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CJEU, C-392/19: embedding a copyright work in a website of a third party through the framing technique may need the right holder's consent

On 9 March 2021, the Court of Justice of the European Union (“CJEU”) ruled on the interpretation of the notion of “communication to the public” under Art. 3(1) of the Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society (the “Information Society Directive”).

Background

The parties to the proceedings are Stiftung Preußischer Kulturbesitz (“SPK”), a foundation registered under German law – responsible of a digital library which networks German cultural and scientific institutions – and Verwertungsgesellschaft Bild-Kunst (“VG Bild-Kunst”), a visual arts copyright collecting company in Germany.

The dispute concerns a licence agreement for the use by SPK of VG Bild-Kunst’s catalogue of works in the form of thumbnails (i.e. smaller versions of original images). In particular, VG Bild-Kunst maintained that the conclusion of its agreement with SPK should be subject to an undertaking on SPK to apply effective technical measures to protect against the framing¹ by third parties of the thumbnails of the works covered by the agreement and displayed on its website.

Taking the view that the provision was unreasonable under copyright law², SPK brought an action in Germany seeking a declaration that VG Bild-Kunst was required to grant the license to SPK without the abovementioned provision.

The German Federal Court of Justice (the “Referring Court”) decided to stay the proceedings and refer the following question to the CJEU for a preliminary ruling: *“Does the embedding of a work – which is available on a freely accessible website with the consent of the right holder – in the website of a third party by way of*

¹ Framing is a technique that allows the screen to be divided into several parts, each of which can independently display a different webpage or internet resource. Thus, the original webpage may be displayed on one part of the screen, while a webpage or other resource from another website is displayed on the other part.

² Art. 16 (1) and (2), first subparagraph, of Directive 2014/26/EU of 26 February 2014 on collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online use in the internal market, transposed into German law, provides as follows: *“1. Member States shall ensure that collective management organisations and users conduct negotiations for the licensing of rights in good faith. Collective management organisations and users shall provide each other with all necessary information. 2. Licensing terms shall be based on objective and non-discriminatory criteria. When licensing rights, collective management organisations shall not be required to use, as a precedent for other online services, licensing terms agreed with a user where the user is providing a new type of online service which has been available to the public in the Union for less than three years ...”*.

However, pursuant to Art. 3 (1) and (3) of the Information Society Directive, *“1. Member States shall provide authors with the exclusive right to authorise or prohibit any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them (...). 3. The rights referred to in paragraphs 1 and 2 shall not be exhausted by any act of communication to the public or making available to the public as set out in this Article”*. Moreover, pursuant to Art. 6 (1) and (3): *“1. Member States shall provide adequate legal protection against the circumvention of any effective technological measures, which the person concerned carries out in the knowledge, or with reasonable grounds to know, that he or she is pursuing that objective”*.

framing constitute communication to the public of that work within the meaning of Article 3(1) of Directive 2001/29 where it circumvents protection measures against framing adopted or imposed by the right holder?”.

In other words, should the framing of thumbnails on third-party website be considered as a communication to the public within the meaning of Art. 3(1) of the Information Society Directive, VG Bild-Kunst would then be allowed to require SPK to implement effective technological measures.

Findings of the CJEU

Firstly, as for the notion of “communication to the public” under Art. 3(1) of the Information Society Directive, the CJEU noted that (i) the alteration in the size of the works is not a relevant factor in the assessment, provided that the original elements of those works are perceptible; (ii) any act whereby a user – in full knowledge of the consequences of what he/she is doing – gives access to protected work is liable to constitute an act of communication; (iii) the protected work must be communicated to a public (i.e. an indeterminate number of potential users) using specific technical means, different from those previously used or, failing that, to a new public (i.e. a public that was not already taken into account by the copyright holder when he/she authorised the initial communication of his/her work).

Secondly, the CJEU recalled that, according to its case-law, on the one hand, the technique of framing constitutes an act of communication to a public, since the effect of that technique is to make the posted element available to all the potential users of a website³. On the other hand, technical means used by framing are the same as those previously used to communicate the protected work to the public on the original website. Thus, it does not fall within the scope of a communication “to the public”, under Art. 3(1) of the Information Society Directive⁴.

Thirdly, the CJEU held that the applicable case-law does only apply where access to the works concerned on the original website is not subject to any restrictive measures, namely when the right holder has authorised from the outset the communication of his/her works to all internet users.

Following on from that, the Court held that where the copyright holder has established or imposed from the outset restrictive measures which limit the access to his/her works from websites other than that on which he/she has authorised communication to the public of such works, he/she is to be deemed to have expressed the intention to confine the public for those works solely to the users of one particular website. In the CJEU’s view, however, in order to ensure legal certainty, the copyright holder is required to limit his/her consent by means of effective technological measure⁵.

In view of the above, the CJEU concluded that, **where the copyright holder has adopted or imposed effective technological measures to restrict framing, the embedding of a work in a website of a third party, by means of the technique of framing, constitutes an act of “making available that work to a new public” which must be authorised by the right holder.**

Indeed, a different approach would amount to creating a rule on exhaustion of the right of communication – contrary to the wording of Article 3(3) of the Information Society Directive – and deprive the copyright holder of the opportunity to claim an appropriate reward for each use of the protected work.

For further information on the case, our article on the Advocate General’s Opinion of 10 September 2020 is available [here](#).

³ See, Judgment of 13 February 2014, *Svensson and Others*, C-466/12, EU:C:2014:76, paragraphs 20, 22 and 23.

⁴ See, Judgment of 13 February 2014, *Svensson and Others*, C-466/12, EU:C:2014:76, paragraphs 24 to 30.

⁵ Article 6(1) and (3) of Information Society Directive. See, in that regard, Judgment of 23 January 2014, *Nintendo and Others*, C-355/12, EU:C:2014:25, paragraphs 24, 25 and 27.