La Société des Auteurs des arts visuels et de l'Image Fixe (SAIF) v. Google: A Parisian Story of the Berne Convention and Online Infringement Claims

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The application of national law to commercial activity and speech on the Internet has generated increasingly complex and, in some instances, inconsistent legal doctrines. Adding to the growing body of law around the globe in this area, the Paris Court of Appeal recently authored its 2011 decision in *La Société des Auteurs des arts visuels et de L'image Fixe (SAIF) v. Google France, S.A.R.L., and Google Inc.*[1] *("SAIF v. Google")*. The case provides an interesting view into the difficulties of determining how to regulate conduct on the Internet, and how various jurisdictions are and are not substantively protecting creative content that increasingly can be copied and distributed online.

The French dispute began as several have in the United States, when a protector of content, in this case SAIF, alleged in 2005 that Google should be held liable for infringement by displaying SAIF's copyrighted small online ("thumbnail") images on the Google website. SAIF complained specifically about the *google.fr* and *images.google.fr* websites and filed a lawsuit in France. Despite the French venue, the Paris Civil Court of First Instance utilized the Berne Convention to apply United States copyright law to the dispute. The Paris Court of Appeal overturned that choice-of-law analysis, however, finding French law applicable, but nevertheless finding no infringement by Google.

A brief analysis of *SAIF v. Google* and its implications begins below with a discussion of the parameters of the copyright dispute regarding display of copyrighted images by internet search engines and includes a brief review of applicable U.S. law. This article then outlines the decision by a lower French court to apply the U.S. Copyright Act and discusses the subsequent Paris Court of Appeal decision reversing that application of U.S. law, and applying French law instead. This article ends with a short conclusion that, not surprisingly, suggests further development of the law in this area is in our future, in both the United States and France.

I. BACKGROUND

A. Use of Copyrighted Images by Internet Search Engines

A number of copyright infringement disputes have arisen over internet search engines displaying copyrighted images in users' search results. These images can be displayed in the form of both small "thumbnail" images and as "in-line" linked images.

"Thumbnail" images are typically small, low-resolution reproductions of full-sized images. Search engines use automated internet crawlers to locate images on websites and to download copies of those images into a database maintained by the search engine operator. In response to user searches, relevant downloaded images are then displayed on the search engine's website in "thumbnail" format.

"In-line" linking, on the other hand, displays full-sized images that appear to be incorporated into the search engine's own website. These linked images are not downloaded to the search engine's server, but they appear to be so because they are framed by text and other information generated by the search engine. "In-line" links are often used to display full-sized images when a user enlarges a "thumbnail" image on a search engine's website.

The question that has arisen under both U.S. and international law is whether search engine use of such images, either in thumbnail or linked format, infringes the copyright owners' exclusive rights to display and/or reproduce their works. To date, however, case law in this area may have produced more questions than answers.

B. U.S. Case Law Prior to *SAIF v. Google*

The U.S. Copyright Act, codified as Title 17 of the U.S. Code, controls determination of copyright infringement under U.S. law. The Copyright Act provides the owner of a copyright the exclusive right to reproduce, distribute, and publicly display copies of the work.[2] To prove copyright infringement, a plaintiff must show both ownership of the copyright and copying by the alleged infringer.[3]

However, the Fair Use Doctrine, codified at 17 U.S.C. Section 107, dictates that "the *fair use* of

a copyrighted work . . . is not an infringement of copyright."[4] 'Fair use' is described by the statute as use for the purpose of "criticism, comment, news reporting, teaching . . ., scholarship, or research."[5] Under the statute, a determination of 'fair use' depends on four factors: "(1) the purpose and character of the use . . . ; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."[6]

Prior to *SAIF v. Google*, two key cases decided by the Ninth Circuit Court of Appeal attempted to define the applicability of the Fair Use Doctrine to copyrighted images displayed by internet search engines:

