

Exhibit A

of

Motion for Leave
to File Surreply

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10 UNITED STATES DISTRICT COURT
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION

13 ROBERT JACOBSEN,) No. C-06-1905-JSW
14)
Plaintiff,)
15 v.) **PLAINTIFF’S SURREPLY TO**
16) **DEFENDANT’S REPLY, IN THE**
MATTHEW KATZER, et al.,) **BRIEFING OF DEFENDANTS’ MOTION**
17) **TO DISMISS AND MOTION TO STRIKE**
Defendants.) **[DOCKET #192]**
18) Courtroom: 2, 17th Floor
19) Judge: Hon. Jeffrey S. White
Date: Fri., April 11, 2008
20) Time: 9:00 a.m.
21)
_____)

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Plaintiff files this Surreply to respond to Defendants’ Reply in the briefing of their Motion to Dismiss DMCA and Contract causes of action and Motion to Strike Relief [Docket #192].

25 **I. Introduction**

26 Defendants earlier filed a motion that incorporated by reference portions of its earlier motions relating to copyright infringement. After Plaintiff objected in his Opposition, Defendants included argument in their Reply that had not been properly present in their initial motion.
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1 Plaintiff responds to these arguments.

2 Plaintiff recently obtained materials from the World Intellectual Property Organization
3 from the Committee of Experts meeting on Rights Management Information. Plaintiff had put in a
4 request in early January 2008, but did not have the information available at the time he filed his
5 Opposition. He includes this newly available information here. He also includes information to
6 correct a misstatement by Defendants relating to the Photo Resource decision, and another
7 misstatement relating to Defendants' motion to strike relief.

8 **II. Argument**

9 **A. Defendants Fail to Show that Plaintiff's DMCA Cause of Action Does Not State**
10 **a Claim for Relief**

11 **1. Defendants' Arguments Relating to Copyright Infringement Are Inapposite Because**
12 **They Have Not Shown They Have a Contract or License**

13 Using faulty logic and unsupportable argument, Defendants urge this Court to dismiss the
14 DMCA claim because, so they say, no one can ever infringe Plaintiff's copyrights. As a
15 preliminary matter, Defendants address only the "giving JMRI credit" argument, and thus for the
16 purposes of this motion, concede infringement for their failure to stay within the restrictions on
17 copying, modifying, and distributing JMRI software, and concede infringement of JMRI software
18 copyrights licensed under GPL 2.0. Defendants insist they have a contract, but they haven't shown
19 acceptance of a contractual offer, therefore, they cannot rely upon an implied license arising from
20 contract. They attempt to argue that, by posting JMRI software on the web, Plaintiff grants a non-
21 exclusive license to copy, modify, or distribute, without regard for the restrictions in the Artistic
22 License or GPL 2.0—a broad interpretation that would wreak havoc on copyright holders. Finally,
23 Defendants insist that Plaintiff has transferred all his rights, and retains none, either through an
24 exclusive license, apparently to the public, or through dedication to the public. This theory suffers
25 a fatal flaw—exclusive licenses or other transfers of ownership require by statute a written
26 document signed by the copyright holder, and Defendants have produced no such document.
27 Because they offer no other theory explaining how they obtained a license, Defendants are
28 infringers and their conduct encourages others to infringe Plaintiff's copyrights.

1 As a preliminary matter, Defendants apparently concede copyright infringement because
 2 (1) they offer no arguments relating to their failure to stay within the restrictions on copying,
 3 modifying, and distributing the Decoder Definition files, or (2) they offer no argument to show that
 4 Plaintiff cannot state a claim for copyright infringement of JMRI software copyrights licensed
 5 under GPL 2.0. See Sun Microsystems, Inc. v. Microsoft Corp., 188 F.3d 1115, 1121 (9th Cir.
 6 1999) (failure to stay within the scope of a license is copyright infringement). Defendants argue
 7 that the only way to violate the Artistic License is to fail to “give credit” to JMRI. Not true. The
 8 Artistic License is a license which grants, but also restricts, the exclusive rights of reproduction,
 9 modification, and distribution of the code. *Opp. to Mot. to Dismiss & Mot. to Strike, Ex. A.*¹
 10 General Public License 2.0 (GPL 2.0) has similar restrictions, plus an automatic revocation of the
 11 license grant when a user violates any term of the license. *Id. Ex. B.* ¶¶ 0-6. Thus, with GPL 2.0,
 12 once a term is violated, any future reproduction, modification, or distribution is copyright
 13 infringement. *Id. Ex. B.* ¶ 4. By failing to make arguments relating to GPL 2.0, Defendants
 14 concede, at least for the purposes of this motion, that they infringe and encourage others to infringe
 15 Plaintiff’s copyrights for code released under the GPL 2.0 license.² Defendants’ actions, in
 16 exercising an exclusive right of copying, modifying, or distributing code, are outside the license
 17 grant of the Artistic License and GPL 2.0. See Second Amended Complaint [hereinafter SAC] ¶¶
 18 280-287. Thus, Plaintiff states a claim for copyright infringement. Defendants’ actions in
 19 removing a reference to license terms, and the license itself, encourage others to engage in
 20 copyright infringement. This, in conjunction with Plaintiff’s arguments in his Opposition, states a
 21 claim under DMCA. That should end the matter relating to Defendants’ motion to dismiss the
 22 DMCA cause of action, but they offer a panoply of flawed theories on how they have a license,

