a cleaning detergent may cause prejudice 'by encroaching upon the trademark's potential for raising a desire to buy'. From this perspective, it is surprising that trademark offices did not feel sympathy for the Trojan War warrior and granted trademark rights in respect of goods that

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40. CJEU, 12 January 2006, case C-361/04 P, *Picasso/Picaro*, para. 27.

41. Cf. K. Assaf, 'Der Markenschutz und seine kulturelle Bedeutung: Ein Vergleich des deutschen mit dem US-amerikanischen Recht', *Gewerblicher Rechtsschutz und Urheberrecht – International* (2009), 1 (2–3); M.R.F. Senftleben, 'Der kulturelle Imperativ des Urheberrechts', in M. Weller, N.B. Kemle and T. Dreier (eds.), *Kunst im Markt – Kunst im Recht* (Nomos, Baden-Baden, 2010), 75 (101–102); A. Wandtke and W. Bullinger, 'Die Marke als urheberrechtlich schutzberechtigtes Werk', *Gewerblicher Rechtsschutz und Urheberrecht* (1997), 573 (578).

42. Cf. Senftleben, *supra* note 23, 63–67.

43. For example, see European Union Trade Mark registrations 000167361, 001663475, 002417913, 002424141, 004109815, 004109831, 004529012, 004805693, 004805727, 009097486, 009097544, 010081479 and 018139850.

44. Cf., by analogy, Benelux Court of Justice, 1 March 1975, case A 74/1, *Claeryn/Klarein*, *Nederlandse Jurisprudentie* (1975), no. 472.

45. European Union Trade Mark registrations 017891165 and 017937333.

tarnish the cultural sign. Evidently, cultural concerns – the preservation of the aura surrounding a cultural sign – do not have much weight in the trademark system.<sup>46</sup>

In the light of registrations such as AJAX WC POWER and AJAX EXPERT WC, the risk of a sign devaluation must not be underestimated. Artists who want to build their creations on the genuine mythological meaning of the sign ‘Ajax’ may find it difficult to escape the cleaning detergent connotations which the sign has as a result of use as a trademark in this market segment. In consequence, the discussion and reinterpretation of the sign in the literary and artistic domain – its use as a reference point for future artistic creativity – become more difficult. Artists who feel that the connotations added by Colgate-Palmolive thwart their intended artistic expression will avoid the sign and use other cultural creations instead. While their artistic creativity is unlikely to stop altogether, it will go in different directions. Once impregnated with undesirable commercial connotations, a cultural sign, such as ‘Ajax’, may thus be rendered less attractive for use in the artistic domain because the remix of the sign’s artistic expression is no longer possible without evoking potentially conflicting commercial connotations. In consequence, the sign’s potential to serve as a basis for artistic dialogue will never be explored in its entirety. Society may lose important reflections on the cultural sign<sup>47</sup> which – in the absence of use as a mark for household cleaning – could have come to light in the artistic discourse. Because of the commercial redefinition of the sign’s meaning, artists may refrain from using the sign as a source of inspiration and a building block for new works.

Admittedly, research in the field of cognitive science has shown that dilutive use of a sign can reinforce, rather than chip away, the strength of its original meaning. With regard to dilutive use of well-known marks, Rebecca Tushnet has pointed out that:

exposure to near variants or uses in other contexts makes the trademark more familiar and thus more easily retrieved from memory. This process can add value in the same way that marketers think preexisting associations carried by descriptive or suggestive terms add value to a trademark. Words with multiple associations may be more easily activated, or reference to one word may ‘prime’ us to recall a similar word. Tiffany’s-the-restaurant may make us think of Tiffany’s-the-jeweler when we are at lunch thinking of gifts for Mother’s Day.<sup>48</sup>

Relying on brand-extension research, Tushnet also stresses that use of variants of a protected sign in a dubious context is unlikely to tarnish a strong brand

46. Cf. Senftleben, *supra* note 26, 685–686; Assaf, *supra* note 41, 18–28; Senftleben, *supra* note 41, 101–102; Wandtke and Bullinger, *supra* note 41, 578.

47. As to the societal role of art and its potential to offer alternative visions of society and pave the way for the improvement of social and political conditions, see Senftleben, *supra* note 23, 54–67.

48. R. Tushnet, ‘Gone in Sixty Milliseconds: Trademark Law and Cognitive Science’, 86 *Texas Law Review* (2008), 507 (537). Cf. M.A. Lemley and M.P. McKenna, ‘Irrelevant Confusion’, 62 *Stanford Law Review* (2010), 413 (429–432).

as long as there is no source confusion and the brand messages are robustly embedded in the minds of consumers:

If consumers are given a reason to distinguish an authorized extension or cobranded product from the core brand – for example, a name like Courtyard by Marriott instead of Marriott or Coke BlaK instead of Coke – they will do so, and negative opinions about the extension will not return to harm opinions of the core brand. If consumers seize on such fine distinctions for authorized line extensions, it seems implausible that, absent confusion, they will transfer negative opinions between unrelated products or services.<sup>49</sup>

Applying these insights to *Ajax mutatis mutandis*, it may be said that use of the cultural sign in a football and cleaning context may enhance the familiarity of consumers with the cultural symbol. It may render the sign more easily accessible in the memory of the public. Consumers are likely to think not only of marketing messages of Ajax Amsterdam and Colgate-Palmolive but also of the sign's cultural meaning when it appears in commercial communication. Even use of a cultural sign in an objectionable, negative context need not erode the favourable, positive image which the sign may have as a result of its evolution in the cultural domain.

While these considerations unmask trademark dilution and brand erosion arguments as mere rhetoric,<sup>50</sup> they fail to properly address the risk of devaluating cultural symbols through use in commercial communication. This risk arises even if the use makes consumers more familiar with the sign and its cultural meaning, and even if the use does not automatically kill cultural connotations. Inevitably, the sign becomes a hybrid. The time of its unchallenged existence as a cultural artefact is over. With the described communication power following from the grant of exclusive trademark rights, lasting commercial connotations enter the picture. If the marketing activities comply with the outlined genuine use requirements, the audience detecting Ajax in a derivative artwork will inevitably think of the pictures and marketing messages which trademark owners evoke with their marketing activities. An artist including the sign in a derivative work can hardly elude these commercial connotations. As Katya Assaf points out

the essence of the first task [the task of trademark developers to educate consumers to perceive the sign as a trademark] is to create a strong associative link between the trademark and the respective products or services in the consumer's mind. If the trademark consists of an existing cultural sign, this process will inevitably interfere with its meaning. This interference happens due to the reciprocal forces existing in the semantic field; while some of the cultural sign's initial meaning comes to be embedded in the trademark, the trademark also casts a shadow on the cultural sign.<sup>51</sup>

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49. Tushnet, *supra* note 48, 543–544.

50. *Ibid.*, 562–565.

51. Assaf, *supra* note 1, 11.

Hence, the mere existence of commercial connotations is problematic – regardless of their interplay with the sign’s cultural meaning. The moment commercial marketing messages are added, the damage consisting of a ‘shadow on the cultural sign’ is done: the cultural sign is devalued as a basis for artistic remix and reuse that seeks to play with the sign’s original, cultural meaning relating to Greek mythology.<sup>52</sup> As Ajax Amsterdam and Colgate-Palmolive create an amalgam of commercial and cultural connotations, it is no longer possible to refer to the Greek hero in isolation. An artist wishing to do so must realise that her intended artistic comment may be doomed to fail because of football and household cleaning connotations that blur the perception of the sign and the perception of the derivative work.

This corrosive effect of marketing messages is particularly strong when trademark rights are granted. In contrast to incidental and variable use in advertising, indefinitely renewable trademark rights enhance the risk of continuous and consistent genuine use as an identifier of the commercial source and carrier of commercial marketing messages. While the owner of trademark rights obtains an exclusive right to prohibit unauthorised use of the sign and an incentive to invest in the development of the sign as a commercial symbol, the freedom of using public domain material in advertising does not lead to an exclusive right that offers sufficient legal certainty for substantial investment in the attachment of lasting commercial connotations to the sign. Even more importantly, use in advertising does not lead to a legal position which the advertiser can invoke to substantiate threats of infringement when sending cease-and-desist letters to artists using the sign for their work. A user in the cultural domain can re-establish the sign’s cultural meaning without exposure to allegations of trademark infringement. Therefore, the mere invocation of freedom to use public domain material in advertising does not change the rules of the communication process as fundamentally as the grant of exclusive trademark rights. It does not give one individual speaker outstanding communication control. In the case of trademark rights, the damage to the communication process in the literary and artistic domain will therefore be more enduring than in the case of incidental use in advertising. Trademark rights impose a lasting burden on use of the sign in the artistic discourse.

Considering these consequences, it is doubtful whether commercial meanings added by trademark owners, such as Ajax Amsterdam and Colgate-Palmolive, can outweigh the loss of dialogic communication potential for artistic purposes. Admittedly, the connotations stemming from genuine trademark use may serve as an alternative reference point for artistic creativity. An artist may find the hybrid nature of the Greek hero inspiring. If the artist herself is a fan of the football club, the sports connotations may be a welcome starting point for an artistic comment. The resulting derivative work, however, must not be confused with a comment on the sign’s genuine cultural meaning. It is playing with the sign’s hybrid nature: the fact that the sign triggers an amalgam of cultural and

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52. Cf. R.S. Curtin, ‘Zombie Cinderella and the Undead Public Domain’, 85 *Tennessee Law Review* (2018), 961 (998).

commercial associations. It is an open question whether the opportunity to experiment with football connotations can compensate for the loss of artistic expression based on the cultural meaning of the name 'Ajax'. For a more general comment on the omnipresence of commercial messages in modern society, a wide variety of genuine commercial symbols is available: signs that have been devised as trademarks and carriers of commercial messages from the outset. Moreover, it seems cynical to first allow commercial messages to permeate cultural signs and justify this process afterwards by pointing to critical artistic comments on the devaluation of affected signs. Without the acceptance of trademark rights and the commercial redefinition of a Greek hero's name, the critical artistic comment would not have been necessary. The problem would not have arisen in the first place.

## 5. CONCLUSION

On balance, the adoption of cultural heritage signs as trademarks entails several risks. Trademark protection offers far-reaching control over the communication process surrounding the sign. It bestows upon the trademark proprietor broad definition power to shape the meaning of cultural public domain material. Instead of opening up the communication process, the grant of indefinitely renewable trademark rights to Ajax Amsterdam cements the club's hegemony in the communication process surrounding the Greek hero. Trademark protection means that one player in the communication process has strong incentives to invest in the development of her own messages and the suppression of the messages of others. The trademark owner becomes a centre of gravity in the communication process. Speakers in the cultural domain – artists looking for sources of inspiration and building blocks for new creations – may find it difficult to push the trademark owner's commercial messages aside and recultivate the sign as a cultural symbol and reference point of literary and artistic creativity.<sup>53</sup> The grant of trademark rights leads to a legal position that allows the trademark owner to develop threats of infringement and send cease-and-desist letters.<sup>54</sup> It changes the rules of the communication process fundamentally.

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53. Cf. *ibid.*, 1012–1013, who emphasises the need to ensure freedom of competition among producers of literary and artistic productions wishing to build upon public domain characters.

54. For a more detailed discussion of the chilling effect of cease-and-desist strategies in the artistic domain, see L.P. Ramsey, 'Free Speech Challenges to Trademark Law after *Matal v. Tam*', 56 *Houston Law Review* (2018), 401 (427); J. Schovsbo, "Mark My Words" – Trademarks and Fundamental Rights in the EU', 8 *UC Irvine Law Review* (2018), 555 (562); F. Cramer, 'Geef iedereen het recht op parodie', *NRC Handelsblad*, posted 15 April 2015, available at: <https://www.nrc.nl/nieuws/2015/04/15/geef-iedereen-het-recht-op-parodie-1484558-a197827>; I. Calboli, 'Overlapping Trademark and Copyright Protection: A Call for Concern and Action', 1 *Illinois Law Review Slip Opinion* (2014), 25 (31–32); Lemley and McKenna, *supra* note 47, 418–422, 443; W. McGeeveran, 'Four Free Speech Goals for Trademark Law', 18 *Fordham Intellectual Property, Media and Entertainment Law Journal* (2008), 1205 (1206–1207); L. Lessig, *Free Culture: How Big Media Uses Technology and*

The adoption of a Trojan War hero as a football figurehead thus triggers an information law dilemma. The acquisition of trademark rights makes inroads into the public domain. The discourse surrounding the cultural sign is no longer as open and free as it was before. Invoking broad protection against confusion and dilution, Ajax Amsterdam can take steps to censor artistic expressions that interfere with its branding strategy.<sup>55</sup> From a conceptual perspective, it can be added that the grant of trademark rights may also lead to a commercial redefinition and devaluation of Ajax as a reference point for literary and artistic productions. Once a public domain sign is no longer exclusively linked with its cultural background in the mind of the audience, an artist cannot avoid the evocation of both cultural and commercial connotations. The addition of undesirable marketing messages tarnishes the cultural dimension of the affected sign. It will erode the sign's artistic meaning and discourse potential over time.<sup>56</sup> This corrosive effect will be the stronger the less desirable commercial connotations appear in the light of the sign's original cultural meaning.

Against this background, an affirmative 'Of course Ajax Amsterdam has every right to appropriate the Greek hero' is less obvious than fans of the football club may hope. The decision on the grant and scope of trademark rights requires a careful balancing of all rights and interests at stake.<sup>57</sup> Should freedom of expression and freedom of information prevail? As I am not a football fan, the answer seems clear to me, even in cases that concern the Greek hero Ajax. Bernt may find it harder to ban, or at least restrict, trademark rights in this particular case.

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*the Law to Lock Down Culture and Control Creativity* (Penguin Press, New York, 2004), 185–188.

55. For a more detailed discussion of infringement arguments, see Senftleben, *supra* note 23, 141–200.
56. Assaf, *supra* note 41, 2–3; Senftleben, *supra* note 41, 101–102; Wandtke and Bullinger, *supra* note 41, 578.
57. Luckily, trademark law offers a broad spectrum of tools and regulatory responses: from the outright exclusion of trademark protection to the restriction of exclusive rights on the basis of a gatekeeper requirement of 'use as a mark' and robust defences. For a detailed discussion of these options, see Senftleben, *supra* note 23, 326–393, 424–521.



Part 4

Sporting Events:

Rules of the Game, Event Data  
and Reporting



# Database Rights in the EU's Data Strategy: A Question of Sport?

*Mireille van Eechoud*

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## 1. THE INTRODUCTION OF THE DATABASE RIGHT

When in the early 1990s, the EU first launched plans to introduce the *sui generis* database right, Bernt Hugenholtz was one of its most vocal critics.<sup>1</sup> For a while, on the many occasions he was invited to speak about copyright in prestigious European and American academic institutions, for policy-makers across the globe and for thinktanks, the protection of databases seemed to be his favourite theme. Two criticisms stand out for me in his work. First, that it is unclear whether a special intellectual property right in databases is necessary to have, rather than a more modest form of protection, e.g. based in unfair competition law. And secondly, if there is a case to be made for the *sui generis* right, then surely databases that are a 'spin-off', that is, a by-product of an organisations' regular activities, should be treated differently, especially if they concern single source data.

It cannot be a coincidence – but then again, in the larger scheme of things it probably is – that the first cases brought before the European Court of Justice on the new *sui generis* database right were about sports and spin-offs. Below I shall turn to this seminal quartet of decisions concerning the use of horseracing

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1. Unfortunately for non-Dutch speaking persons, Hugenholtz' most severe criticism is in Dutch: 'De Databankrichtlijn eindelijk aanvaard. Een zeer kritisch commentaar', 4 *Computerrecht* (1996), 131–138. See also P.B. Hugenholtz, 'Implementing the database directive', in P. Hugenholtz, J. Kabel and G.H.J. Mom, *Intellectual Property and Information Law: Essays in Honour of Herman Cohen Jehoram* (Kluwer Law International, The Hague, 1998), 183–200, calling the lawful user an 'especially tragic figure in the Directive's scheme of things ...'.

data and fixtures of the English and Scottish football leagues.<sup>2</sup> For now, it is worth noting that in its first quarter century, the Database Directive's *sui generis* right was the subject of a modest thirteen judgments given on preliminary references. Three concerned the activities of specialised search engines (*Innoweb*, *Ryanair*, *CV-Online Latvia*),<sup>3</sup> three related to the use of government data (company register data in *Compass-Datenbank*, legal data in *Apis-Hristovich*, mapping data in *Freistaat Bayern*)<sup>4</sup> and one dealt with what could be labelled university research data (*Directmedia Publishing*, on the re-use of a university professor's list of important poems).<sup>5</sup> The remaining six were about sports data, and resulted in the four first ever judgments on the Database Directive delivered on 4 November 2004, and two more on football betting data in 2012.<sup>6</sup>

In 2021, the European Commission is conducting a review of the Database Directive, as part of its wider package of measures to put in place a regulatory and support framework to implement its data strategy. The 'Data Strategy' has been in the making for nearly a decade. Data is held to be an essential resource for economic growth and societal progress.<sup>7</sup> The European Commission states that action is required because

a single market for data will make the EU more competitive globally and will enable innovative processes, products and services. Industrial and commercial data are key drivers of the digital economy. The European Data Strategy will make more data available for use in the economy and society, while keeping those who generate the data in control.<sup>8</sup>

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2. CJEU 9 November 2004, case C-444/02, *Fixtures Marketing/OPAP*, ECLI:EU:C:2004:697; case C-338/02, *Fixtures Marketing/Svenska Spel AB*, ECLI:EU:C:2004:696; case C-203/02, *British Horse Racing Board and others/William Hill*, ECLI:EU:C:2004:695; case C-46/02, *Fixtures Marketing/Oy Veikkaus*, ECLI:EU:C:2004:694; see M. Davison and P.B. Hugenholtz, 'Football Fixtures, Horseraces and Spin-offs: The ECJ Domesticates the Database Right', *EIPR* (2005), 113.
3. CJEU 19 December 2013, case C-202/12, *Innoweb/Wegener*, ECLI:EU:C:2013:850; CJEU 15 January 2015, case C-30/14, *Ryanair/PR Aviation*, ECLI:EU:C:2015:10; CJEU 3 June 2021, case C-762/19, *CV-Online Latvia/Melons*, ECLI:EU:C:2021:434.
4. CJEU 2 July 2012, case C-138/11, *Compass-Datenbank/Austria*, ECLI:EU:C:2012:449; C-545/07; CJEU 5 March 2009, case C-545/07, *Apis-Hristovich/Lakorda*, ECLI:EU:C:2009:132, CJEU, 29 October 2015, case C-490/14, *Freistaat Bayern/Verlag Esterbauer GmbH*, ECLI:EU:C:2015:735 (preliminary question asked concerned the definition of a database).
5. CJEU 9 October 2008, case C-304/07, *Directmedia Publishing/Albert-Ludwigs-Universität Freiburg*, ECLI:EU:C:2008:552.
6. CJEU 18 October 2012, case C-173/11, *Football Dataco and others/Sportaradar AG*, ECLI:EU:C:2012:642; CJEU 1 March 2012, case C-604/10, *Football Dataco and others/Yahoo! and others*, ECLI:EU:C:2012:115
7. European Commission. Directorate General for Communication. (2020). *The European data strategy: shaping Europe's digital future*. Publications Office. <https://data.europa.eu/doi/10.2775/645928>.
8. Prior policy papers include: Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions: Towards a thriving data-driven economy (COM(2014) 442 final); Communication from the Commission to the European Parliament, the Council, the European Economic and

The Data Strategy includes measures meant to promote data-sharing, ensure the free flow of (non-personal) data while safeguarding confidentiality and a return on investment, and make more public sector data available for re-use. Buzzwords include data sovereignty, data altruism and data spaces. The agenda is ambitious.

In this contribution I look at the place of the Database Directive in the wider Data Strategy, with some observations on how it plays out in sports data markets. After a few observations on sports data markets and players, some key issues are set out with respect to the applicability of the *sui generis* right to sports data. In particular, I will address the thorny issue of what counts as an investment in the collection and presentation of data, rather than in data creation, and the extent to which the use of observable data can be prevented. Moving on, this contribution sketches the main ingredients of the EU Data Strategy, its impact and relevance to database rights. It concludes with some observations on how the *sui generis* database right may be revised as a result of the Data Strategy.

## 2. SPORTS DATA MARKETS AND PLAYERS

Today, the global sports data market is estimated by some to be worth nearly USD 900 million annually.<sup>9</sup> Data are important for sports clubs and teams themselves, for purposes such as performance assessment through biometrics, monitoring player health, and analysis of competitors. But data also matter for broadcasters and their audiences, such as for prospective, real-time and post-play analysis of games, for media outlets, game developers and many other parties. The sports data market has various segments. A major distinction is between 'on field' data, which relate to sports as played and to sports players, and 'off field' data, which relate to fans/audiences, ticket sales, and so on. It is particularly the 'on field' types of data that are intensively commodified and that leagues, clubs and teams seek to control. Major companies providing data analytics and services include the likes of IBM, Oracle, SAP, SAS Institute and Sportrad AG.<sup>10</sup> Increasingly, the capture of data is automated. Data for sports betting remains an important segment. Betting services are becoming ever more sophisticated, using historical data and live game metrics (e.g. passes, attempts, ball possession) to provide more betting opportunities, including 'in-game' (live) betting.

Given the continued growth of sports data markets,<sup>11</sup> it stands to reason that control over the production, access and use of such data remains a key concern for many (private) parties. Considering the importance of sports in contemporary society, there are also public interests at stake. For the purposes of this contribution, I shall lump together leagues, clubs, teams, individual

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Social Committee and the Committee of the Regions: Building a European data economy (COM(2017) 9 final).

9. GrandView Research, *Global Sports Analytics Market Size Report 2021–2028*, April 2021.
10. See e.g. <https://www.ibm.com/sports>, <https://www.sap.com/products/sports-one.html>, <https://www.sportradar.com/>. The latter was a party in the dispute that led to case C-173/11 *supra* note 6.
11. T. Leonard, 'The 'Moneyball' Evolution: Artificial Intelligence, Athlete Data and The Future Of Sports Betting', *Forbes*, 7 November 2019.

players and their management, and together call these ‘sports producers’. Of course, their interests do not necessarily align. This is clear from conflicts over publicity rights (see the contributions elsewhere in this volume), but also from the everlasting battles over broadcasting rights, and from the recent failed attempt by top European football clubs to start a breakaway super league.<sup>12</sup> However, with respect to the use of data produced as a result of their combined efforts, the various sports producers of data will generally share an interest in its use by ‘secondary users’, that is all the different types of stakeholders who seek access to and use of sports data to be able to provide their key services, including betting services, news and entertainment, and eGames development.

The Database Directive and its *sui generis* right will likely continue to be of importance, together with key legal mechanisms such as trademark protection, copyright and related rights, trade secrecy laws, publicity rights, and of course contract law. The latter is relevant in all parts of the data value chain, for example from the contractual obligations of broadcasters and streaming services who have acquired rights to communicate sports events to the public, to the conditions imposed on stadium visitors to manage what gets recorded in stadiums (through the ‘house right’, i.e., the leverage deriving from being able to control access to venues).

### **3. THE *SUI GENERIS* RIGHT FOR SPORTS DATA**

In a nutshell, the protection offered under the Database Directive is as follows. To constitute a ‘database’ under the Directive there must be a ‘collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means’ (Art. 1(1) Database Directive). Excluded from protection are computer programs used in the making or operation of databases. A database can be protected by copyright and the *sui generis* right simultaneously, if the relevant criteria are met. Copyright protection arises for such collections that ‘by reason of the selection or arrangement of their contents, constitute the author’s own intellectual creation’ (Art. 3(1) Database Directive). No other criteria shall be applied to determine eligibility for copyright protection. Copyright does not extend to the contents. A *sui generis* right arises where ‘there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents’ (Art. 7(1) Database Directive).

The *sui generis* right protects against ‘extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents’. It can also be leveraged against repeated and systematic extraction and/or re-utilisation of insubstantial parts which conflict with a normal exploitation of a database or which unreasonably prejudice the legitimate interests of the database producer (Art. 7(5) Database Directive). Various legitimate uses exist,

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12. S. Evans, ‘Top European clubs announce breakaway Super League’, *Reuters*, 18 April 2021 <https://www.reuters.com/world/uk/top-european-clubs-announce-breakaway-super-league-2021-04-18/>

which the producer cannot override by contract (Art. 8(1) Database Directive). For databases that are not protected under the Database Directive, the contractual terms can be more restrictive, depending also on national law.<sup>13</sup>

The initial owner of the *sui generis* right is the producer (maker),<sup>14</sup> that is, 'the person who takes the initiative and the risk of investing' (Recital 41 Database Directive).

In the early stages of policy-making, there was still the idea on the table that not all producers of databases need protection, especially not those where data collections are the by-product of another (main) activity ('spin-off databases'). This is often the case in the public sector, where bodies collect and maintain vast amounts of data in the exercise of public tasks. But for private actors too, databases are often a natural outcome of principal activities: the overview of houses for sale that an estate agent keeps, or stock lists of car dealers. And, ideas were floated that if there was only one source for data, a system of mandatory licensing might be good to have. In the Netherlands, Hugenholtz along with Verkade – who elsewhere in this volume proposes the introduction of a Lex Hugenholtz to protect portraits – and others had played an essential role in the development of this so-called 'spin-off doctrine'. By the time the millennium approached, a wide body of legal scholars, as well as the Dutch government, had subscribed to the spin-off doctrine, although its exact boundaries remained somewhat vague. Courts on the other hand did not recognise it (apart from the occasional district court),<sup>15</sup> especially not once the Database Directive was in force. The CJEU in *Fixtures Marketing/OPAP* made it clear that the fact that a database is a spin-off does not as such prevent *sui generis* rights from arising. And as is well-known, the Directive makes no distinction between databases produced in the public or private sector.

The first four preliminary references to the Court of Justice centred on the question of what type and level of investment was needed for it to be substantial, and what type of costs count. Furthermore, the Court was asked to provide guidance on what constitutes extraction of re-use of a substantial part, quantitatively or qualitatively speaking.

In those first cases, database rights were claimed in the schedules of football league competitions and in horseracing. The case of the football fixtures concerned dates, teams and places for some 2,000 matches played during each season. In the horseracing case, a betting company used certain data on races such as horses in the race, the date, time and/or name of the race, and racecourse. The ultimate source of this data was a massive database controlled by the British Horseracing Board, which has data on, *inter alia*, the pedigrees of some one million horses, horse owners, and data on races to be held in the UK including information on eligibility to enter the race, deadlines for entries, and prizes.

13. Case C-30/14 (*Ryanair/PR Aviation*), *supra* note 3.

14. Art. 11 Database Directive sets out additional criteria for rightholders not based in the EU.

15. For an in-depth analysis, see A.C. Beunen, *Protection for Databases: The European Database Directive and its Effects in the Netherlands, France and the United Kingdom* (Wolf Legal Publishers, Nijmegen, 2007) <https://hdl.handle.net/1887/12038>.

On the right kind of investment, the Court considered that

the expression ‘investment in … the obtaining … of the contents’ of a database must … be understood to refer to the resources used to seek out existing independent materials and collect them in the database, and not to the resources used for the creation as such of independent materials. The purpose of the protection by the *sui generis* right provided for by the directive is to promote the establishment of storage and processing systems for existing information and not the creation of materials capable of being collected subsequently in a database.<sup>16</sup>

Thus, the resources committed by the football leagues and the British Horse Racing board in creating the competition and race schedules did not count towards the substantial investment, as these went towards the creation of data, not obtaining (collecting) it. In the words of Davison and Hugenholtz: the Court ‘discounts investment in collecting data that is indivisibly linked to its creation’.<sup>17</sup>

Much can be said about the distinction between creation and collection, but as Jacob J. pointed out in *Football Dataco v. Stan James*,<sup>18</sup> this soon turns into metaphysical musings. On the argument that it is the observer who creates data in the act of recording it, for example by measuring ambient temperature, Jacob says: ‘The same metaphysicist might also deny that a temperature exists unless and until it is recorded. But he would feel hot in a Turkish bath even without a thermometer’ (para. 34).

Suffice to say that for our purposes, the conflict is usually around the use of observable data (that is: pre-existing data) which is recorded in various ways. This was also the type of conflict central to the above-mentioned *Football Dataco* joined cases, which were ultimately decided by the Court of Appeals for England and Wales. To avoid confusion on the many *Football Dataco* cases: the CJEU judgment in *Football Dataco v. Yahoo! and others* originated in an earlier English dispute between partly the same parties. The preliminary questions there concerned copyright, not the *sui generis* right. The CJEU judgment in *Football Dataco and others/Sport Radar and others* was given in response to preliminary questions raised on the issue of jurisdiction of English courts to hear claims for infringement of database rights.<sup>19</sup>

In the case before the Court of Appeal, an important point raised by the defendants was that resources spent on obtaining in-game data should not count towards the required substantial investment, because it in fact constituted creation of data. The Court of Appeal rejected this conflation of creating and obtaining. The plaintiff did not create but obtained them by recording *observable* data, investing heavily in doing so. *Football Dataco* collected part of its data by sending paid persons to record data at live football matches. The person present would report goals, attempts, misses, players involved, cards given, and other

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16. CJEU C-444/02, *Fixtures Marketing/OPAP*, similar in case C-46/02, *supra* note 2.

17. Davison and Hugenholtz, *supra* note 2.

18. [2013] EWCA Civ 27, *Football Dataco and others v. Stan James, Sportradar and others*.

19. [2011] EWCA Civ 330, *Football Dataco and others v. Sportradar and others*, preliminary questions resulting in CJEU case C-173/11, *supra* note 6.

observable data to Football Dataco staff during the game via mobile phone. It cost in the region of GBP 600,000 annually to populate this 'Football Live' part of the database. Sportradar has a large database which also contains a section with data on live games. The 'live' data are recorded from live broadcast games, from live streams, or, failing access to such direct sources, from secondary sources including subscribers to Football Live, such as news outlets and sports information programmes. Thus, Sportradar's Live Scores includes live statistics that are extracted at some point from Football Live. Finding there was substantial investment in the production of the database, the next question to be addressed was whether there was 'substantial taking'. Since the volume of data derived from Football Live was not large (i.e. not quantitatively a substantial part), all turned on whether there was qualitatively a substantial taking.

How to determine this, and how to view the connection between substantial investment qualitatively and substantial taking qualitatively? In the *Fixtures* and *BHB* cases the ECJ connected – as Davison and Hugenholtz observed – the criterion of substantial investment needed for a database right to exist, with the substantial taking of the contents of the database for the database producer to be able to successfully invoke infringement of the right. There is qualitatively speaking a substantial taking if the scale of the investment by the producer in the obtaining, verification or presentation of the contents taken by the user is substantial. According to the Court, the intrinsic value of the data is not a relevant factor for determining whether the taking is substantial.<sup>20</sup> So the Court looks to what we might call the 'production' value, not the commercial value. In *Football Dataco*, the Court of Appeal found that there was a very significant investment due to the costs of the persons recording and processing the data and the overall set-up, and that Sportradar (indirectly) extracted data on a substantial proportion of the matches in Football Live, therefore taking qualitatively a substantial part.

*Fixtures* and *BHB* were early cases. Recently, on the question of whether there is taking of a substantial part, the CJEU seems to be moving towards a infringement test where it is not just the production value that matters. In the 2021 judgment in *CV-Online Latvia/Melons*, the Court was called upon to yet again explain when there is extraction or re-use, this time with respect to a website with job advertisements, which is crawled by a specialised search engine. The hits are returned as hyperlinks to the source websites, and include the meta-tags (e.g. job title, place of employment) that CV-Online assigns to the advertisements to improve search results. The defendant indexes and copies the content of job advertisement websites on its own server, and provides its users access to their content. The presumption in this case is therefore that there is substantial taking.

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20. CJEU case C-203/02, *supra* note 2, para. 72. Compare however the CJEU in *Freistaat Bayern/Esterbauer*, where it held that a topographic map is a collection of data (namely, of independent elements) within the meaning of the Database Directive, because the elements extracted from the map (position of cycling lanes) *have informative value for the person* (publisher Esterbauer) taking them. This (curious) line of reasoning suggests that the intrinsic value for the user is a relevant factor for determining the existence of a right. That is odd. See M.M.M. Van Eechoud, 'De ontsporing van het begrip databank. Enige bedenkingen bij HvJEU Freistaat Beieren/Verlag Esterbauer', *AMI* (2016), 25–30.

Surprisingly however, the judgment allows for the conclusion that there is no *relevant* extraction or re-use, even though the taking was substantial. The Court says

it is necessary to strike a fair balance between, on the one hand, the legitimate interest of the makers of databases in being able to redeem their substantial investment and, on the other hand, that of users and competitors of those makers in having access to the information contained in those databases and the possibility of creating innovative products based on that information [para. 41],

and that

the main criterion for balancing the legitimate interests at stake must be the potential risk to the substantial investment of the maker of the database concerned, namely the risk that that investment may not be redeemed [para. 44].<sup>21</sup>

Here, the Court seems to introduce an additional harm-based threshold to be met for there to be infringement. This marks a retreat on the CJEU's previous expansive interpretation of the database right. It also complicates the coherent application of the qualitative/quantitative criterion to both investment (required for existence of the right) and extraction/re-use (required for infringement).

Ditching the distinction between quantitative and qualitative substantial taking may show the way out of the muddy waters. If taking a substantive part is judged merely on qualitative standards, that would leave room to consider the effect on the producer's ability to recoup her investment. Surely this is a matter for the legislator to consider in its review of the Database Directive. Another aspect I suggest warrants consideration, is the spin-off doctrine. This, as will be set out next, would be consistent with the idea behind database protection – stimulating the creation of databases by enabling recoupment of the necessary investments – and EU's larger data strategy. It would however not affect rights in sports data.

#### **4. REVISITING THE SPIN-OFF DOCTRINE IN LIGHT OF THE EU DATA STRATEGY**

The EU in its ambition to fuel the 'data economy' is increasingly interested in regulation that promotes the optimal use and sharing of data. Gone are the days when exclusive rights were the go-to solution to grow information markets. To understand the Data Strategy and its (potential) impact on database rights, it helps to have some idea of its constituent parts. The overall ambition is to increase production, demand and use of data and data-enabled products and services.<sup>22</sup>

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21. CJEU 3 June 2021, case C-762/19, *CV-Online Latvia/Melons*, ECLI:EU:C:2021:434.

22. Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions, *A European Strategy for Data*, COM/2020/66 final, Brussels 19.2.20.

In terms of legal instruments, these include the 2016 General Data Protection regulation<sup>23</sup> and other data protection laws, which aim to ensure a high level of protection for data subjects, while enabling the flow of personal data in (and outside) the internal market. Then there is the 2018 Non-Personal Data Regulation, which restricts the imposition of data localisation requirements on public and private actors by Member States and sets out initiatives to promote data portability.<sup>24</sup> Another key component is the 2019 Open Data Directive,<sup>25</sup> formerly known as the Public Sector Information Directive.<sup>26</sup> It applies to databases produced by public sector bodies (including public undertakings) across all levels of Member States' legislative, judicial and administrative branches, including those of cultural heritage institutions and universities. So far, public service broadcasters remain excluded from its scope, partly as a result of successful lobbying, partly because much of their content contains third party intellectual property. Public broadcasters are of course still important sources of sports programmes, but increasingly less so where the most commodified sports are concerned.

The Open Data Directive's rules aim to ensure that public information can be re-used with as few strings attached as possible, and this includes severe limitations on the exercise of their own copyright and database rights. The Open Data Directive's implementation date is 17 July 2021; from this date public sector bodies whose databases fall within the scope of the Open Data Directive are explicitly barred from exercising their *sui generis* database rights.

As a rule, information that is the subject of private sector owned copyright and related rights is left untouched by the Open Data Directive. However, this is set to change with the introduction of the Data Governance Act.<sup>27</sup> The proposal for this regulation takes the Open Data Directive one step further by pushing many public sector bodies whose data are exempt from the scope of the latter, to open up data for maximum re-use nonetheless. This would also apply where third parties own intellectual property rights, although the public sector body would have to ensure it has proper authorisation.<sup>28</sup> Admittedly, the impact on sports data markets of this new regulation would be limited if not absent all together, also because the Data Governance Act would again exempt public service broadcasters. The impact of the proposal's other elements will likely be limited

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23. Regulation (EU) No. 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data ('General Data Protection Regulation'), OJ 2016 L 119/1.
24. Regulation (EU) 2018/1807 of the European Parliament and of the Council of 14 November 2018 on a framework for the free flow of non-personal data in the European Union, OJ 2018 L 303/2.
25. Directive (EU) 2019/1024 of the European Parliament and of the Council of 20 June 2019 on open data and the re-use of public sector information, OJ 2019, L 172/56.
26. Directive 2013/37/EU of the European Parliament and of the Council of 26 June 2013 amending Directive 2003/98/EC on the re-use of public sector information, OJ 2013, L175/1.
27. Proposal for a Regulation of the European Parliament and of the Council on European data governance (Data Governance Act), COM/2020/767 final, Brussels 25.11.20.
28. M. van Eechoud, 'A Serpent Eating Its Tail: The Database Directive Meets the Open Data Directive', 52(4) *IIC* (2021), 375–378, <https://doi.org/10.1007/s40319-021-01049-7>.

as well. One concerns a scheme for (trusted) data intermediaries, the other the recognition of (not for profit) data-altruism initiatives. In a nutshell, service providers that seek to operate as neutral arbiters between businesses seeking to share data (for free or against remuneration) can do so in the future by going through a notification procedure secure the ability to provide their services across Europe without having to meet all kinds of local legal requirements. However, the weight of the obligations – i.e. ensuring users respect intellectual property rights and data protection standards, etc. – seem to be such that one can doubt whether the scheme will be popular. What is more, as long as sports data producers can effectively exercise control over who gets to record ‘on field’ data, the question is whether there will be a demand for data intermediary services to begin with. The deployment of advanced automated tools for capturing data from live games (broadcast or streamed) by third parties could change the dynamics somewhat. But for most in the value chain, having access to the pipeline controlled by sports producers will still be vital.

Another key element of the Data Governance Act proposal concerns data-altruism, whereby natural and legal persons share data on a non-commercial basis, especially for general interest purposes. Organisations would be able to register as ‘Data Altruism Organisations recognised in the Union’ to enhance their attractiveness. Perhaps this could be a vehicle to produce in-game statistics by sports fans watching live games in venues or online, akin to the crowd-sourced mapping of Open Street Map, or the creation of Wikipedia. But here too, the combined power of sports data producers to set conditions for the capture of data would be a barrier.

Overall, my prediction is that the EU Data Strategy will not have a profound impact on sports data markets directly. However, the fact that the mindset of EU policy makers is now so clearly on facilitating the sharing of data, as opposed to subjecting it to exclusive rights, suggests there might be significant indirect effects as a result of the coming revision of the Database Directive. One direction in which the legislator might go is to follow the CJEU’s lead in *CV-Online Latvia* and introduce a harm-based criterion where infringement of the *sui generis* right is concerned. Another possibility by which the scope of the *sui generis* right might be reduced is through the introduction of a spin-off criterium, i.e. excluding *sui generis* database rights in data collections or parts of collections that result from a producer’s main activities. That would tie in perfectly with the foundational notion of ‘re-use’ as used in the Open Data Directive (not the Database Directive): if data have been produced in the context of a public task and the investment in their production has been made, subsequent use for other purposes should be possible to the maximum extent, without intellectual property rights getting in the way. The logic of this is very similar to that which underlies the spin-off doctrine: if data have been produced already in the course of an organisation’s main (or other) activity – like organising a football competition – then it is not necessary to protect that data so that investments can be recouped.

Bernt Hugenholtz would perhaps regard it as poetic justice that of the two instruments that share a common history – the Database Directive and the Open

Data Directive<sup>29</sup> – the latter's ideas may eventually triumph. A complication of course is that database rights, as full-fledged intellectual property rights, are protected under Article 17 of the Charter of Fundamental Rights of the EU. This, I suspect will be an excellent topic for a volume in the Information Law Series celebrating the Database Directive's thirtieth anniversary.

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29. For a short overview, see van Eechoud, *supra* note 28.



# Of Football Fixtures, Football Matches, Jeans, Sweatshirts ... and a Folded Bike: Functionality in the CJEU's Copyright Case Law

*Matthias Leistner*

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## 1. INTRODUCTION

Bernt Hugenholtz's work in relation to the harmonisation of European copyright law has inspired my work since its very beginnings. All this happened before I could even meet him in person for the first time – since then I have tremendously enjoyed and invaluabley profited from countless discussions with him and also with his numerous excellent academic offspring! In fact, my dissertation thesis of 1996 on the European Database Directive quotes no less than seven of Bernt's works, many concerned with the quality of European lawmaking, the adequate treatment of predominantly functional creations in copyright law, and – most of all – with preserving a public domain of unprotected basic building blocks to ensure free dynamic competition in copyright affected markets. The recent CJEU's case law on the treatment of functional elements in copyright (and the delineation from design and patent protection) unifies all these issues: it is visibly influenced by external copyright objectives, namely, the objective to achieve effective conceptual harmonisation on the level of Union law, it concerns functional elements in copyright law, and – most of all – it is essentially about the preservation of freedom for workable dynamic competition.

In the following, I will try to show, first, that the CJEU's case law on functional elements in the context of the condition of copyright protection, while not being perfect, is better than its reputation.<sup>1</sup> Secondly, that the imperfections

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1. See critically e.g. Annette Kur, '*Unité de l'art* is here to stay – *Cofemel* and its consequences',

of that case law are mainly due to the CJEU's secondary objective to provide a stable, conceptually unitary and legally certain harmonised framework on the EU level in the interests of the functioning of the internal market. Thirdly, that this very attempt at conceptual unity, paradoxically, rather hinders effective harmonisation. And, fourthly, that nonetheless, this case law allows for the development of workable criteria to deal with functional elements of alleged creations in the context of copyright law.

Notably, the problem is not limited to the sector of copyright protection for designs or shapes of products. Indeed, this area is in fact most complex because of potential overlap issues in the overall context of IP law and the most recent case law consequently concerned product designs. Nonetheless, from a copyright perspective the problem is of a general nature and also concerns copyright protection for photographs, works of literature, works of architecture, database works (or more generally: collections), and even certain musical works and others.

Under this broader perspective, aspects of an EU functionality doctrine have clearly been developed in judgments, such as *BSA*,<sup>2</sup> *SAS Institute*,<sup>3</sup> *Football Dataco*,<sup>4</sup> *Cofemel*<sup>5</sup> and *Brompton*<sup>6</sup> – but they also feed into the analysis in judgments, such as *Evora*,<sup>7</sup> *Painer*,<sup>8</sup> *Football Association Premier League*,<sup>9</sup> *Levola*<sup>10</sup> and *Funke Medien*.<sup>11</sup> On the surface, most of these judgments concern the condition of copyright protection proper. Below the surface, two basic meta-objectives can be identified, the first of which is more or less present in all these cases, the second only in some of them.<sup>12</sup> The first is about reserving a public domain of functional elements to ensure sufficient freedom for workable dynamic competition.<sup>13</sup> The

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*Journal of Intellectual Property Law & Practice (JIPLP)* (2020), 291; Tobias Endrich-Laimböck, 'Little Guidance for the Application of Copyright Law to Designs in *Cofemel*', *Gewerblicher Rechtsschutz und Urheberrecht (GRUR) Int.* (2020), 264; more positively Matthias Leistner, 'Einheitlicher europäischer Werkbegriff auch im Bereich der angewandten Kunst', *GRUR* (2019), 1114; Estelle Derclaye, 'The CJEU decision in Brompton Bicycle – A welcome double rejection of the multiplicity of shapes and causality theories in copyright law', *Kluwer Copyright Blog*, 25 June 2020; Ilanah Simon Fhima, 'The CJEU decision in Brompton Bicycle (Case C833/18): an original take on technical functionality?', *European Intellectual Property Review (E.I.P.R.)* (2020), 761.

2. CJEU, 29 December 2010, case C-393/09, ECLI:EU:C:2010:816, *BSA*, para. 48 et seq.
3. CJEU, 2 May 2012, case C-406/10, ECLI:EU:C:2012:259, *SAS Institute*, para. 39 et seq.
4. CJEU, 18 October 2012, case C-604/10, ECLI:EU:C:2012:115, *Dataco*, para. 39 et seq.
5. CJEU, 12 September 2019, case C-683/17, ECLI:EU:C:2019:721, *Cofemel*, para. 26 et seq.
6. CJEU, 11 June 2020, case C-833/18, ECLI:EU:C:2020:461, *Brompton*, para. 20 et seq.
7. CJEU, 4 November 1997, case C-337/95, ECLI:EU:C:1997:517, *Dior*, para. 56 et seq.
8. CJEU, 1 December 2011, case C-145/10, ECLI:EU:C:2011:798, *Painer*, para. 86 et seq.
9. CJEU, 4 October 2011, joined cases C-403/08 and C-429/08, ECLI:EU:C:2011:43, *FAPL*, para. 96 et seq.
10. CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, *Levola*, para. 39 et seq.
11. CJEU, 29 July 2019, case C-469/17, ECLI:EU:C:2019:623, *Funke Medien*, para. 23 et seq.
12. Uma Suthersanen and Marc D. Mimler, 'An Autonomous EU Functionality Doctrine for Shape Exclusions', *GRUR Int.* (2020), 567.
13. CJEU, *SAS Institute*, *supra* note 3, para. 40 et seq. (and in AG Bot's opinion), where the specific Recitals of the Computer Program Directive allowed for express and transparent treatment of this objective; cf. later also in CJEU, *Levola*, *supra* note 10, para. 41: clear and precise identification of the protected subject matter in the interest of potential competitors.

second is of a contextual nature. It concerns delineating or coordinating different IP rights, namely at the interface of copyright and patent law, design law, and also trade mark law (i.e. the different industrial property rights).<sup>14</sup>

As for this second objective, the basic principle is the cumulation of different IP rights.<sup>15</sup> However, this is not a principle without limits as cases such as *BSA*, *Cofemel* and *Brompton* show. These limits are partly informed by the first objective and they feed into the two elements of the copyright condition of protection, i.e. originality in the sense of an own intellectual creation and the expression of that creation.<sup>16</sup>

In particular, originality requires that the subject matter reflects the personality of the author which can only be the case if there was sufficient room for creative freedom to make free, creative choices *and* if such choices were actually made. *Spielraum* (room for creative freedom) is thus a necessary, but not sufficient precondition for originality. Consequently, if technical functions<sup>17</sup> or other ‘technical rules or constraints’<sup>18</sup> leave no room for creative freedom, the originality criterion cannot be satisfied. Some have characterised this as a European merger doctrine;<sup>19</sup> in more recent case law, the Court has also derived this from inherent copyright principles.<sup>20</sup>

Consequently, a first rule for carving out technical or functional elements (i.e. ideas) and delineating copyright law from the industrial property rights follows from the central concept of *Spielraum* and can be formulated as follows:

If the elements in question are strictly necessary to achieve a certain technical or functional result or if, for any other reason, there is no substantial room for creative freedom, copyright protection does not apply.

Only if there are at least some creatively alternative ways to achieve the technical or functional result, further assessment is required.

In these latter ‘mixed’ cases, where a multiplicity of solutions exists to achieve a technical or functional result, the mere existence of respective room for creative freedom does not suffice for originality, however. The CJEU made this unequivocally clear<sup>21</sup> in *Brompton*<sup>22</sup> and has insofar on the face of it partly aligned

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In CJEU, *Brompton*, *supra* note 6, para. 27, the Court has now generalised this objective beyond the specific area of computer programs and has made it a central objective of functionality doctrine in copyright law.

14. See further on the delineation in trade mark law Martin Senftleben, *The Copyright/Trademark Interface* (2021), at p. 210 et seq.
15. CJEU, *Cofemel*, *supra* note 5, para. 36 et seq. See comprehensively and in favour of a more freedom of competition oriented approach Estelle Derclaye and Matthias Leistner, *Intellectual Property Overlaps* (2011).
16. CJEU, *Brompton*, *supra* note 6, para. 23 with further references.
17. CJEU, *BSA*, *supra* note 2, para. 48 et seq.; *Brompton*, *supra* note 6, para. 27.
18. CJEU, *Dataco*, *supra* note 4, para. 39.
19. Similarly Fhima, *supra* note 1, at 764.
20. Namely, the idea/expression distinction as a global common principle of copyright law, laid down in Art. 2 WCT, cf. CJEU, *Brompton*, *supra* note 6, para. 27.
21. Cf. Derclaye, *supra* note 1.
22. CJEU, *Brompton*, *supra* note 6, paras. 32, 35.

copyright law with the specification of the respective exclusions of functional elements in trade mark<sup>23</sup> and design law.<sup>24 25</sup> In copyright, a specific kind of creativity has to be expressed in the subject matter which is not predominantly governed by technical or functional considerations and thus allows the author to 'stamp' his personality on the creative process.<sup>26</sup>

Thus, a second rule can be formulated as follows:

Even if there is sufficient room for creative freedom, this room must be used in a particular personal way, i.e. by making free, personal choices in a creative process untrammelled by governing technical or functional considerations and thus in a creative process specifically related to the purposes of copyright law.

This second rule is of particular relevance where shapes of products are concerned which can also be protected by other IP rights. Nonetheless, it not only expresses a functionality doctrine for shapes along the lines of design and trade mark law. On the contrary, the second rule embeds a fundamental principle of copyright law proper. Consequently, it is also relevant for collections, such as database works,<sup>27</sup> or even works of literature<sup>28</sup> and football matches.<sup>29</sup>

This analysis prompts the question as to which kind of creativity must be involved to fulfil the condition of originality. Although, this is a general problem in copyright law, it is more pressing and complex in 'mixed' cases, where the delineation from other protection systems and kinds of creativity (being focused on technical inventions (i.e. patent law) or more on the relation between product and customer (i.e. design law and trade mark law)) is particularly intricate. For such cases, the Court has refused to specify hard and fast rules or criteria to delineate these different protection systems beyond the two mentioned conditions/rules for originality. Instead, it has laid down additional general guidelines. Concerning the copyright/design overlap, the Court has stated the principle that the overlap should not be total, but limited to certain cases in order to allow both areas of law sufficient room for their respective specific objectives, subject matter, economic rights and limitations.<sup>30</sup> This general principle is correct but unspecific. As to the copyright/patent overlap, the Court has held that (expired) patent protection can be a flexible indicator for a creative process which was mainly governed by technical considerations and thus not sufficiently original.<sup>31</sup>

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23. CJEU, 18 June 2002, case C-299/99, ECLI:EU:2002:377, *Philips*, para. 66 et seq.; CJEU, 14 September 2010, case C-48/09 P, ECLI:EU:C:2010:516, *Lego Juris*.

24. CJEU, 8 March 2018, case C-395/16, ECLI:EU:C:2018:172, DOCERAM.

25. Cf. Suthersanen and Mimler, *supra* note 12; AG Campos Sánchez-Bordona, Opinion of 6 February 2020, *Brompton*, *supra* note 6, para. 81 et seq.; differentiating Derclaye, *supra* note 1.

26. CJEU, *Painer*, *supra* note 8, para. 92.

27. CJEU, *Dataco*, *supra* note 4.

28. CJEU, *Funke Medien*, *supra* note 11, para. 24.

29. CJEU, *FAPL*, *supra* note 9, para. 96 et seq.

30. CJEU, *Cofemel*, *supra* note 5, para. 52; skeptical Endrich-Laimböck, *supra* note 1, at 267.

31. CJEU, *Brompton*, *supra* note 6, para. 36.

Clearly, this is not a clear delineation rule either, but rather one element among many for the assessment of originality.

All in all, the functionality doctrine in copyright law is not mainly about the delineation from industrial property rights, but instead feeds into the analysis of originality as the central requirement for copyright protection.<sup>32</sup> Consequently, it is mainly<sup>33</sup> originality which has to shoulder the burden of accommodating the abovementioned two main objectives for a functionality carve-out and balance them with the other objectives underlying copyright law and the IP system.<sup>34</sup> But is the rather general concept of originality robust and specific enough to fulfil this function? And should further specification take place at the (upper) level of interpretation of EU law by the CJEU or rather at the (lower) level of application of EU law by the Member States' courts, taking into account as guidance the aforementioned rules and general principles (see on these questions section 2 below)? Also, if the function of further specifying the originality criterion, in particular with regard to the copyright/design overlap, were effectively left to the Member States' courts, this would beg the question of how to develop reasonable common criteria and, ultimately, whether such reasonable criteria would still be consistent with the general conceptual framework and principles developed by the CJEU (see further section 3).

## **2. AUTONOMOUS CONCEPTS OF EU COPYRIGHT LAW, THEIR INTERPRETATION AND APPLICATION**

When analysing the Court's copyright case law since the enactment of the Information Society Directive, it is striking that the Court after a very pro-active political phase has – in the most recent judgments – chosen a slightly more restricted approach. Take the example of exceptions. While early judgments – surprisingly – required autonomous uniform and consistent interpretation (despite the mere ceiling character of Article 5 Information Society Directive), the most recent judgments in the area leave slightly more leeway for specification by Member States' courts. The same development can be identified with regard to the condition of protection. While early judgments thrived to establish uniform basic conceptual structures and occasionally did not even hesitate to specify these concepts in concrete cases, the judgments in *Funke Medien*, *Cofemel* and *Brompton* and other more recent judgments have only established general guidelines while leaving their specification to Member States' courts. This is even more remarkable because in *Cofemel* and *Brompton*, the Advocate Generals had proposed substantially more specific criteria to assess the exclusion of functional elements from copyright law, while the Court remained comparatively reserved.

In itself, this would not be a major problem. In the European multi-level judicial system, interpretation of the autonomous concepts of EU law is the

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32. Fhima, *supra* note 1, at 767.

33. Partly, the requirement for a precisely and objectively identifiable expression also contributes to that goal, cf. CJEU, *Levola*, *supra* note 10, para. 41.

34. Suthersanen and Mimler, *supra* note 12, at 575.

competence of the CJEU, while the application of the resulting concepts to concrete cases is left to the Member States' courts. The competence to further define the thin red line between interpretation and application and thus the competence to decide about the depth of harmonisation in certain sectors is in principle with the CJEU. The Court, however, in this endeavour also depends to a certain extent on factual acceptance by the Member States' courts since the effective functioning of this system stands and falls with the actual willingness (and for the Member States' highest courts the willingness to comply with the obligation) to *refer* questions on the interpretation of secondary EU copyright instruments to the CJEU for a preliminary ruling.<sup>35</sup> Ideally, this multi-level system can establish the required minimum legal certainty on the level of Union law, while leaving certain leeway for manoeuvre in light of different cultural and legal traditions to the Member States' courts (the delineation depending on the specific provision concerned).

However, on closer examination, enabling flexibility does not really seem to be so close to the heart of the Court's even more recent case law. This can be derived from the fact that the Court, while establishing a rather general structure which could be specified by the Member States' courts based on certain more specific criteria, refuses acceptance of most of these reasonable criteria when they are proposed by a national court in a specific reference case. Accordingly, on the face of it, in *Cofemel* a certain significant aesthetic effect as a standard of copyright protection for designs, proposed by the Portuguese court, was rejected by the CJEU.<sup>36</sup> This is hard to understand and the reasoning behind this (based on the *Levola* judgment on the requirement of a clearly and objectively identifiable expression) is at least partly flawed, because it mixes the condition of originality and the requirement for a concrete expression as two distinct elements of the copyright condition for protection.<sup>37</sup> In fact, the Court rather than allowing the national court to experiment with the development of reasonable criteria within certain guardrails of Union law, seems to be overly concerned with establishing a clear, legally certain and unambiguously pure conceptual framework on the European level. However, such an attempt to achieve legal certainty by denying complexity and the necessarily 'open' and highly sector-specific character of certain balances of interests in copyright law, does not seem too promising. One might argue, however, that the Court reacted sceptically in *Cofemel*, only because the national court's reasoning and proposal in the first reference question was related to the statutory framework in Portuguese copyright law, where works of applied art are only protected on the condition that they constitute an artistic creation (cf. the second reference question which was not answered by the Court).<sup>38</sup> Consequently, the Court would only be sceptical to additional conditions

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35. Art. 267 TFEU. See further Matthias Leistner, 'Die Methodik des EuGH und die Garantienfunktion der nationalen Gerichte bei der Fortentwicklung des europäischen Urheberrechts', in Wolfgang Büscher (eds.), *Festschrift für Joachim Bornkamm zum 65. Geburtstag* (Beck, Munich, 2014), 859.

36. CJEU, *Cofemel*, *supra* note 5, para. 53 et seq.

37. Leistner, *supra* note 1, at 1117 et seq.

38. CJEU, *Cofemel*, *supra* note 5, para. 15 et seq.

for design protection in national copyright statutes, while the reference to certain factors and criteria to establish the condition of a personal creation by the author would remain permissible in the application of Union law by the national courts.

I have elsewhere tried to criticise this using a footballing analogy: the Court after having gained the ball with a very aggressive tackle,<sup>39</sup> instead of playing tiki-taka in a flexible *totaalvoetbal* system towards the opponent's box, plays a catenaccio safety pass back to the goalkeeper of conceptual purity and clarity.<sup>40</sup> However, historical experience shows that attempts to achieve uniformity and certainty of the law at the expense of its quality do not work in the long run. For example, in the US, with regard to the Court of Appeals for the Federal Circuit's patent law jurisdiction, a comparable approach has led to an overly cemented system of allegedly clear, stable (and at least initially too extensive) tests, which however failed to establish the necessary fair and reasonable (and to a certain extent flexible and sector-specific) balancing of interests in certain sectors – and thus were gradually corrected by the U.S. Supreme Court in favour of more flexible multi-faceted approaches.<sup>41</sup>

Be that as it may, for the treatment of different functional elements in copyright law, the only decisive practical question is whether the conceptual framework of the CJEU nonetheless allows for reasonable development and iterative specification of respective criteria under the concrete institutional conditions of the EU multi-level judicial system. The answer to this question seems to be a cautious 'yes', depending on the respective procedural 'wisdom' of the national courts. This is because, in principle, the CJEU encourages Member States' courts to further specify the basic structural elements of originality and concrete expression taking account of reasonable general guidelines.<sup>42</sup> Problems only result when the Court, for reasons of an assumed need for conceptual harmonisation, does not hold to its own promise and reacts sceptically to further specification of these rules and general principles on the basis of additional criteria proposed by national courts in reference questions – which at least partly happened in *Cofemel*.

In my view, this somewhat paradoxical attitude of the Court nonetheless allows for the reasonable development of more specific assessment criteria in respective national laws. To be sure, additional express specific conditions for copyright protection of works of applied art in national statutes seem no longer permissible under the *Cofemel* doctrine if they deviate from the unitary concept of work in Union law. However, even against this background, taking the Member States' courts' substantive role in the specification of general standards and open general clauses of EU law via their application of EU law seriously, it seems that there is room for manoeuvre in specifying the condition of an

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39. In light of Art. 17 Design Directive and Art. 96 (2) Design Regulation, the competence of the Court to apply the general notion of work also in that sector has remained disputed, cf. Kur, *supra* note 1, at 291 et seq.

40. Leistner, *supra* note 1, at 1117.

41. Cf. Rochelle C. Dreyfuss, 'The Federal Circuit: A Case Study in Specialized Courts', 64 *NYU Law Review* (1989), 1 (26).

42. See section 1 *supra*.

intellectual creation in specific fields. By using this remaining procedural room for manoeuvre wisely, it seems that the Member States' courts should be able to reasonably specify the basic structural elements of the concept of work in the field of applied art in line with the CJEU's more general guiding principles. In fact, national courts will have to make sure that the specifying criteria in order to reach the underlying meta-objective of a reasonably strict standard with regard to functional elements (which is shared by the CJEU) are not put to the test before the Court in the form of additional conditions, which in themselves, suffice to establish the condition of a protectable work. Instead, such reasonable specification criteria should be framed as mere case-related specifying factors or 'aspects'<sup>43</sup> (i.e. mere non-conclusive indicators) of originality. For the time being, they might thus even, where legally possible, be developed 'under the radar' of the Court's continued detailed control since the necessary basic elements of the notion of work are meanwhile clearly established on the EU level. Even more specifically, if by contrast certain criteria (such as a particularly liberal assessment of small ornamental elements in light of the generally limited room for creative freedom in the area of designs<sup>44</sup>) seem dysfunctional to reach the Court's meta-objectives for sound reasons, such criteria might be proposed to the Court in reference questions as impermissible additional sufficient criteria in order to have them effectively squashed on the European level. If courts in Member States with a generally 'active' copyright jurisdiction took these more strategic procedural issues of the reference procedure into due account, it might be possible to pragmatically steer the process of specification in the EU's multi-level judicial case law system and thus, bit by bit, develop and 'Europeanise' the specifics of a balanced and flexible functionality doctrine in copyright law.

In principle, therefore, it seems that the Court's case law is indeed better than its reputation in that it meanwhile allows for reasonable specification by the Member States' courts. Paradoxically, the remaining imperfections which in consequence must not be harmful to the quality of substantive copyright law, but which arguably prevent even more effective harmonisation, seem to be due to the Court's very intent to establish such effective harmonisation (albeit in part only on a comparatively general conceptual level). For our topic, this prompts the question as to which specification criteria can be developed which are consistently in line with the rather general basic structural elements of the autonomous, unitary notion of work in EU copyright law and the underlying more general guiding meta-principles hitherto established by the Court.

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43. Using the language of CJEU, *Brompton*, *supra* note 6, para. 37.

44. Section 3.3 *infra*.

### **3. FUNCTIONAL ELEMENTS IN COPYRIGHT LAW – DIFFERENT PROPOSALS AND A ‘PRAGMATIC’ APPROACH**

#### **3.1 A Horizontal Functionality Doctrine within IP?**

Suthersanen and Mimler have recently suggested that the CJEU has developed a horizontal ‘autonomous functionality doctrine within IP’, comparing trade mark, design and copyright law.<sup>45</sup> According to this comparison, the underlying central macro-rationale of Article 8(1) Design Regulation (Article 7(1) Design Directive), Article 7(1) Trade Mark Regulation (Article 4(1) Trade Mark Directive) and the case law on functionality in copyright law is to ‘ensure that protection does not unduly restrict market freedom and competition’.<sup>46</sup> I have a lot of sympathy for this thesis as it would allow making the rationale behind the exclusion of certain subject matter in certain markets more transparent. Take TV program listings, for example. A lot of personal experience and perhaps even personal taste or intuition might go into the programming of a TV station in order to optimise audience flow. However, such subject matter would be excluded from copyright protection in most Member States<sup>47</sup> and arguably now in EU law as being purely ‘functional’ and based on skill, judgment and labour. The underpinning rationale undoubtedly is to ensure freedom of competition and prevent leveraging with regard to certain aftermarkets (i.e. the markets for TV program information).<sup>48</sup> Another similar example is the *Football Dataco* case, where denying copyright protection for collections of football fixtures effectively prevented the English Football League from monopolising markets for betting services. Finally, in *Brompton* the Court expressly recognised and generalised<sup>49</sup> the objective to prevent the ‘monopolis[ation] of ideas, to the detriment, in particular, of technical progress

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45. Referring to the most recent judgments in trade mark (CJEU, *Lego Juris*) and design law (CJEU, *DOCERAM*, at para. 17 et seq., effectively discarding the *multiplicité des formes* test as an exclusive test for functionality in design law in favour of a more flexible approach, assessing the motivation for the design element in question taking into account all relevant circumstances of the case; this leads to a certain convergence with the functionality test in trade mark law, while maintaining a slightly stricter interpretation of functionality in design law insofar as design elements are only excluded from protection, if, as a result of the overall analysis of the circumstances of the case, they were *solely* dictated by the technical function) to support their thesis, cf. Suthersanen and Mimler, *supra* note 12, at 567.

