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ASPECTS OF COPYRIGHT AND OTHER RIGHTS IN NON-PATENT LITERATURE
MADE AVAILABLE BY INTELLECTUAL PROPERTY OFFICES

Document prepared by the International Bureau

BACKGROUND

1. The Summary by the Chair of the third session of the Working Group on Reform of the Patent Cooperation Treaty states, in paragraph 63 (see document PCT/R/WG/3/5):

“Copyright Issues Raised by the International Search and Preliminary Examination Procedure

“63. Two delegations observed that the making and sending, by the International Searching Authority, of copies of documents cited in the international search report, as provided by Article 20(3) and Rule 44.3, could involve copyright infringement, in particular where it involved non-patent literature and the first digitization of a document. The International Bureau observed that the library community may also experience similar problems. It was agreed that the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should study the matter with a view to having the matter considered by the appropriate body or bodies within WIPO.”

2. The present document contains a preliminary outline and discussion of certain legal issues arising from the making available of non-patent literature by industrial property offices (“Offices”) and outlines the broader context in which these issues might arise, taking into

account also the likely evolution of office practices in the digital environment. In light of this purpose, the document focuses not only on questions resulting from the application of Article 20(3) of the PCT and Rule 44.3 of the Regulations under the PCT, as mentioned in the summary of the Chair of the third session of the Working Group, but also on those that might arise from other, more technologically advanced, means for Offices to make non-patent literature available. The document was prepared by the International Bureau after making preliminary contacts with the Delegations of Australia and Canada, but it does not represent an agreed position.

INTRODUCTION

3. Examination as to the novelty of a claimed invention requires a review of the relevant prior art. Traditionally, such examination was performed principally by reviewing paper-based sources of prior art, namely copies of published patent documents and of non-patent literature (the latter including, for instance, technical articles and textbooks).
4. During the last decade, in particular, the method by which the prior art review is performed has been profoundly affected by information technology, including the Internet. Sources of prior art which previously were only available on paper now also exist in digital form. Furthermore, in recent years, numerous databases providing online access to a wealth of patent and non-patent literature have become available, many of which can be consulted through the Internet. It is to be expected that this trend will intensify in the future. Some of these databases are made available on a commercial basis by private entities, while others have been developed by public authorities, most notably Offices. The value of these patent databases is a function of the richness of their content, as well as the ease of use. Aggregating a large amount of easily retrievable and relevant information, including non-patent literature, in such databases is a highly attractive proposition for the users of the patent system.
5. In the course of the performance of their functions, Offices make available sources of prior art, including non-patent literature, to a variety of persons and entities, including staff members within the Office, other Offices and applicants, and also third parties. There are various means by which these sources may be made available by the Offices concerned, including the mailing or distribution of paper copies of the materials at issue, the transmission of the same materials in electronic form through networks including the Internet (e-mail) and the making available of databases permitting online access to the materials in question. To the extent that those prior art sources include non-patent literature, their being made available in this manner by Offices may affect third parties' rights in the works concerned. Offices should therefore be aware of the legal implications which their practices may have in respect of those third party rights.

THE MAKING AVAILABLE BY OFFICES OF NON-PATENT LITERATURE: SCENARIOS

6. As explained above, Offices may make non-patent literature available to different persons or entities by various means. While it is recognized that the list below is not exhaustive, it would appear that current and future Office practices typically would fall under one or more of the following categories:

- (i) the making by Offices of physical or digital copies of non-patent literature for consultation only by staff members of the Offices concerned ("Scenario A");

(ii) the creation by Offices of searchable databases containing non-patent literature, for consultation only by staff members of the Offices concerned, through the scanning, using Optical Character Recognition, and uploading of non-patent literature (“Scenario B”);¹

(iii) the transmission by Offices of physical or digital copies of non-patent literature to designated Offices or applicants under Article 20(3) of the PCT (“Scenario C”);

(iv) the transmission by relevant Authorities of International Search Reports and International Preliminary Examination Reports containing hyperlink to non-patent literature hosted on third party Internet resources (for instance, a hyperlink to an article in a technical magazine posted on the website of an Internet publisher) (“Scenario D”);

(v) the creation and making available by Offices of databases, for consultation by the public through the Internet, containing hyperlink to non-patent literature hosted on third party Internet resources (“Scenario E”);

(vi) the making available by Offices of databases described in (ii) to the public for consultation through the Internet (“Scenario F”).