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 24 ¹ This Court is hearing another copyright case the same day (April 11, 2008) as it is hearing this
 25 motion. Like the Jacobsen case, Microsoft Corp. v. EEE Business, Inc. involves a restriction on an
 26 exclusive right—the exclusive right of distribution. If EEE Business distributed Microsoft
 27 software outside of the educational license restriction, then it faces liability for copyright
 28 infringement. The same principle is true here. If Defendants Katzer and KAMIND Associates, Inc.
 copied, modified, or distributed the Decoder Definition files outside the restrictions of the Artistic
 License or GPL 2.0, then Defendants Katzer and KAMIND Associates, Inc. are infringers, and
 removing copyright management information encourages others to infringe.

² Contrary to Defendants’ assertions, this Court did not rule on infringement of JMRI copyrights
 licensed under GPL 2.0, but only JMRI copyrights licensed under the Artistic License.

1 which Plaintiff addresses next.

2 Defendants implicitly argue that because the Artistic License exists, Defendants therefore
3 have a license. This is no more true than if Mr. Katzer walked into his local office supply store and
4 seized a copy of Adobe Acrobat Professional software from a shelf, claiming that because a license
5 exists for Adobe, he therefore has a license. Mr. Katzer would not have license until he installed
6 Adobe and clicked an acceptance of the terms and conditions. Likewise, Defendants must do more
7 than show the Artistic License and GPL 2.0 exist as documents. Defendants must demonstrate
8 how they have obtained a license. They fail to do so.

9 Defendants do not have a contract, a fatal flaw in their implied-license-through-contract
10 theory. A contract requires an offer, an acceptance, and consideration. Unlike all the cases they
11 cite, Defendants offer no proof they accepted a contractual offer. Cf. Sun Microsystems, Inc. v.
12 Microsoft Corp., 188 F.3d 1115 (9th Cir. 1999) (negotiated contract); Polar Bear Prods., Inc. v.
13 Timex Corp., 384 F.3d 700 (9th Cir. 2004) (negotiated contract); S.O.S., Inc. v. Payday, Inc., 886
14 F.2d 1081 (9th Cir. 1989) (negotiated contract). They offer no evidence of a click-through
15 agreement or a shrink-wrap agreement. ProCD, Inc. v. Zeidenberg, 86 F.3d 1447, 1450-53 (7th
16 Cir. 1996) (shrink-wrap license is a contract under Wisconsin law); see also Wall Data Inc. v. Los
17 Angeles Sheriff's Dept., 447 F.3d 769, 775 n.5 (9th Cir. 2006) (describing click-through
18 agreements). They offer no evidence of acceptance through performance, as would exist in a
19 unilateral contract. If there is no contract, there can be no breach of a contract, and state contract
20 law does not govern interpretation of the license. Cf. Sun Microsystems, 188 F.3d at 1122.
21 Defendants argue that the Court should adopt findings of fact in its earlier ruling, but the Court did
22 not make any finding of fact that Defendants had accepted a contractual offer. Thus, Defendants'
23 fatally flawed theory about having a license through a non-existent contract fails.