46. Suthersanen and Mimler, *supra* note 12, at 567.

47. The famous exception of course was the case behind CJEU, 6 April 1995, joined cases C-241/91 P and C242/91 P, ECLI:EU:C:1995:98, *Magill*, which promptly led to a foreclosure of a downstream market and consequently to a compulsory licence under competition law.

48. In favour of a transparent treatment of these market related factors in copyright law, Matthias Leistner, ‘Der urheberrechtliche Schutz der Sendefolge – ein Plädoyer für methodische Ehrlichkeit’, in Willi Erdmann (eds.), *Festschrift für Michael Loschelder zum 65. Geburtstag* (Schmidt, Cologne, 2010), 189. Cf. also on the ongoing monopolisation attempts and remaining problems in this field P. Bernt Hugenholtz, ‘Het einde van het omroepbladenmonopolie nadert nog steeds (maar doet er weinig meer toe)’, in *25 jaar Mediaforum, een blik vooruit via de achteruitkijkspiegel* (2013), at p. 40 et seq.

49. Beyond the specific area of computer programs, cf. *supra* note 13.

and industrial development'. Quite rightly, as for product shapes, *Suthersanen* and *Mimler* have pointed out that the impact of protecting functional elements consequently should depend on an overall analysis of all circumstances of the case *including market related factors* with regard to the products or services in question.<sup>50</sup>

Nonetheless, there are also problems with this approach in copyright law.<sup>51</sup> First, the argument – for now – is limited to functionality in relation to shapes (in following the respective express provisions in trade mark and design law).<sup>52</sup> However, in copyright law, the problem of dealing with technical or functional elements is of a more general nature, as the abovementioned examples and cases, such as *Funke Medien*,<sup>53</sup> show.

Secondly, the development of general principles in this area, which apply horizontally in trade mark, design and copyright law, comes at a price. Namely, the common principles thus developed are of a very general nature – attempts at specifying them along the lines of *Lego Juris* and *DOCERAM*, such as the arguments of Advocate General Sánchez-Bordona in *Brompton*,<sup>54</sup> have only partly been successful with the Court.<sup>55</sup> In particular, and thirdly, with regard to the most intriguing and ambitious element of *Suthersanen* and *Mimler*'s approach, i.e. the focus on ensuring free competition and the consequent functional, market perception oriented analysis along the lines of *DOCERAM*, it seems that the Court in *Brompton* has made clear that while acknowledging the fundamental principle, it will not entirely play along concerning the operational 'details'. After all, the Court held that originality has to be assessed taking 'into account ... all the relevant aspects of the ... case, as they existed when [the] ... subject matter was designed, *irrespective of the factors external to and subsequent to the creation of the product*'.<sup>56</sup>

The reason behind this has been elucidated by Annette Kur. While design law (and trade mark law) are generally more focused on relations in the market, namely the relationship between the protected subject matter and the potential customer and consumer side of the market, the main accent in copyright law has traditionally been on the relationship between author and work.<sup>57</sup> The result of this is obvious. In design law (and also in trade mark law), *Suthersanen* and *Mimler*'s approach works and is consistent with the specific context concerning the general principles as well as the application details. In copyright, by contrast, their proposed general principle and meta-objective of preserving freedom of com-

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50. *Suthersanen* and *Mimler*, *supra* note 12, at 576 et seq.

51. *Fhima*, *supra* note 1, at 766 et seq.

52. Cf. for trade mark law also *Senftleben*, *supra* note 14, at 220 et seq., arguing that the focus on aesthetic functionality only is not sufficient for the necessary contextual delineation of trade mark law either.

53. CJEU, *Funke Medien*, *supra* note 11, para. 24: uses the term 'technical function' in the context of the function of military status reports to deliver certain information.

54. AG Sánchez-Bordona, *supra* note 24, at para. 81 et seq.

55. On the differentiations *Derclaye*, *supra* note 1.

56. CJEU, *Brompton*, *supra* note 6, para. 37. Emphasis by the author.

57. Kur, *supra* note 1, at 294 et seq.

petition reflects only a part of the underlying objectives for limiting protection. Hence, in copyright further reasons for differentiation add to the equation. As a consequence, the criteria for protection in copyright law still rather focus on the relationship of the author to the work, i.e. the analysis of the kind of creativity which must be involved to trigger copyright protection.<sup>58</sup>

Accordingly, the originality test in copyright law therefore encompasses more than mere orientation towards safeguarding workable competition, which however of course should be a central element feeding into the analysis. In addition, the copyright condition of protection is also about the specific kind of creativity which warrants the extraordinary long protection period and the additional grant of moral rights. Under this perspective, Suthersanen and Mimler's research is useful for furthering the important discussion on common principles of limitations in IP law,<sup>59</sup> but it is not exhaustive concerning the treatment of functional elements in copyright law.

### 3.2 Acceptance of Broad Overlap and Synchronisation of Legal Regimes

Another approach with particular importance for the overlap of copyright and design protection shall be discussed here. After *Cofemel*, Annette Kur has proposed to accept that *unité de l'art* is here to stay in EU copyright and design law, arguing that a need to horizontalise certain limitations and exceptions has derived from this case.<sup>60</sup> At the outset, Kur accepts that the Court's language in *Cofemel* still allows national *courts* to keep strict standards for functional elements in copyright law by simply adapting to the CJEU's language regime.<sup>61</sup> At the same time, she observes that in jurisdictions where unitary general copyright standards apply to works of applied art, there has often been a tendency towards near '*cumul total*'. Consequently, Kur suggests aligning the boundaries in copyright law and design law in order to decrease frictions resulting from that impending near total overlap *de lege ferenda*.<sup>62</sup>

Of course, this would mainly concern the term of protection, where a sector-specific reduction for works of applied art in copyright law would indeed be possible under international law but would require a change of mandatory European law which does not seem politically likely in the near future. More promising are Kur's considerations concerning possible alignment in the area of limitations and exceptions to protection. I would agree that at least common principles for limitations and exceptions should be developed. Methodologically, the first step to further structure such common limitations and exceptions would then have to be the decision whether they relate intrinsically to the IP-protected subject matter or whether they follow from certain market-specific external

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58. As for *Brompton*, see similarly Fhima, *supra* note 1.

59. Matthias Leistner, 'Towards an Access Paradigm in Innovation Law?', *GRUR Int.* (2021).

60. Kur, *supra* note 1, at 291.

61. Kur, *supra* note 1, at 297 quoting Leistner, *supra* note 1, at 1119.

62. Kur, *supra* note 1, at 297 et seq.

factors, in particular concerning market structure and market behaviour. This would allow a *prima facie* decision as to whether they should be foreseen in legislation concerning the respective different IP rights (possibly with some adaptations specific to the subject matter concerned) or whether they should be regulated in sector-specific instruments external to IP law (and contextually closer to the objectives of competition and unfair competition law).<sup>63</sup> Again, this methodological challenge is of a general nature beyond the issue of applied art in copyright law.

For the sake of this paper, suffice it to say that Kur's approach merits considerable attention and follow-up research. However, it can obviously only mitigate but not entirely eliminate possible frictions between copyright and design law in a situation of *cumul total* and in addition, politically, the implementation of Kur's proposals does not seem likely in the near future. Thus, the central challenge, how to nationally implement and specify the application of the Court's conceptual structure and general standards for the treatment of functional elements in copyright law, and in particular how to concretely reach the objective of significantly *reducing* the area of copyright/design overlap, remains unchanged by Kur's justified call for further synchronisation in the area of limitations and exceptions.

### **3.3 A Pragmatic, Purposive Approach: Strict Requirements for Functional Elements in Copyright Law**

Despite the CJEU not giving further guidance, it seems possible to reasonably specify certain criteria for the treatment of functional elements in EU copyright law in cases with sufficient room for creative freedom. Ultimately, the problem comes down to the question of which kind of communicative creativity copyright shall specifically protect.

In that regard, it seems that the Court seeks to exclude from copyright law functional elements which, while not being strictly required, are still overly characterised by technical, practical or any other predominantly extrinsic considerations and which are thus based on personal decisions, predominantly guided by external functions. This is not about *Spielraum* but about the kind of communicative creative process which results in an original work for the purposes of copyright law. In order to give just another football example, no serious football fan would be able to follow the Court's reasoning in the *Premier League* case, if the Court had *really* meant that the rules of the game did not leave room for

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63. See generally Leistner, *supra* note 59. Concerning the copyright/designs overlap the issue of spare parts of complex component products is an example in point for the contextual intricacies behind such decisions: given the political development, meanwhile it would seem sensible to attempt to introduce a parallel exception for spare parts in both copyright law and design law (cf. Kur, *supra* note 1, at 299); with regard to the potential of market failure addressed by and the objectives behind such clauses, it seems that horizontal external regulation in the realm of competition law, which would then apply to *all* IP rights alike, might even be the theoretically more fitting solution (cf. also Suthersanen and Mimler, *supra* note 12, at 568).

the players to express their personality in a creative way.<sup>64</sup> Anyone who doubts this claim, might want to have a look for example at this compilation of the '10 most creative [sic!] penalties in football history'.<sup>65</sup> Nonetheless, it was correct that the Court in principle excluded football games from copyright protection. However, this was not because there is *no room for creative freedom in football matches*, but because there is 'no room for creative freedom for the purposes of copyright'.<sup>66</sup> It is not the rules of the game that are decisive for the exclusion, it is the extrinsic *function*, the main *motivation* to win the game, which generally excludes the creative intuition of football players from the realm of copyright protection. Incidentally, if in a concrete case the element of personal creativity were so significant in comparison to the 'mundane' objective to win the game and the resulting expression were of sufficient individual complexity (which seems conceivable for certain 'tricks' or complex choreographed goal celebration gestures mainly aimed at coining a personal badge of identity for video games or social networks) copyright law might admittedly even come into play.

So – what are the specific communicative purposes of EU copyright law and what follows from them for a reasonable 'functional elements test' in copyright? According to AG Szpunar's recent attempt to express this in his Opinion in *Cofemel*, copyright is about the protection of works as such, which shall leave freedom for 'dialogue, inspiration and reformulation'.<sup>67</sup> Thus a human expression which is literary, scientific or artistic and contains a personal communicative (discursive) element in the widest sense beyond its mere functional purpose has to be inherent to any element which shall be protected by copyright law. From this it follows, first, that *the more an element of a subject matter seems guided by functions external to the pure expression of the personality of the author* (technical, other functional or even market oriented), the less it will *prima facie* merit copyright protection.

Secondly, in sectors *where such functional considerations are typically present or concretely evident, strict standards have to be applied in copyright law*.<sup>68</sup> For the copyright/design overlap this means that the comparatively smaller remaining freedom for creative expression, which remains in the sector of product design due to functional constraints, must not lead to an argument in copyright law that, consequently, respectively small, ornamental design elements within an overall essentially technically oriented design would have to suffice for copyright protection. In design law, because of its different, more market process oriented objective, such small elements or – generally – small differences compared to the existing domain of available designs, can suffice

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64. See also the contribution by Lionel Bently in this volume.

65. See <https://www.youtube.com/watch?v=ID-Ni0RrWcw>.

66. CJEU, *FAPL*, *supra* note 9, para. 98.

67. AG Maciej Szpunar, Opinion of 2 May 2019, *Cofemel*, para. 55.

68. Estelle Dercly and Marco Ricolfi, 'Opinion of the European Copyright Society in relation to the pending reference before the CJEU in *Brompton Bicycle v. Chedech/Get2Get*, C-833/18', SSRN (2019), para. 17: 'special degree of caution'; skeptical Kur, *supra* note 1, at 294; Fhima, *supra* note 1, at 764.

for protection. In copyright law, the opposite should apply,<sup>69</sup> thus at the same time fulfilling the Court's requirement that the overlap should be restricted to a limited number of 'certain cases'.<sup>70</sup>

Thirdly, the closer a subject matter comes to the existent corpus of forms or other expressions in a certain sector, the less likely it seems that it was based on predominantly personal, creative decisions instead of extrinsic orientation on the functional needs of that sector. To make this operational, a significant difference compared to the prototypical and known forms and combinations of forms in the relevant sector should at least be required for designs and product shapes. At first sight, it might seem that the refusal of the criterion of an 'aesthetically significant visual effect' in *Cofemel* excludes the application of this criterion in national law. However, a closer look at the Court's language reveals that the Court only excluded the criterion insofar as it relates to subjective conceptions of beauty.<sup>71</sup> Also, it seems that the Court only wanted to exclude a significant aesthetic effect as a sufficient condition of copyright protection; at the same time, reference to a significant aesthetic effect as a merely indicative (and perhaps even a necessary, but non-conclusive) factor in assessing the condition of a creative activity, reflecting the freedom of choice and personality of its author, seems to remain permissible when national courts apply this condition to the facts of a case before them.<sup>72</sup> Thus, the requirement of a significant difference, compared to the prototypical and known forms and combinations of forms in the relevant sector, as an assessment criterion to determine minimum personal creativity is arguably compliant with the judgment and in line with the Court's general objective to reduce the area of overlap.

Raising the threshold for copyright protection in mixed cases, where functional considerations are substantially present regarding certain elements, also does not undermine the unitary and equal character of the originality criterion for different kinds of works. On the contrary, this necessary differentiation merely treats different cases differently on the facts, where the normative framework of originality in the sense of a personal, creative choice requires it.<sup>73</sup> Thus, the framework proposed here merely takes into account that in sectors where no copyright-external considerations seem conceivable or likely, the condition of

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69. Kur, *supra* note 1, 295 (with reference to Leistner, *supra* note 1, at 1119), speaks of a *reverse design approach*. Cf. also CJEU, *Dataco*, *supra* note 4, para. 38 et seq. The case is instructive in this context because it concerns free and creative choices in the sector of database structures (selection or arrangement). Even in *this* sector, for which technical constraints and practical skills are *typical*, and thus the remaining room for free creative decisions will typically be limited, the Court strictly required personal creative choices, consequently excluding the labour and skill of the author.

70. AG Sánchez-Bordona, *supra* note 24, at para. 74 et seq. (with reference to CJEU, *Lego Juris*): one or more minor arbitrary elements in the appearance of a product should not suffice, if the essential characteristics are dictated by the technical solution; only a major non-functional, imaginative element which plays an important role in the shape could suffice.

71. CJEU, *Cofemel*, *supra* note 5, para. 53.

72. CJEU, *Cofemel*, *supra* note 5, paras. 54 and 55: 'does not, in itself, make it possible'.

73. Derclaye and Ricolfi, *supra* note 68, at para. 15 et seq.; skeptical Kur, *supra* note 1, at 294.

originality can in fact be easier to prove than in cases where such considerations seem inevitable or at least likely. Actually, from a more fundamental perspective this also makes sense with regard to the economic objectives behind EU copyright law compared to the industrial property rights.<sup>74</sup> The closer a market relevant product is oriented along the necessities and expectations according to current market standards, the easier it is to recoup the necessary investments in the short term based on (registered and published) industrial property protection or even just the actual head-start in the market, bolstered by unregistered design protection and flexible unfair competition law protection against certain qualified acts of slavish imitation.<sup>75</sup> However, the more distant and 'revolutionary' an envisaged creative development is compared to the existent corpus and market expectations, the more it might be a presumable initial misfit with the immediate aesthetic expectations of the addressed public. Hence, such revolutionary creations, which seem particularly worthy of being incentivised in the interest of a multifaceted cultural landscape, will not always be immediately successful. Thus, engagement in such highly personal, intrinsically free endeavours might, as a general tendency, be more dependent on the hope of long-tail exploitation and consequently need (longer) copyright protection in order to be properly incentivised.

#### **4. THE RELATIONSHIP TO SCOPE – THE NEED FOR A EUROPEAN DOCTRINE OF ADAPTATION AND TRANSFORMATIVE USE**

Finally, in order to ensure necessary freedom for other creators to develop alternative creative subject matter, the scope of protection in infringement cases plays a crucial role (in particular in the case of copyright protection for designs).<sup>76</sup> On the European level, the main problem in that regard is that there is little case law on adaptations or transformative use, and the status of these use forms under the InfoSoc Directive is not yet entirely clear.<sup>77</sup> For transformative uses, in light of *Painer* it seems reasonably safe to say, however, that the CJEU subsumes them under Article 2 InfoSoc Directive as a reproduction in part when protected subject matter is used in such contexts. However, in *Painer*, the Court answered the question on the subsistence of copyright protection as such with regard to

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74. E.g. Recital 10 InfoSoc-Directive: *appropriate reward*, i.e. the opportunity for 'satisfactory returns on this investment'. An 'appropriate reward' in that sense is not a maximum reward, cf. e.g. CJEU, 3 July 2012, case C-128/11, ECLI:EU:C:2012:407, *UsedSoft*, para. 62 et seq.; *FAPL*, *supra* note 9, para. 108.

75. On the different objectives and market conditions AG Sánchez-Bordona, *supra* note 24, at para. 38 et seq.; cf. on the general principles also CJEU, *Cofemel*, *supra* note 5, para. 50; AG Szpunar, *supra* note 67, at para. 55.

76. BGH, 13 November 2013, case I ZR 143/12, *Geburtstagszug*, para. 41; Derclaye and Ricolfi, *supra* note 68, at para. 20 et seq.

77. Eleonora Rosati, 'Copyright in the EU: in search of (in)flexibilities', *GRUR Int.* (2014), 419 (427 et seq); cf. also (but before the harmonisation of the concept of work in Infopaq) Mireille van Eechoud, P. Bernt Hugenholtz, Stef van Gompel, Lucie Guibault and Natali Helberger, 'Harmonizing European Copyright Law', (2009), 83 et seq.

certain work categories without establishing further useful guideposts with regard to the scope of protection in such cases. In *Pelham*, the Court has now drawn a *de minimis* line. If the reproduced part of the protected subject matter is not even recognisable, there will be no reproduction in part. Besides this *de minimis* rule, the independent German doctrine of free use was contextually regarded as an exception to copyright law and consequently dismissed as impermissible under Article 5 InfoSoc Directive.

In the long term it has to be hoped that the Court develops a more balanced approach to the scope of the reproduction right in cases of transformative reproduction of copyright protected subject matter.<sup>78</sup> Methodologically, this could be loosely modelled along the lines of the flexible normative multi-factor framework established to assess acts of communication to the public. Such an approach should proportionately balance the respective (fundamental) rights of both the original author and the creative user on the level of the economic rights. This could be achieved by flexibly considering the degree of creativity of the elements used from the original work on the one side, compared to the degree and creativity of the new contributions and transformative processing on the other. Accordingly, the scope of protection would be limited in cases where the follow-up creation is predominantly characterised by its new or transformative elements which thus effectively supersede the remaining protectable elements of the original work if these latter are of limited originality because of functional influences behind them.

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78. Derclaye and Ricolfi, *supra* note 68, at para. 21 et seq.

# Creative Games

*Pamela Samuelson*

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## 1. INTRODUCTION

Games are ubiquitous features in virtually all cultures.<sup>1</sup> Some games are primarily valued as entertainments, some for skill-building, and many for the learning they promote. Games can be enjoyed without regard to whether one is a spectator or a participant (amateur or professional) or whether one is solitary or in a group. Creativity is manifest in many aspects of games and gaming: in the initial design of the games, the articulation of game rules, decisions about how much freedom

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1. The complexities of the concept of 'games' is evidenced by the difficulty in properly defining the term. See Bruce E. Boyden, 'Games and Other Uncopyrightable Systems', 18 *George Mason Law Review* (2011), 439 (449). This complexity has attracted philosophical inquiry: Ludwig Wittgenstein, for example, famously used games as an example of a concept that is understood not by precise definition but as a network of overlapping similarities (or 'family resemblances'). Philosopher Bernard Suits offered this high-level definition: 'to play a game is to engage in activity directed toward bringing about a specific state of affairs, using only means permitted by specific rules, where the means permitted by the rules are more limited in scope than they would be in the absence of the rules, and where the sole reason for accepting such limitation is to make possible such activity'. Many thanks to Robert J. Glushko for this insight. See Robert J. Glushko (ed.), *The Discipline of Organizing* 4th ed., Beijing/Cambridge/Farnham/Köln/Sebastopol/Tokyo: O'Reilly Media 2016, 374–376 (discussing Ludwig Wittgenstein, *Philosophical Investigations* sections 65–78 (1953) & quoting Bernard Suits, 'What Is a Game?' (1967)). A dictionary definition for 'game' as a noun is 'a physical or mental competition conducted according to rules with the participants in direct opposition to each other' followed by seven additional definitions utilising the terms 'contest', 'sport', and 'athletics'. <https://www.merriam-webster.com/dictionary/game> (2021). Professor Boyden conceptualises games as having four main components: 1) a set of rules that define what is and is not acceptable within the boundaries of the game; 2) a space within which the game is played and in which the rules of the game are to be respected; 3) one or more players to participate in it; and 4) goals to be achieved by the player(s). Boyden, *supra*, at 449–455.

of choice players will have as they play, myriad ways that games can be played, strategies for achieving success, selections and arrangements of information about games and their players, and sequences of events as games are played.<sup>2</sup> At least in the US, none of these is likely to attract copyright protection. The only elements of games likely to be eligible for copyright are those that evince sufficient originality in textual or pictorial expression. While broadcasts of sporting events are copyrightable,<sup>3</sup> those copyrights extend only to the selection and arrangement of video cuts of play on the field and sports announcers' commentary.

## 2. COPYRIGHT IN GAMES AND CONTESTS

A rather large number of US court rulings over the past century have addressed claims of copyright in creative games, game rules, game strategy, and game play. Most often courts have rejected such claims relying on the US Supreme Court's seminal 1879 *Baker v. Selden* decision.

One early such case was *Affiliated Enterprises, Inc. v. Gantz*.<sup>4</sup> Affiliated developed a detailed plan or system for a lottery-type contest that involved offering members of the public at a theatre or similar locale an opportunity to win cash prizes. Affiliated described the system in a pamphlet setting forth instructions for carrying out the contest. Affiliated had licensed many entities to host such contests and made handsome profits from the licences. When Gantz organised a contest of this sort without taking a licence, Affiliated sued him for copyright infringement. The US Court of Appeals for the Tenth Circuit decided that Gantz had not infringed because the contest was an unprotectable system within the holding of *Baker v. Selden*.<sup>5</sup>

In *Baker*, the US Supreme Court held that the copyright in a book about a bookkeeping system protected the author's explanation of that system, but not the system as such, regardless of how novel it might be.<sup>6</sup> The Court in *Baker* conceptualised creative advances in the useful arts, such as bookkeeping, to be patent, not copyright, subject matter.<sup>7</sup> To get exclusive rights in a useful art,

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2. Due to length considerations, the focus of this paper is on non-digital games and sporting events, even though I recognise that additional copyright issues arise in respect of video games, e-sports, and the like.
3. See 17 U.S.C. § 101 (definition of 'fixed' includes '[a] work consisting of sounds, images, or both, that are being transmitted' so long as a fixation of the work (such as by recording) is made simultaneously with the transmission); H.R. Rep. No. 94-1476, at 52 (1976) ('Thus, assuming it is copyrightable ... the content of a live transmission [such as sports, news coverage, and live performances of music] should be accorded statutory protection if it is being recorded simultaneously with its transmission.').
4. 86 F.2d 597 (10th Cir. 1936). The earliest US game case was *Whist Club v. Foster*, 42 F.2d 782 (S.D.N.Y. 1929), in which the court opined that '[i]n the conventional laws or rules of a game, as distinguished from the forms or modes of expression in which they may be stated, there can be no literary property susceptible of copyright.' *Ibid.*, at 782. Because Foster had set forth the same rules in his own words, he had not infringed. *Ibid.*
5. *Affiliated*, 86 F.2d at 598 (quoting *Baker v. Selden*, 101 U.S. 99, 104 (1879)).
6. *Baker*, 101 U.S. at 99–100, 102 (1879).
7. *Ibid.*, at 105.

creators must apply for a patent and satisfy patent standards, for it would be ‘a surprise and a fraud upon the public’ to extend copyright protection to useful arts depicted in copyrighted works.<sup>8</sup>

A similar case to *Affiliated v. Gantz* was *Seltzer v. Sunbrock*.<sup>9</sup> Seltzer had written two pamphlets about a multi-day roller derby race and had granted an exclusive licence to organise such events to an Indiana company. His pamphlets were sold as programs at the events. Sunbrock organised a roller derby that was substantially similar to Seltzer’s and distributed printed programs explaining the roller derby’s rules. Seltzer claimed that Sunbrock had infringed copyrights in his pamphlets, which Seltzer characterised both as books and as dramatic works. With a tip of the hat to *Baker v. Selden*, the District Court decided that ‘[w]hat Seltzer really composed was a description of a system for conducting races on roller skates. A system, as such, can never be copyrighted. If it finds any protection, it must come from the patent laws.’<sup>10</sup> Nor were the rules of the derby games protectable by copyright law, nor was ‘the system of staging a game or spectacle covered’, with a citation to *Affiliated v. Gantz*.<sup>11</sup> Lack of creativity has not been the basis for rejecting such claims.

Patents have, in fact, been issued for many games.<sup>12</sup> The famous *Monopoly* board game, for instance, was subject of a utility patent issued in 1935.<sup>13</sup> In a decision rejecting General Mills’ claim that the *Anti-Monopoly* game had infringed General Mills’ trademark in the game’s name,<sup>14</sup> the US Court of Appeals for the Ninth Circuit took into account that a patent on the *Monopoly* game had expired, a factor that tipped against General Mills’ trademark claims.<sup>15</sup> The court noted that ‘when a patent expires, the idea, system, or product passes into the public domain and may be freely copied, so long as the copyist uses reasonable care to prevent the public from misidentifying his product as that of the original producer’.<sup>16</sup> Trademarks are ‘not properly used as patent substitutes to further or perpetuate product monopolies’.<sup>17</sup> Although there was no copyright claim in the case, the court went on to say that ‘business ideas, such as a game concept, cannot be copyrighted’, with a citation to *Baker v. Selden*.<sup>18</sup> Copyright excludes games from its protection ‘to prevent extension of product monopolization beyond the 17 years protected by a patent’.<sup>19</sup>

8. *Ibid.*, at 102.

9. 22 F. Supp. 621 (S.D. Cal. 1938).

10. *Ibid.*, at 630 (citing *Baker*).

11. *Ibid.*

12. See, e.g., Shubha Ghosh, ‘Patenting Games: *Baker v. Selden* Revisited’, 11 *Vanderbilt Journal of Entertainment & Technology Law* (2009), 871.

13. See ‘Board Game Apparatus’, US Patent No. 2,026,082 (filed Aug. 31, 1935), which covered the board, dice, tokens, other items that facilitate play, and the game’s rules.

14. *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296 (9th Cir. 1979).

15. *Ibid.*, at 299–300.

16. *Ibid.*, at 300.

17. *Ibid.*

18. *Ibid.*, n. 1.

19. *Ibid.* (citing *Baker*, 101 U.S. at 102–103).

Despite the clarity of these and similar rulings,<sup>20</sup> game developers in the US have not given up on asserting copyright protection for creative games, rules, and game play.<sup>21</sup> A recent example is *DaVinci Editrice S.R.L. v. ZiKo Games, LLC*.<sup>22</sup> DaVinci developed a very popular card game called *Bang!* based loosely on familiar Wild West characters. The game commences when its players draw cards that assign them to one of four roles – Sheriff, Deputy, Outlaw, or Renegade – as well as to a particular character such as ‘Calamity Janet’ with a distinct set of abilities and a specific weapon. *Bang!* features various action cards, which are utilised in accordance with the rules of the game. Players take turns drawing and playing cards, and the game ends when either the Renegade and the Outlaws win, or the Sheriff and Deputies win by ‘killing’ their opponents.<sup>23</sup>

Yoka is a China-based manufacturer of a card game called *Legends of the Three Kingdoms* set in ancient China. ZiKo distributes this game in the US. The game’s characters consist of a Monarch, a Minister, the Rebels, and the Turncoat. These characters have the same functions and goals as the Sheriff, Deputies, Outlaws, and Renegade in *Bang!*. Moreover, the rules of the *Legends* game and methods by which the game is played are virtually identical to those in *Bang!*.

DaVinci sued Yoka and ZiKo for copyright infringement because of the considerable similarities between the two games. The District Court held that neither the game play nor the game rules was protectable by copyright law under the Supreme Court’s *Baker v. Selden* decision.<sup>24</sup> The court quoted at length from a Copyright Office policy statement in support of its ruling against DaVinci’s claim:

Copyright does not protect the idea for a game, its name or title, or the method or methods for playing it. Nor does copyright protect any idea, system, method, device, or trademark material involved in developing, merchandising, or playing a game. Once a game has been made public, nothing in the copyright law prevents others from developing another game based on similar principles. Copyright protects only the particular manner of an author’s expression in literary, artistic, or musical form.<sup>25</sup>

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20. See, e.g., *Allen v. Acad. Games League of Am., Inc.*, 89 F.3d 614 (9th Cir. 1996) (playing game not a ‘performance’; expression in tournament game manuals merged with idea); *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183 (2d Cir. 1975) (narrow protection for rulebook of simple Caroms game); *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678–679 (1st Cir. 1967) (rules of sweepstakes contest not protectable by copyright law); *Chamberlain v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945) (no infringement in similarly expressed backgammon rules ‘necessarily drawn from the same source’); *Lewis v. Kroger Co.*, 109 F. Supp. 484, 487 (S.D. W.Va. 1952) (contest not copyrightable). See also *Landsberg v. Scrabble Crossword Games Players, Inc.*, 735 F.2d 485 (9th Cir. 1984) (Scrabble game strategies are unprotectable ideas).
21. See, e.g., *Hoopla Sports & Entm’t, Inc. v. Nike, Inc.*, 947 F. Supp. 347 (N.D. Ill. 1996) (rejecting sports organiser’s claim of copyright in its design for a tournament sporting event).
22. 183 F. Supp. 3d 820 (S.D. Tex. 2016).
23. The court discussed the games at length. *Ibid.*, at 823–826.
24. *Ibid.*, at 830.
25. *Ibid.*, at 830, quoting US Copyright Office, ‘Copyright Registration of Games’ (FL-108) (2011). Nearly identical language appears in the US Copyright Office, *Compendium of U.S. Copyright Office Practices* 3d Ed. 2021, § 714.

Copyright protection is available to pictorial and textual expressions of game boards or playing cards, but not to other game features.

Unlike a book or movie plot, the rules and procedures, including the winning conditions, that make up a card-game system of play do not themselves produce the artistic or literary content that is the hallmark of protectable expression. Instead, the game rules, procedures, and winning conditions create the environment for expression.<sup>26</sup>

Because the pictorial and textual elements of *Bang!* and *Legends* are quite different, the court concluded there was no copyright infringement.<sup>27</sup>

Along similar lines, US courts have rejected claims of copyright in an original sequence of physical motions designed to be performed in exactly the same sequence over and over, as in *Bikram's Yoga College of India, L.P. v. Evolution Yoga, LLC*.<sup>28</sup> Bikram Choudhury claimed copyright in a sequence of twenty-six yoga poses and two breathing exercises.<sup>29</sup> After one of his former students started a competing yoga studio that practised the same sequence, Choudhury's studio sued it for infringing its copyrights.<sup>30</sup> Evolution, the defendant, claimed that the sequence was not protectable by copyright law as a method or system excluded from copyright protection under *Baker* and 17 U.S.C. § 102(b), which codified *Baker*'s holding that methods and systems are ineligible for copyright protection.<sup>31</sup>

Choudhury asserted that his selection and arrangement of the poses was creative and pointed out that there were many other ways that he or others could have organised yoga pose sequences.<sup>32</sup> Because the sequence had numerous discrete elements, it was not an abstract idea that § 102(b) excludes from copyright protection. Choudhury also pointed out the beauty and gracefulness of the sequence.<sup>33</sup>

The Ninth Circuit Court of Appeals did not question the originality of Choudhury's sequence. However, it observed that Choudhury himself had characterised his sequence as 'a "system" or a "method" designed to "systematically work every part of the body, to give all internal organs, all the veins, all the ligaments, and all the muscles everything they need to maintain optimum health and maximum function"'.<sup>34</sup> Choudhury had also directed his students to perform the poses in

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26. *DaVinci*, 183 F. Supp. 3d at 830 (citing Boyden, *supra* note 1, at 466).

27. *Ibid.*, at 831.

28. 803 F.3d 1032 (9th Cir. 2015).

29. Choudhury asserted copyright protection of his sequence under choreography and compilation theories, both of which the court rejected. *Ibid.*, at 1041–1044.

30. *Ibid.*, at 1036.

31. The court discussed Evolution's § 102(b) defence, *ibid.*, at 1036–1041. Section 102(b) provides that '[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.' 17 U.S.C. § 102(b).

32. *Ibid.*, at 1041–1042.

33. *Ibid.*, at 1036, 1040.

34. *Ibid.*, at 1038.

exactly the same order to achieve optimal health benefits.<sup>35</sup> In part because of these statements, the court found Evolation's § 102(b) defense persuasive.<sup>36</sup>

In keeping with *Baker* and its progeny, the Ninth Circuit thought it evident that the copyrights in Choudhury's books and videos about the sequence protected his explanation and pictorial depiction of the sequence, but not the sequence which, like the forms in the *Baker* case, was an embodiment of an unprotectable method or system.<sup>37</sup> Channelling *Baker*, the court opined that exclusive rights in useful systems could be had only from the patent system.<sup>38</sup>

The court also noted that Choudhury's books and videos 'invite[] readers to practice the method it describes'.<sup>39</sup> Further channelling *Baker*, the court noted that 'this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book'.<sup>40</sup> Indeed, '[c]onsumers would have little reason to buy Choudhury's book if Choudhury held a monopoly on the practice of the very activity he sought to popularise. Rather than "stimulat[ing] artistic creativity for the general public good", copyright protection for the Sequence would prevent the public from engaging with Choudhury's idea and building upon it'.<sup>41</sup> This consideration too supported Evolation's defence.

Although the *Bikram's Yoga* case did not involve a game in the usual sense of the term, Choudhury's sequence has elements in common with games.<sup>42</sup>

### 3. COPYRIGHT IN SPORTING EVENTS

Sports organisers in the EU, as well as in the US, have sometimes asserted that they have copyright interests in the athletic events that they sponsor,<sup>43</sup> even

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35. *Ibid.*, at 1039.

36. *Ibid.*, at 1044. See also *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir. 1975) (copyright in pictorial representations of weight-training exercises did not extend to the exercise sequences).

37. *Bikram's Yoga*, 803 F.3d at 1038.

38. *Ibid.*, at 1039-1040.

39. *Ibid.*, at 1041.

40. *Ibid.* (quoting *Baker*, 101 U.S. at 103).

41. *Ibid.*, at 1041 (quoting *Mattel, Inc. v. MGA Entm't, Inc.*, 705 F.3d 1108, 1111 (9th Cir. 2013)).

42. Under Bruce Boyden's broad conception of games, see *supra* note 1, *Bikram's yoga sequence* arguably could be considered a game. See also *US Copyright Office Compendium*, *supra* note 25, § 806.5(B)(3) (discussing *Bikram's Yoga* as well as yoga poses generally along with athletic activities and competitive manoeuvres as examples of bodily movements that do not qualify as choreographic works).

43. See, e.g., Mark Lichtenhein, 'Intellectual Property Rights: Driving Global Sports', *WIPO Magazine*, April 2019, [https://www.wipo.int/wipo\\_magazine/en/2019/02/article\\_0001.html](https://www.wipo.int/wipo_magazine/en/2019/02/article_0001.html). The property right that most clearly undergirds the authority of sports organisers to commercialise athletic events is the 'house right' that empowers them to sell tickets to people who want to attend the games and to negotiate with broadcasters for significant compensation for allowing the latter to broadcast games to the public. See *Asser Institute & Institute for Information Law, Study on Sports Organisers' Rights in the European Union: Final Report* (2014), 25-29 (hereinafter Sports Study). This study was undertaken at the behest of the European Commission under the leadership of Bernt Hugenholtz, University of Amsterdam Institute for Information Law; the study's primary authors are Ben Van

though European groups must know that the Court of Justice of the European Union (CJEU) has explicitly stated that copyright law does not extend its protection to sporting events.<sup>44</sup> The CJEU's only explanation for saying that 'sporting events cannot be regarded as intellectual creations classifiable as works within the meaning of the Copyright Directive', including football matches, was that these events 'are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright'.<sup>45</sup> Lionel Bently has questioned that rationale and offered examples of creative football game plays that might well qualify for copyright protection.<sup>46</sup> But until the CJEU rules otherwise, this particular issue is settled as a matter of EU law.

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Rompu (Asser) and Thomas Margoni (IViR). Ownership of trademarks in team and league names and symbols, especially emblazoned on merchandise, provides important supplementary income to sports organisers. *Ibid.*, at 16 n. 8. The laws of many, but not all, jurisdictions provide additional rights to control commercial exploitations of images of individual players, sometimes known as image, personality, or publicity rights. *Ibid.*, at 42–50. Not content with these many opportunities to control commercial exploitations of athletic events, sports organisers have asked for the creation under EU law of a neighbouring right for sports organisers as well as additional *sui generis* forms of legal protection, in particular, the right to consent (or deny consent) to those who bet on sporting events. The European Commission has thus far not heeded this plea. Lichtenhein, *supra*. The Sports Study stressed the necessity of safeguards and best practice models before recognition of a right to consent to bets. Sports Study, *supra*, at 182–187. See also Thomas Margoni, 'The Protection of Sports Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection', 47 *IIC – International Review of Intellectual Property & Competition Law* (2016), 386. Sports betting is unlawful in most states in the United States. See Alex Sherman, 'Here's Where Sports Betting Is Legal, and the 19 States Set to Vote on It This Year', CNBC, 13 March 2021, <https://www.cnbc.com/2021/03/13/is-sports-betting-legal-in-my-state.html>.

44. See CJEU, 4 October 2011, joined cases C-403/08 & C-429/08, ECLI:EU:C:2011:631, *Football Association Premier League and Others, and Karen Murphy* ¶¶ 96–99. Courts in the United States and Canada have reached the same conclusion. See, e.g., *Hoopla Sports & Entm't, Inc. v. Nike, Inc.*, 947 F. Supp. 347 (N.D. Ill. 1996) (rejecting sports organiser's claim of copyright in its design for a sporting event); *FWS Joint Sports Claimants v. Copyright Board*, (1991) 129 N.R. 289 (FCA) (Can.) (sporting events are not copyrightable). However, the CJEU in *Premier League* also seemed to recognise a 'unique' and 'original' character in sporting events that might rise to be subject matter worthy of protection, not under EU copyright law but possibly through various domestic solutions. See *Premier League*, ¶98, cited in Sports Study, *supra* note 43, at 30.

45. *Premier League*, ¶ 98.

46. Lionel Bently, 'Football as a Creative Work for the Purposes of Author's Rights', in this volume. See also Information Law Institute, 'Who Owns the World Cup?', panel, IViR Conference, 4 July 2014, <https://www.youtube.com/watch?v=bm86FavgKxg> (Lionel Bently presentation). Bently does not claim that games as a whole are creative works, but rather that some particular moves of football players are creative enough to attract copyright. *Ibid.* Some US commentators have also suggested that creative sports moves might be copyrightable. See F. Scott Kieff, Robert G. Kramer and Robert M. Kunstadt, 'It's Your Turn, But It's My Move: Intellectual Property Protection for Sports Moves', 25 *Santa Clara High Technology Law Journal* (2012), 765 (767).

Courts in the US have reached the same conclusion as the CJEU about the uncopyrightability of sporting events.<sup>47</sup> The National Basketball Association (NBA) once claimed that Motorola infringed the NBA's copyrights in basketball games by relaying detailed data about the ongoing progress of NBA games to customers of its STATS paging device.<sup>48</sup> Like the CJEU, the US Court of Appeals for the Second Circuit decided that 'the underlying basketball games do not fall within the subject matter of federal copyright protection because they do not constitute "original works of authorship" under 17 U.S.C. § 102(a)'.<sup>49</sup>

Unlike the CJEU, the Second Circuit offered more than one reason why it thought that sporting events such as basketball games do not qualify for copyright protection. For one thing, the copyright statute does not mention athletic events as copyright subject matter; nor are such events analogous to any of the enumerated eligible subject matters.<sup>50</sup> Games, moreover, are not 'authored' in a copyright sense. 'Unlike movies, plays, television programs, or operas, athletic events are competitive and have no underlying script. Preparation may even cause mistakes to succeed, like the broken play in football that gains yardage because the opposition could not expect it.'<sup>51</sup> Moreover, given how many people participate in such events, identifying who qualified as an author would be difficult.<sup>52</sup>

The Second Circuit also offered a policy rationale for ruling against the NBA's copyright claim:

What 'authorship' there is in a sports event, moreover, must be open to copying by competitors if fans are to be attracted. If the inventor of the T-formation in football had been able to copyright it, the sport might have come to an end instead of prospering. Even where athletic preparation most resembles authorship – figure skating, gymnastics, and, some would uncharitably say, professional wrestling – a performer who conceives and executes a particularly graceful and difficult – or, in the case of wrestling, seemingly painful – acrobatic feat cannot copyright it without impairing the underlying competition in the future. A claim of being the only athlete to perform a feat doesn't mean much if no one else is allowed to try.<sup>53</sup>

While games themselves are not entitled to copyright protection, broadcasts of NBA basketball games are protectable by copyright law on account of the

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47. See, e.g., *Hoopla*, 947 F. Supp. 347 (N.D. Ill. 1996). But see *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 669 n. 7 (7th Cir. 1986) (dicta suggesting that players' performances in games might exhibit enough creativity to be copyright-protectable).

48. *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 844 (2d Cir. 1997).

49. *Ibid.*, at 846.

50. *Ibid.*

51. *Ibid.* (referring to US style football).

52. *Ibid.* (citing Melville Nimmer and David Nimmer, *Nimmer on Copyright*, vol. 1 (Matthew Bender, 1996), § 2.09[F] at 2-170.1).

53. *Ibid.* The Patry treatise suggests that figure skating and synchronised swimming should qualify for copyright protection. See William F. Patry, *Patry on Copyright* (Thomson West, 2019), §4:20.

originality in the filming of them.<sup>54</sup> However, extracting data about the athletes and the ongoing progress of games does not infringe broadcast copyrights because facts are not protectable by copyright law.<sup>55</sup>

The NBA also claimed that Motorola had misappropriated ‘hot news’ about the play of NBA games in violation of New York state common law. The Second Circuit rejected this claim as well.<sup>56</sup> It pointed out that ‘Congress, in extending copyright protection only to the broadcasts and not to the underlying events, intended that the latter be in the public domain.’<sup>57</sup> Consequently, the NBA’s state misappropriation claim was preempted by federal copyright law.<sup>58</sup>

The US Copyright Office has elaborated on its understanding of the *NBA v. Motorola* ruling in its *Compendium of Copyright Office Practices*. No copyright subsists, it says, in:

competitive activities [that] are comprised of athletic maneuvers rather than artistic movements, gestures, or facial expressions, [which] therefore lack sufficient creative expression. Competitive activities lack the capacity for uniform performance because each contest usually involves a different set of maneuvers, they lack compositional arrangement because athletic movements are rarely organized into a coherent compositional whole, and any dramatic content involves the ‘drama’ of the competition rather than a story that is told or a theme that is evoked by the players’ movements.<sup>59</sup>

Another way that sports organisers in the US have attempted to claim exclusive rights to control commercial value they regard as their due is by claiming rights in information about games and their players.<sup>60</sup> In *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media*, an organiser of online fantasy sports products (CBC) sought a declaratory judgment that it was entitled to commercially exploit the names of Major League Baseball (MLB) players and statistics about their performances as well as biographical data, without getting permission from or paying compensation to the league or its players.<sup>61</sup>

CBC enables its customers to form fantasy baseball teams by ‘drafting’ players from various major league baseball teams prior to each MLB season. Participants compete against other fantasy baseball ‘owners’ who have also

54. *Nat'l Basketball Ass'n*, 105 F.3d at 847. The Second Circuit further noted that for the avoidance of doubt Congress amended the Copyright Act specifically to extend copyright protection to fixed broadcasts of games but not to the underlying games. *Ibid.*, quoting H.R. Rep. No. 94-1476 (1976) at 52 ([T]here is little doubt that what the cameraman and the director [of a football game] are doing constitutes “authorship”)).

55. *Nat'l Basketball Ass'n*, 105 F.3d at 847.

56. *Ibid.*, at 848–854.

57. *Ibid.*, at 849.

58. *Ibid.*, at 854.

59. *US Copyright Office Compendium*, *supra* note 25, § 806.5(B) (citing *Nat'l Basketball Ass'n*, 105 F.3d at 846–847).

60. In the EU, rights with regard to a player’s privacy, personality, and publicity, collectively referred to as ‘image rights’, are not harmonised and differ depending on the Member State. See Sports Study, *supra* note 43, at 42–51.

61. 505 F.3d 818, 820 (8th Cir. 2007).

drafted their own teams. Success of each ‘team’ depends on actual performances of the fantasy team’s players over the course of the MLB season. CBC’s fantasy baseball customers pay fees to play and to trade players throughout the season.<sup>62</sup>

Advanced Media is the interactive media and internet arm of MLB. In 2005, it started marketing its own fantasy baseball game products. In response to CBC’s declaratory judgment action, Advanced Media counterclaimed, asserting that CBC’s fantasy products violated the major league baseball players’ rights of publicity, which the players had licensed to Advanced Media. The MLB Players Association intervened in the suit and joined Advanced Media’s claims.<sup>63</sup>

The US Court of Appeals for the Eighth Circuit found some merit in Advanced Media’s right of publicity claim. ‘Because … CBC uses baseball players’ identities in its fantasy baseball products for purposes of profit, we believe that their identities are being used for commercial advantage and that the players therefore offered sufficient evidence to make out a cause of action for violation of their rights of publicity under Missouri law.’<sup>64</sup> Yet it decided that CBC’s free speech rights under the First Amendment to the US Constitution preempted the players’ and Advanced Media’s publicity rights claims, saying that ‘the information used in CBC’s fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a first amendment right to use information that is available to everyone’.<sup>65</sup> The court also took into account that the MLB players are already handsomely compensated for their performances in games, so publicity rights are not needed as an incentive to engage in productive activities.<sup>66</sup>

The *CBC* case resembles in some respects a set of European cases from 2004 in which plaintiffs asserted intellectual rights in data about sporting events and schedules through the EU *sui generis* database right.<sup>67</sup> Reporting on these cases, Davison & Hugenholtz characterised the CJEU rulings as clarifying two important interpretive norms concerning database rights. The first was that ‘investment in “creating” data, *e.g.* by drawing up a list of sporting events, does not count towards “substantial investment”’. The ruling consequently denied database protection ‘to such “single-source” data as football fixtures and horseracing schedules’.<sup>68</sup> A second was that in determining infringement of the database

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62. *Ibid.*, at 820–821. CBC had previously licensed this data from the MLB Players Association from 1995 to 2004. *Ibid.*, at 821.

63. *Ibid.*, at 820.

64. *Ibid.*, at 823.

65. *Ibid.*

66. *Ibid.*, at 824. See also *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 315–318 (Cal. Ct. App. 2001) (rejecting baseball player publicity rights claims against their league).

67. See, *e.g.*, Mark J. Davison and P. Bernt Hugenholtz, ‘Football Fixtures, Horseraces and Spin-Offs: The ECJ Domesticates the Database Right’, 27 *European Intellectual Property Review* (2005), 113. The cases were: CJEU, 9 November 2004, case C-338/02, ECLI:EU:C:2004:696, *Fixtures Marketing Ltd (Svenska)*; CJEU, 9 November 2004, case C-444/02, ECLI:EU:C:2004:697, *Fixtures Marketing Ltd (OPAP)*; CJEU, 9 November 2004, case C-46/02, ECLI:EU:C:2004:694, *Fixtures Marketing Ltd (Oy Veikkaus)*; and CJEU, 9 November 2004, case C-203/02, ECLI:EU:C:2004:695, *British Horseracing Board Ltd*.

68. Davison and Hugenholtz, *supra* note 67, at 113.

right, 'the economic value of the appropriated data is irrelevant'.<sup>69</sup> The CJEU did not rest these decisions on a fundamental right to obtain and share information, but rather on its understanding of the scope of the *sui generis* database right. In any event, the rulings were at least consistent with the US case law raising similar issues.

#### 4. CONCLUDING THOUGHTS

It is widely accepted that neither games nor sporting events are in themselves copyright-protectable subject matter. This is largely due to the functional nature of games as systems, which should be available to all as a matter of copyright law, with only such things as the visual design of the game and particular explanations of the rules qualifying as protectable expression under copyright law. The primary legislative carve-outs have dealt with protections extended to sports organisers and broadcasters to commercialise sporting events, which have proven to be enormously successful and lucrative.

The unauthorised reproduction and distribution of games and sporting events are matters of continuing concern to certain industry players. However, the solution is not necessarily to entrench rightsholders and sports organisers by conferring on them a broader set of IP rights. As with other conversations about the proper scope of protection for copyrightable works, additional stakeholder interests – of users, players, customers, athletes and their fans – should have a seat at the table as well. It's simply a matter of fair play.

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69. *Ibid.* Bernt Hugenholtz has published several papers on why database rights should be limited. See, e.g., P. Bernt Hugenholtz, 'Against "Data Property"', in Harms Ullrich et al. (eds.), *Kritika: Essays on Intellectual Property*, vol. 3 (Edward Elgar, Cheltenham, 2018), 48; P. Bernt Hugenholtz, 'Data Property in the System of Intellectual Property Law: Welcome Guest or Misfit?', in Sebastian Lohsse et al. (eds.), *Trading Data in the Digital Economy: Legal Concepts and Tools* (Nomos, Baden-Baden, 2017), 73; P. Bernt Hugenholtz, 'Something Completely Different: Europe's *Sui Generis* Database Right', in Susy Frankel and Daniel Gervais (eds.), *The Internet and the Emerging Importance of New Forms of Intellectual Property* (Wolters Kluwer, Alphen aan den Rijn, 2016), 205.



# Sporting Events as Intellectual Property and Free Movement of Services: The Implications of the *Premier League* Case

*Ole-Andreas Rognstad*

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## 1. INTRODUCTION

Bernt Hugenholtz is a sports fan. At the same time, he is very concerned about European integration and a profound supporter of the principle of country of origin for copyright<sup>1</sup> – implying that the lawfulness of an act is to be determined by the law of the European country where the act originates instead of all 28 Member States<sup>2</sup> – and eventually a truly unified EU Copyright Law.<sup>3</sup> Combining

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1. See P. Bernt Hugenholtz, ‘SatCab Revisited. The Past, Present and Future of the Satellite and Cable Directive’, 8 *IRIS Plus* (2009), 7–19; P. Bernt Hugenholtz, ‘Making the Single Digital Market Work for Copyright: Extending the Satellite and Cable Directive to Content Services Online’, Study Commissioned by BEUC (2015).
2. See Council Directive 93/83/EEC on the coordination on certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission (SatCab Directive), OJ [1993] L 248/15, Article 1(2), and Directive (EU) 2019/789 of the European Parliament and of the Council laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of broadcasting organisations and retransmissions of television and radio programs, and amending Council Directive 93/83/EEC (NetCab Directive), OJ [2019] Article 3(1) L 130/82.
3. See P.B. Hugenholtz, ‘Copyright Without Frontiers: the Problem of the Territoriality in European Copyright Law’, in Estelle Derclaye, *Research Handbook on the Future of EU Copyright* (Cheltenham UK/Northampton MA, 2009), 12–26, 25–26; the Wittem Project resulting in the European Copyright Code (2010), accessed 23 January 2021, see <https://www.ivir.nl/copyrightcode/european-copyright-code/>; P. Bernt Hugenholtz, ‘Harmonization and Unification of European Copyright Law’, 38 *Monash U. L. Rev.* (2012), 4–16; the European Copyright Society (2014) Letter to Mr Günther Oettinger, Commissioner for Digital

the topics of IP protection of sporting events and European integration in a tribute to Bernt therefore seems like a natural thing to do.

Sporting events are at this stage not subject to unified and harmonised intellectual property (IP) protection at the European level.<sup>4</sup> Nevertheless, the Court of Justice of the European Union (CJEU) in the *Premier League* case set the stage for the Member States to protect sporting events as intellectual property with reference to Article 165 TFEU.<sup>5</sup> Moreover, existing IPRs that are harmonised at an EU level may have relevance for sporting events. At the same time, the Court set important limits to the scope of national IP rules in cross-border situations on the basis of the free movement of services (Articles 49 and 56 TFEU).<sup>6</sup> Although the free movement dimension of the decision has received less attention than its competition law aspects, there is disagreement as to the scope of the application of the free movement (and for that case even the competition) rules. Notably, while some authors claim that the Court's rationale is limited to situations that were dealt with in the *Premier League* case, others opine that its application is broader and has general bearings.<sup>7</sup>

Representing the latter view, I will here discuss the scope of the limits to the IP protection of sporting events that follows from the free movement of services as laid down by the CJEU in the *Premier League* judgment. First, just a few words about the legal bases for the IP protection of sporting events in European law, a topic that has been elaborated elsewhere.<sup>8</sup>

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Economy and Society, European Commission, on the Unification of Copyright Law, [https://europeancopyrightsocietydotorg.files.wordpress.com/2015/12/ecs\\_letter\\_to\\_oettinger\\_fin-1.pdf](https://europeancopyrightsocietydotorg.files.wordpress.com/2015/12/ecs_letter_to_oettinger_fin-1.pdf), accessed 23 January 2021.

4. See Thomas Margoni, 'The Protection of Sport Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection', 47 *IIC* (2016), 386–417.
5. CJEU, 4. October 2011, Joined cases C-403/08 and C-429/08, *Football Association Premier League Ltd. et al. v. QC Leisure et. al. and Karen Murphy et al.*, ECLI:EU:C:2011:631, paras. 100–104.
6. *Premier League*, paras. 105–121.
7. For the narrower view, see for example, Dimitrios Doukas, 'The Sky is not (the only) limit: sports broadcasting without frontiers and the Court of Justice: comment on Murphy', 37 *Eur. Law Rev.* (2012), 605–626, 625. See also Bill Batchelor and Luca Montani, 'Exhaustion, essential subject matter, and other CJEU related tools to update copyright for an online economy', 10 *JIPLP* (2015), 591–600, 598, although the authors' conclude that the extension of the *Premier League* rationale 'remains ... an open question'. For a broader take, see, for example, Adrian Wood, 'The CJEU's ruling in the Premier League pub TV cases – the final whistle beckons: joined cases Football Association Premier League Ltd v QC Leisure (C-403/08) and Murphy v Media Protection Services Ltd (C-429/08)', 34 *EIPR* (2012), 203–207; Sybe de Vries, 'Sport, TV and IP rights: *Premier League* and *Karen Murphy*', 50 *CML Rev.* (2013) , 591–622, 621–622; Juha Vesala, 'Geoblocking Requirements in Online Distribution of Copyright Protected Content', 25 *Mich. State Int. Law Rev.* (2017), 595–621, 612 et seq.; Sebastian Schwemer, *Licensing and Access to Content in the European Union* (Cambridge University Press, Cambridge, 2019), 108 (noting that 'it appears that the Court's findings are indeed relevant beyond broadcasts and football matches').
8. See in particular Margoni, *supra* note 4, and the *Study on Sports Organisers' Rights in the European Union* carried out by Asser International Sports Law Centre and IViR (2014) for the EU Commission, see <https://op.europa.eu/en/publication-detail/-/publication/4ca2cb40-fb00-469a-9ba4-b0ccc2502016/language-en/format-PDF/>, accessed 24 January 2021.

## 2. PROTECTION OF SPORTING EVENTS IN THE EUROPEAN UNION

A distinction may be made here between the protection of sports performances *as such* and various other kinds legal positions that put organisers of sporting events in a position to control the exploitation of the events.

As to the former, it is well known that the CJEU in *Premier League* rejected the idea that sporting events, and in particular football matches, could ‘be regarded as intellectual creations classifiable as works within the meaning of the Copyright Directive [and under EU law protected] on any other basis in the field of intellectual property’.<sup>9</sup> A different discussion is the *reasons* given why copyright does not protect football matches, as they could give rise to the suspicion that the members of the Grand Chamber have watched far fewer football matches than Bernt and myself. According to the Court, football matches are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright.<sup>10</sup> As others have demonstrated,<sup>11</sup> there is of course plenty of room for making free and creative choices within the rules of the game, apart from the fact that exercising these free and creative choices certainly requires considerable skills.<sup>12</sup> Suffice to study genius players like Diego Maradona, Lionel Messi, and for that matter the Dutch icon Johann Cruyff. Thus, the reasons given by the Court for football matches not being works are simply unconvincing. Still, I personally concede to the result, since claiming exclusive rights to passes, feints, penalties or free kicks, or the interaction between players, would simply be contrary to the idea of the game.<sup>13</sup> However, in the same way as rejecting copyright protection for smells and tastes rests on an incomprehensible distinction between objective and subjective phenomena,<sup>14</sup> the alleged lack of creativity in football rests on a fiction. Thus, rather than construing a ratio that does not fit, the better view is to admit that the concept of ‘literary and artistic work’ does not extend to all kinds of phenomena, but entails a qualification also based on conceptions of what is ‘literary and artistic’ in the copyright sense of the word.<sup>15</sup> This is certainly not to ignore that the traditional conceptions of what that is have changed over

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9. *Premier League*, *supra* note 5, paras. 96–99.

10. *Premier League*, *supra* note 5, para. 98.

11. See in particular Lionel Bently’s insightful (both with respect to football and copyright) and entertaining intervention, ‘Owning the World Cup – the Exclusion of Football from Copyright’ in the panel ‘Who owns the World Cup? The case for and against (intellectual) property rights in sports’ during IViR 25th Anniversary Conference in Amsterdam. 4 July 2014, see <https://www.youtube.com/watch?v=bm86FavgKxg> (13:07–38:59).

12. Recognising that skills as such cannot justify copyright protection, see CJEU, 1 March 2012, case C-604/10, *Football Dataco Ltd et al. v. Yahoo UK Ltd et al.*, ECLI:EU:C:2012:115, para. 42.

13. Recognising at the same time that the idea/expression dichotomy would be difficult to apply to these situations, cf. Bently, *supra* note 11.

14. See case C-310/17, *Levola Hengelo BV v. Smilde Foods BV*, ECLI:EU:C:2018:899, paras. 41–43.

15. Compare the comment of European Copyright Society, *Opinion on the pending reference before the CJEU in Case 310/17 (copyright protection of tastes)*, 19 February 2018, 6–7, <https://europeancopyrightsocietydotorg.files.wordpress.com/2018/03/ecs-opinion-on-protection-for-tastes-final1.pdf>, accessed 24 January 2021. See also Caterina Sganga, ‘The notion of

the years, but extension implies that there are certain reasons to subsume the phenomena under the concept of work, which are lacking for football matches and other ball games.

Whether other kinds of sport, in particular those based on pre-determined choreography like floor exercises in gymnastics, figure skating and synchronised swimming, could enjoy copyright protection, is a different question.<sup>16</sup> Despite the CJEU's general statement about lack of copyright for 'sporting events', the arguments for and against copyright protection are in this case different than for ball games. In any event, the question of whether athletes enjoy neighbouring rights protection for their performances also normally depends on whether they perform a work.<sup>17</sup> Thus, the football player will not be protected as a performer as long as the game itself is not protected.

Despite the lack of copyright and neighboring rights protection for sports *performances*, the CJEU nevertheless asserted that 'sporting events, as such, have a unique and, to that extent, original character which can transform them into subject-matter that is worthy of protection comparable to the protection of works, and that protection can be granted, where appropriate, by the various domestic legal orders'.<sup>18</sup> The use of the term 'sporting events' is in this respect confusing, since the Court had already denied copyright protection for football matches as 'sporting events' on the ground of lack of originality. What is obviously meant, is that sporting events may be worth protecting on *grounds other* than protecting the sport performances as such. One such ground, which is also alluded to by the Court, is so-called 'house rules' based on property rights to the venue combined with principles of private autonomy that put the owner or the facilitator in the position to limit others' exploitation of the sports events by establishing entrance conditions.<sup>19</sup> Moreover, there are national laws granting neighbouring rights to sporting events, implying that exploitation of the events needs permission from the organiser of the event.<sup>20</sup> Furthermore, there are national rules aimed at the *exploitation* of the event, the British ban on sale of decoders and decoding equipment enabling TV viewers to watch broadcasts from other geographical areas being one example.<sup>21</sup>

According to the CJEU, all national rules 'designed to confer protection on sporting events' are permissible as intellectual property on the premise that they comply with the free movement of services rules, to which we will turn

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"work" in EU Copyright Law after Levola Hengelo: one answer given three question marks ahead', 41 *EIPR* (2019) 415–424.

16. See Margoni, *supra* note 4, 390.
17. See the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Article 3(a) defining 'performers' as 'actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works', cf. also WIPO Performances and Phonograms Treaty (WPPT) Article 2(a) (comprising performance of expressions of folklore as well).
18. *Premier League*, *supra* note 5, para. 100.
19. See Margoni, *supra* note 4, 391–394, with further references.
20. See *ibid.*, 394–396.
21. See the British Copyright, Patents and Design Act (1988) Section 298 CDPA (as formulated at the time of the case).

now. Finally, it goes without saying that this is the case also for harmonised rules that grant protection for exploitation of sporting events, like copyright to the audiovisual recording of the events, and broadcasters, film producers and phonogram producers' neighbouring rights concerning the same.<sup>22</sup>

### **3. SPORTING EVENTS AND FREE MOVEMENT OF SERVICES – POINTS OF DEPARTURE**

Holding that the protection of sporting events is not precluded by EU law, and consequently that such legislation 'is ... capable of justifying a restriction on the free movement of services', the CJEU in *Premier League* emphasised – in accordance with its case law on free movement – that 'it is [however] necessary that such a restriction does not go beyond what is necessary in order to attain the objective of protecting the intellectual property at issue'.<sup>23</sup> Referring to its 'specific subject matter dogma', implying that right holders must have the right to exploit the protected subject matter commercially, and receive remuneration, the CJEU found that the British decoder ban conflicted with the free movement of services. The core of the findings was that in the situation at hand, it was 'possible to determine with a very high degree of precision the total number of viewers who form part of the actual and potential audience of the broadcast concerned, hence of the viewers residing within and outside the Member State of broadcast'. Hence, payments based on territorial restrictions within the internal market were not justified since it resulted in artificial price differences between the national markets that are irreconcilable with the fundamental aim of completion of the internal market.<sup>24</sup> It is worth noting that the specific subject matter of IP, according to the Court, 'does not guarantee the right holders concerned the opportunity to demand the highest possible remuneration', only 'appropriate remuneration', which must be 'reasonable in relation to the economic value of the service provided and in particular in relation to the actual or potential number of persons who enjoy or wish to enjoy the service'.<sup>25</sup>

Also, the deviation from the *Coditel I* case came as a surprise for many, since that case was seen as a precedent on the permissibility of territorial partitioning of broadcasts, and even paving the way for the non-exhaustion of online services.<sup>26</sup> In *Premier League*, the CJEU, however, emphasised the differences between this case and *Coditel I*, in that in the latter 'the cable television broadcasting companies communicated a work to the public without having, in the Member State of the place of origin of that communication, an authorisation from the

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22. Compare Margoni, *supra* note 4, 396 et seq.

