Practice Point

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

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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 Paper[3] 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.

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.

Directive 98/71 Art 13(1)(c)	Regulation 6/2002 Art 20(1)(c)
acts of reproduction for the purposes of making citations or of teaching	acts of reproduction for the purposes of making citations or of teaching
actes de reproduction à des fins d'illustration ou d'enseignement	actes de reproduction à des fins d'illustration ou d'enseignement

David Stone points out that the German, Italian and Spanish versions of the provision are clearly similar to the English 'citation'.[5] Likewise the Danish and Romanian texts, whereas the Dutch resembles the French:

DK	eftergørelse i *citatøjemed* eller til undervisningsbrug
DE	die Wiedergabe zum Zweck der *Zitierung* oder zum Zweck der Lehre
IT	agli atti di riproduzione necessari per le *citazioni* o per fini didattici
RO	activităţilor de reproducere în scopul *citării* sau predării
PT	actos de reprodução para efeitos de *referência* ou para fins didácticos
ES	los actos de reproducción realizados con fines de *ilustración* o docentes
NL	bestaande in reproductie ter *illustratie* of voor onderricht

As Stone says, 'citation' has a direct French equivalent term ('citer'/'citation'), and indeed the original 1993 Commission proposal[6] (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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1 ECLI:EU:C:2017:146.

2 *Journal of Intellectual Property Law & Practice*, Volume 12, Issue 7, 1 July 2017, pp. 558–564, https://doi.org/10.1093/jiplp/jpx101; the author thanks Mr Stone for sight of this article in draft.

3 Green Paper on the Legal Protection of Industrial Design. Working document of the services of the Commission. III/F/5131/91-EN, June 1991, paras 6.4.7.1–6.4.7.2.

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.

doi:10.1093/jiplp/jpx151

Subparagraph (c) contains a provision on fair use as regards educational use or *quotations*	Le point c) contient une disposition sur l'utilisation du dessin ou du modèle de bonne foi en vue de l'enseignement ou à titre de *citation* . . .

The history of the 'citation and teaching' exception

As any 'use' of a design infringes the rights of the proprietor,[7] it is peculiar that only 'acts of reproduction', rather than all uses, are excepted.[8] The peculiarity points to the historical origin of the provision in the 1986 Directive on Semiconductor Topographies,[9] which (directly and/or via the UK design right system) influenced many aspects of the EU design laws.

Semiconductor Topography Directive 87/54 Art 5.3	**Treaty on Intellectual Propertyin Respect of Integrated Circuits, Washington, 26 May, 1989**
reproduction for the purpose of analyzing, evaluating or *teaching* the concepts, processes, systems or techniques embodied in the topography or the topography itself.	the act of *reproduction* . . . *for* private purposes or for the sole purpose of evaluation, analysis, research *or teaching*
la *reproduction* aux fins d'analyse, d'évaluation *ou d'enseignement* des concepts, procédés, systèmes ou techniques incorporés dans la topographie ou de la topographie elle-même	l'acte de *reproduction* . . . à des fins privées ou à seule fin d'évaluation, d'analyse, de recherche *ou d'enseignement*

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

Green Paper Directive Draft Art 10	**Green Paper Regulation Draft Art 19**
reproducing the design for the purpose of *teaching design.*	*reproducing* the design for the purpose of *teaching design.*

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:[10]

Information Society Directive	**Berne Convention Art 10**
use for the sole purpose of *illustration for teaching* . . .	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*
utilisation à des fins exclusives *d'illustration dans le cadre de l'enseignement* . . .	*d'utiliser* licitement, dans la mesure justifiée par le but à atteindre, des œuvres littéraires ou artistiques *à titre d'illustration de l'enseignement* par le moyen de publications, d'émissions de radiodiffusion ou d'enregistrements sonores ou visuels

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.[11]

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)[12] use the term 'citation'[13] 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.[14]

Larousse and the AG Opinion

It appears that, in not interpreting 'illustration' and 'citation' narrowly, the AG has really removed any

7 Directive 98/71 Art 12(1), Regulation 6/2002 Art 19(1), Musker, D.

8 See Ohlgart, D.C. in Franzosi, M. *European Design Protection* (Kluwer, 1996) p. 144; Suthersanen, U., *Design Law in Europe*, London: Sweet & Maxwell, 2000 at para 6-087, p. 50.

9 Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products.

10 Directive 2001/29 Art 5.3(a).

11 See Musker *Community Design Law* at 1-133, p. 69, Cohen, D. *Le Droit des dessins et modeles* at para 283, p. 75, Suthersanen and Ohlgart at note 8 *supra.*

12 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs.

13 In the English text; the French text translates this as "designation" of the designer.

14 Above n 2.

meaning the words have. The definition given in Larousse, cited by the AG, is:

> [a]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,[15] 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[16]) there is evidence of other drafting and translation errors within the EU design laws,[17] 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 … of artistic works … by way of *illustration … for teaching*'.

Suppose, then, that this part of the laws was drafted or redrafted in French. It would seem reasonable to use the Berne Convention as a model, and start with the phrase 'd'utiliser licitement … 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[18] 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.[19]

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.