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## **Open Access – Access to scientific publications in Swiss law**

Expert opinion commissioned by the University of Zurich

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## List of abbreviations

approx.	approximately
Art.	Article
BBl.	Federal Gazette
BGE	Decisions of the Swiss Federal Court, official collection
BGer	Federal Court
BK	Berner Kommentar
BSK	Basler Kommentar
cf.	compare
Const.	Federal Constitution of the Swiss Confederation dated 18 April 1999, SR 101
CR	Commentaire Romand
E.	Consideration
EC	European Community
ECJ	European Court of Justice
ed.	Edition, Editor
e.g.	for example
et al.	et alii, et aliae (and others)
etc.	and so forth
ETH	Swiss Technical University (Eidgenössische Technische Hochschule)
et seq.	and the following pages
Fn.	Footnote
GRUR	Gewerblicher Rechtsschutz und Urheberrecht
GRUR Int.	Gewerblicher Rechtsschutz und Urheberrecht, Internationaler Teil
ibid.	the same
i.e.	id est
IIC	International Review of Industrial Property and Copyright Law
IPRG	Federal Act on International Private Law (Bundesgesetz über das Internationale Privatrecht) dated 18 December 1987, SR 291
KG	Federal Act on Trusts and other Restrictions of Competition (Anti-trust Act) (Bundesgesetz über Kartelle und andere Wettbewerbsbeschränkungen [Kartellgesetz]) dated 6 October 1995, SR 251
LC	Convention of 16 September 1988 on jurisdiction and the enforcement of judgments in civil and commercial matters (Lugano Convention), SR 0.275.11

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No.	Number
OR	Federal Act concerning Additions to the Swiss Civil Code (Code of Obligations) (Bundesgesetz betreffend die Ergänzung des Schweizerischen Zivilgesetzbuches [Fünfter Teil: Obligationenrecht]) dated 30 March 1911, SR 220
p.	page
Para.	Paragraph
PDF	Portable Document Format
RBC	Berne Convention for the Protection of Literary and Artistic Works, revised in Paris on 24 July 1971, SR 0.231.15
Revised LC	Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (revised Lugano Convention), dated 30 October 2007, BBl. 2009, p. 1841 et seq. (enters into effect at the earliest as of 1 January 2011)
sic!	Zeitschrift für Immaterialgüter-, Informations- und Wettbewerbsrecht
SIWR	Schweizerisches Immaterialgüter- und Wettbewerbsrecht
SMI	Schweizerische Mitteilungen über Immaterialgüterrecht (seit 1997: sic!) (Swiss law reports – sic! since 1997)
SR	Systematische Sammlung des Bundesrechts (Official systematic collection of Swiss legislation)
STB	Standard terms of business
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights dated 15 April 1994 (SR 0.632.20)
UFITA	Archiv für Urheber- und Medienrecht (bis 1999: Archiv für Urheber-, Film-, Funk- und Theaterrecht)
UNESCO	United Nations Educational, Scientific and Cultural Organization
URG	Federal Act on Copyright and Neighboring Rights (Copyright Act) (Bundesgesetz über das Urheberrecht und verwandte Schutzrechte [Urheberrechtsgesetz]) of 9 October 1992, SR 231.1
UrhG	Federal Act on Copyright and Neighboring Rights (Urheberrechtsgesetz) of 9 September 1965 (Germany)
UWG	Federal Act against Unfair Competition (Bundesgesetz gegen den unlauteren Wettbewerb) of 19 December 1986, SR 241
v.	versus
VerlG	Publishing Act (Gesetz über das Verlagsrecht) of 19 June 1901 (Germany)
Vol.	Volume
WCT	WIPO Copyright Treaty of 20 December 1996, SR 0.231.151
WIPO	World Intellectual Property Organization
ZfBB	Zeitschrift für Bibliothekswesen und Bibliographie

ZGB	Swiss Civil Code (Schweizerisches Zivilgesetzbuch) of 10 December 1907, SR 210
ZK	Zürcher Kommentar
ZUM	Zeitschrift für Urheber- und Medienrecht

## A. The question

- 1 The University of Zurich is pursuing the objective of maximising the free access to scientific publications via the Internet. In this way, the University of Zurich is committing itself to an approach that is supported and actively promoted by scientists and scientific organisations internationally under the name “open access”. Against this background, the University of Zurich has requested an overview of the legal conditions for open access in Switzerland.
- 2 For this purpose, the University of Zurich has compiled a catalogue of questions to be answered in the present expert opinion. The focus of interest is on questions of law related to what are known as repositories, i.e. Internet servers that serve to make scientific publications available. In particular, the question arises of the extent to which publications that have already been published by scientific publishers are permitted to be deposited in repositories.
- 3 The present expert opinion is restricted to the situation under Swiss law. Account must be taken of the fact that in international constellations it is often not Swiss but rather a foreign legal system that applies (see below, paragraphs 28 et seq.).

## B. Basic principles

### I. Definition and purpose of open access

#### 1. *Definition*

- 4 The basic idea of open access is that academic knowledge should be freely available to anyone interested. This is also set out in the Berlin Declaration of October 2003, a central manifesto of the open access movement, where it states as its objective the implementation of the vision of a global and available representation of knowledge.<sup>1</sup> The most

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<sup>1</sup> Berlin Declaration on Open Access to Knowledge in the Sciences and Humanities, <http://oa.mpg.de/openaccess-berlin/berlindeclaration.html> (all Internet pages visited on 7 July 2009).

likely medium for the implementation of this objective is the Internet, which easily permits the global dissemination of information.

5 The basic idea of open access can be covered by a variety of definitions that differ in their details.<sup>2</sup> The present expert opinion takes the following definition as its starting point:

6 *Open access is the free access to scientific knowledge via the Internet.*

7 The definition contains the following elements:

- *Free* means that the user does not have to pay a charge for access. The costs for the provision of the information must therefore be borne elsewhere (on the various financing models, see below, paragraph 15).
- Sufficient *access* means that the user can use the information obtained for scientific purposes. This requires him to be able to call up, view and store the documents on his computer and print them for his own purposes.<sup>3</sup>
- *Scientific knowledge* mainly covers scientific publications, but also other scientific materials such as research data and recordings.<sup>4</sup>
- The *Internet* is understood as the global network comprising individual computer networks and serving the exchange of data.

## 2. Purpose

8 The purpose of open access is firstly to make use of the numerous possibilities of the Internet for the communication of knowledge,<sup>5</sup> thereby securing the basis for unrestricted research. This involves the requirement

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<sup>2</sup> On the definition of open access see for instance LOSSAU, p. 18 et seq.; BAILEY, p. 13 et seq.; KUHLEN, p. 457 et seq.; BARGHEER, BELLEM AND SCHMIDT, p. 5 et seq.

<sup>3</sup> According to the Berlin Declaration (above, Fn. 1), the concept of open access also covers other types of use such as distribution, public display and adaptation. This is to be regarded above all as a political demand. The present expert opinion chooses a narrower definition, since it would render the text more difficult to understand if the term open access were restricted to uses where the user is granted all the rights listed in the Berlin Declaration. On this point, see also BARGHEER, BELLEM AND SCHMIDT, p. 6.

<sup>4</sup> Cf. the wording of the Berlin Declaration (above, Fn. 1 **Fehler! Textmarke nicht definiert.**): 'Open access contributions include original scientific research results, raw data and metadata, source materials, digital representations of pictorial and graphical materials and scholarly multimedia material.'

<sup>5</sup> Comparable with 'open source' in the software sector; on common features and differences between 'open access' and 'open source', see MANTZ, Open Source, p. 413 et seq.

that research financed by public funds should be available freely to the public.<sup>6</sup> Thus scientists, knowledge organisations and libraries with restricted budgets should be enabled to contribute to high quality scientific research, each in their own way.

9 In addition, open access should ensure the long-term archiving of scientific knowledge, thereby contributing to securing cultural heritage.<sup>7</sup>

10 These objectives of the open access movement were drawn up against the background of the risks to the freedom of research and long-time archiving by developments both in the university and in the publishing sector.<sup>8</sup> Many institutions in the university sector have, over the last few years, seen budget reductions which also affect the libraries and hence the extent of new acquisitions. In the field of publishing, there has been a shift from print to online media, a shift that has often not led to the expected reductions in prices and thus does not contribute to the solution of the financial problems of libraries.<sup>9</sup> In addition, publications that are only available online (e-only) have also cast doubt on the previous practice of long-term archiving.<sup>10</sup>

## II. Strategies of the open access movement

### 1. *Publication strategies*

#### a) *Golden Road*

11 The “Golden Road” is seen as being publication exclusively or mainly in open access media products. For instance papers can be published in open access journals that, like other journals, apply a peer review proce-

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<sup>6</sup> On this point see HILTY, *Wissenschaftler*, p. 182 with further references

<sup>7</sup> According to the ‘Berlin Declaration’ (above, Fn. 1).

<sup>8</sup> See the Budapest Statement of February 2002 (Budapest Open Access Initiative, [www.soros.org/openaccess/read.shtml](http://www.soros.org/openaccess/read.shtml)), the Bethesda Statement of April 2003 (Bethesda Statement on Open Access Publishing, [www.earlham.edu/~peters/fos/bethesda.htm](http://www.earlham.edu/~peters/fos/bethesda.htm)) and the Berlin Declaration of October 2003 (above, Fn. 1). On the history of the open access movement see also SCHIRMBACHER, p. 22 et seq.; ANDRÉ, p. 32 et seq.

<sup>9</sup> PFLÜGER AND ERTMANN, p. 436 et seq.; EGLOFF, p. 705 f.; KUHLEN, p. 225 et seq., 232 et seq.; HILTY, *Sündenbock Urheberrecht?*, p. 127 et seq.; *IBID.*, *Wissenschaftler*, p. 182 with further references.

<sup>10</sup> For the libraries’ point of view see SCHWENS AND ALTENHÖNER, p. 55 et seq.

dure.<sup>11</sup> Monographs and textbooks can be published – mostly by correspondingly specialised publishers – under open access conditions.<sup>12</sup>

b) *Green Road*

12 The “Green Road” consists of publishing the publication conventionally but providing a parallel publication under open access conditions. This is done either by means of self-archiving, e.g. on the scientist’s personal Internet site, or by institutional archiving in what are known as repositories, i.e. the servers of institutes, universities or other scientific organisations.<sup>13</sup>

13 The Green Road is a compromise solution between conventional and open access publication. Such a compromise is in particular adopted where the reputation of the scientist depends substantially on publications in certain conventional media products – in particular in renowned specialist journals.<sup>14</sup>

14 The present expert opinion focuses on the legal questions of the Green Road, while the Golden Road will be addressed only marginally.

## 2. *Financing strategies*

15 In order to permit users free access to scientific publications, the costs of preparation, evaluation and rendering them accessible must be financed elsewhere. Essentially, a distinction is made between three financing strategies for open access publications, which can, in their details, be further differentiated and modified.<sup>15</sup>

- In the “author pays” model, the author must in principle pay a publication fee for the publication of his article,<sup>16</sup> although in the internal relationship the research institution behind him may assume the costs.

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11 See the overviews of open access journals, a significant number of which apply a peer review: Directory of Open Access Journals ([www.doaj.org](http://www.doaj.org)), Open J-Gate ([www.openj-gate.com](http://www.openj-gate.com)).

12 BARGHEER, BELLEM AND SCHMIDT, p. 7 et seq.

13 BARGHEER, BELLEM AND SCHMIDT, p. 8.

14 DORSCHER, p. 239; PFLÜGER AND ERTMANN, p. 437; EGLOFF, p. 712; HILTY AND BAJON, p. 262.

15 For further details see KUHLEN, p. 553 et seq.; COCKERILL, p. 111 et seq.

16 Such as for instance the major open-access platforms BioMed Central (list of prices at [www.biomedcentral.com/info/authors/apcfag](http://www.biomedcentral.com/info/authors/apcfag)) and PLoS, Public Library of Science (list of prices at [www.plos.org/journals/pubfees.html](http://www.plos.org/journals/pubfees.html)).

- In the “institution” model, the publications are in any case financed by research institutions or libraries, with either themselves operating a publication platform (e.g. a repository) or by third parties doing so raising the necessary revenue in the form of membership subscriptions (e.g. open access publishers).<sup>17</sup>
- In the “hybrid” model, the same media product may permit both open access and conventional publication, i.e. access-restricted, publication. The author has the choice. Open access publication, however, is only made if the author pays a publication fee (or if this fee is paid by a third party such as a research institution), otherwise the publication is published with restricted access and the use is subject to a fee.<sup>18</sup> In the final analysis, in this model commercial intermediaries ensure that the loss of income resulting from free access for users is reimbursed by the scientific community.

### III. Legal basis for open access

#### 1. Copyright

- 16 Since scientific publications are as a matter of principle subject to copyright, copyright law plays an important role in the implementation of open access platforms. The following will briefly set out a number of copyright principles that are relevant for the present expert opinion.
- 17 From the Swiss perspective, the relevant legal basis is to be found in the form of the Swiss Copyright Act (URG) and a number of international agreements, in particular the WIPO Copyright Treaty (WCT) and the Revised Berne Convention (RBC).
- 18 The object of protection of copyright is a work as an intellectual creation (Art. 2 Para. 1, URG), and this, as a matter of principle, irrespective of its

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<sup>17</sup> The open-access platform BioMed Central combines the ‘author-pays model’ with the ‘Institutions model’ in such a way that authors are as a matter of principle charged publication fees (see above, Fn. 16), but researchers of institutes that are members of BioMed Central are exempt from the fee: [www.biomedcentral.com/inst](http://www.biomedcentral.com/inst).

<sup>18</sup> In the meantime, various major publishers offer this model, such as Springer (‘Open Choice’), Oxford University Press (‘Oxford Open’), Elsevier (‘Sponsored Articles’) and Wiley-Blackwell (‘OnlineOpen’): [www.springer.com/open+access/open+choice?SGWID=0-40359-0-0-0](http://www.springer.com/open+access/open+choice?SGWID=0-40359-0-0-0), [www.oxfordjournals.org/oxfordopen](http://www.oxfordjournals.org/oxfordopen), [www3.interscience.wiley.com/authorresources/funded\\_access.html](http://www3.interscience.wiley.com/authorresources/funded_access.html), [www.elsevier.com/wps/find/intro.cws\\_home/sponsoredarticles](http://www.elsevier.com/wps/find/intro.cws_home/sponsoredarticles).

embodiment in a physical work. Thus, for instance, it is not the specific graphic design of a paper that is protected, but only the article “of itself”. Hence copyright protection exists independently of whether the article is represented in the form of a manuscript, the published publisher’s PDF with or without publisher’s logo or in any other manner.

19 Intellectual creations only enjoy copyright protection to the extent that they have an “individual nature” (Art. 2 Para. 1, URG). With scientific works, which are mentioned separately in the Act (Art. 2 Paras. 2 a and d, URG), the individual nature is to be found less in the contents of the work – since the contents will be determined strongly by the logics of the subject – but rather in the specific linguistic or stylistic form, in the wording and the structuring of the material.<sup>19</sup> As a matter of principle, scientific publications are subject to copyright unless they are a mere compilation of data.<sup>20</sup>

20 The following will assume, without closer examination, that the works made available on open access platforms are protected by copyright. This assumption must be made by the operator of an open access platform as a precautionary measure if he is not willing to examine each individual work for its capacity for copyright protection.

21 Copyright consists of a number of sub-rights (Arts, 9-15, URG). These include, to begin with, the user rights such as the rights to reproduce, to distribute and to make available the copyright work (Art. 10, URG). In addition, the author also has the right to recognition of his authorship and the right to decide on the first publication of the work (Art. 9, URG), as well as the right to the integrity of his work (Art. 11, URG). In addition, there are rights that relate to individual copies of the work (Arts. 13-15, URG) such as the right of access to an original copy. The individual rights

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<sup>19</sup> BGE 113 II 306 et seq. E. 3a; BGer, SMI 1996, p. 73 et seq. E. 4a (p. 82); BARRELET AND EGLOFF, Art. 2 Marginal note 16. Arguing in favour of more extensive protection, REHBINDER, Urheberrecht, Paragraph 81, according to which it is also the *content* of scientific works that is capable of copyright protection; this does not impede scientific discussion since other scientists are entitled to reproduce the work within the limits of the right to quote (Art. 25, Copyright Act). Adopting the same point of view, and in detail, ALTENPOHL, p. 81 et seq.

<sup>20</sup> In comparison: judicial practice has included within the term *protected work* for instance the publication of a statute with references to legislation added (BGer, SMI 1996, p. 73 et seq. E. 4a p. 83), and an advertising poster (Tribunale d’appello del Ticino, sic! 2002, p. 509 et seq. E. 5).

*Protection has been denied* for instance to a compendium of pharmaceuticals (Zivilgerichtspräsident Basel-Stadt, sic! 2004, p. 490 et seq. E. 2), air-pressure recommendations in tabular form (Kantonsgerichtspräsident Schwyz, sic! 1997, p. 143 et seq. E. 5a), and bookkeeping structures (Obergericht Luzern, sic! 1998, p. 178 et seq. E. 7.2).

can again be further subdivided (see below, paragraphs 70 et seq.). With open access uses and the contracts concluded in this context, a precise examination must be made of what sub-rights under copyright are affected.

- 22 Copyright is subject to certain limitations (Art. 19 et seq., URG). Where the use of a work falls within a limitation, it may be unrestricted, i.e. possible without the consent of the copyright holder; however, depending on the use, it may be subject to the payment of a fee (e.g. Art. 20, URG). Of interest for open access use are, above all, the limitations of personal use (Art. 19 Para. 1 a, URG), internal use (Art. 19 Para. 1 c) and the making of archive copies (Art. 24 Para. 1 and 1<sup>bis</sup>, URG).