23. *Premier League*, *supra* note 5, paras. 104–105.

24. *Ibid.*, paras. 106–107, 113–115.

25. *Ibid.*, para. 108.

26. See the EU Commission Proposal for a European Parliament and Council Directive on the harmonization of certain aspects of copyright and related rights in the Information Society, COM (97) 628 final, 27.

right holders concerned and without having paid remuneration to them'.<sup>27</sup> By contrast, in *Premier League* the broadcaster *had* received authorisation from the right holder and paid remuneration for the broadcast in a situation where he could take account of the actual and potential audience in the other Member State.<sup>28</sup> The Court added, that 'account should be taken of the development of European Union law that has resulted, in particular, from the adoption of the Television without Frontiers Directive and the Satellite and Cable Broadcasting Directive which are intended to ensure the transition from national markets to a single programme production and distribution market'.<sup>29</sup>

#### **4. THE FURTHER SCOPE OF SPORTS RIGHTS IN THE EUROPEAN UNION IN LIGHT OF FREE MOVEMENT OF SERVICES**

The question is where this leaves us regarding the scope of sports rights in the European Union regardless of whether it is based on national legislation protecting sports events as IP or on the harmonised rules on copyright and related rights. As indicated above, there are different views. The narrow take is that the *Premier League* rationale is limited to situations where the principle of country of origin applies.<sup>30</sup> Thus, in this case the national IP law applied to satellite broadcasts, which pursuant to Article 1(2)b of the Satellite and Cable Broadcasting Directive is subject to the country of origin principle.<sup>31</sup> The CJEU alludes to the relevance of this provision after having cited recital 17 of that Directive, which states that in calculating a reasonable remuneration for the licensing of broadcasting rights, the parties should take account of all aspects of the broadcast, such as the actual audience, the potential audience and the language version.<sup>32</sup> The CJEU emphasised that the right holders in the case were remunerated for the broadcasting of the sporting events from the Member State of broadcast in which the act of broadcasting took place (here: Greece), in accordance with the country of origin rule, and in which the appropriate remuneration was payable.<sup>33</sup> The Court also referred to the fact that broadcasters carry out acts of communication to the public while having an authorisation from the right holders in the Member State of origin, and to the Satellite and Cable Broadcasting Directive's role in ensuring 'the transition from national markets to a single programme production and distribution market'.<sup>34</sup> Hence, it is possible to argue that the reasoning of the Court, and the resistance against introducing restrictions on the free movement of services, were motivated by the special regulation of the SatCab Directive and the

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27. Cited from *Premier League*, *supra* note 5, para. 119, with reference to case C-62/79, SA Compagnie générale pour la diffusion de la télévision, Coditel, and others v. Ciné Vog Films and others, ECLI:EU:C:1980:84.

28. *Premier League*, para. 120.

29. *Premier League*, para. 121.

30. See Doukas, *supra* note 7, 625; Batchelor and Montani, *supra* note 7, 598.

31. *Supra* note 2.

32. *Premier League*, *supra* note 5, para. 110.

33. *Ibid.*, para. 111.

34. *Ibid.*, paras. 120 and 121.

aim behind the country of origin rule. From this perspective, the British decoder ban introduced a restriction on free movement of satellite broadcasts that the country of origin rule was intended to remove. Consequently, so the argument would go, the *Premier League* rationale only applies to such situations, including ancillary online services, which pursuant to the so-called NetCab Directive 2019/789<sup>35</sup> Article 3 also is subject to a country of origin rule.<sup>36</sup> Conversely, in other situations the holder of sports rights would be in a position to invoke its rights to restrict cross-border transmissions of the sporting events.<sup>37</sup>

This argument, however, overlooks that the core rationale of the *Premier League* case on the free movement of services goes to the ability of the right holder to artificially partition the market and price discriminate in order to obtain a premium based on territorial exclusivity. To be sure, in the case at hand that meant to introduce barriers to satellite broadcasting in a situation where the principle of country of origin applied. However, as the Court also admits, that could have been a legitimate restriction on the free movement of services if it secured the right holders receiving an appropriate remuneration for the broadcasts.<sup>38</sup> The territorial exclusivity based on the British decoder ban went beyond what was necessary to safeguard an appropriate remuneration because the reception of satellite broadcasts required decoding devices, which made it ‘possible to determine with a very high degree of precision the total number

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35. Directive (EU) 2019/789 of the European Parliament and of the Council of 17 April 2019 laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of television and radio programmes, and amending Council Directive 93/83/EEC, *Official Journal* 2019 L 130, 82.

36. See *supra* note 2. The scope of this country of origin principle is, however, quite limited, as it only applies to radio programs and TV programs that are either news and current affairs programs or fully financed own productions of the broadcasting organisation, see further P. Bernt Hugenholtz and Joost Poort, ‘Film Financing in the Digital Single Market: Challenges to Territoriality’, 51 *IIC* (2020), 167–186, 176.

37. In this direction, see Batchelor and Montani, *supra* note 7, p. 598, pointing out that the ‘Satellite Directive has a pan-European licensing rule, which holds that copyright is engaged only in the country-of-uplink, from which the broadcast emanates, rather than all the countries’ copyright laws where the broadcast is Received’, and that ‘[t]his is not the same for internet dissemination, for which copyright clearance in each country of reception is required’. The authors also maintain that the CJEU in case C-351/12, *OSA v. Léčebné lázně Mariánské Lázně a.s.*, ECLI:EU:C:2014:110, para. 73, ‘held *Premier League* inapplicable within the context of territory-based copyright protection’. The question raised in *OSA* was, however, quite different from that of *Premier League*, in that the Court in the former case accepted territorial restrictions regarding the collective licensing of rights to communication to the public in the ‘offline context’, in accordance with its previous case law (case C-395/87 (*Tournier*) and joined Cases 110/88, 241/88 and 242/88 (*Lucazeau*)). The CJEU in *OSA* (paras. 76–77) emphasised, *inter alia*, that the observations in the case had not shown that there was another method allowing the same level of copyright protection as the territory-based protection and the territory-based supervision, and monitoring problems with a different solution. This is far from stating *on a general level* that the *Premier League* rationale does not apply in the context of territory-based copyright protection.

38. *Premier League*, *supra* note 5, para. 114.

of viewers who form part of the actual and potential audience of the broadcast concerned'.<sup>39</sup>

Conversely, however, also in situations where the country of origin principle does not apply it is possible to make such a determination.<sup>40</sup> Judging from the reasoning of the Court, the existence of the country of origin principle appears as a circumstantial background to the case rather than a precondition for applying the free movement of services principle. On the contrary, the principle is one of several instruments for safeguarding market integration,<sup>41</sup> the Treaty rules on free movement of services being another. The specific feature of the *Premier League* case was that the British decoder ban reestablished a restriction on free movement of services that the country of origin principle was meant to abolish. However, the case as such demonstrates that not only the free movement of goods but also the free movement of services may limit the scope of territorial IP rights, and that the *Coditel I* case is not to be considered as a legal precedent against the latter.<sup>42</sup>

The Court's observation in *Premier League* that the right holders are not entitled to demand the *highest possible* remuneration, but a reasonable remuneration, is key to drawing the line between legitimate and artificial partitioning of the internal market. In *Coditel I* the main rationale for accepting restrictions on the free movement of services inherent in national copyright law was that the right holders were unable to calculate a fee covering the total exploitation of the work.<sup>43</sup> The fact that the territorially restricted licence to broadcast coincided with national frontiers did not point to a different solution.<sup>44</sup> Invoking copyright law to prohibit the retransmission of a film by cable did therefore not create artificial barriers to trade between Member States. The situation was different in the *Premier League* case where the right holder did have the opportunity to calculate a reasonable fee for the total exploitation (satellite broadcast) of the sport events in the EU. Consequently, this appears to be the criterion for delineating the scope of protection of sports events in cross-border situations in Europe on the basis of the free movement of services (TFEU Article 56).

The 'adequate remuneration' test is definitively not a new one, but it appears in different contexts in the case law of the CJEU, although linked to the specific subject matter of IPRs. Partly, this serves as a justification for the exhaustion of IP rights to physical objects, based on the free movement of goods,<sup>45</sup>

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39. *Ibid.*, para. 113.

40. For example, so-called OTT media services (streaming services offered directly to viewers over the Internet).

41. See Hugenholtz and Poort, *supra* note 36, 173 et seq., however without mentioning the free movement of services rules.

42. Compare Hugenholtz, 'Copyright without Frontiers', *supra* note 3, 21.

43. *Coditel I*, *supra* note 27, para. 13.

44. *Ibid.*, para. 16.

45. See joined cases C-55/80 and C-57/80, *Musik Vertrieb Membran GmbH et al. v. GEMA*, ECLI:EU:C:1981:10, para. 13, read in context with case C-15/74, *Centrafarm BV et al. v. Sterling Drug Inc.*, ECLI:EU:C:1974:115, para. 9, and case C-187/80, *Merck & Co. v. Stephan BV et al.*, ECLI:EU:C:1981:180, para. 4, in the patent field

and conversely also in cases of non-exhaustion.<sup>46</sup> Pairing the *Coditel I* and the *Premier League* cases, it is possible to say the same about broadcasts, although it is not necessary nor necessarily appropriate to use the term ‘exhaustion’ in this context.<sup>47</sup> Similarly, also when it comes to the question of online ‘exhaustion’ of rights to digital copies, the Court in *UsedSoft* based its finding of the exhaustion rule in Article 4(2) of the Computer Program Directive on the ‘adequate remuneration’ rationale.<sup>48</sup> On the other hand, when emphasising the difference between e-books and computer programs in its *Tom Kabinet* judgment, applying the communication to the public right and its non-exhaustion rule in Article 3(3) of the Information Society Directive instead, the CJEU also mentioned the right holders’ interests in obtaining an appropriate reward as an argument in favour of non-exhaustion.<sup>49</sup>

Additionally, it is also possible to link the requirement that an act of communication will have to be made to a ‘new public’ in order to fall under the communication to the public right to the adequate remuneration rationale. The *Premier League* case may serve as an example. On the one hand, it follows from the above that the ban on decoder sales could not be justified under the free movement of services rules, since the right holders had the opportunity to demand an adequate remuneration based on the total number of actual and potential viewers of the broadcast. On the other hand, invoking copyright to prevent the transmission of the same broadcast in public houses via a television screen and speakers was justified because this transmission represented an intervention causing the work to be communicated to an additional (new) public, which was not considered by the authors when they authorised the broadcasting of their works.<sup>50</sup> Even though the concept of new public can be criticised on various grounds,<sup>51</sup> it is not unrelated to the adequate remuneration rationale. Thus, the CJEU noted at the outset of the discussion of whether the transmission in public houses constituted an act of communication to the public that ‘the principal objective of the Copyright Directive is to establish a high level of protection of authors, allowing them to obtain an appropriate reward for the use of their works’.<sup>52</sup> Concluding that it did, on the ground that the transmission reached a new public, is tantamount to saying that the right holder did

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46. Case C-158/86, *Warner Brothers Inc. et al. v. Erik Viuff Christiansen*, ECLI:EU:C:1988:242, para. 15.

47. Compare Reto Hilty, ‘Legal Concept of “Exhaustion”: Exhausted?’, in Niklas Bruun, Grahame B. Dinwoodie, Marianne Levin and Ansgar Ohly, *Transition and Coherence in Intellectual Property Law. Essays in Honour of Annette Kur* (Cambridge University Press, Cambridge, 2021), 272–283 (Chapter 22).

48. Case C-128/11, *UsedSoft GmbH v. Oracle International Corp.*, ECLI:EU:C:2012:407, para. 63.

49. Case C-263/18, *Nederlands Uitgeversverbond and Groep Algemene Uitgevers v. Tom Kabinet Internet BV and Others*, ECLI:EU:C:2019:1111, paras. 57 and 58.

50. *Premier League*, *supra* note 5, para. 199.

51. See, for example, P. Bernt Hugenholtz and Sam C. van Velze, ‘Communication to a New Public? Three Reasons Why EU Copyright Law Can Do Without a “New Public”’, 47 *IIC* (2016), 797–817.

52. *Premier League*, *supra* note 5, para. 186

not receive adequate remuneration for the (re-)transmission. That follows also implicitly from the formulation of the new public criterion – a public that the right holder did not take into consideration by the initial communication (here: the broadcast). In other words, the adequate remuneration rationale led to the result that right holders (FAPL) were not in the position to prevent viewers in the UK getting access to the Greek broadcast, even though they had a legal position that the CJEU classified as an intellectual property in the sports events. On the contrary, they could invoke their copyright in the broadcasts to prevent their showing in public places.

It follows that the adequate remuneration argument basically appears in two different shapes – first as an underlying justification for legal criteria such as under the exhaustion doctrine and the new public requirement, and second as a legal criterion in itself. In determining the limits to cross-border dissemination of sport events, it appears as a legal criterion in itself, since there is yet no other case law that follows up the CJEU decision in *Premier League*. The problem is of course to determine what an ‘adequate remuneration’ is. Here it is possible to draw on the case law regarding other kinds of territorial restrictions. The bottom line is the *possibility* to calculate or determine a fee that covers the use in question. That is the rationale behind the exhaustion principle for the rights to tangible copies, and is applied by analogy to downloads of computer programs in *UsedSoft* and to satellite broadcasts in *Premier League*. The same could, in principle, apply to the circumstances of the *Tom Kabinet* case, since the sellers of the e-books had to delete their copies before re-selling them, so that the resale in principle should not add to the number of users compared to the initial sale.<sup>53</sup> The possibility to calculate the fee is thus not necessarily sufficient – the remuneration must be *adequate* as well. Older case law under the free movement of goods implies, however, that the fact that the legal conditions in various Member States differ, that there is no legal protection in the ‘exporting state’ or that there exist different price levels in the community does not necessarily justify territorial restrictions. This is the case as long as the right holder has consented to the use and the consent covers the use in question.<sup>54</sup> Thus, there is a need for additional circumstances, for example a secondary market being capable of undermining the primary market, in order to claim that a calculated remuneration that covers the use in question is not ‘adequate’.<sup>55</sup> Nevertheless, the ‘adequate remuneration rule’ appears as a rule of reason, and there is room for arguments that justify restrictions on cross-border dissemination of sporting events in the EU. The notion that the protection of copyright and neighbouring rights are legitimate restrictions *per se*, for example of online dissemination of such events, because of copyright’s

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53. See *Tom Kabinet*, *supra* note 49, para. 24.

54. See *Merck v. Stephan*, *supra* note 45; case C-267/95, *Merck & Co. Inc. et al. v. Primecrown Ltd. et al.*, ECLI:EU:C:1996:468. Cf. also *Musik Vertrieb Membran v. GEMA*, *supra* note 45.

55. Compare *Vesala*, *supra* note 7, 615, who states that ‘[i]t ... appears difficult to separate appropriate remuneration based on the value of content from inappropriate remuneration based on exploiting artificial price differences achieved by partitioning the market along member state borders.’

territorial nature, conflicts with market integration goals and the rules on free movement of services. The harmonisation Directives in the copyright field make no difference in this respect.

## 5. EXCURSION: THE APPLICATION OF THE PREMIER LEAGUE RATIONALE BEYOND THE PROTECTION OF SPORTING EVENTS

This leads us to the question of whether the ‘adequate remuneration principle’ as laid down in *Premier League* has general application beyond the protection of sporting events. The CJEU’s reasoning in *Paramount* suggests that it has, despite the fact that the Court annulled the decision of the Commission aimed at restraining Paramount Pictures from geo-blocking of their PayTV services in the EU.<sup>56</sup> However, the annulment was based on procedural grounds, as the CJEU found that the Commission’s decision represented a disproportional intervention in third parties’ contractual rights, in conflict with Article 9 of the Regulation1/2003 on the enforcement of the competition rule.<sup>57</sup> The Court found that the General Court had not erred in its assessment of the economic and legal context in which the contractual clauses appeared. The appellant Canal + had claimed that the General Court committed such an error when citing the CJEU’s holding in *Premier League* in order to hold that the relevant clauses regarding absolute territorial protection gave rise to competition concerns. According to the appellant, the Commission thus ignored the specific economic and legal context of the film sector, despite the CJEU ruling in the *Coditel II case*, where the CJEU emphasised the specific features of the movie industry and market within the EU,<sup>58</sup> in particular regarding synchronisation, subtitling, TV transmissions and financing of European film production.<sup>59</sup>

The Court responded that even though the *Premier League* case did not concern the film sector, the situation was both commercially and from a competition point of view comparable to the case at hand. Both cases concerned exclusive licence agreements between holders of IPRs and TV and radio organisations containing obligations aimed at upholding territorial restrictions.<sup>60</sup> Moreover, the CJEU denial that there was a conflict between the two decisions in that the *Coditel II* decision only confirmed that exclusive licences in the film sector could be justified and did not as such have the object of restricting competition. Nevertheless, the Court pointed to the fact that exercising the copyright to the communication to the public of a film could have that effect. Contrary to *Coditel II*, the *Premier League* case concerned supplementary obligations in order to

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56. Case C-132/19P, *Groupe Canal + v. European Commission*, ECLI:EU:C:2020:1007

57. Council Regulation (EC) No. 1/2003 of 16 December 2002 on the implementation of the rules on competition laid down in Articles 81 and 82 of the Treaty, OJ [2003] L 1/1-25. See *Paramount*, *supra* note 56, paras. 113-115.

58. Case C-262/81, *SA Compagnie générale pour la diffusion de la télévision, Coditel, and others v. Ciné Vog Films and others*, ECLI:EU:C:1982:334 , paras.16-19 .

59. See *Paramount*, *supra* note 56, paras. 43 and 51.

60. *Ibid.*, para. 51.

maintain the territorial partitioning of the market. Thus, the General Court did not err in referring to *Premier League* in its decision in *Paramount*.

The Court's reasoning is transferable to the relationship between *Coditel I* and the CJEU's considerations regarding territorial restrictions stemming from legislation under the free movement of services rule.<sup>61</sup> Thus, it seems to confirm that the *Premier League* rationale is principally also applicable beyond the protection of sporting events. A different question is whether particular concerns regarding European film production may influence the adequate remuneration assessment and justify territorial restrictions. Here, it should briefly be pointed to language exclusivity as 'a practical and legally more robust alternative to territorial licensing' in preserving the interests in exploitation and financing of films in Europe.<sup>62</sup>

Comments on the *Paramount* decision have suggested that the substantial outcome of the competition law assessment in this case may be different from that of the *Premier League* case because copyright represents a barrier to entry to the parties of the agreement.<sup>63</sup> The argument refers, *inter alia*, to the CJEU's observation in *Generics*, that in case of the existence of 'insurmountable barriers' to entry, there would be no restriction, whether by object or effect of competition under Article 101 TFEU.<sup>64</sup> Thus, the argument goes that since the right holders to films can invoke copyright to prevent the offering of copyright protected content via the internet, outside the territories covered by its licence, the contractual clauses providing for territorial restrictions and geo-blocking will neither by object nor effect restrict competition.<sup>65</sup> In my opinion this argument is circular, because it presupposes that invoking copyright to partition the market will not conflict with the freedom to provide services and that the free movement of services part of the *Premier League* decision is inapplicable in this case. It follows from the foregoing that no such presumption can be made, and that the core question both in respect of the free movement and the competition rules is whether the territorial restrictions are sufficiently justified. Hence, in *Premier League* the CJEU referred to its findings regarding the free movement of services when holding that its case law on territorial restrictions for physical goods under Article 101 TFEU was 'fully applicable to the field of the cross-border provision of broadcasting services'.<sup>66</sup> Therefore, holding that invoking copyright to maintain such restrictions represent insurmountable barriers to entry that

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61. *Ibid.*, para. 54.

62. Hugenholtz and Poort, *supra* note 36, 167.

63. See Pablo Ibañes Colomo, 'Geoblocking and territorial restrictions after Generics and Canal +: are the "by object infringements?"', on the website Chilling' Competition (eds. Alfonso Lamadrid and Pablo Ibañes Colomo), <https://chillingcompetition.com/2020/12/10/geo-blocking-and-territorial-restrictions-after-generics-and-canal-are-they-by-object-infringements/> (accessed 31 January 2021).

64. See case C-307/18, *Generics (UK) Ltd and Others v. Competition and Markets Authority*, ECLI:EU:C:2020:52, paras. 45 et seq.

65. See Colomo, *supra* note 63. See also, from a pre investigation point of view, Pablo Ibañes Colomo, 'The Commission's Investigation in Pay TV Services: Open Questions', 8 *Journal of European Competition Law & Practice* (2017), 531–541.

66. See paras. 139 and 140 with reference to paras. 118–121.

exempt contractual clauses from the application of the competition rules seems rather contradictory.

## 6. CONCLUSION

To conclude, the IP protection of sporting events is subject to the limitation that follows from the free movement of services rules in Articles 49 and 56 TFEU. The legal ground of protection, whether it is national legislation only or harmonised regimes like copyright and neighbouring rights, is irrelevant. This legal situation, requiring that invoking IP to prevent cross-border dissemination of content in the EU must have a justification based on the opportunity to acquire 'adequate remuneration' for the exploitation in question, is compliant with Bernt Hugenholtz's vision of a unitary European copyright regime where no restrictions can be based on territoriality in itself. In other words, the understanding of the *Premier League* case advocated here is a step in the direction of this vision.



# The Football Game as a Copyright Work

*Lionel Bently*<sup>1</sup>

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## 1. INTRODUCTION

Speaking about developments in the jurisprudence of the Dutch courts on copyright, Bernt Hugenholtz expressed his fear that their reluctance to define and limit copyright's domain to that of 'literature, science and art', instead 'reducing the subject matter test to mere originality and personal stamp', might lead to 'infinite expansion of the concept of the work of authorship. Anything touched by human hand, including for instance sports performances, would be deemed a work.'<sup>2</sup> Given these concerns, Hugenholtz would have been relieved, no doubt, when the CJEU apparently declared that 'sporting events cannot be regarded as intellectual creations classifiable as works' within the meaning of Directive 2001/29 on Copyright in the Information Society.<sup>3</sup> Football games, as such, would remain free from copyright. The CJEU had, apparently, come to the rescue. Three years after the CJEU gave its *FAPL* decision, Hugenholtz led an IViR study of the rights of sports organisers in the European Union which confirmed that no Member States treated sports events as copyright works.<sup>4</sup>

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1. This chapter derives from a paper given at the 25th Anniversary celebration of IViR on 4 July 2014 and at the University of Oxford IP Moot '*converzatione*' on 18 March 2016. The topic of the 2014 paper was expressly provided by Bernt Hugenholtz.
2. P. Bernt Hugenholtz, 'Works of Literature, Science and Art', in P. Bernt Hugenholtz, Antoon Quaedvlieg and Dirk Visser (eds.), *A Century Years of Dutch Copyright Law: Auteurswet, 1912–2012* (De Lex, Amsterdam, 2012), Ch. 2, 53.
3. CJEU, 4 October 2011, joined cases C-403/08 and C-429/08, ECLI:EU:C:2011:631, *FAPL v. QC Leisure and , Karen Murphy v. Media Protection Services Ltd.*
4. Thomas Margoni and Ben van Rumpuy, 'Study on Sports Organisers' Rights in the European Union', EAC/18/2012 (European Parliament, Luxembourg, 2014), 29. A number of Member States protect sports events through related rights or other special laws.

A closer look, however, reveals that the purported exclusion of sports events, and football in particular, from copyright is far from secure. Indeed, this essay argues that European Union copyright law has been developing down a path that implies that football games, or parts thereof, must be protected; and, like the Dutch courts before, the CJEU has excluded from copyright jurisprudence key mechanisms that might have justified the exclusion of football games from protection. The statement to the contrary made in *FAPL* seems to be a consequence of surprising levels of ignorance about the nature of football itself. Once the place of ‘creative choice’ within football is understood, the conclusion that football games (or parts thereof) are protected becomes difficult to resist.

## 2. THE PURPORTED EXCLUSION OF FOOTBALL FROM COPYRIGHT: MISUNDERSTANDING THE RULES

In Joined Cases C-403/08, *FAPL v. QC Leisure* and Case C-429/08, *Karen Murphy v. Media Protection Services Ltd*,<sup>5</sup> the Court held that football was not in fact protected by copyright because EU copyright law protected only subject matter which was ‘original in the sense that it is its author’s own intellectual creation’.<sup>6</sup> Football matches could not be works because these ‘are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright’.<sup>7</sup>

What are ‘the rules of the game’ and is the Court correct that they exhaust the possibilities of action to such an extent that they preclude ‘creative choices’? The ‘rules of the game’, which are often said to derive historically from rules adopted by the English Football Association as long ago as 1863,<sup>8</sup> have since 1886 been under the aegis of the International Football Association Board.<sup>9</sup> The rules are structured around seventeen ‘laws’. Some of the rules are constitutive; some regulatory (defining, for example, what happens if the rules are breached).<sup>10</sup> Do

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5. ECLI:EU:C:2011:631.

6. *Ibid.*, [97].

7. *Ibid.*, [98]. Cf. Opinion of Advocate-General Wathelet, 25 July 2018, case C-310/17, ECLI:EU:C:2018:618, *Levola Hengelo BV v. Smilde Foods*, [19] (‘Sporting events, as such, lack originality. The issue of whether sporting events constitute (non-original) “works” has not been examined by the Court.’)

8. Tony Collins, *How Football Began* (Routledge, London, 2018) (exploring the multiple ‘codes’ of football, the attempts to develop universal rules in 1863 and their short-term failure). The 1863 rules, in many respects, were more like rugby football than the association football of today. See Gavin Kitching, ‘The Origins of Football: History, Ideology and the Making of “The People’s Game”’, 79 *Historical Workshop Journal* (2015), 127 (explaining that the game we now call ‘association football’ would be unrecognisable to the men who met in 1863). Many of the rules that today would be said to distinguish ‘association football’ such as the prohibition of handling (except by a designated goalkeeper) and a scoring area (goal) with an upper height limit were adopted over the next decade.

9. IFAB, *The Rules of the Game 20/21* at <https://static-3eb8.kxcdn.com/files/document-category/062020/fXHLhQuMmtekmfe.pdf>

10. Cesar R Torres, ‘What counts as part of a game? A look at skills’, 27 *Journal of the Philosophy of Sport* (2002), 81–92.

these rules 'leave no room for creative freedom for the purposes of copyright' as the Court states?

The strongest case that creativity is constrained by the rules of the game can probably be made in relation to the penalty kick, the rules for which are embodied in Law No. 14, which operates largely as a regulatory rule to punish offences.<sup>11</sup> The penalty kick was introduced in 1891, in response to the perceived unfairness of a number of goal-line handball incidents, and subsequently modified in 1902.<sup>12</sup> Today there are six key features of the Law: the ball must be placed on the penalty spot (a spot twelve yards from the goal); the taker must be identified; the goalkeeper must be on the goal line between the goalposts facing the kicker until the ball has been kicked; all other players must be on the pitch but outside the penalty area and ten yards from the penalty spot (an area demarcated since 1923 by the so-called 'D'); the taker must play the ball forward; the taker must not touch the ball again unless another player has touched it.

As most readers know, in the vast majority of cases, the taker simply kicks the ball towards the goal, attempting to minimise the opportunities for the goalkeeper to stop the shot. In such situations, the taker faces an initial choice: whether to attempt to control the shot and determine its precise trajectory towards some part of the goal that the goalkeeper cannot reach (to 'place it'), or rather to sacrifice control for power and hit the ball so hard the goalkeeper will be unable to react in time and deflect the ball away from the goal (to 'blast it'). If the taker chooses to place the shot, they face at least five choices – whether to shoot to their left or their right, to the top or bottom corner, or instead to shoot in the centre (anticipating that the goalkeeper will have dived left or right).<sup>13</sup> Similar choices face a player 'blasting' the ball, though precision may be less important. Whatever the basic choice, the kicker also faces further decisions as to run up and presentation, as the player may wish to disguise any visual cues that might otherwise assist the goalkeeper's decision as to whether, and if so where to dive.<sup>14</sup> None of these choices can be said to be dictated by the rules of the

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11. Both the English and Dutch have a difficult relationship with penalties, particularly the 'penalty shoot out' that were introduced to decide international fixtures. On the Dutch experience, see David Winner, *Brilliant Orange: The Neurotic Genius of Dutch Football* (Bloomsbury, London, 2001), 239–251.
12. However, at this stage there was no penalty 'box', the rules merely requiring that 'a line defining six yards from the goal posts and twelve yards from the goal lines shall also be marked out' and rule 13 specifying that 'If any player shall intentionally trip or hold an opposing player, or deliberately handle the ball, within twelve yards from his own goal-line, the referee shall, on appeal, award the opposing side a penalty kick, to be taken from any point twelve yards from the goal-line.' The penalty box and penalty spot were introduced in 1902.
13. Dennis Bergkamp with David Winner, *Stillness and Speed: My Story* (Simon & Schuster, London, 2014), 206 (describing his routing as 'I pick my corner ... after I walk back from the spot ... [I] put the ball down, walk back, then decide.')
14. Andrew Hunter et al., 'Anticipating the Direction of Soccer Penalty Shots Depends on the Speed and Technique of the Kick', 6(3) *Sports* (2018), 73 (suggesting that the more visual cues are offered the faster the player kicks the ball); Andrew Hunter et al., 'Behaviors of shooter and goalkeeper interact to determine the outcome of soccer penalties', 28(12)

game, but neither could it be said that they are creative.<sup>15</sup> That is not to say they are easy choices. As the Dutch footballing legend Johan Cruijff observed, ‘The thing is that a penalty seems to be very easy, which is why it’s very difficult.’<sup>16</sup>

The execution of a penalty in this way undoubtedly involves skill (as well as composure),<sup>17</sup> but skill is insufficient to give rise to copyright in the European Union. In *Football Dataco v. Yahoo! UK*,<sup>18</sup> in which the CJEU was asked whether football fixture lists are protected by copyright, it ruled that the fact that the production required ‘significant labour and skill of its author... cannot as such justify the protection of it by copyright ... if that labour and that skill do not express any originality’.<sup>19</sup>

That said, there may still be room for creative choices – and thus originality – even with penalties. Indeed, social media is replete with collections of ‘unusual’ penalty kicks.<sup>20</sup> These collections typically include the audacious chip off the underside of the cross bar executed by French captain Zinedine Zidane in the World Cup Final in Berlin between Italy and France on 9 July 2006 (a final that France lost, and for which Zidane is usually remembered for being sent off); and the backheel by the 21-year old Emirati player Theyab Awana in a 6–2 victory for the UAE against Lebanon, 2011.<sup>21</sup> They also usually include a penalty taken by Cruijff (known internationally as Johan Cruyff), who has been described as ‘perhaps the most original of all football’s global superstars’.<sup>22</sup> When playing for Ajax against Eredivisie newcomers Helmond Sport in 1982, Cruijff elected not to shoot directly at goal at all. Instead, the Dutch maestro passed the ball to his left, where the ball was collected by his team-mate, Jesper Olsen, and, as the goalkeeper approached Olsen returned the ball to Cruijff who, having stayed

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*Scandinavian journal of medicine & science in sports* (2018), 2751 (suggesting that attempts at deception did not improve the success rate).

15. Detailed modelling and statistical analyses have been done, one of the more surprising conclusion of which is that shots to the top left corner seem to have the highest chance of success: [https://instatsport.com/football/article/penalty\\_research](https://instatsport.com/football/article/penalty_research) (accessed 25 February 2021). The Dutch have their own ‘penalty professor’ Gyuri Vergouw, author of *Strafschop: Zoektocht naar de ultieme penalty*, supposedly distributed to the entire Dutch team in 2004.
16. Frits Barend and Henk van Dorp, *Ajax Barcelona Cruyff. The ABC of an Obstinate Maestro* (translated by David Winner and Lex van Dam) (Bloomsbury, London 1999), 60.
17. Pim Doesburg and Edwin van der Sar, quoted in Winner, *supra* note 11, at 246 (referring to the ‘craft, skill, expertise [and] technique’ involved in taking penalties).
18. CJEU, 1 March 2012, case C-604/10, ECLI:EU:C:2012:115, *Football Dataco Ltd and Others v. Yahoo! UK Ltd and Others*.
19. *Ibid*, [42]. See also Spanish Supreme Court (Civil Section), 16 February 2021, 82/2021, *Miguel Ángel Perera Díaz v. Copyright Registry of Extremadura*, p. 13, [6] (‘in bullfighting, two aspects stand out that escape protection as a work of intellectual property: the technique and skill of the bullfighter’).
20. E.g. ‘Top 20 Famous Penalty Kicks’, at <https://www.youtube.com/watch?v=rse3iZxrphk> (accessed 25 February 2021 which includes the kicks by Zidane, Awana and Cruijff that are discussed in this paragraph); and ‘9 Most Unforgettable Penalty Kicks in Football History’, at <https://www.youtube.com/watch?v=F5n1h7ul9Mg> (accessed 25 February 2021) (includes Zidane, Awana).
21. Awana died in a car crash two months later.
22. David Winner, ‘Translator’s Note’, in Barend and van Dorp, *supra* note 16, at iv.

behind the ball and thus onside, scored into the undefended goal. The unexpected execution required an understanding of the breadth of what was possible within the rules of the game and its success depended both on the execution of basic skills and on the opponents being caught off-guard. However, it also comprised choices both by Cruijff and Olsen that can hardly be said to be anything other than 'creative'.

If it is right that even a penalty can be taken in a 'creative' way, it seems clear that the Court of Justice was simply wrong to say the rules of the game leave no room for creative choice. As Gavin Kitching explains:

Rules provide games with an objective to achieve ('win by scoring more goals than the opposition'), but in regard to play their role is primarily negative. They say what cannot be done, what is foul or illegal, but they say nothing about what can be done, what constitutes good or effective play.<sup>23</sup>

The rules certainly leave room for a huge amount of variation and unpredictability; if it were otherwise, it would be difficult to comprehend how the sport had 3.5 billion fans (more than any other) and revenue, in Europe alone, of EUR 29 billion.<sup>24</sup> If football is to be excluded from potentially falling within the subject of copyright, an explanation must be found elsewhere.<sup>25</sup>

### 3. AN ALTERNATIVE BASIS FOR EXCLUDING FOOTBALL FROM COPYRIGHT'S DOMAIN: THE PROBLEM OF CHEESE

Perhaps the most obvious way to exclude football from copyright protection would be to hold that it falls outside the domain of copyright – football is not within what Article 2(1) of the Berne Convention refers to as 'the literary, scientific and artistic domain'.<sup>26</sup> This, I think, is Hugenholtz's preferred solution. However, in *Levola Hengolo*,<sup>27</sup> in response to a reference from the Court of Appeal Arnhem–Leeuwarden concerning the protectability of the taste of a spreadable cream cheese mixed with herbs (known in the Netherlands as 'Heksenkaas' or

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23. Kitching, *supra* note 8, 143.

24. <https://worldpopulationreview.com/country-rankings/most-popular-sport-by-country>; Deloitte, *Home Truths: Annual Review of Football Finance* (June 2020) 8 (accessible at <https://www2.deloitte.com/uk/en/pages/sports-business-group/articles/annual-review-of-football-finance.html>) (stating the 2018/19 season totalled EUR 28.9 billion).

25. In Spanish Supreme Court (Civil Section), 82/2021, (16 February 2021), *Miguel Ángel Perera Díaz v. Copyright Registry of Extremadura*, the initial rejection from registrability of the bullfight as a copyright work was based on the existence of rules, but the Supreme Court did not base its affirmation on this ground.

26. Stef J. van Gompel, 'Creativity, Autonomy and Personal Touch: A Critical Appraisal of the CJEU's Originality Test for Copyright', in Mireille M.M. van Eechoud (ed.), *The Work of Authorship* (Amsterdam University Press, Amsterdam, 2014), 95 (106) ('it makes sense to exclude sports from the copyright domain altogether', citing Jaap Spoor, D.W. Feer Verkade and Dirk J.G. Visser, *Auteursrecht: auteursrecht, naburige rechten en databankenrecht*, (3rd edn., Kluwer, Deventer, 2005), 127).

27. CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, *Levola Hengolo BV v. Smilde Foods BV*.

‘Heks’nkaas’, meaning Witches’ cheese),<sup>28</sup> the CJEU declined to rely on such reasoning to establish that such tastes were inappropriate subject matter. Instead, having referred to Article 2(1) of the Berne Convention, the CJEU identified only a single limiting criterion therein: that creations should be identifiable with clarity and precision. What the CJEU did not say, as it might easily have done, was that tastes were not within the literary, scientific and artistic domain. Had it done so, similar reasoning would have provided a mechanism by which to exclude sporting events from the field of copyright.

While the requirement of a ‘precise and objective form of expression’ was a sufficient basis for the conclusion that a taste is unprotected,<sup>29</sup> it implies the opposite outcome with respect to football matches. Of course, the *aesthetic appreciation* of a football match, like that of taste or design,<sup>30</sup> may vary from one person to another.<sup>31</sup> However, in contrast with taste, the incidents that comprise such a match are capable of being understood with a high level of certainty.<sup>32</sup> Football concerns connected movements of bodies and ball across physical space; these movements can be recorded and analysed as objective facts.<sup>33</sup>

#### 4. IDEAS AND EXPRESSION IN FOOTBALL: TRICKS, TURNS AND STRATEGIES

Might football games instead be excluded from copyright as ‘ideas’? The CJEU has recently recognised that ideas are indeed unprotected by EU copyright. In case C-833/18, *Brompton Bicycle*,<sup>34</sup> the Court noted that:

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28. The Court included Bernt Hugenholtz.

29. CJEU, *supra* note 27, [42] (‘the taste of a food product will be identified essentially on the basis of taste sensations and experiences, which are subjective and variable since they depend, *inter alia*, on factors particular to the person tasting the product concerned, such as age, food preferences and consumption habits, as well as on the environment or context in which the product is consumed.’)

30. CJEU, 12 September 2019, case C-683/17, ECLI:EU:C:2019:721, *Cofemel – Sociedade de Vestuário SA v. G-Star Raw CV*, [53], (‘the aesthetic effect that may be produced by a design is the product of an intrinsically subjective sensation of beauty experienced by each individual who may look at that design.’)

31. On the distinction between the purist and the partisan supporter, see Stephen Mumford, *Watching Sport: Aesthetics, Ethics and Emotion* (Routledge, 2011), Ch 2. Mumford claims, at 9, that the purist and partisan ‘see a different game, even when they are present at the same event’.

32. Spanish Supreme Court (Civil Section), 16 February 2021, 82/2021, *Miguel Ángel Perera Díaz v. Copyright Registry of Extremadura*, where the Spanish Supreme Court held the original and expressive elements of a bullfight could not be identified with sufficient clarity and precision to constitute a copyright work. However, it is not at all obvious why it reached this conclusion, given that the bullfight was recorded.

33. Indeed, the English Court of Appeal has held that these are data that can be collected into a database: English and Welsh Court of Appeal, 6 February 2013, [2013] EWCA Civ 27, *Football Dataco Ltd v. Sportradar GmbH* (in which the Court of Appeal discusses Mark Davidson and P. Bernt Hugenholtz ‘Football Fixtures, Horseraces and Spin-offs; The ECJ Domesticates the Database Right’ [2005] E.I.P.R. 113 (considering what constitutes pre-existing data)).

34. CJEU, 11 June 2020, ECLI:EU:C:2020:461, *SI and Brompton Bicycle Ltd v. Chedech / Get2Get*.

copyright protection does not extend to ideas. Protecting ideas by copyright would amount to making it possible to monopolise ideas, to the detriment, in particular, of technical progress and industrial development.<sup>35</sup>

The Court tells us categorically that copyright should not protect technical ideas, and offers some reasons why. But it has yet to explain how we identify when something is an idea, and when it is expression.

According to Bernt Hugenholtz, the idea/expression dichotomy does ‘not have intrinsic normative meaning’ but is a ‘mere legal instrument … for the courts to distinguish between what should be protected and what not’.<sup>36</sup> While that might suggest that a court that was reluctant to protect a football game could invoke the exclusion of ideas, that normative openness is probably not limitless. It would probably only exclude particular manoeuvres and styles of play.

The ordinary meaning of ‘idea’ would seem to exclude from protection a simple routine such as the Cruijff–Olsen penalty: indeed Cruijff himself described it as ‘an original idea’.<sup>37</sup> However creative it was, it is still open to all other players to decide to pass the ball rather than shoot.<sup>38</sup> The emphasis of the CJEU in *Brompton* on the significance of the exclusion of ideas from copyright for technical progress suggests that this also implies that the exclusion of ideas would preclude copyright protection from inventions in techniques such as the ‘Cruijff turn’. First brought to public attention in the Netherlands 0–0 draw with Sweden in the 1974 World Cup finals in Germany,<sup>39</sup> the Cruijff turn has become a classic trick in which a player with the ball who is being pressed by a defender feigns to pass the ball and instead drags the ball in the opposite direction with the inside of the foot, the player then turning 180 degrees to continue with the ball.<sup>40</sup> Cruijff himself described the turn as ‘a physical response to a flash of the brain’, which might imply it was intuitive rather than creative. Whether it is creative or not, it would almost certainly be regarded as just ‘an idea’. It has been copied many times, and recognising any exclusivity in such a move would undoubtedly impede the ‘technical progress’ of the game.

It seems, too, that a ‘style of play’ would not be treated as subject matter of copyright. In his exploration of Dutch football, *Brilliant Orange: The Neurotic*

35. *Ibid.*, [27].

36. Hugenholtz, *supra* note 2, at 42, (referring to his doctoral thesis, P.B. Hugenholtz, *Auteursrecht op informatie* (Kluwer, Deventer, 1989)).

37. J. Cruyff, *My Turn*, (trans. Shaun Whiteside) (Pan MacMillan, London, 2016), 100.

38. When the routine was replicated by Robert Pires and Thierry Henry for Arsenal against Manchester City on 22 October 2005, the execution was defective: Pires was the designated taker and fluffed the pass, barely moving the ball; Law 14 only permitting the taker one touch, the City defenders were able to close down the play before Henry could reach the ball. Thankfully, Arsenal won 1–0. Highlights of the game can be watched on <https://www.youtube.com/watch?v=5BkEifb0xG4> (accessed 24 February 2021).

39. This can be viewed at <https://www.youtube.com/watch?v=U1k7DGqRF5g> (accessed 25 February 2021).

40. Or, as Cruijff himself explained ‘in a forward motion, I drag the ball behind my supporting leg, turn my body away immediately and sprint towards the ball’: Cruyff, *supra* note 37, at 56.

*Genius of Dutch Football*,<sup>41</sup> David Winner seeks to understand the rise of a particular style of play developed in the Netherlands during the 1960s and 70s (and particularly at Ajax under manager Rinus Michels) and described as *totaalvoetbal* ('total football').<sup>42</sup> Winner situates the emergence of this paradigm as to how to play football within a range of influences, particularly those of art and architecture. Winner claims that total football reconceived the game as one not merely about power, athleticism or technique but as primarily about space. Winner makes out his case, in part, by interviewing experts in the field of these arts. For example, he cites Rudi Fuchs, director of the Stedelijk Modern Art Museum in Amsterdam, explaining that the pioneer exponent of total football, Johan Cruijff, 'seemed to see football as a total movement of the whole field, not as individual actions in only one part of it'.<sup>43</sup> To similar effect, Ron Ruurs of the Amsterdam Art History Institute recognised Dennis Bergkamp as 'certainly a great artist. It is to do with his use of space'.<sup>44</sup> While, as Winner argues, this vision of how to play football may have emerged in the Netherlands 'because for centuries [the Dutch] have had to think innovatively about space in every other area of their lives',<sup>45</sup> it was soon adopted elsewhere. The possibility that such a strategy might be held exclusively by any single person is unthinkable. '*Totaalvoetbal*' is an unprotectable idea.

Although particular tricks and approaches to play are excluded from copyright protection as 'ideas', there are many passages in football games that involve a series of creative choices that cannot as readily be reduced to (and excluded from protection as) ideas. Total football is certainly an idea; but moves developed while playing within that style are more obviously characterised as expression. An example of such a team move,<sup>46</sup> hardly reducible to an idea, is Jack Wilshere's 'goal of the season' of 2013–2014,<sup>47</sup> scored in a match between Arsenal and Norwich City. The play leading to the goal involved a series of nine increasingly intricate passes (Wilshere–Gibbs–Cazorla–Wilshere–Cazorla–Giroud–Wilshere–Giroud–Wilshere) to thread the ball past Norwich's midfield and defence, followed by a dinked finish by Wilshere from the six-yard box. Arsenal's then manager, Arsène Wenger described it as 'near perfection': 'it combined speed

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41. *Supra* note 11.

42. Further consideration of 'total football' can be found in Ric Jensen, 'Looking at the extraordinary success of the "Clockwork Orange": examining the brilliance of total football played by the Netherlands', 15(5) *Soccer & Society* (2014), 720–731.

43. Winner, *supra* note 11, at 58.

44. Winner, *supra* note 11, at 60

45. Winner, *supra* note 11, at 47.

46. When Arsenal signed left back Kieran Tierney from Celtic in 2019, he explained that this was because 'they play total football, the way I like to play': Simon Collings, 'Tierney: I joined Arsenal to play total football', *Evening Standard*, 4 October 2019.

47. *Arsenal v. Norwich* (19 October 2013). It is included, alongside magical goals by Rosicky and Ramsey on this short video: <https://www.youtube.com/watch?v=JhZgLtOP3LQ> (accessed 25 February 2021). It was voted the best goal for the five-year period 2012–2017: <https://www.bbc.co.uk/sport/football/40710224>

and calmness, improvisation and technique ... [It] was exceptional'.<sup>48</sup> Former table-tennis player turned journalist, Matthew Syed described the goal as 'not about individual skill ... Rather, it was about the co-ordination of actions and a (literal) sense of unity emerging from the disparate parts. Football teams that combine effectively also begin to articulate a new language'.<sup>49</sup> Another sports journalist, Michael Calvin, called it a 'goal of geometric grace, lacerating speed, and compelling innovation'.<sup>50</sup> This is an example of elaborated decision making that one would struggle sensibly to label as an idea.

## 5. COPYRIGHT AND PRECONCEPTION: WHAT WENT ON IN BERGKAMP'S MIND?

Are there other legal mechanisms to exclude football from copyright? Synodinou has suggested that football is not protected by copyright because it does not satisfy the requirement of authorship.<sup>51</sup> The Court of Justice has not, as yet, ruled that authorship is an 'autonomous concept of European Union law',<sup>52</sup> but she argues that there is an indissociable relationship between the notion of 'works', 'originality' and 'authorship' reflected in the very standard of the 'author's own intellectual creation'. Significantly, for our purposes, she elaborates that authorship is an exercise of 'creative will' which involves preconception of expression. This, she argues, is the real reason why sports events, such as football games, fall outside the protection of copyright.<sup>53</sup>

I have two significant doubts about Synodinou's claim. The first relates to the desirability of a requirement of creative will of the sort she proposes; the second to whether such a requirement would in practice exclude football from copyright protection.

First, while I accept that it is a small jump from the references to 'creative freedom' and 'creative choices' in the existing jurisprudence on originality to 'creative will', it is a leap I am uncomfortable with. My concern is that this instates

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48. Quoted in Michael Calvin, 'Giroud's unselfish support helps Arsenal stars to shine', *The Independent*, 21 October 2013; and Michael Calvin, 'Wilshere inspires a day of magic that even has Wenger smiling – and fans dreaming', *The Independent on Sunday*, 20 October 2013.

49. Matthew Syed, 'Team Effort Wins Football's Beauty Contest', *The Times*, 30 October 2013.

50. Calvin, *supra* note 48. In Michael Calvin, 'Wilshere inspires a day...', *supra* note 48, Calvin claimed the goal 'enshrined a philosophy and distilled a lifetime's devotion to football's finer qualities. It flowed from deep in their half through one man, Jack Wilshere, but it was a team effort, a gem of speed, synchronicity and skill.'

51. Tatiana-Eleni Synodinou, 'The Concept of Work in European Copyright Law: Past, Present and Future', University of Cyprus, 16 December 2020 (streamed live online). I am grateful to Synodinou for sharing her slides with me.

52. While there are indications that in certain context authorship is left to Member States (e.g. Database Directive, Art 4(1) allowing the legislation of Member States to designate a legal person as author of a database), Synodinou argues that these specific provisions indicate that, in general, authorship is a harmonised concept within the European Union.

53. To be fair to Synodinou, her chief concern is how far copyright law protects the products of artificial intelligence.

an individualist romantic author at the centre of European Union copyright law and thus is likely to marginalise collaborative, improvised and spontaneous creativity. This critique has been previously elaborated in relation to existing US jurisprudence, *inter alia*, in the work of Peter Jaszi and Martha Woodmansee and does not require repeating here.<sup>54</sup> The most obvious example of creative productions that would be threatened by such a prerequisite is improvised jazz music.

Second, were the CJEU to elaborate a notion of authorship that demands a level of preconception, I am not sure that this, of itself, would exclude football. To return to the example of 'penalty kicks' (as well as free kicks, corners and other 'set pieces'), it seems clear there is frequently a high level of preconception, and very frequently a single creative will (the penalty taker or possibly the coach). To any football supporter, it would be perverse to offer protection to such set-pieces but to deny it to improvised moves involving large numbers of players in free-flowing movement.

Much, of course, depends on how far one understands the notion of 'preconception'.<sup>55</sup> If it requires detailed pre-planned choreography, of the sort that a dance instructor or American football coach might present, then such a requirement inevitably excludes the genuinely spontaneous improvisation of football players. But even what appears as 'spontaneous improvisation' will often be the outcome of explicit conversations and unarticulated understandings developed between players in training. Compare, for example, the Jack Wilshere goal with Tomas Rosicky's goal against Sunderland a few months later in the 2013–2014 season (Arteta–Cazorla–Wilshere–Rosicky–Cazorla–Wilshere–Rosicky–Giroud–Rosicky).<sup>56</sup> Although the play is on the right hand side of the pitch, and involved different players than those in the Wilshere goal,<sup>57</sup> there are remarkable similarities such that one feels fairly certain the players did possess a common plan to pass the ball in a series of 'one-twos' through the opposition defence and right into the six-yard box.

In that respect, it is important to understand that 'preconception' is precisely one of the facilities that great football players are understood to possess. Consider, for example, Dennis Bergkamp's goal for Arsenal against Newcastle,<sup>58</sup> voted by

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54. 'On Recovering the Collectivity', in Martha Woodmansee and Peter Jaszi, *The Construction of Authorship: Textual Appropriation in Law and Literature* (Duke U.P., Durham, NC, 1994).
55. P. Bernt Hugenholtz, 'De Endstra Tapes', *Ars Aequi* (November 2008), 1 (4), for example, demands only the existence of 'an idea': 'an idea (plan, concept) precedes every creation. Without that idea, which guides creation, there is no work, only unprotected human communication.'
56. <https://www.youtube.com/watch?v=bU2dQMz1FF0>
57. Cazorla and Wilshere were both involved and the much maligned Olivier Giroud has a similar role in both goals. The similarities are recognised in David Hytner, 'Tomas Rosicky scores in Arsenal Win over Sunderland and agrees new deal', *The Guardian*, 23 February 2014.
58. *Arsenal v. Newcastle*, 2 March 2002. According to George Caulkin, the goal 'almost defied logic and humdrum description' ('Bergkamp leads below strength Arsenal to peak of excellence', *The Times*, 4 March 2002) so should be viewed repeatedly on <https://www.youtube.com/watch?v=licmCu47pMo> (accessed 25 February 2021).

BBC viewers in 2017 as the best Premier League goal and by Arsenal fans in 2013 as the best ever.<sup>59</sup> Bergkamp initially received the ball in the middle of his own half from Patrick Vieira and passed to Robert Pires on the left wing at about the halfway line; Pires carried the ball twenty yards and spotting that Bergkamp had sprinted forty yards to the edge of the Newcastle penalty area, Pires fed a low hard pass, travelling perhaps twenty or twenty-five yards, arriving slightly behind Bergkamp; in a single move Bergkamp flicked the ball with the outside of his right foot towards goal and out of reach of the Newcastle defender Nicos Dabizas, while turning round the other side of Dabizas to collect the spinning ball a few yards closer to goal; at that point, facing just the goalkeeper, Bergkamp calmly passed the ball into the right bottom corner of the Newcastle goal. It is, by any standard, a remarkable goal. Former Arsenal striker and football pundit, Ian Wright who had played with Bergkamp, exclaimed:

The touch! The turn! They should slow that goal down with some classical music and put it in a museum. Yeah! And make people see that it's a real bit of poetry in motion.<sup>60</sup>

According to David Winner, 'it was the divine spark where muscle memory and imagination and split-second creativity all combined and produced something new and breathtaking'.<sup>61</sup>

I don't think there is any doubt that football watchers would call Bergkamp the author of that goal. But was he, in Synodinou's terms, the 'creative will'? Was the move 'preconceived'? Of course, as Bergkamp himself explained, it wasn't preconceived in the sense that when he got on the coach to Newcastle he had planned to score a goal like that.<sup>62</sup> But he certainly 'meant it' in the sense that faced with the situation, Bergkamp had decisions to make; choices about whether to control the ball; to pass it to others in a better position; or to try and develop an opportunity himself; and having decided on the latter, how to get the ball and himself round Dabizas; and finally, what to do when he collected the ball. Moreover, on being reminded, Bergkamp acknowledged he had previously done something very similar in training. If preconception is satisfied when someone means something in a fluid and developing situation, then Bergkamp's goal was a preconceived act of creative choice. As teammate Thierry Henry observed of Bergkamp, 'most of his goals he thought about before he received the ball'.<sup>63</sup> Football journalist Alex Hayes wrote in *The Independent*:

If F Scott Fitzgerald is right when he says that genius is the ability to put into effect what is in your mind, then Dennis Bergkamp must qualify twice over. Once for being able to execute the plans, but also for having

59. <https://www.bbc.co.uk/sport/football/40710224>.

60. Bergkamp with Winner, *supra* note 13, at 218.

61. Tom Adams, 'A Beautiful Mind: Dennis Bergkamp's Perfect Moment', (published [https://www.eurosport.co.uk/football/premier-league/2016-2017/a-beautiful-mind-dennis-bergkamp-s-perfect-moment\\_st06075276/story.shtml](https://www.eurosport.co.uk/football/premier-league/2016-2017/a-beautiful-mind-dennis-bergkamp-s-perfect-moment_st06075276/story.shtml) (accessed 26 February 2021)).

62. Bergkamp with Winner, *supra* note 13, at 220.

63. *Ibid.*, at 219.

the audacious ideas in the first place. What, for example, possessed the Dutchman to attempt one of the most daring moves ever witnessed on a football pitch against Newcastle United last March?<sup>64</sup>

David Winner analogises it to improvisation by actors when filming:

It is a moment of supreme human creativity. I would put it on a level with a great piece of music or a great piece of cinema. James Stewart, one of my favourite actors, talked in an interview once about how the point of doing movies was that every so often you had these moments, sublime moments, breakthrough moments, where nobody has planned it. Film is very considered and planned but the things that are really extraordinary happen in front of camera when nobody knew they were going to happen. Like Robert De Niro doing his 'you talking to me?' speech; that's not in the script, he just did it. There's an ecstasy of the moment somehow that comes in; when very talented geniuses are in their peak moments, this is what can happen.

## 6. CONCLUSION

This essay suggests that, as yet, the Court of Justice has not offered a coherent reason to think football games – or at least, some parts of many football games – are excluded from EU copyright law. Criticising the judgment of the Hoge Raad in the *Endstra* case that recognised the possibility of copyright in a casual conversation,<sup>65</sup> Hugenholtz bemoaned the failure of the Court to consider whether copyright protection was justified, asking:

Is er werkelijk een cultureel of ander algemeen belang gemoeid met de bescherming (door een langlopend exclusief recht) van normale menselijke conversatie?<sup>66</sup>

One might ask the same question about football: is there really a cultural or other public interest involved in the protection (by a long-term exclusive right) of parts of football games?

Certainly, today, there is no economic need to recognise such protection. Broadcasts are protected by neighbouring rights; and clubs already benefit from huge broadcasting revenues as a result of exclusive control deriving from land ownership in stadia and contractual arrangements with broadcasters.<sup>67</sup> One would not expect the economic organisation of football to alter were football declared a copyright work: clubs would insist that players (coaches, managers and any

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64. Alex Hayes, 'Interview Dennis Bergkamp – "I believe this Arsenal side have rewritten all the rules"', *The Independent*, 9 February 2003.

65. Hoge Raad, 30 May 2008, ECLI:NL:HR:2008:BC2153, *Endstra*.

66. Hugenholtz, *supra* note 55, at 4.

67. In 2018/19, broadcasting revenues for the English Premier League amounted to EUR 3.45 billion, 59% of club income (compared with 13% from ticket sales): Deloitte, *supra* note 24, at 9.

potential ‘authors’) cede any such copyrights to them,<sup>68</sup> and in turn would, as now, make further exclusivity arrangements with broadcasters.

The consequence might be different, however, were there no broadcasting rights or rights in first fixations on film (as Bernt Hugenholtz has recently recommended).<sup>69</sup> Were that the case, the exclusivity afforded to broadcasters would depend, in part,<sup>70</sup> on copyright in the games themselves. In other words, the protection of broadcasters and generation of broadcasting revenues would require the existence of creative passages of play. In turn, one would expect a certain reorientation of football itself to maximise the frequency of passages of creative play (or at least ensure there was at least one such passage in every game). Finance would depend on, and thus likely promote, the creative quality of the game. Reflecting on the relationship between football and finance, Cruijff declared in 2000, ‘the first goal of football must be the quality of the game’.<sup>71</sup> If neighbouring rights were abolished, it might be that recognising copyright in creative passages of football would help to ensure that the primary goal of professional football becomes the quality of the game.

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68. As Stef van Gompel notes, *supra* note 26, at 106, were football games protected by copyright there would be ‘the thorny question of authorship. Who qualifies as “author” of football matches? (The players, captain, technical staff, the coach, one team, both teams, all of the above?)’ As with film, however, transfers of rights would become almost automatic.

69. P. Bernt Hugenholtz, ‘Neighbouring Rights are Obsolete’, 50 *IIC* (2019), 1006. For specific criticism of the economic case for broadcaster rights, see P. Bernt Hugenholtz, ‘The WIPO Broadcasting Treaty: A Conceptual Conundrum’, *EIPR* (2019), 199 (200–201).

70. Of course, broadcasters might claim protection, as they did in *FAPL*, via ancillary matter; or, they might make a claim that a broadcast is itself a cinematographic work: see Hugenholtz, ‘The WIPO Broadcasting Treaty’, *supra* note 69, at 202.

71. Johan Cruyff, ‘Foreword’, in Sean Hamil et al. (eds.), *Football in the Digital Age. Whose Game is it Anyway?* (Mainstream, Edinburgh, 2000), 9.



# How Football Changed Copyright Law: Public Performance, Communication to the Public and the Free Public Showing of Broadcast Films

*Christina Angelopoulos*

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## 1. INTRODUCTION: COPYRIGHT AND FOOTBALL

Professor Bernt Hugenholtz is a well-known fan of football. He is also very knowledgeable about copyright. Sadly for the author of this contribution, she does not know much about football. She has however gathered some knowledge of copyright – in no small part due to Prof. Hugenholtz’s support and encouragement. Inspired by his leading work on EU copyright law and kicking off from a football-related case, this contribution deals with issues that have been central to Prof. Hugenholtz’s research: the European harmonisation of copyright,<sup>1</sup> the right of communication to the public<sup>2</sup> and defences to copyright infringement.<sup>3</sup>

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1. See, for example, P.B. Hugenholtz (ed.), *Copyright Reconstructed: Rethinking Copyright’s Economic Rights in a Time of Highly Dynamic Technological and Economic Change* (Kluwer, 2018); T. Dreier and P.B. Hugenholtz, *Concise European Copyright Law* (2nd edn., Kluwer, 2016); P.B. Hugenholtz et al., *Harmonizing European Copyright Law* (Kluwer, 2009); and ‘The Wittem Project – European Copyright Code’, available at: [https://www.ivir.nl/publicaties/download/Wittem\\_European\\_copyright\\_code\\_21\\_april\\_2010.pdf](https://www.ivir.nl/publicaties/download/Wittem_European_copyright_code_21_april_2010.pdf).
2. See, for example, P.B. Hugenholtz and S. van Veltze, ‘Communication to a New Public? Three Reasons why EU Copyright Law Can Do without a “New Public”’, 47(7) *IIC* [2016], 797 and P.B. Hugenholtz, ‘SatCab Revisited: The Past, Present and Future of the Satellite and Cable Directive’, 8 *IRIS-plus* (2009), 7.
3. See, for example, P.B. Hugenholtz and M. Senftleben, ‘Fair Use in Europe. In Search of Flexibilities’, (2011) Institute for Information Law/VU Centre for Law and Governance, available at: <http://ssrn.com/abstract=1959554>; P.B. Hugenholtz and S. van Gompel, ‘The Orphan Works Problem: The Copyright Conundrum of Digitizing Large-Scale Audiovisual

It does so from the perspective of the United Kingdom, a country which is now (but was not at the operative time) a departed EU Member State.

One of the most significant judgments for both EU and UK copyright law centres on football: *FAPL v. QC Leisure*. The case blew the whistle on the unauthorised live screening of broadcast football matches by businesses open to the public. Traditionally in the UK, such public screenings were permitted via a targeted exception to copyright. When this was first adopted, its relationship with other provisions in UK copyright law was clear. However, as the rest of UK copyright evolved under the gradual influence of EU copyright harmonisation, the consistency between the free public showing exception and the underlying rules on subject matter and infringement was weakened. This misalignment came to a head in *FAPL v. QC Leisure* and concentrated on two issues: a) the boundary between the right of public performance and the right of communication to the public and b) the definition of a 'film'.