24 Defendants next argue that Plaintiff has granted the public a non-exclusive right to copy,
25 modify, and distribute without restriction. Setting aside that this treats all restrictions in the
26 Artistic License and GPL 2.0 as if they never existed, this interpretation of the Artistic License and
27 GPL 2.0 would wreak havoc on any person posting content on the Internet. For instance, the local
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1 and national newspapers post stories, photos, and other content, daily on their websites. Under
2 Defendants' reasoning, these newspapers have no rights in their stories, photos, or other content,
3 and anyone can copy, modify, and distribute any stories, photos, or other content, without fear of
4 facing a charge of copyright infringement. Another example: a business owner creates his own
5 custom-made website and posts it on the Internet. Under Defendants' theory, anyone can copy,
6 modify, and distribute the business owner's website without fear of facing a charge of copyright
7 infringement. In advocating a broad interpretation of the Artistic License, Defendants' arguments
8 again ignore the mandatory authority of the Ninth Circuit's S.O.S. decision, which requires a
9 narrow interpretation of the license, and put this Court at risk of adopting erroneous reasoning.³
10 Again, Defendants' argument fails.

11 Defendants make another fatally flawed argument—that Plaintiff has not retained any rights
12 in the copyright. Mirroring their appellate argument, Defendants argue that Plaintiff has not
13 retained any rights in the copyrighted work, and refer to two cases⁴ involving exclusive licenses.
14 Fatal to Defendants' argument is that both cases involve exclusive licenses, for which a written
15 transfer that is signed by the copyright owner is required by statute. 17 U.S.C. Sec. 204(a); Effects
16 Assoc., Inc. v. Cohen, 908 F.2d 555, 557 (9th Cir. 1990) (“The rule is really quite simple: If the
17 copyright holder agrees to transfer ownership to another party, that party must get the copyright
18 holder to sign a piece of paper saying so.”). Likewise, a dedication to the public is a transfer, and
19 also requires the transfer to be in writing and signed. Just as they cannot point to any signed
20 contract between themselves and Plaintiff, Defendants cannot point to any signed transfer
21 document, transferring all rights in JMRI software to Defendants or the public. So, Defendants are
22 wrong again. Defendants' flawed arguments relating to exclusive licenses and irrelevant case law
23 put this Court at risk of adopting their erroneous reasoning, and should be rejected.

24 In sum, Defendants do not show they have a license. Therefore, they are infringers, and
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26 ³ Under a proper reading of the S.O.S. decision, the copyright holder who posts content on the web
27 has at most granted an implied license to his website visitors to make on a visitor's hard drive a
verbatim, cached copy of a website or other content when the visitor has viewed the content.

28 ⁴ United States Naval Institute v. Charter Communications, Inc., 936 F.2d 692 (4th Cir. 1991);
Considine v. Penguin U.S.A., No. 91 Civ. 4405, 1992 WL 183762 (S.D.N.Y. July 20, 1992).

1 they have encouraged others to infringe.⁵

2 2. Plaintiff's Copyright Management Information is Within the Scope of DMCA

3 Plaintiff adds legislative history relating to the DMCA and rebuts Defendants' arguments
4 regarding precedent, Photo Resource, which Plaintiff cited in his Opposition, and IQ Group.
5 Plaintiff begins with a brief discussion relating to the legislative history, as described in the
6 Opposition, to place the new material in context.

7 As noted in Plaintiff's Opposition, the DMCA originated with an intellectual property
8 working group, headed by then-PTO Director Bruce Lehman, created as a part of the National
9 Information Infrastructure task force set up in 1993. After Congress introduced legislation to
10 implement the task force's recommendations and held a number of hearings, work to pass the
11 proposed statutes came to a halt while Director Lehman and others went to Geneva to negotiate the
12 World Intellectual Property Organization (WIPO) Copyright Treaty. WIPO held a Committee of
13 Experts meeting, during which member states submitted proposals for the new treaty. Upon treaty
14 ratification, Congress introduced new bills and held further hearings to put the treaty in effect.
15 That legislation led to the DMCA. Plaintiff discussed in detail the National Information
16 Infrastructure task force, congressional hearings, and WIPO treaty in his Opposition, but a specific
17 report from Committee of Experts meeting was unavailable. He recently obtained the information
18 from WIPO, the relevant portions of which are attached as Exhibit A.⁶

19 During treaty negotiations, the United States sought a broad interpretation for copyright
20 management information. At the meeting of the Committee of Experts on a Possible Protocol to
21 the Berne Convention, in Geneva from February 1 to 9, 1996, the United States advocated
22 language taken from the National Information Infrastructure task force's White Paper. Ex. A at 2-
23 3. The United States argued that copyright management information would serve as a license plate
24 for a work as it traveled the Internet. See Ex. A at 5, 11. As stated in its earlier White Paper, the
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26 ⁵ Plaintiff has discussed briefly in his Opposition how one may obtain a license when no contract
27 exists. Defendants claim they are confused by these arguments. See Reply at 7. Plaintiff will
28 elaborate further at the hearing if the Court seeks further explanation.