## 2. **Competition law**

- 23 Open access platforms constitute a part of the publishing sector and at the same time represent a potential competitor to it. For this reason, the present legal opinion also takes account of competition law aspects. The relevant legal basis is to be found in the Anti-Trust Act (Kartellgesetz – KG) and the Federal Act against Unfair Competition (UWG).

- 24 In the context of open access, the focus is on the question of the extent to which scientific publishers are subject to competition law monitoring in terms of pricing and access to the works controlled by them (see below, paragraphs 218 et seq.).

## 3. **Contract law**

- 25 The grant of copyright to scientific works is by means of contracts. Of interest in connection with open access use are, above all, the publisher's contract and standard terms of business (STBs) that, if the parties involved consent, likewise have the status of a contract. The relevant legal basis is the Code of Obligations (OR), in particular the regulation of the contract of publication (Arts. 380 et seq. of the OR) as well as the copyright contract law principles that are in part expressed in Art. 16 of the URG.

- 26 Contracts take priority over non-mandatory legislation, but not over binding legislation. According to Arts. 380 et seq. of the OR, publishing con-

tract law is entirely non-mandatory,<sup>21</sup> and the URG contains practically no binding regulations specifically for copyright contracts.<sup>22</sup> This means that the contracting parties can as a matter of principle abandon these rules. If for instance a publishing contract lays down that a second publication of the work in a repository is forbidden or only permitted under specific conditions (e.g. omitting the publisher's logo and the publisher's page numbers), there is as a general rule, no statutory, copyright or publishing contract law rule, that would forbid such a clause (see below, paragraphs 106 et seq.).

27 However, the anti-trust law provision of Art. 7 of the KG, concerning unlawful conduct by market-dominant enterprises, is binding. In the present context, however, it only applies in individual exceptional cases (see below, paragraphs 218 et seq.).

#### 4. *International private law*

28 In international constellations, it is necessary to determine the applicable law, i.e. it must be clarified whether the factual constellation in question is to be assessed according to Swiss or a foreign law. It must first be determined whether there is a legal venue in Switzerland; the legal basis for this is to be found, above all, in the Lugano Convention (LC) and in the Swiss Federal Act on International Private Law (Bundesgesetz über das Internationale Privatrecht - IPRG). If a Swiss court has jurisdiction, it answers the question concerning the applicable law according to the provisions of the Swiss law on conflict of laws, which in turn is regulated in the IPRG.

29 Copyright infringement is as a matter of principle subject to the country of protection principle, i.e. the law applies of the country in whose territory copyright protection is claimed (Art. 110 Para. 1, IPRG, see below, paragraphs 157 et seq.).<sup>23</sup>

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<sup>21</sup> REHBINDER, Urheberrecht, Paragraph 164; CR-CHERPILLOD, note 10 before Art. 380–393; HILTY, Verlagsvertrag, p. 565.

<sup>22</sup> There is an exception in the form of the *exploitation obligation* via collecting societies that applies to certain rights (e.g. Art. 22 Para. 1, Copyright Act concerning the dissemination of broadcast works). In addition, all the rules that lay down the characteristics of copyright (such as assignability of copyright; severability of copyright sub-powers) are binding. Finally, contracts are also subject to the *general limitations* imposed by the legal system (Art. 19 Para. 2, Code of Obligations).

<sup>23</sup> BSK-JEGHER, Art. 110 notes 17 et seq.; REHBINDER, Urheberrecht, Paragraph 220.

30 However, a distinction must be made between infringement of copyright and breaches of contract. Publishing contracts are, as a matter of principle, subject to the law of the country in which the publisher has its business establishment (according to the prevailing legal opinion on the interpretation of Art. 117 IPRG, see below, paragraph 155).

31 In addition, it must be examined in each case whether the parties have concluded a valid agreement concerning the applicable law. If so, it takes priority.

## 5. *Further aspects*

### a) *Constitutional law*

32 The postulate of open access can rely on the basic right of the freedom of science established in Art. 20 of the Federal Constitution (= Const.). According to what is known as the indirect effect of the constitutional rights, the freedom of science applies not only as against the state but must also be taken into account in the interpretation of private law provisions (e.g. of the URG).<sup>24</sup> Such an *interpretation on the basis of the Constitution* has, at least within the framework of questions concerning open access, no major practical significance in Swiss law.<sup>25</sup> Firstly, the interpretation, in conformity with the Constitution, must remain within the limits of the purpose of the legislation, hence is not permitted to correct the law.<sup>26</sup> Secondly, an interpretation in conformity with the Constitution must take account not only of the freedom of science, which tends to favour open access, but also the guarantee of property, which tends towards the opposite (Art 26) and protects private persons inter alia in their proprietorship of copyright.<sup>27</sup>

33 A further constitutional law aspect is the compatibility of repositories operated by public bodies with the principle that the economy should be free from the state (Art. 94 Para. 1, Const.). For instance universities operate repositories and as such constitute, to some extent, competition to private

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<sup>24</sup> BGE 111 II 245 et seq. E. 4b; KRAMER, p. 91 et seq.

<sup>25</sup> The situation is different under German law, where the practice of the Constitutional Court is of greater significance. Cf. the legal opinion by GOUNALAKIS, cited in the list of references, which deals exclusively with the question whether Sec. 52a of the German Copyright Act (concerning public accessibility for teaching and research purposes) is compatible with the Constitution.

<sup>26</sup> KRAMER, p. 90.

<sup>27</sup> HÄFELIN, HALLER AND KELLER, Paragraph 597.

law scientific publishers – all the more so if repositories of scientific works are made available for free. Although such conduct is not forbidden by the Constitution, it is subject to the requirement of a sufficient statutory basis, a sufficient public interest and compliance with the principle of reasonableness.<sup>28</sup> The present legal opinion will not therefore address this question in any further depth.

b) *Criminal law*

34 It should be pointed out that copyright and competition law infringements may have not only civil law but also criminal law consequences (Arts. 67 et seq., URG, Art. 54 et seq., KG, Arts, 23 et seq., UWG).

c) *Public law*

35 Scientific publications are often made available by public law institutions and to this extent depend in many respects on public law aspects. Mention must be made for instance of the organisational regulations for universities and libraries, the law concerning the employment of researchers at universities and the university doctoral regulations with their provisions concerning the online publication of dissertations.

#### IV. Structure of the legal opinion

36 The present legal opinion sets out the legal aspects of open access. In part, different legal issues arise for the individual persons and bodies involved.

37 For this reason, in the following the topic will be set out separately from the point of view of the author (under C.), the operator of the repository (D.) and the user (E). The point of view of the publishers, who are, as a matter of principle, potential competitors to open access platforms, is taken into account in each context.

38 This division of the perspective into three parts (author, communicator, user) has proved useful in copyright law theory as a means of assessing comprehensively the status of interests in copyright issues.<sup>29</sup> Moreover,

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<sup>28</sup> For more details see VOGEL, p. 107 et seq., 128, who also points out that the state in its capacity as market participant is subject to competition law.

<sup>29</sup> See for instance HILTY, *Sündenbock Urheberrecht?*, p. 113 et seq.; for a detailed discussion on the issue as a whole, see SCHWEIKART, p. 22 et seq. In addition to these three different individual

such a three-part division proves advantageous when the objective is to determine which interests are to be promoted by an amendment of legislation (under F.). This is finally followed by a summary of the legal opinion (G.).

## C. From the author's point of view

### I. Overview

39 The postulate of open access means, amongst other things, that the scientific author is required to make available his works free of charge via the Internet. The legal system does not prevent the author complying with this requirement. As soon as he has created his work, copyright to the work vests in him by virtue of the law and he can, as a matter of principle, dispose freely of it, and in particular make it available to an open access journal or a repository (see below, II.).

40 In many cases, however, the author, mostly for reasons of reputation,<sup>30</sup> decides to publish his work via a conventional publisher. If he wishes to deposit the work in a repository at the same time, the question arises of whether the corresponding rights are already held by the publisher and to what extent the author can at all still dispose of these rights. For this purpose, it is necessary to examine whether the author has entered into a legal commitment to the publisher (III.), what rights have been granted to the publisher and what agreements have been concluded about the exercise of the rights (IV.).

41 In addition, the opinion sets out the legal situation in the case of works created by a plurality of authors (V.) and in international situations (VI.), and is followed by a conclusion (VII.).

### II. Starting position under copyright law

#### 1. *Creator principal*

42 According to Swiss copyright law and the author-principal prevailing in international law (Art. 6, URG), only natural persons can be an author, and copyright exists in the person of the "intellectual creator".<sup>31</sup> By creating the work, the author acquires all copyright in it.

43 According to the creator principal, legal persons cannot be the author; they can at best have the copyright granted by the author. Legal persons – for instance an employer or client – are thus (at least according to the

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<sup>30</sup> DORSCHER, p. 239; PFLÜGER AND ERTMANN, p. 437; EGLOFF, p. 712; HILTY AND BAJON, p. 262.

<sup>31</sup> BGE 116 II 351 et seq. E. 2b.

interpretation of copyright in continental Europe) never the author but at most derivative copyright holders.<sup>32</sup>

44 Copyright in a work can also lie with a plurality of persons. Joint authors are all the persons who have made a creative contribution to the work (for further details of the exercise of copyright by a plurality of authors, see below, paragraphs 138 et seq.).

45 In various disciplines, scientific publications are subject to a review process before publication, either by the publisher itself (editorial review) or by external experts (peer review). As a general rule, such reviewers are not to be regarded as joint authors of the scientific work if they analyse the work, assess it, express criticism or submit ideas for its improvement. Since copyright lies not in ideas or notions as such, but rather in their concrete expression,<sup>33</sup> it is only in very exceptional cases that the reviewer might have joint authorship, such as if the reviewer makes specific fully-developed proposals concerning wording or representation and the author adopts them essentially unchanged.

46 Nor do joint authors include persons who were not involved in the content of the scientific work but only in its external appearance, such as the design of the layout, changes to the technical production publication format or correcting typing errors. Joint authors likewise do not include scientific assistants who carry out auxiliary and preparatory activities for the work without participating in the specific wording and the presentation of the content. Here again (as was just explained in paragraph 45), the provision of ideas does not lead to joint authorship unless the ideas are provided in a specific form and adopted as such into the work.

47 In scientific activity, it may be that publications also identify as authors persons, such as department heads, who assume a certain responsibility for the content of the publication but have not provided any creative contribution of their own. Such a person is admittedly not a joint author, but if a person is identified as author in the publication, it's authorship is assumed by law (Art. 8 Para. 1, URG), i.e. the person is regarded as an author and holds the corresponding rights until non-authorship is proven.

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<sup>32</sup> According to some opinions in the teaching, the special case of Art. 393, Code of Obligations (adaptation of a work according to a plan by the publisher) departs from this principle, see the overview of the different views in BSK-HILTY, Art. 393 note 4.

<sup>33</sup> REHBINDER, Urheberrecht, Paragraph 27 (p. 47).

And as a matter of principle, the joint authors (for instance the department head's staff) will for obvious reasons refrain from providing such proof (against their superiors).

## 2. *Communication of the work*

48 As the first holder of copyright the author can decide whether, when and how his work is to be published and hence communicated to the public (Art. 9 Para. 2, URG).

49 The author can publish the work either under open access conditions ("Golden Road", see above, paragraph 11) or otherwise, such as via a conventional publisher. The author can also combine both types of publication, i.e. publish a publication through a publisher and at the same time on an open access platform (the "Green Road", see above, paragraphs 12 et seq.). In this case, the simultaneous grant of rights by the author to the publisher and the operator of the open access platform must be compatible, hence the rights cannot be transferred without restriction to the one or the other, nor can an exclusive licence be granted (on the difference, see below, paragraphs 65 et seq.).

50 Publication under open access conditions – on the "Golden" or the "Green Road" – means that any user is granted free access to the publication via the Internet for private use (corresponding to the definition of open access, see above, paragraphs 6 et seq.). However, this does not mean that the author thereby abandons his copyright. The user as a matter of principle receives neither the right to all possible uses (such as distribution of printed copies or translation) of the work nor the power to ignore the author's moral rights (e.g. the right to identification). The author can apply licence conditions to a work made available in order to regulate the details of the permitted uses. Corresponding model licences – such as the Creative Commons Licences<sup>34</sup> – are available on the Internet.<sup>35</sup>

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<sup>34</sup> The Creative Commons Licences adapted to Swiss law can be found at <http://creativecommons.org/international/ch>.

<sup>35</sup> On the question as a whole, PEIFER, p. 41 et seq.; DORSCHER, p. 254 et seq.

### III. Entry into a commitment to the publisher

#### 1. Publishing contract

##### a) Conclusion of contract

51 If the author decides to publish his work through a publisher, he will have to achieve a corresponding agreement with the publisher. In order to obtain legal clarity about the relationship between the author and the publisher, it must first be determined whether the author has at all entered into a legal commitment to the publisher, in particular whether a publishing contract has been concluded.

52 The conclusion of the contract depends on whether the parties have agreed on the main contents of the contract (cf. Art. 1 Para. 1, OR).<sup>36</sup> The objectively essential contents of the publishing contract are that the author provides the publisher with the work for the purpose of publication and the publisher reproduces and distributes the work (cf. Art. 380, OR)<sup>37</sup> or makes it available online (for more details on the online publishing contract, see below, paragraphs 79 et seq.).

53 Additional aspects are only of relevance for the conclusion of the publishing contract if one party clearly shows that it does not wish to conclude a contract if there is no agreement on these aspects, with the result that these aspects are not objectively but nevertheless *subjectively essential*.<sup>38</sup> If a publishing contract lays down for instance that the author is not entitled to publish his work on an open access platform at the same time, the contract is not concluded if the author clearly indicates that he is only willing to conclude the publishing contract if he has the possibility of a parallel publication.

54 The conclusion of the publishing contract is *not tied to compliance with a specific form*.<sup>39</sup> Hence the contract need not be in writing nor be explicit. If for instance the author delivers his manuscripts to the publisher with a request for publication in a specific journal, and the publisher then publishes the text in this journal, a publishing contract has been concluded in

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<sup>36</sup> GAUCH, SCHLUEP AND SCHMID, Paragraphs 329 et seq.

<sup>37</sup> Details in HILTY, Verlagsvertrag, p. 574 et seq.

<sup>38</sup> BGE 118 II 32 et seq. E. 3d with further references.

<sup>39</sup> ZK-TROLLER, Art. 380 note 14; CR-CHEPILLOD, Art. 380 note 7; BSK-HILTY, Art. 380 note 1.

legal terms, since the agreement on the essential points of the contract can be derived from the author's letter (offer of contract) and the resulting corresponding actions on the part of the publisher (acceptance of contract).

55 In other words, a publishing contract can be concluded without a written or oral agreement but entirely through the corresponding conduct by the author and publisher. For this reason, there is in legal terms a publishing contract even if the legally ignorant author is of the opinion that he has not concluded a contract or has "not signed anything".

b) *Contractual supplements*

56 In the same way as the conclusion of an agreement, an amendment also requires an expression of intent by the parties to this effect, unless the parties have laid down otherwise. For this reason, a supplement to the contract – regarded either as part of the original contract or as an amendment thereof – requires the consent of both parties if it is to be valid. In the field of open access, a common international instrument is the SPARC (the Scholarly Publishing and Academic Resources Coalition) model contractual supplement that is intended to improve the author's possibilities for disposing of his work and in particular to enable him to deposit the work in repositories.<sup>40</sup>

57 If the publisher for instance sends a specific contractual offer to the author and the author accepts this offer but adds additional contractual provisions (such as to the effect that he is entitled to deposit the work in a repository), this supplement itself requires the publisher's consent if it is to be valid. The publisher's consent can be made expressly, implicitly – i.e. by corresponding conduct – or in specific cases even by means of silence (Art. 1 Para. 2 and Art. 6, OR).

58 If the contractual supplement is not expressly confirmed by the publisher, but if the publisher then publishes the work, this conduct can be interpreted in two ways:

- On the one hand, the publication could be regarded as *implicit consent*<sup>41</sup> (which as a matter of principle can only be valid if the publish-

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<sup>40</sup> SPARC contractual supplement: [www.arl.org/sparc/bm~doc/Access-Reuse\\_Addendum.pdf](http://www.arl.org/sparc/bm~doc/Access-Reuse_Addendum.pdf); for further details, see below, Fn. 80 and MANTZ, Open Access, p. 97 et seq.

<sup>41</sup> In this sense (for German law) MANTZ, Open Access, p. 99.

ing contract does not lay down that amendments to the contract must be in writing).

- On the other hand, the publication could also be regarded as merely the performance of the original contract and for the rest it is to be assumed that the publisher *has not consented* to the contractual supplement.

59 In such an ambiguous situation, the decisive factor is who bears the burden of proof. If the author wishes to derive rights from the contractual supplement (e.g. to the deposit of the work in a repository), he bears the burden of proof that the publisher has issued its consent to the corresponding contractual supplement (Art. 8, Civil Code = ZGB). However, if in addition to the publication the publisher has not disclosed any conduct that would argue in favour of his consent, the author will probably not be able to successfully provide proof.

60 In the final analysis, the mere fact that the publisher has published the work is probably not sufficient to construe the publisher's consent to a contractual supplement (e.g. concerning the permission to deposit in a repository) that the publisher never expressly accepted.

## 2. **Standard terms of business (STBs)**

61 Publishers often use standard terms of business (STBs), which raises the question of when such STBs are binding on the author. The reply is determined according to the general principles of contract law, i.e. STBs are only binding if they can be based on a reciprocal expression of intent by the parties to this effect (Art. 1 Para. 1, OR).