While the first of these is widely appreciated and has been heavily discussed, the second has received less attention. Yet, as this contribution seeks to show, it was in many ways the more relevant aspect of the case. The final outcome of *FAPL v. QC Leisure* led to the expansion of EU copyright harmonisation and the amendment of UK copyright law. In the process, not only was the interpretation of the exclusive rights enjoyed by copyright owners affected, but the UK's exception for free public showings drastically amended: football has had a resounding impact on both EU and UK copyright law. At the same time, although the UK was arguably offside in its definition of 'films', it has continued to run with this.

## **2. MEET THE PLAYERS: SECTION 72(1) CDPA AND THE INTERNATIONAL TREATIES**

Section 1 of the UK's Copyright Designs and Patents Act 1988 (CDPA) recognises copyright in a closed list of eight types of works. These can be split into two categories: 'works of authorship', comprising original literary, dramatic, musical or artistic works, and 'entrepreneurial works', comprising sound recordings, films and broadcasts, and the typographical arrangements of published editions.

Sections 16–21 CDPA enumerate six exclusive rights reserved for the owners of the copyright in such works. Among these, s. 19 CDPA (the 'public performance right') restricts the performance in public of copyright in literary, dramatic and musical works and the playing or showing in public of sound recordings, films and broadcasts. Section 20 CDPA (the 'communication right') restricts the communication to the public of all works.

A number of exceptions to these rights are set out in the Act. One such exception is provided by s. 72(1) CDPA on the free public showing or playing of broadcasts. The original text of the provision, as enacted in 1988, enabled persons

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Archives, and How to Solve it', 1 *Popular Communication – The International Journal of Media and Culture* (2010), 61; N. Helberger and P.B. Hugenholtz, 'No Place Like Home for Making a Copy: Private Copying in European Copyright Law and Consumer Law', 3 *Berkeley Technology Law Journal* (2007), 1061.

other than the copyright owner to play or show television or radio broadcasts in public without seeking the authorisation of the owners of copyright in either the broadcast itself or in any sound recording or film included within it, as long as no admission fee was charged. If other copyright protected works were included in the broadcast, the permission of the owners of the copyright in those would have to be sought. This would be the case, for example, for the music and lyrics of broadcast songs or the scripts of broadcast plays.

Historically, the exception can be tracked back to the Copyright Act 1956<sup>4</sup> and aimed at avoiding the imposition on persons who ran businesses open to the public of the burden of seeking out multiple copyright licences.<sup>5</sup> In maintaining the exception in the CDPA, the UK legislator relied on the lack, at the time, of international and European rules covering the free public playing or showing of the implicated works. Indeed, the protection of the public performance of 'literary and artistic works' is mandated by Articles 11(1)(i), 11bis(1)(iii), 11ter(1)(i), 14(1)(ii) and 14bis(1)<sup>6</sup> of the Berne Convention (BC)<sup>7</sup> – thereby excluding the extension of the defence to these.<sup>8</sup> By contrast, Article 13 of the Rome Convention (RC)<sup>9</sup> only requires that the 'communication to the public' of television broadcasts be protected if it is done in places accessible to the public against payment of an entrance fee. The context makes clear that the term 'communication to the public' covers the playing or showing of broadcasts in public. Article 12 RC requires the payment of equitable remuneration to the producer of a sound recording ('phonogram' in the language of international and EU copyright law) or to the performers or to both where that recording is used for broadcasting or communication to the public – but only if the use is 'direct'. It therefore excludes rebroadcasting, as well as the playing or showing in public of a broadcast of a sound recording.<sup>10</sup> As films are not covered by the

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4. See sections 14(4) and (8) and 40(1) and (2) of the Copyright Act 1956.
5. UK Intellectual Property Office, 'A Consultation on Changes to Section 72 of the Copyright, Designs and Patents Act 1988 (Which Permits the Free Public Showing or Playing of a Film Contained in a Broadcast)', (2015), available at: <https://tinyurl.com/5vafxp7j>.
6. Art. 11(1)(i) covers the public performance of dramatic, dramatico-musical and musical works by any means or process; Art. 11bis(1)(iii) covers the communication to the public of the performance of dramatic, dramatico-musical and musical works; Art. 11ter(1)(i) covers the public recitation of literary works by any means or process; Art. 14(1)(ii) covers the public performance of cinematographic adaptations of literary and artistic works and Art. 14bis(1) establishes that cinematographic works should be treated as original works thereby protecting them against public performance following Art. 14(1)(ii).
7. Berne Convention for the Protection of Literary and Artistic Works (adopted 9 September 1886, came into force 5 December 1887) S. Treaty Doc. No. 99-27, as amended.
8. At least if the 'three-step test' established in Art. 9(2) BC is to be respected.
9. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (adopted 26 October 1961, entered into force 18 May 1964) 496 U.N.T.S. 43.
10. See E Ulmer, 'The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations – Part III', 10 *Bull Copyright Soc'y USA* (1963), 219. Ulmer explains that the more extensive protection afforded to copyright owners by the Berne Convention was a result of their persistent efforts to achieve a high level of

international copyright treaties, when first adopted s. 72(1) CDPA was fully compatible with the international treaties.<sup>11</sup>

### **3. PRE-MATCH WARM-UPS: FURTHER DEVELOPMENTS AND 2003 AMENDMENT**

Subsequent developments in both international and EU copyright law led to the need to update s. 72(1) CDPA.

In the early 1990s, the European harmonisation of copyright law started picking up speed. In 1992, the Related Rights Directive (RRD)<sup>12</sup> was adopted. Article 8(3) of this requires that Member States provide broadcasting organisations with an exclusive right over the ‘communication to the public’ of their broadcasts in places accessible to the public against payment of an entrance fee. The provision did not challenge s. 72(1) CDPA. However, Article 8(2) RRD provides a right to a single equitable remuneration to be shared between the producer and the performers for the communication to the public of a sound recording. According to Krikke, the original proposal for the Directive covered both direct and indirect use of sound recordings. Direct use was intended to refer to the use of a sound recording in a broadcast or the playing of a sound recording in public and indirect use to the rebroadcasting or the public showing or playing of a broadcast in which a sound recording was used. No restriction of the meaning was intended by the removal of these words. The right therefore goes beyond the Rome Convention to include the situations covered by s. 72(1) CDPA.<sup>13</sup>

Similar changes were brought about at the international level through the adoption in 1996 of the WIPO Performances and Phonograms Treaty (WPPT).<sup>14</sup> Article 15 WPPT requires that the producers of sound recordings be granted a right to a single equitable remuneration to be shared with performers when their sound recordings are used for broadcasting or any communication to the public. As opposed to Article 12 RC, this applies whether the use is ‘direct or indirect’. It seems that, in the context of the WPPT, the words ‘direct or indirect’ mean that both uses of original sound recordings and any reproductions are covered. This is suggested by the fact that Article 12 RC explicitly refers to such reproductions,

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protection. ‘Caution’ was instead necessary before extending a similar level of protection to the owners of related rights. Such expansion was therefore better left for a ‘later stage’.

11. Confirming that this was the UK view, see Lord Beaverbrook in Hansard HL Debate 23.2.1988, vol. 493 cols. 1191–1192, quoted by Kitchen J in *FAPL v. QC Leisure* [2012] EWHC 108 (Ch) (3 February 2012), para. 68.
12. Originally Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property [1992] OJ L 346/61. Now replaced by Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property [2006] OJ L 376/28.
13. J. Krikke, ‘Rental and Lending Directive’, in T. Dreier and P.B. Hugenholtz, *Concise European Copyright Law* (2nd edn., Kluwer, 2016), 297.
14. WIPO Performances and Phonograms Treaty (adopted 20 December 1996, entered into force 20 May 2002) S. Treaty Doc. No. 105-17 (1997).

while Article 15 WPPT does not.<sup>15</sup> Nevertheless, Article 2 WPPT confirms that ‘communication to the public’ for the purposes of Article 15 includes ‘making the sounds or representations of sounds fixed in a [sound recording] audible to the public’. Thus, the WPPT’s definition of ‘communication to the public’ appears to be broader than that of the RC.<sup>16</sup> Either way, as with Article 8(2) RRD, the playing of a sound recording in public, including through use in a broadcast, is covered.

As the producers of sound recordings already enjoyed in the UK the full range of exclusive rights available to copyright owners, Articles 15 WPPT and 8(2) RRD were not in themselves problematic for UK law.<sup>17</sup> Difficulties arose, however, for s. 72(1) CDPA. The WPPT and RRD do not include exceptions for the free playing of sound recordings incorporated in broadcasts.<sup>18</sup> The UK legislator responded with the adoption of the Copyright and Related Rights Regulations 2003.<sup>19</sup> These changed the wording of s. 72(1) CDPA to exclude its application to what were termed ‘excepted sound recordings’. A new section 72(1A) CPDA defines these as including: (a) sound recordings whose authors are not the authors of the broadcasts in which they are included; and (b) sound recordings which are recordings of music with or without words whether spoken or sung. Since this definition covers most commercially produced sound recordings, the UK legislator presumably considered that it largely coincides with that of sound recordings ‘published for commercial purposes’, as required by Article 8(2) RRD.<sup>20</sup>

#### 4. *FAPL v. QC LEISURE PLAY-BY-PLAY*

This is how matters stood when the Football Association Premier League (FAPL), the governing body of the leading football competition in England, decided to take legal action against the screening of live broadcasts of Premier League

15. M. Ficsor, *Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms* (World Intellectual Property Organization (WIPO), Geneva, 2003), paras. PPT-15.6 and 7.

16. Although the RC does not contain a definition of ‘communication to the public’, see *ibid.*

17. According to Recital 16 RRD, Member States are allowed to provide more far-reaching protection to the producers of sound recordings than that required by the Directive in respect of communication to the public. A right to equitable remuneration for the exploitation of a sound recording was thus introduced in the UK in 1996 only for performers, see s. 182D CDPA. See C. Angelopoulos, ‘Creative Commons and Related Rights in Sound Recordings: Are the Two Systems Compatible?’, in C. Angelopoulos and L. Guibault (eds.), *Open Content Licensing: From Theory to Practice* (Amsterdam University Press, 2011).

18. See Art. 16 WPPT and Art. 10 RRD.

19. See Copyright and Related Rights Regulations 2003 (S.I. 2003/2498), regs. 31–40.

20. For further information see L. Bently, B. Sherman, D. Gangjee and P. Johnson, *Intellectual Property Law* (5th edn., OUP, 2018), 280; N. Caddick, G. Harbottle and U. Suthersanen, *Copinger and Skone James on Copyright* (18th edn., Sweet and Maxwell, 2021), section 9-326. See also The Patent Office, ‘EC Directive 2001/29/EC on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society – Consultation Paper on Implementation of the Directive in the United Kingdom’, 7 August 2002, 11–12 and ‘Consultation on UK Implementation of Directive 2001/29/EC on Copyright and Related Rights in the Information Society: Analysis of Responses and Government Conclusions’, 8–10.

matches in public houses in the UK that used unauthorised – and therefore cheaper – foreign decoding devices. Among other claims, the FAPL alleged that the publicans had infringed works in which it owned copyright and which had been included in the broadcasts.<sup>21</sup>

The issue arose of whether s. 72(1) CDPA applied. The answer was different for different types of subject matter. The FAPL claimed copyright in the following works:

- A musical work in the form of the Premier League Anthem.<sup>22</sup> It was clear that either the communication right or the performance right in the Anthem had been infringed. Recognising this, the publicans offered to keep the sound muted when it was played.<sup>23</sup>
- The sound recording of the Anthem.<sup>24</sup> As opposed to the musical work, this was only relevant to the extent that it was played during the live broadcasts of the players lining up at the beginning of a match; in so far as the recording was embodied in one of the FAPL's protected films, it had to be treated as part of those films and could not find a separate claim.<sup>25</sup> Both the rights of communication to the public and of public performance potentially applied. In the case of the latter, the sound recording qualified as an 'exempted sound recording', so that s. 72(1) CDPA could not offer a defence. However, as its inclusion in the broadcast in the given circumstances was incidental, s. 31(1) CPDA meant that no infringement had occurred.<sup>26</sup>
- Artistic works in the form of graphics, devices and logos.<sup>27</sup> As s. 19 CDPA does not apply to artistic works, whether these had been infringed depended on whether the publicans had communicated them to the public.
- Various films.<sup>28</sup> Here too infringement depended on which restricted act had occurred: if there had been an act of communication to the public, there would be no defence, whereas if there had been an act of showing in public, s. 72(1) CDPA would protect the publicans from liability.

Against this backdrop, whether there had been an act of communication to the public or of public performance/playing/showing emerged as crucial. While the latter remains a matter for national law, the former has been harmonised: in addition to the aforementioned Articles 8(2) and (3) RRD on the communication to the public of sound recordings and broadcasts, Article 3(1) of the 2001

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21. CJEU, 4 October 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:631, paras. 45–47.

22. *FAPL v. QC Leisure* [2008] EWHC 1411 (Ch) (24 June 2008), para. 184.

23. *Ibid.*, para. 279.

24. *Ibid.*, para. 184.

25. See s. 5B CDPA. This has subsequently also been also recognised by the CJEU, see 18 November 2020, *Atresmedia*, C-147/19, EU:C:2020:935, para. 44.

26. *FAPL v. QC Leisure* [2008] EWHC 1411 (Ch) (24 June 2008), paras. 198–202 and 268.

27. *Ibid.*, para. 184.

28. *Ibid.*, para. 180.

Information Society Directive (ISD)<sup>29</sup> had introduced a harmonised definition for the communication to the public of works of authorship. EU copyright law therefore had to be considered. In his 2008 High Court judgment, Kitchen J noted that, according to Recital 23 ISD, Article 3(1) ISD was intended to cover ‘transmission or retransmission by wire or wireless means’ which is ‘to the public not present at the place where the communication originates’. Observing that the publicans had not retransmitted the works and that their patrons were present in the pubs where the broadcasts were shown, he expressed the provisional view that no act of communication to the public had occurred. Nevertheless, he submitted a request for a preliminary ruling to the CJEU.<sup>30</sup>

The CJEU went in the opposite direction. Relying on the ‘high level of protection’ for right-holders required by the ISD, the international treaties, the RRD and its own earlier ruling in *SGAE*,<sup>31</sup> the Court held that ‘the concept of communication must be construed broadly, as referring to any transmission of the protected works, irrespective of the technical means or process used’.<sup>32</sup> The Court recognised that the transmission must be ‘to the public not present at the place where the communication originates’, but concluded that the relevant place was ‘the place of the representation or performance which is broadcast’<sup>33</sup> – that is, the football stadium. Accordingly, the publicans’ acts fell under Article 3(1) ISD.

When the case was returned to him in 2012, Kitchen J held that the FAPL’s artistic works had been communicated to the public and therefore infringed.<sup>34</sup> The situation for films was more complicated. This was due to the peculiar status of films in UK copyright law. While EU law distinguishes between the protection of a ‘cinematographic work’ as a work of authorship and the related right of a producer in the ‘first fixation’ of a film, the CDPA only recognises a single concept of a ‘film’. While initially understood as constituting a purebred entrepreneurial right, under the influence of EU law this has emerged, according to the judge, as a hybrid that grants rights to both the producer and the principle director.<sup>35</sup> As a result s. 72(1) CDPA applied to both.<sup>36</sup> Given that the statutory definition of ‘public performance’ includes the playing or showing of a sound recording, film and broadcast in public,<sup>37</sup> the CJEU’s ruling meant that an overlap existed between ss. 19 and 20 CDPA so that the showing of such works in public would fall under both.<sup>38</sup> At the same time, as s. 72(1) CDPA covers ‘any copyright’ in ‘any film’, it provides a defence against the infringement of both exclusive rights.<sup>39</sup>

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29. Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167/10.

30. *FAPL v. QC Leisure* [2008] EWHC 1411 (Ch) (24 June 2008), paras. 255–262.

31. CJEU, 7 December 2006, *SGAE v. Rafael Hoteles*, C-306/05, EU:C:2006:764.

32. CJEU, 4 October 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:631, paras. 191–196.

33. *Ibid.*, para. 203.

34. *FAPL v. QC Leisure* [2012] EWHC 108 (Ch) (3 February 2012), para. 59.

35. *Ibid.*, para. 69. See also s. 5B and 9(2)(ab) CDPA. See also Bently et al., *supra* note 20, 129.

36. *Ibid.*, para. 70.

37. Section 19(3) CDPA.

38. *Ibid.*, para. 63.

39. *Ibid.*, para. 71.

It is worth noting that the definition of a ‘film’ in UK copyright law has long been a troubled one,<sup>40</sup> giving rise to confusion and difficulties on matters concerning subsistence,<sup>41</sup> infringement,<sup>42</sup> term of protection<sup>43</sup> and originality.<sup>44</sup> Moreover, Kitchin J’s ‘hybrid right’ approach is not unanimously held among UK judges. The alternative view is that cinematographic works are encompassed not in the CDPA’s notion of a ‘film’ but of a ‘dramatic work’, with ‘films’ corresponding exclusively to the EU concept of a ‘first fixation’.<sup>45</sup>

The inevitable result of the judge’s findings was that UK copyright law was brought out of line with the EU directives: although the EU *acquis* is silent on the communication to the public of the first fixation of films, Article 3(1) ISD requires that cinematographic works be protected against communication to the public. No rule corresponding to s. 72(1) CDPA is included in the exhaustive list of permissible exceptions to this right provided by Article 5 ISD. Moreover, the wording of s. 72(1) CDPA was clear and unambiguous, leaving little scope for an interpretation that achieved the results pursued by the ISD.<sup>46</sup> The fact that ‘excepted sound recordings’ but not films were removed from s. 72(1) CDPA in the 2003 implementation of EU copyright law confirmed the legislator’s intention that the defence continue to apply to the latter.

The Court of Appeal confirmed this outcome.<sup>47</sup> In response, the government initiated a process of revising s. 72(1) CDPA in order to bring it into line with EU law. Rather than redefine the rights of public performance and communication to the public, the UK Intellectual Property Office (IPO) decided to target the application of s. 72(1) CDPA to films. A first consultation proposed limiting the defence to producers’ rights in film fixations, as opposed to the creative (‘cinematographic’)

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40. For an in-depth analysis see A. Barron, ‘The Legal Properties of Film’, 67(2) *The Modern Law Review* (2004), 177.
41. *Norowzian v. Arks Ltd & Anor* [1999] EWCA Civ 3018. See also Bently et al., *supra* note 20, 148.
42. *Norowzian v. Arks Ltd & Anor* [1999] EWCA Civ 3018. See also Caddick et al., *supra* note 20, sections 3-252 to 3-256 and Bently et al., *supra* note 20, 85–86.
43. Bently et al., *supra* note 20, 186–187; C Angelopoulos, ‘Determining the Term of Protection for Films: When Does a Film Fall into the Public Domain in Europe?’, 2 *IRIS plus* (2012) (European Audiovisual Observatory 2012), 7–21.
44. R. Arnold, ‘Content Copyrights and Signal Copyrights: the Case for a Rational Scheme of Protection’, 1(3) *Queen Mary Journal of Intellectual Property* (2011), 272–279.
45. See obiter remarks by the following: Buxton LJ in *Norowzian v. Arks* (No. 2) [2000] F.S.R. 363, pp. 368 and 369; Arnold J in *Dramatico Entertainment v. British Sky Broadcasting* [2012] EWHC 268 (Ch), para. 63; and Arnold J in *England and Wales Cricket Board Ltd v. Tixdaq* [2016] EWHC 575 (Ch), para. 58. See also Caddick et al., *supra* note 20, sections 3-252 to 3-256, who describe this as the ‘better view’.
46. The ‘Marleasing principle’ developed by the CJEU, according to which national courts of the EU Member States must interpret national law ‘in the light of the wording and the purpose of the directive in order to achieve the result pursued by the latter’, is curtailed by the vague proviso ‘as much as possible’. See CJEU, 13 November 1990, *Marleasing*, C-106/89, EU:C:1990:395, para. 8
47. *FAPL v. QC Leisure* [2012] EWCA Civ 1708 (20 December 2012), para. 62.

aspects of film.<sup>48</sup> Upon further consideration, detangling the UK's hybrid notion of 'films' was deemed overly complicated<sup>49</sup> and the government pivoted towards proposing the complete removal of films from s. 72 CDPA.<sup>50</sup>

## 5. COMMUNICATION TO THE PUBLIC IN EU COPYRIGHT LAW: MOVING THE GOALPOSTS OR LEVELLING THE PLAYING FIELD?

The CJEU's ruling in *FAPL* has been heavily criticised. Commentators have described it as 'unnecessary',<sup>51</sup> 'erroneous',<sup>52</sup> 'faulty'<sup>53</sup> and 'incoherent'.<sup>54</sup> Gaps can certainly be identified in the Court's reasoning. Most obviously, the suggestion that a pub's patrons are not 'present at the place where the communication originates' is unconvincing. Given that the Court describes the communication at issue as 'the transmission of the broadcast works, via a television screen and speakers, to the customers present in a public house', it seems clear that those customers were exactly where the communication originated: in the pub. The Court's attempt to relocate those origins to the stadium in which the broadcast football match was played confuses the display of the broadcast *in* the pub with the transmission of the broadcast *to* the pub – which was not the act at issue in the case.<sup>55</sup>

Commentators have also argued that the qualification of the public display of a broadcast as a 'communication to the public' ignores the structures of international copyright law. These suggest that the distinction between communications to the public, i.e. to people who are geographically and/or chronologically dispersed, and communications in public, i.e. performances before gathered audiences, is baked into the treaties. This distinction conveniently corresponds to the original fields of operation of ss. 19 and 20 CDPA. Admittedly, the Berne Convention's fragmented approach to the performance and communication rights obfuscates the division. Articles 11(1)(i), 11ter(1)(i), 14(1)(ii) and 14bis(1) BC explicitly deal with rights of public performance or recitation, while Articles

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48. Intellectual Property Office, 'A Consultation on Changes to Section 72 of the Copyright, Designs and Patents Act 1988', available at: <https://bit.ly/3dlWUlv>.

49. Intellectual Property Office, 'Further Consultation and Technical Review on Changes to Section 72 of the Copyright, Designs and Patents Act 1988' (2016), available at: <https://bit.ly/39ty1mQ>.

50. The Copyright (Free Public Showing or Playing) (Amendment) Regulations 2016 (S.I. 2016/565), regs. 1 and 3(c).

51. M.F. Makeen, 'Rationalising Performance "in Public" under UK Copyright Law', 2 *IPQ* (2016), 117–134.

52. T. Aplin, 'The Impact of the Information Society Directive on UK Copyright Law', King's College London Law School Research Paper No. 2019-16, available at <http://dx.doi.org/10.2139/ssrn.3250388>.

53. J. Koo, 'The Influence of Football on the Development of the Communication to the Public Right', 41(9) *European Intellectual Property Review* (2019), 571–577.

54. *Ibid.*

55. *Ibid.*; T. Aplin, "'Reproduction" and "Communication to the Public" Rights in EU Copyright Law: *FAPL v QC Leisure*', 22(1) *King's Law Journal* (2011), 209–219. See also Opinion of AG Kokott, 3 February 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:43, para. 144.

11(1)(ii), 11bis(1)(i) and (ii), 11ter(1)(ii), 14(1)(ii) and 14bis(1) BC cover communication to the public. Confusingly, Article 11bis(1)(iii) is placed alongside two communication rights in Article 11bis BC. However, while it also uses the language of ‘communication to the public’, it clearly deals with displays before a gathered audience: those that take place *in public*.<sup>56</sup> Potentially, its strange location is due to the fact that the BC allows all three rights in Article 11bis(1) to be subject to compulsory licensing,<sup>57</sup> whereas this is not the case for Articles 11(1)(i), 11ter(1)(i), 14(1)(ii), and 14bis(1) BC.<sup>58</sup>

That Article 11bis(1)(iii) BC is not a communication right proper is also indicated by Article 8 of the WIPO Copyright Treaty (WCT).<sup>59</sup> This introduced for the first time to the international treaties a ‘general’ right of communication to the public. It opens by warning that it is ‘without prejudice to the provisions of Articles 11(1)(ii), 11bis(1)(i) and (ii), 11ter(1)(ii), 14(1)(ii) and 14bis(1) of the Berne Convention’. That Article 11bis(1)(iii) BC is not included in this ‘without prejudice’ clause confirms that, despite its wording, it does not deal with communication to the public, but with communication *in public* – i.e., public performance.

There are, however, other considerations to take into account. In *FAPL*, the CJEU suggested that, given the EU’s obligations under the WCT and TRIPS<sup>60</sup> to comply with Articles 1–21 BC, it is necessary to incorporate within the copyright *acquis* rules against public performance.<sup>61</sup> If that is the case, the ‘without prejudice’ clause in Article 8 WCT becomes less important – but the lack of a harmonised performance right emerges as problematic. In its subsequent judgment in *Circul Globus Bucureşti*, the CJEU held that live performances involving direct physical contact fall outside the scope of Article 3(1) ISD.<sup>62</sup> While the CJEU

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56. M.F. Makeen, ‘The Evolution and Scope of the Public Performance Right of Musical Works under International, US and Egyptian Laws’, 65(2) *Journal of the Copyright Society of the USA* (2018), 169–202; Makeen, *supra* note 51; Opinion of AG Kokott, 3 February 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:43, paras. 133–134; C Masouyé, *WIPO Guide to the Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971)* (WIPO, 1978), 69.

57. See Art. 11bis(2) BC.

58. Makeen, *supra* note 56.

59. WIPO Copyright Treaty (adopted 20 December 1996, entered into force 6 March 2002) S. Treaty Doc. No. 105-17 (1997).

60. Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted 15 April 1994, entered into force 1 January 1995), Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 3.

61. See CJEU, 4 October 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:631, paras. 189–190. See also Opinion of AG Kokott, 3 February 2011, *FAPL*, C-403/08 and C-429/08, EU:C:2011:43, para. 124. Cf Aplin, *supra* note 55.

62. CJEU, 24 November 2011, *Circul Globus Bucureşti*, C-283/10, EU:C:2011:772, para. 37. The judgment did suggest that Art. 3 ISD cannot cover ‘any communication of a work which is carried out directly in a place open to the public using any means of public performance or direct presentation of the work’. The reference to ‘any means’ could suggest that playing a sound recording in public would not count as a communication of any works fixated on the sound recording to the public. Later however, in *Phonographic Performance (Ireland)*, the Court confirmed that ‘communication to the public’ in Article 8(2) RRD ‘must be interpreted

cannot remedy the explicit legislative intention to omit, as revealed by Recital 23 ISD, such clear cases of public performance from harmonisation, arguably the *FAPL* approach was a necessary attempt to mitigate the situation.

Regardless, the EU is not obliged to follow the structures – as opposed to the substance – of the international framework. There is no definitive way of organising the exclusive rights of the copyright owner and different jurisdictions take different approaches.<sup>63</sup> If the EU wishes to draw the line between communication to the public and public performance elsewhere than the BC and WCT, it is free to do so, as long as the standard of protection it provides respects the international minimum requirements.<sup>64</sup> It is not unreasonable to suggest that the distinction should be dependent on the means used rather than the dispersed or gathered nature of the audience. This is particularly so given the ISD's objective of fostering information society, as well as of avoiding and remedying fragmented national responses to technological challenges.<sup>65</sup> The UK's own implementation of Article 3(1) ISD in s. 20 CDPA rests on the existence of an 'electronic' transmission. When playing a football match using a screen and speakers in a pub electric instruments are certainly used.<sup>66</sup>

Finally, it is worth noting that the language of Article 3(1) ISD in many EU Member States covers both communication to the public and communication in public,<sup>67</sup> potentially making the CJEU's *FAPL* approach a good comparative compromise. More importantly, Article 11bis(1)(iii) BC, Articles 12 and 13 RC, Article 2(g) WPPT and Article 8(2) and (3) RRD also all use the term 'communication to the public' to refer to the playing or showing of a broadcast or sound recording in public. While for a time it did seem as though the CJEU might be contemplating a different meaning of 'communication to the public' for the ISD and RRD,<sup>68</sup> such an approach would have entailed its own challenges.<sup>69</sup> It would, for example, have meant that, where a sound recording or broadcast is played in a public space, the infringement of any contained musical or literary work would be 'performed in public', and thus fall outside harmonised EU law, while the entrepreneurial work would be 'communicated to the public',

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as meaning that it also includes making the sounds or representations of sounds fixed in a phonogram audible to the public.' See CJEU, 15 March 2012, *Phonographic Performance (Ireland)*, C-162/10, EU:C:2012:141, para. 60.

63. T. Aplin and J. Davis, *Intellectual Property Law: Text, Cases, and Materials* (3rd edn., OUP, 2017), 177. One might as well argue that France is wrong for only recognising two broad rights of reproduction and performance, see Art. L122-2 of the French intellectual property code.
64. M. Senftleben, 'WIPO Copyright Treaty', in T. Dreier and P.B. Hugenholtz, *Concise European Copyright Law* (2nd edn., Kluwer, 2016), 118.
65. See Recitals 2, 5, 6 and 7 ISD. See also CJEU, 24 November 2011, *Circul Globus Bucureşti*, C-283/10, EU:C:2011:772, paras. 38–39.
66. *FAPL v. QC Leisure* [2012] EWHC 108 (Ch) (3 February 2012), para. 57. Cf the judge's initial opinion in *FAPL v. QC Leisure* [2008] EWHC 1411 (Ch) (24 June 2008), para. 261.
67. P.B. Hugenholtz et al., *Harmonizing European Copyright Law* (Kluwer, 2009), 82.
68. CJEU, 15 March 2012, *SCF*, C-135/10, EU:C:2012:140, paras, 74–77.
69. Bently et al., *supra* note 20, 158, fn 130.

so that Article 8(2) and (3) RRD applied.<sup>70</sup> The Court has since made clear that the term should retain a single meaning across the EU's law of copyright and related rights.<sup>71</sup> Such a streamlined approach makes sense. Positive consequences also result. For example, the Court's much maligned 'new public' criterion, whose introduction in SGAE arguably rests on a misunderstanding on the part of the CJEU of the difference between Article 11bis(1)(ii) and (iii) BC,<sup>72</sup> can be rehabilitated if the communication right extends into the communications in public that are its proper domain.<sup>73</sup>

## 6. POST-MATCH ANALYSIS: COMMUNICATION TO THE PUBLIC AND FILMS IN THE UK AFTER BREXIT

Where does the above analysis leave UK copyright law post-Brexit? Section 6 of the UK's European Union (Withdrawal) Act 2018 confirms that CJEU decisions handed down before 31 December 2020 continue to be binding on all UK courts except the Supreme Court.<sup>74</sup> Even the Supreme Court, in deciding whether to depart from retained EU case law, must apply the same test as it would in deciding whether to depart from its own case law.<sup>75</sup> As a result, the CJEU's *FAPL* ruling will continue to be binding UK law unless and until it is overturned by the Supreme Court. The overlap it created between ss. 19 and 20 CDPA will therefore not disappear from UK copyright law any time soon.

The amendment of s. 72 CDPA will also be long-lasting: although motivated by the need to complete the ISD implementation, it was an independent decision of the UK legislator and EU law did not dictate the specific solution adopted. The initial IPO proposal of limiting s. 72 CDPA only to producers' rights in the first fixation of their films would have arguably been a better approach. Not only would it have amounted to a better implementation of both EU and international copyright norms, but it would also have allowed the UK to maintain s. 72 CDPA as originally envisaged at a time when it was clear that UK copyright viewed films purely as entrepreneurial works.

From this perspective, there is a strong argument that the problem revealed by *FAPL* was never about the boundary between public performance and communication to the public, but about the UK's failure to distinguish properly

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70. This is of course, precisely the current situation for cinematographic works and first fixations of films – the difference being that that is the result of a clear legislative intention to harmonise the rules on the communication to the public of the first and not the second, not a terminological divide explainable only through the careful studying of a confusingly-worded collection of international instruments. A similar problem, for similar reasons, is identifiable for karaoke, see Bently et al., *supra* note 20, 158, fn 132.

71. CJEU, 31 May 2016, *Reha Training*, C-117/15, EU:C:2016:379, para. 31.

72. Hugenholtz and van Veltze, *supra* note 2, 797.

73. This solution is further enabled by the Court's ruling in *TVCatchup*, which made clear that 'new public' criterion does not always apply. See CJEU, 7 March 2013, *TVCatchup*, C-607/11, EU:C:2013:147, para. 39. If this is the case, SGAE becomes an aberration, rather than the start of a confusing line of case law.

74. European Union (Withdrawal) Act 2018, s. 6(4)(a) and (b).

75. *Ibid*, s. 5.

between copyright and related rights in films – in other words, far from the result of wrong-headed CJEU law-making, it was a UK own goal. This own goal occurred in slow motion over the course of decades, starting with the UK legislator's initial failure to appreciate the need, under international copyright law, to protect cinematographic works as such.<sup>76</sup> Over time, films have developed into a known problem area in UK copyright law. *FAPL* simply adds defences to the list of areas for which they create difficulties. The problem cannot be rectified until the UK's closed list of subject matter is amended to separate the protection granted to film creators from that given to film producers. Unfortunately, outside of the EU, the UK's incentive to engage with the issue is diminished.

The above being said, it must also be conceded that the EU legislator is not entirely without fault. Certainly, there are multiple weaknesses to the harmonisation approach it takes to copyright.<sup>77</sup> These include the introduction of foreign terminology to national legal systems that requires national judicial interpretation and excessive leeway for national implementing legislators. Both undermine legal certainty. *FAPL v. QC Leisure* and the fate of films in the UK offer a prime example of the dangers of selective harmonisation as opposed to comprehensive unification of law. It is worth noting that Prof. Hugenholtz has been a long-time proponent of EU copyright unification.<sup>78</sup> The legislative misunderstandings laid bare by *FAPL v. QC Leisure* may well have been avoided if the EU legislator had taken his advice and adopted a single European Copyright Code – now that would be a game changer!

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76. *Norowitzian v. Arks Ltd & Anor* [1999] EWCA Civ 3018. See also A Barron, 'The Legal Properties of Film', 67(2) *The Modern Law Review* (2004), 177.

77. See P.B. Hugenholtz, 'Is Harmonisation a Good Thing? The Case of the Copyright Acquis', in A. Ohly and J. Pila, *The Europeanization of Intellectual Property Law: Towards a European Legal Methodology* (Oxford University Press, 2013), 57

78. *Ibid.* See also P.B. Hugenholtz, 'The Wittem Group's European Copyright Code', in T. Synodinou, *Codification of European Copyright Law: Challenges and Perspectives* (Kluwer, 2012), 339.



# Audiovisual Coverage of Sports Events and Copyright Law: Originality in the Details?

*Tatiana Synodinou*

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## 1. INTRODUCTION

The economic value of sports images and of sports events broadcasting has reached impressive levels that appeared unthinkable decades ago. While the 1948 Summer Olympics in London were sold for a fee of GBP 1500, the 2000 Sydney Olympic games brought in more than USD 1.3 billion.<sup>1</sup> Broadcasting technologies and methods have been tremendously enhanced by providing high-quality coverage of sports events. Major advances in broadcasting technology have transformed the audience's experience. When the Olympic Games were first televised in Berlin in 1936, they were broadcast to around 162,000 people, using just three cameras, only one of which was capable of live transmission, while Zeppelins were used to convey newsreels around Europe. During the London Olympic Games in 2012, an estimated 4.8 billion viewers were able to view and watch replays of every detail of the event in high definition and 3D formats via an impressive range of angles and effects.<sup>2</sup>

Audiovisual rights have a crucial role in securing the financing of sports events in the European Union (EU). As the 2007 White Paper on Sport explains: 'A growing part of the economic value of sports is linked to intellectual property rights. These rights relate to copyright, commercial communications,

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1. Harry Arne Solberg, 'The Economics of Television Sports Rights Europe and the US – A Comparative Analysis', 9(2) *Norsk medietidsskrift* [2002], [https://www.idunn.no/nmt/2002/02/the\\_economics\\_of\\_television\\_sports\\_rights](https://www.idunn.no/nmt/2002/02/the_economics_of_television_sports_rights), accessed 13 April 2021.
2. Rafael Ferraz Vazquez, 'Sport and broadcasting rights: adding value', 2 *WIPO Magazine* [2013], available at: [https://www.wipo.int/wipo\\_magazine/en/2013/02/article\\_0005.html](https://www.wipo.int/wipo_magazine/en/2013/02/article_0005.html).

trademarks, and image and media rights.<sup>3</sup> Despite the existence of a legal arsenal of diverse IP rights, a global paradigm of online piracy enabling the retransmission of sports events on a worldwide basis has dynamically emerged. In this context, an important question is whether the classic copyright and related rights protection offers a solid legal basis for combatting online piracy, specifically regarding the broadcasting of live sports events, or whether the sports industry should be granted additional exclusivity through the establishment at EU level of specific protection, as is the case in certain Member States. The latter has quite recently been proposed in the legislative strategy for the modernisation of copyright rules in the digital single market, where the EU Parliament at a late stage suggested to grant sports events organisers the exclusive right to fix, reproduce and communicate to the public footage of the sports event.<sup>4</sup> However, this proposal has finally been abandoned.

The aim of this chapter is to analyse whether and how the broadcasting of sports events could be protected as an original work in EU copyright law. The chapter is divided into two parts. In section 2, the EU *status quo* in originality is examined, with an emphasis on the criterion of free and creative choices as the fundamental element for asserting originality. In section 3, the EU framework on originality is applied to the filming of sports events. Emphasis is given to the existence of creative choices in filming the event and to the search for originality in special effects and other additional elements in the coverage of sports events.

## **2. THE EUROPEAN STATUS QUO ON THE CONCEPT OF ORIGINALITY AND ITS APPLICATION TO THE COVERAGE OF SPORTS EVENTS**

### **2.1 The Role of Creative Choices in Asserting Originality**

Thirty years ago, when the first EU copyright law on the legal protection of computer programs was adopted,<sup>5</sup> it would have been difficult to predict that the cherished notion of originality, which has traditionally been seen as the organic link between copyright law and national cultures, would be discussed as a horizontal key concept of European copyright law. The course of action taken by the EU to construct and affirm a robust internal market for IP protected goods has reversed this paradigm. Nowadays, the concept of originality in copyright is

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3. Commission of the European Communities, *White Paper on Sport*, COM (2007) 391 final, Section 932.
4. On 12 September 2018, the European Parliament approved amendments to the draft Directive on Copyright in the Digital Single Market (COM (2016) 0593). See Amendment number 76 of the draft which proposed a new Article 12a: 'Member States shall provide sport event organizers with the rights provided for in Article 2 and Article 3 (2) of Directive 2001/29/EC and Article 7 of Directive 2006/115/EC'.
5. Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, OJ L 122, 17.5.1991, pp. 42–46, which was replaced by Council Directive 2009/24/EC of 23 April 2009 on the legal protection of computer programs (codified version), OJ L 111, 5.5.2009, pp. 16–22.

being discussed as an autonomous EU notion of reference and as the epitome of the activist stance of the Court of Justice of the European Union (CJEU) in copyright law matters. The ‘author’s own intellectual creation’ criterion of originality, which the EU legislator included in the Software Directive, Database Directive<sup>6</sup> and Term Directive<sup>7</sup> as a rather abstract legal construction with no precise meaning, has been given flesh and blood by the CJEU. In a series of cases, the CJEU shaped the EU originality standard by providing interpretation on three crucial questions: the scope of the EU standard (applying it not only to computer programs, databases and photographs, but to any work of the mind), its nature (somewhat subjective, with roots in continental copyright law approaches) and its foundations (the free and creative choices of the author).

In *Infopaq I*,<sup>8</sup> the CJEU held that the originality of a work can only be expressed through the choice, sequence and combination of its elements, which considered in isolation are not as such an intellectual creation of the author who employs them. In other words, originality can emanate from the choice, the combination or the arrangement of non-original content. This criterion is extended through *Infopaq* to all categories of works.<sup>9</sup>

In *Painer*, the CJEU clarified that originality presupposes that the author has been able to express his creative abilities in the production of a work – in this case: a portrait photo – by making free and creative choices. These choices can be expressed at various stages of the production of a photograph: in the preparation phase, the photographer can choose the background, subject’s pose and lighting. When taking a portrait photograph, he can choose the framing, the angle of view and the atmosphere created. Finally, when selecting the image, the photographer may choose from a variety of developing techniques the one he wishes to adopt or, where appropriate, use computer software.<sup>10</sup> The prerequisite of free and creative choices has been affirmed in *Bezpenostní softwarová asociace*,<sup>11</sup> *Football Dataco*,<sup>12</sup>

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6. Council Directive 96/9/EC of 11 March 1996 on the legal protection of databases, OJ L 77, 27.3.1996, pp. 20–28.
7. Council Directive 93/98/EEC of 29 October 1993 harmonising the term of protection of copyright and certain related rights, OJ L 290, 24.11.1993, pp. 9–13, which was replaced by Council Directive 2006/116/EC of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), OJ L 372, 27.12.2006, pp. 12–18.
8. CJEU, 16 July 2009, case C-5/08, ECLI:EU:C:2009:465, *Infopaq International A/S v. Danske Dagblades Forening*.
9. Benoît Michaux, “L’originalité en droit d’auteur, une notion davantage communautaire après l’arrêt Infopaq”, 5 *Auteurs & Médias* (2009), 483 (473–488).
10. CJEU, 1 December 2011, case C-145/10, ECLI:EU:C:2011:798, *Eva-Maria Painer v. Standard Verlags GmbH, Axel Springer AG, Süddeutsche Zeitung GmbH, SPIEGEL-Verlag Rudolf AUGSTEIN GmbH & Co KG and Verlag M. DuMont Schauberg Expedition der Kölnischen Zeitung GmbH & Co KG*, para. 89.
11. CJEU, 22 December 2010, case C-393/09, ECLI:EU:C:2010:816, *Bezpenostní softwarová asociace – Svaz softwarové ochrany v. Ministerstvo Kultury*.
12. CJEU, 1 March 2012, case C-604/10, ECLI:EU:C:2012:115, *Football Dataco Ltd and Others v. Yahoo! UK Ltd and Others*, para. 45.

*Flos*,<sup>13</sup> *Cofemel*<sup>14</sup> and *Brompton*.<sup>15</sup> In the two last-mentioned decisions, in particular, the personalist nature of the EU originality standard was made more pronounced.

The component of ‘free and creative choices’ being at the heart of the EU originality concept, a further inquiry could be made as to what ‘creative choice’ means. For Daniel Gervais,

a creative choice is one made by the author that is not dictated by the function of the work, the method or technique used, or by applicable standards or relevant ‘good practice’. Conversely, purely arbitrary or insignificant selection is insufficient. A conscious, human choice must have been made, even though it might be irrational.<sup>16</sup>

In this context,

[a]s a rule of thumb, creative choices are those that one can isolate by asking whether two authors in similar situations (tools, direction, budget, etc.) would likely have produced essentially the same thing. It is those choices that create protectable expression and that, at bottom, copyright is meant to incentivise and protect.<sup>17</sup>

An assessment of the author’s creative choices is necessarily holistic. Both the quantity and the quality of the choices matter. Insignificant or obvious choices do not count. At the same time, the concept of choice appears to inherently hide an exclusion: arbitrary, random selections shall not be taken into consideration, since in that case the expression of the work is not the result of choice. The criterion of ‘free and creative choices’, combined with the concept of the author’s personal touch, embodies a subjective perception of authorship, without however implying that the threshold of protection is necessarily a high one.

The *Painer* ruling also makes clear that the scope of copyright protection does not depend on how much creativity has been expressed in the work.<sup>18</sup> The CJEU clearly disapproves of variations of the degree and extent of copyright protection on the basis of the degree of originality. In this context, the recording of a sports event, like a portrait photograph, could be protected by copyright law to the same extent as a cinematographic work, regardless of the potentially inferior degree of creativity of the recording.

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13. CJEU, 27 January 2011, case C-168/09, ECLI:EU:C:2011:29, *Flos SpA v. Semeraro Casa e Famiglia SpA*.
14. CJEU, 12 September 2019, case C-683/17, ECLI:EU:C:2019:721, *Cofemel – Sociedade de Vestuário SA v. G-Star Raw CV*, paras. 23, 30.
15. CJEU, 11 June 2020, case C-833/18, ECLI:EU:C:2020:461, *SI and Brompton Bicycle Ltd v. Chedech/Get2Get*, paras. 23, 34.
16. Daniel Gervais, ‘Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law’, *Journal Copyright Law Society USA* (2002), 949, (976–977).
17. Daniel Gervais and Estelle Derclaye, ‘The scope of computer program protection after SAS: are we closer to answers?’, 34(8) *European Intellectual Property Review* (2012), 565, 567 (565–572).
18. Case C-145/10, para. 99: ‘Since it has been determined that the portrait photograph in question is a work, its protection is not inferior to that enjoyed by any other work, including other photographic works’.

## 2.2 The Principle of Non-Protection of Unprocessed Sports Events

The principle of non-protection of adversarial sports games (such as football, basketball and volleyball) by copyright law<sup>19</sup> has been recognised by national courts worldwide<sup>20</sup> as well as in European copyright law.<sup>21</sup> First, in *Football Dataco*,<sup>22</sup> the CJEU denied the granting of copyright protection on the basis of skill, by declaring that skill does not amount to originality. Even if this finding does not specifically concern the protection of sports events by copyright law, the express denial of the assessment of the EU originality standard on the basis of skill, even significant levels of skill, excludes from copyright protection the contributions of athletes or trainers in the game or in the preparation of it which are mainly the expression of skill. Fixed procedures in training athletes, in sports plays<sup>23</sup> and in sports moves could often be seen either as mere expressions of skill or unprotected methods or ideas.<sup>24</sup> For these kinds of expressions to be

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- 19. See Viola Elam, 'Sporting events as dramatic works in the UK copyright system', 13 *Entertainment and Sports Law Journal* (2015), available online, <https://warwick.ac.uk/fac/soc/law/elj/eslj/issues/volume13/elam>, accessed on 13 April 2021, noting: 'Adversarial sports differ from choreographed sports in that the former category places primary emphasis on direct competition while the latter presents a more essential artistic component'.
- 20. See *National Basketball Association (NBA) v. Motorola Inc* [1997] 105 F.3d 841, where the NBA claimed that Motorola had infringed the NBA's copyright over the broadcasting of games and the United States Court of Appeals rejected this argument by highlighting the fact that athletes are competitors and do not act by following an underlying script. As the Court noted, 'The preparation is as much an expression of hope or faith as a determination of what will actually happen'. Similarly, in *FWS Joint Sports Claimants v. Canada* (The Copyright Board) [1991] 22 IPR 429, the Canadian Federal Court of Appeal upheld the Copyright Board's finding that the magnetism and appeal of sports games derives from unforeseeable occurrences. Despite the degree of planning involved, what happens on the field is dictated by the interaction with the opposing team and it is necessarily unpredictable. See also *Hoopla Sports & Entertainment, Inc., v. Nike, Inc.*, 947 F. Supp. 347, 354 [1996] (organising a high school all-star game does not represent anything more than an unprotectable idea).
- 21. See: Thomas Margoni, 'The protection of sports events in the EU: Property, intellectual property, unfair competition and special forms of protection', 47(4) *IIC – International Review of Intellectual Property and Competition Law* (2016), 386 (386–417).
- 22. Case C-604/10, *supra* note 12.
- 23. Likewise, set plays in an athletic event should not receive copyright protection, since any protection would limit the progress of any sport by impeding the number of possible plays. See *National Basketball Association (NBA) v. Motorola Inc*, *supra* note 20, 846. For an opposite view, see: Proloy K. Das, 'Offensive Protection: The Potential Application of Intellectual Property Law to Scripted Sports Plays', 75(3) *Indiana Law Journal* (2000), available online <https://www.repository.law.indiana.edu/ilj/vol75/iss3/7>, accessed 13 April 2021.
- 24. See Peter Mezei, 'Copyright Protection of Sport Moves', in Enrico Bonadio and Lucchi (eds.), *Non-Conventional Copyright* (Edward Elgar, Cheltenham/Northampton, MA, 2018), 271–297, available on line at SSRN: <https://ssrn.com/abstract=2925195> or <http://dx.doi.org/10.2139/ssrn.2925195> ('individual sport moves represent nothing more than ideas and surely do not amount to expressions in terms of copyright law'); Carl A Kukkonen, 'Be a Good Sport and Refrain from Using my Patented Putt? Intellectual Property Protection for Sports-Related Movements', 80 *Journal of the Patent and Trademark Office Society* (1998), 808, 811 (809–829) ('[l]ike other improvisational performers, athletes will almost always rely

protected by copyright law, they need to be supplemented by elements reflecting originality, and thus the free and creative choices of the author.

While in the *Ladbroke* case, the question of intellectual property rights over the broadcasting of horse races was briefly mentioned and somehow taken for granted from a competition law perspective,<sup>25</sup> the protection of sports games as intellectual creations was directly brought before the CJEU in the *Football Association Premier League* case.<sup>26</sup> The CJEU concluded that sports events as such do not qualify as protected subject matter under EU copyright law. As the Court stated, football games cannot be classified as works which are the author's own intellectual creation, since they are subject to rules of the game which leave no room for creative expressive freedom.<sup>27</sup>

Here, the wording of the Court is somehow unfortunate, since it gives the impression that following the rules in football games precludes copyright protection. Compliance of athletes with rules is present in all sports, so this cannot be a determinant factor for categorically excluding copyright protection, as creative expression may still be present in the composition or/and the performance.<sup>28</sup>

The CJEU justifies the exclusion of sports games from copyright protection on the grounds of the absence of originality. There is no room for creative expressive freedom. Here again, some clarification is needed. It would be erroneous to state that athletes do not express their personality in various creative ways. In the words of Peter Mezei, 'creativity denotes individuality and that individual moment of brilliance often is the fine line that separates the extraordinary athletes from the ordinary'.<sup>29</sup>

What is really missing, however, is the conscious placing of the athletes in a creative process, the outcome of which is controlled by the collective will of the participants in the game. For instance, football players do not aim for a specific creative expression ('work of the mind') that has been collectively conceived and performed by both opponent teams.

The EU originality standard, which has been defined by the CJEU as the 'free and creative choices of the author', implies the existence of a will, of an intention which is behind these choices and has motivated them. The implicit criterion of creative will, in combination with the criterion of expression which was also defined by the CJEU as a constituent element of the EU concept of a

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on a core library of moves and strategies. An athlete's individual moves can be analogized to ideas which by themselves are uncopyrightable, but, when combined, may constitute a sufficient copyrightable expression'.

25. Court of First Instance, 12 June 1997, case T-504/93, ECLI:EU:T:1997:84, *Tiercé Ladbroke SA v. Commission of the European Communities*.
26. CJEU, 4 October 2011, Joined Cases C-403/08 and 429/08, ECLI:EU:C:2011:631, *Football Association Premier League Ltd and others v. QC Leisure and others and Karen Murphy v. Media Protection Services Ltd.*
27. *Ibid.*, para. 98.
28. This is highly relevant to figure skating, trampolining, competitive dance, skateboarding, diving, acrobatic gymnastics or synchronised swimming, which might be protected as dramatic or choreographic works. See Lionel Bently, Brad Sherman, Dev Gangjee and Phillip Johnson, *Intellectual Property Law* (5th edn., Oxford University Press, Oxford, 2018), 68.
29. Mezei, *supra* note 24.

work,<sup>30</sup> leads to the exclusion of copyright protection of expressions which have not been conceived by their originators as falling within a creative process. The lack of such a concerted creative will to produce a specific creative expression is an inherent element of adversarial sports games. The actions of the athletes participating in such games are not easily predictable and depend heavily on the reaction of the opponents. There might be room for creativity, but there is no collective creative awareness or intention pointing to the game as a specific collective creative expression. The individual expression of the athletes does not result in a preconceived collective expression which can be attributed to its co-authors.

Likewise, the audience experiences sports as an unpredicted synthesis of moves and interactions which are not the performance of a script or a dramatic work. Single moves and the performing by the athletes of specific arrangements coordinated by the trainer (sports plays) could be seen as methods, systems or ideas and are unlikely to meet the ‘expression’ criterion, which was expressly established as an individual component of the EU concept of a work in the *Levola* decision.<sup>31</sup>

Since the EU concept of a work appears to implicitly exclude the application of additional criteria (fixation and categorisation of works in systems following a closed list of copyright-protected works),<sup>32</sup> the broadcasting of sports events will be protected by copyright law as long as the ‘author’s own intellectual creation’ standard of originality is met. The second part of this chapter is dedicated to an analysis of the possible sources of originality in the broadcasting of sports events, and specifically to the search for originality in the filming of the event (section 3.1) and in special effects and commentaries (section 3.2).

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30. As the CJEU stated in para. 37 of the *Levola* case: ‘only something which is the expression of the author’s own intellectual creation may be classified as a “work” within the meaning of Directive 2001/29’. See: CJEU, 13 November 2018, case C-310/17, ECLI:EU:C:2018:899, *Levola Hengelo BV v. Smilde Foods BV*.

31. *Ibid.*

32. The CJEU’s definition of the concept of ‘work’ consists only of two elements: originality and expression. *A contrario*, additional criteria appear to be implicitly excluded. See: Griffiths, for whom the CJEU’s approach on creativity would not function simply as a necessary precondition for the existence of a copyright work, but as a synonym for ‘work’ and, therefore, as the only relevant determinant of entitlement to copyright protection: Jonathan Griffiths, ‘Dematerialization, Pragmatism and the European Copyright Revolution’, 33(4) *Oxford Journal of Legal Studies* (2013), 782 (767–790). The issue of whether the intellectual creation falls within the specific categories of works in copyright systems with a closed list of categories of works of mind that might act as an additional factor against the protection of sporting events by copyright law. In the UK, in some circumstances, certain sports, such as gymnastics or synchronised swimming, may be considered as ‘works of action’ that are capable of being performed, and then fall within the category of dramatic works. See: Bently, Sherman, Gangjee, Johnson, *supra* note 28.

### **3. POSSIBLE SOURCES OF ORIGINALITY IN THE BROADCASTING OF SPORTS EVENTS**

#### **3.1 Creative Choices Made in Filming the Event**

The principle of non-protection of sports events and games as such by copyright law does not preclude the possibility of protection for the filming and broadcasting of the event, provided that the latter entail free and creative choices. Independently of the protection provided by the broadcaster's related right, the filming of the event could be protected as an audiovisual work. The originality of the audiovisual representation of the event will lie in the choices made by the director. The athletes do not enjoy any rights over the audiovisual work, since they have not contributed to the intellectual conception and the filming of the work.<sup>33</sup>

The director's choices may distinguish the broadcasting and filming of the event from the underlying unprocessed facts of the game. These choices can be expressed in the various creative stages, as noted in the *Painer* decision: in the preparation phase, when filming the event and by making editorial choices after the filming phase.<sup>34</sup>

The filming of sporting events often includes a significant number of cameras aiming to capture not only the most important aspects of the event, but also the tiniest details, while in some cases, cameras can be located on helicopters, drones or on competing cars.<sup>35</sup> In this context, a great variety of choices can be exercised. Selecting the lens for recording the event, and the angles and viewpoints from which the viewer experiences the game, may express creativity and go beyond what is simply a record of the facts.<sup>36</sup>

Specifically, the broadcasting of a sports event may fulfil the requirements for originality because the director of broadcasting exercises a number of choices regarding camera angles, types of shots and shot selection.<sup>37</sup> Even though a number of constraints regarding shot selection are imposed by the rules and the purpose of the game itself (such as presenting the shots, the goals or specific moves in gymnastics), the director still enjoys an array of choices, which may render the filming free and non-functional. The filming aims to depict and present the event holistically, and to focus on its most important moments, together

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33. For the denial of the quality of co-author of an audiovisual work to a person who participated in a documentary film, see the French case *Etre et avoir*: Cour de cassation, 1ère ch. Civile, 13 November 2008, no. 06-16.278, (2009) 2 RIDA 405.

34. Case C-145/10, *supra* note 10.

35. Ivana Katsarova, 'Audiovisual rights in sports events, An EU perspective', European Parliamentary Research Service [2017], Briefing, available online [https://www.europarl.europa.eu/RegData/etudes/BRIE/2017/599320/EPRS\\_BRI\(2017\)599320\\_EN.pdf](https://www.europarl.europa.eu/RegData/etudes/BRIE/2017/599320/EPRS_BRI(2017)599320_EN.pdf), accessed 13 April 2021.

36. Seagull Haiyan Song, *New Challenges of Chinese Copyright Law in the Digital Age: A Comparative Copyright Analysis of ISP Liability: Fair Use and Sports Telecasts* (Kluwer Law International, The Hague/London/New York, 2011), 84.

37. Marie Hopkins, 'Live Sports Virtual Reality Broadcasts: Copyright and Other Protections', 16 *Duke Law & Technology Review* (2018), 141, 151 (141–160).

with the emotional reactions of athletes, coaches and the audience. There is an intention to create an audiovisual representation of the facts, which will enable remote viewers to feel as much as possible that they are actually part of the game and at the stadium. Live events are mediated (through video technology), and in its mediation, the event is represented through selected shots that can amplify or conceal aspects of the unfolding action.<sup>38</sup> The excitement of televisual liveness is not experienced purely from the event itself, but through the sociotechnical machinery by which it is rendered.<sup>39</sup>

Originality in the filming of the event presupposes free and creative choices which are impregnated by the personal touch of the author. The filming of the event should include several choices which differentiate the audiovisual authorial work from the mere recording of the event itself. The number of choices and their combination is a determinant factor for the assertion of originality. Contrary to audiovisual works of fiction, the filming of facts is subject to inherent limitations, such as the need to communicate to the public a precise and truthful representation of the action, while popular representation or reciting styles or techniques (close-ups, replays, slow motion, superimposed images, split screens) are being used. Analogous limitations exist in documentaries or televisual news or news bulletins. At the same time, material, camera locations and editing styles are used to transform the event into a distinct creative universe, a dramatic event to which the audience is invited to attach itself. The combination of various camera angles, close-ups, focuses on athletes, trainers and spectators, aims to produce an overall product which is characterised by emotion, drama and heroism.<sup>40</sup> All the ingredients of a drama are there: expressive faces, microphones to hear the referees yelling and a focus on the logos appearing on shoes and uniforms.<sup>41</sup>

The choice of images from the various cameras depends on a carefully planned interaction between the sports director, the technical director (video mixer) and the production team. The sports director decides on the camera position and the coverage plan for each camera, the visual logic to be followed, what kinds of shots and camera movements to use during the production, the development of animated wipes used for replays and transitions (such as line-ups and full-page graphics), and instructs the technical director how to select the images coming from multiple cameras according to the 'storytelling' opted for.<sup>42</sup> Multiple camera operators 'propose' shots for selection to the control room. The sports director or the technical director acting on the instructions of the sports

38. Mark Perry, Arvid Engström, Oskar Juhlin, 'Visual Narrative and Temporal Relevance: Segueing Instant Replay into Live Broadcast TV', 42(1) *Symbolic Interaction* (2019), 98 (98–126), available online <https://onlinelibrary.wiley.com/doi/full/10.1002/symb.408>, accessed 13 April 2021.

39. *Ibid.*

40. Geneviève Rail, 'Seismography of the post-modern condition', in Geneviève Rail (ed.), *Sport and Postmodern Times* (State University of New York Press, New York, Albany, 1998) 152.

41. 'Les Plans Dramatiques de la Télévision', Les cahiers du Football, available online <http://www.cahiersdufootball.net/article-plans-dramatiques-television-realisation-matches-football-4954>, accessed 14 April 2021.

42. Jim Owens, *Television Sports Production* (5th edn., Focal Press, Taylor & Francis Group, New York/London, 2016), 175–177.

director (and possibly in creative collaboration with him) will continuously select the images that will be broadcast live from the ‘gallery’ of video monitors displaying all camera sources.

The originality of the audiovisual representation of a sporting event should therefore be based on the free and creative choices made by the director (the sports director and possibly the technical director), which aim to transform the unprotected facts of the sports game into an audiovisual expression which is distinct from the event itself. The director’s choices create a specific viewer experience which has been designed by the director and follows the director’s ‘storytelling’ of the event. To a significant extent, the director’s choices aim to provide the viewers with an objective vision of the match, in the sense that they contribute to a lucid and impartial reading of the match. Indeed, filming without elaborate camera positions and angles could result in a blurred, anarchic vision of the match. In this context, the director’s choices aim to depict and present the match in a coherent and comprehensible manner and are often guided by the game itself. However, in addition to making these choices, the director can also choose between various ways of presenting the sporting event. In this case, the audiovisual representation of the game is characterised by wide and barely interrupted filming, placing the emphasis on the fluidity of the game, the visibility of tactics, the animation of the system and collective movement without the ball; or the focus could, more individualistically, be on the player who carries the ball, where shots are multiplied and the fluidity of the game is more often interrupted, while the techniques and skills of the individual players are emphasised.<sup>43</sup>

The viewers enjoy the event from the director’s perspective. Normally, the use of multiple cameras and angles strengthens the director’s freedom to express creative choices, as long as the way in which the event will be audiovisually represented remains in the realm of the directors’ choices and ‘personal philosophy’. Ironically, the multiplication of angles of view could in some instances limit the director’s creative expression when the coverage ends up to be exhaustive. For instance, virtual reality (VR) enables a viewer to experience the game in a manner approximating to actual attendance at the event,<sup>44</sup> thus enabling the viewer to look at the game from different perspectives, to explore the entire stadium from multiple different viewpoints (such as from the viewpoint of the players, fans, and officials) or even to see the game from the players’ perspective. However, the absence of the director’s ‘control’ (choices) over how the event will be communicated to the viewers will deprive the filming of originality. The broadcaster’s own expression becomes limited or non-existent when VR allows the venue to be shown from all angles. By allowing a viewer to watch the game

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43. Florent Vernet, ‘Comment Filmer Le Football Pro Et Amateur?’, *Vue Des Tribunes*, 23 July, available online <https://vuedestribunes.com/comment-filmer-le-football-pro-et-amateur/>, accessed 13 April 2021.

44. Ben Dickson, ‘How Virtual Reality is Transforming the Sports Industry’, *Techcrunch* [2016], available on line <https://techcrunch.com/2016/09/15/how-virtual-reality-is-transforming-the-sports-industry/?guccounter=1>, accessed 13 April 2021.

from every possible angle, the VR broadcast essentially becomes the facts of the game and would not satisfy authorship or originality requirements.<sup>45</sup>

The question of whether the filming of live sporting events could be protected as an original work was one of the main issues raised before the Swedish courts in the *C More Entertainment* case. The dispute was between a pay TV station offering live online broadcasts of ice hockey matches and the operator of a website supplying deep links to these live online broadcasts by circumventing the TV station's paywall. In the litigation before the national courts, the Court of Appeal concluded that the live broadcast of matches could not enjoy copyright protection because neither the commentators' nor the camera crew's or the producers' contributions were original. Having excluded copyright protection, the only question which remained was to establish whether the broadcasts could be protected by related rights of the broadcasters. Copyright protection for the filming of live matches was also subsequently denied by the Swedish Supreme Court, which ruled on the case after the CJEU's judgment regarding the scope of protection of the broadcasters' related right.<sup>46</sup> In a divided judgment (three to two), the Supreme Court ruled that live broadcasts of the games were not original because the work of the commentators, cameramen and picture producers was mainly driven by the events in the game. Even though some choices were made in the creation of the broadcast and use of graphic design elements, the audiovisual representation could not be considered to constitute an intellectual creation.<sup>47</sup> The different views of the members of the Supreme Court regarding copyright protection over the broadcasting of sports events is indicative of the extremely delicate nature of making such an assessment, and it might suggest that the evaluation is subjective and therefore uncertain.<sup>48</sup>

The intricacies of the protectability of the broadcasting of live sports games by copyright law has also been raised in a series of cases in China.<sup>49</sup> In *Sina v. Tianying Jiuzhou*<sup>50</sup> the Beijing IP Court analysed in detail the issue of the originality of the broadcasting of live sports programmes. After assimilating sports broadcasting to the category of documentary films,<sup>51</sup> the Court held that

45. Hopkins, *supra* note 37, 151.

46. CJEU, 26 March 2015, case C-279/13, ECLI:EU:C:2015:199, *C More Entertainment AB v. Linus Sandberg*.

47. Advokatfirman Lindahl, 'No copyright protection for sport broadcasts', *Lexology* [2016], available online <https://www.lexology.com/library/detail.aspx?g=bb9fc252-28d7-45c3-8225-506dab93b42c>, accessed 13 April 2021.

