



ICLG

The International Comparative Legal Guide to:

Copyright 2017

3rd Edition

A practical cross-border insight into copyright law

Published by Global Legal Group, in association with Bird & Bird LLP

With contributions from:

Atsumi & Sakai

Bereskin & Parr LLP

Deep & Far Attorneys-at-Law

Dumont Bergman Bider & Co., S.C.

East & Concord Partners

Goroditsky & Partners (Ukraine)

Güzeldere & Balkan Law Firm

Hamdan AlShamsi Lawyers & Legal Consultants

HOYNG ROKH MONEGIER

J Pereira da Cruz

KG Law Firm

LPS L@w

Meisser & Partners AG

MinterEllison

Pereira da Cruz e Associados, R.L.

S. P. A. Ajibade & Co.

Schwärzler Attorneys at Law

Sheppard Mullin Richter & Hampton LLP

SyCip Salazar Hernandez & Gatmaitan

Tay & Partners

Tilling Peters LLC

Weisselberg Avocat



global legal group

Contributing Editor

Phil Sherrell,
Bird & Bird LLP

Sales Director

Florjan Osmani

Account Directors

Oliver Smith, Rory Smith

Sales Support Manager

Paul Mochalski

Senior Editor

Rachel Williams

Chief Operating Officer

Dror Levy

Group Consulting Editor

Alan Falach

Group Publisher

Richard Firth

Published by

Global Legal Group Ltd.
59 Tanner Street
London SE1 3PL, UK
Tel: +44 20 7367 0720
Fax: +44 20 7407 5255
Email: info@glgroup.co.uk
URL: www.glgroup.co.uk

GLG Cover Design

F&F Studio Design

GLG Cover Image Source

iStockphoto

Printed by

Ashford Colour Press Ltd
October 2016

Copyright © 2016

Global Legal Group Ltd.

All rights reserved

No photocopying

ISBN 978-1-911367-17-8

ISSN 2056-4333

Strategic Partners



General Chapter:

1	Implications of Brexit for English Copyright Law – Will Smith & Phil Sherrell, Bird & Bird LLP	1
---	---	---

Country Question and Answer Chapters:

2	Angola	J Pereira da Cruz: Maria João Nunes & Nuno Cruz	6
3	Australia	MinterEllison: John Fairbairn & Emily Hawcroft	11
4	Canada	Bereskin & Parr LLP: Jill Jarvis-Tonus	17
5	China	East & Concord Partners: Charles (Chao) Feng	24
6	France	Weisselberg Avocat: Elise Weisselberg	30
7	Germany	HOYNG ROKH MONEGIER: Thomas H. Schmitz & Mathis Breuer	35
8	Greece	KG Law Firm: Irene Kyriakides & Panagiota (Julie) Vasileiadou	40
9	Japan	Atsumi & Sakai: Chie Kasahara & Reina Kanemura	46
10	Liechtenstein	Schwärzler Attorneys at Law: Dr. Alexander Amann	52
11	Malaysia	Tay & Partners: Lin Li Lee & Kah Yee Chong	57
12	Mexico	Dumont Bergman Bider & Co., S.C.: Laura Collada & Jonathan Rangel	65
13	Mozambique	J Pereira da Cruz: Maria João Nunes & Nuno Cruz	71
14	Nigeria	S. P. A. Ajibade & Co.: John C. Onyido & Yetunde Okojie	77
15	Philippines	SyCip Salazar Hernandez & Gatmaitan: Vida M. Panganiban-Alindogan & Enrique T. Manuel	83
16	Portugal	Pereira da Cruz e Associados, R.L.: João Sardinha & Nuno Cruz	91
17	Russia	Tilling Peters LLC: Elena Buranova & Ekaterina Tilling	97
18	Senegal	LPS L@w: Léon Patrice Sarr & Ndèye Khady Youm	104
19	Switzerland	Meisser & Partners AG: Dr. iur. Marco Bundi & Benedikt Schmidt	109
20	Taiwan	Deep & Far Attorneys-at-Law: Yu-Li Tsai & Lu-Fa Tsai	114
21	Turkey	Güzeldere & Balkan Law Firm: Altuğ Güzeldere & Didem Ataün	120
22	Ukraine	Gorodissky & Partners (Ukraine): Nina Moshynska & Oleg Zhukhevych	129
23	UAE	Hamdan AlShamsi Lawyers & Legal Consultants: Dr. Ghandy Abuhawash	135
24	United Kingdom	Bird & Bird LLP: Rebecca O’Kelly-Gillard & Phil Sherrell	140
25	United States	Sheppard Mullin Richter & Hampton LLP: Edwin Komen & Theodore C. Max	146