62 Agreement on the STBs can be achieved by the STBs being integrated in the individual contract or by referring to the STBs in the contract.<sup>42</sup> Where there is only a reference, it is also a requirement that the consenting party had the opportunity to acquire knowledge of the content of the STBs in a reasonable manner.<sup>43</sup> This precondition is for instance not satisfied if the STBs are printed in such small print that they are hardly legible,<sup>44</sup> or if they are only difficult to find on the publisher's Internet site.

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<sup>42</sup> GAUCH, SCHLUEP AND SCHMID, Paragraphs 1129 et seq.

<sup>43</sup> SCHWENZER, Paragraph 45.03.

<sup>44</sup> GAUCH, SCHLUEP AND SCHMID, Paragraph 1140a; SCHWENZER, Paragraph 45.03.

63 One party's STBs have no legal effect for the other party if the latter has not consented to the STBs. Thus it is not sufficient for the application of the STBs between the two parties if for instance one of the parties has placed its STBs on its Internet site without referring the other party to these STBs. As a general rule, implicit consent to STBs cannot be assumed; this is only possible in very exceptional cases, such as if the parties have already used the same STBs within the framework of previous contractual relationships.<sup>45</sup>

64 Although, as a matter of principle, STBs strongly unilaterally benefit the party that has drawn them up, Swiss law does not as a matter of principle provide for any monitoring of the contents to correct this fact and protect the other party. Provisions of the STBs will only be held not to be binding in exceptional cases, such as in the case of unusual and surprising provisions that the other party cannot reasonably be expected to reckon with,<sup>46</sup> or misleading provisions that deceive the other party about a condition that is disadvantageous to it (Art. 8, UWG).<sup>47</sup>

#### IV. Scope of the rights granted to the publisher

##### 1. *Basic principles*

###### a) *Distinction between assignment and licence*

65 If a contract has been concluded, it is necessary to determine the rights that the author has granted to the publisher. This is a precondition for answering the question whether the publishing contract leaves the author with the necessary rights to allow him to deposit the work in question in a repository at the same time as publication by the publisher.

66 In the analysis of copyright contracts, it is essential to determine whether the contract provides for an assignment or a licensing of copyright. The differentiation between these two types of grant of right is as basic as the well-known distinction between the buying and the renting of objects.

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<sup>45</sup> GAUCH, SCHLUEP AND SCHMID, Paragraph 1130.

<sup>46</sup> Known as the "unexpectedness rule": BGE 119 II 443 et seq. E. 1a; BGer 4C.282/2003 E. 3.1; BGer 4A\_438/2007 E. 5.1.

<sup>47</sup> Art. 8 of the Act against Unfair Competition is rightly regarded by the literature as 'pointless', focussing as it does on special cases with little relevance to practice (thus BAUDENBACHER, Art. 8, heading before note 32).

67 Unfortunately, in contracting practice, the assignment and licensing of copyright are often insufficiently clearly distinguished, with the consequence that many contractual provisions in this respect are ambiguous and for this reason must be construed.<sup>48</sup> The vague contractual practice is based in part on the fact that in Switzerland model contracts based on German law are used that as a matter of principle do not permit the assignment of copyright, unlike under Swiss law.<sup>49</sup>

68 The *assignment* of copyright is defined by the assignor basically abandoning his copyright by granting it to the assignee. In other words, the assigned right transfers from the assignor to the assignee. In this way, the assignee acquires an absolute right, i.e. a right that can be enforced against anyone (including against the author himself).<sup>50</sup> An assignment in this sense is *inter alia* the phrase common in contractual practice that copyright “is granted without restriction in space, time and content.”

69 Under a *licence*, on the other hand, the party granting the right retains his copyright. The acquirer does not receive the copyright itself but only the permission (licence) to use the work. This permission is merely a relative right that only applies against the person granting the right as a matter of principle.<sup>51</sup> The person granting the right remains the copyright holder, and his legal position depends on the type of licence:<sup>52</sup>

- By granting a *exclusive* licence, he undertakes not to grant a licence to the corresponding work elsewhere.
- If on the other hand he grants only a *non-exclusive* licence, he is entitled to grant further (non-exclusive) licences to third parties.

b) *Severability of individual copyright sub-powers*

70 Copyright contains a number of sub-powers (see above, paragraph 21). The individual sub-powers are as a matter of principle severable from the

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<sup>48</sup> BARRELET AND EGLOFF, Art. 16 note 2a; STAUB, p. 57.

<sup>49</sup> Sec. 29 Para. 1 of the German Copyright Act.

<sup>50</sup> HILTY, Lizenzvertragsrecht, p. 85; DE WERRA, Art. 16 note 7; SEEMANN, p. 35.

<sup>51</sup> HILTY, Lizenzvertragsrecht, p. 136 et seq., 147 f. An exception to the relative nature of the licence follows from Art. 62 Para. 3, Copyright Act, according to which the licensee of an exclusive licence can, if the licensed right is infringed or endangered, take legal action not only against the licensor but also against any third party.

<sup>52</sup> See HILTY, Lizenzvertragsrecht, p. 237 et seq.

other parts of copyright and can be transferred individually to an acquirer (cf. Art. 16 Para. 2, URG). Thus the author of a scientific work can for instance transfer only the rights of reproduction and distribution to a publisher and dispose of the translation rights to a different publisher. Licensing can also be limited to individual sub-powers, which is entirely usual.

71 The individual sub-powers can be defined in different ways:<sup>53</sup>

- One possible definition of a sub-power is by means of the *categories of the statutory list of rights* (Arts. 9-15, URG). Thus for instance the assignment of the “right of reproduction” (Art. 10 Para. 2 a, URG) or the “broadcasting rights” (Art. 10 Para. 2 d, URG) to a work can be agreed.
- However, sub-powers can also be described on the basis of *other categories*. Thus for instance it is possible to grant a “digitisation right” to works of music recorded by analogue technology. In terms of the categories of the statutory list of rights, the digitisation right is a special form of the right of reproduction (Art. 10 Para. 2 a, URG). This shows that the right of reproduction need not necessarily be granted in entirety and instead its scope can be restricted both in an assignment and in a licence.
- Finally, it is also common to *combine* the categories of the statutory list of rights and other categories. Thus for instance the right of reproduction (Art. 10 Para. 2 a, URG) to a scientific work can be granted “for a print edition” or for “online publication”. In this event, it is not the right of reproduction in entirety, but only a restricted aspect that is granted.

c) *Rights retained by the author*

72 In order to determine whether the author who has published his scientific work through a publisher is entitled to publish it in a repository at the same time, it is necessary to determine what rights have remained with the author.

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<sup>53</sup> In order to ensure legal certainty, the possibilities of dividing copyright are not unlimited, since legal certainty in business prohibits a ‘fragmentation’ of copyright, for more details see STAUB, p. 28 et seq.

- As a matter of principle, the publishing contracts lay down the *assignment* of rights.<sup>54</sup> In such cases, the author retains the sub-powers that he has not assigned to the publisher (or any third party) together with the sub-powers that, because they are tied to the person of the author, can, by virtue of the law, not be assigned at all (e.g. the author's right to oppose any distortion of his work that infringes his personality as laid down in Art. 11 Para. 2, URG).<sup>55</sup>
- If the publishing contract does not provide for the assignment but only the *licensing* of copyright to the publisher, the first question that arises is whether this is a non-exclusive or an exclusive licence. With a non-exclusive licence, the author is as a matter of principle at liberty to grant additional licences (for instance to the operator of a repository). In the case of an exclusive licence to the publisher, the author is not permitted to grant any further licences to the same rights within the scope of the exclusivity agreement (for instance if there is a time limit, up to expiry of the agreed exclusive period).

73 Once the rights remaining with the author have been determined, two further aspects must be taken into account:

- It is necessary to examine whether there is a limitation on copyright that allows the author to deposit his work in a repository, even if the corresponding rights have been transferred. This covers above all the limitation to the benefit of internal use (see below, paragraphs 197 et seq.).
- Conversely, it is also possible for the author not to be permitted to deposit his work in a repository although he actually holds the corresponding copyright. This is for instance the case if the author has contractually undertaken not to exercise the right (restrictive covenant).<sup>56</sup>

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<sup>54</sup> Thus also the (mandatory) provision of Art. 381 Para. 1, Code of Obligations.

<sup>55</sup> On the non-assignability of individual sub-powers see SEEMANN, p. 245 et seq.

<sup>56</sup> Restrictive covenants are laid down for instance in (mandatory) Art. 382 Code of Obligations, see below, Paragraph **Fehler! Verweisquelle konnte nicht gefunden werden.** et seq.

## 2. *Statutory provision*

### a) *Basic principle*

74 The publishing contract law of the OR is entirely in the form of non-mandatory law.<sup>57</sup> Thus statutory provisions only apply to the extent that the parties to the contract have not concluded any provision to the contrary (on the possible contractual provisions that differ from those under the OR, see below, paragraphs 106 et seq.).

75 The statutory provisions apply in particular if the publisher has published a work on the instructions of the author but without the publisher and the author having concluded specific legal agreements. Equally, the statutory provisions apply if the parties have corresponded or negotiated over a specific item but no agreement on this item has been concluded. If for instance the author, after conclusion of the contract, asks the publisher whether he is permitted to deposit his work in a repository, and if the publisher answers in the negative, this prohibition on deposit is not covered by an agreement between the two parties (always assuming that the publishing contract contains no provision to this effect), with the result that the right to deposit in a repository is determined by the statutory provisions.

76 The core provision for the question of the grant of the author's rights to the publisher is

*Art. 381 Para. 1, OR*

*The author's rights are only transferred to the publisher to the extent and for as long as is necessary for the performance of the contract.*

77 This provision is a case of application of the *purpose-of-transfer theory* that applies in copyright law and according to which the grant of rights is, in the event of doubt, only to the extent required by the purpose of the contract.<sup>58</sup> Applied to the publishing contract, this means that as a matter of principle, without a contractual provision to the contrary, only the right of reproduction and the right of distribution to the work are granted,<sup>59</sup> and

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<sup>57</sup> REHBINDER, *Urheberrecht*, Paragraph 164; CR-CHEPILLOD, note 10 before Art. 380–393; HILTY, *Verlagsvertrag*, p. 565.

<sup>58</sup> BSK-HILTY, Art. 381 note 4; REHBINDER, *Urheberrecht*, Paragraph 165.

<sup>59</sup> The reproduction and distribution rights are together referred to as 'publishing rights': REHBINDER, *Urheberrecht*, Paragraph 165 (p. 171).

even then only to the extent necessary to the performance of the contract.<sup>60</sup> In addition, the rights are granted for a limited period of time, i.e. only for the duration of the contractual relationship. However, Art. 381 Para. 1 of the OR lays down that these rights are *assigned* and not simply licensed (although this basic statement is qualified by Art. 382 Paras. 2 and 3 of the OR for articles, see below, paragraph 93).

78 However, account must be taken of the fact that the question of whether a scientist is permitted to deposit his work in a repository depends not only on what rights he has *assigned* (see below, paragraphs 82 et seq.) but also on any other additional provisions concerning the *exercise or non-exercise* of the rights (paragraphs 86 et seq.).

79 In the teaching, there is a controversial discussion as to whether the publishing contract law of the OR also applies to a purely online publication (online publishing contract).<sup>61</sup> On the one hand, the publishing contract law of the OR is not directed at online publications but rather at the *printing* of copies, by assuming a specific print run with a specific number of copies (see Art. 382 Para. 1, Art. 383, OR). On the other hand, it is theoretically possible to construe the OR's publishing contract law broadly and to apply it to online publications as well.

80 There is no need to decide on this disputed question here. In the final analysis, it is irrelevant whether online publications are subsumed under the *publishing contract law of the OR* or whether the online publishing contract is construed as a *special kind of publishing contract*. Whatever approach is adopted, it is the case that the law does not contain suitable provisions for various questions of online publication with the result that a separate appropriate solution must be found, with account being taken as far as possible of the values expressed in the publishing contract law of the OR.<sup>62</sup>

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<sup>60</sup> Since the reproduction right can for instance be divided into the right to a first edition, a paperback edition, a collected works edition etc. (BARRELET AND EGLOFF, Art. 10 note 13), the grant of rights, applying the purpose-of-transfer principle, only covers the proposed type of publication. That the right to a collected works edition does not transfer to the publisher unless both parties intend such also follows from Art. 386 Para. 2, Code of Obligations.

<sup>61</sup> *In favour*: PIAGET, p. 260 f.; HOCHREUTENER, p. 55; *opposed*: HILTY, Verlagsvertrag, p. 583 f.; REHBINDER, E-Book-Verlagsvertrag, p. 224 (but with differentiation); cf. also the prevailing opinion in *German* law arguing against the online publishing contract being subject to the German Publishing Act; see the overview of the various opinions in SCHMAUS, p. 45 et seq.

<sup>62</sup> From a methodological point of view, the publishing contract law in the Code of Obligations is taken into account either, depending on viewpoint, by means of *direct application and extensive construction where appropriate*, or by means of *application by analogy*.

81 As far as concerns the scope of the grant of rights, the purpose-of-transfer theory also applies outside the publishing contract law of the OR and hence not only to conventional publishing contracts but also to online publishing contracts.<sup>63</sup>

b) *Assignment of online rights*

82 The online publication of scientific works, for instance in repositories, requires the right to upload (reproduction right, Art. 10 Para. 2 a, URG)<sup>64</sup> and the right to make available (Art. 10 Para 2 c, URG).<sup>65</sup> For purposes of simplicity, these two rights will in the present legal opinion be subsumed under the collective term *online rights*.

83 The following sets out when, in the absence of an agreement to the contrary between the parties, the author grants the publisher the online rights according to the statutory provisions or the purpose-of-transfer theory.

84 A distinction must be made between three constellations:

- Conventional publishing contracts refer *exclusively to printed copies*. Such a contract is for instance concluded if the author wants a book printed and distributed or if he wishes to have a paper published in a journal that appears exclusively in printed form. In these cases, it is sufficient for the performance of the contract if the author grants the publisher the right of reproduction – restricted to printing and the necessary preparatory acts – and the right of distribution. For this reason, according to the statutory provision in Art. 381 Para. 1 of the OR, there is no grant of the online rights.
- Combined publishing contracts relate *both to printed copies and to online publication*. In such a case, the performance of the contract requires that the publisher also obtains the online rights.
- Online publishing contracts refer *exclusively to online publication*. In such contracts, it is not necessary for the publisher to be given the right of reproduction for the purpose of printing, or the right of distribution. It is sufficient if he is granted online rights.

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<sup>63</sup> Cf. BARRELET AND EGLOFF, Art. 16 note 20 (generally on the purpose-of-transfer theory).

<sup>64</sup> BARRELET AND EGLOFF, Art. 10 note 12; BU, p. 55; BÜHLER, p. 157 et seq.

<sup>65</sup> BARRELET AND EGLOFF, Art. 10 note 22a.

85 According to the provision of Art. 381 Para. 1 of the OR and the purpose-of-transfer theory, the scope of the rights granted is thus determined according to the type of use of the work proposed in the specific case. This is in particular of significance for publishing contracts that were concluded before the possibilities of the Internet became known (approx. 1995). For the latter, it is to be assumed that they were conventional publishing contracts in which online rights were not transferred unless the parties concluded a provision to the contrary (on this problem of the agreement concerning unknown types of use, see below, paragraph 111).

c) *Exercise of the online rights*

86 If the author has not assigned the online rights to the publisher, this does not automatically mean that he is himself entitled to exercise them and to deposit his works, for instance in a repository. Conversely, the assignment of the online rights does not in every case mean that the author is to be denied the right to deposit them in a repository.

87 The publishing contract law of the OR provides for particular restrictive covenants and exploitation rights that apply to the author as against the publisher.<sup>66</sup> The statutory provision reads as follows:

*Art. 382, OR*

<sup>1</sup> *Unless the editions of the work to which the publisher is entitled are out of print, the publishee is permitted to dispose elsewhere neither of the work in entirety nor of individual parts thereof to the publisher's disadvantage.*

<sup>2</sup> *Newspaper articles and individual smaller papers in journals can be republished by the publishee at any time.*

<sup>3</sup> *Contributions to collective volumes or larger contributions to journals may not be republished by the publishee before expiry of three months after the complete publication of the contribution.*

88 Art. 382 Para. 1 of the OR generally regulates restrictive covenants. In particular, it means that the author is not permitted to make an online publication during the term of the publishing contract if this is "to the dis-

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<sup>66</sup> In addition, as the user of his own work, the author has a certain scope on the basis of the copyright limitations, see below, Paragraphs **Fehler! Verweisquelle konnte nicht gefunden werden.** et seq.

advantage” of the publisher. This also applies even if the author has not transferred online rights to the publisher; in such a case, the author holds the online rights, however, pursuant to the law he is not permitted to exercise them. In factual terms, this is a contractual *prohibition on competition* for the protection of the publisher.<sup>67</sup>

89 If for instance the author has had a book printed and distributed, he is not permitted, until the edition is out of print, to offer it for downloading in a repository or on his personal Internet site if the transaction could damage the publisher. The potential for damage depends in particular on the practices in the subject discipline in question:

- Those publications for instance in the field of *law* are usually cited using page numbers. Accordingly, the potential for damage is considerably reduced if the author does not pass on the original publisher's PDF with the publisher's original page numbers. Such an online version is not capable of correct citation, and for this reason it is probably to be permitted for lack of capacity to compete.<sup>68</sup>
- In contrast, in the *natural sciences* and in *medicine*, citations of books normally simply refer to the book as a whole or a chapter thereof, but not to the page number. To this extent, an online version even without the original formatting and original page numbers is covered by the prohibition on competition in Art. 382 Para. 1 of the OR and therefore not permissible.