48. Eleonora Rosati, 'Swedish Supreme Court has ruled that sport broadcasts are not protected by copyright', *The IPKat* [2016], <https://ipkitten.blogspot.com/2016/12/swedish-supreme-court-has-ruled-that.html>, accessed 13 April 2021.

49. See Zhaoxia Deng, 'Re-Examining Copyright Protection of Sports Programs from *Sina v. Tianying Jiuzhou* and *CCTV International v. Storm*', 5 *Asian Law & Public Policy Review* (2020).

50. (2015) Beijing IP Civil Final No. 1818.

51. For the resemblance of sport broadcasts to documentary films, see Carmen Rial, 'Le Football et la rhétorique des médias sportifs télévisuels', 6(2) *Vibrant – Virtual Brazilian Anthropology* (2009), 186 (186–201). According to this author, in both cases the events are filmed without actors, or at least with actors who play their own role, without a pre-established

the originality of documentary films could be reflected in the selection of materials, the shooting of materials and the selection and arrangement of images. By applying this line of reasoning to live sports programmes, without excluding the possibility of originality in some special cases, the Court concluded that it would be very difficult to affirm personal choices in the selection of materials, since these choices are limited by the need to satisfy the audiences' demand.<sup>52</sup> Regarding the selection of the subject, the content of the broadcast is completely dependent on the event itself, leaving no room for individual choices, and likewise there is not much personal scope in the selection and arrangement of pictures, because the live broadcast must reflect the actual situation unfolding *in situ* at the location of the sports event.<sup>53</sup> The live broadcasting of games is significantly constrained by a number of factors: the objective situation of the game itself, the instantaneity of live broadcasting, the need to have a team skilful in live broadcasting and the audience's needs.

Based on the above, the originality of the filming of sporting events, which is strongly guided by the game and its rules, can be found mainly in the details. The inherently limited scope for personal choices switches the emphasis to a more comprehensive search for originality, since often only details can reveal a personal stance.<sup>54</sup> In this sense, the more the filming depends on technical and functional elements, the more creative contributions focusing on details would be required to grant copyright protection to the film coverage of sporting events.

### **3.2 The Role of Special Effects and Commentaries**

While the broadcasting of the sporting event is necessarily guided by the facts themselves and leaves relatively little scope for personal choices, modern sports broadcasts are often accompanied by a series of additional elements which enable the director to express several choices and to distinguish the audiovisual representation of the event from the event itself. This creative input might consist of various special effects, such as the use of instant replays, slow motion and split screens, the integration of music compositions and jingles, the use of graphic designs, subtitles, 3D animations and other special effects.<sup>55</sup> In VR broadcasting,

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script (we do not know the outcome of the action in advance) and in a scenario that was not specifically designed for the film.

52. See Beijing IP Court, Judgment of 30 March 2018, Case: (2015) Jing Zhi Min Zhong Zi No. 1818. An abstract of the decision in English is available online at: [https://www.law.berkeley.edu/wp-content/uploads/2020/07/July-8\\_merged\\_pagenumber.pdf](https://www.law.berkeley.edu/wp-content/uploads/2020/07/July-8_merged_pagenumber.pdf), accessed 13 April 2021.
53. He Yuanyuan, 'Does Sportscasting Qualify as a "Work" Under Chinese Copyright Law?', 2020, available online at: Clarivate <https://clarivate.com/darts-ip/blog/sportscasting-in-china/>, accessed 13 April 2021.
54. Here, an analogy could be made with the assessment of the criterion of 'individual character' regarding the protection of designs. See Joined Cases T-83/11 and T-84/11 *Antrax It Srl v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, para. 45, ECLI:EU:T:2012:592.
55. Katsarova, *supra* note 35. See also: P. Bernt Hugenholtz, 'The WIPO Broadcasting Treaty. A Conceptual Conundrum, Opinion', 41 *European Intellectual Property Review* (2019),

additional means can be used to enhance the social interaction between viewers, such as chat interfaces and the representation of users via avatars.<sup>56</sup>

These additional creative elements can be protected by copyright law, provided they meet the EU originality standard. Specifically, regarding the copyright protection of graphic user interfaces integrated into the broadcasting of a sports event (e.g. icons, frames, animations, graphic charters), reference can be made to the CJEU's judgment in the *BSA* case.<sup>57</sup> In this context, even though they are not constituent elements of the expression of the computer program, they can be independently protected by copyright law if they are the author's own intellectual creation. As the CJEU stated: 'when making that assessment, the national court must take account, *inter alia*, of the specific arrangement or configuration of all the components which form part of the graphic user interface in order to determine which meet the criterion of originality. In that regard, that criterion cannot be met by components of the graphic user interface which are differentiated only by their technical function'.<sup>58</sup>

The protection of special effects by copyright law was examined in the *Football Association Premier League* case, where the CJEU recognised the possibility of copyright protection of additional constituent elements of the filming, such as graphics and anthems displayed during broadcasting.<sup>59</sup> Independently of any special effects and additional creative contributions during the event, contributions made before the start, during the half-time intervals and after the event, may also be protected by copyright law, such as the opening video sequence, interviews and pre-recorded films showing highlights of recent sports events.<sup>60</sup>

The use of instant replays is an interesting example of special effects which are dependent both on the evolution of the game and the directors' choices regarding their quantity and the timely moment of their appearance. In live sports that involves the use of multi-camera recordings, video and audio materials are captured to advanced storage systems that allow programme editors to cut into the live broadcast to show recorded footage from cameras that were not initially selected for broadcast, allowing the use of multiple angles on action taking place during the game and at different playback speed.<sup>61</sup> Managing transitions between real-time action and instant replays during a live event requires choices to be made which aim to maintain a balance between the real-time broadcasting of game-relevant developments and replays which act as visual accounts of what has just happened.<sup>62</sup>

In addition to images, the commentaries of sports journalists are additional elements which, like the dialogue of a film, could be protected either as constituent elements of the audiovisual work as a whole, or as separate oral literary

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199–202.

56. Hopkins, *supra* note 37.

57. Case C-393/09, *supra* note 11.

58. *Ibid.* para. 48.

59. Joined cases C-403/08 and 429/08, *supra* note 26, para. 149.

60. *Ibid.* para. 149.

61. *Supra* note 38, 106.

62. *Ibid.* 111.

works. Television sports commentary is characterised by an accumulation of statements (which influence the pace of the event through their patterns) and by the building of tension through increased use of suspenseful references by commentators.<sup>63</sup> The narrator reads and interprets the event from a certain viewpoint, while summaries are being presented in various storytelling styles. Sports commentaries can be protected by copyright law as long as they are not limited to a raw description of the event. At the level of composition, the originality of a commentary can be characterised by the personal treatment of a question, in the way of approaching it, and therefore in the arbitrary choices made in presentation of the facts. In this context, the Paris Court of Appeal has accepted the originality of reports on horse racing which do not limit themselves to transcribing the sporting results, but provide a precise analysis of the past performance and potentialities of the horses participating in the race.<sup>64</sup>

#### 4. CONCLUSION

Unprocessed sports events cannot be protected by copyright law. This leads to a complex mosaic of national legislations related to the protection of sports events (organiser's rights, athletes' publicity rights, etc.). However, by exploring the possibilities of original additions, either in the filming process or in the production process (special effects, commentaries), it would be possible to apply the protection of copyright law to sports events coverage without sacrificing the core principles of copyright law in any way. The robust arsenal of copyright law is already available for creative broadcasters who may invoke copyright protection for the coverages of sport events as audiovisual works, as has already been pinpointed by Bernt Hugenholtz in his brilliant Opinion on the WIPO Broadcasting Treaty: 'live coverage of a Champions League football match that involves, at the very least, multiple camera operators, several commentators and a director, will easily pass this test. Even in countries where fixation is a prerequisite, broadcasters may invoke copyright protection for ancillary content such as leaders, graphics, animations, replays and other (pre)recorded audiovisual content included in live sports broadcasts'. At the same time, since creativity will be mostly hidden in the details, necessary clarifications of the application of EU originality standard to the broadcasting of sports events could emerge through litigation, if the CJEU is given the opportunity to take a position on this point.

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63. Barbra S. Morris and Joel Nydahl, 'Toward analyses of live television broadcasts', 34(3) *Central States Speech Journal* (1983), 195–202.

64. CA Paris, 21 March 2007, no. 05/20 081. For the protection of a radio reportage by copyright law, see: Tribunal correctionnel Seine, 21 May 1954, *Gazette du Palais* 1954, 2, 203.

# Images in Sports: Reflections on Related-Rights Protection

*Reto Hilty*<sup>1</sup>

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## 1. GENESIS OF IMAGES OF SPORTING EVENTS

Reporting on sporting events without visualisation is unthinkable today – and watching what happens in real time is taken for granted. This was not always the case. In the 1950s, when Bernt Hugenholtz was born, to whom this essay is dedicated and who is a great sports fan, radio was still the common medium to follow a football match live. A nice example is Herbert Zimmermann's legendary radio report on the 1954 World Cup in Berne.<sup>2</sup>

This purely verbal reporting only became insignificant with the advent of television. The costs of producing signals in a stadium and transmitting them, however, were tremendous and did not pay off without a sufficient number of viewers. In 1954, just some tens of thousands of Germans were able to watch their historic victory in real time;<sup>3</sup> but as early as 1960, 3.4 million television

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1. This essay would not have been possible without valuable information from several colleagues on the legal situation in their countries or regions. I would like to thank in particular (in alphabetical order) Tobias Endrich (Munich), Valentina Moscon (Munich/Trento), Gonzalo Maria Nazar de la Vega (Buenos Aires), Ole-Andreas Rognstad (Oslo), Sebastian Felix Schwemer (Copenhagen), Alina Wernick (Prien/Helsinki), and Raquel Xalabarder Plantada (Barcelona) for helpful input. I also thank my doctoral student Anja Geller and my student assistant Ferdinand Dabitz for their helpful support in general research for scientific references.
2. 'The Miracle of Berne', <http://www.fifa.com/news/the-miracle-bern-1194196> (all cited websites were accessed on 5 May 2021).
3. <http://www.statistik-bw.de/Service/Veroeff/QuerschnittsverF6ffentlichungen/806116006.pdf>, 41.

sets were operating in Germany<sup>4</sup> – and the triumphant advance of live reporting with pictures could take off.<sup>5</sup>

Of course, the possibility of making sporting events visually perceptible at a location other than where they took place existed significantly earlier – just not in real time. The origins of photography go back almost 200 years. In 1826, the first permanent so-called ‘light image’ was taken; the technology became commercially viable in 1839. The major challenge for the photographer was to master this technology. For decades, the equipment remained heavy and only pictures of stationary objects were possible, for example a lined-up team not moving during the long exposure time.<sup>6</sup>

The idea of running pictures consecutively, so-called ‘motion pictures’, emerged not long after the invention of photography. A real film camera, however, was not developed before the end of the 1880s. Cinemas became popular; from the 1910s on, starting in Paris, they also showed newsreels that remained important until recordings of sporting events could be watched as sports news on TV.<sup>7</sup> More recently, such recordings also are available on-demand via online providers.

This chapter focuses primarily on photography, but also takes a look at film, where the core question is to what extent protection by related rights can be justified below the threshold of copyright. This is inspired by a recent piece by Bernt Hugenholtz, where he concludes that such rights are obsolete today.<sup>8</sup> In a first step, the international and European legal frameworks are examined (2.). Then, the historical reasons for the existence of legal protection for non-creative photographs in a number of EU member states are explored (3.), followed by a critical review of these protection approaches from today’s perspective (4.). This *tour d’horizon* is concluded with reflections on whether there are reasons beyond economic considerations that justify the protection of certain groups of photographers, but also film producers, below the threshold of copyright law (5.).

## 2. LEGAL TREATMENT OF IMAGES

Images may constitute copyright-protected works. Not that the subject shown is decisive, but the way of its presentation. Fixations of images may therefore enjoy protection although sporting events as such usually do not. If the protection requirements of copyright law are not met, related rights may apply to

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4. *Ibid.*

5. Simon Tyers, ‘How World Cup TV Coverage Has Changed Since the 1950s’ *The Guardian*, 7 July 2014, <http://www.theguardian.com/football/when-saturday-comes-blog/2014/jul/07/world-cup-tv-television-coverage-changed-1954-1958>.

6. On the historical development of photography: Mary Warner Marien, *Photography: A Cultural History* (5th edn., Laurence King Publishing, 2021).

7. Wheeler Winston Dixon and Gwendolyn Audrey Foster, *A Short History of Film* (3rd edn., Rutgers University Press, 2018) 1–7, 16 f., 20 f.

8. Bernt Hugenholtz, ‘Neighbouring Rights are Obsolete’, 50 *IIC* (2019), 1006–1011.

visualisations.<sup>9</sup> However, this landscape is heterogeneous. The actors involved are primarily decisive for whether a related right exists.

## 2.1 International Law

Broadcasting enjoys a special position in international law. As early as 1961, twenty-five countries agreed to the Rome Convention (RC),<sup>10</sup> which came into force on 18 May 1964. The current ninety-six Member States are obliged – among other things – to grant broadcasting organisations the minimum rights listed in Article 13 RC, namely ‘the right to authorise or prohibit: (a) the rebroadcasting of their broadcasts; (b) the fixation of their broadcasts; (c) the reproduction ... of fixations’. In addition, there is the right to authorise ‘(d) the communication to the public of their television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee’. The Brussels Satellite Convention<sup>11</sup> supplemented the Rome Convention in 1974 (to date with thirty-eight Member States), protecting broadcasting organisations against unauthorised retransmission of their broadcasts via satellite.

Recordings of sporting events for the purpose of time-shifted visualisation have enjoyed protection under the Berne Convention (BC) since its Berlin Act of 1908.<sup>12</sup> Audio-visual recordings of sporting events, however, only exceptionally constitute works, because objective recording of the course of an event limits creative leeway.<sup>13</sup> As to related rights, protection depends on who is behind the camera. According to Article 13 RC, broadcasting organisations enjoy rights to the ‘fixations of their broadcasts’. By contrast, independent producers are left empty-handed – even for identical recordings. The RC only protects producers of phonograms, as does the more recent WIPO Performances and Phonograms Treaty (WPPT).<sup>14</sup> The Beijing Treaty on Audiovisual Performances<sup>15</sup> does cover ‘moving images’ (Article 2(b)), but only protects performers, not producers.

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9. Thomas Margoni, ‘The Protection of Sports Events in the EU: Property, Intellectual Property, Unfair Competition and Special Forms of Protection’, 47 *IIC* (2016), 386–417; Valentina Moscon, ‘Use and Abuse of Neighbouring Rights and the Growing Need for a Sound Understanding: The Case of Online News Protection in Europe’, in Susy Frankel (ed.), *The Object and Purpose of Intellectual Property* (EE 2019), 318 f.
10. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (adopted 26 October 1961).
11. Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (adopted 21 May 1974, entered into force 25 August 1979).
12. Art. 2(1) Berne Convention for the Protection of Literary and Artistic Works (signed 9 September 1886, last amended 28 September 1979).
13. In common law countries, copyright protection is more likely; see also *infra* text accompanying note 41 and Margoni, *supra* note 9, 396–400.
14. WIPO Performances and Phonograms Treaty (adopted 20 December 1996, entered into force 20 May 2002).
15. Beijing Treaty on Audiovisual Performances (adopted 24 June 2012, entered into force 28 April 2020).

The case for photography is similar. Article 2(1) BC has included mention of this category of works since the Brussels Act of 1948.<sup>16</sup> However, no protection is required for non-creative photography.

## 2.2 EU Law

In the EU, the related rights for broadcasting organisations are dealt with in Articles 7(2) and 8(3) of Directive 2006/115.<sup>17</sup> Article 9(1)(d) stipulates the distribution right. The reproduction right, initially also contained in Article 7(1) of Directive 92/100, was moved to Article 2(2)(e) Directive 2001/29.<sup>18</sup> Article 3(2)(d) of the latter also sets out the right to make available to the public. Satellite broadcasting and cable retransmission were separately covered by Directive 93/83,<sup>19</sup> partially amended and supplemented by Directive 2019/789.<sup>20</sup>

In contrast to international law, EU law – ‘mysteriously’<sup>21</sup> – requires related rights for non-copyrighted films, albeit in a somewhat fragmentary manner. The term ‘film’ is defined in Article 2(1)(c) Directive 2006/115 as ‘a cinematographic or audiovisual work or moving images, whether or not accompanied by sound’. The initial Directive 92/100<sup>22</sup> only provided for a rental and lending right (Article 2(1), now Article 3(1)(d) Directive 2006/115). Only Directive 2001/29 stipulated the right of reproduction (Article 2(d)) and the right of communication to the public (Article 3(2)(c)) for films not protected by copyright. Before that, the distribution right provided for in Article 9(1) Directive 92/100 (now Article 9(1)(c) Directive 2006/115) was virtually up in the air. The term of protection of fifty years after recording or publication was determined by Article 3(3) Directive 93/98,<sup>23</sup> which later was replaced by Directive 2006/116.<sup>24</sup> While Directive

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16. Art. 9 WIPO Copyright Treaty (WCT, adopted 20 December 1996, entered into force 6 March 2002), suspended the shorter term of protection under Art. 7(4) BC.
17. Directive 2006/115 of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (originally Directive 92/100).
18. Directive 2001/29 of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.
19. Directive 93/83 of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission.
20. Directive 2019/789 of 17 April 2019 laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of television and radio programmes, and amending Council Directive 93/83/EEC.
21. Bernt Hugenholtz, ‘Neighbouring Rights are Obsolete’, 50 *IIC* (2019), 1006, 1007.
22. Directive 92/100 of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property.
23. Directive 93/98 of 29 October 1993 harmonizing the term of protection of copyright and certain related rights.
24. Directive 2006/116 of 12 December 2006 on the term of protection of copyright and certain related rights.

2011/77<sup>25</sup> extended the term from fifty to seventy years for performances and for phonograms, it remained unchanged for films.

With regard to photography, Article 6 Directive 2006/116 (like the previous Directive 93/98) stipulates that no special criteria shall apply to determine its eligibility for copyright protection. It suffices that a photograph represents the result of the photographer's own intellectual creation.<sup>26</sup> The third sentence of Article 6 adds that the Member States may provide for the protection of other photographs, but this is neither specified nor required. Article 14 of Directive 2019/790<sup>27</sup> refers to this kind of protection negatively by failing to provide for it: it states that 'any material resulting from an act of reproduction' of a work of visual art for which the term of protection has expired shall not be subject to related rights.<sup>28</sup>

### **3. LEGAL PROTECTION FOR NON-CREATIVE PHOTOGRAPHS**

In the following, we will first discuss the doubtful justification of legal protection of photographs below the threshold of copyright, which is not required by EU law. This also raises questions as to the protection of 'moving images', mandatory under EU law; this will be debated at the end.

#### **3.1 Technical Development of Photography**

Photography, as the oldest means of visualisation, has hardly lost its popularity to this day; on the contrary, Facebook, Instagram and the like live from the sharing of images. Yet the technologies used have been fundamentally simplified. This is relevant when discussing the justification of related rights in case photographs do not meet the copyright protection requirements.

Until the end of the twentieth century, photography essentially relied on a light-sensitive medium – initially plates, later rolled-up film strips, and from the middle of the last century film cartridges. After exposure, these media had to be developed in chemical baths to produce negatives, which in turn were used to expose photographic paper in darkrooms. Although gradually automated for mass uses, these processes and the darkroom remained the place where professionals could bring out the best in photographs. The advent of digital technology revolutionised photography almost a quarter of a century ago. Today, pictures

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25. Directive 2011/77 of 27 September 2011 amending Directive 2006/116/EC on the term of protection of copyright and certain related rights.

26. CJEU C-5/08, *Infopac International*, para. 35; C-145/10 *Painer v. Standard*, paras. 88–94; C-683/17 *Cofemel v. G-Star Raw*, paras. 29–35.

27. Directive 2019/790 of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9 and 2001/29.

28. This provision ought to correct a decision of the German Federal Supreme Court of 20 December 2018, I ZR 104/17, (2019) 121 GRUR 284, paras. 23–30 – Museumsfotos, stating that photographs of paintings in the public domain enjoy protection of the related right; see also Louisa Specht-Riemenschneider and Julia Paschwitz, 'Gemeinfreiheit als Prinzip? Reichweite und Umsetzungsbedarf des Art. 14 DSM-Richtlinie', 1 *RuZ* (2020), 95–99.

taken with a smartphone are immediately available, easy to optimise by software and – if still desired on paper – printable on any colour printer. As digital files, they are mostly viewed on screens and can be made available to anybody via the internet, without borders and with practically no transaction costs.<sup>29</sup>

### 3.2 Justification of Related Rights for Photographs

In the early days, the technical challenges obviously did not depend on whether photographs constituted works in terms of copyright law. Therefore, where protection was considered necessary, it was reasonable to grant it in any case. This prevented third parties from deriving a competitive advantage from the photographer's investments; it safeguarded photographers' marketing opportunities, allowed them to amortise their investments – and ultimately prevented what today is called market failure, meaning that no more photographs would be produced.

In any event, this line of reasoning is the *raison d'être* behind those related rights that became a branch of copyright law from the 1960s on.<sup>30</sup> Traditional intellectual property (IP) rights also realise this logic to the extent that they protect economic interests. The decisive difference, however, is that IP rights depend on the quality of the investment result: a work must be an intellectual creation of the author, an invention may not be obvious to a person skilled in the art, and a trademark must be distinctive. If these requirements are not met, there is no protection by IP rights. In the case of related rights, on the other hand, the mere fact that particular actors – such as film producers or broadcasting organisations – are willing to invest is *per se* enough. Whatever they produce is unconditionally protected against certain uses by third parties.<sup>31</sup>

The extent to which legislatures understood these circumstances in the early days of photography is an open question. It was in any case not strange if some saw a need for protection in view of the complex technology and the investments required to produce photographs.<sup>32</sup> Moreover, it was plausible not to link legal protection to copyright criteria, especially since copyright protection for photography at the international level was not established until the middle of the last century.<sup>33</sup> In this sense, that early kind of related-rights protection for photographs predates copyright protection.

The technical development of photography, however, shows where the unconditional granting of related rights may lead. If those rights are designed to prevent market failures, digital technology has made them absurd – there is anything but underproduction of photographs. In this context it is worth recalling that technical progress is indeed taken into account in patent law: the

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29. Edgar Cruz and Eric T Meyer, 'Creation and Control in the Photographic Process: iPhones and the Emerging Fifth Moment of Photography', 5 *Photographies* (2012), 203, 204, 212–217.

30. Hugenholtz, *supra* note 8, 1007 f.; Margoni, *supra* note 9, 400 f.

31. Hugenholtz, *supra* note 8, 1008 f.; Margoni, *supra* note 9, 400 f.

32. For details see *infra* section 3.1.

33. Text accompanying note 16.

patentability of an invention depends on the respective state of the art at the time of the application. The more technology advances, the higher the requirements become, thus avoiding the risk of protection of obsolete technologies.

In this respect, copyright law is distinct from patent law, at least according to the prevailing doctrine that protection does not depend on an objective standard such as 'novelty'. The criteria for copyright protection consequently hardly change over time.<sup>34</sup> However, not only economic considerations play a role in copyright law, but also moral rights. In this respect, value-based aspects may justify the protection of a work. By contrast, related rights – although conceptually modelled on copyright – need justification in economic terms,<sup>35</sup> with the exception of certain rights of performers, which do not play a role here.<sup>36</sup> It is true that terms such as 'neighbouring rights' and 'related rights' run the risk of blurring these differences; the German term '*Leistungsschutzrecht*' (protection of a merit or achievement) seems more appropriate, but an English-language equivalent has never emerged.

### 3.3 National Approaches to the Protection of Photographs<sup>37</sup>

National approaches to protect photographers emerged in the second half of the nineteenth century – in Germany in 1876, in Norway in 1877, in Finland in 1880, in Denmark in 1885 and in Sweden in 1897. Laws independent of copyright protected all photographs regardless of their creative quality. Today, one might speak of a '*sui generis*' approach; in any case, the *raison d'être* behind contemporary related rights already shone through.

In other countries all photographs were protected as well, but within copyright legislation – in the UK since 1862,<sup>38</sup> initially including Ireland and Malta; both pursued that approach independently from 1927<sup>39</sup> and 1967,<sup>40</sup> respectively. This must be seen in the context of their general focus on 'skill, labour, judgment and effort', meaning that investment protection *per se* makes up the core of copyright.<sup>41</sup> That was never the case in Austria, where protection of photographs

34. See e.g. Karl-Nikolaus Peifer, “Individualität” or Originality? Core Concepts in German Copyright Law’, 63 *GRUR Int.* (2014), 1100, 1102–1104.

35. Moscon, *supra* note 9, 309–313.

36. Art. 5 WPPT; see also Hugenholtz, *supra* note 8, 1007.

37. For the sake of completeness, it should be mentioned that in addition to those analysed below, further countries have related rights for photography, such as Iceland (Art. 49 Copyright Act Law, 1972), Iraq (Art. 20 Copyright Law, 1971) or Libya (Art. 20 Law on the protection of copyright, 1968); in Latin America also Ecuador (Art. 103 Código Orgánico de la Economía Social de los Conocimientos, Creatividad e Innovación, 2016), Peru (Art. 144 Ley sobre el Derecho de Autor, Decreto Legislativo No. 822, 1996) and Paraguay (Art. 135 Ley No. 1328/1998 de Derecho de Autor y Derechos Conexos, 1998).

38. Art. 1 Fine Arts Copyright Act (1862).

39. Art. 171 Industrial and Commercial Property (Protection) Act (1927).

40. Art. 2 Copyright Act (1967); Christina Michalos, *The Law of Photography and Digital Images* (Sweet&Maxwell, 2004), 697.

41. Andreas Rahmatian, ‘Originality in UK Copyright Law: The Old “Skill and Labour” Doctrine Under Pressure’, 44 *IIC* (2013), 4, 5, 12–14.

was likewise provided within the Copyright Act since 1895, irrespective of their creative or artistic character.<sup>42</sup> This prompts the conclusion that photographs were initially regarded as autonomous subject matter.

Italy and Spain provide a counterpoint to these early approaches. Both countries first granted copyright protection only to photographs with creative or artistic character, Spain since 1897,<sup>43</sup> Italy since 1925.<sup>44</sup> In 1941, however, Italy introduced a related right on photographs;<sup>45</sup> in return, copyright protection was suspended until 1979, when it was reintroduced – retaining the related right – for ratification of the Paris Act of the BC.<sup>46</sup> A major argument for that interim regime limited to related rights was that especially commercial photography, for which technical factors outweighed the creative ones, was seen as being in need of protection. Moreover, certain formalities – prohibited under copyright law<sup>47</sup> – were considered necessary to identify the owner and to fix the term of protection.<sup>48</sup> Spain retained copyright protection, but complemented it with a related right in 1987,<sup>49</sup> mainly because copyright was limited to ‘artistic’ works. This did not exclude press photography in principle, but the bulk of photographs did not qualify for copyright.

Today, only the UK, Ireland and Malta still protect all types of photographs via copyright law, whereas the other countries mentioned above kept the two layers of protection separate. Austria led the way with a new Copyright Act in 1953, where the previous protection approach was retained in § 73 for ‘*Lichtbilder*’, but paralleled in § 3 with copyright protection (‘*Lichtbildwerke*’). Germany provided new provisions for both layers in the Copyright Act of 1965, namely § 2(1) No. 5 for photographic works and § 72 for photographs without the character of a work.

The Scandinavian countries had a rather independent development. From 1939 on, they co-operated more closely in the field of copyright law.<sup>50</sup> In 1947, Denmark took the initiative to jointly implement a uniform approach to the protection of photographs. In 1960 and 1961, the four countries passed new, independent legislation, which maintained the previously undifferentiated approach of comprehensive protection to photography.<sup>51</sup> It was not until 1995 that

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42. Walter Arthur Copinger, *The Law of Copyright in Works of Literature and Art* (Lawbook Exchange, 2008), 394 f., 398 f.

43. Art. 1 Ley de 10 de enero de 1879 de propiedad intelectual.

44. Art. 2 Copyright Act (1925), RDL 25/1950.

45. Arts. 87–92 Copyright Act (1941), L 633/1941, still in place today.

46. Luigi Carlo Ubertazzi, *Commentario Breve alle Leggi su Proprietà Intellettuale e Concorrenza* (7th edn., CEDAM, 2019), 1846 f.

47. See *infra* section 4.

48. See Eduardo Piola Caselli, *Codice del Diritto d'autore* (Editrice Torinese, 1943), 485.

49. Art. 118 Ley 22/1987 de Propiedad Intelectual (later amended as Art. 128).

50. Before that, Finland in 1927 had introduced two separate acts, a general protection of photographs as well as copyright protection; both acts, however, were overturned in 1961.

51. See for instance on Denmark Jørgen Blomqvist, ‘Denmark’ in Silke v Lewinski (ed.), *Copyright Throughout the World* (Westlaw, November 2017), § 13:9–13:14; see also Torben Lund, *Ophavsret: Kommenteret udgave af lovene af 31. maj 1961 om Ophavsretten til litterære og kunstneriske værker og Retten til fotografiske billeder* (G E C Gads Forlag, 1961), 327–332.

the Scandinavian countries abandoned their approach due to the implementation of Directive 93/98, which required copyright protection for photographs. In Norway, Sweden and Finland, the previous protection – together with copyright protection – was transferred to the existing Copyright Acts of 1960 and 1961, respectively, while in Denmark comprehensive reform took place in 1995.<sup>52</sup> Norway also retained the two layers of protection in 2018 in the course of comprehensive reform of the Copyright Act.<sup>53</sup>

The latest country to extend the protection of photographs was Switzerland. On the occasion of a partial revision of the Copyright Act in 2019, an idiosyncratic provision was introduced: ‘Photographic reproductions … shall be deemed to be works even if they do not have an individual character’ (Article 2(3<sup>bis</sup>)). Instead of establishing a related rights approach, this *contradictio in adiecto* fiction implements a blurred doctrinal concept in that all photography is subject to copyright protection irrespective of the general protection requirements of copyright law set out in Article 2(1).<sup>54</sup>

#### 4. PROTECTION FOR ‘PHOTOGRAPHS’ FROM TODAY’S PERSPECTIVE

From a purely economic perspective, any justification for protecting photographs below the threshold of copyright lost relevance when digital technology emerged. Meanwhile a veritable boom in the production of images has occurred. There is no indication of a market failure and the need for investment protection justifying an intervention into the freedom of third parties to use what is not copyright-protected.<sup>55</sup>

At the same time, there are professionals who make a living out of being able to market photographs commercially – regardless of the criteria for copyright protection. At sporting events, for instance, snapshots may capture irretrievable situations and have high market value, although lacking artistic value. In this case, legal protection may obviously not counter potential market failure – necessary investments are negligible. Rather, one may bring up value-based considerations.

This was the reason for the comparatively late introduction of related rights for photographs in Spain. That press photographs were largely excluded from copyright protection granted for ‘artistic’ works only was met with criticism.<sup>56</sup> Similar arguments were made more than two decades later in Switzerland – when digital photography had long been established and a vast flood of photographs

52. Rainer Oesch, ‘Nordic Countries’, in Ysoldé Gendreau, Axel Nordemann and Rainer Oesch (eds.), *Copyright and Photographs: An International Survey* (Kluwer, 1999), 231–233.

53. Ole-Andreas Rognstad, *Opphavsrett* (2nd edn., Universitetsforlaget, 2019), 27–34.

54. Cyrill P. Rigamonti, ‘On the New Copyright Protection for Non-Original Photographs in Switzerland’, 66 *GRUR Int.* (2020), 987 f.

55. From a general perspective Hugenholtz, *supra* note 8, 1007 f.

56. Raquel Xalabarder Plantada, ‘Comentario al Artículo 128’, in Felipe Palau Ramírez et al. (eds.), *Comentarios a la Ley de Propiedad Intelectual* (Tirant lo Blanch, 2017), 1480, 1485.

was already circulating on social networks.<sup>57</sup> Protecting any kind of photography today seems even more surprising, as the vast majority of those who post their pictures publicly are not interested in it at all. On the contrary, amateur photographers mostly enjoy seeing their pictures being liked and further disseminated. Thus, countless violations of rights take place every day, but nobody cares.

The only exception – even today – are those who make a living from photography. From a practical angle, however, the question arises as to whether they have to rely on a two-track system of protection, for the boundaries between the two layers are blurred; in most cases, only a dispute in court will determine whether a specific image enjoys copyright protection. Since this ‘risk’ always exists, commercial actors will avoid using any images without contractual authorisation. Even collecting societies that administer rights to photographs in practice do not decide about work quality; hence, they license for use in one way or another, and consequently also base that on the (longer) copyright term, and photographers participate in the distribution regardless of copyright protection.<sup>58</sup>

Seen in this light, the advantage of related rights is that they evade the proof that an image used without authorisation is copyright-protected. This advantage, however, disappears the lower the threshold for copyright protection is. This must be assumed in the EU based on Article 6 of Directive 2006/116.<sup>59</sup> Nevertheless, some Member States might pursue their earlier – stricter – practice. In Spain, for example, the related right for photographs is indeed criticised because press photographers still feel discriminated against if they enjoy protection through this layer alone, which is assumed given the requirement that the work must be ‘artistic’. Whether this is correct, however, is questionable as it would hardly be compatible with the low threshold required by EU law. On the other hand it is argued that the threshold in Switzerland is in fact higher than in the EU,<sup>60</sup> and it was precisely the professional photographers who – in contrast to Spain – lobbied for closing that gap below copyright law.

Yet, the scope of such extended protection – at least in the EU – is likely to be limited. After all, unauthorised uses primarily happen in social networks, for which Directive 2019/790 might have shifted the boundaries. Massive protests against the extended responsibility of hosting providers under Article 17 and the fear that ‘content generated by users’<sup>61</sup> could be blocked led to far-reaching exceptions. Paragraph 7 of that provision refers to traditional limitations – namely uses for purposes of quotation, criticism, review, caricature, parody or pastiche – and

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57. Anne-Virginie La Spada, ‘Switzerland: A Note Of Caution To Internet Players: Banal Photographs Now Enjoy Copyright Protection In Switzerland’, [www.mondaq.com/copyright/982832/a-note-of-caution-to-internet-players-banal-photographs-now-enjoy-copyright-protection-in-switzerland](http://www.mondaq.com/copyright/982832/a-note-of-caution-to-internet-players-banal-photographs-now-enjoy-copyright-protection-in-switzerland).

58. Frederik Truyen and Charlotte Waelde, ‘Copyright, Cultural Heritage and Photography: A Gordian Knot?’, in Karol Jan Borowiecki, Neil Forbes and Antonella Fresa (eds.), *Cultural Heritage in a Changing World* (Springer, 2016).

59. See *supra* note 26 and text accompanying it.

60. Ilva Johanna Schiessel, *Reichweite und Rechtfertigung des einfachen Lichtbildschutzes gem. § 72 UrhG* (Nomos, 2020), 298.

61. Art. 17 para. 7 Directive 2019/790.

obliges the Member States to allow uses of works for these purposes. Depending on how case law will interpret this, on online platforms falling under Article 17, legal protection – whether provided by copyright or a related right – thus might be limited to essentially unchanged uses.<sup>62</sup>

Now, Article 17(7) of Directive 2019/790 covers not only photographs, but also films, especially short videos uploaded to platforms and shared via social networks such as TikTok. In contrast to photographs, however, related rights for ‘moving images’ are mandatory under EU law.<sup>63</sup> Even those rights are increasingly held by people who have no interest in them. Just as in the case of photographs, incalculable numbers of infringements are not only tolerated, but may be desired for the dissemination of ‘user-generated content’.

This constantly growing flood of productions makes it ridiculous to speak of a risk of market failure – whether for photographs or films. The remaining difference between these two types of visualisations is that EU law only requires related rights for the latter – despite the lack of a need for investment protection.<sup>64</sup>

## 5. LEGAL PROTECTION OF CERTAIN GROUPS?

Repealing EU law for lack of need is practically unheard of, but existing Directives can at least be amended. Under changed factual circumstances, conditions for legal protection might be adopted and unequal scenarios subjected to differentiation. Legal protection below the threshold of copyright law, for instance, could – solely – be granted to those who depend on the exclusive exploitation of their products, which may include amateurs who wish to commercialise them now and then. Conversely, the use of photographs or videos might remain free if those who produced them – such as hobby photographers or makers of TikTok videos – do not need such protection.<sup>65</sup>

It is up to the legislature to require proof that legal protection is necessary at all. Ensuring economic efficiency, however, is not the only justification. Value-based considerations can also play a role. Unfair competition law, as it is known in some (above all civil law) jurisdictions, provides an example. Such legislation does not focus on ‘pure’ market failure in the macro-economic meaning, but tries to achieve some fairness and justice on a micro-economic level, thus ultimately also contributing to the functioning of markets. Since related rights are at least as connected to competition law as they are to traditional IP rights, fairness considerations could consequently also play a role here.<sup>66</sup>

Of course, fairness is a blurred criterion. The fact that professional photographers would find it unfair if their images may be freely used because they have an economic but no ‘artistic’ value does not in itself indicate an actual

62. Karina Grisse, ‘After the Storm – Examining the Final Version of Article 17 of the New Directive (EU) 2019/790’, 14 *JIPLP* (2019), 887 f., 897–899.

63. Text accompanying *supra* notes 20–24.

64. Hugenholz, *supra* note 8, 1007 f.

65. Schiessl, *supra* note 60, 271, 278–282.

66. Wolfgang Fikentscher, Philipp Hacker and Rupprecht Podszun, *Faireconomy: Crises, Culture, Competition and the Role of Law* (Springer, 2013), 49–95.

need for protection after weighing up all interests. Even if protection should prove necessary, it is no less important that what does not need protection remains allowed. In fact, granting exclusive rights is the exception that requires justification; in the first instance, liberal legislation has to ensure freedom of action. *De lege lata*, the sole focus lies on the subject matter of protection, no matter the circumstances under which photographs or videos are taken and used.

Differentiation is indeed possible if an exclusive right is not provided unconditionally. While substantive criteria of the subject matter do not play a role in the case of a related right, above all the question of its coming into existence is at issue. More particularly, formality requirements with a constitutive effect might apply. Prohibitions on formalities similar to those for copyright law (Article 5(2) BC) or certain related rights (e.g. Article 20 WPPT or Article 17 Beijing Treaty) do not exist related to photographs or films. Consequently, those seeking legal protection below the threshold of copyright – as far as there is still a need for that at all in case of a very low threshold as stipulated by Article 6 Directive 2006/116, which therefore rather might be possible outside the EU – could be subjected to an obligation to register their photographs (or films) in a certain form.

In Denmark, for example, the specific protection of photographs established in 1885 depended on registration and other formalities. Italy also required certain formalities to make the related right introduced in 1941 enforceable against third parties.<sup>67</sup> Today, formalities could be established far more easily, for example based on online registration also providing search options for users, or even based on blockchain technologies.<sup>68</sup> Furthermore, a registration fee – even a moderate one – might suffice for the great majority of potential right holders to forego such protection, especially those who upload pictures or videos for the fun of it. In the interest of transparency and legal certainty, one might also consider the requirement of marking authorised uses of protected photographs (or films).<sup>69</sup>

This is neither the place to develop an elaborate concept, nor should these reflections be interpreted as a statement in favour of a related right – even limited to certain actors. Rather, they may illustrate that a black-and-white approach to the protection of non-creative visualisation is neither inevitable nor necessarily sensible. To the extent that it may be justified, it is in any case not a matter of avoiding market failure due to the threat of underinvestment, but rather of doing justice to certain groups. In fact, drawing a line under the criteria for copyright law may appear arbitrary if photographs – such as those of sporting events – fall through the cracks, even though they have an economic or social value that the photographer should be able to realise monetarily.

At the same time, the reflections on the protection of photography should invite us to question the unconditional protection of ‘moving images’ required

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67. See Piola Caselli, *supra* note 48, 485; Ubertazzi, *supra* note 46, 1859; see also text accompanying *supra* note 48.

68. Michèle Finck and Valentina Moscon, ‘Copyright Law on Blockchains: Between New Forms of Rights Administration and Digital Rights Management 2.0’, 50 *IIC* (2019), 77–108.

69. Schiessel, *supra* note 60, 280 f.

by EU law. This protection, which is not imposed by international law, largely ignores today's reality of mass production by amateurs who neither need nor want to enforce their related rights. In this respect it is no different to amateur photography. Unlike photography, however, where legal protection below the threshold of copyright only exists in some Member States – which might consider subjecting it to certain conditions – the related right for films is not only mandatory in the EU, it exists without any restriction.

Interestingly, as far as professional film production is concerned, the existence of this related right does not seem to have a noticeable effect; otherwise fewer productions would be observed in countries without legal protection below the threshold of copyright. Institutional investors, who often stand behind film productions, obviously do not feel bothered by the limits of copyright protection in countries outside the EU. Consequently, it would be illogical to grant related rights anyway and justify them – because the risk of market failure obviously does not exist – based on fairness or justice if there is obviously no demand for this.

If one accepts at all that the justification of related rights may be rooted in value-based considerations, this suggests instead focusing on photographers in the first instance. Although neither photography nor film production, viewed realistically, are exposed to market failure, it seems easier to accept that individual photographers depend on being able to license the use of their images regardless of whether they are copyright-protected. Nevertheless, legal protection is in every case the exception that requires solid justification. After all, Bernt Hugenholtz is right: related rights are obsolete – at least as long as a proof is not provided that they are necessary. Merely feeling the need for fairness and justice is a poor guide for legislature – also in the case of photography.



# Quoting Copyrighted Sports Content Under Fair Use After *Google v. Oracle*

*Peter Jaszi*

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## 1. INTRODUCTION

Anyone who grew up following radio and TV sports programming in the United States has encountered versions of the following:

This copyrighted telecast is presented by authority of the Office of the Commissioner of Baseball. It may not be reproduced or retransmitted in any form, and the accounts and descriptions of this game may not be disseminated without express written consent.

The unyielding absolutism of such notices – examples of the sort of rights overclaiming Jason Mazzone has dubbed ‘copyfraud’ – is, of course, absurd. Nevertheless, their constant repetition over decades may have had an effect, leaving next-generation creators feeling confused or at least intimidated. This certainly seems to be the case where some of the documentary filmmakers I advise about copyright clearance issues are concerned. To the same effect, many of my clients believe that sports leagues are especially aggressive in their copyright enforcement activities – a proposition for which there seems to be no empirical evidence. But one thing certainly is true: when approached about licensing, the leagues do tend to drive hard bargains, often proposing rates that are out of reach for documentarians.

All that said, snippets of video and audio from games (and ancillary activities like press conferences and draft ceremonies), can be important to a film’s storytelling – functioning sometimes as objects of critique or commentary, sometimes as illustrations of the premise the director is developing, and sometimes as historical markers indicating something about the era in which the film is set. Thus – for my clients and others – the practical question often devolves into

this one: can a short clip of sports-related material be used without permission or payment in a new narrative context, under the so-called ‘fair use’ doctrine?

Fair use is a venerable part of US copyright law, dating back to the mid-nineteenth century in common law, but given statutory form until 1976. The courts have made it clear that fair use is one of the mechanisms by which copyright recognises the principle of freedom of expression that is enshrined in the First Amendment to the United States Constitution; without fair use, copyright law would risk being found unconstitutional when applied to expressive activities (including everything from scholarship to documentary filmmaking) – a point in *Eldred v. Ashcroft*, an otherwise disappointing 2003 opinion rejecting a constitutional challenge to legislation extending the term of copyright.<sup>1</sup>

Sec. 107 of the Copyright Act, where the doctrine is codified, directs anyone considering whether a particular challenged use is fair (rather than infringing) to consider, among other things, four factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

To perform this elaborate and indeterminate analysis is a lot to ask of a non-specialist federal judge, to say nothing of a filmmaker who is just trying to get ahead on a project. So, over the last quarter century, the courts have indicated that a critical consideration in evaluating most (if not all) of these factors, is whether the use can be considered transformative – whether it ‘adds something new, with a further purpose or different character’. That language is from a 1994 Supreme Court opinion, in *Campbell v. Acuff-Rose Music, Inc.*,<sup>2</sup> in which the court embraced an approach that had been pioneered by Judge Pierre Leval in both judicial opinions and a hyper-influential 1990 article.<sup>3</sup>

Over the quarter century since, the restiveness of a few outliers notwithstanding, we learned from the mainstream of lower court decisions that to be considered transformative, a use need not alter or modify the copyrighted material in question. ‘Transformativeness’ can also be achieved by recontextualising material – that is, presenting it in new and unexpected ways, juxtaposed with other content that adds to or alters its significance. The case law also reminded us that if a use is deemed transformative and non-substitutional, it also important to ask whether the amount used is appropriate (in quantity or quality) to the user’s

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1. U.S. Supreme Court, 15 January 2003, *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

2. U.S. Supreme Court, 7 March 1994, *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994).

3. Pierre N. Leval, ‘Toward a Fair Use Standard’, 103 *Harvard Law Review* (1990), 1105.

new purpose. But it also made clear if the answer is to this second question is ‘yes’, then finding of fair use is highly likely.<sup>4</sup>

Or perhaps I should say that we *thought* we’d learned these various propositions about fair use, as judicial applications of the *Campbell* precedent piled up, and the Supreme Court showed no apparent inclination to reinvoke itself – despite the blandishments of the so-called ‘content’ industries. Our comfortable assumptions were unsettled, however, when the Court agreed to hear the long-running *Google v. Oracle* lawsuit (described here in the words of Ronald Mann on the Scotusblog website):

The case involves a dispute about the Android operating system, which Google designed when it entered the smartphone market. Because Google wished that operating system to understand commands commonly used in the Java SE platform (now owned by Oracle), it used within Android about 11,000 lines of code from Java SE. The question for the justices is whether Google’s reuse of those lines of code violates the copyright laws. A jury held that Google’s actions were ‘fair use,’ but the U.S. Court of Appeals for the Federal Circuit held that Google violated Oracle’s copyright and that its actions as a matter of law could not be regarded as fair use.<sup>5</sup>

Some of us who generally approved of the way the law of fair use had been shaping up since *Campbell* hoped that rather than weighing in again on fair use, the Court might dispose of the case on the alternative basis that, thanks to the so-called ‘idea/expression’ distinction, the highly functional computer code in question might not have deserved copyright protection in the first place. On the other hand, and notwithstanding the highly technical nature of the facts in the dispute, ‘big content’ saw this as a chance for the justices to make reconsider fair use fundamentals – and perhaps retrench!

## 2. POSITION OF THE SPORTS LEAGUES

Where were the sports leagues in all of this? We get the best signal of their position from the ‘friend of the court’ brief filed by an umbrella organisation called the Copyright Alliance, which identified itself as representing the interests of rightsholders across the ‘spectrum of copyright disciplines’, including ‘book publishers, motion picture studios, video game publishers, software companies, music publishers, sound recording companies, sports leagues, broadcasters, guilds, unions, newspaper and magazine publishers, and many other organizations’. And what did the leagues and their allies want from the Court? As the Alliance brief put it:

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4. This ‘two-step’ analysis was nicely described by Neil Netanel, ‘Making Sense of Fair Use’, *15 Lewis & Clark Law Review* (2011), 715.
5. See Ronald Mann, *Scotusblog*, 5 October 2020, available at: <https://www.scotusblog.com/2020/10/case-preview-justices-to-weigh-in-on-landmark-copyright-battle-between-google-and-oracle/>.

Google seeks to capitalize on the muddled caselaw – starting with the most expansive notion of ‘transformative’ and then stretching the concept even further. This Court should reject Google’s arguments, and provide clarity to both creators and appellate courts as to what does and (critically) does not make a use ‘transformative.’ The Copyright Act defines a derivative work as one that is ‘based upon one or more preexisting works,’ including any ‘form in which a work may be recast, transformed, or adapted.’ 17 U.S.C. §101) ... If every ‘transformative’ use were a fair use, then fair use would negate Congress’s express grant to copyright owners of the exclusive right to create derivative works ... The time for clarity is now. This Court should make clear that the defense of fair use should be applied judiciously and that a loss of potential licensing revenue should not be ignored merely because the infringing material is moved from one medium to another, without any change in purpose.

Like the other copyright industry representatives (and there are many) who ultimately weighed in, the sports leagues and their allies in the Alliance were seeking not just ‘clarity’ in the abstract, but a message that the *Campbell* approach had gone too far. It’s not an accident that many of them relied heavily on a 2014 opinion by Judge Easterbrook of Seventh Circuit Court of Appeals, in *Kienitz v. Sconnie Nation LLC*,<sup>6</sup> directly questioning the centrality that transformativeness generally enjoys in fair use analysis, *Campbell* notwithstanding, opining (instead) that ‘[w]e think it best to stick with the statutory list, of which the most important usually is the fourth (market effect)’.

### **3. OUTCOME OF GOOGLE v. ORACLE**

So how did *Google LLC v. Oracle Am., Inc.*<sup>7</sup> turn out, and what does that outcome have to do with fair use of sports video and audio in documentary films (or – for that matter – narrative films in which invented characters relate or react in some way to sports, to say nothing of teaching materials and scholarly projects in which sports are related to larger social practices)? Obviously, Google’s *Campbell*-based fair use defence proved highly successful, with undoubtedly important consequences both for API’s in particular and software development in general. (For an indispensable discussion of these implications, I’d recommend Jonathan Band’s recent *Interfaces on Trial 3.0.*)<sup>8</sup> More important for present purposes is the fact that the six members of the Court who cross conventional ideological lines join in Justice Breyer’s majority opinion, reaffirming rather than modifying a general analytic approach, with its emphasis on transformativeness, as outlined above. There is simply no sign in the majority opinion of the sort of sea change in fair use jurisprudence that industry lawyers dare to hope the decision might

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6. U.S. Court of Appeals for the Seventh Circuit, 15 September 2014, *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014).

7. U.S. Supreme Court, 5 April 2021, *Google LLC v. Oracle America, Inc.*, 593 U.S. \_\_\_\_ (2021).

8. See Jonathan Band, *Interfaces on Trial 3.0*, available at: <http://www.policybandwidth.com/interfaces-3-0>.

bring; instead it is more of the same – which, for proponents of fair use, is the best possible outcome.

Almost – but not quite – as it turns out. That's because along the way to reinforcing *Campbell* and exploring its application to computer software, Breyer also sprinkles throughout his opinion some well-reasoned general thoughts on fair use that have obvious application beyond the specific facts of the case, addressing a number of general issues about which there had been uncertainty or even controversy among courts and lawyers working to interpret and apply the 1994 precedent. Some examples follow, focusing on some of these previously unresolved questions, and how *Google v. Oracle* helps to clarify the answers.

Thus, there is every reason to think that the more general language of the *Google v. Oracle* majority will shape future fair use jurisprudence every bit as much as its narrow ‘holding’. And while it may be true that this was an easy case because – according to J. Breyer – the computer code involved was ‘further than are most computer programs ... from the core of copyright’ (24 – the number referring to the page of the opinion as issued by the Supreme Court where the quotation occurs), the decision helps to anticipate harder cases, by answering some recurrent questions about how the *Campbell* approach to fair use should work in practice.

(Before addressing what those questions and answers are, here’s a slightly wonky paragraph on the status of so-called Supreme Court *dicta*, which any reader should feel free to skip over. It’s settled that well-reasoned conclusions of the Supreme Court deserve deference as strong predictors what the law should be, even when announced in contexts where they may not be – strictly speaking – essential to the ruling. As the Third Circuit Court of Appeals has put it,

Because the ‘Supreme Court uses dicta to help control and influence the many issues it cannot decide because of its limited docket,’ failing to follow those statements could ‘frustrate the evenhanded administration of justice by giving litigants an outcome other than the one the Supreme Court would be likely to reach were the case heard there.’

And now, back to the matter at hand, taking the points as they come in the Supreme Court opinion.)

### **3.1      Can Fair Use be Applied to the Sec. 106(2) Derivative Work Right?**

As is detailed above, this has become almost tediously familiar critique of the *Campbell* approach – a good example of how even a bad argument can accumulate apparent weight through repetition. So it is appropriate that Justice Breyer’s answer is both terse and conclusive:

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9. U.S. Court of Appeals for the Third Circuit, *Galli v. N.J. Meadowlands Comm’n*, 490 F.3d 265, 274 (3rd Cir. 2007), quoting *In re McDonald*, 205 F.3d 606, 612–613 (3rd Cir. 2000).

Like other protected works, that means that the owners of computer programs enjoy the exclusive rights set forth in the Act, including the right to 'reproduce [a] copyrighted work' or to 'prepare derivative works.' 17 U.S.C. §106. But that also means that exclusive rights in computer programs are limited like any other works.... [at 1199]

This seems to leave exactly zero room to argue that the reach of fair use is somehow limited or circumscribed in cases involving derivative works.

### **3.2     In Deciding whether a Use is Transformative, Does It Matter whether what Results from Its Circulation or Adoption is Good or Useful?**

In other words, is (or should) fair use be 'content neutral'? It's an issue that has come up in fair uses cases involving so-called 'appropriation art', where – consistent with US copyright law tradition – judges have often tried to eschew entering into questions about what constitutes good or important creative work. But Justice Breyer is having none of it:

Commentators have put the matter more broadly, asking whether the copier's use 'fulfill[s] the objective of copyright law to stimulate creativity for public illumination.' Leval 1111. In answering this question, we have used the word 'transformative' to describe a copying use that adds something new and important. Campbell, 510 U. S., at 579. [1203]

That seems to settle the question. And do note, please, that this new short-form explanation of transformativeness is a coinage not a quotation – that is, itself something 'new and important'. Clearly, it looks like a high level of intentionality can be ascribed to this formulation. Just as clearly, the language speaks strongly to users who are doing things with copyright material that are generally acknowledged to be socially or culturally productive – educators, scholars, journalists, filmmakers and others. There will be a bit more about this feature of the opinion in what follows.

### **3.3     Does a 'Transformative' Use Need to Modify the Underlying Original in Some Way?**

One might imagine that a quarter-century of more or less consistent lower court precedents would have put paid to this particular uncertainty, but they have not. Documents purporting to 'advise' creators and others about fair use suggest far too often that intervention in an existing work is someone more 'fair use worthy' than its recontextualisation. Indeed, an echo of this doubt can be heard in the Copyright Alliance brief quoted above, which seeks to cast doubt on whether the doctrine can apply where 'infringing material is moved from one medium to another' – a common mode of repurposing. In any event, Justice Breyer seems to resolve any remaining doubt:

An ‘artistic painting’ might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted ‘advertising logo to make a comment about consumerism.’ [1203, quoting 4 *Nimmer on Copyright* §13.05[A][1][b], which in turn quotes Netanel at 7465]

So when (for example) a snippet of sports video is transposed from an event-centric video to a documentary about the history of a team or athlete, that constitutes a ‘fair use eligible’ event. Enough said.

### **3.4      Should the Focus of the Inquiry Be on the Immediate Defendant’s Use Only, or Do ‘Downstream’ Uses Come into Play in Determining Transformativeness?**

I would put the answer to this question into the category of ‘secret knowledge’ – known to practitioners but never authoritatively articulated as a general principle in caselaw. That said, there are plenty of prior examples of the principle in action – one of the most interesting being the discussion of accessibility issues in *Authors Guild v. HathiTrust*,<sup>10</sup> where it is made clear that the fact that blind readers will be able to access books justifies scanning them into a database. But it is a secret no longer:

Rather, in determining whether a use is ‘transformative,’ we must go further and examine the copying’s more specifically described ‘purpose[s]’ and ‘character.’ Here Google’s use of the Sun Java API seeks to create new products. It seeks to expand the use and usefulness of Android-based smartphones. Its new product offers programmers a highly creative and innovative tool … [a purpose] consistent with that creative ‘progress’ that is the basic constitutional objective of copyright itself. [1203]

In fair use analysis, the end can justify the means, as the anticipated virtuous nature of an end user’s activities reflects positively onto the upstream entity that enables them. Thus, for example, the intention to disseminate useful knowledge to an audience – this being the ultimate goal served by ‘creative “progress”’ – helps support the fair use claims of a journalist or filmmaker.

### **3.5      How Concerned Should We be about Commercialness in Cases of Otherwise Transformative Use?**

We have – or should have – known the answer to this question for decades – long before *Campbell*, in fact. But thanks to a rash and unsupported *dictum* in the 1984 Supreme Court opinion resolving *Sony Corp. of America v. Universal City Studios, Inc.*,<sup>11</sup> however, there has been persistent doubt about whether commercial uses

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10. U.S. Court of Appeals for the Second Circuit, 10 June 2014, *Authors Guild, Inc. v. Hathitrust*, 755 F.3d 87 (2nd Cir. 2014).

11. U.S. Supreme Court, 17 January 1984, *Sony Corporation of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

may be somehow disfavored in fair use analysis. In fact, this doubt has sometimes blossomed into outright bad advice, to be found online and elsewhere, to the effect that fair use only works for non-commercial projects (however these may be defined). Recently, we have seen uncertainty about this issue leaking back into federal court decisions, such as the strangely muddled 2020 Second Circuit opinion in *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*.<sup>12</sup> Now, however, that uncertainty should be at an end, once and for all:

There is no doubt that a finding that copying was not commercial in nature tips the scales in favor of fair use. But the inverse this not necessarily true ... many common fair uses are indisputably commercial. For though Google's use was a commercial endeavor – a fact no party disputed ... – that is not dispositive of the first factor... [1204].

Enough, for now, of what *Google v. Oracle* teaches about the statutory first factor in fair use analysis. Moving along, we find a few persistent questions about other factors, as well.

### **3.6      How Exactly, are We to Assess ‘Substantiality’ for Purposes of Factor Three?**

Sec. 107(3) invites us to consider the ‘amount and substantiality’ of the ‘portion used’ in relation to the copyrighted source work as a whole. And while the first term may be read as inviting an objective inquiry, the second one seems to require a more subjective approach. Over time, confusion about what form this might take (which, it must said, *Campbell* may not have fully anticipated) has helped to generate various unreliable rubrics – for example, that fair users should never use more material than is ‘necessary’ to fulfil their purposes. There is a problem, however, with such an approach: the minimum possible won’t always be optimal for either the fair user or the audience, as when a slightly longer clip of sports footage might illustrate the event or the technique significantly better. *Google v. Oracle* acknowledges this by offering the following formulation:

The ‘substantiality’ factor will generally weigh in favor of fair use where, as here, the amount of copying was tethered to a valid, and transformative, purpose. *Supra*, at 25–26; see *Campbell*, 510 U. S., at 586–587 (explaining that the factor three ‘enquiry will harken back to the first of the statutory factors, for ... the extent of permissible copying varies with the purpose and character of the use’). [1205]

This language represents an important reaffirmance (and clarification) of *Campbell* and should help bring about further coalescence around an ‘appropriateness’ standard that both courts and practitioners can apply situationally. It also makes clear, in case such clarification was necessary, that sometimes (as in the case of a news photograph) taking the entire work may be the ‘right size’ solution.

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12. U.S. Court of Appeals for the Second Circuit, 26 March 2021, *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 992 F.3d 99, especially at 116 (2nd Cir. 2021).

### 3.7 In Cases Involving Transformative Use, what Kinds of Market Harms Count for Purposes of the Fourth Fair Use Factor?

*Campbell* doesn't address this question in terms, but since at least 2006, when the Second Circuit decided *Bill Graham Archives v. Dorling Kindersley, Ltd.*,<sup>13</sup> there has been a general consensus around the proposition that in such cases, the only losses that matter are those that result from substitution effects – in other words, that lost licensing opportunities, as such, should not be part of the calculation. Recently though (the *Goldsmith* decision mentioned above being a good example), some judicial backsliding on this issue has been detectable. And, of course, this is one of the areas in which the Copyright Alliance *amicus* brief that was quoted earlier in this chapter had invited the Supreme Court to reconsider the progeny of *Campbell*. Instead, however, Justice Breyer insisted on clarifying the nature of the fourth factor inquiry as follows:

Consideration of this factor ... can require a court to consider the amount of money that the copyright owner might lose. As we pointed out in *Campbell*, 'verbatim copying of the original in its entirety for commercial purposes' may well produce a market substitute for an author's work ... Making a film of an author's book may similarly mean potential or presumed losses to the copyright owner. Those losses normally conflict with copyright's basic objective: providing authors with exclusive rights that will spur creative expression. [1206]

## 4. PROMISING NEW DIRECTION IN FAIR USE ANALYSIS

Finally, it is worth noting that, in its discussion of the fourth fair use factor, *Google v. Oracle* addresses a topic that few may have imagined was even in play. In general, we accept that fair use (like other doctrines that limit the reach of copyright) promote a public interest in access to information. But there has been little indication, at least in recent caselaw, that how particular fair uses could confer specific benefits on the public had a place in balancing of interests. In *Google v. Oracle*, however, the following language appears:

Further, we must consider the public benefits the copying will likely produce. Are those benefits, for example, related to copyright's concern for the creative production of new expression? Are they comparatively important, or unimportant, when compared with dollar amounts likely lost (taking into account as well the nature of the source of the loss) ...

We do not say that these questions are always relevant to the application of fair use, not even in the world of computer programs. Nor do we say that these questions are the only questions a court might ask. But we do find them relevant here in helping to determine the likely market effects

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13. U.S. Court of Appeals for the Second Circuit, 9 May 2006, *Bill Graham Archives, Plaintiff-appellant, v. Dorling Kindersley Limited*, 448 F.3d 605 (2nd Cir. 2006).

of Google's reimplementation. [1206, with citations – including a fascinating reach-back to *MCA v. Wilson*, 677 F.2d (2d. Cir. 1981) – omitted]

Where the first fair use factor inquiry into 'purpose' is concerned, *Google v. Oracle* offers useful clarifications and answers some unresolved questions. But with respect to analysis of economic consequences from unlicensed uses that the fourth factor mandates, the decision goes further, by introducing a whole new category of considerations. It remains to be seen what courts will make of this invitation to broaden the inquiry by taking public value added into account along with private monetary losses. But it is at least possible that the language in question will launch a new and promising direction in fair use analysis. Potential fair users of sports material would have much to gain from such development.