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

Switzerland

Meisser & Partners AG

Dr. *iur.* Marco Bundi



Benedikt Schmidt



1 Copyright Subsistence

1.1 What are the requirements for copyright to subsist in a work?

There are no formal requirements for a work to be protected. Rather, as soon as a work is created and qualifies under the Federal Act on Copyrights and Related Rights (Copyright Act, CopA), it enjoys protection (Art. 29 (1) CopA). Works that may enjoy protection under the Act are defined as literary and artistic intellectual creations with an individual character, irrespective of their value or purpose (Art. 2 (1) CopA). The critical criterion is the individual character.

1.2 On the presumption that copyright can arise in literary, artistic and musical works, are there any other works in which copyright can subsist and are there any works which are excluded from copyright protection?

The term “work” is to be understood in a very broad way. Any literary or artistic creation can be protected. The law includes a non-exhaustive positive list, including linguistic, acoustic, visual and audio-visual works, works of art, scientific or technical works, works of applied art, choreographic works, works of mime and computer programs (Art. 2 (2) and (2) CopA). Also derivative works being intellectual creations with an individual character that are based upon pre-existing works whereby the individual character of the latter remains identifiable as well as collections are protectable (Art. 3 and 4 CopA).

Works that are expressly excluded from copyright protection are acts, ordinances, international treaties and other official enactments, means of payment, decisions, minutes and reports issued by authorities and public administrations and patent specifications and published patent applications (Art. 5 (1) CopA).

1.3 Is there a system for registration of copyright and if so what is the effect of registration?

No, there is no system for registering copyrights in Switzerland as they enjoy protection once created. Proof of authorship can be supported by a statement of a Notary Public. Musical and audio-visual works can be enrolled by members with the collecting society in charge. A common way to verify authorship is sending a letter with the work by post to oneself. However, a preferable way is notarisation, as it is inexpensive and made by a person with authority.

1.4 What is the duration of copyright protection? Does this vary depending on the type of work?

Protection expires 70 years after the death of the author for all works except for computer programs, for which protection expires 50 years after the death of the author (Art. 29 (2) CopA). Where it has to be assumed that the author has been dead for more than 50 or 70 years respectively, protection no longer applies (Art. 29 (3) CopA). Protection for related rights ends 50 years after the performance, publication, production or transmission (Art. 39 (1) CopA).

1.5 Is there any overlap between copyright and other intellectual property rights such as design rights and database rights?

While there is no overlap with patent rights, there can be an overlap with trademark rights and design rights, given their different protection prerequisites. In particular, logos and other artworks or three dimensional designs can enjoy protection under the different acts. As design registration is inexpensive, easy and fast (no material examination), it can be worth registering an artwork as a design to obtain an initial formal certificate of IP-protection. However, and since design registrations may be challenged more easily (prior forms) and are limited to 25 years of protection, trademark rights and copyrights may be more attractive, but also have a higher threshold.

In addition, copyrightable works can be protected under the Federal Act Against Unfair Competition (UCA). For example, databases can enjoy protection under both the CopA (as a collection) and under the UCA.