90 The restrictions in Art. 382 Para. 1 of the OR are qualified by Paras. 2 and 3 of the same Section with respect to newspaper articles, papers and contributions to collective works. The law makes a distinction between smaller and larger papers. According to teaching, the size of the paper cannot, however, be the decisive factor, with the result that the statutory criteria are to be applied with modifications. With this in mind, a distinction is to be made between *current reporting* on the one hand and *in-depth examination of topics* on the other hand.<sup>69</sup>

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<sup>67</sup> BK-BECKER, Art. 382 note 2. Thus the publisher can also take measures against uses for which it does not itself hold the copyright but which compete with its exercise of its copyright. Similarly, Sec. 9 Para. 2 of the *German VerIG* also grants an 'excessive' right to prohibit that in addition, and unlike Swiss law, applies not only against the publishee but also against everyone: SCHRICKER, Sec. 9 note 12 in conjunction with Sec. 8 note 9, 20 et seq.

<sup>68</sup> BSK-HILTY, Art. 382 note 2.

<sup>69</sup> BSK-HILTY, Art. 382 note 5; *IBID.*, *Verlagsvertrag*, p. 601; BK-BECKER, Art. 382 note 5, does not provide for such a modified application of the law.

- 91 For current reporting, Art. 382 Para. 2 of the OR entitles the author to publish it elsewhere at any time. Para. 3 entitles him to publish scientific papers dealing with the topic in depth elsewhere after expiry of a waiting period of three months after the date of the primary publication. This second publication is not restricted to a specific format, and can be in printed form just as much as online (e.g. in a repository). In addition, in this context it is irrelevant whether the first publication took place before the possibilities of the Internet became known (approx. 1995) or subsequently.
- 92 As a general rule, scientific papers come within the category of an in-depth treatment of the topic. The right to exploit according to Art. 382 Para. 3 of the OR permits the author to deposit the paper as early as three months after first publication, for instance in a repository. In certain disciplines (e.g. medicine), the paper could already be somewhat outdated after three months, while in others (e.g. theology) it is hardly likely to have lost any value.
- 93 This right to exploit, conferred by Art. 382 Para. 3 of the OR, for scientific papers also exists if the publishing contract relates to online publication and not only to printed copies (always assuming that the parties did not exclude the right to exploit in their contract). In theoretical terms, it could be assumed that the author has *assigned* online rights to the publisher pursuant to Art. 381 Para. 1 of the OR and in turn receives from the latter a *licence* to exploit pursuant to Art. 382 Para. 3 of the OR. A simpler approach than this backwards and forwards construct is, in the final analysis, an interpretation of the law according to which the author in such a case a priori only grants a licence to the publisher, which automatically allows the author to exercise copyright elsewhere – after expiry of the waiting period.<sup>70</sup>
- 94 As already mentioned, theory is not agreed as to whether the publishing contract law in the OR is also applicable to purely online publications (see above, paragraphs 79 et seq.). In this context, the question arises whether the restrictive covenants and the rights to exploit regulated in Art. 382 of the OR are appropriate for purely online publishing contracts. This

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<sup>70</sup> Interpreted in this way, Art. 382 Para. 2 and 3 Code of Obligations leads to a modification of the assignment principle (Art. 381 Para. 1, Code of Obligations): HILTY, *Verlagsvertrag*, 602; similarly also HOCHREUTENER, p. 112.

question is no doubt to be answered in the affirmative. Even in the online sector, restrictions contained in contracts serving to protect the publisher against competition are appropriate to the interests involved.

95 With respect to the restriction for newspaper articles, papers and contributions to collective volumes, the question might arise as to whether the waiting periods (none or three months) are also appropriate for the online sector. The Internet permits easy access to archives, with the result that the publisher might continue to have an interest in exclusive use even after expiry of the three-month period. However, of more importance is the argument that the ageing of a paper or report depends essentially on its content and not on the form of its publication. For this reason, it appears legitimate to apply the waiting periods of Art. 382 of the OR to online and printed publications equally, subject, of course, here and generally, to a contractual agreement to the contrary (see below, paragraphs 106 et seq.).

d) *Use of the publisher's PDF?*

96 If the author is entitled by virtue of the statutory provision (in the absence of an agreement to the contrary) to deposit his work in a repository, the question arises of whether he is entitled to use the publisher's PDF for this purpose.

97 Apart from the elements protected by trademark rights (for instance a publisher's logo entered in the Trademark Register) that the author can under no circumstances use without the entitled party's consent, an examination must be made above all of whether the layout as an achievement by the publisher is legally protected.

98 Protection against the exploitation of another's achievements is regulated in unfair competition law. In the present connection, it is to be assumed that the publisher's layout is published and for this reason does not constitute confidential information, with the result that it is not Art. 5 a and b of the UWG<sup>71</sup> but rather subsection c of this provision that is relevant:

*Art. 5 c, UWG*

*Shall be deemed to have committed an act of unfair competition, anyone who in particular by means of technical reproduction proc-*

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<sup>71</sup> BAUDENBACHER, Art. 5 note 30 with further references.

*esses and without a corresponding effort of his own, takes the marketable results of work of another person and exploits them as such.*

99 The publisher's PDF is indeed a "marketable result"<sup>72</sup> of work that can be exploited by the author using a "technical reproduction process", namely by copying a computer file. The question is whether he exploits it "without a corresponding effort of his own" within the meaning of Art. 5 c of the UWG, the author's efforts having to be set in relationship to the efforts of the publisher.<sup>73</sup>

100 If all that was to be considered was the production of the layout, it could be concluded that there has been no corresponding effort on the part of the author, since he can generate a copy of the publisher's PDF without any working effort whatsoever,<sup>74</sup> while the design of the layout by the publisher (assuming that the author has not himself provided the layout) can constitute a not insignificant use of labour, depending on the situation.

101 However, such an isolated consideration is not appropriate to the factual situation. On the contrary, account is to be taken of the fact that the publisher's PDF as a result of work consists not only of the layout but also, and mainly, of the contents of the publication, which have been created not by the publisher but by the author (even if a review process has contributed to an increase in its quality), while at the same time it has become common practice today for the author himself to largely assume responsibility for formatting, even if he thereby also follows the publisher's specifications. If account is taken of this aspect, there can no longer be a question of a parasitical usurpation of a work result created by the publisher.

102 Nevertheless, there remains a degree of legal uncertainty since there is no unambiguous and established practice on this issue. Moreover, it would be an oversimplification to rely merely on national law on this issue, since Art. 5 c of the UWG is unique in its concept; if a foreign law applies, other aspects can hence also come into play. Against this back-

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<sup>72</sup> According to the Federal Court, there is no need for a particular level of achievement as required for instance for copyright protection: BGer, sic! 1999, p. 300 et seq. E. 2b.

<sup>73</sup> Dispatch, BBl. 1983, p. 1071.

<sup>74</sup> Cf. BAUDENBACHER, Art. 5 note 56, according to whom the costs of simply copying data are so low that it can always be assumed that they are disproportionate to the costs of the creator of the data.

ground, the possibility of a court restricting its view to the question of the layout and prohibiting the adoption of the publisher's PDF by the author cannot be excluded in entirety. In any event, from the Swiss point of view the publisher cannot rely on Art. 5 c of the UWG if its costs (for the production of the layout) have already been paid off,<sup>75</sup> for instance if the publisher's PDF is used only after a waiting period during which it has been able to cover its costs.

e) *Result*

103 The statutory provision of publishing contract law only applies to the extent that the parties have not agreed the contrary. The author's rights are assigned to the publisher subject to the principle that only the rights necessary for the performance of the contract are assigned (Art. 381 Para. 1, OR, purpose-of-transfer theory).

104 However, the question whether the author is entitled to deposit his scientific work in a repository depends ultimately not on the question of the transfer pursuant to Art. 381 Para. 1 of the OR but rather on the contractual restrictive covenants and the rights to exploit regulated in Art. 382 of the OR. Accordingly, the following picture emerges:

- *Scientific papers* (where they deal with the topic in depth) can be published elsewhere by the author after expiry of three months after complete publication, hence they can also be deposited in a repository (Art. 382 Para. 3, OR).
- *Current reports* can be published by the author elsewhere, for instance in a repository, at any time, i.e. without a waiting period (Art. 382 Para. 2, OR).
- *Other works*, in particular monographs and textbooks, must not be published by the author elsewhere in competition with the publisher as long as the edition is not out of print. During the effect of the contract of publication deposit in a repository is, as a principle, not permitted unless it is a version that cannot be correctly cited (whereby different requirements are made of citability in the various disciplines) and that does not constitute genuine competition with the publisher's publication (Art. 382 Para. 1, OR).

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The calculation of the expenditure must include depreciation: BGer 4A\_404/2007 E. 4.3.

105 If, pursuant to the statutory provision, the author is entitled to deposit his  
work in a repository, he can, according to this author's opinion, use the  
publisher's PDF for this purpose. However, there is no established judicial  
practice on this point. For this reason, there remains the risk that a court  
may decide differently, applying Swiss law in the form of Art. 5 c of the  
UWG.

### 3. **Contractual provision**

#### a) *Basic principle*

106 The publishing contract law of the OR contains no binding regulations,  
nor are the provisions of the URG relating to contracts binding in most  
cases (see above, paragraph 26). As a matter of principle, publishing  
contracts do not infringe the binding provisions of competition law (see  
below, paragraphs 218 et seq.).

107 For this reason, the parties are generally *free to arrange* their contractual  
relationship and to accept STBs. In particular, they are at liberty to depart  
from the non-mandatory provisions of the law. Most publishing contracts  
provide for a very extensive or even comprehensive assignment of copy-  
right to the publisher.<sup>76</sup>

108 Once the parties have concluded a provision concerning the assignment  
of the rights, this agreement supplants not only the non-mandatory provi-  
sion of Art. 381 Para. 1 of the OR concerning the assignment of rights  
but, if appropriate, also the likewise non-mandatory provision of Art. 382  
concerning the restrictive covenants imposed on and the rights to exer-  
cise held by the author. If the parties have agreed on the assignment of  
the rights without providing for particular restrictive covenants and rights  
to exercise, it is to be assumed that they did not intend to impose any  
such special obligations and rights. In such a case, there is no scope for  
the application of Art. 382 of the OR.

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<sup>76</sup> See for instance CR-CHERPILLOD, note 11 before Arts. 380–393; likewise (for Germany) DOR-  
SCHEL, p. 239 et seq., who however also refers to the practice of a number of publishers that allow  
authors to pursue the 'Green Road' (above, Paragraphs **Fehler! Verweisquelle konnte nicht ge-  
funden werden.** et seq.) as open access strategy.

b) *Provisions concerning online rights*

109 Online rights (on the definition of online rights, see above, paragraph 82) can be assigned expressly or implicitly in the publishing contract. If the publisher is assigned for instance “all rights to the work” or “all copyright”, this includes online rights. If the publishing contract is not beyond doubt about the scope of the grant of rights and merely provides for the assignment of “copyright”, the purpose of the contract must be used to determine whether the online rights are included in the assignment (see above, paragraphs 82 et seq.).

110 If on the other hand only “publishing rights” or “reproduction and distribution rights” are assigned or licensed, this does not as a matter of principle cover online rights, or at least not in full (in particular, the right to make available is not covered, Art. 10 Para. 2 c, URG). The contrary applies at most if the context – e.g. the contractual negotiations – shows that in the specific case these rights were also intended to permit online use. In such a case, the wording of the contract is to be construed correspondingly broadly.

111 Contracts that were concluded before the possibilities of the Internet became generally known (approx. 1995) can also implicitly provide for the grant of online rights. Whether this is the case is to be determined by construing the specific publishing contract. If for instance “all copyright” or the “rights to previously unknown types of use” have been granted, such wording also covers the online rights common today. Swiss law does not prohibit the grant of rights concerning unknown types of use.<sup>77</sup>

112 If the author has assigned the online rights to the publisher or granted it an exclusive licence to these rights, the author is prevented from depositing the works in question in a repository unless the publisher permits him to do so separately.

113 If on the other hand the online rights are not transferred to the publisher, or if the author has only granted a non-exclusive licence to these rights, the author can deposit them in a repository. This is subject to the condition that no corresponding prohibition (on competition) has been agreed.

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<sup>77</sup> DE WERRA, Art. 16 note 28; BARRELET AND EGLOFF, Art. 16 note 9. Until recently, Sec. 31 Para. 4 of the German Copyright Act contained such a prohibition, which was repealed for contracts as of 1 January 2008.

c) *Provision concerning personal Internet sites*

114 Publishing contracts and publishers' STBs can permit the author to publish his work on his personal Internet site. Such a provision lies within the framework of the freedom of contract and is of itself permitted.

115 The term personal Internet site does not as a matter of principle only include an Internet site that is operated privately by the author as a platform for his own person. An institutional Internet site (for instance within the framework of the Internet presence of the university or another research institution) assigned to the author is also to be regarded as the latter's personal Internet site. The fact that the Internet site is located within an institutional context does not affect its reference to a person.

116 If the consent clearly only relates to publication on the author's personal Internet site, this cannot include the repository of the university that employs him. Such a construction would go too far. On the other hand, the operator of the repository is at liberty to set a hyperlink to the author's personal Internet site and the work made available there (see below, paragraphs 176 et seq.).

117 Difficulties of construction could arise if a publishing contract permits publication on the employer's Internet site. It must be clarified in the individual case, taking into account the specific circumstances, whether such wording also includes a repository that is operated by the employer (e.g. a university) or is only intended to permit publication on the author's personal Internet site within the framework of the employer's Internet presence (see above, paragraph 115). If the publishing contract itself distinguishes between the employer's Internet site on the one hand and a repository on the other hand,<sup>78</sup> this can be used to conclude that permission to publish on the employer's Internet site does not include depositing in a repository.

d) *Provision concerning author's version/publisher's PDF*

118 The freedom of contract likewise covers publishing contracts and STBs that distinguish between the published publisher's PDF and the manu-

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<sup>78</sup> Such as the American Society for Microbiology, whose contracts for the journals it publishes distinguish between 'institutional repositories' on the one hand and 'personal or employer websites' on the other hand ('ASM Journals Statement of Authors' Rights', [http://journals.asm.org/misc/ASM\\_Author\\_Statement.dtl](http://journals.asm.org/misc/ASM_Author_Statement.dtl)).

script accepted by the publisher (final author's version) and lay down that the author can only deposit the accepted manuscript but not the publisher's PDF in the repository.

119 Copyright law does not prevent such a contractual arrangement. Firstly, copyright in a work covers the appearance of both the publisher's PDF and the manuscript (see above, paragraph 18), with the result that the copyright holder can easily permit one type of use and forbid the other. Secondly, an arrangement according to which the author is only permitted to deposit the manuscript can be concluded purely contractually and even independently of the ownership of the copyright if the author agrees to such.

120 In legal terms, such a provision can have two meanings, depending on who holds the online rights to the work:

- If the author transfers the online rights in the publishing contract, the publisher becomes the holder of these rights. If the publisher simultaneously permits the author to deposit the author's manuscript in a repository, this consequently amounts to a (non-exclusive) *licence* from the publisher to the author's benefit.
- If the publishing contract does not provide for an assignment of the online rights, they are retained by the author, with the result that he is as a matter of principle entitled to deposit his work in a repository. If, however, the publishing contract only allows him to deposit it in the form of the accepted manuscript, this is a – contractual – *restrictive covenant* concerning the use of the publisher's manuscript, i.e. the agreement restricts the author's exercise of his online rights.

121 However, the publisher is also at liberty to expressly permit the author to use the publisher's PDF. The publisher can subject this to conditions, such as by permitting the deposit of the publishers PDF if the publisher's logo and the original publisher's page numbers are omitted.

122 If the parties have not concluded any regulation concerning the use of the publisher's PDF and if it follows from the contractual arrangements – or, in the absence thereof, from the law (in application of Art. 382 Paras. 2 and 3, OR, see above, paragraphs 90 et seq.) that the author is entitled to deposit his work in a repository – he can, according to this author's opinion, do so using the publishers PDF. However, it cannot be entirely

excluded that the court may decide differently in application of Art. 5 c of the UWG (see above, paragraphs 96 et seq.).

e) *Other provisions*

123 Other provisions can be adopted concerning the use of the work by the author.<sup>79</sup> A usual feature is to protect the publisher by providing for a *waiting period*, after expiry of which the work can be used elsewhere. If, however, the author is permitted by contract to deposit the work in a repository without providing for a waiting period (or a corresponding prohibition on competition), no waiting period applies. The parties are namely at liberty to depart from Art. 382 of the OR.

124 Some publishers' contracts also lay down that a use of the work elsewhere by the author must always contain a *hyperlink* to the Internet site of the publisher or the journal in which the work was published.

125 In addition, certain publishing contracts lay down that the work may be made available via the Internet but only if it is ensured that only a *restricted circle of persons* can have access to it. Such a restriction of the circle of persons can be established by making the work available only in a password-protected area. Another possibility for restricting the circle of persons is for the user not to retrieve the work directly from the Internet but to address an enquiry to the author, who then arranges for the user to be sent the work by e-mail (known as request-a-copy function, see below, paragraphs 179 et seq.).

f) *Result*

126 The parties to the publishing contract are as a matter of principle free to arrange the contractual relationship and as a matter of principle also to accept STBs. If they have concluded such a provision, it takes priority over the non-mandatory provisions of the law.

127 The agreement between the parties concerning online rights can be derived explicitly or implicitly from the contract. An assignment of online rights to the publisher can also result from contracts that were concluded before the possibilities of the Internet became known (approx. 1995).

