

The liability of Book scan service provider in Copyright Law

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1. Introduction

In principal, the original owner of the book can scan and digitalize without infringing to copyright because of its private reproduction. But, in case of the original owner of the book demands book scanning to the book scan service provider, does not the book scan service provider have a liability to the copyright holders as a subject of private reproduction in Copyright Law? About this issue, The Tokyo District Court in Japan gave the book scan service provider the guilty verdict and commanded a total of 140 million yen. In other word, they have liability to the copyright holder of direct copyright infringement. This paper is a review of these Japanese cases, and propose what some extent the Book Scan service provider should have the liability to the copyright holders.

2. Summary of the Case[1]

The facts of this case are as bellows.

- (1) Plaintiffs are the novelist, cartoonist, comic original author.
- (2) Defendants are the book scan service provider.
- (3) Clients buy the books and request the book scanning to the defendants.
- (4) Without permission from the copyright holder, defendants cut the books, scan it, make it to the electronic files, and deliver the electronic files to the clients by download or DVD.
- (5) Plaintiffs insisted that works of plaintiffs could be included in the books which are requested the order by clients and the possibility of infringing plaintiffs' copyright (especially the right of reproduction) is very high in the future.
- (6) Plaintiffs claimed that defendants must quit book scan service and prosecute a claim for damages.

In this case, the issues are (i)Success or failure of the demand for injunction based on Article 112 the 1st clause of the Copyright Act, (ii)Success or failure of the claim for damages based on an illegal act, (iii)Amount of damage.

Issue(i) is divided into the three individual points at issue. Namely (a)is there any possibility that defendants may infringe on the copyright of plaintiffs? (b) Can defendants' scanning say that it is lawful as assistance of the reproduce for private use? (c) Is the demand for injunction to defendant of plaintiffs in charge of abuse of right?

This article limits issues to issue(i)(a), because it is most important issue and relation of space.

3. Judgment of Tokyo district court

「The Article2(1)(xv) of the Copyright Act is defined as “reproduction” means the reproduction in a tangible form by means of printing, photography, photocopy, sound or visual recording or other methods.”

In order to make possible reproduce, a series of acts which consists of two or more stages may be performed, and in such a case, the problem whom to regard as the subjects of a reproduce among two or more persons who participated in generating of the tangible result arises.

As for those who did the significant act in realization of a reproduce about this problem, inquiring from the standpoint of someone is considerable. And about a significant act and its subject, it is considerable in each case to judge in consideration of elements, such as objects of a reproduce, a method, the contents of the participation to a copy, and a grade[2].

In this case, Reproduction are performed by the following process. <i> Clients apply for make electronic file of books to defendants. ii> Clients send books to defendants. <iii> Defendants judge so that it may be easy to scan books. <iv> Defendants read and make electronic files the cut-out books with the scanner which defendants manage. <v> A series of progress of receiving is realized through the client download the completed electronic files with the internet, or was recorded on media, such as DVD.

In this the progress of a series, the objects of a reproduce are books which client holds, and the methods of a reproduce is to read the character and drawings printed at books with the scanner which defendants manage and make it to electronic files.

If the contents and a grade of involvement of clients and defendants in the process of completing the tangible reproduction with making electronic files are seen, it is the client who sends the books which are the targets of a reproduce, but it is defendants chiefly that are participating in work of making electronic files from books, and the client is not participating in this work at all.

As mentioned above, the reproduce in this case has the special feature in the point of making electronic files from books, and the work of making electronic files should be the significant act in a reproduce, it is defendants that are doing the significant act, not client.

Therefore, it is considerable to concede defendants to be the subjects of a reproduce.]

4. Comment

(1) This case is meaningful in conceding the liability of book scan service providers by the court for the first time. In other word, subject of reproduction are book scan service providers not clients.

(2) In principal, the original owner of the book can scan and digitalize without infringing to copyright because of private reproduction by Article 30(1)[3] of Japanese Copyright Act. In this case, Tokyo District Court judged that it did not need to discuss as a problem of private reproduction but a problem of the subject of a using act.

(3) Tokyo District Court conceded that the subject of a using act is the defendants (book scan service providers). In the process recognizing liability of reproduction and control of the book to defendants, the court took into account difficulty of making electronic files for clients by costs, laborious tasks, technique. And also the court decided that making electronic files is the most significant act to consider infringement of copyright.

(4) In private opinion, difficulty of making electronic files for clients is not valid. Because it is very easy for the user to get cutting machine, scanner, personal computer in making digital files. The merit for the user to demand scan service is only "saving time and efforts (convenience)". So we need to focus more on the issue of interpreting the private reproduction[4]. Because defendants act is originated by the user's request. But, to extend the range of permitting private reproduction broadly may cause trouble that the electronic files without DRM will be spread and will give economical disadvantage to copyright holder.

(5) The problem is how far can the range of private reproduction be extended? It is very hot issue and difficult one. But on this case, if service provider gave the books back to clients or destroy it after complete a series of wok, it is included in private reproduction.

(6) In case of digitized analog works, we must consider the type of service and user's using act to keep balance or make division of profits between users, service providers and copyright holders. Because many other foreign copyright law system including Japanese copyright Act have a same goal. It is the development of culture through not only the protection of copyright holders but also the security for user's fair use.

[1] Tokyo District Court, September 30, 2013, Case No. 24(wa)33525.

[2] Supreme Court, January 1st, 2011, Case No. 21(jyu)788.

[3] Japanese Copyright Act 31(1) provides that except in the cases listed below, it shall be permissible for the user of a work that is the subject of a copyright (below in this Subsection simply referred to as a "work") to reproduce the work for his personal use or family use or other equivalent uses within a limited scope (hereinafter referred to as "private use"):

[4] Tamura Yoshiyuki, "Book scan service provider and infringement of copyright" Westlaw Japan 《WLJ Case Column》 No.19 Literature No.2014WLJCC001