7. After a general review of the relevant legal principles, the remainder of this document will outline the legal issues which may arise from each of the above scenarios.

RELEVANT LEGAL PRINCIPLES

8. A substantial portion of the non-patent literature, typically technical textbooks or articles in technical publications, are subject to exclusive rights granted to their authors by the copyright system and may also benefit from other forms of protection offered by similar rights. These exclusive rights or other forms of protection place important restrictions on the use which other parties may make of the works in question, absent authorizations (licenses) from the rightsholders. The international legal basis of these restrictions is discussed in the subsequent paragraphs of this paper.

Protection Under Copyright

9. Article 2 of the Berne Convention for the Protection of Literary and Artistic Works (the Berne Convention) states that “[t]he expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings....” Many forms of non-patent literature, and certainly technical textbooks and articles in technical publications, qualify as “literary and artistic works” under the Berne Convention. The essential elements of the Berne Convention have been incorporated into the TRIPS Agreement through its Article 9(1) stating that “[m]embers shall comply with Articles 1 through 21 of the Berne Convention.”²

¹ See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

² Except in respect of the rights conferred under Article 6 *bis* of the Berne Convention.

10. The copyright system confers upon the author of literary and artistic works a bundle of different rights. Among the various rights granted, those that concern most directly the topic at issue are the right of reproduction, the right of distribution and the right of making available to the public.

11. The right of reproduction is enshrined in Article 9 of the Berne Convention, which provides that “[a]uthor of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.” With respect to the application of this right in the digital environment, the agreed statement concerning Article 1(4) of the WIPO Copyright Treaty (WCT)³ reads as follows:

“The reproduction right, as set out in Article 9 of the Berne Convention, and the exceptions permitted thereunder, fully apply in the digital environment, in particular to the use of works in digital form. It is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of the Berne Convention.”

12. The right of distribution is laid down in Article 6(1) of the WCT which stipulates as follows:

“Authors of literary and artistic works shall enjoy the exclusive right of authorizing the making available to the public of the original and copies of their works through a sale or other transfer of ownership.”

13. With respect to the right of making available to the public, Article 8 of the WCT states as follows:

“Without prejudice to [certain provisions of the Berne Convention], authors of literary and artistic works shall enjoy the exclusive right of authorizing 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 these works from a place and at a time individually chosen by them.”

The passage “making available to the public of . . . works in such a way that members of the public may access these works from a place and at a time individually chosen by them” covers the posting of works on the Internet in order to allow the public to access or download them.⁴

³ The WCT is one of two treaties which were adopted in 1996 by the WIPO Member States (both commonly referred to as the “WIPO Internet Treaties”), the other being the WIPO Performances and Phonograms Treaty (WPPT). The treaties, each having reached their 30th ratification or accession, have both entered into force: the WCT on March 6, 2002, and the WPPT on May 20, 2002. The WIPO Internet Treaties are designed to update and supplement the existing international treaties on copyright and related rights, namely, the Berne Convention and the Rome Convention.

⁴ For an extensive analysis of the background to this provision and its relationship with the interactive, on-demand transmission of works in digital networks, see Mihály Ficsor, *The Law of Copyright and the Internet* (Oxford University Press, 2002), pages 145 through 254. For a broad discussion of copyright in the digital environment, see WIPO, *Intellectual Property on the Internet: A Survey of Issues* (December 2002), pages 29 through 63, available at <http://ecommerce.wipo.int/survey/index.html>.

Protection Under Similar Rights

14. While copyright is the most important, as well as the most internationally harmonized, legal source of limitations on the use which third parties may make of protected works, it is not the only such source. Depending on the jurisdiction in question, a variety of comparable user restrictions may be grounded on legal foundations other than copyright, including, in particular, misappropriation, unfair competition and the protection of databases. The latter concept is discussed in more detail below, in light of its special relevance to the topic at issue.

