Practice Point

‘Making citations’—mystery or mistranslation?
The Opinion of Advocate General Bot in Nintendo v BigBen

David Musker*

The language issue—‘Illustration’ or ‘Citation’?
As Advocate General Bot points out in his Opinion, the term used in the French translation of the Directive and Regulation in place of ‘making citations’ is ‘illustration’, which overlaps only minimally in meaning.

<table>
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<tbody>
<tr>
<td>acts of reproduction for the purposes of making citations</td>
<td>acts of reproduction for the purposes of making citations</td>
</tr>
<tr>
<td>or of teaching</td>
<td>or of teaching</td>
</tr>
<tr>
<td>actes de reproduction à des fins d’illustration ou d’enseignement</td>
<td>actes de reproduction à des fins d’illustration ou d’enseignement</td>
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</table>

David Stone points out that the German, Italian and Spanish versions of the provision are clearly similar to the English ‘citation’. Likewise the Danish and Romanian texts, whereas the Dutch resembles the French:

<table>
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<tr>
<th>DK</th>
<th>DE</th>
<th>IT</th>
<th>RO</th>
<th>PT</th>
<th>NL</th>
</tr>
</thead>
<tbody>
<tr>
<td>eftergørelse i citatøjemed eller til undervisningsbrug</td>
<td>die Wiedergabe zum Zweck der Zitierung oder zum Zweck der Lehre</td>
<td>agli atti di riproduzione necessari per le citazioni o per fini didattici</td>
<td>activităților de reproducere in scopul citării sau predării</td>
<td>actos de reprodução para efeitos de referência ou para fins didácticos</td>
<td>bestaande in reproductie ter illustratie of voor onderricht</td>
</tr>
</tbody>
</table>

As Stone says, ‘citation’ has a direct French equivalent term (‘citer’/‘citation’), and indeed the original 1993 Commission proposal6 (the point at which the reference to ‘citation’/‘illustration’ first appears) refers in its French text not to illustration but to citation. To add to the confusion, the parallel English text explanatory refers not to citation but to quotation.

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This article
- The European design laws exclude from infringement ‘acts of reproduction for the purposes of making citations or of teaching’. The interpretation of the former exception was recently referred to the Court of Justice (CJEU) from the OLG Düsseldorf (Joined Cases C-24/16 and C-25/16, Nintendo Co. Ltd v BigBen Interactive GmbH, BigBen Interactive S.A.), and considered by Advocate General Bot in an Opinion dated 1 March 2017.1 In his recent article ‘Design Law Misplayed in Nintendo AG Opinion’,2 David Stone explains the case and argues persuasively that the Advocate General’s interpretation of ‘making citations’ is over-broad.

- The purpose of the exemption for teaching is clear, and was well flagged up in the 1990 Commission Green Paper3 and the original 1993 Commission legislative proposals.4 The exemption for ‘citation’ is, however, a mystery and perhaps a mistake. This article attempts to explore its origins as a guide to its interpretation.

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1 ECLI:EU:C:2017:146.
4 C0M(93) 344 final-COD 464 re Art 13 and re Art 22.
5 Above, n 2.
6 COM (93) 342 final, 3 December 1993.
The history of the ‘citation and teaching’ exception

As any ‘use’ of a design infringes the rights of the proprietor, it is peculiar that only ‘acts of reproduction’, rather than all uses, are excepted. The peculiarity points to the historical origin of the provision in the 1986 Directive on Semiconductor Topographies, which (directly and/or via the UK design right system) influenced many aspects of the EU design laws.

The draft design laws in the 1990 Green Paper essentially followed that format:

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<tbody>
<tr>
<td>reproducing the design for the purpose of teaching design</td>
<td>the act of reproduction . . . for private purposes or for the sole purpose of evaluation, analysis, research or teaching</td>
</tr>
<tr>
<td>reproducing the design for the purpose of teaching design</td>
<td>l’acte de reproduction . . . à des fins privées ou à seule fin d’évaluation, d’analyse, de recherche ou d’enseignement</td>
</tr>
</tbody>
</table>

This in turn was seemingly derived from the Berne Convention Article 10 exception for copyright, enacted in Europe in 2001 as the Information Society Directive:

