Symposium: Digital Archives: Navigating the Legal Shoals

International Issues: Which Country's Law Applies When Works are Made Available Over the Internet?

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Before I start, I'd like to thank the Rockefeller Archives, and especially Jack Meyers, for all of the Archives' many forms of support. And I'd particularly like to thank June Besek, who is the Executive Director of the Kernochan Center, whose brainchild and product of a lot of sweat of the brow this conference is.

My topic is International Implications, a topic that would not exist but for the Internet. When access to archival materials was on a physical basis, patrons came to the archive and consulted the material on site; the material did not leave the archive, much less get sent overseas. Even digitized materials, if consulted on site, do not present the problems that arise if the archives puts this material on a website, which is accessible around the world, that ubiquity being the default condition of the Internet.

Let us consider some problems that might arise and which have international consequences. First of all, with respect to contract law, what was the scope of the authorization set out, for example, in the donor agreement? Does the agreement permit digitization? Is there any indication that the agreement contemplated digitization at all? Does the agreement permit making material available overseas? Any indication that was considered?

From contracts let us move to copyright and other forms of tort liability. With respect to copyright, many questions arise, one of which was alluded to in an earlier presentation. If this material is unpublished, it is being made publicly available for the first time. In many countries, the so-called "divulgation right" may be even stronger than the U.S. traditional right of first publication. As a result, making the digitized material available to readers from those countries might violate the author's divulgation rights overseas simply by disclosing the material.

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This concern may be the strongest when the author is a national or resident of the foreign country, but authors also enjoy divulgation rights in countries where they do not reside. Thus, if a U.S. archive makes a letter by a French author accessible all over the world via the Internet, that author's French divulgation rights are violated, but so are they also in Germany, Spain and any other country that recognizes those rights.

Whether or not the work has previously been published, copyright grants authors the exclusive rights of reproduction (making copies), and in the context of the Internet, communicating works to the public, or making them available, because people receive these works by means of transmission. These rights subsist not only in the work's country of origin (the author's residence or the country of the work's first publication), but also in every other country with which the country of origin has copyright relations, for example through common membership in the Berne Convention (which has over 164 member States).[1] In many countries, the author's rights reach not only direct actors, but also downstream users whose acts of reproduction or communication to the public a third party "authorized" or enabled. As a result, the archive may need to consider its possible liability if a user in such a country accessed the work and then made it available to other persons who might in turn infringe the work.

Outside of copyright, there are privacy issues. In many countries, privacy rights do not end at death, thus the family may have lingering privacy rights. As a result, the absence of postmortem privacy rights in the United States does not mean that the dead person, or her family, does not have those rights somewhere else.

Continuing with the list of potential problems beyond copyright issues, consider defamation: different countries have different standards of liability for defamation, including whether or not truth is a defense. A variation on defamation: hate speech. In the United States, there is no liability for hate speech, but in a number of countries, certain kinds of communications—for example, Nazi apologia—are illegal. Suppose your archive includes a lot of Nazi propaganda, for example, because the person whose documents constitute the archives was a Nazi sympathizer? If the archive makes those documents available, will it risk liability for hate speech in some country?

Then consider certain general tort issues, which might be called "The Mushroom Problem." It may be an urban legend, but someone once published a guidebook to edible mushrooms, only one of them wasn't. Would the publisher be liable if a reader relied on the advice of the guidebook? Suppose that the papers in an archive include the founder's home recipes, and these include a savory preparation of an edible mushroom that turns out to be poisonous. If the archive discloses the recipe, does the archive become a publisher? And if so, is it liable for the fatal consequences of following the recipe?

I have given just a short overview of the kinds of problems that might arise once the archive's website becomes available to foreign users. Practical concerns arise

1. *Berne Convention Member Statistics*, WORLD INTELL. PROP. ORG., http://www.wipo.int/treaties/en/statistics/StatsResults.jsp?treaty_id=15&lang=en (last visited Oct. 20, 2010).

only if the archive is likely to be sued in another country for these acts, or if, wherever the archive is sued, a law unfavorable to the archive would be applied.

What is the likelihood of being sued? That depends a lot on whether the jurisdiction considers that simply having a website accessible in the forum suffices to make a foreign defendant amendable to suit. Mere accessibility is generally not the rule. There has to be somewhat greater contact between the forum and the website. If the website is clearly targeting users in that forum, that generally may be considered a basis for dragging the foreign website operator before the court. But then there is the grey area: if the foreign website is not specifically targeting readers or users in that jurisdiction, but the website is interactive, so that readers can, for example, view, download and recommunicate content. That level of interactivity might make the foreign operator amenable to suit.

If the archives can be sued abroad, what law applies? With respect to contracts, the usual conflicts rule designates the law that the parties to the contract have chosen. How many donor agreements specify the applicable law? In the absence of such a specification, most courts try to "localize" the contract to find the arrangement's general center of gravity. In many cases the law that governs that contract may end up being U.S. law. Assuming that, on the whole, U.S. law seems the best choice, archives should ensure that the donor agreements specify the applicable law.

But what if liability is based not on contract, but on copyright infringement or some other tort? On what basis does a court determine whose law applies? There are a couple of alternative points of attachment. One is the law of the country from which the communication is originating. If the website is in the United States, although accessible elsewhere, U.S. law would apply because the communication comes from the U.S. Another possibility—more likely, I think, for reasons that will become apparent—is the law of the country where the harm from the communication is felt. That would be the country of receipt, where somebody is accessing that material. And a third possibility is the country with the most significant relationship to that communication, which could be the country from which the communication is originating, or it could be the country in which the communication is received.