15. The region of the world where the protection of databases has found its most explicit legal articulation is the European Union, through Directive 96/9/EC of the European Parliament and of the Council of March 11, 1996 on the Legal Protection of Databases (the Database Directive).⁵ Article 1(1) of the Database Directive defines a database as “a collection of independent works, data or other material arranged in a systematic or methodical way and individually accessible by electronic or other means.” Article 7(1) of the Directive stipulates that “Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of the database.” Article 7(5) further states that “[t]he repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database shall not be permitted.”

16. At the international level, there does not exist at present a comparable “*suigeneris*” right in databases, such as the one provided for in Article 7 of the Database Directive, although the possible creation of international protection for databases which by their nature do not benefit from copyright protection (namely, non-original databases), has been the subject of discussion for several years in WIPO’s Standing Committee on the Law of Copyright and Related Rights.

Exceptions: General

17. The copyright system has traditionally maintained a balance between protecting creators’ property rights through exclusive rights to control the use of their works, and the public interest in having access to and reasonable possibilities to use such materials. Copyright laws permit exceptions and limitations to copyright, in order to maintain this balance. In the United States of America, for example, this balance has been enshrined in the principle of “fair use” limitations on the rights of authors, while in other countries such as Australia and the United Kingdom, the concept is recognized by way of statutory exceptions to copyright infringement for “fair dealing.” In other countries, such as France, there exists no broad doctrine governing exceptions (such as “fair use” or “fair dealing”),⁶ but specifically enumerated exemptions are expressly foreseen in the copyright legislation.

⁵ That Directive entered into force on January 1, 1998, and has since been implemented in the national legislation of all European Union Member States.

⁶ See Paul Edward Geller, *International Copyright Law and Practice*, Volume I, Release No. 14 (LexisNexis, 2002), para. 8[2].

18. The scope of permissible exceptions is to a large degree a matter of national law, although a number of overarching general principles exist at the international level. With respect to the right of reproduction, Article 9 of the Berne Convention states as follows:

“It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.”

19. Article 10 of the WCT similarly foresees that Contracting Parties may provide for exceptions to the right of distribution and right of making available to the public, subject to their meeting the same “three step test” laid down in Article 9 of the Berne Convention. The agreed statement concerning Article 10 of the WCT furthermore adds the following:

“It is understood that the provisions of Article 10 permit Contracting Parties to carry forward and appropriately extend into the digital environment limitations and exceptions in their national laws which have been considered acceptable under the Berne Convention. Similarly, these provisions should be understood to permit Contracting Parties to devise new exceptions and limitations that are appropriate in the digital network environment.”

20. The law of copyright, like patent law, is territorial and this characteristic is perhaps nowhere felt more acutely than in the area of exceptions and limitations. Which use would fall under the scope of an exception varies significantly from one jurisdiction to another, and the analysis of whether certain cross-border uses of works may benefit from an exception therefore, will often require finding the applicable law. If use of the work is made on the Internet, finding the applicable law becomes an exceptionally difficult exercise, in the light of the ubiquitous and global nature of that medium.⁷

21. Article 9 of the Database Directive also foresees a number of exceptions to the database “*sui generis*” right which it creates. These exceptions present certain similarities to those that are found in the copyright system.

Exceptions: Government Use

22. Several countries have provided for copyright exceptions relating to certain government use of protected works. For example, Section 45 of United Kingdom Copyright, Designs and Patents Act states that “(1) [c]opyright is not infringed by anything done for the purposes of parliamentary or judicial proceedings and (2) [c]opyright is not infringed by anything done for the purposes of reporting such proceedings, but this shall not be construed as authorising the copying of a work which is itself a published report of the proceedings.”⁸ In certain countries, the exceptions for government use are more broadly crafted. The French Intellectual Property Code, for instance, states in its Article L.331-4 that “[copyright] may not prevent actions

⁷ For an introductory discussion of the interplay between private international law, intellectual property and the Internet, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 113 through 131, available at <http://ecommerce.wipo.int/survey/index.html>.