<table>
<thead>
<tr>
<th>Information Society Directive</th>
<th>Berne Convention Art 10</th>
</tr>
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<tbody>
<tr>
<td>use for the sole purpose of illustration for teaching . . .</td>
<td>the utilization, to the extent justified by the purpose, of literary or artistic works by way of illustration in publications, broadcasts or sound or visual recordings for teaching</td>
</tr>
</tbody>
</table>

Between the 1990 Green Paper and the 1993 Proposals for a Directive and a Regulation, the Commission apparently created a new act of non-infringement without analogues in other IP laws. Why did it use two essentially non-equivalent terms, (‘citation’ and ‘illustration’), but explain its purpose using different terms again? With no flagging or explanation that a free-standing defence of citation for all purposes was to be created, it is hardly surprising that contemporary commentators working forward from the Green Paper either ignored the change or assumed that citation/illustration were non-commercial acts, at one with teaching.

And, in fact, why would one need a right to reproduce for the purpose of citation? Articles 18 and 36(3)(e) of the Community Designs Regulation (CDR) use the term ‘citation’ to mean ‘naming and acknowledgement of the designer’, which is in line with its normal meaning in English. As the defence for use in citation and teaching requires that ‘mention is made of the source’, providing a purpose of citation, which is dependent on the act of citation, seems pointless. As for the purpose of illustration, surely, ‘illustration’ in a broad sense is precisely one of the uses of design by the designer. A broad reading of ‘illustration’ cannot avoid impinging on the rights of the designer, as Stone argues.

Larousse and the AG Opinion

It appears that, in not interpreting ‘illustration’ and ‘citation’ narrowly, the AG has really removed any
meaning the words have. The definition given in Larousse, cited by the AG, is:

\[ \text{a} \text{ction d'éclairer par exemples un développement abstrait, ce qui a valeur d'application, de vérification, de démonstration (act of clarifying, by means of examples, an abstract idea for purposes of application, verification and demonstration).} \]

As Stone points out, the Larousse definition is in fact not broad enough to underpin the AG’s conclusion on the facts of this referral.

The Larousse definition does however seem to include teaching within its breadth, for teaching is precisely an ‘act of clarifying, by means of examples, an abstract idea’. If that was the correct interpretation, the separate statutory non-infringement of ‘teaching’ would be redundant, which cannot be right. If ‘citation’ is a separate non-infringement act to ‘teaching’, the former should be construed so as to give it a meaning that does not make the latter redundant.

Is error the explanation?

In the absence of a reasonable explanation for the presence of ‘citation’ or ‘illustration’ as a separate non-infringement, and since (as Stone points out) there is evidence of other drafting and translation errors within the EU design laws, error seems to offer a probable explanation of the evolution of this defence.

It can be seen above that the Information Society Directive refers to ‘the sole purpose of illustration for teaching’. That is a reasonable abbreviation of the Berne Convention exception for ‘utilisation ... des œuvres littéraires ou artistiques à titre d’illustration de l’enseignement’.

The same phrase was eventually translated in the Information Society Directive as ‘utilisation à des fins exclusives d’illustration dans le cadre de l’enseignement’. Might it erroneously have been translated as ‘utilisation à des fins d’illustration ou d’enseignement’?

Or perhaps the error was made in another language. It would be even easier to have written ‘illustration or teaching’ in English instead of ‘illustration for teaching’, and then have substituted ‘citation’ for ‘illustration’.

Unfortunately, although there is a wealth of material explaining the changes to the Directive and Regulation after the initial 1993 Proposals, there is nothing public which takes us from the Green Paper to those initial Proposals.

Conclusion

There is no clear contextual or historical purpose to a separate ‘citation’ defence, let alone a broad ‘illustration’ defence. Rather than creating two defences, one fully explained and consistent with other IP laws and the other unexplained and inexplicable, it seems likelier to assume that the original legislative intention was to create a functioning defence for teaching by reproducing designs to illustrate instruction on design. One can only agree with Stone that the CJEU should resist being drawn too far down the path suggested by the AG. If the non-infringing act of ‘illustration’ exists, it should be construed narrowly.

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15 Ibid.
16 Ibid.
17 See for example Art 110 CDR as discussed in BMW v Round & Metal, [2012] EWHC 2099 (Pat), [2013] Bus LR D30, and the very un-aligned versions of Art 11 CDR.
18 Above n 2.
19 Ibid and also Stone, D., ‘A Cracker Year to Come in Designs Cases’, ManagingIP.com, April 2017 at p. 56.