⁶ Exhibit A contains selected pages from the Committee of Experts meeting. Plaintiff can make the
full set (approx. 100 pages) available to the Court and Defendants, upon request.

1 United States saw a need to protect copyright management information, because of the need to
2 protect authors, and to protect the public from unknowingly committing copyright infringement.
3 Id. at 6, 12. And the United States advocated for a broad interpretation of copyright management
4 information. “The U.S. proposal prohibits the falsification, alteration or removal of any copyright
5 management information—not just that which is included in or digitally linked to the copyrighted
6 work.” Id. Plaintiff’s copyright management information, which is in and digitally linked to JMRI
7 software files, would clearly fall within the definition proposed by the United States during WIPO
8 Treaty negotiations. The United States definition of copyright management information supports a
9 construction of the term “copyright management information” that is broader than described in IQ
10 Group, Ltd. v. Wiesner Pub. LLC, 409 F. Supp. 2d 587, 597-98 (D.N.J. 2006), which limited
11 copyright management information to information that was protected by a technological device.
12 As noted in Plaintiff’s Opposition, the IQ Group Court did an incomplete review of the legislative
13 history of the DMCA, and did not consider any of the material from the WIPO Committee of
14 Experts meeting, now provided by Plaintiff. Thus, a proper interpretation of “copyright
15 management information” includes the information that Defendants removed, altered, and falsified.

16 Defendants argue that the Court should not consider the Photo Resource decision, cited by
17 Plaintiff in his Opposition, because it was not adopted by an Article III judge. More than three
18 weeks before Defendants filed their Reply, a district court did adopt the magistrate judge’s
19 findings, and ruled in the copyright holder’s favor. Photo Resource Hawaii, Inc. v. Am. Resource
20 Hawaii Travel, Inc., 2008 WL 41425, (D. Haw. Jan. 2, 2008) at *1 (order adopting magistrate’s
21 findings of fact and order as the opinion and order of the district court). Defendants had an
22 obligation to check their assertion before making it in their filing. By failing to meet their
23 obligation, they once again put the Court at risk of adopting their reasoning in error.

24 Defendants argue that IQ Group excludes any false copyright management information in
25 Defendants’ software products, which are protected by technological measure. They do not cite to
26 any portion of the IQ Group decision that supports their argument. Nor could they. The whole
27 point of Section 1202 is to subject to scrutiny copyright management information provided by the
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1 infringer. Thus, Defendants’ argument should be rejected.
2 In sum, the copyright management information in Plaintiff’s software is protected by the
3 DMCA. Plaintiff has shown he states a claim for relief under Section 1202 because Defendants
4 removed, altered, or falsified copyright management information, which encourages others to
5 infringe Plaintiff’s copyrights. Defendants’ motion to dismiss DMCA should be denied.

6 **B. Defendants Confuse “Alleged Infringement” with Infringement in Their**
7 **Motion to Strike**

8 No precedent supports striking statutory copyright damages for “alleged infringement”.
9 Defendants argue that precedent states a Court may strike copyright statutory damages based on the
10 date “alleged infringement” began. But no case that Defendants cite supports striking relief in the
11 early stages of litigation when the time infringement began was unknown. All cases Defendants
12 cited, centered on whether statutory damages were available because infringement, which had been
13 established, began before copyright registration. Defendants attempt to work around these facts by
14 slipping in that these cases involved “alleged infringement”. None do. Thus, the case law is
15 irrelevant. Defendants’ use of this irrelevant case law puts the Court at risk of adopting it in error.

16 **III. Conclusion**

17 Plaintiff’s DMCA cause of action states a claim upon which relief can be granted. By
18 removing Plaintiff’s copyright management information, Defendants encouraged others to infringe
19 Plaintiff’s copyrights. No relief should be stricken until the entire extent of Defendants’
20 infringement—not mere use—is established.