1. Kelly v. Arriba Soft Corporation (2003)

In 2003's *Kelly v. Arriba Soft Corporation*, Kelly, a professional photographer, brought claims against an internet search engine for displaying his copyrighted photographs in the form of both thumbnail views and in-line linked images.[7] The District Court granted summary judgment to the search engine with respect to both types of images. The Ninth Circuit Court of Appeal then affirmed with respect to the thumbnail images, but reversed the decision as to the linked images and remanded for further consideration of that issue. The Court of Appeal held that Arriba's use of thumbnail versions of copyrighted images fell within the 'fair use' exception to copyright infringement, mainly on the basis of the first and fourth statutory factors:

- As to the first factor ("the purpose and character of the use"), the Court of Appeal found the purpose and character of the use to be transformative in serving an informational rather than an artistic function, and the Court of Appeal additionally determined that the use was not highly exploitative and that the search engine presented a significant public benefit.

- As to the fourth factor ("the effect of the use upon the potential market for or value of the copyrighted work"), the Court of Appeal found the thumbnail images did not harm the market for Kelly's images.

Because these factors weighed heavily in favor of Arriba, the Court of Appeal affirmed summary judgment for the defendant search engine company.

2. Perfect 10, Inc. v. Amazon.com (2007)

Four years later, in 2007's *Perfect 10, Inc. v. Amazon.com ("Perfect 10")*,[8] the Ninth Circuit Court of Appeal revisited the issue of copyright infringement in the context of internet search engines. Perfect 10, Inc. sued both Google and Amazon, seeking to preliminarily enjoin Google's search engine from displaying thumbnail and in-line linked images retrieved from Perfect 10's website. The Ninth Circuit Court held that in-line linking was not a direct infringement of the copyright owner's right to display copyrighted material because the search engine never actually downloaded the image. In addition, the Court determined that linking did not infringe the copyright owner's right to distribute the images because the search engine was not actually communicating the image to the user's computer.

With respect to thumbnail images, the Court adopted its prior reasoning in *Kelly*, holding that Google's display of thumbnail images constituted 'fair use' because the use was highly transformative, provided a public benefit, and did not harm Perfect 10's market for exploiting its copyrighted images. The Ninth Circuit Court then remanded to the District Court for further proceedings regarding Perfect 10's claims that Amazon and Google should be held secondarily liable for reproducing images from a third-party website that was infringing Perfect 10's copyright.

As the *Kelly and Perfect 10* decisions suggest, the case law is not yet perfectly clear, but some U.S. courts have been receptive to internet search providers proffering the Fair Use Doctrine as an affirmative defense against claims of copyright infringement. These decisions have, in addition, played a role in legal action taken in France on similar issues against Google Inc., as discussed below.

II. *SAIF v. GOOGLE* – PARIS CIVIL COURT OF FIRST INSTANCE (2008)

In 2005, *La Société des Auteurs des arts visuels et de l'Image Fixe (SAIF)*, a French collective organization representing the interests of visual artists, sued Google and Google France in the Paris Civil Court of First Instance. SAIF alleged that Google was liable for reproducing and displaying thumbnail images of the

work of SAIF artists on the Google search engine as accessed through the *google.fr* and *images.google.fr* websites. SAIF sought an injunction to stop displays of the works, subject to a €1,000 penalty for each instance of infringement, as well as damages in the amount of €80,000.

In response to the lawsuit, Google made an interesting strategic decision, arguing that the French court should apply U.S. law to dismiss SAIF's claims, on the basis of the Fair Use Doctrine. Google argued that Section 5.2 of the Berne Convention for the Protection of Literary and Artistic Works[9] controlled the choice of law analysis in this case. Pursuant to the Berne Convention, "the extent of protection [for artistic works], as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed."[10]

In its May 20, 2008, decision, the Paris Civil Court of First Instance adopted Google's argument and applied U.S. copyright law to the question of Google's alleged infringement of the rights of the French collective organization. The Civil Court first noted that the Berne Convention did in fact control the Court's choice of law analysis, and then indicated that the Court of Cassation, the highest court of France, had interpreted the Berne Convention to require application of the law of the place where the alleged harm was *produced*. The Civil Court reasoned that, because the alleged harm was generated by the Google search engine, which was itself developed by Google Inc. at the company's headquarters in California, the United States was the locale of the production of the harm and thus U.S. law should apply.[11]