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<sup>79</sup> See the overview of the practice of the individual publishers with respect to open access at [www.sherpa.ac.uk/romeo.php](http://www.sherpa.ac.uk/romeo.php).

Swiss copyright does not prohibit the grant of rights concerning unknown types of use.

128 Contractual provisions according to which the author is permitted to publish his work on his personal Internet site but not elsewhere are permissible. The same applies to an agreement that the author is only entitled to publish the manuscript but not the publisher's PDF online.

129 If the author is entitled to publish his work elsewhere, he is, in the present author's opinion, permitted, in the absence of an agreement to the contrary, to use the publisher's PDF or the publisher's layout, even if the publisher has not expressly given consent. In the absence of established judicial practice on this point, however, it cannot be excluded that the court will decide otherwise in application of Art. 5 c of the UWG.

#### 4. **Model clauses**

130 A model clause in publishing contracts that takes appropriate account of the open access principal and contains a corresponding provision to the author's benefit necessarily affects the publisher's interest in the undisturbed exploitation of the work.

131 From the point of view of the author, it would be ideal if he were not to assign any copyright to the publisher in the first place (in particular not online rights),<sup>80</sup> but were only to grant a non-exclusive licence to the work. Provided that the publishing contract did not contain a prohibition on competition, this would immediately allow him to deposit the work in a repository or to make it generally available elsewhere. However, such a wish list on the part of the author is hardly likely to be signed by the publisher.

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<sup>80</sup> To this end, Sec. 4 of the *SPARC* model contractual supplement (above, Fn. 40) provides that the copyright remains largely with the author. According to this proposal, the author retains inter alia 'the rights to reproduce, to distribute, to publicly perform, and to publicly display the Article in any medium for non-commercial purposes.' On this clause from the point of view of German law see MANTZ, *Open Access*, p. 100 et seq.

Similarly, Sec. 1 b of the *Science Commons* 'Open Access Law: Publication Agreement' (a Creative Commons project) provides that the author remains the holder of the rights: <http://sciencecommons.org/projects/publishing/oalaw/oalawpublication>.

Greater differentiation is to be found in the proposed 'Licence to publish' of the *Cooperation between the British JISC (Joint Information Systems Committee) and the Netherlands SURF foundation*, which on the one hand provides for a sole licence to the benefit of the publisher, while at the same time allowing the author to exercise the rights necessary for open access use (Clauses 2 and 3): [http://copyrighttoolbox.surf.nl/copyrighttoolbox/download/licence\\_to\\_publish.pdf](http://copyrighttoolbox.surf.nl/copyrighttoolbox/download/licence_to_publish.pdf)

- 132 More realistically, it is to be assumed that the publisher will use its typical market power in order to insist on the assignment of the copyright and will only be willing to make concessions to the extent that there is no serious risk of a threat to its sales. In order to permit open access use, the following proposes a contractual supplement that provides for a corresponding *licence* to the benefit of the author that only enters into effect after a *waiting period*. The imposition of a waiting period for open access use corresponds with the practice of a number of publishers already.<sup>81</sup>
- 133 Setting the waiting period at three months would appear appropriate since such a period is already established in current, although not binding, publishing contract law for articles in journals and collective volumes (Art. 382 Para. 3, OR). In order to increase acceptability for the publishers, however, a waiting period of six months is proposed here.
- 134 With respect to entire books (monographs, textbooks), publishers cannot be expected to consent willingly to open access use. For this reason, a relatively generous compromise would be a waiting period of three years. However, all of these periods are of course negotiable.
- 135 Since publishers as a matter of principle make use of pre-worded publishing contracts, which they will not easily be willing to replace, the following proposes a model clause that can also be signed separately as a contractual supplement (unless the publishing contract explicitly excludes such). In order to ensure the validity of the contractual supplement, it should be ensured that it is served not only on the publisher but also that its consent is given beyond doubt (see also above, paragraphs 56 et seq.).
- 136 A model clause within the meaning of the above remarks could read as follows:

*Supplement to the publishing contract*

*This supplement supplements the publishing contract between the parties and takes priority over any provisions to the contrary in the publishing contract.*

*After expiry of six months (in the case of entire books, after expiry of three years) after publication, the author shall be entitled to make this*

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<sup>81</sup> Cf. the list at [www.sherpa.ac.uk/romeo.php](http://www.sherpa.ac.uk/romeo.php).

*article available generally or empower third parties to do so using the internal networks of educational and research institutions, institutional repositories and his personal Internet site.*

*If the publisher assigns the rights to the author's work to a third party, the publisher shall ensure that the third party complies with the obligations resulting from the present supplement to the publishing contract.*

137 Another strategy, that likewise is already covered by the practice of a number of publishers,<sup>82</sup> would be not to lay down a waiting period but rather that the author is not permitted to make generally available the publisher's PDF but only an *author's version* (without publisher's logo and publisher's page numbers).

## V. Joint authors

138 If the work has been created by a number of persons, it must first be clarified which of them are to be regarded as *joint authors in the legal sense*. For a person to be regarded as a joint author, it is necessary for him to have participated creatively in the concrete creation of the work. It is not sufficient, in the case of scientific works, if the person merely bears responsibility for the content without participating specifically in the work; nor does work on the layout or mere auxiliary or basic work count (for further details on the whole, see above, paragraphs **Fehler! Verweisquelle konnte nicht gefunden werden.** et seq.).

139 If the circle of joint authors of the work has been determined, the question arises whether they have concluded a *publishing contract* or have agreed on *STBs* with respect to the work. As a matter of principle, an agreement concerning the use of copyright works is only valid if *all joint authors* have issued their consent; however, consent must not be refused in bad faith (Art. 7 Para. 2, URG). The publication of a work must therefore not be blocked by individual joint authors if the latter cannot provide a sufficiently important objective reason for such. As a matter of principle, the usual trade use of a work by the joint authors is to be permitted.<sup>83</sup>

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<sup>82</sup> Cf. here too the list at [www.sherpa.ac.uk/romeo.php](http://www.sherpa.ac.uk/romeo.php).

<sup>83</sup> BARRELET AND EGLOFF, Art. 7 note 10; VON BÜREN AND MEER, p. 158.

140 The consent of all joint authors is only dispensable if all joint authors have agreed on a different solution and for instance have determined that the consent of one or more joint authors is valid (Art. 7 Para. 2, URG). In such a case, a publishing contract can be validly concluded even without the consent of all the joint authors.

141 If a publishing contract has been concluded or if STBs have been agreed with the publisher, the same principles as applied to an individual author (see extensively above, paragraphs 65 et seq., 74 et seq., and 106 et seq.) apply to the question whether the work can be published in a *repositorio* simultaneously to the publication by the publisher.

142 If the publishing contract shows that such a deposit of the work in the repository is permissible, the deposit itself requires the consent of all joint authors unless they have already agreed that the consent of only one or some of the joint authors is sufficient (Art. 7 Para. 2, URG).

## VI. International constellations

### 1. *Legal venue*

#### a) *Within the scope of application of the Lugano Convention*

143 The remarks made so far all concerned Swiss law. However, the law of another country can also apply in international constellations.

144 In order to determine the applicable legal system, it must first be clarified whether there is any legal venue in Switzerland at all. In the relationship with most countries in Europe, the jurisdiction is determined according to the Lugano Convention (LC),<sup>84</sup> which takes precedence over the IPRG (Art. 1 Para. 2, IPRG). The LC has been revised and the new version (revised LC) will enter into effect for Switzerland at the earliest as of 1 January 2011.

145 The parties are at liberty to conclude an *agreement on the legal venue*. The court designated then enjoys exclusive jurisdiction provided that the agreement of legal venue complies with the requirements of Art. 17 of the LC/revised LC.

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<sup>84</sup> Signatories are currently Belgium, Denmark, Germany, Finland, France, Greece, Great Britain, Ireland, Iceland, Italy, Luxembourg, the Netherlands, Norway, Austria, Poland, Portugal, Sweden, Switzerland and Spain.

- 146 If *no legal venue has been agreed*, general jurisdiction according to Art. 2 Para. 1 of the LC/revised LC lies with the courts of the country in which the defendant has his domicile or registered office. If for instance the publisher files an action against the author, according to Art. 2 Para. 1 of the Convention a Swiss court enjoys jurisdiction if the author is domiciled in Switzerland, while whether the publisher's registered office is in Switzerland or abroad is of no consequence.
- 147 If an action is filed against an author with a foreign domicile (in a signatory state to the LC), there may be a specific legal venue in Switzerland under certain circumstances according to Art. 5 of the Convention. This question will not be examined in any depth here. Briefly, two possible cases of application can be determined:
- First of all, Art. 5 No. 1 of the Convention might apply, according to which an action based on contractual claims can be filed at the *place of performance*. However, if the case concerns the enforcement of contractual restrictive covenants that are not related to one particular country (for instance, if the author is contractually obliged to generally refrain from publishing his work in any repository), judicial practice is that this legal venue pursuant to Art. 5 No. 1 of the Convention does not apply.<sup>85</sup>
  - Another possibility of bringing an action in Switzerland against an author domiciled abroad is provided by the legal venue for torts pursuant to Art. 5 No. 3 of the Convention, which also relates to breaches of copyright.<sup>86</sup> This legal venue is at the *place of the act or the place of the effect*,<sup>87</sup> which could therefore be in Switzerland if the breach of copyright is the result of the publication of a work in a Swiss repository. If access to the repository is also possible in another country, however, this country will (also) be the place where the harmful effect occurred, thereby establishing a further legal venue; simply carrying out the act in Switzerland alone is not sufficient in order to avoid litigation abroad. The legal venue for tort also applies if it must first be clarified whether a contract permits the use of the work in

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<sup>85</sup> ECJ Case No. C-256/00 dated 19 February 2002, Paragraphs 21 et seq.

<sup>86</sup> OBERHAMMER, Art. 5 note 130; BSK-JEGHER, Art. 109 note 30.

<sup>87</sup> ECJ Case No. 21-76 dated 30 November 1976; OBERHAMMER, Art. 5 note 133.

question,<sup>88</sup> for instance whether the author is entitled to deposit the work in a repository on the basis of the publishing contract or not.

*b) Outside the scope of application of the Lugano Convention*

148 International situations that do not fall within the scope of application of the LC are as a matter of principle to be determined according to the IPRG. This law also permits the agreement of the legal venue if the statutory preconditions are satisfied (Art. 5, IPRG).

149 *In the absence of an agreement on legal venue*, similarly as within the scope of application of the LC, it is as a matter of principle the court at the defendant's domicile or, in the absence of such in Switzerland, his ordinary place of residence<sup>89</sup> that enjoys jurisdiction, both for actions based on the publishing contract (Art. 112 Para. 1 IPRG) and those based on copyright (Art. 109 Para. 2 sentence 1, IPRG). If the publisher brings an action against the author, the Swiss courts enjoy jurisdiction if the domicile or the place of residence of the author is in Switzerland, while the publisher's registered office or business establishment is of no relevance.

150 If the action is brought against an author whose domicile is abroad, there are again two indications for a legal venue in Switzerland:

- First of all, a contract law legal venue at the *place of performance* is possible, i.e. at the place in which the performance is to be provided in Switzerland (Art. 113, IPRG). However, there is no established teaching or judicial practice on the question of what happens with geographically undefined restrictive covenants.<sup>90</sup> If the author undertakes to refrain from publication in repositories, it has not yet been determined whether this can be used to derive a Swiss legal venue on the basis of Art. 113 of the IPRG.
- As within the framework of the LC, the IPRG also provides for a legal venue at the *place of the act and of the effect* for breaches of copy-

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<sup>88</sup> KROPHOLLER, p. 152, on the practically identical provision of Art. 5 No. 3 of EC Regulation No. 44/2001.

<sup>89</sup> The ordinary place of residence is 'where the person lives for a longer period of time, even if this period is a priori limited' (Art. 20 Para. 1 b Act on International Private Law).

<sup>90</sup> Without comment on this, ZK-KELLER AND KREN KOSTKIEWICZ, Art. 113 note 16 et seq.; in BSK-AMSTUTZ, VOGT AND WANG, Art. 113 note 9, the restrictive covenant is mentioned but without any discussion of the problem of the restrictive covenants that are not defined geographically and for which reason apply 'everywhere'.

right (Art. 109 Para. 2 sentence 2, IPRG). Here too, account must accordingly be taken of the risk of an action being brought in countries in which the acts of infringement have an effect, in particular as a result of Internet content being available.

## 2. *Applicable law*

151 If a Swiss court enjoys jurisdiction, it must, according to the Swiss IPRG, determine whether the case is subject to Swiss or foreign law (if jurisdiction is enjoyed by the court of a foreign country, the applicable law is to be determined according to the conflict of law rules of that country). If a publisher brings an action against an author for having made his work available in a repository, a distinction must be made according to whether the action is based on intellectual property law or contract law.

### a) *Contract law*

152 In the case of an action by the publisher, *contract law questions* are frequently to the fore, the applicable law being derived from Arts. 116 et seq. of the IPRG. These provisions relate in particular to the *conclusion, the content, the validity and termination of the contract*.<sup>91</sup> They are as a matter of principle also applicable to the construction of the contract in order to determine its content (e.g. in order to determine whether the author is entitled to exercise the online rights to his work).

153 The publishing contract can provide for a *choice of law* for the contract, which must satisfy the requirements of Art. 116 of the IPRG.

154 If the parties have *not concluded a choice of law*, the applicable law for publishing contracts is determined according to Art. 117 of the IPRG. According to the prevailing theory, Art. 122 of the IPRG, under the heading Contracts concerning Intellectual Property Rights, does not apply to publishing contracts, although publishing contracts also mostly concern intellectual property rights (copyright).<sup>92</sup>

155 The prevailing view links the applicable law to the *characteristic performance* (Art. 117 Para. 2, IPRG) of the publishing contract, and regards this

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<sup>91</sup> ZK-VISCHER, Art. 122 note 11; BSK-JEGHER AND VASELLA, Art. 122 note 13.

<sup>92</sup> HILTY, *Verlagsvertrag*, p. 570; CR-CHEPILLOD, note 14 before Art. 380 Fn. 29; reaching the same conclusion ZK-VISCHER, Art. 122 note 24, according to whom 'a correction of Art. 122 Act on International Private Law is to be made via Art. 117'.

as being the reproduction and distribution of the work by the publisher. Accordingly, the law of the country in which the publisher has its place of business applies as a matter of principle.<sup>93</sup>

156 This means that the decisive factor is not the author's domicile or place of residence. If for instance joint authors from various countries conclude a publishing contract with a publisher based in Switzerland, Swiss law applies as a matter of principle. Conversely, a contract with a foreign publisher is as a matter of principle subject to the law of this foreign country.

b) *Intellectual property rights*

157 If the court has to determine questions that relate not to the contract but to copyright as such, Art. 110 of the IPRG applies in this respect. This provision is used to determine the applicable law, in particular with respect to the *creation of the work and the content, limitations, transferability and protected period of copyright*.<sup>94</sup>

158 Pursuant to Art. 110 Para. 1 of the IPRG, such intellectual property right questions are to be determined according to the law of the country for which the protection of intellectual property rights is claimed. This *country-of-protection principle* is a manifestation of the territoriality principle, which means that there is no worldwide uniform copyright to work but rather a multiplicity of parallel national copyrights concerning one and the same work.<sup>95</sup>

159 The fact that the starting point is the country for which copyright protection is claimed conversely means that the publisher's place of business, unlike in questions concerning contract law (see above, paragraph 155), plays no decisive role. Nor is the author's or joint authors' domicile or place of residence relevant.

160 A departure from the country-of-protection principle by means of a *choice of law* is only possible within the narrow limits laid down by Art. 110 Para. 2 of the IPRG. Firstly, the choice of law can only be made following the

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<sup>93</sup> ZK-KELLER AND KREN KOSTKIEWICZ, Art. 117 note 89, 133; ZK-VISCHER, Art. 122 note 24; HILTY, Verlagsvertrag, p. 568; CR-CHERPILLOD, note 14 before Art. 380; disagreeing, BSK-AMSTUTZ, VOGT AND WANG, Art. 117 note 45, who distinguish according to whether the publisher pays the publisher compensation.

<sup>94</sup> BSK-JEGHER AND VASELLA, Art. 122 note 13; HILTY, Verlagsvertrag, p. 571.

<sup>95</sup> ZK-TROLLER, Preliminary comment to Arts. 380–393 note 42; BÄR, p. 136 et seq.; REHBINDER, Urheberrecht, note 218 (indicatively: 'bundle of national copyrights'), note 220.

occurrence of the damaging event, and secondly it is only possible to select the law of the legal venue (which is pointless if this law would also apply without choice of law on the basis of the country-of-protection principle<sup>96</sup>).

161 The distribution of works via the Internet as a matter of principle gives rise to *cross-border infringements of rights*, with the result that for the application of the country-of-protection principle, it is first necessary to determine the country where the potential infringement of copyright is located. Uploading works on the Internet (reproduction pursuant to Art. 10 Para. 2 a, URG) takes place at the location of the Internet server to which the work is copied.<sup>97</sup>

162 If for instance a publisher objects to an author having deposited his work in a Swiss repository (i.e. on a server located in Switzerland), and if the publisher demands the removal of the work, he can do this by means of an action for abatement (Art. 62 Para. 1 b, URG). Because the place of the infringement that the publisher wishes to have eliminated is in Switzerland, *Swiss law* applies pursuant to the country-of-protection principle provided that the case concerns purely copyright questions and not questions concerning publishing contract law.

163 In theoretical circles, there is a discussion of whether, in the case of works that are placed on the Internet by means of a Swiss server, *the foreign law* of the country in which the work is available can also apply. The deposit of works in a repository affects not only the right of reproduction but also the right to make available (Art. 10 Para. 2 c, URG).