21 Respectfully submitted,

22
23 DATED: April 4, 2008

By _____ /s/
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27 ATTORNEY FOR PLAINTIFF

Exhibit A

WIPO



BCP/CE/VI/1
ORIGINAL: English
DATE: November 24, 1995

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE OF EXPERTS ON A POSSIBLE PROTOCOL TO THE BERNE CONVENTION

Sixth Session
Geneva, February 1 to 9, 1996

AGENDA

Prepared by the Director General

1. Opening of the session by the Director General
2. Election of a Chairman and two Vice-Chairmen
3. Examination of the proposals concerning a possible protocol to the Berne Convention
4. Adoption of the report of the session
5. Closing of the session

[End of document]

WIPO



BCP/CE/VI/8
ORIGINAL: English
DATE: December 5, 1995

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE OF EXPERTS ON A POSSIBLE PROTOCOL TO THE BERNE CONVENTION

Sixth Session
Geneva, February 1 to 9, 1996

PROPOSALS SUBMITTED BY THE UNITED STATES OF AMERICA

*Text of the proposals**

[1] Enclosed are the United States proposals for treaty language for consideration by the Committees of Experts on the Protocol to the Berne Convention and the New Instrument on the Protection of Performers and Producers of Phonograms, scheduled for February 1 through 9, 1996. The accompanying commentary explains the proposals and offers indications of points on which further discussion is likely to be required before treaty language can meaningfully be considered ...

[2] We are convinced that the United States Government proposals will provide for the strong and coherent copyright and neighboring rights protection needed to foster the growth of the Global Information Infrastructure. A few overall comments concerning the nature of the submissions is in order.

[3] The proposals related to distribution by transmission, technological safeguards and copyright management information included herein are based on the Administration's recent

* Received by the International Bureau on November 30, 1995. In the introductory part, paragraph numbers have been added by the International Bureau in brackets to facilitate reference.

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White Paper on Intellectual Property and the National Information Infrastructure and legislation currently pending before both the House of Representatives and the Senate. These proposals are submitted with the understanding that the United States may also amend its proposals to reflect the course of Congressional action and debate.

[4] The United States has not submitted any proposed treaty language dealing with private copying for either the Berne Protocol or the New Instrument. We believe that consideration of such a provision at this point is premature. Because any private copying regime will implicate the exercise of the author's exclusive rights by the use of digital transmissions, the treatment of such transmissions in both the Protocol and the New Instrument should be resolved first. Until the scope and interaction of all of the exclusive rights in the digital environment is clear, it is impossible to evaluate the impact or appropriateness of a private copying regime. In particular, one of the most important issues to resolve in connection with digital transmissions is the distinction between public and private uses. Depending on how the concept of "public" is defined in association with a particular right or rights, a levy for private copying may either be inappropriate or unnecessary, or may need to be circumscribed in ways that are not apparent at this stage of deliberation.

[5] In respect of the New Instrument, the United States has not submitted any language on moral rights of performers. We remain unconvinced, as do a number of other countries, that such rights are necessary. As we have noted in past discussions of the issue, should there be a consensus that moral rights of performers are necessary, we could consider a provision for such rights patterned on Article 6*bis* of the Berne Convention.

[6] As we noted in our June, 1995, submission, before the successful conclusion of the Uruguay Round Agreement on the Trade Related Aspects of Intellectual Property (TRIPs) in December 1993, the United States supported the inclusion of enforcement provisions in any new WIPO agreement. We believed that if TRIPs, with its strong enforcement provisions, was not adopted, then other multilateral agreements should establish enforcement norms. Since TRIPs has been adopted and successfully establishes broadly applicable enforcement disciplines, we believe that such provisions should no longer be included in the Protocol and New Instrument texts. Rather than be helpful, inclusion of the TRIPs enforcement provisions in the texts under consideration would be redundant and create the possibility of conflicting norms. If the enforcement language differed from that in TRIPs, the relative obligations in the two sets of texts would be unclear; even if the enforcement language in the texts were identical to that in TRIPs, there would still be the strong possibility of confusion through different interpretations of the texts in different fora. As a result, the United States believes that the TRIPs enforcement provisions should be removed from the Protocol and New Instrument unless they apply only to intellectual property standards not included in the TRIPs Agreement. In other words, to the extent that enforcement provisions are included, they should apply only to the new "TRIPs plus" elements of the Protocol and New Instrument, such as provisions on the protection of rights management information and the prohibition of devices and services that may be used to defeat technical security measures.