Applying the U.S. Copyright Act, the Civil Court exonerated Google under the 'fair use' exemption. The court analogized Google to a dictionary or directory providing cost-free and universal access to information, and thus deserving of the 'fair use' protection. The court then reviewed the four statutory 'fair use' factors, finding in Google's favor that the image search engine itself did not directly generate revenue and that it was necessary to use the entire copyrighted image to provide sufficient information to the users. The court also found that images in Google's cache were not "stored" by Google because caching was done by automated servers without Google's intervention. Lastly, the Court held that the thumbnail images viewed on Google's website did not replace the copyrighted works or prevent the owners from marketing their works. Thus, for many of the same reasons articulated by the Ninth Circuit in *Kelly* and *Perfect 10*, the Paris Civil Court found that Google's use of copyrighted images in its search results constituted 'fair use' under the U.S. Copyright Act. Google was well on its way to using the Berne Convention to expand *Perfect 10* outside the United States.

III. *SAIF v. GOOGLE* – PARIS COURT OF APPEAL (2011)

As one might expect, SAIF was not happy with the lower court's decision to exonerate Google under U.S. law. SAIF appealed the decision of the Paris Civil Court of First Instance to the Paris Court of Appeal. On January 26, 2011, the Court of Appeal issued its decision.[12] The Court of Appeal began with the same choice of law analysis conducted by the lower court, but reversed the Civil Court's application of U.S. law based on a divergent interpretation of Section 5.2 of the Berne Convention. Contrary to the Civil Court, the Court of Appeal interpreted the Berne Convention to require application of the law of the place where the alleged harm was *sustained*. In this case, the court reasoned that the alleged harm was sustained in France when users accessed the Google search engine through the *google.fr* and *images.google.fr* websites. With the harm sustained in France, held the Court of Appeal, French law should apply.

Even under French law, however, the Court of Appeal still rejected SAIF's claims and ruled in favor of Google, finding that Google's search engine qualifies as a neutral intermediary. Thus Google is not liable for copyright infringement under the Law on Confidence in the Digital Economy (*Loi sur la Confiance dans l'Economie Numérique,* or "LCEN"),[13] which governs internet actors absent a more specific statute. The court based its decision on the fact that Google's search engine uses automated and neutral "robot explorers" to locate and download images. The Court of Appeal also found Google's reproduction of the thumbnail images of the copyrighted works necessary to support Google's public search service and held that this transient reproduction of copyrighted images was justified by the public benefit it provided.

Thus, even under the laws of France, Google's use of copyrighted images to convey information to its users was found to be exempt from copyright infringement liability.

IV. CONCLUSION

For California's considerable technology community, the Paris Court of Appeal decision is a mixed blessing. The French Court stopped Google's attempt to export *Perfect 10* to Europe through the Berne Convention, but nevertheless found Google's use of copyrighted thumbnail images appropriate under the laws of France.

For the world's content-protection community, however, this is more bad news, and for those watching the continuing development of attempts by national legal systems to regulate online conduct, *SAIF v. Google* is simply another stepping stone on a winding path with no end in sight.

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Endnotes

1 *Cour d'appel* [CA] [regional court of appeal] Paris, 1e ch., Jan. 26, 2011, *available at* http://www.juriscom.net/documents/caparis20110126.pdf.

2 17 U.S.C. §§106, 106A.

3 *See Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 817 (9th Cir. 2003).

4 17 U.S.C. §107.

5 *Id.*

6 *Id.*

7 336 F.3d 811 (9th Cir. 2003).

8 508 F.3d 1146 (9th Cir. 2007).

9 Berne Convention for the Protection of Literary and Artistic Works, art. 5, §2, Sept. 9, 1886 (Paris Text 1971).

10 *Id.*

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

12 *See* note 1, *supra*.

13 *Loi 2004-575 du 21 juin 2004 pour la confiance dans l'économie numérique* [Law 2004-575 of June 21, 2004 on the confidence in the digital economy], JOURNAL OFFICIEL DE LA RÉPUBLIQUE FRANCAISE [J.O.] [OFFICIAL GAZETTE OF FRANCE], June 22, 2004.