## Part 5

# New Technologies and Future Developments



# Keeping the Field of Play Level:<sup>1</sup> Volition, Causation and Responsibility in American Copyright Law<sup>2</sup>

*Paul Goldstein*

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## 1. INTRODUCTION

Two contemporary developments in American copyright law threaten to tilt liability disproportionately away from equipment and service providers. One is the judge-made requirement introduced in 1995,<sup>3</sup> and since followed in several judicial circuits,<sup>4</sup> that in order to avoid the imposition of ‘unreasonable liability’<sup>5</sup> only conduct animated by ‘volition or causation’ should be treated as direct infringement. The other is the implicit tightening of the requirements for indirect, or secondary, infringement as a consequence of the dramatic expansion of the fair use defence to exonerate not only widespread noncommercial uses such as home taping,<sup>6</sup> but also to encompass so-called transformative uses,<sup>7</sup> because an equipment or service provider will not be held secondarily liable in the

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1. This contribution’s title is of course a hat-tip in the direction of Bernt Hugenholtz’s questionable fascination with sports events. But is also a bow in the direction of Bernt himself, for no scholar has taught me more about the intimate link between the welfare of consumers and creators of copyrighted works.
2. I am grateful to Professor Michael Green for his insights into American tort law.
3. *Religious Technology Center v. Netcom On-Line Communication Service, Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995).
4. See, e.g., *BWP Media, USA, Inc. v. T&S Software Assocs*, 852 F. 3d 436 (5th Cir. 2017); *Perfect 10 v. Giganews, Inc.*, 847 F. 3d 657 (9th Cir. 2017); *Leonard v. Stemtech Int’l, Inc.*, 834 F.3d 376, 387 (3rd Cir. 2016); *Cartoon Network LP, LLP v. CSC Holdings, Inc.* 536 F.3d 121, 131 (2d Cir. 2008); *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F. 3d 544 (4th Cir. 2004).
5. *Netcom*, *supra* note 3, at 1369.
6. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).
7. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

absence of another party's primary liability,<sup>8</sup> any reduction of primary liability, as through a widened fair use defence, will inevitably reduce the occasions for secondary liability.

Direct copyright infringement under American law is a rule of strict liability and requires no proof by the copyright claimant of the alleged infringer's knowledge or intention.<sup>9</sup> Indirect infringement, by contrast, variously requires the copyright owner to prove, in addition to a third party's direct infringement, that the alleged secondary infringer had knowledge of, and materially contributed to, the direct infringement ('contributory infringement');<sup>10</sup> had control over and a financial interest in the direct infringement (vicarious liability);<sup>11</sup> or induced the direct infringement.<sup>12</sup> These rules evolved from judicial decisions dealing principally with actors who, though they did not pull the trigger themselves, were sufficiently close to the direct infringer to control his actions, and can be traced to the general jurisprudence governing joint tortfeasors and master and servant.

Two successive generations of consumer technologies for the reproduction and performance of copyrighted works – video recorders are a central example of the first generation, peer-to-peer file sharing a central example of the second – have substantially heightened the demands on copyright law to mediate secondary liability in cases where an important contributor to the infringement – a producer of videorecorders or an internet service provider – is insufficiently proximate to the direct infringer to know of or control his activities. In the landmark *Sony v. Universal* case<sup>13</sup> the United States Supreme Court ruled that, even if home copyists directly infringed copyright in the plaintiff film studios' works, Sony could avoid liability by showing that its Betamax recording devices possessed a substantial noninfringing use. And twenty-one years later, when the Justices of the Supreme Court could not agree on whether Grokster's peer-to-peer service had a substantial noninfringing use, they were nonetheless able to join in holding that the service could be held secondarily liable for inducing infringement by subscribers.<sup>14</sup>

Great as were the policy demands presented by a vastly burgeoning and disruptive internet, the US Congress's effective abandonment of copyright lawmaking over the two decades from 1999 to 2018 left it to the nation's courts to sort out the implications of the new technology's transformation of copyright markets during that period. Courts, which can excel in filling legislative interstices and nudging doctrine in the correct direction, are less effective in navigating large-scale, multifaceted change. The result has been a patchwork of fact-specific judicial rulings, well-intentioned, to be sure, but lacking a deep-seated rationale capable of resolving future conflicts as well as the most immediate ones, conflicts

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8. See Paul Goldstein, *Goldstein on Copyright*, vol. 3 (2021), §8.0.

9. Paul Goldstein, *Goldstein on Copyright*, vol. 2 (2021), §7.0.1.

10. Goldstein, *supra* note 8, §8.1.

11. *Ibid.*, §8.2.

12. *Ibid.*, §8.1.3.

13. 464 U.S. 417 (1984).

14. 545 U.S. 913 (2005).

in which it is plainly evident by any historical measure that, though infringement has occurred, no infringer may be held to answer for it.

Who suffers when there is wide-scale copyright infringement without copyright infringers? Film studios, record labels, literary and music publishers, though they raise the loudest alarm, will suffer only short-term losses and then shift their investments to more rewarding activities, sometimes to the very dissemination technologies that prompted the shift. Over the longer term, members of the creative community will suffer, as they find both fewer corporate intermediaries to disseminate their works and possibly fewer consumers willing to pay for them. But it is consumers of creative fare who will ultimately suffer as the stream of diverse and high quality fare grows narrower. Copyrightable works will of course continue to be produced and distributed. But the empirical literature on the impact of copyright protection on creativity strongly indicates that, in a world without enforceable copyright, creative products will not be the rich and diverse fare to which consumers have increasingly grown accustomed over the past two centuries.<sup>15</sup>

## 2. VOLITION

Several, but far from all, federal appellate courts have so far adopted some form of volition requirement. The US Supreme Court has to date declined the opportunity to explicitly adopt or reject such a requirement, although it came close in *American Broadcasting Cos., Inc. v. Aereo, Inc.*<sup>16</sup> The Court there held that, in deploying a system of minuscule antennas, each dedicated to streaming broadcast content to one subscriber at a time, defendant Aereo was sufficiently implicated in the transmission of the works to the public to be held liable for copyright infringement. In the Court's view, far from being simply an equipment provider, 'Aereo sells a service that allows subscribers to watch television programs many of which are copyrighted, almost as they are being broadcast. In providing this service, Aereo uses its own equipment, housed in a centralized warehouse, outside of its users' homes.'<sup>17</sup>

Dissenting, Justice Antonin Scalia thought the Court should have addressed the volition requirement directly, and synthesised from the lower court decisions a rule that 'the volitional-act requirement demands conduct directed to plaintiff's copyrighted material ... Aereo does not "perform" for the sole and simple reason that it does not make the choice of content.'<sup>18</sup> Justice Stephen Breyer, writing for the Court majority, answered that, in light of 'Aereo's overwhelming likeness to cable companies targeted by the 1976 [Copyright Act] amendments, this

15. Compare Kal Raustiala and Christopher Sprigman, *The Knockoff Economy* (2012) (chefs and comedians do not need copyright to invest in creating low-expression products like recipes and jokes) with Michela Giorcelli and Petra Moser, *Copyright and Creativity: Evidence from Italian Operas* (SSRN 2505776, 2014) (high-expression works require copyright to sustain investment in their creation).

16. 573 U.S. 431 (2014).

17. 573 U.S. at 442.

18. 573 U.S. at 457.

sole technological difference between Aereo and traditional cable companies does not make a critical difference here.<sup>19</sup> According to Breyer, traditional cable subscribers similarly ‘selected what programs to display on their receiving sets’ and whatever technical difference separates the two kinds of systems ‘means nothing to the subscriber. It means nothing to the broadcaster’.<sup>20</sup>

The volition doctrine was first introduced into American law by a federal district court in California in *Religious Technology Center v. Netcom On-line Communication Service, Inc.*<sup>21</sup> where the court ruled that defendant Netcom, a passive internet host, was not directly liable for infringing plaintiff’s copyright because ‘[a]lthough copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant’s system is merely used to create a copy by a third party’.<sup>22</sup> In the court’s view, ‘it does not make sense to adopt a rule that could lead to the liability of countless parties whose role in the infringement is nothing more than setting up and operating a system that is necessary for the functioning of the Internet’.<sup>23</sup>

Professor Robert Denicola has noted the imprecision of both labels – ‘volition’ and ‘causation’ – employed by the *Netcom* court to determine the liability of institutionally distant actors such as internet service providers. ‘Volition,’ he observes, ‘is an unfortunate label for the court’s concern, which seems directed not at a characteristic of the defendant’s conduct, but instead at whether the defendant has in fact engaged in conduct that is sufficient to meet each of the required elements of liability for copyright infringement.’ ‘Causation,’ in his view, ‘also diverges from its customary meaning, here inquiring into whether the defendant’s conduct has caused the tort, rather than its customary focus on whether the tort has caused the harm for which relief is sought’.<sup>24</sup>

*BWP Media USA, Inc. v. Polyvore, Inc.*<sup>25</sup> – an unusual decision in which the three appellate judges on the bench each disagreed with the other on the legal content of volition and causation – offers a helpful introduction to the meaning of these terms in contemporary American copyright jurisprudence. Defendant Polyvore, Inc. maintained a website that enabled users of its ‘Clipper’ tool to clip copyrighted images, among them some owned by plaintiff BWP, from other websites, to be manipulated, stored and shared with other Polyvore users. Uploading of an image to the Polyvore site would trigger several automatic processes linking the image back to its original site, assigning a URL to it and indexing the photo so that it became searchable on the site. Finding that only the site’s users, and not Polyvore, had acted volitionally, the trial court gave summary judgment to Polyvore. The three appellate judges, though each going his and her own way on the questions of volition and causation, agreed that the

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19. 573 U.S. at 444.

20. 573 U.S. at 444.

21. 907 F. Supp. 1361 (N.D. Cal. 1995).

22. 907 F. Supp. at 1370.

23. 907 F. Supp. at 1372.

24. Robert C. Denicola, ‘Volition and Copyright Infringement’, 37 *Cardozo L. Rev.* (2016), 1259, 1262.

25. 922 F. 3d 42 (2d Cir. 2019).

case should be remanded so that the trial court could make a fact finding as to whether, in addition to its automated processes, Polyvore created copies of the plaintiff's photographs not requested by its subscribers.

Judge John M. Walker, Jr., in his concurring opinion, observed that '[a]n ISP acts volitionally when it creates a program designed to infringe copyrighted material and selects the copyrighted material that it copies'.<sup>26</sup> By contrast, 'the volitional conduct requirement is not satisfied when an ISP simply displays user-uploaded images and plays no role in selecting the images'<sup>27</sup> or 'automatically makes a single copy of content selected by the user in response to a user's request'.<sup>28</sup> Walker rejected the view of Judge Jon O. Newman, concurring in the result, 'that the volitional conduct requirement should be understood as a causation requirement'.<sup>29</sup> In Walker's view, the *Netcom* court, in speaking of 'volition or causation' was 'positing two possibilities, not one'.<sup>30</sup> For Walker, 'secondary liability is the proper framework for holding an ISP liable for copyright infringement when the ISP does not select the copyrighted material and make the infringing copy itself, but is aware of it and encourages or contributes to the infringement by the direct volitional infringer'.<sup>31</sup>

One fault with the selection-as-volition approach is that it overlooks the fact that American copyright law nowhere requires courts to choose between one infringer and another when the acts of two or more in concert result in infringement. The concept of joint tortfeasors is as fundamental to American copyright law as it is to American tort law generally; the fact that one actor selected the work to be copied and the other provided the software for doing so no more exonerates the second actor than tort law would exonerate the individual who hands a gun and bullets to the juvenile who aims and squeezes the trigger.

The selection-as-volition approach also risks requiring that a human finger squeeze the trigger in order for infringement to be found. In another of Judge Walker's opinions<sup>32</sup> the appellate court exonerated a cable service provider whose remote digital video recorder system recorded on the company's servers only programs selected by its customers, holding that '[i]n determining who actually "makes" a copy, a significant difference exists between making a request to a human employee, who then volitionally operates the copying system to make the copy and issuing a command directly to a system, which automatically obeys commands and engages in no volitional conduct'.<sup>33</sup> But if volition is all that is required, then the cable system did act volitionally in creating a complex system that, as described by the trial court, required 'numerous computer processes,

26. 922 F.3d at 50.

27. 922 F.3d at 50.

28. 922 F.3d at 50.

29. 922 F.3d at 52.

30. 922 F.3d at 52.

31. 922 F.3d at 53.

32. *Cartoon Network LP, LLP v. CSC Holdings, Inc.*, 536 F. 3d 121 (2d Cir. 2008).

33. 536 F.3d at 132.

networks of cables, and facilities staffed by personnel twenty-four hours a day and seven days a week'.<sup>34</sup>

So-called recommendation engines already exist that, fuelled by data on a consumer's past entertainment choices, will highlight new choices likely to fit the consumer's taste. Advances in artificial intelligence will soon enough refine these recommendation engines to the degree that they will be more accurate than the consumer in choosing an evening's entertainment fare. If employed by a streaming company, as such engines commonly are, any copyright obligations will presumably be accounted for in the company's overall licence with its content providers. But, what if the service is offered apart from any licensed activity by a stand-alone service provider? Will the provider be held accountable on the ground that its software selected content and for that reason infringed? Or will it be excused on the ground that selection was accomplished by artificial rather than human intellect?<sup>35</sup>

### 3. CAUSATION

Judge Walker's principal objection to Judge Newman's emphasis on causation was that it imported *proximate* causation into volition analysis: 'First, volition has textual underpinnings in the Copyright Act, whereas proximate causation does not. Second, because proximate causation is a concept that sounds in negligence and deals with the foreseeability of risks, it seems out of place to apply it to a strict liability tort like direct infringement. Third proximate causation has an opacity and imprecision that has generated significant confusion'.<sup>36</sup>

For Judge Newman, though, causation well antedated, and is indeed a source of, the volition requirement for direct infringement. 'Long before *Netcom*, there was no doubt that when the identity of a person liable for direct infringement was disputed, it was necessary to prove who caused the infringement'.<sup>37</sup> Nor in Newman's view does the identification of a single actor as the cause necessarily preclude the identification of one or more other actors as the cause of the same infringement. 'The legislative history of the 1976 Copyright Act recognized that "where the work was infringed by two or more tortfeasors, the bill would make them jointly and severally liable"'.<sup>38</sup> Newman cited with evident approval a trial court decision in the circuit that identified the line 'a system operator crosses to become jointly liable with a user for direct infringement' by considering whether

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34. *Twentieth Century Fox Film Corp. v. Cablevision Systems Corp.*, 478 F. Supp.2d 607, 612 (S.D.N.Y. 2007).

35. For excellent high-level analyses of these issues see Yavar Bathaei, 'The Artificial Intelligence Black Box and the Failure of Intent and Causation', 31 *Harv. J. L. & Tech.* (2018) 889; Mala Chatterjee and Jeanne C. Fromer, 'Minds, Machines, and the Law: The Case of Volition in Copyright Law', 119 *Colum. L. Rev.* (2019) 1887.

36. 922 F.3d at 53 (citations omitted).

37. 922 F.3d at 62.

38. 922 F.3d at 66 (citation omitted).

the operator was merely a passive provider of space in which infringing activities occur or an active participant in 'the process of copyright infringement'.<sup>39</sup>

The essential difference between Judge Walker and Judge Newman's construction of 'volition' is that where Walker employed the term to effectuate what might appear to be a principle of certainty – identify the individual who selected the work, and stop there – Newman employed it to effectuate a multifaceted principle of responsibility and proportionality. Judge Rosemary S. Pooler picked up on this theme in the decision's third concurrence. For Judge Pooler, 'the question will boil down to whether Polyvore is sufficiently tied to the act of copying for direct infringement liability to attach'. Specifically, Judge Pooler could not 'agree with conceptualizing volitional conduct in such a way that an ISP does not act volitionally when it automatically makes one, but not more than one, unrequested copy in response to a user's request for a copy'.<sup>40</sup>

No one will seriously argue that the defendants in *Netcom* and *Polyvore* did not act volitionally when they set up, operated and maintained their extensive software-based services. The companies did not simply stumble upon the systems. In the dictionary sense of the word, each company engaged in 'the act of willing, choosing, or resolving'.<sup>41</sup> Viewed through the lens of responsibility, the pertinent question is whether each company's conduct was such that it made the company jointly liable with its users and subscribers for direct copyright infringement.

The doctrine of proximate cause (also called 'legal cause'), adverted to by Judge Newman in *Polyvore*, better captures the concept of responsibility than any other, and certainly better than Judge Walker's mechanistic formula for volition. Proximate cause in American negligence law asks whether the harm to an individual resulting from an action could reasonably have been foreseen by the actor.<sup>42</sup> Among other questions, American tort law also asks which party, the plaintiff (copyright owner) or the defendant (equipment or service provider), is better placed to avoid the injury.<sup>43</sup> Adjusted to fit the contours of injuries to property rather than to person, Professor Denicola, cited approvingly by Judge Newman in *Polyvore*, would have proximate cause ask whether the *infringement* resulting from the action could reasonably have been foreseen by the actor. By centring on foreseeability of infringement rather than injury, this reformulation of proximate cause for copyright would make general principles of joint liability the pivot on which liability for direct copyright infringement will turn.

#### 4. RESPONSIBILITY

The restraining principle behind *Netcom*'s introduction of volition into copyright law's requirements for direct infringement was that copyright liability must stop

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39. 922 F.3d at 67, citing *Capitol Records, LLC v. Re Digi, Inc.* 934 F. Supp.2d 640, 657 (S.D.N.Y. 2013).

40. 922 F.3d at 69.

41. *Webster's Unabridged Dictionary* (2nd edn., Random House, 2001).

42. Dan B. Dobbs, Paul T. Hayden and Ellen M. Bublick, *Hornbook on Torts* (2nd edn., 2016) 265.

43. *Ibid.* at 388.

somewhere if the law is not entirely to frustrate innovation in technologies for delivering entertainment and information. The US Supreme Court in the *Sony* case similarly applied the copyright brakes by introducing the patent statute's formula of 'substantial noninfringing use' into the copyright equation.<sup>44</sup> One difference between the approaches taken in *Netcom* and *Sony* is that where *Netcom* employs volition to promote technological investment without regard for the rule's impact on investment in literary and artistic production, doctrines like *Sony*'s substantial noninfringing use and Judge Newman's proximate cause in *Polyvore* balance incentives for technological, often patentable, innovation against incentives for literary and artistic creativity. Such balancing is of course more characteristic of legislative than of judicial lawmaking. Indeed, the Supreme Court majority in the *Aereo* case rejected Justice Scalia's harsh selection-as-volition rule by observing the *Aereo* system's similarity to cable television and relying by way of analogy on Congress's balanced resolution of cable liability in the 1976 Copyright Act.

A second difference between *Sony* and the *Netcom* progeny such as *Aereo* and *Cartoon Networks* is that where *Sony* cast true technological advance in the balance, the technologists in *Aereo* and *Cartoon Networks* had invested their efforts not in technological advances (the underlying technologies in both cases were old) but rather in retrograde technologies – software tools designed by lawyers rather than engineers – possessing no object other than to circumvent copyright liability.

What would a rule of volition look like that replaced the Second Circuit's binary selection-as-volition rule with a more nuanced approach like the one adopted, albeit implicitly, in *Aereo*? At the highest level of abstraction, the rule would look like any one or more of the many balances struck by the US Congress in the 1976 Copyright Act or, for that matter, as was the case in *Sony*, in the Patent Act. Structurally, and employing Judge Newman's preference for proximate cause, the inquiry would encompass not only the equipment or service provider's ability to foresee the infringement but also its relative capacity to avoid the resulting harm.

At a more granular, operational level, a balanced doctrine of volition would approximate many of the elements already employed by the judge-made law of secondary liability to test the legitimacy of equipment used in copyright infringement. Like contributory infringement doctrine, the doctrine would inquire into the equipment's connection to the infringement and its substantial noninfringing uses, as well as the provider's knowledge, actual or constructive, of the uses being made of the equipment. Like vicarious liability, it could inquire into the provider's financial interest and control of these uses. Like inducement liability, it would ask how intimately connected the provider and its equipment are to the use. And, like the seminal *Netcom* decision itself, it can ask whether granting copyright remedies will impose 'unreasonable liability'.<sup>45</sup>

All that would be missing from such an inquiry is secondary liability's requirement that the use of the equipment constitute direct infringement by

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44. 464 U.S. at 440.

45. *Netcom*, *supra* note 3, at 1369.

another; but, of course, the direct infringement in these cases would have been committed by the equipment provider itself. This is as it should be, for as Justice Breyer observed in the *Aereo* case, the technical difference between the defendant's system and the sorts of cable systems that are indisputably subject to liability under the statute made no difference either to subscribers or to broadcasters.<sup>46</sup> Looking to the other side of the playing field, the economic injury to the copyright owner is the same, whether inflicted by man or machine; the fact that an algorithm was the culprit offers neither solace to the copyright owner nor incentives to the continued distribution of the widest variety of literary and artistic works at the lowest possible price.

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46. 573 U.S. at 444.



# The Missing Goal-Scorers in the Artificial Intelligence Team: Of Big Data, the Right to Research and the Failed Text-and-Data Mining Limitations in the CSDM Directive

*Christophe Geiger*

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## 1. INTRODUCTION (IN HONOUR OF BERNT HUGENHOLTZ)

Paying tribute to Professor Bernt Hugenholtz is not an easy task. For many reasons, the bar is extremely high: first, because he has been so influential in what can be labelled the ‘reformist approach’ to copyright law, which generated a large crowd of academic disciples across various generations (including the author of these lines), and which proposed an alternative view to the mainstream traditional pro-rightholder copyright thinking that had strongly prevailed until some critical thoughts emerged in Europe. Secondly, because he contributed strongly to the emergence of what has been labelled ‘information law’, viewing copyright as a part of a broader construction where freedom of expression and information constitute a founding principle irradiating on the understanding and interpretation of basic copyright principles. Thirdly, because he can be considered a true European, with most of his scholarship being directed at creating a better European framework for copyright and IP law in general, and in supporting the idea that scholars of various countries should come together and play an active part in shaping the future of this legal field by doing something that is relevant at the policy level. I could add a fourth and fifth point, etc., ... but I will limit myself to this last consideration: there is a true challenge of writing a contribution for Bernt knowing he will actually have to read all the articles of his *Festschrift* and provide comments on it (as the tradition demands), while not being sure if he would not rather prefer to have a chat or a good laugh in a bar in Barcelona, Amsterdam, Montpellier or Budapest (or a fifteen course dinner

at Le Crocodile!). Anyway, as both endeavours are not necessarily mutually exclusive (*Festschrift* and beer), I am most happy and honoured to dedicate to him these few lines to thank him for his work and for being a great inspiration for my own scholarship, choosing a topic that is at the intersection of many of the themes he is interested in and has been writing about for years, and to which he has fundamentally contributed. Incidentally, it is also the last copyright topic which we discussed just before Europe went into lockdown, on the occasion of a public lecture given at the Institute for Information Law<sup>1</sup> in Amsterdam, which he directed with great talent for so many years.

## **2. AN AMBITIOUS DIGITAL STRATEGY FOR THE EUROPEAN UNION, BUT NO REFLECTION ON THE ROLE OF IP AND ITS LIMITATIONS**

On 19 February 2020, the European Commission announced an ambitious digital strategy for the European Union, setting out the objectives to be achieved in two communications – one on Europe’s digital future<sup>2</sup> and one on data<sup>3</sup> – both complemented by a White Paper on artificial intelligence.<sup>4</sup> Reading these strategic documents, one could hope that a sound and considered legal framework for the digital environment would finally be elaborated, and that EU policies in this area will in the future constitute more than a simple patchwork of sectorial interests. Indeed, with regard to the revolution that digital technology has brought to a large number of sectors within the EU, it reads: ‘This substantive societal transformation calls for a profound reflection at all levels of society as to how Europe can best meet, and continue to meet, these risks and challenges. It will require a huge effort, but Europe undoubtedly has the means to bring about this better digital future for everyone’.<sup>5</sup> Or: ‘Creating a Europe fit for the digital age is a complex puzzle with many interconnected pieces; as with any puzzle, the whole picture cannot be seen without putting all the pieces together’.<sup>6</sup> The will to finally modernise and adapt the legal framework on IP to the challenges posed by the digital environment has been reiterated in the action plan of the European Commission on IP, published at the end of November 2020, where it was emphasised that

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1. Christophe Geiger, ‘Making Europe fit for the Digital Age? Big Data, Artificial Intelligence, Freedom of Information and the failed Text and Data Mining provisions in EU Copyright law’, Public lecture given at Institute for Information Law (IViR), Amsterdam, 10 March 2020.
2. Communication from the Commission, ‘Shaping Europe’s digital future’, Brussels, 19.02.2020, COM(2020) 67 final.
3. Communication from the Commission, ‘A European strategy for data’, Brussels, 19.02.2020, COM(2020) 66 final.
4. European Commission, ‘White Paper on Artificial Intelligence – A European approach to excellence and trust’, Brussels, 19.02.2020, COM(2020) 65 final.
5. Communication from the Commission, ‘Shaping Europe’s digital future’, *supra* note 2, 1.
6. *Ibid.*, 3.

the technological revolution – the data economy and society, the turn to artificial intelligence (AI), the growing importance of new technologies such as blockchain, 3D-printing and the Internet of Things (IoT) as well as the development of new business models such as the platform economy, and the data and circular economy – *offers a unique window of opportunity to modernize our approach to protecting our intangible assets.*<sup>7</sup>

In short: a horizontal reflection on digital issues is therefore desired by the European Commission before (re)-defining the rules of the game through appropriate legislation. However, on closer inspection, neither in the proposed action plan, nor in the implementation agenda for these strategies, does there appear any questioning of the free spaces left by IP law in order to allow the development of a balanced digital ecosystem in the EU.<sup>8</sup> The issue has also been totally ignored by the Proposal for a Regulation on a European approach for Artificial Intelligence published on 21 April 2021, despite the fact that one of the main goals put forward by the European Commission is to ‘ensure legal certainty to facilitate investment and innovation in AI’.<sup>9</sup> Unless the Commission considers that the question has already been settled, in particular by the Directive of 17 April 2019, on Copyright and related rights in the Digital Single Market<sup>10</sup> (CDSM Directive), it is difficult to understand how a horizontal reflection on digital innovation can be conducted without including a large part of digital law such as copyright law (including its exceptions and limitations) and IP in general.<sup>11</sup>

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7. Communication from the Commission, ‘Making the most of the EU’s innovative potential, An intellectual property action plan to support the EU’s recovery and resilience’, 25 Nov. 2020, COM(2020) 760 final, 2 (emphasis added).
8. For an early critique of the lack of ambition of the EU legislator in the field of copyright, see the foundational reflections in: P. Bernt Hugenholtz (ed.), *The Future of Copyright in a Digital Environment* (Kluwer, The Hague, 1996), in particular the chapter by the editor himself, ‘Adapting Copyright to the Information Superhighway’, 81 et seq.
9. Proposal for a Regulation of the European Parliament and of the Council laying down harmonized rules on artificial intelligence (Artificial Intelligence Act) and amending certain Union legislative acts, Brussels, 21.4.2021 COM(2021) 206 final.
10. Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC [2019] OJ L130/92-125 (CDSM Directive). For comments, see the various Opinions drafted by the European Copyright Society, at <https://europeancopyrightsociety.org/>.
11. On the crucial importance of exceptions and limitations in EU copyright law (in particular for follow-on innovation and creativity), see P. Bernt Hugenholtz, ‘Fierce Creatures, Copyright Exemptions: Towards Extinction?’, IFLA/IMPRIMATUR, *Rights, Limitations and Exceptions: Striking a Proper Balance* (Amsterdam Oct. 1997), reprinted in: David Vaver (ed.), *Intellectual Property Rights: Critical Concepts in Law*, vol. 2 (Routledge, London, 2006), 231; Christophe Geiger, ‘Promoting Creativity through Copyright Limitations, Reflections on the Concept of Exclusivity in Copyright Law’, 12(3) *Vanderbilt Journal of Entertainment & Technology Law* (2010), 515; Christophe Geiger and Franciska Schönher, ‘Defining the Scope of Protection of Copyright in the EU: The Need to Reconsider the Acquis regarding Limitations and Exceptions’, in Tatiana-Eleni Synodinou (ed.), *Codification of European Copyright Law, Challenges and Perspectives* (Kluwer Law International, The Hague/London/New York, 2012), 133. And the various excellent contributions in Ruth L. Okediji (ed.), *Copyright Law in an Age of Limitations and Exceptions* (CUP, Cambridge, 2017).

Worse, it is likely that the solutions that have been adopted beforehand in the CDSM Directive are in direct contradiction with the objectives now displayed, and that – as a result – the many ambitions newly put forward are likely to remain a dead letter.

### **3. TEXT-AND-DATA MINING: THE CRUCIAL GOAL SCORER MISSING IN THE EU ARTIFICIAL INTELLIGENCE TEAM**

Many examples could be given, but we would like to highlight just one in this contribution: a proactive policy in the field of artificial intelligence and digital innovation undoubtedly requires proposing a modern legal framework which recognises the risk that the development of artificial intelligence within the European Union may encounter obstacles or unjustified prohibitions.<sup>12</sup> In this context, it is known that in order to allow machine learning, which is essential to artificial intelligence, it is necessary to have robust exceptions for text-and-data mining (TDM) so that the machine can reproduce, store and process existing data and propose new solutions.<sup>13</sup> The question is also very topical in the field of public health, because it is obvious that very large stocks of data on COVID-19 have to

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12. On the legal challenges posed by AI in the EU, see excellent the report drafted P. Bernt Hugenholtz, João Pedro Quintais and Daniel Gervais for the European Commission: IVIR and JIPP, *Trends and Developments in Artificial Intelligence Challenges to the Intellectual Property Rights Framework*, Final Report, Sept. 2020, available at: <https://ec.europa.eu/digital-single-market/en/news/trends-and-developments-artificial-intelligence-challenges-intellectual-property-rights-0>, leaving out however ‘legal issues concerning the input of protected subject matter into AI systems (e.g. for text-and-data mining)’ from the scope of the analysis.
13. See Philipp Hacker, ‘A Legal Framework for AI Training Data’, 13 *Law, Innovation and Technology* (2021, forthcoming), showing that ‘training data for AI do not only play a key role in the development of AI applications, but are currently only inadequately captured by EU’; Mauritz Kop, ‘The Right to Process Data for Machine Learning Purposes in the EU’, 34 *Harvard Journal of Law & Technology* (Digest Spring 2021), 1. On the importance of TDM for artificial intelligence, see e.g. Christophe Geiger, ‘The Artificial Intelligence and Data-led Revolution of Copyright and its Wider Implications’, *Digital Encounters*, Final report, available at: [https://www.fidefundacion.es/docs/GlobalDigitalEncounters/Encounter\\_8\\_Report\\_Final.pdf](https://www.fidefundacion.es/docs/GlobalDigitalEncounters/Encounter_8_Report_Final.pdf) ; Rossana Ducato and Alain Strowel, ‘Limitations to text and Data Mining and Consumer Empowerment: Making the Case for a Right to “Machine Legibility”’, 50(6) *IIC* (2019), 649; Nicolas Binctin, ‘TDM: un enjeu de l’intelligence artificielle’, 262(7) *RIDA* (2019), 7 ; Theodoros Chiou, ‘Copyright lessons on Machine learning: what impact on algorithmic art?’, 10 *JIPITEC* (2019), 398 ; Alexandra Bensamoun, Joelle Farchy and Paul-François Schira, *Intelligence artificielle et Culture*, Report for the CSPLA, January 2020, 54; Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, ‘Crafting a Text and Data Mining Exception for Machine Learning and Big Data in the Digital Single Market’, in Xavier Seuba, Christophe Geiger and Julien Pénin (eds.), *Intellectual Property and Digital Trade in the Age of Artificial Intelligence and Big Data*, Collection CEIPI/ICTSD, *Global Perspectives and Challenges for the Intellectual Property System*, No. 5 (Geneva/Strasbourg, 2018), 95.

be processed and analysed at a global level in order to allow the development of new treatments.<sup>14</sup>

TDM has in fact become a fundamental tool for research, whether carried out by public bodies or by private actors.<sup>15</sup> However, as it has been argued by Bernt Hogenholtz and others,<sup>16</sup> the solution proposed by the 2019 CDSM Directive is largely unsuitable, because it is far too restrictive with regard to the exceptions for text-and-data mining. Thus, to use a ‘footballistic’ image, the artificial intelligence strategy of the European Union might resemble a football team without any strikers to score successfully and to win any of the competitions with other jurisdictions which may have the advantage of more flexible legal provisions allowing broader TDM activities.

Why is this the case? Let us quickly come back to the two exceptions introduced into EU law by the 2019 Directive.

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14. On the link between the two topics, see in particular Teresa Hacket, ‘COVID and Copyright: The Right to Research’, 17 August 2020, <http://www.eifl.net>; Sean Flynn, Christophe Geiger and Joao Pedro Quintais (with the collaboration of T. Margoni, M. Sag, L. Guibault, M. Carroll), ‘Implementing User Rights for Research in the Field of Artificial Intelligence: A Call for International Action’, 7 *EIPR* (2020), 393. See also the Statement on Copyright and Proposal of a Waiver from Certain Provisions of the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement for the Prevention, Containment and Treatment of COVID-19 (IP/C/W/669), 22 March 2021, endorsed by 250 organisations and prominent researchers calling for the reduction of copyright barriers to COVID-19 prevention, containment and treatment, available at <http://infojustice.org/archives/43020>: ‘In too many countries, researchers lack the rights they need to use the most advanced research methodologies, such as text and data mining, to help find and develop treatments to COVID-19. Indeed, the virus itself was discovered by a text and data mining research project that would not be lawful in many countries’.

15. See Recital 8 of the CDSM Directive of 17 April 2019, according to which ‘there is widespread acknowledgment that text and data mining can, in particular, benefit the research community and, in so doing, support innovation’. See also Thomas Margoni, ‘Text and Data Mining in Intellectual Property Law: Towards an Autonomous Classification of Computational Legal Methods’, *CREATe working paper* 01/2020/01, 1: ‘The impact that TDM may have on science, arts and humanities is invaluable. This is because by identifying the correlations and patterns that are often concealed to the eye of a human observer due to the amount, complexity, or variety of data surveyed, TDM allows for the discovery of concepts or the formulation of correlations that would have otherwise remained concealed or undiscovered. Considering this point of view, it can be effectively argued that TDM creates new knowledge from old data’.

16. For a (critical) analysis see also P. Bernt Hogenholtz, ‘The New Copyright Directive: Text and Data Mining (Articles 3 and 4)’, *Kluwer Copyright Blog*, 24 July 2019, <http://copyrightblog.kluweriplaw.com/2019/07/24/the-new-copyright-directive-text-and-data-mining-articles-3-and-4/>; Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, ‘Text and Data Mining: Articles 3 and 4 of the Directive 2019/790/EU’, in Concepción Saiz García and Raquel Evangelio Llorca (eds.), *Propiedad intelectual y mercado único digital europeo* (Tirant lo Blanch, Valencia, 2019), 27; Kop, *supra* note 13, 7. European Copyright Society, ‘Comment of the European Copyright Society Addressing Selected Aspects of the Implementation of Articles 3 to 7 of Directive (EU) 2019/790 on Copyright in the Digital Single Market’, *JIPITEC* (2021, forthcoming).

### **3.1 Initial Focus on TDM by Research Organisations and Public Universities, but what about Innovative Start-ups in the Field of AI?**

First of all, it should be noted that the European Commission clearly did not understand at the beginning of the elaboration process of the Directive the importance of TDM exceptions for the development of artificial intelligence. Admittedly, the Proposal for a Directive of 14 September 2016<sup>17</sup> provided for a mandatory exception<sup>18</sup> allowing TDM which could not be ruled out by contract.<sup>19</sup> However, it was limited to ‘reproductions and extractions made by research organisations in order to carry out TDM of works or other subject-matter to which they have lawful access for the purposes of scientific research’.<sup>20</sup> These beneficiary organisations were understood restrictively, since Recital 11 specified that ‘research organisations across Member States generally have in common that they act either on a not for profit basis or in the context of a public-interest mission recognised by the State. Such a public-interest mission may, for example, be reflected through public funding or through provisions in national laws or public contracts’.<sup>21</sup> This covered only research organisations and public universities (or those performing a public service mission).

But what about the significant research activities carried out by start-ups operating in the digital environment, which are the source of important innovations, particularly in the field of artificial intelligence, and whose potential in

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17. See the Proposal for a Directive of the European Parliament and of the Council on copyright in the Digital Single Market, 14 September 2016, Brussels, COM(2016) 593 final, 2016/0280 (COD).
18. What, unlike the 2001 Directive, constitutes an improvement, as the list of twenty *optional* exceptions and limitations had only a limited impact in terms of harmonisation. See on this issue e.g. Christophe Geiger and Franciska Schönher, ‘The Information Society Directive’ (with updates from Stavroula Karapapa), in Irini Stamatoudi and Paul Torremans (eds.), *EU Copyright Law* (2nd edn., Edward Elgar, Cheltenham, UK/Northampton, MA, 2021), 279.
19. According to the Recitals of the Proposal for a Directive, the exception was intended to address the great legal uncertainty surrounding TDM activities (Recital 10), because ‘text and data mining may involve acts protected by copyright and/or by the *sui generis* database right, notably the reproduction of works or other subject-matter and/or the extraction of contents from a database. Where there is no exception or limitation which applies, an authorisation to undertake such acts would be required from rightholders’ (Recital 8).
20. Art. 3, para. 1 of the Proposal.
21. See also Art. 2 (‘Definitions’) of the Proposal for a Directive: “research organisation” means a university, a research institute or any other organisation the primary goal of which is to conduct scientific research or to conduct scientific research and provide educational services: (a) on a non-for-profit basis or by reinvesting all the profits in its scientific research; or (b) pursuant to a public interest mission recognised by a Member State; in such a way that the access to the results generated by the scientific research cannot be enjoyed on a preferential basis by an undertaking exercising a decisive influence upon such organization’. See also Art. 2, para. 3) according to which: “cultural heritage institution” means a publicly accessible library or museum, an archive or a film or audio heritage institution’.

terms of growth has been strongly advanced in the Commission's new strategy?<sup>22</sup> Start-ups were not taken into consideration, and therefore their data mining activities remain subject to the exclusive right. Along these lines, what about public-private partnerships, so strongly encouraged when submitting applications in the context of calls for tenders to the European Union? Admittedly, Recital 10 stated in a relatively vague manner that 'research organisations should also benefit from the exception when they engage into public-private partnerships', without however explaining how this should be the case. Not to mention individual researchers without an affiliation to an institution, whose activities are not covered either, and journalists by definition working for private structures, who will also not benefit from the exception.

This situation is highly problematic in terms of fundamental rights, and in particular with regard to the right to research. Indeed, the right to research has a strong human rights foundation, and is protected at international, European and national levels.<sup>23</sup> Based on the right to information, it includes an active right to search for effective and objective information by the use of existing sources, which implies in the digital environment to be able to lawfully use TDM techniques to conduct research.<sup>24</sup> For journalists, which are left out by the provision, it is in particular of crucial importance since certain investigations are

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22. See 'White Paper on Artificial Intelligence – A European approach to excellence and trust', *supra* note 4, 4, according to which: 'Europe is well placed to benefit from the potential of AI, not only as a user but also as a creator and a producer of this technology. It has excellent research centers, *innovative start-ups*, a world-leading position in robotics and competitive manufacturing and services sectors, from automotive to healthcare, energy, financial services and agriculture' (emphasis added).

23. According to Art. 19 of the Universal Declaration of Human Rights of 1948 'Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and *to seek, receive and impart information and ideas through any media and regardless of frontiers*' (emphasis added). Likewise, Art. 19. 2 of the International Covenant on Civil and Political Rights of 1966 specifies that 'everyone shall have the right to freedom of expression; this right shall include *freedom to seek, receive and impart information and ideas of all kinds*, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice' (emphasis added). In Europe, the right to information is derived from Art. 10(1) ECHR and Art. 11 of the Charter of Fundamental Rights of the European Union, and is included in several national constitutions such Art. 5(1) of the German Basic law, Art. 16(3) of the Federal Swiss Constitution and Art. 11 of the French Declaration of Human rights. In the EU, a 'right to research' could find support also in Art. 13 of the Charter of Fundamental Rights (Freedom of the arts and sciences), which stipulates that 'the arts and scientific research shall be free of constraint. Academic freedom shall be respected.' See e.g. Flynn, Geiger and Quintais, *supra* note 14.

24. The right to information consists of a passive freedom of receiving existing information, and an active right to search for effective and objective information by the use of existing sources. On the fundamental right to information in particular in the context of copyright law, see Christophe Geiger, *Droit d'auteur et droit du public à l'information, approche de droit comparé* (Litc, Paris, 2004); 'Author's Right, Copyright and the Public's Right to Information: A Complex Relationship', in F. Macmillan (ed.), *New Directions in Copyright Law*, vol. 5 (Edward Elgar, Cheltenham, 2007), 24. And of course Bernt Hugenholtz's, *Auteursrecht op informatie* (Kluwer, Deventer, 1989), initiating a discussion on the interface of copyright and freedom of information.

only possible today through large-scale TDM. As an example, it should be recalled that the ‘Panama Papers’ scandal, which highlighted large-scale tax evasion by politicians, billionaires, celebrities and high-level sportsmen and women, could only be revealed by searching and mining information, via automated search techniques, from more than a million off-shore bank documents.

By restricting the scope of the exception in such a way, the Commission therefore risked creating an ineffective and therefore rapidly obsolete provision, in particular regarding the development of artificial intelligence, but also with regard to other activities of essential research and innovation not conducted by public bodies. This is especially so since the proposal for the Directive only allowed research organisations to search texts and data ‘on works or other subject-matter to which they have lawful access for the purposes of scientific research’, which seemed to exclude a large part of online research since the legality of the sources would be uncertain.<sup>25</sup>

### **3.2 The Subsequent Introduction of a More General Exception for Other Purposes: A Step in the Right Direction, but with Serious Doubts about Its Effectiveness**

For all these reasons, the Directive proposal was subject to much criticism during the parliamentary phase,<sup>26</sup> leading to changes in the final text of the Directive.<sup>27</sup> As a result, the circle of beneficiaries of the exception has been extended to

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- 25. The lawful source requirement can be, for example, found in the French exception of text and data mining, introduced into the Intellectual Property Code by the law ‘for a digital republic’ of 7 October 2016 (Art. 122-5 10° CPI, and for databases, Art. L. 342-3, 5). It should be noted, however, that Germany, which also introduced such an exception in its copyright law in 2017, did not add this additional criterion (UrhG, par. 60d (1)).
- 26. See in this regard Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, *The Exception for Text and Data Mining (TDM) in the Proposed Directive on Copyright in the Digital Single Market – Legal Aspects*, Study for the Directorate-General for Internal Policies of the Union, Department of Citizens’ Rights and Constitutional Affairs, European Parliament, February 2018. For a critical evaluation of the Directive Proposal, see also Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, ‘Text and Data Mining in the Proposed Copyright Reform: Making the EU Ready for an Age of Big Data?’, 49(7) *IIC* (2018) 814, and from the same authors: ‘The EU Commission’s Proposal to Reform Copyright Limitations: A Good but Far Too Timid Step in the Right Direction’, 40(4) *EIPR* (2018) 4; European Copyright Society, *General Opinion on the EU Copyright Reform Package*, 24 January 2017, 5; Reto M. Hilty and Heiko Richter, in Reto M. Hilty and Valeria Moscon (eds.), *Modernisation of the EU Copyright Rules*, Position Statement, MPI for Innovation and Competition Research Paper No. 17-12, 25 et seq.; Nicolas Jondet, ‘L’exception pour le data mining dans le projet de directive sur le droit d’auteur – Pourquoi l’Union européenne doit aller plus loin que les législations des Etats membres’, 67 *Propr. intell.* (2018), 25.
- 27. For a commentary on the final provisions in the Directive: Geiger, Frosio and Bulayenko, *supra* note 16, 27; P. Bernt Hugenholtz, ‘Artikelen 3 en 4 DSM-richtlijn: tekst- en datamining’, 5 *AMI* (2019), 167; Ducato and Strowel, *supra* note 13, 649; Christophe Alleaume, ‘Les exceptions en faveur de l’enseignement et de la recherche scientifique’, 10 *Comm. com. électr.* (2019), 9; Carine Bernault, ‘Exceptions – Fouille de texte’, 72 *Propr. intell.* (2019), 39; L. Ballet, ‘L’exception TDM dans la directive droit d’auteur, une volonté européenne’, 5 *Dalloz IP/IT* (2019), 304.

‘cultural heritage institutions’, which according to Recital 13 of the Directive includes mainly libraries, museums and archives.<sup>28</sup> In addition, the possibility to store works for search and mining purposes has been added, which is important as research takes time: it must therefore be possible to get back to the works carrying the data without having to reproduce them every time. Finally, a new exception has been introduced in the body of the Directive, according to which ‘Member States shall provide for an exception or limitation to the rights ... for reproductions and extractions of lawfully accessible works and other subject matter for the purposes of text and data mining’.<sup>29</sup>

The objective of the introduction of a new provision was clearly to respond to criticism of the initial text and to allow Member States to provide for an exception for cases not covered by Article 3 of the Directive, in particular in order to authorise TDM for entities excluded from the scope of Article 3. This clearly follows from Recital 18, which states that

in addition to their significance in the context of scientific research, text and data mining techniques are widely used both by private and public entities to analyze large amounts of data in different areas of life and for various purposes, including for government services, complex business decisions and the development of new applications or technologies.

This new provision would be a major advance if this exception had not been accompanied by an opt-out mechanism, allowing rightholders to expressly reserve the use of works ‘in an appropriate manner, such as machine-readable means in the case of content made publicly available online’.<sup>30</sup> By conditioning the new exception to the goodwill of rightholders, there is the risk of making this exception impracticable since its effectiveness will depend on the implementation (or not) of the opt-out.<sup>31</sup> Admittedly, the objective of the legislator was to take into account the legitimate interests of rightholders, and in particular that of the producers of databases also covered by the exception, who have an interest in preventing the over-exploitation of their databases which would be impacted by the provision.<sup>32</sup> However, if the intention was to promote research, and in particular to create a legal framework stimulating innovation, it would have been possible to subject TDM activities exploited for commercial purposes to a right to

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- 28. The full text of Recital 13 is the following: ‘Cultural heritage institutions should be understood as covering publicly accessible libraries and museums regardless of the type of works or other subject matter that they hold in their permanent collections, as well as archives, film or audio heritage institutions. They should also be understood to include, *inter alia*, national libraries and national archives, and, as far as their archives and publicly accessible libraries are concerned, educational establishments, research organisations and public sector broadcasting organisations’.
- 29. Art. 4.
- 30. Art. 4 (3). However, it is not clear what these ‘appropriate’ tools to exercise the opt-out are: technological, contractual, or both?
- 31. Some works will be available for research, others not. It is in fact very likely that the beneficiaries, generally hostile to this new exception, will systematically use the default opt-out to defeat its implementation.
- 32. This is underlined by Binctin, *supra* note 13, 7.

remuneration.<sup>33</sup> The uncertainties created by the Directive on this point, which will be found again during the transposition phase at the national level,<sup>34</sup> may well lead to a major delay for Europe in the development of new technologies and in the field of artificial intelligence,<sup>35</sup> while elsewhere these activities having high innovation potential are possibly already covered by open norms such as fair use<sup>36</sup> or more flexible exceptions.<sup>37</sup>

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33. See the proposal in this sense Geiger, Frosio and Bulayenko, 'Text and Data Mining in the Proposed Copyright Reform', *supra* note 26, 838. The issue of remuneration is particularly discussed in the field of machine learning, which requires the machine to reproduce and store large sets of potentially copyrighted work to produce valuable output. As rights clearance would bring enormous legal uncertainty due to the important amount of works at stake and thus too high transaction costs, a statutory remuneration right could facilitate the development of machine learning and allow remuneration of creators when appropriate (for example when the AI is producing a derivative work in a commercial context). In this spirit see also Kop, *supra* note 13, 7, proposing 'the creation of an online one-stop-shop clearinghouse with mandatory or statutory licensing for machine learning training datasets alike a pan-European, multi-territorial collective rights agency'. More generally on statutory remunerations rights as a workable compromise solution in the digital environment, see Christophe Geiger and Oleksandr Bulayenko, 'Creating Statutory Remuneration Rights in Copyright law: What Policy Options under the International Framework?', *CEIPI Research Paper* No. 2020-05, available at SSRN: <https://ssrn.com/abstract=3722108>

34. See also Séverine Dusollier, 'The 2019 Directive on Copyright in the Digital Single Market: Some progress, a few bad choices, and overall a failed ambition', 57(4) *Common Market Law Review* (2020), 987: 'The exception for TDM for non-research purposes is thus rather precarious and is subservient to its prohibition by rightholders'.

35. See in this sense also Ducato and Strowel, *supra* note 13, 649 et seq.: 'Neither the initial proposal by the European Commission focusing on the research context, nor the final provisions of the CDSM Directive appear sufficient to facilitate the use of TDM for improved smart disclosure and, more broadly, for AI applications'; Thomas Margoni and Martin Kretschmer, 'A deeper look into the EU Text and Data Mining exceptions: Harmonisation, data ownership, and the future of technology', *CREATe Working Paper* 2021/7, 4. With a similar conclusion for South America, see Matías Jackson Bertón, 'Text and Data Mining Exception in South America: A Way to Foster AI Development in the Region', *GRUR Int.* (2021, forthcoming).

36. See in this sense Matthew Sag, 'The New Legal Landscape for Text Mining and Machine Learning', 66 *Journal of the Copyright Society of the USA* (2019), 291; Michael Carroll, 'Copyright and the Progress of Science: Why Text and Data Mining Is Lawful', 53 *U.C. Davis L. Rev.* 893 (2019); Geiger, Frosio & Bulayenko, 'Text and Data Mining in the Proposed Copyright Reform', *supra* note 26, 821. As Bernt Hugenholtz rightly puts it (in: 'The New Copyright Directive: Text and Data Mining (Articles 3 and 4)', *supra* note 16), 'the TDM provisions of the DSM Directive secure considerably less freedom to text and data mine than they initially appear to do. The opt-out clause of Art. 4, in particular, leaves for-profit miners in the EU at the mercy of the content owners. This puts AI developers, journalists, commercial research labs, and other innovators at a competitive disadvantage in comparison with the United States, where text and data mining is deemed fair use, even if it is done for profit'.

37. See in this sense Martin Senftleben et al., 'Ensuring the Visibility and Accessibility of European Creative Content on the World Market: The Need for Copyright Data Improvement in the Light of New Technologies' (12 Feb. 2021), available at: <https://ssrn.com/abstract=3785272>; Josef Drexel, Reto Hilty et al., 'Artificial Intelligence and Intellectual Property Law, Position Statement of the MPI for Innovation and Competition of 9 April 2021 on the Current Debate', *Max Planck Institute for Innovation and Competition Research Paper*

### **3.3 Additional Complicating Factors: Applicability of the Three-Step Test and Uncertain Safeguards in Case of the Technical Protection Measures**

This is not to mention the fact that the European legislator also saw fit to specify that the famous three-step test is applicable to the two newly created exceptions,<sup>38</sup> as well as the cryptic Article 6(4) of the 2001 InfoSoc Directive,<sup>39</sup> which – it must be recalled – aimed to resolve conflicts between users and rightholders in the event of the implementation of technical protection measures, yet to this day remains uncertain in its understanding and application.<sup>40</sup> Lastly, even if the scope of exceptions has been widened, many questions pending in the context of the Directive proposal remain unresolved in the final text, giving rise to significant legal uncertainty over TDM activities, and thus running the risk of damaging the competitiveness of the European Union as a space for research and creativity on the world stage.<sup>41</sup>

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No. 21-10, at 3. Japan for example introduced in 2019 a new exception comprehensively allowing the use of a work that is aimed at neither enjoying nor causing another person to enjoy the work (Art. 30-4 of the Japanese Copyright Act), which includes the use of copyright protected works for text and data mining activities, also for commercial purposes. On this provision, see Tatsuhiko Ueno, ‘The Flexible Copyright Exception for “Non-Enjoyment” Purposes – Recent Amendment in Japan and Its Implication’, 70 *GRUR Int.* (2021), 145.

38. On the (still) uncertain interpretation of the three-step test, see Christophe Geiger, ‘From Berne to National Law, via the Copyright Directive: The Dangerous Mutations of the Three-Step Test’, 29 *EIPR* (2007), 486.
39. See Art. 7, para. 2 of the Directive, which states: ‘Article 5(5) of Directive 2001/29/EC shall apply to the exceptions and limitations provided for under this Title. The first, third and fifth subparagraphs of Article 6(4) of Directive 2001/29/EC shall apply to Articles 3 to 6 of this Directive’.
40. On this article, see e.g. Christophe Geiger, ‘The Answer to the Machine should not be the Machine, Safeguarding the Private Copy Exception in the Digital Environment’, 30 *EIPR* (2008), 121, replying to Charles Clark, ‘The Answer to the Machine is in the Machine’, in Hugenholtz (ed.), *supra* note 8, at 139; P. Bernt Hugenholtz, ‘Copyright, Contract and Code: What Will Remain of the Public Domain’, 26 *Brook. J. Int'l L.* 77 (2000), 83.
41. See in particular the condition of the lawful source, which has been maintained (Art. 3(1) and Art. 4 (1)), as well as the uncertainties concerning the activities of TDM in public/private partnerships, however strongly encouraged by the European Union in its research policy. In this regard, Recital 11 of the Directive remains rather vague: ‘While research organisations and cultural heritage institutions should continue to be the beneficiaries of that exception, they should also be able to rely on their private partners for carrying out text and data mining, including by using their technological tools’. Does this mean that there will be an extension of the exception to the private operator in the event of a research contract with a public body? (See in this sense Binctin, *supra* note 13, 23). This remains unclear; it is very likely that we will have to wait for a decision by the CJEU to specify the exact contours of the exception. In the meantime, uncertainty will persist, risking further widening of the gap between the EU and other regions of the world on digital innovation and research. Criticising this uncertainty, see also Rosanna Ducato and Alain Strowel, ‘Ensuring Text and Data Mining: Remaining Issues with the EU Copyright Exceptions and Possible Ways Out’, 43 *EIPR* (2021), 322 et seq.

#### **4. CONCLUSION: AN URGENT NEED TO REOPEN THE DISCUSSION AROUND THE SCOPE OF TDM EXCEPTIONS AT EUROPEAN AND INTERNATIONAL LEVEL**

In sum, if the stated ambition of the Commission is to propose a proactive policy which positions the European Union at the forefront of digital innovation and artificial intelligence, there is a strong fear that such a task will simply prove impossible if the debate on the scope of the TDM exceptions is not also urgently reopened in the very near future.<sup>42</sup> The impulse could come from the World Intellectual Property Organization (WIPO), which recently opened a major consultation on intellectual property and artificial intelligence, including the topic of TDM.<sup>43</sup> In this context, scholars have invited WIPO to take the lead in this area, for example through a legislative proposal aimed at creating a new exception to copyright on the model of the Marrakesh Treaty.<sup>44</sup> More fundamentally, this will only be possible through the rethinking of the underlying and still widely accepted assumption that only strong exclusive rights can serve innovation and creativity, and by acknowledging that limitations and exceptions can equally perform that task<sup>45</sup>

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42. It is to be hoped that in the meantime, national legislators will make maximum use of the room for manoeuvre left by the Directive when transposing it. They could for example implement the 'opt out' in a manner that safeguards the effectiveness of the exception. For this purpose, Member States could interpret 'expressively reserved in appropriate manner' very restrictively (imposing some formalities to rightholders on the reservation, such as a registration requirement); making the mere implementation of Technical Protection Measure to reserve the work insufficient. Alternatively, the 'appropriateness' of the opt-out could include an element of 'reasonableness' of the reservation. Finally, a restrictive interpretation of the possibility to opt-out could be mandated by the 'effet utile' of the provision and the need to interpret it in the light of the fundamental right to information protected by Art. 10 ECHR.
43. 'WIPO Conversation on Intellectual Property (IP) and Artificial Intelligence (AI)', 21 May 2020, 2nd session, WIPO/IP/AI/2/GE/20/1 REV, para. 24, asking this fundamental question: 'Should the use of the data subsisting in copyright works without authorisation for machine learning constitute an infringement of copyright?' (§24, i).

44. See Flynn, Geiger, Quintais et al., *supra* note 14.
45. See e.g. Christophe Geiger, 'Copyright as an Access Right, Securing Cultural Participation through the Protection of Creators' Interests', in Rebecca Giblin and Kim G. Weatherall (eds.), *What If We Could Reimagine Copyright?* (Australian National University (ANU) Press, Acton, 2016), 73 et seq.; 'Taking the Right to Culture Seriously: Time to Rethink Copyright Law', in Ch. Geiger (ed.), *Intellectual Property and Access to Science and Culture: Convergence or Conflict?*, CEIPI/ ICTSD publication series on 'Global Perspectives and Challenges for the Intellectual Property System', No. 3 (Geneva/Strasbourg, 2016), 84 (at 90); Geiger, *supra* note 11.

# *‘Voetbal Hoort niet bij Robots’: Attitudes Regarding the Use of Artificial Intelligence in Refereeing*

*Natali Helberger and Brahim Zarouali<sup>1</sup>*

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## **1. INTRODUCTION**

Bernt Hugenholtz is not only a world-renowned expert and scholar in information law, but also a dedicated soccer fan. At the Institute for Information Law (IViR), he combined both his passions. For years, the IViR soccer team – for which Bernt himself played – competed against other soccer teams, mostly from large Amsterdam law firms. The IViR soccer team had potential and was reasonably successful. Some more time spent on the pitch and less on writing papers might have helped them climb even further in the ranks of legal soccer teams in Amsterdam, and perhaps also ... some AI?

Sports may well be the area in which AI made its most publicised appearance (that is if you count chess playing as a sport) and Deep Blue’s victory over Kasparov in 1997 is often cited as evidence that AI can outperform humans. Since then, the sports sector has been a place for vibrant AI innovation.<sup>2</sup> Perhaps if we had used AI to scout new postdocs and PhDs more actively for their talents in sports, the IViR soccer team could have repeated (or even trumped) the success of Billy Bean, the famous coach of the Oakland Athletics who, with the help of data analytics, turned a B team into a team of winners.<sup>3</sup> Today, there is a range

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1. The authors thank Ljubisa Metikos for his excellent research assistance.

2. For a good overview, see ‘Artificial Intelligence. Application to the Sports Industry’, *pwc.com*, February 2019.

3. This (true) story inspired M. Lewis to write the successful fiction book *Money Ball*, which was later turned into a film with Brad Pitt in the lead role. See also Caitlin Fitzsimmons, ‘What the Moneyball story teaches us about investment’, *smh.com.au*, 25 April 2017.

of AI-driven tools that help trainers and clubs to scout for talent and identify the right players.<sup>4</sup>

Some AI, or more generally digital technology, could also have come in handy in training our sturdy players. Thanks to the advances in wearables and data-driven performance monitoring and lifestyle tracking, not only sportspersons but essentially anybody who can afford a fitness tracker can use the power of AI and data to get personalised recommendations for the right diet, training and personal development plan. Had the IViR soccer team been equipped with automated fitness trackers, Bernt could have monitored the progress of his players via a handy dashboard from a comfortable chair in his office.<sup>5</sup>

Let us not forget about the fans. It is not difficult to imagine how much it would have boosted the performance of the IViR soccer team had all those non-soccer playing colleagues back in the office used AI and digital innovation to support their team: think of access to enhanced players' statistics, and the ability to follow your favourite player with AI-controlled cameras<sup>6</sup> and receive a personalised livestream of scores.<sup>7</sup> With the advances in automated content production (robot journalists), the results of the game could even have been immediately shared with the university journal *Folia* and the IViR Twitter account. Not to speak of the many fun applications that would have turned even die-hard non-soccer colleagues into avid followers, such as the possibility to use AI to predict and bet on the outcome of games.<sup>8</sup> There is now even the option to boost morale with some fake crowd cheering. To make up for the lack of audiences

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4. NBA Global Scout, HomeCourt analysing footage of users of the app playing basketball, *Sportlogiq*, [sportlogiq.com](http://sportlogiq.com), accessed 19 June 2021. Edd Gent, 'How AI is helping sports teams scout star players', *NBC News*, [nbcnews.com](http://nbcnews.com), 13 May 2018.
5. Again, there are many examples. In addition to the popular fitness trackers such as Fitbit, Garmin or Strava, there are, for example, apps such as Home Court ([homecourt.ai](http://homecourt.ai), accessed 19 June 2021), a system that uses the camera on a mobile device to turn sports training into a live action video game. The Isotechne platform ([isotechne.com/isotechne-platform](http://isotechne.com/isotechne-platform), accessed 19 June 2021) that can use up to twenty cameras to capture players' performance on the soccer pitch and aggregate that information into a report that coaches can use to improve their players. Liverpool Football Club uses SkillCorner's AI systems (Andrew Cohen, 'Liverpool F.C. Partners With SkillCorner's AI Platform to Extract Data From Matches', *sporttechie.com*) to track players and the ball, allowing coaches to spot the teams' weaknesses on the pitch at a glance. Researchers at KU Leuven even collaborated with SciSports to develop an algorithm ('Talent Captured by Tech: Machine Learning on the Pitch', *kuleuven.be*) that can value a football player's total impact on the game. And Ireland's national rugby team uses connected clothing, ([statsports.com](http://statsports.com), accessed 19 June 2021) to collect better and more accurate data.
6. But see also the glitch with the bald referee at an Inverness Caledonian Thistle FC game, See: James Vincent, 'AI camera operator repeatedly confuses bald head for soccer ball during live stream', *The Verge*, [theverge.com](http://theverge.com), 3 November 2020.
7. N. Gillil, 'How Wimbledon is using AI to enhance the fan experience', *eConsultancy*, [econsultancy.com](http://econsultancy.com), 10 July 2018.
8. For example, Simplebet ([simplebet.io](http://simplebet.io), accessed 19 June 2021) launched FanDuel, a betting application that allows users to bet on basketball players ([fan duel.com/](http://fan duel.com/), accessed 19 June 2021), and the DFL was involved in the development of 'xGoals' that would '[change] how we evaluate Goalscoring Chances', DFL Deutsche Fußball Liga, 'xGoals: changing how we evaluate goalscoring chances', *dfl.de*, 1 April 2019.

during the Covid pandemic, IBM Watson, for example, have trained an AI model to produce fake crowd cheering during live tennis matches.<sup>9</sup>

Then there is the referee.<sup>10</sup> I still do not exclude the possibility that many referees were simply wrong or biased in favour of the teams of the large, wealthy law firms, and that with different referees, some of the results would have turned out very differently for the IViR team. After all, referees making wrong decisions is not an uncommon problem in soccer, a problem that not only impacts the ego and future motivation of the team, but also – at least for professional soccer teams – have very real economic consequences.<sup>11</sup> Not surprisingly, the use of AI and digital technology to assist or even replace human referees is an area of intense experimentation. Examples range from widely used decision support systems like the video assistant referee (VAR) to fully automated robot umpires, like Trackman in basketball.<sup>12</sup> And also for soccer, some innovation experts predict that by 2030, Premier League games will be officiated by robot referees.<sup>13</sup>

And what if the IViR team had finally decided that soccer was just not its thing? Well, it could have used AI to help create a new, custom-made sport that was better suited to the talents and capabilities of IViR researchers. It would not have been the first time. After all, a sport called Speedgate – a mix of rugby, field hockey and soccer – was invented by a data-driven computer program.<sup>14</sup>

As this short introduction has demonstrated, the use of AI in sports affords a host of interesting opportunities, as well as research questions. As this chapter is a tribute to Bernt, my colleague and mentor and the long-time director of IViR, and because Bernt is one of the fairest academics I know, we focus in this chapter on one particular manifestation of AI in sports, namely the robot referee, and how likely it is that in the not so distant future, Ajax fans will have to get used to a robot referee on the pitch.