[7] The following proposals are based on developments and discussions in the Committees of Experts, U.S. domestic developments, our studies on intellectual property and the National and Global Information Infrastructures and consultations with our trading partners. They are

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made without prejudice to further proposals that may be made in light of U.S. legislation to amend the copyright law to ensure protection for the content of the NII. However, we are firmly convinced that consideration of one or more international agreements as outlined in the attached paper is necessary on an expedited basis.

PROTOCOL TO THE BERNE CONVENTION
FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS

Preamble

0.1 No proposal is made at this time for a Preamble to the Protocol. However, a Preamble may be useful to clarify the purposes of the Protocol and to explain its relation to provisions of the Berne Convention and other international agreements.

Article 1
Definitions

1.1 No definitions are currently included in this proposal. However, the United States continues to believe that the issue of definitions is critical and must be addressed after the subject matter and the substantive obligations of the Protocol have been agreed upon. In particular, because of the inclusion of elements of the digital agenda in this agreement, the United States believes that it will be necessary to include definitions that clearly distinguish between acts which are "public", and hence subject to the authorization of the authors or their successors in interest, from those which are essentially private in nature, some of which may be outside such control.

Article 2
Computer Programs and Databases

- (1) Computer programs are protected as literary works within the meaning of Article 2 of the Paris Act of the Berne Convention. Such protection applies to the expression in any form of a computer program.
- (2) It shall be a matter for national legislation in the countries party to this Protocol to provide for limitations or exceptions to the exclusive rights in a computer program. These limitations or exceptions shall be confined to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rightholder. This provision shall not permit limitations or exceptions that derogate from existing obligations under the Paris Act of the Berne Convention.
- (3) Collections of data or other material, in any form, which by reason of the selection or arrangement of their contents constitute intellectual creations are

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7.3 The proposed prohibition is intended to assist copyright owners in the protection of their works. It is not intended to stifle the development or introduction of consumer technologies such as television sets or video cassette recorders which may include electronic components aimed, for example, at improving the reception of broadcast signals. Copyright owners may wish, for instance, to use technological protection systems to prevent the unauthorized reproduction of their works, but may also wish to allow some users to deactivate the systems. Furthermore, certain uses of copyrighted works are not unlawful under national law in compliance with the Berne Convention. The proposal would make unlawful only certain acts involving those devices or products, the primary purpose or effect of which is to circumvent such systems *without authority*. That authority may be granted by the author or by limitations on or exceptions from copyright owner's rights under national copyright laws.

7.4 Precedent for this type of obligation exists in regional agreements and in the laws of a number of Berne Member countries. The North American Free Trade Agreement (NAFTA) requires each party to make it a criminal offense to "manufacture, import, sell, lease or otherwise make available a device or system that is primarily of assistance in decoding an encrypted program-carrying satellite signal without the authorization of the lawful distributor of such signal ..." In 1988, the United Kingdom enacted legislation prohibiting the manufacture, distribution or sale of a device designed or adapted to circumvent copy-protection systems.

Article 8

Protection of Copyright Management Information

Contracting Parties shall make it unlawful for any person knowingly:

- (a) to provide false copyright management information and to distribute or import for distribution, false copyright management information;
- (b) to remove or alter, without authority, any copyright management information;
- (c) to distribute or import for distribution, without authority, copyright management information that has been altered without authority of the author or his successor in interest; and
- (d) to distribute, or import for distribution, without authority, copies from which copyright management information has been removed or altered without authority of the author or his successor in interest.

8.1 In the future, the copyright management information associated with a work -- such as the name of the author, the copyright owner and the terms and conditions for uses of the work -- may be critical to the efficient operation and success of the GII. Copyright management information will serve as a kind of license plate for a work on the information superhighway, from which a user may obtain important information about the work. The accuracy of such information will be crucial to the ability of consumers to find and make authorized uses of

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copyrighted works on the GII. Reliable information will also facilitate efficient licensing and reduce transaction costs for licensable uses of copyrighted works (both fee-based and royalty-free).

8.2 This proposal is aimed at protecting not only authors and their successors in interest, but also the public at large. The public should be protected against those who would falsify information about who created the work, who owns rights in it, and what uses may be authorized on what terms by the copyright owner. Therefore, the Protocol should include an article to prohibit the provision, distribution or importation for distribution of copyright management information known to be false and the unauthorized removal or alteration of copyright management information. Under the proposed article, copyright management information would include the name and other identifying information of the author of a work, the name and other identifying information of the copyright owner, terms and conditions for uses of the work, and other similar information.