1.6 Are there any restrictions on the protection for copyright works which are made by an industrial process?

No, as long as the work is created by a human being, there are no restrictions. The process of creation requires the mental activity of a human being (irrespective of the mental state), materialising in a perceptible work. If a work emerges purely and merely by an industrial process, without any influence of a human being, it would not qualify as copyrightable work.

2 Ownership

2.1 Who is the first owner of copyright in each of the works protected (other than where questions 2.2 or 2.3 apply)?

Unlike the registered rights, the copyright law is governed by the “creation principle”. Whoever creates a work is the author and first owner of the copyright. It is compulsory that the work is created by a natural person. The presumption of authorship states that, unless otherwise proven, the author is the person whose name, pseudonym or distinctive sign appears on copies or the publication of the work (Art. 8 (1) CopA).

2.2 Where a work is commissioned, how is ownership of the copyright determined between the author and the commissioner?

The author is the first owner of the copyright. Copyrights are assignable (Art. 16 (1) CopA; except of some moral rights) and, therefore, depending on the specific agreement between the parties, some rights are generally assigned to the commissioner. It is important to note that the assignment of rights is, as a legal presumption, limited to those rights that are explicitly regulated in the agreement between the parties (Art. 16 (2) CopA) or, if nothing further was agreed upon, to the rights that are necessary for the commissioner to achieve the purpose of the agreement (“principle of assignment limited to the purpose”). Hence, and for the commissioner, it is highly advisable to clearly regulate and assign the rights in a sufficiently broad way.

2.3 Where a work is created by an employee, how is ownership of the copyright determined between the employee and the employer?

The employee is, in principle, the author and first owner of the copyright. The CopA provides for a legal exception of this principle for computer programs. In this event, the employer alone is entitled to exercise the exclusive rights of use in the case where the employee created computer software under the employment contract in the course of discharging professional duties of fulfilling contractual obligations (Art. 17 CopA for computer programs). While the Swiss Code of Obligations includes similar provisions with respect to the rights to inventions and designs, there is no regulation with respect to copyrights. As such, the copyrights to works other than computer programs need to be assigned by the employee to the employer. This is typically done within the employment contract. However, general assignments have to be interpreted restrictively (see question 2.2 above). Hence, it is highly advisable to clearly regulate the scope of assignments, typically in the employment contract.

2.4 Is there a concept of joint ownership and, if so, what rules apply to dealings with a jointly owned work?

Joint authorship is possible. Where two or more persons have contributed as authors to the creation of a work, the copyright belongs to all such persons jointly (Art. 7 (1) CopA). Unless they have agreed otherwise, they may only use the work with the consent of all authors. However, the consent may not be withheld for reasons contrary to the principle of good faith (Art. 7 (2) CopA).

Each author may independently bring an action for infringement (Art. 7 (3) CopA). Only where the individual contributions may be separated, each joint author may use his own contribution independently, as long as the use does not impair the exploitation of the joint work (Art. 7 (4) CopA).

3 Exploitation

3.1 Are there any formalities which apply to the transfer/assignment of ownership?

No, assignments of copyrights may be concluded even orally. There is no formal agreement required. However, for proof purposes and especially for the assignee, it is highly advisable to enter into a written agreement.

3.2 Are there any formalities required for a copyright licence?

Again, there are no formalities required.

3.3 Are there any laws which limit the licence terms parties may agree (other than as addressed in questions 3.4 to 3.6)?

The CopA provides for a compulsory licence for a musical work for the manufacture of phonograms under certain circumstances (Art. 23 CopA). Furthermore, there can be limitations based on competition laws including antitrust law and the Federal Act against Unfair Competition.

3.4 Which types of copyright work have collective licensing bodies (please name the relevant bodies)?

There are collective licensing bodies for many types of works, such as SUIA for musical works (<http://www.suisa.ch/>), SUISSIMAGE for visual and audio-visual works (<https://www.suissimage.ch/>), SSA for stage works, fictional radiophonic works and audio-visual works (<https://www.ssa.ch/>), ProLitteris for literature, visual arts and photography (<http://prolitteris.ch/>), and SWISSPERFORM for related rights (<http://www.swissperform.ch/>).