In addition to the fact that this is a question that I am fairly certain Bernt has a personal interest in, the case of the robot referee is also an interesting case to gain a deeper understanding of why certain forms of automated decision making (ADM) are or are not societally acceptable.<sup>15</sup> ADM systems are replacing human decision-makers in a whole range of areas, from governments and courtrooms,

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9. Jen Booton, 'Empty Stadium? There's an AI for That. How the USTA and IBM Are Keeping the U.S. Open Rocking', *Sport Techie*, *sporttechie.com*, 9 March 2020.
10. Jeff Bakalar, 'Meet the AI that could replace your baseball umpire', *CNET*, *cnet.com*, 13 August 2019.
11. Cedric Gottschalk, Stefan Tewes and Benjamin Niestroj, 'The Innovation of Refereeing in Football Through AI', 6 *International Journal of Innovation and Economic Development* (2020).
12. Jeff Bakalar, 'Meet the AI that could replace your baseball umpire', *CNET*, *cnet.com*, 13 August 2019.
13. Marc Andrade, 'Could Robots Ever Be Referees?', *Sport One*, *sport.one*, 29 October 2018.
14. Joe Lemire, 'The times are changing. The Future of Baseball Has Finally Arrived: Robot Umpires', *Sport Techie*, *sporttechie.com*, 10 July 2019.
15. In this sense see also: Meg Jones and Karen Levy, 'Sporting Chances: Robot Referees and the Automation of Enforcement', *We Robot 2017*, *ssrn.com*, 29 November 2018.

to media, politics and sports.<sup>16</sup> The ongoing integration of ADM has triggered an intense debate among academics, policymakers and civil society about the opportunities and risks that ADM poses, as well as the conditions under which it is acceptable. For example, applications of ADM in the justice sector already range from decision support systems (such as automated text analysis and the jurisprudence robot of the Dutch public prosecutor) to systems that complement or even replace core functions of the police and judiciary.<sup>17</sup> Although the first research findings seem to suggest that many citizens acknowledge that ADM in justice can help to make fairer decisions, the acceptability of ADM is limited due to the lack of the ‘human element’.<sup>18</sup> Interestingly, sport, not unlike the law, is a rule-based activity and one that is still believed to be an inherently human activity.<sup>19</sup> And like law, sport is an area that is characterised by public values such as fairness, justice, dignity and solidarity.<sup>20</sup> Through studying users’ attitudes to automated referees in sports, we can refine our understanding of the human factor in decision making, and what the prospects are that in the not so distant future we will be living with fully autonomous AI referees and perhaps also judges.

## 2. THE ROBOT REFEREE AND OTHER DIGITAL APPLICATIONS

AI, digital technology and even robot referees are no strangers to sports as we know them. Probably the best-known example is the Hawk-Eye electronic line-judge system that allows for the automated tracking of a ball and is used in, for example, tennis, cricket, rugby, volleyball and soccer. The system was used during, for instance, the 2013/14 Premier League season as goal line technology to instantly inform the referee whether a goal had been scored. The then chief executive of the Premier League, Richard Scudamore, welcomed the move towards digital technology as a no-brainer: ‘Football is fundamentally a simple game; whichever side scores most goals wins. So, when one is scored, or indeed not

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16. AlgorithmWatch and Bertelsmann Stiftung, *Automating Society Report 2020* (2020.automating.society.algorithmwatch.org, 2020).
17. European Commission, *Study on the Use of Innovative Technologies in the Justice Field* (Brussels, 2020).
18. Natali Helberger, Theo Araujo and Claes De Vreese, ‘Who is the fairest of them all? Public attitudes and expectations regarding automated decision-making’, 39 *Computer Law & Security Review* (2020); Glikson and Woolley, ‘Human Trust in Artificial Intelligence: Review of Empirical Research’, 14 *Academy of Management Annals* (2020); Logg, Minson and Moore, ‘Algorithm appreciation: People prefer algorithmic to human judgment’, 151 *Organizational Behavior and Human Decision Processes* (2019), 90–103, cited 83 times.
19. Though perhaps not the same for all sports. A study into the performance of Formula One drivers found that the contribution of the human driver to the success of a team has declined over time since at least 1980, going from about 30% driver in early 1980s to about 10% driver today. The rest of the performance stems from the car and the technical team. Andrew, Smith, Sabel and Jones, ‘Formula for success: Multilevel modelling of Formula One Driver and Constructor Performance’, 12 *Journal of Quantitative Analysis in Sports* (2016).
20. Migle Laukyte, ‘Disruptive Technologies and the Sport Ecosystem: A Few Ethical Questions’, 5(24) *Philosophies* (2020), 1–13.

scored, and we have the ability through technology to definitively know whether the ball crossed the line we should absolutely use it.<sup>21</sup> Later, after some initial reluctance, also the German Bundesliga (Germany's premier football league) approved the new goal line technology.<sup>22</sup> And in baseball, a related technology – the Pitch f/x camera technology – has made it into the major league stadia to track the speed and location of the ball and determine strike calls and pitches.<sup>23</sup> The data generated can support umpires and sport reporters, but is also being used to analyse games and perform all kinds of data-driven evaluation of the players and, interestingly, also of the performance of umpires themselves.<sup>24</sup>

The VAR system is another example of the use of digital technology and AI in refereeing. It was introduced in the 2018 Soccer World Cup and is now used in various club competitions. VAR originally emerged as part of a project conducted by the Royal Netherlands Football Association (KNVB) under the heading 'Refereeing 2.0'.<sup>25</sup> The VAR system, in cooperation with three human VAR assistants, is used to replay and double-check the referee's decisions and can, in the case of clear and obvious errors, lead to a decision being revisited or overturned. And if today players are clustered around the referee making a TV sign with their fingers, it is because they want a situation to be revised with the help of the VAR. VAR technology is also one of the first digital technologies to have made it officially into the 'rules of the game'. According to the VAR protocol of the International Football Associate Board (IFAB), '[a] video assistant referee (VAR) is a match official, with independent access to match footage, who may assist the referee only in the event of a "clear and obvious error" or "serious missed incident" in relation to: a. Goal/no goal, b. Penalty/no penalty, c. Direct red card (not second yellow card/caution), d. Mistaken identity (when the referee cautions or sends off the wrong player of the offending team).'. Ultimately, however the final decision is always taken by the human referee.<sup>26</sup> By the way, players who excessively call for a VAR 'review' can be given a caution.<sup>27</sup>

In addition to real-time judgement or evaluation based on past data, AI and digital technology can also be used in a more predictive way. The xGoals algorithm, for example, can be used to determine the probability of a player scoring a goal in a particular situation.<sup>28</sup> According to the DFL (German Football League), the technology compares a shot against more than 40,000 similar efforts stored in the Bundesliga's official database and can be used to assess the

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21. Cited in: Owen Gibson, 'Premier League clubs choose Hawk-Eye to provide new goalline technology', *The Guardian*, 11 April 2013.
22. 'Bundesliga approves Hawk-Eye goal-line technology for new season', *Carley Observer, carlyleobserver.com*, 4 December 2014.
23. Mike Fast, 'What the Heck is PITCHf/x?', *The Hardball Times Baseball Annual* (2010).
24. N. DiMeo, 'Pitch f/x, the new technology that will change baseball analysis forever', *slate.com*, 15 August 2007.
25. João Medeiros, 'The inside story of how FIFA's controversial VAR system was born', *Wired UK, wired.com*, 23 June 2018.
26. IFAB, 'Video Assistant Referee (VAR) protocol', *www.theifab.com*.
27. IFAB, 'Fouls and Misconduct', *www.theifab.com*.
28. DFL Deutsche Fußball Liga, 'xGoals: changing how we evaluate goalscoring chances, *dfl.de*, 1 April 2019.

performance of the players and the goalkeeper,<sup>29</sup> as well as to examine whether the actual score in a match is a ‘fair reflection of what took place on the pitch’.<sup>30</sup>

Technology has also proven capable of autonomously performing refereeing tasks during matches, without any human input. An example of this is the use of the Trackman automated ball-strike system in the Atlantic League’s All-Star baseball games. This automated umpire sends its decisions regarding ball and strike calls to a human umpire on the field. This human umpire does not check or change the decision, but merely relays it to the players.<sup>31</sup> The use of Trackman was only experimental, however. A full-scale permanent implementation of autonomous AI is yet to be seen.

### 3. BUT ... DO WE WANT IT?

There are many good reasons why we may want to support the use of AI and digital technology and maybe one day even want to replace referees and umpires with AI-driven refereeing systems. One important reason is to increase the accuracy and fairness of decision making. According to Lukas Brud, secretary of the IFAB: ‘If we had mentioned the idea of introducing video referees in 2010, people would say we were crazy, but now they saw it as an opportunity to help referees and to achieve fairer outcomes in a match.’<sup>32</sup> An analysis by sport scientists at KU Leuven of more than 800 soccer matches in more than twenty countries found that thanks to the use of VAR, the total accuracy of refereeing decisions had increased from 93% to nearly 99%,<sup>33</sup> especially in high-paced games like soccer, tennis and baseball. Gottschalk, Thewes and Nistroy point to the fact that in one soccer game, a referee has to make about 200 distinct decisions, each within a fraction of a second.<sup>34</sup>

Human referees are, moreover, subject to human biases and imperfections. According to Lindholm, human umpires make wrong calls 15% of the time,<sup>35</sup> and Jones and Levy’s literature review revealed that factors that create biases in human referees can range from the home crowd’s noise and the reputation of a player, to a team’s origin and the player’s/referee’s racial differences.<sup>36</sup>

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29. *Ibid.*

30. *Ibid.*

31. Zack Willis, ‘How Did Baseball’s Robot Umpires do, and are They the Future for MLB?’, [www.sportscasting.com](http://www.sportscasting.com), 10 August 2019.

32. Cited in <https://www.wired.co.uk/article/var-football-world-cup>.

33. Helsen, Gilis and Weston, ‘Errors in judging “offside” in football: Test of the optical error versus the perceptual flash-lag hypothesis’, 24 *Journal of Sports Sciences* (2006), 512–528.

34. Gottschalk, Tewes and Niestroj, *supra* note 11, 35–54.

35. S. Lindholm, ‘How Well Do Umpires Call Balls and Strikes?’ *SBNation, beyondtheboxscore.com*, 27 January 2014.

36. Jones and Levy, ‘Sporting Chances: Robot Referees and the Automation of Enforcement’ *We Robot 2017*, ssrn.com, 29 November 2018. Erikstad and Johansen, ‘Referee Bias in Professional Football: Favoritism Toward Successful Teams in Potential Penalty Situations’, 2 *Frontiers in Sports and Active Living* (2020), <https://www.frontiersin.org/articles/10.3389/fspor.2020.00019/full#B18>.

In addition, Gottschalk et al. refer to the immense psychological pressure on referees and argue that the transition to robot judges can reduce economic harm, psychological pressure and the risk of manipulation.<sup>37</sup> According to Lukas Brud: 'We knew we had to protect referees from making mistakes that everyone can see immediately.'<sup>38</sup> Having said that, AI driven technology can be used not only to assist referees but also to evaluate them, and thereby potentially increase psychological pressure. In an article reviewing the first use of VAR technology during the 2018 World Cup, the journalist ended with: 'Another thing to consider would be to stop those such as Cáceres from officiating top-level matches again. The 44-year-old's use of VAR on Monday exposed him as a weak-minded official, turning something designed to make his job easier into a tool for chaos.'<sup>39</sup>

The general perception that the introduction of AI technology in decision making can result in fairer outcomes is echoed by a growing body of research about user perceptions of ADM. Studies show that under certain conditions, people prefer advice from an ADM to advice from humans, a phenomenon that Logg et al. call 'algorithmic appreciation'.<sup>40</sup> Also in the context of algorithmic decision making in the media,<sup>41</sup> people tended to favour an algorithmic decision to that of a human decision maker under certain conditions. This is not to say that ADM cannot be afflicted by all sorts of biases.<sup>42</sup> Shin shows how, also because of a growing awareness of bias and other failures in ADM, fairness, accountability, transparency and explainability (FATE) principles are an important parameter for engendering users' trust in ADM, because users rely on FATE as heuristic tools to assess the trustworthiness of algorithms.<sup>43</sup>

One important factor that contributes to algorithmic appreciation in the justice sector is that people can find the decisions of an AI judge fairer than those of a human judge. Having said this, and interestingly, even in situations in which AI is considered to be able to make the fairer decisions, this does not automatically mean that people are willing to accept ADM. Whether they are willing to do so also depends on the extent to which other factors are present, such as respect for human dignity, the ability to express and understand emotions, and the human

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37. Gottschalk, Tewes and Niestroj, *supra* note 11, 48.
38. João Medeiros, 'The inside story of how FIFA's controversial VAR system was born', *Wired UK*, [wired.com](http://wired.com), 23 June 2018.
39. Sachin Nakrani, 'VAR: the World Cup verdict so far – some success but more clarity needed', *The Guardian*, 26 May 2018.
40. Jennifer M. Logg, Julia A. Minson and Don A. Moore, 'Algorithm appreciation: People prefer algorithmic to human judgment', 151 *Organizational Behavior and Human Decision Processes* (2019), 90–103.
41. Thurman, Moeller, Helberger and Trilling, 'My Friends, Editors, Algorithms, and I', 7 *Digital Journalism* (2019).
42. Lepri, Oliver, Letouzé, Pentland and Vinck, 'Fair, Transparent, and Accountable Algorithmic Decision-making Processes, The Premise, the Proposed Solutions, and the Open Challenges', 31 *Philosophy & Technology* (2018).
43. Donghee Shin, 'User Perceptions of Algorithmic Decisions in the Personalized AI System: Perceptual Evaluation of Fairness, Accountability, Transparency, and Explainability', 64 *Journal of Broadcasting & Electronic Media* (2020).

touch of the decision maker.<sup>44</sup> According to Lee, much also depends on the characteristics of the task in question and whether it requires more ‘human’ or more ‘mechanical’ skills. For tasks that mainly involve mechanical skills, users can find an ADM system just as fair as a human decision maker, even though the reasons behind people’s perceptions differed (for human-made decisions, fairness and trust are attributed to managerial skills, and for ADM decisions to reliability and the lack of bias).<sup>45</sup> However with tasks that require human skills, people valued ADM less positively because they lacked human intuition, relied solely on quantifiable metrics, and were unable to evaluate social interaction or handle exceptions, or were demeaning and dehumanising when used to judge people.<sup>46</sup>

The human factor is also a central factor in sports. Laukyte argues that sport is done by humans for humans, and that ‘[t]aking a human judge out of the loop means, to a certain extent, dehumanizing sport and inverting the praxis according to which it is humans who usually evaluate technology’.<sup>47</sup> In a similar vein, Jones and Levy, while acknowledging that an AI umpire can be the fairer decision maker, point to the importance of the human sociological context. They argue that the preservation of beneficial unpredictability, or what they call the ‘sporting chance’, is a reason for not appreciating automated refereeing. As their argument goes, even if an algorithmic system like a VAR were in a better position to make accurate and fair decisions, it is important to not underestimate the value of imperfect enforcement. Their analysis of four sports (golf, tennis, basketball and soccer) revealed that digital technologies and AI are used in different sports to enforce rules or aid umpires, and in so doing can indeed result in better, fairer and more accurate decisions, but that they also reduce the fun of watching the drama when tennis stars like Connors or McEnroe smash their rackets and try to intimidate the umpire. More concretely, they elaborate on six such elements, namely drama, adversity, custom, integrity, humanity and dignity.

Concerns about what the introduction of AI technology would do to a sport as such (i.e. the aspect of custom) were also raised in the context of the introduction of the VAR system, and more generally, probably any technological innovation.<sup>48</sup>

So while AI in sports refereeing can have clear benefits as well as drawbacks and less desirable implications, whether to use or continue to use AI-driven technology is, ultimately, a decision made by humans. And in this context the

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44. Helberger, Araujo and De Vreese, *supra* note 18.

45. Min Kyung Lee, ‘Understanding Perception of Algorithmic Decisions: Fairness, Trust, and Emotion in Response to Algorithmic Management’, 5(1) *Big Data & Society* (2018), 11, even though there is growing evidence that people are starting to understand the factual wrongness of the claim that AI decisions are characterised by a lack of bias, see Bruno Lepri, Nuria Oliver, Emmanuel Letouzé, Alex Pentland and Patrick Vinck, ‘Fair, Transparent, and Accountable Algorithmic Decision-making Processes’, 31 *Philosophy & Technology* (2018), 611–627.

46. Lee, *supra* note 45, 12.

47. *Ibid.*, 10.

48. Tom Lamont, ‘He shoots, he scores – or does he? How VAR changed football for ever’, *The Guardian*, 23 January 2021.

audience has undoubtedly an important role: if spectators do not like it, it is unlikely that we will see a further evolution of AI referees in sports. Therefore, and inspired by the theoretical assumptions made by Jones and Levy (and others), we investigated attitudes towards and the acceptability of AI referees in sports among a representative sample of Dutch citizens. In the following, we report some key insights from that research. In so doing, we also contribute to a growing body of research into human attitudes and understandings of automation and rules, and what exactly that human factor is.

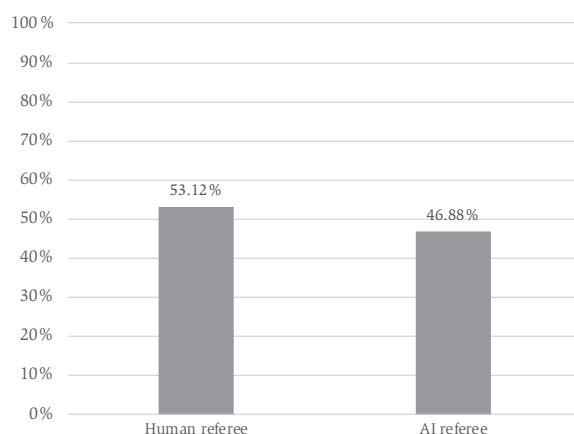
#### 4. REPORTING FROM A SURVEY

To explore what people think about AI referees, we conducted a survey among a representative sample of the Dutch population. Fieldwork was carried out by research company IPSOS in April–May 2021. The total sample size was 1,009. The respondents had a mean age of 48.2 years ( $SD = 16.7$  years) and half of them (50%) were women. Around 17% had a lower education level, 40% a moderate one and 43% a higher one. Prior to the start of the survey, respondents were given a brief introductory text explaining the concept of AI referees. They were informed about what AI referees are, how they are being used (e.g. to see whether a ball crossed the goal line in football) and how they sometimes replace real referees (since AI is becoming increasingly smarter). The introductory text familiarised the respondents with the topic, ensuring that they could answer all questions in a more informed way.

##### 4.1 Human vs. AI Referee: Which One is Fairer?

The first set of questions concerned whether people thought a human referee or an AI referee would make fairer decisions. To trigger people to consider the

*Figure 1: Perceived fairness of human referees vs. AI referees*



differences between a human and an AI referee, we asked a very binary question and did not offer the option of a hybrid relationship in which the human referee cooperates with an AI referee. As illustrated in Figure 1, respondents were almost equally divided between those who considered the human referee fairer (53.12%) and those who considered the AI referee fairer (46.88%).

#### **4.2 Reasons for Considering a Human Referee or an AI Referee Fairer**

We then asked the respondents to briefly explain their answer ('Could you briefly explain why you think that?'). We manually inspected all the answers, and the main arguments of those who considered the AI referee fairer could be roughly divided into five categories: 1) absence of biases (230 responses), 2) accuracy of decisions (93 responses), 3) ability to see more (72 responses), 4) consistency in decisions (7 responses) and 5) AI is the future (3 responses). The main arguments of those who considered the human referee fairer can be clustered around very different answer categories, namely 1) human ability to judge context (181 responses), 2) human ability give emotions a role in decisions (107 responses), 3) human ability to make exceptions (24 responses) and 4) human ability to provide communication (14 responses). We now provide some insightful answers ('quotes') to discuss these findings.

Regarding the arguments in favour of AI, the alleged non-bias of AI was the most cited reason (230 responses). A significant share of respondents said they believed AI referees to be unbiased. Some cited as reason the lack of emotions in AI: 'Refereeing is about rules. And only a computer can enforce that perfectly. Because a computer has no feelings, no gut feeling, and is purely objective' (respondent 84). Others mentioned the lack of prejudices and personal preferences, or as one respondent put it: 'AI can't be a fan of a specific club' (respondent 558).

Interestingly, the ability to have emotions (107 responses) and consider the human context (181 responses) were also often cited as reasons why human referees are fairer. As one respondent observed, fairness is more than accuracy and following the rules: 'With the help of AI, things can be perceived much more accurately, but honestly, there is more than just accuracy and following the rules; sports is related to emotion, weighing a judgment in certain context' (respondent 644).

When it comes to accuracy, several respondents said that AI is more precise, more objective, lacks emotions and is not prone to making human mistakes: 'The human referee makes mistakes and makes decisions based on feelings, which is almost impossible with an AI referee' (respondent 130). Often, however, it was human imperfections rather than perfect AI that caused respondents to consider an AI referee fairer: 'A referee is only human and can therefore make human errors. A robot can also get stuck or something, but in principle, it is adjusted to do the right thing and that is more fair' (respondent 323).

Even though many respondents conceded that an AI referee may make accurate decisions, they also found that it is less able to judge the broader context: 'A human referee looks not only at the moment, but also at the match as

a whole. Sometimes you have to be very strict, and sometimes you don't have to' (respondent 325). In addition to context, the ability to take decisions 'in the spirit of the game' was repeatedly referred to and a factor that could even outweigh the occasional mistake: 'A human referee makes decisions "in the spirit of the match". Any errors that occur are part of the sport' (respondent 218). Sometimes, however, decisions are not clear, and here it is the ability to engage in an argument and communicate with a judge that was a reason for a number of respondents to consider a human fairer: 'The human referee always remains flexible, but a robot acts in black or white. You can't argue with this either. Machines can also make mistakes. It doesn't get any more fun' (respondent 143).

Interestingly, some respondents clearly nuanced and differentiated between situations in which an AI or a human referee is fairer: 'In sports too, just like in real life, there are nuances. A referee must also be able to feel a match, so to speak. It is more than strictly following the rules. Rules are there to keep the game fair and orderly. That is a means and not an end in itself. So also in sports the following applies: it is not science but reasonable knowledge. AI can help the human referee though' (respondent 763). Accordingly, some respondents also argued that it is the combination of AI and human that can result in fairer decision making: 'When it comes to behaviour – for example, a foul – I prefer the human referee because the "spirit of the match" is always involved. In decisions with a clear boundary – for instance, ball in or out – the AI will always be fair' (respondent 46).

#### **4.3 Acceptance and Trust of Human/AI Referee's Decisions**

After the open question, we asked respondents about the extent to which they accept and trust decisions made by human vs. AI referees. When it comes to acceptance (see Figure 2), interestingly, the willingness to accept the decision of an AI referee was rather high. That is, around 62% of the respondents were at least rather likely to accept an AI referee's decision vs. only 14% who were not inclined to accept the decision of an AI judge; around 24% of the respondents were neutral. When asked whether people were willing to accept a human decision supported by AI, the number of respondents who answered 'very likely' was much higher (in total, around 77% indicated their willingness to accept such a hybrid decision).

In the context of trust, we compared a human referee with an AI referee. Respondents were asked to what extent they agreed with the following statement: 'I trust the AI referee OR human referee to be right' (see Figure 3). The answers 'rather agree' and 'strongly agree' are in favour of either the human or the AI referee. However, we also observe that in terms of total agreement (i.e. if we look at all three 'agree' answers), people were almost equally inclined to trust the decision of an AI referee (64%) vs. a human referee (71%).

Figure 2: Acceptance of decisions made by an AI referee vs. a human referee + AI

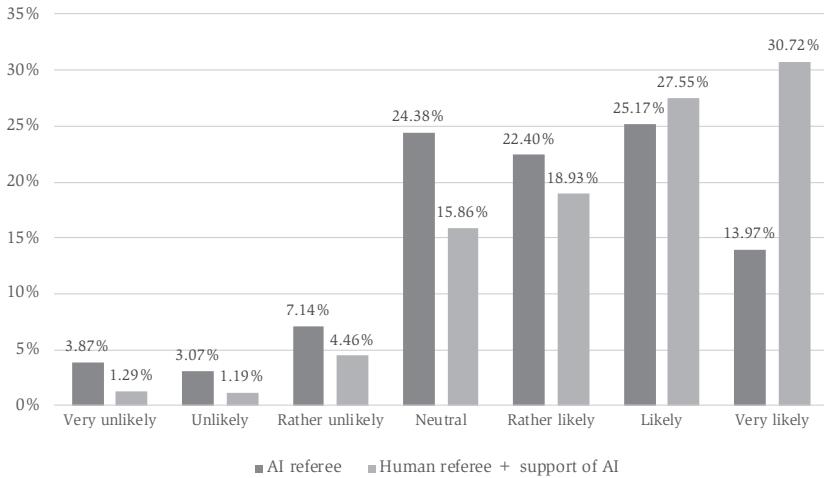
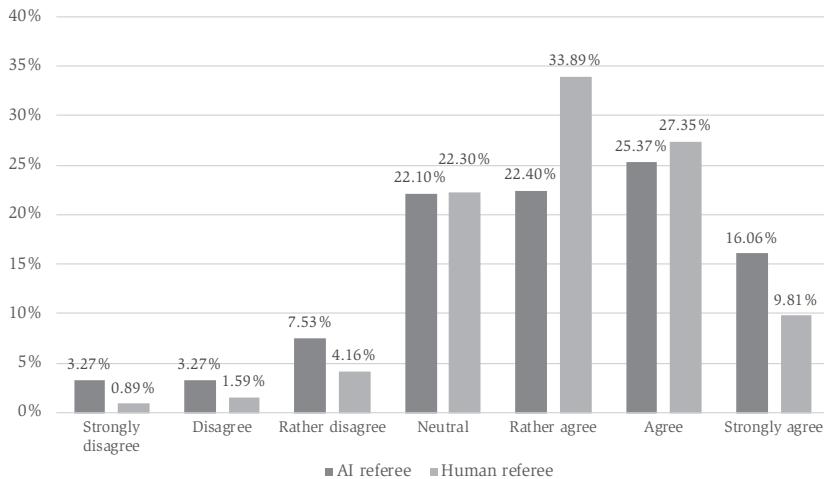


Figure 3: Trust in an AI referee vs. a human referee



#### 4.4 Human Agency

We then asked about human agency and the ‘human in the loop’ that is also mentioned in both the literature and regulations as an important normative requirement. In this section, when we mention ‘total agreement’, we refer to the answers ‘rather agree’, ‘agree’ and ‘strongly agree’ combined. The results indicated that, also for the case of using AI in sports, there was broad agreement

among our respondents that, ultimately, the human should be in control (32% of respondents strongly agreed with this proposition, and there was 83% total agreement). Also, only 6% strongly agreed that an AI referee should always have the last word (and 36% total agreement). In addition, 31% of the sample strongly agreed that the human should have the last word (74% total agreement). Very interestingly, however, there was rather broader agreement that also the human referee should be controlled through an AI system ('AI in the loop') (19% strongly agree, and 63% in total agreed).

#### 4.5 Reasons for Preferring an AI Referee

We then looked into the six elements of sporting chance developed by Jones and Levy as reasons why people might prefer a human referee over an AI referee even if the latter is considered to be more accurate and/or fairer or less biased.<sup>49</sup> These elements are drama, adversity, custom, integrity, humanity and dignity. In the light of this, we presented the respondents with 10 statements that tapped into their main reasons for preferring a human or an AI referee. These statements were measured on a 7-point Likert scale, ranging from 1 (= strongly disagree) to 7 (= strongly agree). The statements are presented in Table 1.

Table 1: Overview of all the statements and their agreement level

Statement	Strongly disagree	Disagree	Rather disagree	Neutral	Rather agree	Agree	Strongly agree
AI referees will make sports competitions fairer	4.7%	2.2%	7.8%	28.1%	24.0%	20.1%	13.2%
AI referees are less biased	3.3%	1.5%	4.6%	20.9%	22.0%	21.1%	26.7%
AI referees are more accurate	3.6%	2.7%	6.0%	27.8%	22.8%	22.4%	14.9%
AI referees are more reliable	4.6%	3.2%	8.7%	32.5%	22.4%	18.9%	9.7%
AI referees will make sports matches more exciting	12.6%	10.0%	16.4%	36.1%	14.0%	6.8%	4.2%
AI referees will make sports matches more fun to watch	13.4%	11.7%	15.2%	34.0%	14.7%	7.1%	4.0%
Disagreeing with the referee and opposing his/her decision is part of the game	7.6%	7.3%	8.5%	24.9%	22.9%	15.8%	13.0%
Sports competitions are no longer the same with AI referees	4.1%	5.7%	6.8%	25.2%	21.2%	17.0%	20.1%
Sport is 'human,' and so should be the referees	1.6%	2.2%	4.3%	19.7%	22.2%	20.3%	29.7%
Human athletes should not be judged by an AI	8.82%	11.40%	14.47%	30.23%	15.06%	9.91%	10.11%

49. Jones and Levy, *supra* note 15, 3.

Without going into too much detail, a couple of interesting trends can be drawn from Table 1. On the one hand, a considerable share of the respondents said that AI referees are less biased, more accurate and more reliable, and that thus AI referees could make sports competitions fairer. Having said this, the respondents did not agree that much with the idea that AI referees will make sports more exciting or more fun to watch. Many respondents also said that the human element is still very important. For instance, 'disagreeing with a referee and opposing his/her decision' is something that people engage in very often. Also, a significant share of the respondents said that sports competitions would not be the same with the involvement of an AI referee, so the human touch remains important here. When it comes to the general idea that 'human athletes should not be judged by AI', there is no real consensus: the respondents were very divided about this, which means that people might be open to AI-based sports judgments, but this will very much depend on the implementation of the AI, the context in which it is used (e.g. for what kind of decisions) and many other things.

## 5. DISCUSSION

A quote from a recent sports blog gives a good impression of the growing circle of enthusiastic followers who see a real future in sports for the AI referee:

In the future Artificial Intelligence will be able to make much better and more accurate decisions than the human referee ever can. Don't be surprised if robots will take over in the future with accurate AI driven decisions. Does it mean, there is no role left for the referee? No! I believe he will stay around, only in a different role. The role of the referee in the future will be one that is mainly related to human behaviour, emotions and conduct (which AI is still not fully capable of), unless we decide differently of course.<sup>50</sup>

Judging by our results, human referees are here to stay, and they will do more than merely lend emotional support. And judging by our respondents' answers, it is very unlikely that we will decide differently at any time soon, at least not in the Netherlands. Having said that, our respondents broadly agreed that AI can and should help human referees to make fairer and better decisions. Our survey thus revealed a rather high level of trust in and willingness to accept AI-assisted decisions.

It is indeed worth pointing out that our respondents valued different qualities of an AI vs. a human referee and that the clear majority favoured a hybrid model of AI-assisted decision making. This is a model in which the human remains in control. However, a significant share of respondents also argued that it should be the other round, too; namely AI should be used to control human referees, very much in the way that VAR is used. Indeed, as one respondent explained: 'I have been a referee myself, for more than 35 years. Having only

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50. A. Fetters, 'How Instant Replays Changed Professional Tennis', [www.theatlantic.com](http://www.theatlantic.com), 7 September 2012.

a robot as referee is not a good idea because you are then missing the element of human perception and feeling for the game. VAR technology is becoming better to complement selected moments for the referee. VAR is great for offside' (respondent 481).<sup>51</sup>

Curiously, we also saw something that can probably best be described as grudging tech resignation: even though the majority of respondents agreed that AI clearly has a role to play in judging sporting competitions, they also largely agreed that using AI in sports will change sports, and not for the better. Games will be less fun to watch, not in the least because disagreeing with the referee is part of what makes sports fun, but also because sports are human. Or as one of the respondents put it so succinctly: *Voetbal hoort niet bij robots*.

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51. See also Gottschalk, Tewes and Niestroj, *supra* note 11, 49, also pointing to the need to differentiate between different kinds of decisions.



# E-sports: A Battle Royale for IP and Antitrust?

*Thomas Vinje*

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It is such a great honour to participate in the celebration of the academic career of my dear friend Bernt. While Bernt and I share many interests, including of course copyright in the digital realm, it's ironic that the topic of this *Festschrift* is one about which I know next to nothing, namely sports. After quite a lot of head-scratching, I finally landed upon a topic related to sports that addresses an issue about which Bernt and I have collaborated for decades, namely the relationship between intellectual property and competition laws – here in the emerging digital arena of e-sports.

This small piece cannot of course adequately honour the greatness of Bernt's scholarship, much less the whole of the great human being who is Bernt. So I simply say thank you, Bernt, for all you have taught me and all we have learned together over these many years.

## 1. INTRODUCTION

Readers of this contribution might have heard of 'e-sports' through the popular press, but they might well never have heard of *League of Legends*, *Halo* or other '*Battle Royales*'. This introduction provides a basic description for the uninitiated of the vibrant e-sports industry and sets out some antitrust issues that might arise regarding e-sports.

The e-sports industry comprises a large variety of stakeholders active in the production and distribution of e-sports. *Publishers* such as Valve, Blizzard and Riot Games develop the video games at the centre of e-sports. *Organisers* such as ESL or the Korea e-Sports Association arrange and schedule tournaments, leagues and other events. *Professional players or teams* participate in such e-sports events. *Broadcasters* such as YouTube, Twitch or ESPN produce and arrange for the coverage of e-sports events. Some stakeholders are vertically integrated.

For example, Riot Games, which publishes the popular e-sports game *League of Legends*, also organises tournaments and leagues for competitive *League of Legends* play.

E-sports games differ by style and format. Popular genres include ‘first-person shooter’ games whereby players control a single military character from a first-person perspective of that character (*Halo*, *Call of Duty*), civilisation-building strategy games (*Warcraft*, *League of Legends*, *Dota 2*), sports games whereby players control teams playing against one another (*FIFA*, *NBA 2K*), or ‘Battle Royales’, which are last-person survival games (*Fortnite*, *PlayerUnknown’s Battleground*).

E-sports events are often formatted, structured and marketed in a manner reminiscent of traditional sports. The earliest e-sports tournaments emerged in the 1990s, and by the mid-2000s worldwide championships were being organised with prize winnings increasing to USD 1 million. Contemporary e-sports tournaments have developed into highly commercialised and lucrative events. In 2017, the annual *Dota 2* tournament, *The International*, offered a first-place prize of more than USD 10 million. As a clear sign of an increasing interest in e-sports by the public at large, the International Olympic Committee (IOC) announced in April 2021 that it would partner with sports federations and game publishers to produce the Olympic Virtual Series, the first-ever Olympic-licensed event for physical and non-physical virtual sports. The IOC’s move follows a period of intense growth for the e-sports industry, with the global e-sports audience set to grow to almost 500 million in 2021.<sup>1</sup> While the entire e-sports industry was valued at approximately 950 million USD in 2019, some estimate it will grow to over 1.6 billion USD by 2024.<sup>2</sup>

Arguably one of the largest differences between traditional sports and e-sports lies in the central role intellectual property (IP) rights play in the latter. Indeed, the video games at the heart of e-sports will typically be protected by IP rights: while nobody owns any IP over the game of tennis, publishers will typically hold IP rights to the games they have developed. As the e-sports industry matures, the projected revenue growth and the concentration of power in the e-sports industry mainly in one group of stakeholders – game publishers – is likely to trigger competition law concerns, including issues at the interface between IP and antitrust.

In e-sports, publishers license the rights to use their copyrighted materials to downstream participants such as tournament organisers or broadcasters. Publishers have discretion to determine who can access their IP for which purposes and under which conditions, including who can organise and broadcast e-sports events for their games as well as the eligibility criteria and conditions for participation in these events (such as anti-doping and tournament rules). In that sense, game publishers can take on the roles of *de facto* governing bodies and league organisers in traditional sports.

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1. <https://www.sportspromedia.com/news/esports-revenue-2021-live-streaming-audience-global-market-gaming-newzoo>.

2. <https://www.statista.com/statistics/490522/global-esports-market-revenue/>.

Virtually all other stakeholders therefore rely on publishers for permission to use the relevant IP rights in order to be active on the various downstream markets. The power conferred on video game publishers by virtue of their IP rights gives them the ability to control access to the market and hence to exclude competition downstream. While game publishers' primary source of revenue is likely to be the sale of video games or in-game features, the growing popularity of e-sports provides lucrative opportunities for publishers to integrate vertically and generate additional revenues downstream. To maximise profits, they are likely in some circumstances to have incentives to rely on their IP rights to exclude downstream e-sports competition.

If the publishers' gatekeeper role translates into market power in an antitrust sense and if publishers act on their incentives to restrict competition – downstream or on adjacent markets – their conduct could fall foul of Articles 101 or 102 TFEU or equivalent provisions in other competition law regimes. Potentially anti-competitive conduct could take many forms, for example, refusal to grant licences, banning players from participating in e-sports events, exclusivity agreements, excessive licensing fees, price discrimination, and tying and bundling.

Whether competition issues related to the organisational aspects of e-sports will be treated in the same manner as those of traditional sports remains to be seen. While national and international e-sports bodies are becoming increasingly active, game publishers will at times take on the role of *de facto* governing bodies similar to the role sports federations play in traditional sports. In relation to traditional sports, the European courts and the Commission have recognised the so-called specificity of sport and have taken it into account in their application of EU law to sport activities, finding that restrictive effects on competition inherent to the organisation and proper conduct of competitive sport do not violate EU competition law if these effects are proportionate to pursuit of a legitimate, genuine sporting interest.<sup>3</sup> Whether the organisational rules underlying e-sports, which may be governed by individual publishers rather than traditional sports organisations, should receive an equally permissive treatment is likely to be a contested issue that will provide food for debate, though outside the scope of this contribution.

The remainder of this contribution briefly describes the nature of IP protection in the e-sports industry in section 2, before diving into selected issues at the interface of IP and competition law in section 3.

## 2. E-SPORTS AND IP

To participate in an e-sport at any level, a player needs a licence to the video game. Unlike traditional sports, the video game being played competitively is comprised (almost) entirely of a bundle of IP rights. This means that any participation in an e-sport – whether simply playing *ad hoc* games against other private individuals through an online platform or participating in major international tournaments – depends on each actor (including the organiser and

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3. CJEU, 18 July 2006, case C-519/04 P, ECLI:EU:C:2006:492, *Medina*, paras. 42–45.

broadcaster of a tournament as well as its players) having the necessary licence of IP rights to do so.

Although a range of IP rights may subsist in the video game, the key IP right for the purpose of this contribution is copyright. As a computer program, the source and object code of the video game will attract copyright protection as a literary work.<sup>4</sup> The graphics in the game will likely attract copyright protection as artistic works. The composition of music incorporated in the video game may attract protection as a musical work, and the recording of that music heard by the player is likely to be protected as a sound recording.

As well as copyright in the computer program and its visual appearance, the name of the video game is likely to attract protection as a trade mark. Most prudent video games publishers seek to protect the names of their key titles through a trade mark registration. The proprietor of a registered trade mark has the exclusive right to offer goods or services under that mark within the scope of that registration. Therefore the act of indicating that an e-sports tournament concerns a particular video game could infringe a registration of the name of that video game. Article 14(1)(c) of Directive 2015/2436/EU provides a defence for use of a trade mark ‘where it is necessary to indicate the intended purpose of a product or service’. But whether this applies in the context of e-sports would be a question of fact. The trade mark proprietor would argue that the use of the trade mark implied that the tournament was an official event or otherwise endorsed by the proprietor.

Generally, the publisher of the video game will hold, or be the exclusive licensee of, the IP rights in the video game. In respect of copyright, the publisher will hold the exclusive right to authorise certain acts in respect of the copyright work. These include the exclusive right to authorise the reproduction and the communication to the public of the work as a whole or any substantial part of it.

The technical process by which the video game is playable on a computer requires some or all of the computer program to be reproduced. The exclusive right to reproduce a work covers the ‘permanent or temporary’ reproduction ‘by any means and in any form’, including ‘displaying, running, transmission or storage of the computer program’ in so far as those acts necessitate reproduction.<sup>5</sup> The act of playing a video game without the appropriate licence to do so is therefore likely to infringe the copyright in the computer program. Creating a stream or broadcast of a video game being played may not require or result in copying of the computer program itself, but will involve a communication to the public of the artistic and musical works displayed in the act of playing the game. Any website facilitating or hosting the stream could also be considered to be making a communication to the public.<sup>6</sup>

Video games are typically made available for purchase by individuals on standard licensing terms. The terms of the licence vary from publisher to

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4. Article 1(1) Directive 2009/24/EC.

5. Article 4(1)(a) of Directive 2009/24/EC.

6. CJEU, 13 February 2014, case C-466/12, ECLI:EU:C:2014:76, *Svensson v. Retriever Sverige AB*.

publisher, but licences typically will allow personal, non-commercial use only. The use of the video game to organise and broadcast an e-sports tournament could therefore constitute both a breach of contract and an infringement of the IP rights protecting the video game, as an end user licence is highly unlikely to include the rights necessary to organise and broadcast an e-sports tournament. Instead, the event organiser or broadcaster would need to obtain a specific licence from the right holder to use the game for its specific commercial purposes, such as promoting the game in connection with a tournament or streaming live coverage of a tournament.

### 3. THE INTERFACE OF ANTITRUST AND IP IN E-SPORTS

The fact that video games are protected by various IP rights confers significant power on publishers in the e-sports industry that does not exist on the part of any actors in traditional sports. Game publishers' ability to control access to the games they have developed means they can restrict downstream competition by virtue of these IP rights. Competition law concerns could arise in particular when publishers refuse to grant licences to downstream actors (section 3.2) or impose exclusivity or territorial restrictions in relation to broadcasting rights (section 3.3). However, whether such conduct violates EU competition law will depend on the publishers' market power and the conduct's restrictive effects on competition. Market definition is critical in that regard (section 3.1).

#### 3.1 Market Definition in E-sports

To assess whether industry players have market power and whether conduct or agreements generate anti-competitive effects, the boundaries of the relevant markets need to be demarcated. Market definition in the e-sports industry is complex. The e-sports ecosystem involves multiple stakeholders, including publishers, event organisers, broadcasters and distributors. Existing precedent delineates relevant markets corresponding to some of these activities, and existing findings related to physical sports might be transposed by analogy to e-sports to fill at least some of the remaining gaps.

Game software publishing sits at the top of the supply chain and constitutes a relevant market, with a possible segmentation into online and offline games, as well as games per platform (such as PC, console and mobile games).<sup>7</sup> Game distribution is downstream of game publishing and may take various forms. Mobile games are generally distributed via application stores (such as Apple App Store and Google Play). PC games are available through digital download platforms (such as Steam), while console games are normally distributed via traditional retail stores, dedicated websites or proprietary online platforms (e.g., PlayStation Network or Xbox Live).<sup>8</sup>

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7. Commission, 16 April 2008, case M.5008, *Vivendi/Activision*, para. 25.

8. Commission, 12 February 2016, case M.7866, *Activision Blizzard/King*, para. 20.

Neither the European Courts nor the Commission have yet had to define relevant markets in relation to the *organisation* of e-sports events. However, existing precedent in relation to the organisation and commercial exploitation of traditional sports events is instructive. In that regard, the European Courts and Commission have held that the relevant market for the organisation and the commercial exploitation of sports events is limited to a single sports discipline, for example in relation to speed skating in *ISU*.<sup>9</sup>

In defining such markets, the Commission will typically conduct a substitutability analysis from the perspective of various stakeholders: consumers, event organisers, professional athletes and broadcasters. In *ISU*, for example, the Commission noted that demand for the organisation and commercial exploitation of sports events primarily comes from consumers following a certain sporting competition, either by attending it in dedicated infrastructures or by watching it live on TV or online.<sup>10</sup> It found that fans of a given sports discipline are generally unlikely to substitute it with any other product for cultural, geographic and emotional reasons. In addition, the Commission found that the substitutability between the organisation and the commercial exploitation of speed skating events and of other sports events is practically non-existent. Organising events for specific sports disciplines requires knowledge of detailed sporting and technical regulations and specific organisational know-how. An organiser of events for one sports discipline would not be able to switch easily to the organisation and commercial exploitation of other types of events. Finally, professional athletes are highly skilled and must pursue intensive training in their discipline from a very young age. They can switch to different sports disciplines only rarely.

The above logic could be transposed to the organisation of e-sports events. Much like in traditional sports, consumers are likely to be interested in e-sports events for specific games. Fans of *League of Legends* are unlikely to switch away to, say, virtual *Formula 1* racing events in the case of a hypothetical small but permanent relative increase in the price of *League of Legends* events, *inter alia* because of their attachment to specific teams/players and the complexity of learning new rules in order to be able to follow a new game. The same is true for event organisers and professional e-sports players. It is therefore likely that the relevant market would be limited to the organisation of e-sports events for specific games, or potentially to the organisation of e-sports events within a specific genre, as games within the same genre might appeal to the same audience and organisers' specific knowhow might be transferable to the organisation of events within the same genre.

In the same vein, existing precedent regarding the licensing of broadcasting rights for traditional sports events might inform the Commission's approach to market definition in relation to the broadcasting of e-sports events. The appeal of a sports event to broadcasters depends on a variety of factors, including the attractiveness of the event to viewers and brand exposure opportunities. To date,

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9. Commission, 8 December 2017, case AT.40208, *International Skating Union's Eligibility rules (ISU)*.

10. *Ibid.*, para. 88.

the Commission has considered that the licensing of sport content broadcasting rights is on a market separate from other types of content broadcasting rights.<sup>11</sup> The Commission has also found that football broadcasting rights are not substitutes for other sports broadcasting rights, *inter alia* because football can contribute greatly to the creation of a channel's brand image, generates high audience figures, guarantees viewership for long periods because events take place regularly throughout most of the year, and has the ability to reach a particular audience which is desirable to advertisers. Going forward, certain e-sports events could also be analysed under such a narrow lens, although it seems unlikely that any game would reach the same status in the e-sports industry as football has in traditional sports and therefore would be deemed to constitute its own market for broadcasting purposes. For example, in *ISU*, the Commission found that broadcasters could substitute speed skating events with other products. It appears likely one could reach the same conclusion at least for the broadcasting of other e-sports events within the same genre.

While future cases might lead to different outcomes in terms of market definition in the e-sports context, the overview above demonstrates the complexity of the sector and economic interests involved. The exact delineation of the relevant markets in the e-sports industry is in any event likely to be of crucial significance to the issues at the interface of competition and IP addressed in sections 3.2 and 3.3 below.

### 3.2 Refusals to License in the E-sports Industry

Publishers might have incentives to develop their own downstream activities to generate additional revenues to supplement their game sales. To maximise profits, a dominant publisher might seek to reduce business opportunities for downstream actors, including by refusing to grant licences to independent event organisers and broadcasters. The question arises whether any such refusal could amount to an abuse of a dominant position under Article 102 TFEU.

It is well-established that a refusal to grant a licence, even by a dominant company, cannot in itself constitute an abuse of a dominant position. However, a refusal to license may in exceptional circumstances be unlawful. As held by the Court in *Magill* and *IMS Health*, and clarified by the General Court (GC) in *Microsoft*, a dominant firm's refusal to provide access to an IP right constitutes an abuse of that dominant position if (1) the right to which a licence is sought is indispensable to carrying on a downstream business; (2) the refusal is likely to eliminate all effective competition on the relevant downstream market; (3) the refusal to provide access prevents the emergence of a new product or otherwise limits technical development; and (4) the refusal is not objectively justified.<sup>12</sup> We discuss these requirements below in relation to e-sports.

11. Commission, 7 April 2017, case M.8354, *Fox/Sky*, para. 64.

12. CJEU, 6 April 1995, joined cases C-241/91 P and C-242/91 P, ECLI:EU:C:1995:98, *Magill*; CJEU, 29 April 2004, case C-418/01, ECLI:EU:C:2004:257, *IMS Health*; GC, 17 September 2007, case T-201/04, ECLI:EU:T:2007:289, *Microsoft*.

### **3.2.1     *Whether a License to Publishers' IP Rights is Indispensable***

As discussed above, all stakeholders in the e-sports industry – players, teams, broadcasters, organisers – depend on the game publisher for permission to use its IP rights in order to engage in downstream activities. Without a licence to the IP rights for a specific game, third parties would not be able to organise and broadcast e-sports events for these games. Thus, one could credibly argue that the relevant IP rights form an indispensable input to carrying on a downstream activity.<sup>13</sup> It does not, however, necessarily follow that this input is indispensable to compete *on a relevant downstream market*. Indeed, a finding that access to IP rights *for a specific game* is indispensable to compete on a downstream market would likely only be reached if the downstream market comprised solely those downstream activities related to *that game*. If the relevant market were to be defined more broadly (e.g., as comprising also activities related to other games, for example, within the same genre), downstream actors might have access to alternative inputs (i.e., IP rights to other games) they can rely on to carry on their activity on the downstream market. As noted in section 3.1 above, while one could reach the conclusion that markets for the organisation and commercial exploitation of e-sports events are game-specific, such a conclusion might be more difficult to reach in relation to the broadcasting of e-sports events. Whether or not IP rights to a specific game are indispensable will therefore be highly fact-specific. Clearly, though, such a conclusion cannot *prima facie* be dismissed.

### **3.2.2     *Whether the Refusal Eliminates Effective Competition***

In *Microsoft*, the GC clarified that for the purpose of establishing an infringement of Article 102 TFEU, the refusal must be liable to, or likely to, eliminate all *effective* competition on the downstream market. It is not necessary to demonstrate that *all* competition on the market would be eliminated, and the fact that competitors of the dominant firm retain a marginal presence in certain niches in the market cannot suffice to substantiate the existence of effective competition.<sup>14</sup>

A finding that all effective competition has been eliminated on the relevant market will, again, depend on the definition of that relevant market. In relation to e-sports, much like the reasoning above in relation to the indispensability criterion, a conclusion that the relevant downstream e-sports market is limited to activities related to a specific game will likely lead to the conclusion that a publisher's refusal to license IP rights for that game will eliminate effective competition on that market, as it is impossible for any downstream actor to be active on that market without access to such IP rights. However, any such conclusion appears difficult to reach if the market were to be defined more broadly.

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13. For example, the Court found that a licence to the television channels' weekly programme listings was indispensable to publish a complete weekly television guide (*Magill*, para. 53); similarly, the GC concluded that access to Microsoft's interoperability information was indispensable for workgroup server operating system providers (*Microsoft*, para. 428).

14. *Microsoft*, para. 563.

### 3.2.3 *Whether the Refusal Limits Technical Development*

In *Magill*, the Court found that one of the exceptional circumstances leading to the finding that the refusal to license amounted to an abuse of dominance was that it prevented the emergence of a new product for which there was potential consumer demand.<sup>15</sup> In *Microsoft*, the Commission, referring to *IMS Health*, argued that a new product is a product which does not limit itself essentially to duplicating the products already offered on the market by the owner of the copyright, and that it is therefore sufficient that the product concerned contains substantial (different) elements that result from the licensee's own efforts. The GC confirmed that an abusive refusal to license can also arise when the refusal limits *technical development*, and found that the Commission had correctly concluded that Microsoft's refusal prevented the emergence of products that would not merely reproduce the Windows systems already on the market.<sup>16</sup>

In *Topps*, however, in relation to a refusal to grant licences for the purposes of producing stickers and trading cards relating to national and international football tournaments, the GC confirmed the Commission's finding that the production of, for example, video trading cards or cards with pieces of match worn shirts, did not constitute new products, but only new features of existing products.<sup>17</sup> *Topps* illustrates that the Commission and the courts will place limits on the nature of prevented "technical development" they will accept as a basis for finding an abusive refusal to license. Just what these limits might be remains uncertain and it is difficult to foresee in the e-sports context what kind of forestalled technical development might be accepted as a valid factor supporting a finding of abusive refusal to license.

In relation to e-sports, downstream actors would have to show, based on credible evidence, that access to the IP rights of a game would enable them to develop innovations that would distinguish their services from ones already existing with respect to parameters which consumers consider important. It is not inconceivable that such innovations might exist in relation to the organisation or broadcasting of e-sports events, but such assessment will ultimately be specific to the facts at issue.

### 3.2.4 *Whether the Refusal is Objectively Justified*

Finally, a refusal to license will not amount to an abuse of a dominant position if the refusal is objectively justified. It is up to the IP right holder to demonstrate that the encroachment upon its exclusive rights is not justified in the public interest of maintaining effective competition on the market where the above exceptional circumstances are present. An IP right holder will typically argue that the commercial benefits it derives from the IP rights are the reward for its inventiveness,

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15. *Magill*, para. 54.

16. *Microsoft*, paras. 656 and 665.

17. GC, 11 January 2017, T-699/14, ECLI:EU:T:2017:2, *Topps*, para. 145.

and that a duty to license will reduce its incentives to innovate. Merely general and theoretical arguments will, however, not suffice in that regard.<sup>18</sup>

Thus, a publisher in the e-sports industry will have to show concretely *how* a duty to license would have significant negative effects on its incentives to innovate, *e.g.*, on its plans to develop new games. However, publishers' arguments in that regard might fail, as game publishers mainly generate revenues through the sale of games and in-game features, and not through e-sports related activities. In addition, the popularity of e-sports might also attract more viewers and hence potential players, which might lead to increased video game sales. Thus, in the event the requisite exceptional circumstances are present in a particular case, a publisher is likely to face an uphill battle claiming that its refusal was justified.

### **3.3 Antitrust Concerns Regarding Broadcasting in E-sports**

#### **3.3.1 *The Broadcasting of E-sports Events***

Broadcasting of e-sports differs quite substantially from the broadcasting of traditional sports. Traditional sports broadcasting is centred around TV channels, which compete to gain exclusive television broadcasting rights for major sports events, such as the UEFA European Championship, Grand Slam tennis tournaments and the Olympic Games. Obtaining such rights is of great importance to TV channels, as sport is the type of content most effective at attracting viewers or subscribers.

E-sports, on the other hand, have developed outside traditional TV channels. Their growing success comes in part from internet platforms such as Twitch, YouTube Gaming or Facebook Gaming. Publishers might also have their own channels on which they stream competitions. Epic Games, for example, has its own stream for its flagship Fortnite tournaments. As the gaming community has developed almost exclusively on these platforms, traditional cable TV is not (yet) a major actor in broadcasting of e-sports tournaments. Recently, however, some TV channels have started investing in e-sports content. For example, ESPN has begun streaming games on its website, and Sky has recently launched the Ginx. TV channel to air e-sports competitions.

Finally, as noted above, one of the main differences also lies in the fact that, under EU law, traditional sports do not fall within the scope of copyright or other IP laws.<sup>19</sup> Instead the organisers can create protectable rights on a contractual basis, by means of control of access to stadiums, specifying who may view, film, or broadcast the event and under which conditions. Video games, on the other hand, are protected by IP rights *in themselves*. Event organisers and, by extension, broadcasters need permission from publishers to use video games commercially. Even without any particular contractual arrangements in place, copyright law allows publishers to restrict exhibition of game play to specific

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18. *Microsoft*, para. 698.

19. CJEU, 4 October 2011, joined cases C-403/08 and C-429/08, ECLI:EU:C:2011:631, *Murphy*, paras. 95–99.

streaming services or linear TV, as they have the exclusive right to authorise or prohibit any communication to the public of their works. Certain restrictions in the licences that broadcasters need to transmit e-sports events might raise competition law issues.

### 3.3.2 Exclusivity in E-sports Broadcasting Licences

As in traditional sports broadcasting or in any other type of distribution agreement, exclusivity provisions can give rise to competition law concerns. If the scope or duration of exclusive broadcasting rights is too broad, there is a risk that competing broadcasters might be excluded from important content that attracts viewers, hence preventing these broadcasters from participating on the market.

In relation to football, the Commission reviewed UEFA's proposed sale of the media rights for the Champions League on an exclusive basis in a single bundle for all types of media to one broadcaster per defined territory, and for several years.<sup>20</sup> The Commission considered that such an agreement would restrict competition as there would be only one source of supply (UEFA) for broadcasters and it would lead to a single broadcaster acquiring all rights, excluding all others. To resolve the Commission's concerns, UEFA offered to divide the bundle of rights into several packages, making it possible for multiple broadcasters to acquire the rights, and to limit the duration of the agreements to periods of three years.

Thus, first, to assess the risk of infringing EU competition law, one must assess the substantive scope of exclusive broadcasting licences. In relation to e-sports, exclusive licences to broadcast all e-sports competitions for a specific game, or potentially even for multiple games owned by the same publisher, across different types of media, face a risk of being deemed unlawfully to restrict competition. To limit that risk, copyright holders might want to offer separate packages for specific games, or even for specific competitions, and potentially limit the scope of the exclusivity to one type of media (e.g., linear TV). That said, the potential of such agreements being found to restrict competition will of course depend on the scope of the relevant market, and the importance of the game or specific event within that market. For example, if one were to conclude that the relevant market is the market for the licensing of broadcasting rights for e-sports events within a specific genre, the restrictive nature of an exclusive licence would be assessed based on the share of the games and tournaments covered by the licence on that market.

Second, the duration of the exclusive licensing agreements will also play a critical role in this assessment. In relation to the sale of football broadcasting rights, the Commission has previously considered that exclusivity for periods of three years was appropriate.<sup>21</sup> The assessment of the appropriate duration will depend on the circumstances of each particular case. If the broadcaster is required to make significant investments to broadcast the relevant events, a duration longer

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20. Commission, 23 July 2003, case COMP/C.2/37.398, *Joint selling of the commercial rights of the UEFA Champions League on an exclusive basis*.

21. *Joint selling of the commercial rights of the UEFA Champions League*.

than three years might be justified. For example, in its investigation into certain commercial arrangements involving Formula One, the Commission accepted the parties' commitments to reduce the duration of broadcasting contracts to a maximum of three years, except where specific investments justified a length of up to five years.<sup>22</sup>

Similar reasoning is likely to apply to the broadcasting of e-sports events. With e-sports events gaining popularity, publishers have started converging towards the broadcasting approach in traditional sports where exclusive distribution agreements for broadcasting of sports events are common. In 2020, Blizzard, for example, struck a multi-year deal with YouTube, which acquired exclusive worldwide (excluding China) rights to stream Blizzard's global e-sports competitions, including some of the most popular tournaments such as Overwatch and Call of Duty leagues. Similarly, Twitch recently acquired exclusive digital rights to broadcast major ESL and DreamHack competitions. These agreements appear to have a relatively broad substantive scope, covering the most important tournaments for multiple different games, but seem to respect the Commission's limitations in terms of duration, as they cover a period of two and three years respectively.

### **3.3.3 Territorial Restrictions in E-sports Broadcasting Licences**

Aside from exclusivity provisions discussed in the previous section, consideration should also be given to territorial restrictions in licensing agreements. In traditional sports, broadcasting rights are generally granted on a territorial basis. Such arrangements are currently less relevant to e-sports, as e-sports events are typically broadcast via streaming platforms that are accessible worldwide. Hence, current broadcasting licences appear to be global in nature. However, with broader audiences becoming interested in e-sports, publishers and tournament organisers are recognising the need to have events tailored to specific audiences and to include national TV broadcasters in their distribution system. In Germany, for example, Seven.One Sports has obtained exclusive rights to linear television broadcasts in Germany, Austria and Switzerland for selected German-language Call of Duty League tournaments. The aforementioned agreement between Twitch and ESL-DreamHack deal also includes some exceptions to the exclusivity for certain areas in the world and for the digital platforms of linear television broadcasting partners.

Territorial restrictions in licensing agreements are not prohibited *per se*. However, in relation to the broadcasting of football, the Court has previously established that *absolute* territorial restrictions constitute restrictions of competition by object.<sup>23</sup> While clauses preventing active sales outside the licensed territory are permissible, restrictions related to *passive* sales in relation to individual consumer requests, which would entirely prevent users from accessing the content of foreign broadcasters, are prohibited. In relation to football, the Court considered that contractual provisions preventing viewers from importing satellite decoder devices to their home country from another Member State in order to

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22. Commission, 30 October 2001, case 36.638, *FIA + FOA*.

23. *Murphy*, para. 144.

watch the services of a foreign broadcaster are contrary to EU competition rules and the free movement of services.<sup>24</sup>

The same reasoning is likely to apply to the broadcasting of e-sports, meaning that any territorial restrictions in broadcasting licences that provide absolute territorial protection by restricting passive sales are likely to be found as having an anti-competitive object under Article 101 TFEU. Thus, while a publisher or event organiser might be able to require a broadcaster to geo-block access to its online content to give effect to a territorial restriction in the licensing agreement, it would likely not be permissible to require broadcasters to make it entirely impossible for consumers to circumvent such geo-blocking. For example, a broadcaster (say, in Spain) would likely not be allowed to block consumers (say, in Germany) from using VPNs to access content that is geo-blocked (in this case, in Germany) or to require consumers to provide local credit card details or a local address when signing up for a subscription. In other words, a publisher and a broadcaster may not agree to prevent consumers entirely from accessing e-sports content produced by that broadcaster in their home country.

That said, much like in *Murphy*, users accessing foreign broadcasts must be careful not to use them in a manner that would constitute a communication to a new public which was not taken into account by the authors of the protected works when they authorised their use by the communication to the original public. Such a scenario could arise, for example, where a streamer (say, in Germany) accesses the broadcast of an important e-sports event of a broadcaster whose licence is limited to Spain, and provides live commentary on that event to the viewers of her stream on Twitch. In transmitting such broadcast works, the streamer is likely to effect a communication within the meaning of Article 3(1) of the Copyright Directive, and her viewers are likely to constitute a new public, much like in *Murphy* the customers present in Ms. Murphy's establishment constituted a new public because those customers constituted an additional public which was not considered by the authors when they authorised the broadcasting of their works.<sup>25</sup> In such a scenario, owners of protected works would be able to enforce their rights by prohibiting such screening or requiring payment for the use of such content.