164 If a work is deposited in a Swiss repository, the literature rightly upholds the view that the work has been "made available" not only in Switzerland as the location of the server but also in the foreign country of reception; in other words, the breach of copyright is located not only in Switzerland but also in the countries of reception.<sup>98</sup>

165 If for instance a publisher requires the author not to make available the work in certain countries, it is the law of these countries that applies in

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<sup>96</sup> BSK-JEGHER, Art. 110 note 29.

<sup>97</sup> STIESS, p. 198, 200; KATZENBERGER, note 145 before Secs. 120 et seq.

<sup>98</sup> To quote KATZENBERGER, note 145 before Secs. 120 et seq. with further references (concerning German law); this approach is also adopted (for Swiss law) in the comment by BÄR, p. 148 et seq., according to whom the 'possibility of reception in other states' may infringe their rights.

this respect. In normal cases, however, an action for abatement would be more efficient if it takes as its starting point the Swiss place of the copyright infringement and a priori forbids the Swiss repository (applying Swiss law) from storing copies of the specific work on the Swiss server, since this automatically also prevents the work being made available in all other countries.

c) *Result*

166 In determining the applicable law, a distinction must be made, according to the Swiss IPRG, between questions of contract law and questions of copyright law. In the relationship between the author and publisher, it will often be contractual aspects such as the conclusion and construction of a publishing contract that are disputed. These aspects are subject to the *law of the country in which the publisher has its place of business* (Art. 117 Para. 2, IPRG) unless a choice of law to the contrary has been concluded (Art. 116, IPRG).

167 This means that in a dispute with a foreign publisher, it is as a matter of principle the corresponding *foreign law* that applies whether by virtue of Art. 117 Para. 2 of the IPRG or by virtue of a choice of law agreed in the publishing contract. Swiss law is only applicable in such a case to the extent that the case concerns copyright law as such and if copyright protection is claimed for Switzerland (e.g. in the case of an action for the removal of the work from an Internet server located in Switzerland).

## VII. Conclusion

168 This Section C. has set out the open-access problem from the point of view of the author. In this context, the decisive factor is that in Swiss copyright law and publishing contract law it is largely the principle of *freedom of contract* that applies. The parties are theoretically at liberty to conclude a publishing contract that permits the author not only to have his work published by a publisher but also to publish it simultaneously in a repository – either in the form of the publisher's PDF or in an author's version (without the publisher's logo and publisher's page numbers).

169 In practice, however, it is as a matter of principle the publishers that determine the contractual conditions. In this situation, the freedom of contract generally works to the detriment of the author, since the publishers

frequently ensure that all rights under copyright are transferred, with the result that they can prohibit the work being deposited in a repository.

## D. From the repository operator's point of view

### I. Overview

170 Repositories are Internet servers that make available a large number of scientific publications online. Operators of repositories are mostly universities and other research institutions, as is reflected in the frequent use of the term institutional repository.<sup>99</sup> Repositories contribute to the implementation of the open-access principal by acting as interface between authors and users and allowing users free access to scientific works via the Internet.

171 Since scientific publications are as a matter of principle protected by copyright, the operator of the repository requires the corresponding copyright for his activity (below, II. and III.), otherwise he would be liable for the corresponding breaches of copyright (IV.). Finally, the legal situation for international constellations is set out (V.) and the conclusions are drawn (VI.).

### II. The starting point under copyright law

#### 1. *Deposit of copies of works*

172 Repositories are used for the depositing of digital copies of scientific works. The purpose of this is to make the work available to the general public and to archive the work in a manner that is technically most appropriate. As a consequence, the depositing process is to be classified under copyright law (see also above, paragraph 82).

173 Deposit takes place by the work being uploaded, i.e. a digital copy of the work being stored on the Internet server. This use of the work falls within the *right of reproduction* pursuant to Art. 10 Para. 2 a of the URG.<sup>100</sup> It is not in every case that the repository operator handles the uploading. It is also possible to arrange the repository in such a way that the author himself can deposit a copy of the work there. Under certain circumstances, the deposit of a copy of a work may involve additional – under certain cir-

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<sup>99</sup> On the definition of the institutional repository see BARGHEER, BELLEM AND SCHMIDT, p. 1 et seq.; in depth on this point, JONES, ANDREW AND MACCOLL, p. 1 et seq.

<sup>100</sup> BARRELET AND EGLOFF, Art. 10 note 12; BÜHLER, p. 157 f.

cumstances not stable – digital copies such as on a further server or on data carriers for back-up purposes.

174 The operator of the repository makes available the work on the Internet. This falls within the *right to make the work available* pursuant to Art. 10 Para. 2 c of the URG.<sup>101</sup>

175 The two rights, of reproduction (for the purpose of uploading) and of making available are subsumed in the following under the collective term *online rights* (see above, paragraph 82). For his activity, the operator of the repository requires the online rights for the works that he makes available.

## 2. *Link to copies of the work*

### a) *Hyperlinks*

176 Another possibility for the repository operator is not to make available the scientific works himself but simply to place a hyperlink on his Internet site that leads to these works. In this way, the operator of the repository can for instance link to the scientist's personal Internet site and to the works that the latter publishes there.

177 The mere setting of hyperlinks is as a matter of principle not a copyright use of the work to which the link is made. This is basically a mere reference to a work to be found on another Internet site, with the special feature that the hyperlink permits easy and rapid access to the work.<sup>102</sup>

178 However, hyperlinks are not unobjectionable in every case. They may be of copyright relevance in particular in two cases:

- If the hyperlink consists of more than just one or a few key words, and if instead a copyright part of the destination site (e.g. a picture or a short text) is integrated in the repository's own Internet site, this as a matter of principle constitutes a copyright use for which the rightholder's consent is required.<sup>103</sup>
- If the hyperlink refers to an Internet site with content that breaches copyright, this link can constitute a contribution to the copyright in-

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<sup>101</sup> BARRELET AND EGLOFF, Art. 10 note 22a.

<sup>102</sup> R. H. WEBER, E-Commerce, p. 247; IBID., Suchmaschinen, p. 65.

<sup>103</sup> HILTY, Link, p. 139 with further references; cf. also BU, p. 63 f.

fringement by a user. In such a case, the remedies available under copyright law can also be asserted against the operator of the repository.<sup>104</sup> There is no such infringement of copyright by the user – and a corresponding participation by the operator of the repository – if the user is entitled to use by virtue of the statutory limitations for personal or internal use<sup>105</sup> (see below, paragraphs 253 et seq.).

b) *“Request a copy” function*

179 Some repositories apply a further kind of link by means of the request-a-copy function. This consists of the repository not releasing a specific work directly for access on its Internet site, which instead contains a request-a-copy field that can be clicked by the user if he wants a copy of the work. The author of the work in question is then sent an e-mail allowing him to accept or reject this request. If the request is accepted, the user is sent the work by e-mail.

180 The referral of the user to the author is irrelevant for copyright purposes. In contrast, the necessary copyright is required for the sending of the work to the user, since this constitutes both a reproduction (Art. 10 Para. 2 a, URG) and a distribution of the work (Art. 10 Para. 2 b, URG).<sup>106</sup> A significant factor is whether the work is sent solely by the author or whether the operator of the repository participates in this process (for instance if the sending is only triggered by the author but actually takes place from the repository operator's Internet server).

181 Thus there is no distinction between the generally available deposit in the repository and the request-a-copy function to the extent that both require the entitlement to use the necessary rights. In practical terms, however, an important factor is that the request-a-copy function leads to specific *difficulties of furnishing evidence* when the rights are to be enforced. For an outsider (for instance a publisher who wishes to take action against the operator of the repository), the technical structure of the request-a-copy function is not transparent, with the result that it will not always be

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<sup>104</sup> Within the meaning of Art. 50 Para. 1, Code of Obligations, actions can be brought against ‘instigators, perpetrators or accessories’: BARRELET AND EGLOFF, Art. 62 note 5; in depth RUBLI, note 112 et seq.

<sup>105</sup> This is referred to by STRAFNER, p. 61 et seq. (concerning German law, and with further references).

<sup>106</sup> The term ‘distribution’ also includes ‘electronic acts of disposal’: BARRELET AND EGLOFF, Art. 10 note 16.

easy for him to determine whether any breaches of copyright have been committed solely by the author or also by the operator of the repository.

### III. Entitlement to the copyright required

#### 1. *Entitlement through author's consent*

##### a) *Scope of consent*

182 The operator of the repository can himself acquire the online rights to the work to be deposited from the author, provided that the latter has not already disposed of the rights elsewhere.

183 If the author consents to the work being deposited in the repository without concluding an express agreement with the operator about the type of grant of rights, the purpose-of-transfer theory (see above, paragraph 77) assumes that the author only grants a non-exclusive licence and does not assign any rights. The purpose of the grant of rights here is only the deposit; unlike a publisher, the operator of a repository as a general rule does not intend to exploit the work as comprehensively as possible.<sup>107</sup>

##### b) *By author bound by publishing contract*

184 If the author is already bound by a publishing contract, it must be determined whether he is at all entitled to issue his consent to the deposit. The individual legal relationships between the author, the publisher and the operator of the repository must be clearly distinguished:

- *Relationship between publisher and author:* If a publishing contract does not permit the author to deposit his work in a repository, and if the author does so nevertheless, he is in breach of the publishing contract and can be sued by the publisher.
- *Relationship between the author and the operator of the repository.* By depositing a work in the repository, the author concludes a second contract concerning the copyright in his work alongside the publishing contract. The author can only grant the operator of the repository copyright to the extent that he still retains it pursuant to the publishing contract with the publisher.

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DORSCHER, p. 238 et seq.

- *Relationship between the operator of the repository and the publisher:* The operator of the repository is not a party to the publishing contract (concluded between the publisher and the author) and can for this reason not infringe this contract. However, the publishing contract is of relevance for the operator of the repository to the extent that the author cannot grant effective consent to the operator if he has already assigned his copyright to the publisher or granted it an exclusive licence. In these cases, an action for breach of copyright can be filed by the publisher against the operator who makes the work available to the public.<sup>108</sup>

185 As already stated, it is not always easy to determine whether a publishing contract between the author and the publisher also includes the online rights, whether the author remains entitled to deposit his work in a repository and the extent to which he is entitled to use the publisher's PDF or an author's version for this purpose (see above, paragraphs 65 et seq.).

186 The repository operator who wishes to eliminate the risk of having to bear the consequences of a breach of copyright has as a matter of principle two possibilities. Either he clarifies the legal situation himself or he transfers the – at least financial – risk to the author by providing in the contract with the author that the latter guarantees the validity of the copyright required and that he will indemnify the operator in the event of an infringement (see below, paragraphs 232 et seq.).

c) *Author bound by contract of employment*

187 If the author is employed at the university that operates the repository, the employer can be granted the necessary copyright by means of the contract of employment. Admittedly, the principle applies that university employees who work independently in their subject (i.e. do not work as assistants) are themselves entitled to dispose of the results of their work.<sup>109</sup> However, the university is at liberty to depart from this principle in the contract of employment and require the author to grant it the online

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<sup>108</sup> In the case of an *exclusive licence* the publisher's right to file an action derives from Art. 62 Para. 3 of the Copyright Act, which entered into effect on 1 July 2008, but which is only applicable to contracts concluded or confirmed after 1 July 2008 (according to the transitional provision in Art. 81a of the Act). For older contracts, the publisher only has a right to file an action if the author has specifically granted such a power, see BARRELET AND EGLOFF, Art. 62 note 21 with further references.

<sup>109</sup> REHBINDER, Urheberrecht, Paragraph 173 (p. 177 et seq.).

rights (the legal basis of such an obligation may also be the applicable university legislation, see below, paragraphs 302 et seq.).

188 Such measures would of course mean that the university was restricting the author's freedom to dispose of his publications, which ultimately would constitute a deterioration of his working conditions. Likewise, his position as against the publishers would be weakened. Under certain circumstances, a scientist who is obliged by contract of employment to publish his works on the Internet in a repository will not easily find a renowned specialist journal that is willing to publish his work under these conditions. Whether this would ultimately be in the interests of the university – which is after all competing for the best scientists<sup>110</sup> – is doubtful.

189 Political resistance is already developing against such contractual conditions. In the Heidelberg Appeal, published in March 2009 and since then signed not only by publishers but also by numerous scientists, any coercion to publish in a specific form is criticised as being unacceptable.<sup>111</sup>

## 2. *Entitlement through publisher's consent*

190 It is also conceivable for the operator of the repository to receive the copyright needed from the publisher. Such a co-operation between the repository operator and the publisher would have the advantage that the operator would not have to ask each individual author for the rights but could agree a package solution concerning a number of works with the publishers concerned.<sup>112</sup> However, such co-operations are often prevented by the fact that conventional publishers perceive open access publications as undesirable competition.<sup>113</sup>

191 The grant of copyright is not limited to a specific form. For this reason, it is necessary to examine whether specific conduct on the part of a publisher can be interpreted as implied consent (i.e. expressed by means of

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110 HILTY AND BAJON, p. 262.

111 'For freedom of publication and the guarantee of copyright': [www.textkritik.de/urheberrecht/index.htm](http://www.textkritik.de/urheberrecht/index.htm).

112 Such as the cooperation between the State of Lower Saxony State and University Library at Göttingen with the Springer Verlag: [www.sub.uni-goettingen.de/ebene\\_2/oa\\_journals/springer.html.de](http://www.sub.uni-goettingen.de/ebene_2/oa_journals/springer.html.de).

113 Cf. from the publisher's point of view, VON LUCIUS, p. 96: '[...] the supporters of the Green-Road version of open access are happy to leave it to the publishers to organise, produce and finance the journals and then after six months, by means of what amounts to expropriation, propose to deny them any opportunity whatsoever to achieve any further earnings without a subject-specific or commercially differentiated analysis.'

corresponding conduct). If for instance a publisher has made a scientific work freely available on the Internet itself, the question arises whether this can be regarded as consent to this work also being made available by third parties.

192 This question is basically to be answered in the negative. If the publisher makes a work available on the Internet and this offer is taken up, a copyright contract is automatically concluded between the publisher and the user. This is to be construed according to the purpose-of-transfer theory, i.e. copyright is only regarded as granted to the extent necessary for the purpose of the contract (see above, paragraph 77). The user only requires the right of reproduction (Art. 10 Para. 2 a, URG) to download the work. In contrast, the publisher's conduct cannot be used to conclude that the user is also intended to receive the right to make available (Art. 10, Para. 2 c, URG).

193 In the final analysis, the fact that the publisher makes the work freely available by no means suggests that he is abandoning the corresponding copyright in full. On the contrary, such an action is only to be regarded as a licence to the benefit of the user who may himself use the work but, without express permission, is not entitled to make it available publicly himself. For this reason, in such a case the operator of a repository is prevented from depositing the work such that it is freely available.

194 The same applies to scientific articles in journals that are subscribed to by the repository operator. Even an on-line subscription only entitles the operator of the repository to use the contents of the journal for his own purposes but not to communicate it publicly on the Internet.

195 If the publisher holds the necessary copyright to the scientific work, the requirement of the publisher's consent cannot be circumvented by slightly changing the work. In particular, the use of the scientific work in a different layout – for instance omitting the publisher's logo and the original page numbers – cannot be made without the publisher's consent (the omission of the original page numbers can, however, be relevant within the framework of the publishing contract between the author and the publisher, see above, paragraph 89).

196 The publisher's consent would only be dispensable if the content of the work was changed so considerably that the essential features of the

original work paled by comparison.<sup>114</sup> Simply shortening or rearranging the text is not sufficient. Nor as a matter of principle is consent necessary if the repository operator only inserts a hyperlink to the publisher's publications that are freely available, provided that he complies with the general preconditions for this (see paragraphs 176 et seq.).

### 3. *Entitlement by virtue of statutory limitations*

#### a) *Limitation for internal use*

197 The deposit of works in a repository is permissible without the consent of the party entitled to the copyright if it is covered by a limitation, in particular the limitation for internal use. According to this, the internal use of works is permitted by virtue of the law even where the author has assigned the online rights to the publisher or granted it an exclusive licence.

198 Internal use is regulated in Art. 19 Para. 1 c of the URG, account having to be taken in particular of the restrictions in Para. 3 of the provision.<sup>115</sup>

#### *Art. 19 Paras. 1 c and 3, URG*

<sup>1</sup> *Published works may be used for individual purposes. Individual purposes shall mean:*

...

c. *the reproduction of copies of a work in enterprises, public administrations, institutes, commissions and similar bodies for internal information or documentation.*

<sup>3</sup> *The following shall not be permissible outside the private circle:*

a. *the complete or largely complete reproduction of copies of works available commercially;*

b. *the reproduction of works of fine art;*

c. *the reproduction of graphic representations of musical works;*

d. *the recording of the delivery, performance or presentation of a work on phonograms, videograms or data carriers.*

<sup>114</sup> REHBINDER, Urheberrecht, Paragraph 98.

<sup>115</sup> For purposes of clarity, only part of Art. 19 Copyright Act is reproduced here.