3.5 Where there are collective licensing bodies, how are they regulated?

These collective licensing bodies are regulated in Art. 40 *et sub.* CopA. They are subject to federal supervision and require the authorisation from the Swiss Federal Institute of Intellectual Property (IPI). Authorisation is granted for five years and can be renewed. They have the obligation to assert those rights that fall within their field of activity. They are required to conduct their business in accordance with proper business management principles, but they may not aim to make a profit. They shall publish tariffs for remuneration, which are subject to the approval by the Federal Arbitration Commission. They shall draw up distribution regulations, which are subject to approval by the supervisory authority (IPI). A portion of the proceeds may be used for social welfare purposes and for the appropriate promotion of culture. The IPI can take necessary measures in the case that the collective licensing body does not comply with its obligations.

3.6 On what grounds can licence terms offered by a collective licensing body be challenged?

The tariffs in its structure and individual provisions have to be fair and reasonable (Art. 59 (1) CopA) and respect the principle of equitableness. If they are not, tariffs approved by the Federal Arbitration Commission can be appealed at the Federal Administrative Court. Decisions of the Federal Administrative Court can be appealed at the Federal Supreme Court.

4 Owners' Rights

4.1 What acts involving a copyright work are capable of being restricted by the rights holder?

The rights holder has the exclusive right to decide whether, when and how his work is used (including producing copies, distributing copies, performing a work, broadcasting a work or making available a work). He can ask the authorities to prohibit any imminent infringement, remedy an existing infringement, require the defendant to provide information on the origin and quantity of infringing items, ask for damages, ask for customs assistance or ask for criminal prosecution.

4.2 Are there any ancillary rights related to copyright, such as moral rights, and if so what do they protect, and can they be waived or assigned?

The copyright can be divided in many partial rights, including moral rights. Moral rights include the recognition of authorship (Art. 9 (1) CopA), the right of first publication (Art. 9 (2) CopA), the integrity of the work (Art. 11 (2) CopA), the author's right of access and exhibition (Art. 14 CopA) and the protection against destruction (Art. 15 CopA).

It is possible to waive or assign some of the moral rights. According to the doctrine and case law, the recognition of authorship can be waived to a certain extent but not assigned, the right of first publication can be waived and assigned, the integrity of the work can be waived to the extent that the altered work is not a violation of the author's personal rights but not assigned, the author's right of access and exhibition can be waived and assigned and the protection against destruction can be waived and assigned.

4.3 Are there circumstances in which a copyright owner is unable to restrain subsequent dealings in works which have been put on the market with his consent?

In Switzerland, the principle of international exhaustion of copyrights was confirmed by the Supreme Court with respect to the specific physical copies of the work (Art. 12 CopA). Hence, it is not possible for the copyright owner to block parallel imports of physical copies of the work. However, copies of audio-visual works (movies, DVDs) may not be further transferred or rented, as long as the author is thereby impaired in exercising his right of performance, which was introduced to protect cinemas.

5 Copyright Enforcement

5.1 Are there any statutory enforcement agencies and, if so, are they used by rights holders as an alternative to civil actions?

The only way to enforce the rights is through civil courts, criminal courts or customs. Criminal prosecution is initiated *ex officio* in case of an act for commercial gain. Customs authorities may suspend the import, export or transit of suspicious goods *ex officio*.

5.2 Other than the copyright owner, can anyone else bring a claim for infringement of the copyright in a work?

Besides the copyright owner, the exclusive licensee is entitled to file a separate action, unless such right is expressly excluded in the licence agreement (Art. 62 (3) CopA). The collective rights management organisations may also file a claim in their fields of activity.

5.3 Can an action be brought against 'secondary' infringers as well as primary infringers and, if so, on what basis can someone be liable for secondary infringement?