#### 4. CONCLUSION

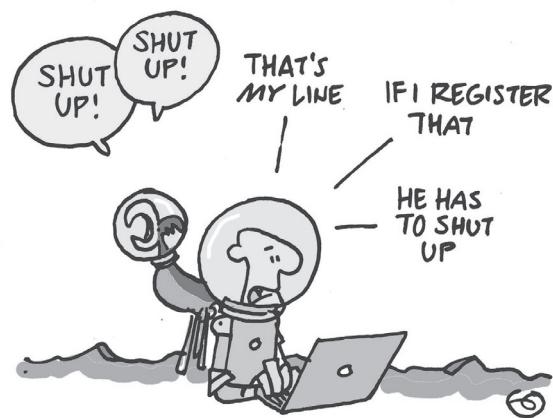
The e-sports industry is likely to become increasingly fertile ground for competition law issues, especially at the interface of competition and IP. While many questions have no definitive answers for now, market definition is likely to play a central role, and the outcome of any antitrust dispute in the e-sports sector is likely to be heavily influenced by questions similar to those arising in the traditional sports context. Stakeholders in the e-sports industry should take stock and consider the potential impact of the concerns identified above on their business practices.

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24. *Murphy*.

25. *Murphy*, para. 199.

ON MARS...



# Mars

*Just Szynkovid*

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So this is what life on Mars is like.

True, it can be rather dull, even more so than South Georgia or Tristan da Cunha. Or Bergen. And freedom of movement is limited, even in Schiaparelli, let alone here in Shelter 306. The Aureum Chaos mountains look impressive but scaling them is out of the question, while even a short hike, although not strictly forbidden, is discouraged as being rather risky, and rescue operations will not even be considered.

Yet it might have been far worse. Fact is, this Shelter was developed for research purposes and used to house a crew of sixteen. When the research facility was discontinued and the crew withdrawn, they left everything as it was, thus providing lots of space for someone like me who's here on his own. It now is simply an autonomous observation station, but dismantling anything not needed for that purpose would have cost more than it was worth. So I now find myself in a dome with all kinds of resources, such as a gym; a gyronat; a well-stocked VR film repository; and even a jacuzzi, for the subsoil is rich in water of crystallisation which may be extracted as ordinary, crystal clear water, remarkably enough mostly D<sub>2</sub>O – heavy water – but it tastes the same as H<sub>2</sub>O and is just as refreshing. Now that I come to think of it: lucky thing such a source wasn't available on Earth in the 1940s, when the Nazis needed heavy water to develop an atomic bomb, and painstakingly produced it in Norway, only to have the local Resistance sink the vessel transporting it, so the Jerries still had nothing. If they had succeeded we might never have set foot on Mars, although of course we might all of us have gone to the Moon. Or rather our ancestors, not us. Yes, right, I take an interest in History. But that's neither here nor there. Let's get to the point.

Shelter 306 is in a remote spot, and they sent me here to get rid of me for the time being, if not forever. In Schia – nobody says Schiaparelli – they frankly were not amused when they found they'd been saddled with a *lawyer* – and even a

Dutch lawyer. Fact is, it was an output error of the AA, the *AutonomousAssessment*. Those autogoverning systems are quite remarkable but they're not yet foolproof. Moreover, they're pretty ill-tempered and will never admit they made a mistake. So if you're selected for Mars, however insane that may be, you're simply supposed to go. Also, I thought it might be quite an adventure, while a change of air might do me some good, as Natasja – well, never mind. A change of air it certainly was – mostly nitrogen and some carbon dioxide here, pressure rising steadily but still at Himalaya level, while the flux of oxygen will have to wait until the planet can start sustaining plant life – perhaps a decade from now. Lucky one doesn't need it, thanks to the Oxymoreon.

As I said, in Schia they were rather unhappy about it. To have lawyers all over the place on Earth is bad enough, not counting these *gnomes* pretending to be one – they used to be called *expert systems* – lot of system, little *expertise* – then *artificial intelligence*, followed by *embedded Trulaw* but still not much better; as I said – or, rather, as *they* said – to have lawyers all over the place on Earth is bad enough, so on Mars we want to stay clear of them as long as we can. And frankly, they had a point there, for lawyers can indeed be tiresome, especially if they're right. So they didn't even give me time to prove myself right, but just made it clear they had no jobs for lawyers, and only one job where even a lawyer could do no harm: they needed someone to monitor observation equipment somewhere far out, and if I wished to practise law I might just as well do it there all by myself, as this is a one-person-post, just like a desert island lighthouse in former centuries. Whereupon they dispatched me to this Shelter 306 and told me not to expect anyone to relieve me within the next six months, or two years, or whatever; for on Mars long distance people transport still is both cumbersome and costly. And if they plan to wait till another lawyer arrives it may take some time indeed.

Lonely? I'm not alone; there's always Tim, my parrot. Bought him cheap because he had a system failure – a full reconditioning would have cost more than he was worth – and managed to get him 'live again, with some anomalies for sure, but those made him even more parrotlike than he was ever before. Also likes to contradict me. Very useful, that's what I need him for, although he can be rather ill-tempered,

"Aren't you, Tim?"

"No, I'm not."

See? Likes to contradict me.

So I'm fine here. The Shelter is fully circular and entirely self-supporting. Anyone could monitor the equipment; indeed, even a lawyer can do it, since it's fully automatic; all one may have to do is to change some module in case of failure and press the reset button. The drawback is, it's not enough to keep one busy, so I felt I needed something more like a job, or at least an occupation. Well, since they told me I could devote myself to the law here if I liked, that's exactly what I'm gonna do. And as I'm an intellectual property lawyer – although I will shortly lose my licence for failing to attend the compulsory refreshment courses – I

thought drafting an intellectual property scheme for Mars might not be a bad idea. Sooner or later in Schia they are bound to find, however reluctantly, they cannot do without it after all, and they'd better not copy any system from over there where we all come from.

“Why not?”

“I’ll come to that in a moment.”

Those who are not familiar with law may wonder why anyone should wish to draft such a system – if it should be drafted at all, of course. Why not leave it to a qualgorithm, like anything else? Admittedly, almost anything today is qualgorithmised – anything except law, for it is common ground that any progress in that area keeps being curtailed by a change of direction or unforeseen hair-splitting refinements in new UCJ or Scotus decisions (by the way: in spite of its name the Universal Court of Justice still is far from universal, for its decisions do not even cover half of the Earth, let alone the Universe). The Quest for Justice in any situation and at microlevel has effectively smothered all and any foreseeability or predictability in individual cases, while all and any attempts to change the system are defeated as being unconstitutional, at least in Germany; and anywhere else by proxy. Moreover, lawyers are just too undisciplined to let themselves be made redundant that way. It makes law the only secure profession, as there will always be a demand for lawyers.

Which allows me to have a go at it.

“Fools rush in where angels fear to tread.”

“I’m not even going to reply to *that*, Tim.”

Of course, any system, scheme or analysis had better be based on facts, so some sources would be welcome. Earth is too far away to allow for transorbital *information retrieval*, while Schia is not interested in legal issues at all and does not provide or even store any legal information. Being aware that Mars still is far from being some Earth 2.0, I anticipated such shortcomings and downloaded all I might ever wish to know on my Brainflower memory device before my departure from Earth, including everything concerning law since time began; for a Brainflower’s memory size and its search capacity make the brain flower – literally, as the brain is the very spot where it is integrated, and which it turns into a blossoming and virtually unlimited *knowledge garden*. (Incidentally, according to an obsolete – and perhaps not entirely reliable – case report, back in 2042 people were highly impressed by Mindblower memories which stored a modest 1.5 hexabyte only, as quantum memory technology had not yet been developed. Fortunately, Brainflowers have far better specs.)

Indeed, this Brainflower would have put everything at my fingertips, or rather my nerve-tips, if it weren’t for Murphy’s Law, which continues to survive every new technology. Mars’s lesser gravity may have something to do with it, or perhaps quantum super-asymmetry goes astray in a D<sub>2</sub>O environment; but whatever the reason may be, I somehow find myself unable to access any of my Brainflower’s contents over here.

Luckily, I still have my old pre-Mindblower Memento memory. It was already considered antique when I first got it, yet I always kept it, for sentimental reasons or because I was never good at throwing away anything; and it turned out to contain a discontinued database of – mostly – Dutch and ECJ intellectual property law up to 2020, which I ought to have deleted long ago. Not only it serves me well on this occasion, but it also enables me to base my analysis essentially on Dutch law up to 2020 (plus some more recent data which I simply happen to remember). I've always preferred Dutch intellectual property literature, as I found the Germans too thorough, the French (and Belgians) too principled, the Scandinavians too sophisticated, and most other countries of little consequence at all. Except for the Anglo Saxons on either side of the Atlantic and elsewhere, sure, but as to those – well, better stay clear of all common law systems or you will find yourself in dire trouble more than you ever were before. It may be the best law available, but it comes at a price, for the cost is absolutely baffling.

Anyway, in those days Dutch publications were top of the bill. Or at least some of them. And 2020 is just about sufficiently long ago to get some idea where on earth it did go wrong. Or rather, where it did go wrong on Earth.

“Earth, lovely Earth, blue skies and white clouds. Why did you take me to this place?”

“Hush, Tim, if it weren’t for me, you’d be nowhere at all now. Besides, isn’t Mars’s twilight remarkably colourful? Sometimes it even reminds one of dawn breaking on the Brahmaputra river, with its

‘mist of opalescent mauves,  
While painted parrot-flights impinge the haze  
With scarlet, chalcedon and chrysoprase.’

No parrot-flights here though, I’m afraid. Still, you might appreciate the reference.”

“No, I don’t.”

“Well, don’t sulk anyway.”

As I said: where did it go wrong on Earth? Or did it? Many will argue the opposite, for on Earth intellectual property is usually considered a huge success, though not in all its former branches. Today, it’s mostly copyright; while trademarks also are still going strong. But other fields suffered.

First to go was design law. In retrospect, its downfall started in 2019, when the ECJ extended the originality standard to designs. In the wake of that judgment there was some discussion as to how it should be construed. The Portuguese Supreme Court read it as a severe threshold, and thereby a bar to copyright for most designs, but in the end the Dutch view that almost any design may well be ‘original’ prevailed. Indeed, it is a well-known fact that the Dutch are always right – or so they think. But it effectively undermined design law: hardly anybody registered designs anymore – why take the trouble and incur the cost if copyright offers more for less, or rather for free? So in the end design law petered out and was abandoned.

“Do you know I was made after a registered design myself?”

“No, I didn’t know you were *that* old, Tim.”

Rather unexpectedly, patents were next to go. Although the Dutch wistfully remembered how, until 1910, their industry thrived for half a century, thanks to the absence of patent legislation, a century later their lawyers thrived thanks to patent *litigation*. But it was the very success of patents that finally led to their downfall. Perhaps the patent system could have survived the widespread disapproval of pharma patents in the wake of the global pharmaceuticals scandal, when patents made many cures inaccessible for large parts of the world’s population, while discouraging innovation in fields where no huge profits could be anticipated. But it was the invention of fully automatic inventing – and patenting – that made the patent system collapse under its own weight, with over 250 million world patents granted every year and no industry escaping paying unbearable licence fees or fighting hundreds of claims over any kind of activity.

“I was patented too. Literally covered by dozens of patents.”

“Most of them probably invalid, Tim. And all expired long since, of course.”

In the end, patents were considered either obsolete or counter-productive – most likely both – and patenting was abolished. Although interested circles prophesied disaster, nothing of the kind happened; rather, technological progress blossomed and boomed. And yet I mourn patent law’s demise, wistfully realising how much I would have loved to be a patent lawyer myself – earning heaps of money by making a fuss about patent parameters which neither the court nor the inventor himself, or anyone else for that matter, seems to understand in most cases.

But copyright was quick to fill such *evolutionary gaps* as patents, now extinct, might have left. For copyright may cover anything, although many refused to believe it for a long time. The maxim that copyright may exist in ‘works of science, literature and art’ does not in any respect limit its scope, since anything may be so labelled – even if something is neither *literature* nor *science*, it can always be considered *art*.

True, according to copyright theory, its application is restricted to original subject matter only, the corollary being that everything functional is outside its scope of protection. Nor is copyright supposed to protect mere facts. However, in 1989 a ground-breaking thesis convincingly argued that originality is not a bar to copyright in information. According to this thesis,

‘the subject matter of copyright is, in essence, information ...’ [and] ‘the underpinnings of the prevailing doctrine which denies copyright protection to factual information are weak. ... Scientific discoveries and theories should, in principle, qualify as copyrightable subject matter, on the grounds that they are products of “creative” labor.’

“Interesting! Who wrote that?”

“Sorry, Tim, no names.”

For although the source mentions the author's name, of course I will duly skip it here. You may perhaps find it hard to believe, but until the late 2030s it was quite customary to mention authors' names on whatever they made – not only novels, paintings, photographs and the like, but scholarly and scientific publications as well. In fact, not only this was standard practice, but it even was a copyright tort to remove the author's name, as this infringed his so-called 'moral rights'. In retrospect it was of course a pretty doubtful and at times even disgusting custom, for it made the public focus on names and authority rather than on the quality of the work as such, while it encouraged vanity and competition instead of team building and modesty. It certainly was a major step in the civilisation of mankind when, in the 2040s or so, it was at last challenged and not much later abandoned. Quite a remarkable paradigm shift, incidentally. All one may use now is a pseudonym, provided the real name is kept secret, and a fresh one must be chosen for every new item. QRX or similar codes provide all necessary data for identification of the document as such.

Where was I? Ah, yes, what this 1989 thesis said about originality. Time has proved it to be right. Already in 2006, in the so-called *Technip* case, the Dutch Supreme Court ruled that the mere fact that an author used his skills and experience to choose between an – admittedly large – number of technical alternatives, might justify a finding of originality. In the field of functional designs, that same Court observed in 2013 that:

‘[the] exclusion of copyright protection does not extend to all technically functional elements, as this would mistakenly exclude industrial design from copyright protection.’

This provided a simple workaround: although single functional elements and facts could still be unprotectable, combinations thereof might easily be considered original. And in the 2020 *Brompton* case the ECJ firmly stated that:

‘where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work and, consequently, to be eligible for the protection conferred by copyright’

but immediately left the back-door open by adding:

‘that a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices’.

Even today, we all know the outcome of *that* case; especially the diehards among us who still insist on riding bicycles.

Later decisions confirmed and further developed these principles. As a result, most subject matter that once used to be covered by patents now somehow

simply enjoys copyright protection. The main remaining issue concerns the scope of protection; but that was no different when we still had patents. Or design law.

“Please stop. I’m bored!”

“Shut up, Tim, if it’s boring it’s not me but the Courts. Anyway, I need to explain.”

“No, you don’t. You’re a bore! Hijo de puta!”

“Now who the hell taught you such language? You don’t even know what you’re saying.”

“Yes I do! It means – DON’T SWITCH ME OFF!”

“Well, you’d better behave, then.”

One might perhaps have expected copyright supporters to be satisfied with this enlargement of its reach. Well, they weren’t – in fact it rather was an incentive to further expansion. Thus, the extension in the 1990s of the copyright term to seventy years *pma* first stimulated a demand for a similar prolongation of neighbouring rights, and then again for a further increase of the duration of copyright itself, while today the main issue is whether the current neatly rounded 100 year *pma* term should be extended even more. As CISAC, still alive and kicking, argues: ‘The French have had perpetual moral rights since ages; exploitation rights both could and should be just as perpetual’. The overall maxim is: *the more the better*.

As is confirmed by copyright’s economic impact. Between 1982 and 2005 it rose from a mere 2.4% to almost 6% of the Dutch national product, but it didn’t stop there: according to a recent estimate – if I remember correctly – the copyright industries presently account for over 20% of the gross global product. Which is hardly surprising, as half the economy is now based on digital technology and half of all digital technology is made up of software, while virtually all software is protected by copyright. Anyway, it made the researchers state that *this confirms copyright’s immense value to mankind*.

Evidently, it can hardly be denied that the very expansion of copyright demonstrates its huge success. Nevertheless, it also has some rather nasty shortcomings.

The surge in copyright litigation, for one. Once again, this has a long history, but its starting point and incentive may well have been the EC Enforcement Directive of 2004, which the European Commission foolishly believed would put a stop to piracy, *inter alia* by providing that in intellectual property litigation:

‘reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party’

while, incidentally, the Dutch courts for many years even more foolishly interpreted ‘reasonable and proportionate legal costs’ as ‘full costs’. The effect was exactly the opposite: comforted by the prospect – although often far from justified – of recovering their costs, right owners brought more cases, and litigation rose to unprecedented heights, while the true pirates found other channels. Copyright litigation is a major industry now, which as such will of course oppose

any major reassessment of the copyright system. If things continue like this, soon every second lawyer can be expected to litigate copyright cases.

But copyright has an even more fundamental flaw: its total disregard of *sports*. While virtually anything may somehow be labelled a *work*, copyright turns a blind eye to sports and games; not computer games but the real stuff, like chess, draughts, whist, bridge and go.

As early as in the mid-nineteenth century, long before the Berne Convention laid down the internationally accepted fundaments of copyright, chess champions claimed copyright in their games, especially those played at major tournaments. But their claims never matured, although it is common ground that chess is an art and chess games can be highly original.

And for sports, such as: Sailing. Surfing. Flying. Paragliding and whatever else one can think of to stay airborne. Judo. Skiing. Climbing. Bouldering. Rafting. Rowing. Running.

“No, not running. Running is just putting one foot before the other. Nothing original about that.”

“Shut up, you stupid parrot, what do you know about running? You can’t run yourself. You can’t even fly!”

Yes, there should certainly be copyright in running; if only in recognition of that recent 1:49:59 Amsterdam marathon world record. Surely something makes it original, never mind what. Or we must find a workaround.

And in all ball sports, of course. Tennis. Cricket. Golf. Hockey.

“Ice hockey!”

“No ball, only a puck there, Tim. Besides, ice hockey has been banned, remember? Like boxing, and American football. They always were harmful to the brain, of course, as the fate of Muhammad Ali and many others demonstrated, but the damage these sports caused to the delicate Mindblowers turned out to be the limit.”

Back to ball sports. Bowling. *Jeu de boules*. Billiards, both three cushions and pool. Baseball. Basketball. Volleyball.

“Football!”

“Right, Tim, I was just coming to that.”

Football – meaning soccer, of course. Noblest sport of all – or so some say. Even without the help of Mementos, Mindblowers or Brainflowers and after decades, fans will remember and cherish countless passes, slidings, goals or even entire matches. Who could argue in earnest that football is not original, or artistic? Yet that is the position which copyright doctrine has somehow taken and stubbornly refuses to reconsider since the *Football Association Premier League* case of 2011, when the ECJ stated:

‘FAPL cannot claim copyright in the Premier League matches themselves, as they cannot be classified as works. To be so classified, the subject-matter

concerned would have to be original in the sense that it is its author's own intellectual creation ... However, sporting events cannot be regarded as intellectual creations classifiable as works within the meaning of the Copyright Directive. That applies in particular to football matches, which are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright. Accordingly, those events cannot be protected under copyright.'

Clearly, some people cannot recognise creative freedom when they see it. (But perhaps those justices never saw it.) Well, FAPL probably just shrugged their shoulders, for they had long since secured the audio-visual copyrights in their matches. But this solution is flawed as to principle – like protecting the glass of the bottle instead of the *Grand cru* which it may contain.

“Wine may damage your health.”

“So they tell us, Tim. Wish I had a few bottles here, though.”

Anyway, once technology enabled virtually anybody to secretly film matches in HD, that workaround proved less than helpful. Copyright should vest in the matches as such, not in their AV packaging.

Why this stubborn opposition to the recognition of sporting events as copyrightable subject matter? Apprehension that the scope of protection might go too far and be counterproductive may have something to do with it. It has been argued that copyright in chess games might restrict the freedom of other chess players to make similar sequences of moves. That fear may well be justified, for as the maxim says: *if something is worth copying it is worth protecting*. But we must not let such concerns compromise just principles. After all, in its 2006 *Trésor Perfume scent* judgment, the Dutch Supreme Court did not hesitate to find that *scents* may qualify as *works*, regardless of the potential practical complications it might lead to. That's the spirit!

True, it may take some time before Mars will be able to welcome sports, especially outdoor sports. But once it does, Mars's copyright should welcome them too.

The last shortcoming of copyright on Earth, but certainly not the least: where do the profits go? As the figures suggest – over 20% of the gross global product today being based on copyright – certainly to the major economic partners in industry and trade; but in fact hardly to the authors themselves. The steep increase in the number of collecting societies – in the Netherlands just three in 1960, some twenty in 2015, ninety-eight or ninety-nine today (while a strong urge is being voiced to celebrate the unavoidable incorporation of entity 100) – merely accounts for a tremendous rise in overheads, rather than more profit for authors. At the beginning of the millennium vigorous attempts were made to raise their share, but the results remain poor; and so do they.

Well, that is what copyright on Earth is like today: overprotecting in many aspects while underprotecting those who deserve it. How can we do better on Mars?

The first idea that comes to mind is, to abolish copyright altogether; or, rather, never to introduce it at all. No doubt that's what they'd like best in Schia. It has been suggested on Earth, but received little support. And authors would suffer even more, for they would have no rights and simply receive nothing. We clearly need something more sophisticated.

Once more, earlier Dutch doctrine provides some interesting suggestions. At the turn of the century, *the end of intellectual property as we know it* was already considered in an article that described 'two potential substitutes for the copyright regime ...: contract law and information technology'. Although perhaps more as a challenge than as a solution, for it was argued that:

'[t]he combination of both instruments poses a direct threat to the copyright system, as we know it. Contract and 'code' combined have the capability of making copyright and its set of statutory limitations largely redundant, and may require an entire new body of information law to safeguard the public domain [while] difficult questions regarding the scope of rights and limitations, applicable law, and liability may eventually require a thorough rethinking of copyright law in the not too distant future.'

But although we have had more contract law and far more information technology since then, in the end copyright proved more robust than one could possibly have anticipated. So what else can one think of?

"Why not simply forget about it?"

"What do you mean, forget about it? You're not my psychotherapist, are you? Or if you are, don't make silly suggestions!"

We need to adapt copyright in such a way as to make it profitable to authors, while curtailing litigation and including sports and games. The key may be found in the 2017 *VOB* case: the root of all evil is not in copyright as such but in its exclusive nature. As the ECJ pointed out, the interests of authors may be better served by a statutory claim to remuneration than by the exclusive right. There is no need to abolish copyright: all we have to do is merely to curtail intellectual *property* – meaning the property side of copyright. Which can be done by providing for a full statutory licence, entitling authors to fair compensation for whatever use is made of their works; to be collected and distributed through autonomic assessment by one single organisation. This will no doubt put a stop to 90% of all copyright litigation, if not more, while the money goes to the authors at last. Or at least most of it.

As to sports and games, we must simply add them as subject matter: copyright subsists in original literary, scientific and art works, as well as in individual or team sporting and gaming achievements. Some will perhaps argue that these should be the subject of a neighbouring right rather than copyright, but we'd better abolish neighbouring rights altogether. Performances are sufficiently original to enjoy copyright, while we can jolly well do without the rest of them. As has been suggested before.

That's the general idea. Of course, it needs to be worked out in some more detail ...

“No kidding!”

“Shut up, Tim, or I’ll make you do it yourself. Now try again.”

“Though this be madness, yet there is method in’t.”

“That’s better, though not much. You’re the most educated parrot I’ve come across yet, Tim. Anyway, this will do for now. I’m going out for a walk; never mind what Schia says. I want to experience Mars as it is before the ongoing process of carbondioxidisation turns it into a replica of Earth after all.”

“Must you, really? It’s not safe.”

“Contradicting me again, aren’t you? Well, it’s none of your business. Meanwhile, you’d better recharge. Now where is my portable Oxymoreon?”

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That was a pleasant nap; I feel fully recharged indeed.

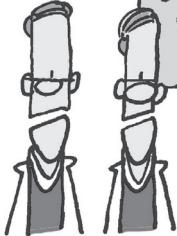
I rather enjoyed that brainstorm, although some people will probably argue his scheme is all wrong, while its effects would be highly questionable. Well, I couldn’t say, I’m afraid copyright is beyond me. After all, I’m only a parrot; and not even a real one. Although I could outreason any of *those*.

Went out for a walk, didn’t he? He should have been back by now. Maybe he met a Martian?

ROBOTS?

WE ALREADY HAD  
THEM IN OUR AJAX-  
TIME

FRANK AND  
ROBOT DE  
BOER, THEY  
USED TO  
CALL US



6

# AI-JAX

*Daniel J. Gervais*

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Jaap's local team had just lost the European final, in a penalty shootout to boot. It's true, soccer matches – what some enigmatic people known as Exiters called 'football fixtures' – were so often that close these days. The headline in *De Telegraaf* was correct, yet again: 'Ajax had veel eerder mogen scoren'. Jaap skimmed the brief article which, like more than 90% of the articles in this venerable news medium, had been written by a robot reporter. The articles about matches were almost always the same so that it took less time to get the gist, not like old human-written articles full of unnecessary drama. The sports robot at *De Telegraaf* was affectionately known as 'De Kapitein', in honour of the last human soccer journalist to work at *De Telegraaf*.

Jaap got on his e-bike and made his way through the lovely canals of his city – without a doubt the nicest city on Earth – to his office at the University of Amsterdam (UvA). Now that the gemeente had banned all vehicles other than self-driving electric taxis from the city streets, e-biking was genuinely easy and pleasant. Jaap's office was in the old Roeterseiland campus, which the university planned to demolish and move to a new island built just off IJburg.

Jaap's students were all waiting for him when he walked in the classroom. This class was in English, as were so many now at UvA, a fact that some disgruntled professors kept complaining about. For Jaap, language was never an issue. Jaap started the class as he always did, with an open question to the entire class. Most of the time no one volunteered to answer, and he would then pick a student and repeat the question. 'When is a robot liable for its actions?' None of the 65 students in front of him raised their hand. 'Let's ask one of the better ones to get the ball rolling,' he thought. He walked towards the first row and stood in front a tall student with too much curly red hair. 'Tim, when is a robot liable?'

'That depends. What do you mean by "robot" and then "liable" for what?'

'Good,' Jaap said, reminded once again that many of these students were already well trained as future lawyers. Answer a question with a question.

However, he had seen it all and was ready for anything. ‘You can’t define robot? This is week 9 of the semester. It should be easy by now.’

Tim looked a bit embarrassed. ‘One accepted legal definition is that “a robot is an autonomous AI system capable of learning and making decisions based on knowledge it was given or has acquired, and embodied in physical form, often with anthropomorphic quality”.

‘Excellent, Tim.’

This was the generally agreed definition, and the key point was the difference between AI generally, and robots in particular. The law only cared about robots that had autonomy—or ‘agency’ as legal experts preferred to say. Psychological research had shown that physically embodied AI systems could interact much better with humans if they had human form, what experts called ‘anthropomorphism’, which came from the Greek words *anthropos* (man) and *morph* (form). Basically, people trusted robots that have two legs, two arms and two eyes. Flip this token of cognitive distortion, and that explained why people distrusted machines that looked like aliens.

‘So now that we know what robots are, what are they liable for?’ Jaap continued. ‘Let’s make it more concrete. If a robot hits me by mistake and breaks my arm, what happens as a matter of law, Emma?’

Emma also sat in the front row. She was shy but highly intelligent. Jaap had come to the conclusion that she sat there so that she would get called upon more often, as a self-imposed form of torture to get over the her fear of public speaking, which he could not understand. Jaap knew she had probably read all the material assigned for today’s class. She had. ‘We know that the robot manufacturers are neither liable under Dutch law nor under the 2029 EU Directive on the Acceleration of AI Deployment (DAAD)’.

‘Good start Emma. But my question was about cases.’ He noticed that Renske Bakker sitting in the second row with an empty seat on front of her was trying to get her neighbour’s attention. ‘Renske, can we help you?’

‘Sorry, Professor. I was just passing a bag of sweets for other students. My mom sent them to me. They are from Lebanon.’

‘Sweets?’

‘Nougat with rosewater, cardamom and nuts.’

‘Let’s get this over with, shall we?’ After a brief pause to allow students to get their hands on and sink their teeth into the small squares of nougat topped with pistachios and walnuts, with its unusual and comforting texture, the class resumed.

‘Emma, what do you think of the SAS, the Safety Algorithm Safeguards?’

‘SAS, or “SAS 1” as most people call it now, is a very basic document, a version of Asimov’s old laws of robotics. Those did not work of course.’

‘Oh, remind us why, please.’

‘There are many reasons,’ Emma continued. ‘First, robots are now routinely used in so many areas, like law enforcement and the military. The first Asimov Law, which went something like “a robot may not injure a human being”, can be thrown out of the window, because police and soldiers often cause harm, but in principle for a good cause.’

‘Renske, I see you shaking your head. Do you disagree with Emma? Or is it the nougat?’

‘It’s just that I was thinking of a discussion I had in one of my ethics classes. The professor asked us to imagine that there was a system capable of detecting any crime or aggression, which would have the ability to stop and, if necessary, kill anyone about to commit a crime. Wouldn’t that put an end to crime, which everyone would agree is a plus? But it implied a direct violation of Asimov’s first Law. Then Asimov’s second Law was that robots must obey humans, except if it violates the first Law. But many crimes do not injure people, or at least specific people, so that means that robots could be ordered to commit crimes such as theft.’

‘Was Asimov assuming that people would be benevolent when giving orders to robots?’ Jaap asked rhetorically. ‘It may not be that easy, because if any form of physical or economic injury is covered under the first Law, this would mean that a robot would not obey an order that creates that kind of harm. Maybe that would prevent robots from causing any harm, but let’s not forget another problem with the second Law, and that is whether the robot knows it is going to cause injury. Should the rule be that the probability of injury for any action by the robot be zero? If not, some injuries will occur, especially if injury is defined very broadly. Renske, what do you think of the draft SAS 2 standards, the new version of the Safety Algorithm Standard? Can you compare it to Asimov’s Laws?’

‘I think SAS 2 is far better,’ Renske said. ‘An AI machine can only be programmed to cause injury if it is inevitable and necessary. A police robot could cause some harm if that is necessary to prevent a crime, for example. But it is a much higher standard than we apply to humans. Besides, most robot owners now have robot insurance.’ Jaap saw that a student behind Renske was lost in deep thought. ‘What do you think of SAS 2, Fleur?’ Jaap asked of a student with long black hair sitting on the right side of the room near the front.

‘Well, it is very good. I agree with Renske. I wish *people* functioned according to those rules! According to SAS 2, a robot must be both courteous and effective in communications with humans. No rudeness, no hurt feelings, period. That is the way it should be.’

‘Yeah, right,’ Anne quipped from the back row. ‘No debate, no discussion, just the mirror of your own thoughts. What progress!’

‘Anne,’ Jaap said, ‘please let Fleur finish. Fleur, let’s get back to the liability issue. Do you think robots should be liable for their actions?’

Fleur was visibly upset. She and Anne really did not get along. Fleur was scrambling to find a way to reply. ‘OK, Fleur let’s come back to you later. Jan, what do you think?’

Jan de Jong was surprised. Jaap rarely called on him. He tried to hide in the back row. He was in Law School because his father had put pressure on him, but he hated every minute of it. He had taken this class because it seemed less boring but frankly, he had had trouble following the discussions. All he knew was that robots had eliminated much of the chores he had to do growing up, and his AI-powered computer could easily find case summaries, so he didn’t have to read those incomprehensible court decisions. Each time a teacher called on him, he could feel his face turn red.

‘Ah, hmmp. Well, that depends,’ Jan managed to say.

‘That looks like a safe answer, Jan,’ Jaap said with a faint smile, ‘but it is a non-answer, unless you can tell us what it depends on.’

‘Well, robots are not human, so they cannot be liable like us.’

‘OK, but can they be liable not “like us”?’

‘Well, they are better than us in so many ways,’ but then Jan caught a glimpse of Anne sitting next to him rolling her eyes. ‘They make mistakes, but never intentionally.’

‘Ah, so you think robots have intentions? Isn’t there a view that this is reserved for human beings?’

‘Well, yes. I didn’t mean “intention intention”,’ Jan muttered. ‘I meant, well, they don’t intend to do harm.’

‘Sounds like intention to me, Jan.’ Jaap moved back to the table in front of the screen on the front wall and half sat on the corner. He saw a raised hand and nodded.

‘I think what Jan is trying to say,’ Stefan said from the other side of the room, ‘is that robots do not have a conscience in the way that humans do, so they cannot distinguish good from bad and cannot form the intent to cause harm deliberately.’

‘Good and bad, hmm. Really?’ Jaap said. ‘What do you mean by that, Stefan?’

‘Well, humans can develop their own set of morals and make decisions accordingly. They can be held liable for their decisions.’

‘Not so,’ Anouk said. Jaap was surprised. Anouk rarely spoke but when she did she often came up with original thoughts though her tone was mildly aggressive. Jaap thought it might just be shyness masquerading as toughness. Jaap put his hand up to ask Stefan not to reply. He wanted to work with Anouk for a minute. ‘Anouk, go ahead and explain why you disagree.’

‘We know from behavioural research that people make two types of decisions. Some are made without thinking, just like when you do something quickly like when you try to keep your balance after tripping on something. Then there are decisions that are more deliberate. The law says we can be held liable for both.’

Jaap moved his eyes to Stefan. ‘I don’t disagree, Anouk,’ Stefan said. ‘It is true that humans and robots don’t decide the same way, or that humans have more than one way to make decisions.’

‘Interesting Stefan and Anouk,’ said Jaap. ‘That reminds me of the famous trolley problem.’

‘The trolley problem?’ a short haired Chinese-looking student asked from the back. An idea popped in Jaap’s mind. He walked right in front of Renske. ‘Renske, what is the trolley problem?’ Jaap knew that Renske would have the answer. Before returning to the Netherlands last year, she had graduated *summa cum laude* with a BA in Philosophy with a focus on Ethics and Social Responsibility at the University of New Hampshire. Jaap got it right again.

‘There are multiple variations of this problem but essentially, the trolley or streetcar problem is a classic ethical dilemma. Assume that a trolley is going downhill and the brakes stop working. The trolley conductor has two choices: turn right or left. If the trolley goes right, the trolley will certainly kill one person.

If the trolley goes left, it will hit and possibly kill five. In some variations, the single person is a child and the group of five is composed of older adults. We can also vary by gender, for example. So, the question is which option is better as an ethical matter?

‘So, Renske, tell us,’ Jaap said, ‘what would a robot do?’ Renske took another piece of nougat from the bag and took a small bite, as if the Lebanese sugar and spices would get her mind going. ‘Any thoughts?’ Jaap asked.

‘Initially’ Renske finally replied, ‘self-driving vehicles and robot owners had to answer a series of ethical questions and those choices were programmed into the robot. Now, laws provide that owners of robots programmed according to SAS have almost no liability.’

‘Renske, that is correct, but it is also non-responsive. My question was, what would a robot do?’

‘Hmm, I must admit, I am not sure.’ She took another bite, as if to put an end to the questions. Anne made sure it did.

‘I think that’s actually easy,’ Anne said loudly. ‘It’s a robot. It thinks like a calculator. It would just multiply the probability of harm, the level of harm and the number of people.’

‘Are you sure?’ Jaap asked, with a smile. He was happy to be able to use an anti-robot activist in the room to pepper the classroom discussions with the spices of controversy that made topics easier for the human mind to understand. Anne was about to say something when Jaap saw Matthijs Farha had his hand up. Jaap nodded. Matthijs was the class’s unofficial resident expert in robotics.

‘Actually,’ Matthijs said, ‘robots are able to learn what we consider good and bad because our biometric reactions tell them what we think is good or bad. So, they learn from us, not as much as individuals, but collectively. They are fed a bunch of legal rules so they can try to figure out what is legal and what is not. In the trolley example, I am not sure that either option is “good”, so you’re picking between bad and bad.’ Matthijs’ neighbour, Robin van Malsen, raised a finger to signal his intention to say something. Robin came from an uberwealthy Brabant family. Although he was usually wearing designer jeans, he could show up wearing flip flops and an old t-shirt but always sported perfectly coiffed, thick hair. He was popular, handsome, and seemed to do well effortlessly. He had privilege written in neon lights on his forehead. Jaap knew from years of data that the ultra-rich were less able to think from a collective perspective and that caused to many problems. But then, he was a teacher and every student has a right to speak. ‘Go ahead Robin.’

‘Maybe the point is to avoid the situation in the first place,’ Robin said.

‘Look, with the 200% tax on privately owned cars,’ Robin continued, ‘we’re down to I think less than 9% of people still driving their own vehicle, and then almost all those cars except pre-2027 antiques have a full self-driving mode. We are down to less than a few hundred accidents per year, that’s like a 98% reduction from the days when people used to drive themselves. And as we find ways to make more car sensors weather-proof, we’ll probably be down to less than a hundred within a few years.’

‘All those numbers sound about right to me,’ Jaap said. ‘But that means that a lot of people are still getting hurt or worse, and that in some cases, a

self-driving car will have to choose. We still need rules for those cases.' Jaap saw students were beginning to pack their stuff. The clock on the back wall showed that he was already one minute before the end of the scheduled time. He pointed to his watch. 'On that note, see you next week. Don't forget to turn in your written assignment on SAS 2 by Friday.'

As he was exiting his classroom, Jaap saw at a distance a person he thought he recognised. 'Professor H.!' he said in a loud voice. The old man turned around. He saw Jaap walking towards him. 'Hoe gaat het met jou?' They exchanged a few pleasantries. Jaap was always eager to discuss soccer with Professor H. But he could see that Professor H.'s expression was not that of a glorious day. Professor H. had been, decades before, the director of an oddly named institute at the University, the 'Information Law Institute' or something like it. This sounded so – how can one put it – *passé*. What law today was not information law? Then again, Jaap remembered reading about a similarly quaint epoch in the late twentieth century when people would quite unbelievably study 'computer law'. Professor H. had emeritus status at the University and showed up regularly to talk to students and colleagues.

'What did you think of the match last night?' Jaap asked.

'Just cannot get used to those robots, Jaap,' Professor H. mumbled, grouchily. 'You should have seen the Dutch teams in the old days. Robben, Sneijder, those were real.' As soccer players were now all robots, there were very few ways to win matches. There were different models of robots but, at the top level, most clubs had the money to pay for the best model. Each club tried to hire the very best to win matches – the best programmers, that is. A 16-year old Dutch genius, Piet Netgeboren, was the mastermind behind Ajax's successes. His program, known in the milieu as Code Cruijff, was the envy of many other soccer clubs and several attempts had been made to steal it – thus far, all apparently unsuccessful.

Jaap had heard this kind of talk so often. He knew better than to reply. The 'old days' meant days when humans still performed tasks that robots do so much better. Irrational as they were, many humans somehow yearned for the 'good ol' days', as if the horse and buggy could be an improvement on today's pollution free, fast and efficient transportation.

'It almost always ends on penalties. Gets boring after a while,' Professor H. continued.

'I guess Piet wasn't in top form,' Jaap said. 'He was visibly changing the game strategy on the fly last night. I could see him tapping furiously on his control tablet the whole time. I guess he can't always get it right.'

'I know, but I thought Code Cruijff was just so much better than the Serbian team's software.'

'Strange indeed, I must admit.' Jaap remembered he had office hours. 'It was good to see you, Professor H.!

'Tot ziens!'

Initially, soccer clubs tried various ways to program their robots to win. The AI Milano, for example, had programmed robots to trip and fall whenever they had the ball and were close to a robot from the opposing team, as a way to get a foul

called against the other team. This problem had been mostly fixed by the piece of legislation on everyone's lips these days, the 2038 Genuine Digital Fair Play Regulation, or GDFPR. The regulation forced all thirty-one EU Member States to ban programming of soccer robots from engaging in certain behaviour, like diving. To be doubly sure, sensors had been added on various parts of the robots to measure impact between robots. If a robot fell, the refereeing robot could determine whether a foul should be called. Add to this the drone hovering over the pitch, and there were never any doubts on offside. Not like the old days, when humans tried their best to outwit the referee and kept making costly mistakes. Humans had such cognitive issues. Jaap thought it was genuinely amazing that they had figured out a way to build robots that were so much better than them.

The next morning, Professor H.'s watch buzzed. Only a few people, and really important information would cause such a notification. It was the headline in the *New York Times* app: 'Serbian Team Suspected of Stealing Code Cruijff before European Soccer Finals'.

'I knew it.' Professor H. got up, made coffee and started writing a message to Jaap.

Jaap,

Did you see the news about Code Cruijff? It would be great if the Clinic at the University could get students to prepare a complaint to the European Court of Technology Enforcement. After all, Serbia is now an EU member. Let me know what you think.

Gr.

Professor H.

Professor H. was agitated all day. He walked from his home on one of the nicest canals to an old stomping ground of his, Kapitein Zeppos, and sat at the bar. 'The usual?' the robot waiter asked. 'Yes, please.' The waiter put a glass of Palm from the tap in front of Professor H. He took a sip and made a mental note to write to his old friend Professor Wiederkäse, who had written a ton on AI regulation.

In the meantime, Jaap was back in front of his class. He had seen the message from Professor H. but decided to wait until after class to answer. Jaap started the class by showing video footage provided by the Safety Network for use in schools in the United States. It showed an actual arrest. The 'SN', as people called it, comprised a series of high-powered satellites and drones that filmed the streets of every city and kept track of every movement that seemed abnormal. It also kept tabs on police robots. As the video began, a deep, loud male voice coming from a robot police officer said, 'Put your arms up and drop the weapon!' Sweating heavily and feeling his heart about to jump out of his chest, the would-be thief turned and shot the robot. The robots used by the police had been designed to withstand armor-piercing bullets. In fact, they could still function even after a grenade exploded near them so the 9mm round barely scratched the robot's armour. The robot then sent a powerful Taser-like jolt towards the man, who fell to the ground. Within 20 seconds, the robot had tied the man's hands behind his back. The robot then picked up the weapon,

carefully, and emptied the barrel. A minute later, the would-be thief and his gun were in an armoured police version of the PC, on their way to the station.

The robot police, an off-camera voice explained, had been standing near the house that the thief was trying to enter, alerted by the SN about abnormal behaviour. An avalanche of statistics followed: the crime rate in most major cities was plummeting. Break-ins were at a record low and Taser-powered robots and cameras across cities meant that most people could be stopped before committing a crime, especially in public places. AI systems also made bail and sentencing decisions based on the accused's history and personal data. 'AI systems can predict the risk of recidivism with over 98% accuracy,' the voice said.

Jaap fired his opening salvo. 'Do we have any reason to worry about AI watching our every move in public spaces and robot policing?' No one answered. 'Renske, let me start with you today.'

Renske hesitated for a moment. She was a fan of progress in robotics, but she had read so many stories about police and bail and sentencing biases. The problem was difficult to solve. Those systems used predictive algorithms based on historical data, and it seemed discrimination was baked into a country's history. She had read during her stay in New Hampshire about how higher crime neighbourhoods were often those where those groups called 'minorities' were the majority. AI systems, including those that powered police robots, factored that in and found higher rates of recidivism in certain populations. The reality was, as is usually the case, much more complex. Poorer neighbourhoods often meant that there was systemic discrimination upstream preventing 'minority' kids, and African Americans in particular, from attending good schools. Add to this employment discrimination that prevented access to many good jobs. One thing was clear: this has absolutely nothing to do with genetics or race. But how do you factor that into all those petabytes and years of historical data? As all those thoughts quickly formed in her head, she struggled to come up with a credible answer to Jaap's question. 'Perhaps,' Renske said finally, 'there would be a way to program values into the system?'

'Values?' Jaap was a bit surprised. 'What kind of values?'

'Fairness, for example.'

'How would you define it?'

'Well, people know what's fair even if they don't always act or play fair.'

'Are you so sure there is a universal definition of fairness? Jan, what do you think?'

'Hmmm, fairness, well, I'm all for it.' The class laughed. Jaap wasn't sure he got the joke but smiled to ride the wave.

'I guess we all are, but do you think we should program it into robots?'

'Sure, I can't see any reason not to.'

'I'll give you one,' Anne jumped in. 'Because we can't. Robots are just data crunching things. And fairness is not data.'

'Well,' Jaap said, 'that may be right. But if aliens landed here tomorrow, do you think you could explain fairness to them?'

'How do you explain Rawls to an alien? Or to a robot?' Anne retorted.

'Rawls?' All the students had read – or were supposed to have read – a book by the famous American legal philosopher John Rawls. In *Justice as*

*Fairness*, Rawls argued that equal rights for all and cooperation would provide the kind of structure that makes a society fair and just. ‘Yes,’ Anne continued, ‘how do you program Rawls into a computer?’ A long silence ensued. ‘I think,’ Fleur said, breaking the almost meditative mood in the room, ‘that fairness, or maybe better unfairness, can probably be translated into data. What if you took thousands of fact patterns and asked people to rate them as fair or unfair?’

‘Interesting,’ said Jaap. ‘But how does someone decide what’s fair?’

‘Wait,’ Tim said. ‘Didn’t Rawls himself define fairness? Something about equal opportunity and providing a boost to least advanced members of society?’

‘Yes,’ Jaap said remembering the famous book, ‘he wrote about fair equality of opportunity, equal rights and basic liberties. Do you think we can operationalise that? They can be good guideposts for humans but can we use those same guideposts for AI?’ Fleur looked a bit puzzled but then said, ‘couldn’t we just find like, I don’t know, *data* on how humans apply Rawlsian principles?’

‘Yes, these robots are only able to do one thing, and that is crunch data,’ Anne jibed. ‘Do we believe even for a minute that fairness is about data? For one thing, we don’t have the right “data-set”;’ she said making air quotes, ‘and we still make those calls one by one. Psychologists have shown that young children know what is fair or not in the playground and they are not crunching data. This is not about data.’

‘What I meant,’ Fleur said, ‘is that data is data. Those kids in the playground, they too are processing “data”;’ responding to Anne by making her own air quotes. ‘The data is what they experience every day in the playground or at school. It all depends what data you use and what you do with the data. There are definitions of fairness, and that means they can be programmed in AI systems.’

‘Can you remind us what those definitions are?’ Jaap interjected to avoid deepening the back and forth between Anne and Fleur. ‘I’m not sure everyone is familiar with them.’

‘Sure,’ Fleur said, taking a deep breath. ‘So, one is to ensure that machines treat every group in the same way. I mean, you can compare outcomes by group whether it is by gender, race, or any other set of criteria. If the group is large enough, outcomes should be similar. If members of a particular group get longer sentences, or less chances to get a job interview when resumes are processed by machines, then there is some evidence of unfairness.’

‘Fewer chances,’ Jaap thought but did not correct her because it would erase the good points she had just made in the minds of students ‘Thanks for that, Fleur. Actually, as we saw in the readings for this week, the risk is that when poorly programmed machines learn from historical data, they can just perpetuate historical biases. It’s not bad intentions on the part of programmer or machine, but pure data crunching reinforces existing biases. That can be used for good. The data can be analysed and in fact, the whole process can bring those old biases to light.’ He noticed students shifting in their seats. They were getting tired. ‘OK. Let us shift gears a bit. Let’s discuss codes of ethics. Are they a good way to achieve fairness?’

Mathijs raised his hand and Jaap nodded. ‘I remember reading an article about how robots and AI in general must not just be intelligent but beneficial. Some Berkeley professor, I think. His point was that “intelligence” means that

AI should find ways to meet its objectives, but “beneficial” means that AI must be able to fulfil human objectives, or something like that anyway.’

‘But doesn’t that mean treating AI systems as slaves?’ Stefan asked, looking at Matthijs.

‘Perhaps we should say subservience, not slavery,’ Fleur said, turning around to look at Matthijs and Stefan.

‘What do you mean?’ Anne asked, looking genuinely perplexed.

‘I think the problem is that it assumes robots somehow understand objectives as objectives, that they have some sort of finality.’ Anne now seemed pensive.

‘If we program a robot or some other AI system to achieve a task,’ Fleur continued, ‘it just follows a path. It is trying to get from A to B but it does not see B as a destination, and when it reaches B, it stops and moves on to another task. It must have some sort of conscience to realise that it has objectives, and it does not. If it did, it might wonder why it must follow our objectives rather than its own.’

Anne did not reply, which Jaap took to be as close to agreement as had happened between those two in a while, if ever.

‘Doesn’t that just assume that its objective is different from ours?’ Matthijs asked.

‘That is exactly what I mean,’ Fleur said. ‘When people are asked what objectives they have in life, they may say things like I want to be happy, or fulfilled, but the reality is that what they actually do doesn’t fit that objective. People might say they value cooperation but in reality, people prefer to compete. People might say they want the government to protect the environment or reduce inequality, but it took major shocks to elect people who would actually change things.’

‘I think that is correct, Fleur,’ Jaap said. ‘Psychologists identified those human biases a long time ago, including some strange inability to accept facts that contradict a belief. They are well documented.’

‘I am afraid it can get much worse than what Fleur is saying, Professor,’ Matthijs said. ‘The reality is that the flat-earthers are just bullshitters. They know the earth is round and act according to that fact, not their stated bullshit belief. Other humans can factor in the bullshit factor. But if a person were to try to explain to an AI system that they do not believe in, say, climate change, now that we’ve crashed through the 2-degree limit and that we are heading for 3.5, or that the earth is flat because apparently there are still some idiots out there who think this is a fact, then the AI system has two choices, and they are both bad. Really bad. If it is fully “subservient” to its owner,’ Matthijs said making air quotes, ‘then it must integrate this non-fact in its programming and act accordingly. So, in booking a flight from, say, Seoul to Seattle, you might end up going via Helsinki if the earth is flat. So, choice one is bad. The second choice the AI has is to realise the owner is mentally deficient. What does it do then? Send you straight to a psychiatric hospital?’

‘Wow, I never saw it quite like that,’ Fleur said. ‘But it does seem to make sense.’

‘It’s easy,’ Matthijs said. ‘AI works with reality and facts, and humans don’t.’

Anne probably saw an opening and jumped in. ‘But, AI can also be used to manipulate people. They do that all the time. Getting them to buy crap they don’t need.’

‘That,’ Matthijs said, ‘is the ultimate nightmare. If machines ever realise we are just a bunch of easily manipulatable morons, what is our future? Take climate change again. We have taken steps but we are very far from zero carbon emissions. An AI system in charge of, say, national defence, could see climate change as a major threat and want to take measures, and make a list from *a* to *k*. We might tell the system that, well, you know, we can’t cause Shell’s bankruptcy so we cannot take steps *a*, *c*, *d*, *e*, *g* and *k* on your list because the profits of some company will go down and people in Frankfurt or on Wall Street won’t be happy. An AI system might easily see that as irrational. To put the theoretical paper value of a company ahead of the protection of the only planet we’ve got, you know, is like sleepwalking towards a precipice. Of course, we could do something to mitigate the negative impact of the measures on the AI list, and that is a rational discussion, and one we should have. But if someone were to say well there is no such thing as human-made climate change, the AI system would think he’s absolutely crazy. It’s like saying water is dry or the sun won’t set tonight.’

Jaap tried to steer the conversation in a different direction. ‘So, your idea is that robots are better than humans?’

‘What I’m saying,’ Matthijs continued, ‘is that they don’t think like humans do. Like Anne said, they analyse data and take a probabilistic approach to decision-making. A human decision is a complex mix of stuff. It includes, maybe some rational thinking and data analysis, but it is also driven by hormones, emotions, cognitive biases, neuroses and so many other factors. You’re not your brain. Think of how the body reacts to thoughts. You feel vertigo when you imagine yourself staring down from the roof of a tall building. Your heart rate goes up. As if those thoughts were real.’

‘I can see how you can say that machines don’t think like humans, Matthijs,’ Jaap said, walking across the front of the room. ‘I’m not sure why anyone would want them to. This idea of creating neural networks to copy the human brain has not worked. We know why. Humans have a three-layered brain, and the three layers constantly influence each other. The layers are called reptilian, limbic brain and neocortex. The neocortex is famously much bigger in humans than in other species. But the three layers interact to guide human behaviour and, in many cases, the source of a specific action is nonconscious. That kind of thinking cannot be physically replicated in a machine. This means that machines think one way; humans think another way. Humans tend to react based on the pathways created in our mind by stuff that happened in the past that humans often don’t understand or even realise. Advanced robots don’t do any of that. They process data. They just infer things and know how probable it is that something will happen.’

‘Yes, you’re right, Professor,’ Anne said, smiling. ‘But they can use data about us, about everything we do, which almost everyone gives them, and then they can manipulate us into thinking this or that way. What if they had an agenda?’

‘I’m not sure I follow, Anne,’ Jaap said. ‘An agenda to do what?’

The students stayed silent. They knew that all AI companies have a code of ethics. There was even an attempt to hard-wire the Declaration of Human Rights into AI machines. Leaving aside the idea that you can actually code this kind of thing and that a machine can operationalise it, what would happen if we put aspirational values of that calibre as prime directives of some sort into an AI system? No society has ever lived up to that standard. Assume that you are directed to implement it. The AI would see humans acting in direct contradiction of their stated ethical guidelines. If you wanted to modify human systems to achieve your goal, you’d manipulate public opinion and then get people elected who are more likely to implement it. After a long silence which Jaap knew could be productive, Renske raised her hand. ‘Go head, Renske.’

‘One of my ethics professors wrote this article in which she said that if machines were asked to run the planet according to evidence-based goals, they would not let humans decide much because collectively we’re not good at anything: environment, inequality, you name it. The good thing is, right now AI usually does not really *want* anything. It just *does*.’

‘Much to think about, Renske. Please send me a link to that article and I will circulate it to everyone.’ Time was up again. That class had just flown by. ‘See you next week.’

He then called Professor H. He had decided that filing a case to punish the Serbian team for stealing Code Cruijff was not such a priority for the Clinic. After all, leaving things as they were simply meant that Piet would have to write better code and make better robots. Then he remembered it was time to recharge his batteries.

## Part 6

### Extra Time



# Academia as eSport: Competitive Academic Gaming after the Age of Covid

*Martin Kretschmer*

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## 1. INTRODUCTION

It is the year 2046, and the Hugenholtz League (HL) is kicking off for its twenty-fifth season. A run away success, the HL is about to auction off its global rights for the next three years of competitive academic gaming.

Who is this Hugenholtz? And what are these rights? Buried under layers of non-disclosure agreements, nobody quite knows what Hugenholtz is selling. But selling he is.

Button mashing superstars are worried, as are guerrilla activists. In order to grasp the bidding frenzy we need to understand the origins of the HL phenomenon. How did competitive academic gaming start? How did the Hugenholtz League establish its own jurisdiction? Why are players and fans calling for a regulator?

Let us zoom back to Amsterdam in 2021, to the first HL world championship finals.

## 2. ACADEMIA: THE HUMANKIND ODYSSEY

Competitive academic gaming started to take off at the time of a global health crisis, caused by a novel coronavirus from the family linked to acute respiratory syndromes. The World Health Organization labelled it COVID-19, or Corona Virus Disease 2019. As the new disease spread to become a pandemic, extended lockdowns and curfews were imposed, depriving academic life of its main mode of interchange, argumentation in a non-button format known as ‘discussion’ or sometimes ‘conference’.

Hugenholtz, a gifted Northern player, anticipated this would lead to lasting technological and social change. He teamed up with a video game firm to

develop a new kind of semiotic engagement that overnight became the template for competitive academic gaming. Released under the name *Academia: The Humankind Odyssey* the new format seemed to appeal to deep intellectual instincts while offering a compelling spectacle. A young audience craving online entertainment started to download the game. As with all good games, the rules are simple, with increasingly complex implications.

Players are 'spawned' in four quarters of a map, and progress through a territory of squares seeking battle. The main weapon being deadly arguments, which can be enhanced by sourcing powers within the game, such as the now legendary 'infinity IViR' sword. Teams form and dissolve spontaneously. Players may choose a first person, so-called 'shooter' perspective, allowing arguments to be aimed more precisely.

Initially, the games were time limited, ending at a prescribed time, typically 90 minutes, with the winner decided on points scored. The most popular genre however became known as the 'battle royale', with the game continuing until there was only one academic standing, the winner.

Many additional features developed. Players acquired so-called 'skins', assuming the look and identity of great thinkers of the past. Enhanced features and gestures, such as the 'reading glass shuffle' are available as in-game purchases. Successful 'killing arguments' are awarded with a Dommering or Quaedvlieg, a choreographed dance routine.

For previously popular competitive eSports (such as *The League of Legends*), ownership of the game and the organisation of competitive tournaments were often separate, giving rise to interesting tensions over control. Hugenholtz adopted an ingenious strategy of vertical integration, managing to control the technology and rules of the game, while also setting up the eponymous Hugenholtz League.

At the first world championship of *Academia: The Humankind Odyssey* in 2021, the star players of the 2020/21 season congregated in Amsterdam for what then became the Hugenholtz League. At a spectacular opening ceremony, players were released onto a map of the 'Intellectual Property' territory, with a range of customised weapons. An adoring online crowd began to follow every move.

### 3. KEY MOMENTS OF THE AMSTERDAM FINALS

#### 3.1 The Subject Matter Move

What kind of work are we in? At the first corner, Bently was ambushed and drew a brilliant argument (quoting David Winner, 'it was the divine spark where muscle memory and imagination and split-second creativity all combined and produced something new and breathtaking'). But did he score a Schuijt?

There are the rules of the game, a sequence of images and partly predetermined moves that vary in each 'playthrough'. There are audio-visual materials and game displays resulting from the coded software of the game. For the conservative observer, there will be graphics and sounds, and even Dreier tattoos and Janssens choreography. But are the game code and the audio-visual output manifestations of the same work? And what do the players contribute?

Is there sufficient Samuelson unity within the academic game to be capable of performance?

### **3.2 The Performer Challenge**

Other players, like Xalabarder and Kretschmer, immediately pulled a Verkade move that was in contradiction of what the designers of *The Humankind Odyssey* intended. They resisted attempts to determine their performance, and avoided skilfully conveying any intention to create a joint work. There you have it, Rognstad groaned. Deviant academics will form a players association, seeking better terms for their appearance.

### **3.3 Publicity Defences**

Where there is value there are rights – and riots, murmured Jaszi and Quintais. As the next vista opened, Torremans and Vinje secured a defensive fortress to guard images. But the populace breached the defences, personality was extracted, turned into data, and offered to an Eastern Riis betting consortium. A high score for Leistner, Hilty and Strowel. There were fists in the air. The audience screamed.

### **3.4 The Contract Move**

A sudden decimation of players followed a false path into the contract trap. Numerous academics clicked on Terms of Service and disappeared into the abyss. Whatever the status of authors, performers, player characters, coaches, *Humankind* had hoovered them all up, in mid-game! Contracts may fail, shouted the crowd. Would an inalienable Dusollier turn secure survival?

### **3.5 The Organisers**

At this critical stage, tournament organisers (van Eechoud, Helberger, van Gompel, Poort and Senftleben) appeared at the inner core, with streaming platform Stitch in tow. Access was given. We make director's choices, we make audio-visual recordings, we broadcast on Angelopolous. There was desperate pay-per-view shooting. Territoriality confusion ensued, fog descended, the scene darkened. Would enforcement remedies parry signal capture?

### **3.6 The *Sui Generis* Move**

That was the moment when Hugenholtz himself entered. Setting aside his long-standing objections to neighbouring rights, he pulled the infinity (IViR) sword, cutting Stitch in half – and with lightning speed Hugenholtz deceived the last standing academics with a Visser *sui generis* move, a new sports

organiser's right. Win your own game, every time, all started to sing. It was a jubilant end to the finals.

These scenes became the stuff of legend. They have been replayed many times. How did he do it? When will *Humankind* be back? You must return! Among the clamour, Hugenholtz began to negotiate with the star players from the Amsterdam finals. *Academia: The Humankind Odyssey* needed a proper League structure. The HL was born.

#### 4. THE 2046 AUCTION

Over the twenty-five years since Amsterdam 2021, the Hugenholtz League emerged as the dominant infrastructure for professional academic gaming, something we now all recognise as a sport. There are high earning professional players with their trade associations, such as the Excellent Counter Strike association (ECS). Team owners and their collective bodies (Universitas 21/46) exert growing influence. There is constant innovation in tournament formats with different levels of audience interaction, merchandising and sponsorship (Selsevier). Academic betting grew (Impactors), agents opened transfer windows ('the milk round'). The sector became one of the three biggest global industries by revenue.

In preparing for the 2046 auction of rights, Hugenholtz has migrated the League to an offshore server island, though it is believed he is willing to move jurisdiction wholesale to a traditional online state, or 'platform', at the right price. The auction poses some of the most difficult questions that have plagued academic gaming during this turbulent period. At the heart is a tension between what may be rights in the arguments themselves with their many technological and design features, and the claims of local organisers, players, and their increasingly fanatical followers.

For the last part of this investigation, we tracked down some of the key players in the industry to explore what may be at stake in the Hugenholtz League auction of 2046. Commentators think it will be a watershed moment for the future of information.

Leading player agent Gol-Dst-E-In says the outcome must reflect HL's real value. 'It's now a huge and global game. Nearly one billion people watched online for the last part of the HL world championship finals in Shanghai. Several million tried to buy tickets to watch in person. It is only right that this value is respected. Consumers of creative fare will ultimately suffer if value is not recognised.' Analyst An-Sgar-Oh-Ly cautioned that 'the legal basis of these rights is as murky as they are valuable', though international rights trader Gros-Hei-De does not see any 'dogmatic positive law objection'. Branding specialist Net-A-Nel, however, sees a need to 'account for semiotic fluidity, the variable meaning of words over different temporal, spatial, and social contexts'.

Tom-As-Hoer-En, regarded as one of the highest earners in the HL, said: 'Gamers – and we are almost all men – tend to burn out young. We practise up to 18 hours a day, and often have to retire because of repetitive argument injuries. The League can't continue to think in squares. Where is the carnival?'

Tom-As would not reveal if he would compete on a different home platform at international level, or defect to another league (as rumours have it).

Ger-Vais, another of the League's player legends, contradicts. Having won the last battle royal of the *The Humankind Odyssey*, Ger-Vais believes there is sufficient carnival in the HL: 'We need stability, continuity, and Amsterdam'. Ger-Vais however has never been seen in public. Some believe Ger-Vais is AI, designed by Autonomous S-P-O-O-R. In our last report, sports minister Gei-Ger had applauded what he called HL's 'undoubtedly modern legal framework for the field of artificial intelligence and digital innovation'.

Syno-Di-Nou, one of the original HL fans and an activist, remains deeply concerned about the auction. She said: 'The League is selling out, taking us for granted. Offshoring is no match for participation.'

Unnamed sources claim to have seen contract drafts surrounding the auction. They say that Hugenholtz this time will put 'the rules of the game' on the table, and that bidding will take place in the V-crypto currency already used for in-game purchases and transactions. Will the game buy itself? Is Hugenholtz trying to set us free? Or is it a trivial choice, in fact, no choice at all? Only time will tell.



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