- 199 The limitation is not restricted to businesses in the narrower sense but, according to the wording of Art. 19 Para. 1 c, URG, also extends to the use of the work in public administrations, institutes, commissions and similar bodies. The legal form or separate legal personality is of no relevance.<sup>116</sup> The circle of entitled parties is thus worded broadly,<sup>117</sup> with the result that it also covers universities, scientific institutes and other scientific organisations.<sup>118</sup>
- 200 The fact that entitlement extends to universities also means that internal use permits the exchange of information within the entire university and not only within its individual institutes. The mention by name of institutes in Art. 19 Para. 1 c, URG, means above all that independent institutes not integrated in universities can rely on this limitation. It cannot be used to derive a restriction of the exchange of information to parts of the university.
- 201 According to the wording of Art. 19 Para. 1 c of the URG, the limitation only permits the “*reproduction of copies of works*”. However, this wording is too narrow and must be construed broadly in the light of the purpose of the provision – internal information and documentation. Since it is today usual to use electronic networks (e.g. intranet) for information and documentation purposes, the term reproduction in this context must also include the right to make available.<sup>119</sup> As a result, making available by a repository as a matter of principle also falls within the limitation of internal use.
- 202 The limitation only extends to “*internal*” use of the work. General availability in the sense of the open-access principle, i.e. without restriction to a specific circle of persons, is not permitted by the limitation. Thus for instance it does not cover the exchange of data *between* universities. The internal group of persons comprises firstly the employer and the employees. If a research institution is organised as an association, association

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<sup>116</sup> GASSER, *Eigengebrauch*, p. 91 et seq.

<sup>117</sup> Entitlement extends to ‘the entire professional and working world’: BARRELET AND EGLOFF, Art. 19 note 16.

<sup>118</sup> Cf. also the first preliminary drafts of the Copyright Act, according to which ‘scientific institutions’ were expressly still included amongst the entitled parties: Art. 29 Para. 3 Preliminary Draft 1971 (UFITA 66/1973, p. 184), Art. 31 Para. 1 Preliminary Draft 1974 (UFITA 72/1975, p. 231).

<sup>119</sup> BGE 133 III 473 et seq. E. 3.1 and 3.2; BARRELET AND EGLOFF, Art. 19 note 16.

members as well as staff are regarded as internal.<sup>120</sup> In the case of universities, the question arises whether students and postgraduates are also included within the internal circle. This is no doubt to be answered in the affirmative. For the university, students and postgraduates are not external customers in the legal sense,<sup>121</sup> but are members of the institution.<sup>122</sup>

203 The limitation for internal use relates only to published works (Art. 19 Para. 1 Sentence 1, URG). Internal use is subject to payment of a fee (Art. 20 Para. 2, URG). The fee is collected by an approved collecting society such as Pro Litteris (Art. 20 Para. 4, URG), which distributes the proceeds to the entitled authors (Art. 49, URG).

204 According to judicial practice and teaching, the authorised person must have had lawful access to the copy of the work used internally.<sup>123</sup> Thus the internal copying of a stolen book is not permitted. Of interest in this connection is the fact that, in application of Art. 39a Para. 4 of the URG, there is a statutory authorisation to use copies of works internally that have been obtained by circumventing technical protection measures; accordingly, such a circumvention can in this context not be treated as the same as theft (see below, paragraphs 258 et seq.).

205 If the entitled person is lawfully in possession of a copy of the work, the applicability of the limitation is not affected by who holds the copyright to the work in question. If for instance an author has concluded a publishing contract with the publisher and has received a publisher's PDF and galley proofs from the publisher, but has assigned all copyright to the publisher, the author is lawfully in possession of the publisher's PDF within the meaning of the URG (and in particular has not stolen it). For this reason, he is entitled to use them internally, provided that this is not forbidden by the publishing contract.

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120 GASSER, *Eigengebrauch*, p. 92; CHERPILLOD, *Schranken*, p. 279.

121 Customers are regarded as external persons: BARRELET AND EGLOFF, Art. 19 note 16; GASSER, *Eigengebrauch*, p. 93.

122 See for instance the Universities Act of the Canton Zurich (Regulation No. 415.11), which includes 'students' (Sec. 13 et seq.) amongst the 'members' (according to the heading to Sec. 8 et seq.) of the university.

123 BGE 128 IV 201 et seq. E. 3.5; GASSER, *Eigengebrauch*, p. 60 et seq. In the literature, a distinction is made between the question of the user's lawful access and the further (and related) question whether the copy of the work has been made lawfully and made accessible lawfully, or whether it is a pirate copy (see below, Paragraph 256).

- 206 The same applies if a university has subscribed to online journals. Here, too, the university has lawful access, with the consequence that the University is permitted to reproduce and make the content of the journal available internally as a matter of principle, unless it is not obliged, specifically within the framework of the online subscription, to apply a more restricted use (e.g. limitation of the number of simultaneous accesses from different work stations).
- 207 Internal use is subject to extensive restrictions. In this, the legislature has adopted the requirements of international law, in particular the three-step test (see below, paragraphs 283 et seq.). The most important restriction for repositories results from Art. 19 Para. 3 a of the URG, according to which the privilege of internal use does not cover “*the complete or largely complete reproduction of copies of works available commercially*”).
- 208 The restriction, according to theory and judicial practice, does not extend to all copies of works available commercially but only to complete sales copies in the form as offered for sale.<sup>124</sup> This means that for instance a monograph available commercially cannot be deposited completely in the repository by relying only on the limitation of internal use. On the other hand, an individual article in a journal can be deposited if the journal is only sold as a whole commercially;<sup>125</sup> if, however, the publisher offers the individual articles separately (e.g. on the publisher's own Internet platform), its deposit in the repository is no longer covered by the limitation.<sup>126</sup>
- 209 At first sight, the legal situation would appear different if Art. 19 Para. 3<sup>bis</sup> of the URG is included, according to which “reproductions made when retrieving a work lawfully made available” are not subject to the restrictions of Para. 3. However, the proper view is that this only covers the downloading of itself and the resulting (automatic) reproduction, but not

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<sup>124</sup> BGE 133 III 473 et seq. E. 3.1; BARRELET AND EGLOFF, Art. 19 note 23; GASSER, *Eigengebrauch*, p. 120 et seq.

<sup>125</sup> According to BARRELET AND EGLOFF, Art. 19 note 23; GASSER, *Eigengebrauch*, p. 120 et seq., Fn. 28.

<sup>126</sup> BARRELET AND EGLOFF, Art 19 note 23a; likewise no doubt also GASSER, URG, Art. 19 note 37. In contrast, the Berne Court of Appeals – sic! 2001, p. 613 et seq. E. 7 (p. 620) – adopted a diverging decision, but the grounds are probably outdated (Internet access was ‘far from being a matter of course’ in 2001 and for this reason copies of works accessible via Internet archives could not be ‘available commercially’).

subsequent uses (the French version is clearer: “les reproductions confectionnées lors de la consultation [...]”).

210 Nor does the permitted internal use cover the deposit of works of fine art, musical scores and recordings of lectures, performances and presentations (Art. 19 Para. 3 b-d, URG).

211 *In summary* it should be noted that the internal use limitation basically permits scientific organisations (in particular universities) to make available works already published to internal persons by means of a repository without requiring the consent of the holder of the rights. Internal use, however, only relates to copies of works that the scientific organisation has acquired through lawful access. The internal use limitation use does not cover copying and making available complete sales copies (e.g. the copy of the entire contents of a book). If the sales copy is in the form of a journal, individual articles can be also used in full as long as the individual article is not marketed by the publisher separately (e.g. online).

b) *Limitation for archiving and backup copies*

212 Further limitations are contained in Art. 24 of the URG, and serve the preservation of works. The 2007 amendment of the URG introduced a special provision for libraries and other institutions in Art. 24 Para. 1<sup>bis</sup>:

*Art. 24 Para. 1<sup>bis</sup>, URG*

*Publicly accessible libraries, educational institutions, museums and archives can make the copies necessary for backing-up and preserving their stocks provided that these copies do not pursue economic or commercial purposes.*

213 This provision permits the entitled parties (libraries, educational institutions etc.) to make copies of the works in their stocks for purposes of their preservation. This complies with one of the objectives of the open-access movement, namely that of the long-term archiving of scientific knowledge to preserve the cultural heritage.<sup>127</sup>

214 On the other hand, the provision does not contribute to the main purpose of open access, namely to make scientific works generally available free

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<sup>127</sup> Cf. , BBl. 2006, p. 3430, according to which this addition to the Act was necessary ‘because the digital environment is setting new challenges to the institutions that deal with the preservation of our knowledge and our cultural achievements.’

of charge. Firstly, the entitled parties are not provided a right of access to copies of works that they do not already hold. Secondly, the entitled party is only permitted by Art. 24 Para. 1<sup>bis</sup> of the URG to make copies but not to use them for commercial purposes. The background materials to the URG show that Art. 24 Para. 1<sup>bis</sup> was not intended to permit the entitled persons to open a database by means of which the copied works could be retrieved.<sup>128</sup>

215 *In summary*, this limitation permits certain libraries and other institutions to make backup copies of their stocks. However, it neither provides the entitled parties with a right of access to works nor does it permit them to make works available themselves without the consent of the right holder.

c) *Additional limitations*

216 The operator of a repository does not benefit from the *quotation right* pursuant to Art. 25 of the URG, according to which published works may be quoted "if the quotation serves as an explanation, a reference or illustration and the extent of the quotation is justified for such purpose." The operator of a repository cannot rely on Art. 25 if he makes the work available generally without it serving as an explanation, a reference or illustration of a statement.

217 Nor can the operator of a repository derive anything to his benefit from Art. 27 of the URG. According to this provision, *works located in a place accessible to the general public* can be reproduced by anyone without the right holders consent. Art. 27 protects the freedom of the panorama and for instance permits public photography without publicly accessible works (statues, churches, fountains) having to be left out.<sup>129</sup> Thus the provision does not relate to the virtual space of the Internet, and the term "place accessible to the general public" cannot be interpreted to mean freely available Internet sites.

#### 4. *Entitlement based on anti-trust law?*

218 In practice, publishers mostly use pre-worded model contracts that lay down that the author assigns to the publisher all (or at least all relevant) copyright in the work. As a result, the publisher acquires a monopoly over

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<sup>128</sup> To quote the , BBl. 2006, p. 3430.

<sup>129</sup> BARRELET AND EGLOFF, Art. 27 note 1.

the exploitation of this work. In this situation, the question arises of the extent to which such a single-source situation is of relevance under competition law and could lead to the monitoring of the publishers' business activities.

219 The starting point is Art. 7 of the KG, according to which market-dominant enterprises are not permitted to abuse their market position.<sup>130</sup> Abuse can be in the form of a refusal to enter into a business relationship without an objective reason (Art. 7 Para. 2 a, KG) and the imposition of inappropriate prices or terms of business (Art. 7 Para. 2 c, KG).

220 In the field of scientific publishing, as a general rule the problem of the publisher refusing to supply journals does not arise. On the other hand, the research institutions are burdened by the fact that many publishers charge excessive prices in full knowledge that the research institutions are not able to waive the subscription to renowned journals if they wished to make available a high-quality research infrastructure to their members.<sup>131</sup>

221 However, high expectations should not be made of anti-trust price controls. The purpose of anti-trust law is not to enforce reasonable prices but is limited to counteracting the elimination of well functioning competition.<sup>132</sup>

222 If an anti-trust obligation to conclude a contract and to apply market prices can have any effect in the first place, the publisher must as a whole be capable of being classified as a *market-dominant enterprise*.<sup>133</sup> The crucial factor here is, however, the determination of the relevant market.<sup>134</sup>

223 According to prevailing opinion, a market is determined by substitutable products.<sup>135</sup> According to the traditional view of anti-trust law, it is there-

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<sup>130</sup> Assuming that anti-trust law applies, see Art. 3 Para. 2 of the KG and STIRNIMANN, p. 41 et seq. and HILTY, KG, p. 325 et seq., each with further references.

<sup>131</sup> See as example the negotiations between Elsevier and the Max-Planck Society: HILTY, *Wissenschaftler*, p. 183 et seq.

<sup>132</sup> ZÄCH, Paragraph 693; STIRNIMANN, p. 217.

<sup>133</sup> The monopoly that results from ownership of copyright does not of itself establish a market-dominant position: WIELSCH, p. 131.

<sup>134</sup> For further details, see HILTY, *Zwangslizenzen*, p. 638 et seq.

<sup>135</sup> ZÄCH, Paragraphs 532 et seq.

fore necessary to ask whether the different publishers compete by putting rival products on the market, a question which as a general rule must be answered in the affirmative. From the point of view of the scientist, however, scientific publications are hardly substitutable. If a scientist requires a particular paper as a source for his research, because only this paper contains the information he is seeking, he cannot, in the context of high-quality research, switch to a different paper published by a different publisher.<sup>136</sup> This would logically mean that basically each individual non-substitutable scientific paper constituted a separate market, with the result that academic publishers would always have to be qualified as market-dominant and be subject to corresponding anti-trust law controls.

224 Such a radical escalation of the term “market” is of course in conflict with prevailing teaching and judicial practice in anti-trust law, although in fact it correctly describes the actual situation, in which the individual scientist and the libraries are largely at the mercy of the publisher and its pricing policies. However, the specific notion of the irreplaceable paper in the field of science is not covered by anti-trust law as currently in force.<sup>137</sup>

225 On the contrary, the European Commission, for instance, assumes that the determination of the relevant market for scientific publications must apply an additional criterion (such as the circle of purchasers, subject discipline and access to authors and publishers) alongside the substitutability of the product, and expressly rejects a narrowing of the term “market” to individual journals or even individual papers.<sup>138</sup>

226 This position means that according to current law scientific publishers as a general rule do not have a market-dominant position as long as there are serious competing publishers in the same discipline. Accordingly, an obligation to conclude a contract or price controlling on the basis of Art. 7 of the KG cannot be applied in most cases.

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<sup>136</sup> HILTY, *Wissenschaftler*, p. 185 et seq.; HILTY AND BAJON, p. 258; EGLOFF, p. 714.

<sup>137</sup> Although the prevailing view in the literature is that the essential-facilities doctrine applies to copyright, STIRNIMANN, p. 243 f.; HILTY, *Lizenzvertragsrecht*, p. 412 et seq., 437, each with further references, nevertheless this is subject to the condition that the enterprise holding the ‘essential facility’ has a market-dominant position.

<sup>138</sup> EC Commission, Case No. IV/M.1377 dated 15 February 1999, Paragraphs 9–12; confirmed in EC Commission, Case No. COMP/M.3197 dated 29 July 2003, Paragraphs 12–15 (both decisions rendered in merger control proceedings).

#### IV. Legal consequences in the event of a lack of entitlement

##### 1. *Legal consequences for the operator of the repository*

227 If a repository operator makes scientific works available without holding the necessary copyright, he commits a breach of copyright. In such a case, the copyright holder has at his disposal the legal remedies pursuant to Arts. 61 et seq. of the URG. In particular, an action can be brought against the operator for the elimination of the infringement (Art. 62 Para. 1 b, URG). Thus the operator can for instance, be obliged to remove the work in question from the repository.<sup>139</sup>

228 Financial consequences are also possible on the basis of actions deriving from the OR, as reserved by Art. 62 Para. 2 of the URG. The obvious measure here is an action for damages with which for instance the publisher can claim the refund of the profit lost through the breach of copyright from the repository operator (Art. 62 Para. 2, URG in conjunction with Arts. 41 et seq., OR).<sup>140</sup> However, the publisher must prove the difference, which is probably difficult in practice because it is hardly possible to establish causality between the activities of the repository operator and the losses incurred by the publisher.

229 *An action can be filed* by anyone who holds the infringed copyright subpowers (Art. 62 Para. 1, URG) or who holds an exclusive licence to these powers (Art. 62 Para. 3, URG). The publication of a work in a repository involves the online rights (see above, paragraph 175), that are as a matter of principle held by the author or the publisher. Hence it is mostly the author or the publisher that is entitled to file the action. In the case of joint authorship, each joint author is individually entitled to file an action but can only claim payment for all joint authors (Art. 7 Para. 3, URG).

230 The *defendant* can be both the operator of the repository but also any other persons who have participated in the copyright infringement. In other words, it is not only the main infringer but also an instigator or an

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<sup>139</sup> Other remedies provided by the Copyright Act are the action for a declaratory judgment (Art. 61), the action for an injunction (Art. 62 Para. 1 a), the claim to information (Art. 62 Para. 1 c), confiscation (Art. 63), preventive measures (Art. 65) and publication of the decision (Art. 66).

<sup>140</sup> Art. 62 Para. 2 of the Copyright Act also allows an action for satisfaction (Art. 49, Code of Obligations) and for surrender of profits (Art. 423, Code of Obligations). Another possibility is an action based on unjust enrichment (Art. 62 et seq., Code of Obligations): BARRELET AND EGLOFF, Art. 62 note 17.

accessory who can be sued (cf. Art. 50 Para. 1, OR).<sup>141</sup> If the online rights to a work are held for instance by a publisher, and if the author has nevertheless published his work in a repository, an action can be brought both against the operator of the repository and against the author. In the case of a claim for damages, the operator and the author are jointly and severally liable (Art. 50 Para. 1, OR). The plaintiff can choose the defendant against whom he wishes to proceed and whether to claim a whole or a part of the losses from this person (Art. 144 Para. 1, OR).

231 The publication in a repository can infringe not only copyright but also other legal positions. If a paper is defamatory with respect to a third person, for instance, this constitutes an infringement of personality rights (Art. 28, ZGB). It is also possible to conceive of content that infringes data protection law, identification rights (e.g. trademark rights) or the criminal law.<sup>142</sup>

## 2. *Transfer of the legal consequences*

### a) *Recourse to the author*

232 The repository operator can by contract transfer the risk of being sued for damages by third parties for infringement of rights to the author. This is done by means of a contractual clause in which the author undertakes to indemnify the repository operator in the event of third-party claims, i.e. to assume the costs incurred and any damages payable.<sup>143</sup>

233 From a practical point of view, it should be noted that such a transfer of the risk to the author can reduce the attractiveness of the repository and that there might be fewer authors willing to publish in the repository.<sup>144</sup> As follows from the remarks above, the publishing contract between the author and the publisher does not always make it immediately clear whether the author is authorised to make a parallel publication in a repository (for details see above, paragraphs 65 et seq.). For this reason, the manner in

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<sup>141</sup> BARRELET AND EGLOFF, Art. 62 note 5; see also RUBLI, Paragraph 112 et seq.