⁸ Similar provisions exist in the legislation of, for instance, Australia, Greece, India, Ireland, Spain and Singapore.

which are necessary for the accomplishment of a judicial or administrative procedure provided for by law, or which are undertaken for the purposes of public security.” As regards United States of America law, in an opinion of April 30, 1999 addressed to the General Counsel of the United States Department of Commerce, the Acting Assistant Attorney General concluded as follows on the question of whether government reproduction of copyrighted materials invariably is a “fair use”:

“There is no ‘per se’ rule that government reproduction of copyrighted material – including, in particular, government photocopying of copyrighted materials for internal government use – automatically qualifies as a fair use under section 107 of the Copyright Act of 1976. However, government photocopying would in many contexts be non-infringing because it would be a ‘fair use’; and there are good reasons that, if an agency decides to negotiate photocopying licensing agreements, it should seek to limit the scope of any such arrangement to cover only those government photocopying practices that otherwise would, in fact, be infringing.”⁹

23. With respect to the situation in Japan, a commentator from the Japan Patent Office (JPO) has stated the following:

“Article 42 of the Copyright Law of Japan stipulates that the right of reproduction shall not extend to (i) cases necessary for court procedures and (ii) those necessary for legislative and administrative internal use purposes, provided that the interests of the author are not unduly injured in light of the number and mode of the reproduction.”¹⁰

24. The subsequent section of this document considers each of the Scenarios identified in paragraph 7, above, in light of the aforementioned legal principles.

APPLICATION OF LEGAL PRINCIPLES TO SCENARIOS

Scenarios A and B

25. Several actions taken in Scenarios A and B may be viewed as implicating the right of reproduction and the right of distribution. In Scenario A, this is the case for the physical or digital reproduction of the copies of the prior art source materials by the Office (right of reproduction) and their transmission to the staff members of the Office (right of distribution). In Scenario B, the right of reproduction is implicated, at the very least, by the scanning of the works in question and their uploading into the database. Furthermore, the making available of the works through the database to the examiners of the Office may also implicate the right of communication to the public, notwithstanding the fact that these works may be accessible only by staff members of the Office and not the general public.

26. However, as observed above, certain countries recognize exceptions for government use and the actions taken by Offices in Scenarios A and B may, in a number of countries, fall under such exceptions. For instance, with respect to the situation in Japan concerning Scenario B, the Japan Patent Office has noted that:

⁹ The full text of the Opinion is available at <http://www.cybercrime.gov/fairuse.htm>.

¹⁰ See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

“Understanding that the digitization of documents for [insertion into a database made available to the examiners of the Japan Patent Office (JPO)] is a permissible reproduction under Article 42 [of the Copyright Law of Japan], the JPO are continuing to digitize relevant documents for internal use only, without license agreement with the rightsholders.”¹¹

27. It may be concluded that, in a number of countries, Scenarios A and B are problematic from a copyright perspective, unless appropriate licenses have been secured from the rightsholders, or unless they benefit from exceptions provided for under the applicable national law.

Scenarios C and D

28. Scenario C is based on Article 20(3) of the PCT, which reads as follows:

“At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.”¹²

With respect to the international preliminary examination report, Article 36(4) of the PCT furthermore states that:

“The provisions of Article 20(3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.”

Copies of cited documents sent under Article 20(3) by relevant Authorities might be in paper or in electronic form (that is, scanned versions of the source material).

29. Scenario D reflects how the practice provided for in Article 20(3) might transform itself in the digital environment. Instead of sending physical or electronic copies of the documents, Authorities would simply provide hyperlinks, embedded in electronic versions of these search and examination reports, permitting recipients to access online the prior art source materials, which themselves would be hosted on third-party Internet resources.

30. In terms of the rights affected, Scenario C implicates the right of reproduction, the right of distribution, as well as the right of making available to the public.

