Digitized images of works in the public domain: what rights vest in them? Analysis of the recent BGH Reiss-Engelhorn judgment - Part 1

Reiss-Engelhorn Museen

A few days ago the German Federal Court of Justice (BGH) released the **full text** of its recent judgment concerning protection of digitized versions of public domain images. The IPKat is delighted to host, in two posts, the analysis provided by **Tobias Lutzi** (Research Fellow at the University of Cologne) and **John Weitzmann** (General Counsel at Wikimedia Deutschland e. V. in Berlin) **[**here**]**, respectively.

Here's what Tobias writes:

"**The German Federal Court Strengthens the Legal Position of Museums Displaying Works in the Public Domain – or does it?**

The **German Federal Court of Justice** recently published the **full version** of its highly-anticipated decision on the publication of photographs of paintings held by a group of German museums on **Wikimedia Commons**. The case had raised several unresolved questions of German copyright law with regard to works in the public domain.

The courts of first and second instance had given favourable decisions to the claimant group of museums. The Federal Court's judgment confirms these decisions and seems to strengthen the legal position of the owners of paintings in the public domain. But as it refuses to address the most controversial aspect of the decision in appeal, the decision seems to leave the door wide open for future reconsideration of the latter.

The facts of the case

The case involved the (online) publication of 37 digital copies of paintings that are owned by rem (Reiss-Engelhorn Museen), a partly publicly-funded group of museums in the German city of Mannheim; the copyright of the paintings has expired in accordance with **§ 64 of the German**

Act on Copyright and Related Rights (UrhG). 17 of the copies were scans of photographs that had been taken by a professional photographer employed by the claimant; the other 20 were photos that the defendant had taken himself while visiting one of the museums.

The claimant group of museums, rem, had sought an injunction requiring the defendant to take down the files, arguing (a) that the photographs he had scanned enjoyed special protection under German law and (b) that the photographs he had taken himself were violating their rights in rem (no pun intended). After the claimant had won in first and second instance, the defendant – with the support of the German Wikimedia chapter, who were defending parallel proceedings in Berlin, which they had won in the second instance – appealed to the Federal Court.

The photographer's right to prevent the reproduction of their photographs of public-domain paintings

The defendant put forward two arguments for why he was allowed to scan the photographs that had been commissioned by the claimant. First, he argued that the photos were merely replicating the paintings and thus missed the threshold of **§ 72 UrhG**, which creates a neighbouring right for photographs. Second, he claimed that the provision did not apply to photographs the copyright of which has expired because the owners of paintings that have fallen into the public domain would otherwise be able to continue their exclusive exploitation via photographic reproductions.

The Federal Court was not convinced by either of these arguments. With regard to the threshold of § 72 UrhG, it confirmed the lower courts' decision according to which even the mere replication of a painting requires a significant amount of effort, which the provision aims to protect:

> [26] Taking a photograph of an (even two-dimensional) work requires [...] decisions of the photographer as to several artistic factors, including position, distance, angle, lighting, and framing [...]. The fact [...] that the photographer takes these decisions according to technical considerations and aims for an exact replication of the original does not deny the existence of a personal intellectual contribution. [own translation]

The Court held that the corresponding protection under § 72 UrhG also covers photographs of paintings that are no longer protected by copyright.

> [30] The protection of photographs under § 72 UrhG does not prevent the general public from accessing the work in the public domain [that has been photographed] because it only prohibits the reproduction of the photographs themselves [...]. [own translation]

This author finds it difficult to disagree with the Federal Court of Justice on this point. § 72 UrhG creates a neighbouring right precisely to protect the significant amount of labour and expertise that may go into the creation of a photograph, where said photograph fails to meet the threshold of an "intellectual creation" under **§ 2(2) UrhG**. While John, in his contribution here, is right to point out that the case law of the Federal Court does not require a particularly high amount of either labour or expertise, the photographic recreation of a painting seems to require both. Thus,

even though it is indeed a purely technical activity, it seems to fall squarely into the scope of this provision.

One may regret the unfortunate consequence that this allows the owner of a work which is no longer protected by copyright to continue to exploit it by creating a (protected) photographic copy while simultaneously restricting access to the (unprotected) original. But it seems to be a consequence that the German legislator was willing to accept when they created the sui generis right for photographs.

Whether a publicly funded museum should exploit this possibility is, of course, a different question entirely.

Kat in the public domain (Sophia Dumergue and her cat by Johann Zoffany)

The owner's right to prevent the taking of photographs of public-domain paintings

Arguably the stronger reason for the Federal Court's decision to be anticipated by German scholars was its take on the photographs that had been taken by the defendant himself.

The decision promised to shed a new light on a well-known controversy involving two senates of the Federal Court. While the Fifth Senate had held, in its two infamous Sanssouci decisions from 2011 and 2013 (**V ZR 45/10** and **V ZR 14/12**), that the owner of an immovable object has the right to prevent the exploitation of photographs thereof that could only be taken upon entering the property, the First Senate had, in an earlier decision, implicitly rejected this view (**I ZR 54/87**). This latter position is shared almost unanimously in German scholarship, which rightly emphasises that the question whether the owner of an object can prevent others from publishing an image thereof is a question of copyright, not property law – and, accordingly, must be subject to its limitations.

The present decision seemed to provide a welcome opportunity for the First Senate to address the Fifth Senate's jurisprudence and discuss the serious academic concerns over it, as the Court was asked to extend said jurisprudence to movable objects. Surprisingly, it refused to take this opportunity. Instead, the Court held that by taking and uploading the pictures, the defendant had violated his contract with the museum; he consequently owed damages to the claimant, which would take the form of removing the pictures he had uploaded to Wikimedia Commons.

While one may question whether in interpreting the contract between the claimant and the museum, the court has struck the right balance between the economic interests of the museum and the public's interest in having access to works in the public domain, the much more interesting question is this:

What happens if someone who is not bound by the visitor contract uploads photographs of the paintings?

Would the visitor who took the photographs have to compensate the museum for the resulting damage (provided that they can be identified)?

And more importantly, would the museum have any remedy against the uploader?

The answer to the second question, it seems, goes straight back to the question of whether the owner of a painting has a property right that allows them to prevent others from sharing an image of the object. As several of the photographs in question have indeed already been re-uploaded to Wikimedia Commons by other users, the Federal Court of Justice may soon get a second chance to answer it.

Still, with regard to its property-right dimension, the Federal Court's decision is as unsatisfying for academics as it is for those taking photographs in museums – who now face serious liability risks – and for the claimant group of museums itself – which, instead of being confirmed in its assertion of a widely interpreted property right, have, for now, been relegated to a contractual right vis-à-vis their visitors.

Ultimately, they may have scored nothing more than a pyrrhic victory."