Let me give you some concrete examples. Google has been sued in France for its book-scanning program.[2] It has also been sued for making available thumbnails of photographs, photographs that it has scanned and then makes available.[3] There have been three lawsuits. In one of those lawsuits, the French court determined that the law of the country of origin of the communication (the United States) applied, and then held that the making available of the works in question was fair use.[4] But in one of the other two cases, the court applied the law of the country to

2. Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, 3e ch., Dec. 18, 2009, 09/00540, *available at* http://www.juriscom.net/documents/tgiparis20091218.pdf.

3. Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, 3e ch., May 20, 2008, 05/12117, *available at* http://www.juriscom.net/jpt/visu.php?ID=1067.

4. *Id.*

which the communication was sent, France.[5] In the other case—the book-scanning case—the court held that France was the country with the most significant relationship to the controversy, not only because the works were received in France, and read by French viewers, but because the plaintiffs in the case were French publishers; so, the works at issue were French works.[6] Counting up all the contacts, the court determined that France was the focus of the litigation, warranting application of French law. French law has no general fair use exception, and Google's provision of "snippets" of the scanned books did not meet the conditions of French copyright law's specific exceptions.

In the European Union generally, copyright exceptions are narrower and more specific than the rather open-ended, if somewhat uncertain, exception for fair use in the United States, specifically with respect to libraries and archives. The European Union Information Society Directive of 2001, which has now been implemented in all the member States' national laws, contains some exceptions pertinent to libraries and archives, but we'll see that they perhaps are not pertinent enough.[7] Member States are permitted to make exceptions to the reproduction right in respect of specific acts of reproduction made by publically accessible libraries, education establishments or museums, or by archives, which are not for direct or indirect economic or commercial advantage.[8] At first blush, the scope of these exceptions seems favorable, until one realizes that they cover only reproduction. But remote transmissions over the Internet implicate communications to the public, which is a different right. While there is an exception for communication, it does not go far enough for these purposes.[9] It provides that member States may make exceptions to the communication right for use by communication, or making available for the purpose of research or private study, to individual members of the public by dedicated terminals on the premises of establishments referred to in paragraph 2(c) (which concerns libraries, archives and so forth) of works and other subject matter which are contained in their collections and are not subject to purchase or licensing terms.[10]

In ordinary English, what does that mean? If the archive possesses the material by virtue of a license, it cannot override the license by application of this exception; but most importantly for the archive's purposes, the exception concerns only the making available on the premises, not to remote users. Thus, people can come into the library or archive and can see the work on terminals in the library or archives, which may also make internal transmissions within the premises, but this exception does not permit the transmission of works to users outside the library or archives;

5. Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, 3e ch., Oct. 9, 2009, *available at* http://www.legalis.net/jurisprudence-decision.php3?id_article=2776.

6. Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, 3e ch., Dec. 18, 2009, 09/00540, *available at* http://www.juriscom.net/documents/tgiparis20091218.pdf.

7. Council Directive 2001/29/EC, 2001 O.J. (L 167) 10 [hereinafter Information Society Directive].

8. Information Society Directive, *supra* note 7, at 10, 16.

9. *Id.*

10. *Id.* at 10, 17.

in other words, not to users located, for example, at home or in offices, at remote universities and so forth. As a result, if the copyright law of an E.U. member State applies, the library or archive may well have a problem. Under what circumstances will E.U. law apply?

If the Google cases are any indication, making available U.S. works to European viewers may not result in the application of the law of France or Germany or so forth, notwithstanding the receipt in those countries, if it seems that U.S. law bears the most significant relationship to a controversy involving an American archive making American works available even outside the U.S. If, however, French material is made available to French viewers, French law may apply, and if it applies, the library or archives may not qualify for an exception.

The better news is that the practice, as Maria Pallante indicated, of extended collective licenses albeit not yet E.U. wide, is growing.[11] Thus, even in the absence of a specific exception, there may be improved prospects for a licensing practice.

To close on a more depressing note: what happens if the library or archives has made the material available, and the availability would violate local law, and a local jurisdiction has determined that local law does apply? To what remedies might the library or archives be subject? If the remedy is simply an injunction barring making the material available to that jurisdiction, the risks to the library or archive are tolerable. Indeed it might be desirable first to ascertain the risk of liability in certain jurisdictions and then block access from those jurisdictions by anticipation. This approach is possible because one can slice and dice the Internet geographically. Thus, the library or archive can either limit access proactively or in response to a court order.

A more problematic remedy, which the French trial court ordered in the Google book scanning case, was not only to require Google to stop making that material available to France, but also to purge the scanned books from Google's database in the United States.[12] That result, I believe, was probably wrong. I think that French law properly applied to the communication of the "snippets" to France, but not to the subsistence of the scanned books in the database in the United States. But even if an American court would not enforce that judgment—in other words, if Google didn't purge its database and then the French publishers were to seek enforcement from a U.S. court, that is not the end of the story, at least not for Google, because the French court issued its order subject to an *astreinte*. An *astreinte* is a sum of money that a party must pay for every day during which it does not obey the court's order. In the French Google Books case, the order was for 10,000 Euros a day. I am not suggesting that a French court would assess 10,000 Euros a day against an American archive, but it does suggest that a foreign judgment which may not be enforceable in the United States may nonetheless have some bite if the defendant has assets in the foreign jurisdiction. That is all the more reason to think

11. Maria Pallante, *Orphan Works, Extended Collective Licensing and Other Current Issues*, 34 COLUM. J. LAW & ARTS 23 (2010).

12. Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, 3e ch., Dec. 18, 2009, 09/00540, *available at* http://www.juriscom.net/documents/tgiparis20091218.pdf.

ahead of time about what the library or archives make available to certain jurisdictions.