Yes, "secondary infringers" can be sued if they also caused the infringement or participated thereon, such as instigators, perpetrators, and accomplices or, under certain circumstances, beneficiaries, including host-providers for example.

5.4 Are there any general or specific exceptions which can be relied upon as a defence to a claim of infringement?

There is the parody exception (Art. 11 (3) CopA) and there is a catalogue of exceptions to copyright (Art. 19 *et seq.* CopA), including private use in the sense of personal use of a work or use within a circle of persons closely connected (relatives, friends) (not applicable to computer software), backup copies, temporary copies, quotations, works on premises open to the public or reporting of current events. Further, and since the threshold for the individual character is rather high, a defence could be that the work does not qualify for copyright protection. Also, it may be difficult to prove ownership of the copyright by the Plaintiff, so lack of legitimation could be another defence.

5.5 Are interim or permanent injunctions available?

Yes, such injunctions are available. An interim injunction has to be filed with the competent Civil Court. The Court orders interim measures if the applicant provides *prima facie* evidence that a right to which he or she is entitled to has been violated or a violation is anticipated and the violation threatens to cause not easily repairable harm to the applicant.

5.6 On what basis are damages or an account of profits calculated?

The assessment of financial compensation regularly proves to be difficult. The amount is either based on the actual loss of profits proven by the Plaintiff or estimated at the discretion of the

Court based on the method of licence analogy or analogy to the account of profits. Generally, the threshold for obtaining financial compensation is rather high and damages are usually not very high, and Plaintiffs often focus on injunctions and recovering the compensation for court and legal fees.

5.7 What are the typical costs of infringement proceedings and how long do they take?

The financial risks of ordinary proceedings in the first instance are between CHF 30,000–50,000 (including court fees, attorneys' fees, and party compensation). The prevailing party can claim party compensation which is typically slightly lower than the actual fees and expenses. The losing party has to bear the Court fees, its own fees and pay party compensation to the prevailing party.

Generally, it takes about one to three years for obtaining a judgment in ordinary proceedings in the first instance.

5.8 Is there a right of appeal from a first instance judgment and if so what are the grounds on which an appeal may be brought?

As only High Courts or Commercial Courts (depending on the venue and Canton) judge such conflicts, an appeal may only be brought to the Federal Supreme Court. The grounds of appeal are mainly restricted to the infringement of federal law. A wrong establishment of the facts of the case can only be challenged if it was "obviously not correctly" interpreted.

5.9 What is the period in which an action must be commenced?

Ordinary actions can be brought any time before the Court until the rights are forfeited. Interim measures should be filed within three months from the date of knowledge of the infringement. However, there is no legal term in the law. The longer the Plaintiff waits, the higher the risk that the judge states that there was no urgency for issuing such measures.

6 Criminal Offences

6.1 Are there any criminal offences relating to copyright infringement?

The criminal provisions are set out in Art. 67 et sub. CopA. Copyright infringement (Art. 67 CopA), omission of source (Art. 68 CopA), infringement of related rights (Art. 69 CopA), offences relating to technical protection measures and rights-management information (Art. 69a CopA) and unauthorised assertion of rights (Art. 70 CopA) are criminal and punishable offences.

6.2 What is the threshold for criminal liability and what are the potential sanctions?

It is required that the crime has been committed wilfully. A person acts wilfully as soon as he regards the realisation of the act as being possible and accepts this. Depending on the criminal act, and in cases of commercial gain, the penalty may be a custodial sentence not exceeding five years or a monetary penalty. However, in practice, mostly monetary penalties are issued (although such criminal cases are rather rare).