8.3 The U.S. proposal prohibits the falsification, alteration or removal of any copyright management information -- not just that which is included in or digitally linked to the copyrighted work. Many users will obtain such information from public registers, where the integrity of such information will be no less important. The proposal also contains a knowledge requirement; therefore, inadvertent falsification, alteration or removal would fall outside the scope of the obligation.

Article 9

National Treatment

9.1 The United States continues to regard national treatment as one of the keystones of any agreement on intellectual property. However, in consideration of the views expressed in earlier meetings of the Committees of Experts, we have agreed that this subject will be addressed, as will the question of definitions, only after agreement is achieved on the subject matter and rights to be covered in this Protocol. However, we believe that it is clear that certain principles must apply.

9.2 Consistent with Article 5(1) of the Berne Convention, nationals of other Contracting Parties should receive no less favorable treatment than a Contracting Party accords to its own nationals with regard to all rights and benefits. It should be clear that this obligation would apply to all rights presently provided for, or later granted, under a Party's domestic laws in respect of literary and artistic works, transmissions of such works, or fixations embodying such works. It should be clear that benefits include the same possibility to exploit and enjoy rights in the national territory of a Contracting Party as that Party grants to its own national.

[End of document]

WIPO



BCP/CE/VI/12
ORIGINAL: English
DATE: January 10, 1996

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE OF EXPERTS ON A POSSIBLE PROTOCOL TO THE BERNE CONVENTION

Sixth Session
Geneva, February 1 to 9, 1996

COMPARATIVE TABLE OF PROPOSALS AND COMMENTS
RECEIVED BY THE INTERNATIONAL BUREAU

Document prepared by the International Bureau

I. INTRODUCTION

1. At the fifth session of the Committee of Experts on a Possible Protocol to the Berne Convention and the fourth session of the Committee of Experts on a Possible Instrument for the Protection of the Rights of Performers and Producers of Phonograms, meeting jointly from September 4 to 8 and 12, 1995, it was agreed that "the Director General should invite the Government members of the Committees and the European Commission to send to the International Bureau by November 20, 1995, proposals in treaty language ... to be circulated as documents for consideration at the next [that is, the present] meetings of the Committees" (see WIPO document BCP/CE/V/9-INR/CE/IV/8, paragraphs 356 and 376). Following the invitation sent by the Director General, the International Bureau received ten proposals concerning the possible Protocol to the Berne Convention, namely from the European Community and its Member States, as well as from Argentina, China, Uruguay, Australia, Brazil, the United States of America, Japan, Canada and the Republic of Korea in that order.

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2. This document presents the proposals and comments on each of the issues concerning the above-mentioned Protocol, in alphabetical order of the countries (and the European Community and its Member States).

3. The issues covered by the proposals and by the relevant comments are as follows:

- preamble (chapter II),
- definitions (chapter III),
- computer programs (chapter IV),
- data bases (chapter V),
- non-voluntary licenses for the sound recording of music works (chapter VI),
- non-voluntary licenses for primary broadcasting and satellite communication (chapter VII),
- distribution, including importation (chapter VIII),
- rental (chapter IX),
- transmission, communication to the public and public performance (chapter X),
- digital transmission (chapter XI),
- private copying (chapter XII),
- duration of the protection of photographic works (chapter XIII),
- enforcement of rights (chapter XIV),
- technological measures (chapter XV),
- rights management information (chapter XVI),
- national treatment (chapter XVII).

4. The text of treaty-language proposals are indented and are reproduced in italics.

XVI. RIGHTS MANAGEMENT INFORMATION

Argentina:

The Contracting Parties shall impose the same sanctions as are provided for in the case of copyright infringement on any person who:

- (a) omits the name of the author or of the owner of rights and the conditions on which the work is being used;*
- (b) fraudulently includes information on such particulars and on the management thereof.*

Brazil:

Contracting Parties shall establish the sanctions to be applied in the cases of inclusion, elimination or modification of fraudulent information about the collective management of copyrights.

This proposal aims at protecting both authors and users, due to the fact that adulteration of such an information is harmful to all society.

Canada:

Copyright management information consists of the:

- (a) the name and other identifying information of the author of the work,*
- (b) the name and other identifying information of the maker of a cinematographic work,*
- (c) the name and other identifying information of the copyright owner;*
- (d) the name and other identifying information of the publisher of the work,*
- (e) the name or title of the work,*
- (f) any standard identifying designation with respect to the work,*

where such information is embodied in [or affixed to] the work.