31. With respect to Scenario D, the question is whether providing a hyperlink which resolves to a protected work may be infringing. No internationally harmonized rules governing specifically the liability for linking online content exist and, at the national level, the matter is mostly left for the courts to resolve. The case law which can be observed to date

¹¹ See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

¹² Rule 44.3 provides for modalities for the copying and transmission of the documents cited in the international search report.

is far from settled and it is therefore hard to draw any general conclusions, apart from the following:¹³

(i) Linking to the homepage of a website normally raises less concern than “deep-linking,” which connects a user directly to secondary material on another site, bypassing that site’s homepage. Links that might be provided in Scenario D would most likely qualify as deep links, as they would presumably resolve to a particular work (for example, a specific article in a technical magazine) hosted on the site of an online publisher, rather than its homepage.

(ii) The use of deep -links to retrieve pages from the targeted site’s database may, in some jurisdictions, amount to an infringement of rights in the database that contains the secondary information. As explained above, in the European Union, Article 7 of the Database Directive requires Member States to provide protection against the extraction and/or re-utilization of the “whole or of a substantial part of the contents of a database,” as well as against “the repeated and systematic extraction and/or re-utilization of an insubstantial part of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database.”

32. While it is clear that Scenarios C and D raise important rights issues, a proper assessment of the legal appropriateness of these Scenarios should also take into account the following:

(i) The action taken by Offices in Scenario C (and, *mutatis mutandis*, perhaps also those in Scenario D) are mandated by a treaty provision, namely Article 20(3) of the PCT. While this provision does not explicitly exempt Offices from complying with their copyright obligations, the fact that the practice at issue finds support in a rule of international law is not an irrelevant consideration. The relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law, and the impact this may have on the rights and obligations of relevant Authorities with respect to the reproduction and making available of non -patent literature to other Offices and applicants under the PCT merits further consideration.

(ii) Under Article 20(3) only the designated Office and the applicant would receive copies of (or hyperlinks permitting access to) the materials in question. As those materials thus would be made available only to a limited number of persons or entities (not the general public), such practice may benefit from an exception in a number of countries. A definitive answer to this question requires further analysis of the applicable national law by each Office concerned. To the extent the applicant and/or designated office is located in a jurisdiction other than that of the International Searching Authority or the International Preliminary Examination Authority, such analysis may require the consideration of more than one national law.

¹³ For a more detailed discussion of linking online content, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 51 through 53, available at <http://ecommerce.wipo.int/survey/index.html>.

Scenarios E and F

33. Scenarios E and F, implicating the right of reproduction, as well as the right of making available to the public, raise even more serious concerns from a copyright and database protection perspective, as any exceptions for government use that may be provided for under the applicable national law would not apply to them, since the general public would be the primary beneficiaries of the databases in question.

POSSIBLE APPROACHES

34. The preceding paragraphs indicate that, to varying degrees, all Scenarios envisaged in this document raised delicate issues of copyright and similar rights. With respect to the question of how to address these issues, the following observations are offered for consideration by the Working Group:

(i) As noted above, the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law merits further consideration. Such further consideration could occur in the context of the Study to be performed by the International Bureau, in cooperation with the Delegation of Canada and other Authorities, as envisaged by the Chair's Summary of the third session of the Working Group (see paragraph 1, above).

(ii) Certain of the Scenarios envisaged in this document may benefit from exceptions under national laws. Offices concerned therefore should review the legal position in their jurisdiction, taking into account also considerations of private international law to the extent the materials in question would be made available in other jurisdictions, possibly through the Internet.

(iv) A more global, systematic and comprehensive solution may require the conclusion of licensing agreements with the rightsholders of the principal sources of non-patent literature by Offices, International Search Authorities and International Preliminary Examining Authorities, as well as the International Bureau. The principle and the modalities of such license agreements might also usefully be further considered in the Study referred to in (i) above.

35. The Members of the Working Group are invited to consider the contents of this document and to decide whether the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should:

(i) further consider the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law; and

(ii) further consider the principle and possible modalities of the licensing agreements referred to in paragraph 34(iv), above.

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