7 Current Developments

7.1 Have there been, or are there anticipated, any significant legislative changes or case law developments?

The Swiss Federal Council indeed currently wishes to modernise the copyright law. The new project includes more efficient measures to combat internet piracy without criminalising the users of such services and the adoption of the law to the latest technological developments (internet TV, streaming services, etc.). Still, the download of copyrighted works for private use shall remain legal, despite international critics (e.g. Watch List 2016 of the Special 301 Report). The Federal Council submitted a draft amendment of the Copyright Act for consultation on December 11, 2015.

The Federal council also published a report on resale rights and is of the opinion that there is no need to introduce any resale right into legislation.

7.2 Are there any particularly noteworthy issues around the application and enforcement of copyright in relation to digital content (for example, when a work is deemed to be made available to the public online, hyperlinking, etc.)?

The Federal Council published a report on the civil liability of providers on December 11, 2015, which summarises the case law and doctrine and contributes to legal development and legal security. The use of hyperlinks is not an issue (as long as they are not "embedded"). If the links are used to lead to infringing content, then the domain owner could be punished for aiding and abetting.

**Dr. iur. Marco Bundi**

Meisser & Partners AG
Schulstrasse 1
7302 Landquart
Switzerland

Tel: +41 81 410 23 23
Email: bundi@swisstm.com
URL: www.swisstm.com

Marco Bundi studied law in Zurich. He was admitted to the Bar in 2005 and subsequently joined the Swiss Bar Association. He practised law before the cantonal courts before obtaining his LL.M. from the University of Bern. He joined Meisser & Partners AG in 2006, after working at the UN Special Court in Sierra Leone. He writes on various aspects of trademark law and regularly contributes to *GRUR* and *World Trademark Review*. He obtained his doctorate from the University of Bern in 2008 and became a notary public in 2014. His practice covers IP rights enforcement, including domain disputes, unfair competition issues (including counterfeiting and passing off) and proceedings before national authorities and courts. He became a partner in 2012.

**Benedikt Schmidt**

Meisser & Partners AG
Bahnhofstrasse 8
7250 Klosters
Switzerland

Tel: +41 81 410 23 23
Email: schmidt@swisstm.com
URL: www.swisstm.com

Benedikt Schmidt studied law in Zurich and Paris, was admitted to the Bar in 2004 and subsequently joined the Swiss Bar Association. He joined Meisser & Partners in 2005 and became a partner in 2012. His practice includes counselling on registrability and enforcement of IP rights, anti-counterfeiting, domain disputes, protection against unfair competition and copyrights. He regularly represents clients in proceedings before national authorities and courts. He writes on various aspects of trademark law and regularly contributes to *GRUR*. He was a lecturer at the Swiss Public Relations Institute and is a member of the Swiss Bar Association, INGRES, INTA and PTMG.



Meisser & Partners AG is a boutique law firm established in 1979 which provides IP prosecution and litigation services. The firm consists of a team of a dozen professionals (attorneys-at-law, paralegals, secretaries) and represents local and foreign clients in Switzerland, including in the fields of tobacco, pharmaceuticals, cosmetics, tourism, financial services, stock exchange indices, IT services, food, textiles, sporting goods, supermarkets, technical products and names of celebrities. Further information about the firm, publications and fees is available at www.swisstm.com.

Current titles in the ICLG series include:

- Alternative Investment Funds
- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Competition Litigation
- Construction & Engineering Law
- Copyright
- Corporate Governance
- Corporate Immigration
- Corporate Investigations
- Corporate Recovery & Insolvency
- Corporate Tax
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment & Climate Change Law
- Family Law
- Franchise
- Gambling
- Insurance & Reinsurance
- International Arbitration
- Lending & Secured Finance
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- Mining Law
- Oil & Gas Regulation
- Outsourcing
- Patents
- Pharmaceutical Advertising
- Private Client
- Private Equity
- Project Finance
- Public Procurement
- Real Estate
- Securitisation
- Shipping Law
- Telecoms, Media & Internet
- Trade Marks



59 Tanner Street, London SE1 3PL, United Kingdom
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255
Email: sales@glgroup.co.uk

www.iclg.co.uk