Where a work is a translation, adaptation, arrangement or alteration of another work, copyright management information includes such

copyright management information about the translated or underlying work which may be embodied in [or affixed to] the work.

It is an infringing act to remove [for fraudulent purposes]/[for purposes of distribution or communication to the public] any copyright management information embodied in [or affixed to] a work.

Comment: The removal of the name of the author should not be subject to the condition that it be for fraudulent purposes.

It is an infringing act to knowingly sell, rent, or distribute any work from which copyright management information has been unlawfully removed.

It is an infringing act to knowingly communicate to the public in a form which can be received by a computing device any work from which copyright management information embodied in the work has been unlawfully removed or altered.

China:

NCAC suggests that all the problems arisen from the new technology such as digital transmission, right management and technical measures, should be studied further.³²

European Community and its Member States:

The European Community and its Member States are not making any specific proposals at this stage on the possible impact of new technologies on authors' rights. However, on the basis of the first results of the consultative process initiated with the adoption on 19 July 1995 of the European Commission's Green Paper on "Copyright and Related Rights in the Information Society", the European Community and its Member States should be in a position to make a valuable contribution to the debate on this issue which will take place in the sixth session of the Committee of Experts. We would like to underline again the importance attached to this subject and to reiterate the view that it is appropriate for these issues to be examined in WIPO and that the current discussions taking place in both Committees of Experts provide an adequate basis for doing so.³²

Japan:

The Government of Japan reserves its position on other items such as ... "Rights Management Information" ...

³² The foregoing text is also reproduced in Chapter XI (Digital Transmission) and in Chapter XV (Technological Measures).

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United States of America:

The proposals related to distribution by transmission, technological safeguards and copyright management information included herein are based on the Administration's recent White Paper on Intellectual Property and the National Information Infrastructure and legislation currently pending before both the House of Representatives and the Senate. These proposals are submitted with the understanding that the United States may also amend its proposals to reflect the course of Congressional action and debate.

The following proposals are based on developments and discussions in the Committees of Experts, U.S. domestic developments, our studies on intellectual property and the National and Global Information Infrastructures and consultations with our trading partners. They are made without prejudice to further proposals that may be made in light of U.S. legislation to amend the copyright law to ensure protection for the content of the NII. However, we are firmly convinced that consideration of one or more international agreements as outlined in the attached paper is necessary on an expedited basis.³³

Protection of Copyright Management Information:

Contracting Parties shall make it unlawful for any person knowingly:

(a) to provide false copyright management information and to distribute or import for distribution, false copyright management information;

(b) to remove or alter, without authority, any copyright management information;

(c) to distribute or import for distribution, without authority, copyright management information that has been altered without authority of the author or his successor in interest; and

(d) to distribute, or import for distribution, without authority, copies from which copyright management information has been removed or altered without authority of the author or his successor in interest.

In the future, the copyright management information associated with a work -- such as the name of the author, the copyright owner and the terms and conditions for uses of the work -- may be critical to the efficient operation and success of the GII. Copyright management information will serve as a kind of license plate for a work on the information superhighway, from which a user may obtain important information about the work. The accuracy of such information will be crucial to the ability of consumers to find and make authorized uses of copyrighted works on the GII. Reliable information will also facilitate efficient licensing and reduce transaction costs for licensable uses of copyrighted works (both fee-based and royalty-free).

³³ The foregoing text is also reproduced in Chapter XI (Digital Transmission) and in Chapter XV (Technological Measures).

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This proposal is aimed at protecting not only authors and their successors in interest, but also the public at large. The public should be protected against those who would falsify information about who created the work, who owns rights in it, and what uses may be authorized on what terms by the copyright owner. Therefore, the Protocol should include an article to prohibit the provision, distribution or importation for distribution of copyright management information known to be false and the unauthorized removal or alteration of copyright management information. Under the proposed article, copyright management information would include the name and other identifying information of the author of a work, the name and other identifying information of the copyright owner, terms and conditions for uses of the work, and other similar information.

The U.S. proposal prohibits the falsification, alteration or removal of any copyright management information -- not just that which is included in or digitally linked to the copyrighted work. Many users will obtain such information from public registers, where the integrity of such information will be no less important. The proposal also contains a knowledge requirement; therefore, inadvertent falsification, alteration or removal would fall outside the scope of the obligation.