<sup>142</sup> On the liability risks of the repository operator in this respect see M. P. WEBER, p. 149 et seq. (on German law).

<sup>143</sup> JONES, ANDREW AND MACCOLL, p. 150, recommend the repository operator to agree such a clause.

<sup>144</sup> Cf. HANSEN p. 387: '[...] many scientists are reluctant to implement self-archiving merely because of a legal situation that they see as unclear and that has to be clarified laboriously in the specific case.'

which liability for infringements of rights is distributed is a central aspect of the agreement between the author and the repository operator.

234 If the repository operator and the author have not included a provision in the agreement dealing with liability for rights infringements, the repository operator can only have recourse to the author to the extent that the latter is jointly responsible for the copyright infringement (and to this extent can also be sued directly). Such a joint responsibility applies as a matter of principle if the deposit is made by the author himself or with his consent. The shares to be assumed by the repository operator and the author are determined by judicial discretion in the specific case (Art. 50 Para. 2, OR).

235 The repository operator is to be classified as a content provider, whose performance goes beyond mere technical storage and making available as provided by a purely access provider. However, even the content provider is only subject to liability to the extent that he has failed to take possible and reasonable measures to prevent infringements of rights.<sup>145</sup> The repository operator can be expected to clarify the copyright entitlement to the individual works and to attempt to remedy any infringement of rights. However, the repository operator could not additionally be expected to acquire knowledge of the content of each individual work and to examine it for infringements.<sup>146</sup>

236 The author will also be liable for the conduct of his employees and assistants if such conduct takes place in the performance of employment or business duties. The author can only obtain release from this liability if he has applied "all the care necessary in the circumstances in order to prevent damage of this kind, or if the damage would have occurred even if such care had been applied" (Art. 55 Para. 1, OR).

*b) Recourse to employees*

237 The question of recourse also arises if the infringement of copyright is due to conduct on the part of an employee of the repository operator (e.g. a secretary or library employee). Thus copyright can for instance be in-

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<sup>145</sup> Generally on provider liability, FRECH, p. 338; similarly, on German law M. P. WEBER, p. 155, 165.

<sup>146</sup> M. P. WEBER, p. 165. The principle that the content provider is fully aware of the content he communicates (according to R. H. WEBER, Haftung, p. 178 et seq) can thus not be transferred automatically to the repository operator.

fringed if the employee wrongly assumes that the repository operator holds the necessary copyright.

238 As a matter of principle, the repository operator is also liable to third parties for losses caused by his employees and assistants (Art. 55 Para. 1, OR, see above, paragraph 236). However, the repository operator's liability does not prevent him having recourse to the employee. If the loss can be proven to have been caused by unlawful and culpable conduct by the employee, the employee is liable in whole or in part for the loss (Art. 55 Para. 2 in conjunction with Art. 321e, OR). The employer's claim for damages against the employee must be reduced or fails entirely if the loss is due to a deficient business or working organisation.<sup>147</sup>

## V. International constellations

### 1. *Legal venue*

239 The principles concerning the jurisdiction of the courts for international constellations have already been discussed. In any event, there is a legal venue in the defendant's country of domicile and there may also be a legal venue at the place of completion, of the act or of the effect (for details, see above, paragraphs 143 et seq.).

### 2. *Applicable law*

240 The reader is also referred above to the question of the applicable law (paragraphs 151 et seq.). While from the point of view of the author it was, above all, necessary to determine the law that applies to actions by the publisher against the author, from the point of view of the repository operator the issue is mainly that of actions by the publisher against the operator (on the distinction between the legal relationships between the author, the publisher and the repository operator, see above, paragraph 184).

241 As a matter of principle, the repository operator will not be contractually bound to the publisher, with the result that an action by the publisher against the repository operator is usually not based on contract but is based exclusively on copyright issues. To this extent, the country-of-protection principle applies, according to which the law of the country ap-

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PORTMANN AND STÖCKLI, Paragraph 212.

plies for which copyright protection is claimed (see above, paragraphs 157 et seq.).

242 If for instance a foreign publisher claims that the repository operator has infringed its copyright by depositing works (on a Swiss Internet server), the corresponding action for the elimination of the infringement is as a matter of principle to be assessed according to Swiss law, even if the deposit means that the work can be retrieved worldwide (on the application of the law of the foreign country of reception in exceptional cases, see above, paragraphs 163 et seq.).

## VI. Conclusion

243 This Section D. examined legal questions concerning open access from the point of view of the repository operator. In order to be able to deposit works in his repository and make them generally available, the repository operator must acquire the corresponding copyright, which as a matter of principle is held by the author or the publisher.

244 Without the consent of the rightholder, the repository operator can only use works to the extent permitted by the statutory limitation rules. Thus by virtue of the law he is permitted to make internal use of the work – e.g. on university internal networks – (Art. 19 Para. 1 c, URG) and to make archive copies (Art. 24 Para. 1<sup>bis</sup>, URG). For purposes of completeness, it should be added at this point that the limitation for internal use is not so broad in other countries (specifically EU countries, which are bound by Directive 29/2001 on Copyright in the Information Society).

## E. From the point of view of the user

### I. Overview

245 The open access postulate aims primarily at improving the position of the user, who should be granted access to scientific knowledge that is as broad as possible and free of charge. The user will often himself to be a scientist and will use the access to scientific publications in order to create new publications in turn. The benefit to the user is ultimately not for its own sake but rather serves the public interests, in particular the guaranteeing of the freedom of science in a manner as comprehensive as possible (Art. 20, Const.).

246 In order to use scientific works, the user needs the corresponding right if he obtains the works from the Internet (below, II.). Without the necessary entitlement, he commits an infringement of copyright (III. and IV.). A brief examination is made of the legal situation for international constellations (V.) before finally a conclusion is drawn (VI.).

### II. Starting point under copyright law

#### 1. *Principle of the enjoyment of the work free from copyright*

247 The content of copyright is regulated in Arts. 9-15 of the URG. Not every use of a work is covered by the content of copyright. The enjoyment of the work is not a matter for copyright. In particular, reading a text or listening to a piece of music is not a use of the work within the meaning of Art. 10 of the URG.

248 For this reason, the user does not as a matter of principle require the copyright holder's consent to enjoy the work. Anyone who for instance acquires a scientific monograph or a journal in a bookstore and reads it through is carrying out an action that is free of copyright.<sup>148</sup>

#### 2. *Limitations in the case of Internet uses*

249 The principle of the enjoyment of a work free of copyright is restricted in the case of Internet use. The use of scientific works from the Internet usually involves reproductions that fall within the right of reproduction

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BARRELET AND EGLOFF, Art. 10 note 6a; EGLOFF, p. 707 with further references.

pursuant to Art. 10 Para. 2 a of the URG. Reproductions include in particular displaying the work on the user's own screen, downloading it to his own hard disk and making a printout of the work.

250 However, the restrictions have been revised by the 2007 URG amendment such that the enjoyment of a work via the Internet is in many cases exempt from the need to obtain the rightholder's consent. The following sets out the relevant restrictions.

### III. Entitlement to the copyright needed

#### 1. Entitlement through statutory limitation

##### a) Temporary reproductions

251 Art. 24a of the URG, introduced by the 2007 amendment, means that temporary reproductions that are necessary for purely technical reasons are exempt. This means in particular that the rightholder has no power to forbid reproductions as occur regularly and often automatically when working with the Internet.

252 If scientific works are displayed on the screen or if they are downloaded, these are uses that, even if they are only temporary, are no longer covered completely by Art. 24a of the URG, but are already of independent commercial significance (Art. 24a d, URG).

##### b) Private and internal use

253 Art. 19 Para. 1 a of the URG permits "any use of a work in the personal sphere or within a circle of persons closely connected to each other such as relations or friends." For this reason, such a private use does not require the rightholder's consent. The limitation of private use only benefits natural persons.<sup>149</sup> It only relates to published work (Art. 19 Para. 1, Sentence 1 of the URG).

254 Private use includes for instance if a scientist researching on his own account copies articles and books.<sup>150</sup> If on the other hand he is working as an employee of an institute or a university, this limitation no longer applies and instead recourse must be had to the narrower limitation for in-

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<sup>149</sup> BARRELET AND EGLOFF, Art. 19 note 8; GASSER, *Eigengebrauch*, p. 50.

<sup>150</sup> GASSER, *Eigengebrauch*, p. 65: 'personal research'.

ternal use (for details, see above, paragraphs 197 et seq.). In this case, there can no longer be a question of a circle of persons closely connected to each other within the meaning of Art. 19 Para. 1 a of the URG who are using the document copies privately.

255 Scientific works can admittedly be copied by the user both for private and for internal use without the copyright holder's consent. However, there are a number of differences between the two types of use, two of which shall be mentioned here:

- Of importance in practical terms is the fact that for private use, complete copies of a work available commercially can be made, which is not permitted in the case of internal use (Art. 19 Para. 3 a, URG), particularly since Art. 19 Para. 3<sup>bis</sup> of the URG likewise does not provide a general exemption (see above, paragraph 209).
- Private use is, as a matter of principle, not subject to remuneration (Art. 20 Para. 2, URG) with the exception of the copyright remuneration charged for blank data carriers (Art. 20 Para. 3, URG), while remuneration is payable for internal use (Art. 20 Para. 2, URG). There is only an exception for works that are lawfully retrieved from the Internet or comparable services such that the reproductions occurring during the downloading process are also exempt from remuneration in the case of internal use (Art. 19 Para. 3<sup>bis</sup> in conjunction with Art. 20 Para. 2, URG).

256 It is disputed whether the statutory authorisation for private use also extends to copies of the work made without permission or made available without permission (pirate copies).<sup>151</sup> As yet, the Swiss courts have not decided on this point. However, since the URG exempts any use of the work and this exemption relates to the intangible work of itself – without any differentiation being made on the basis of the physical embodiment of this use of the work – the wording of the provision tends to argue for the open approach.

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*In agreement:* , BBl. 2006, p. 3430; BARRELET AND EGLOFF, Art. 19 note 7b; CHERPILLOD, Schranken, p. 270 et seq. *Opposed:* GASSER, URG, Art. 19 note 10; BU, p. 70. The comments mostly concentrate on private use and do not raise the issue of internal use.

c) *Limitations and access to copies of the work*

257 The above-mentioned limitations for temporary reproductions and private and internal use only in part advance the open access idea. Admittedly, they give the user an extensive right to reproduce scientific works, which is actually sufficient for their use as intended. However, use is only possible if the user actually has access to a – printed or digital – copy of the work. The limitations do not, however, give the user a right of access<sup>152</sup> (nor does the right of access laid down in Art. 14 Para. 1 of the URG provide any assistance on this point, see below, paragraphs 265 et seq.).

258 One approach to free access to scientific works follows from the provision concerning *technical measures* (Art. 39a–c URG) introduced by the 2007 amendment of the URG. Technical measures are defined by the URG as “technologies and devices such as access and copy control mechanisms, encoding, distortion and other conversion mechanisms that are intended and capable of preventing or restricting unauthorised uses of works and other objects of protection” (Art. 39a Para. 2, URG).

259 The law lays down a basic prohibition on the circumvention of effective technical protective measures (Art. 39a Para. 1, URG), but provides an exception for circumventions that are made “exclusively for the purpose of a use permitted by law” (Art. 39a Para. 4, URG).<sup>153</sup> Among other things, this means that the prohibition cannot be asserted in connection with private or internal use. As a result, the user<sup>154</sup> basically also has a “right to hack” that allows him to access – in many cases free of charge<sup>155</sup> – content protected by technical measures and subject to a charge.

260 However, the effects of this statutory right to circumvent are considerably restricted by the broad prohibition on the making and offering for sale of circumvention instruments (such as instructions or computer programs to this effect) (Art. 39a Para. 3, URG). If the trade in circumvention aids is prohibited, the “right to hack” can, in the final analysis, only benefit a user

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152 AUF DER MAUR, Art. 39 note 20 et seq.; RUBLI, Paragraph 386; cf. also WIELSCH, p. 61 et seq.

153 On this point, Swiss law is more liberal to the user's benefit than the (excessively strict) EU law; for further details see HILTY, Informationsgesellschaft, p. 978 et seq.

154 Even if, strictly speaking, the user does not have a ‘right of circumvention’ but merely uses the statutory privilege of being allowed to carry out per se prohibited acts of circumvention without legal consequences. On the construct in legal theory, see RUBLI, Paragraphs 458 et seq.

155 The remuneration for personal and internal use is determined according to the general rules in Art. 19 et seq., Copyright Act.

who obtains his circumvention instrument from an illegal supplier or who himself has the necessary technical knowledge.<sup>156</sup> Nevertheless, the person entitled to use who does not have the necessary technical knowledge is probably permitted to avail himself of the services of a third party and still remain within the limits of Art. 19 Para. 2, URG<sup>157</sup> (subject to the corresponding fee for the copies made, Art. 20 Para. 2, URG).

261 In the light of these narrow limits, the provision concerning the circumvention of effective technical protective measures likewise does not fulfil the function of a right of access in the true sense of the term.

## 2. *Entitlement through author's consent*

262 The statutory limitations on copyright allow the user to a large extent to make the reproductions needed for the use of scientific publications but without giving him a *right of access* to a copy of the work (set out above in paragraph 257). For this reason, the following sets out the extent to which the author can provide the user with the necessary access.

263 As long as the author has not already assigned his right to make the work available (Art. 10 Para. 2 c, URG) to a publisher and also contractually is not obliged to abstain, the author can provide the user with access to the work via the Internet, either by doing so himself (e.g. through his personal Internet site) or via a third party (e.g. by means of publication in a repository).

264 The same applies to the distribution right (Art. 10 Para. 2 b, URG) to printed copies of the work. If he still holds such a right, the author can sell or gift such a copy directly (e.g. by mail) or via a third party.

265 It is also appropriate to examine whether, in this context, use could be made of a right held by the author that in fact has a very limited scope of application, namely the *author's right of access to a copy of his work* (Art. 14 Para. 1, URG).<sup>158</sup> This right of access can for instance allow a painter to have access to an oil painting in the possession of a purchaser in order to make a photograph of the work. The author as a matter of principle re-

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<sup>156</sup> For further details, see RUBLI, Paragraphs 466 et seq.

<sup>157</sup> Thus also BARRELET AND EGLOFF, Art. 39a note 13.

<sup>158</sup> Art. 14 of the Copyright Act is raised by EGLOFF, p. 715, in this context; see below, Fn. 180.

tains the right of access even if he has assigned the rights to exploit the work (cf. Art. 16 Para. 2, URG).

266 However, the approach of the author using his right of access to provide the user with access to a scientific work free of charge does not achieve the desired result. Firstly this right of access is designed for the person of the author, and it is disputed whether it can be granted to another person at all.<sup>159</sup> Even if it were held to be permissible to grant this right to the user, it would not be of any assistance since the right of access must be granted *inter alia* if “such is necessary for the exercise of copyright” (Art. 14 Para. 1, URG). In other words, the right of access only applies if the entitled person has in his possession at least one further copyright sub-power, and requires access to the copy of the work in order to exercise this right.<sup>160</sup> The grant of the right of access alone would thus not confer on the user an enforceable right to access the work.

### 3. ***Entitlement through consent by the publisher or the repository operator***

267 The user can also acquire access to a copy of the work from the *publisher* if the latter holds the corresponding copyright. Conventional publishers will as a matter of principle only provide access in return for payment.

268 On the other hand, access free of charge will be possible if the *repository operator* holds the necessary right to make available.

## IV. **Legal consequences of lack of entitlement**

269 The remarks so far show that the statutory limitations on copyright largely entitle the user to use scientific publications appropriately (see above, paragraphs 251 et seq.). Even if he circumvents technical measures such as access restrictions, this is permitted by the law if such is only for the purpose of private or internal use (see above, paragraphs 258 et seq.).

270 The problem for the user is not primarily that he might be guilty of copyright infringement but rather that access to scientific publications is im-

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<sup>159</sup> See the overview on the state of opinions in SEEMANN, p. 325.

<sup>160</sup> According to BARRELET AND EGLOFF, Art. 14 note 4 (who however also allows the right of access for the purpose of the stocktaking of works by the author).

peded if their acquisition involves considerable costs and if the libraries to which the user has access do not stock the publication in question.

271 Nevertheless, the following sets out in brief the consequences of the user infringing copyright. The user infringes copyright if he uses the work in a manner that is covered neither by the statutory limitations nor by the rightholder's consent. This is the case for instance if a researcher employed by a university copies not merely extracts but rather the entirety of a book in the library (Art. 19 Para. 3 a, URG).

272 In such a case, an action can be brought against him by the rightholder, who can have recourse to the remedies set out in Arts. 61 et seq. of the URG, in particular actions for the elimination of the infringement and for damages (for further details on this see above, paragraphs 227 et seq.). Given the small scope of infringements by the individual user, the rightholder will as a matter of principle not pursue his rights through litigation, or will tend to take action against a person, such as a repository operator under certain circumstances, who can be made responsible not merely for one but rather for a number of infringements.

## V. International constellations

273 For determination of the court with jurisdiction and the applicable law in international constellations, reference is made to the remarks already made on this point (see above, paragraphs 143 et seq.). The law that applies to infringements of copyright by the user is as a matter of principle determined, provided that no contract law questions are involved, according to the *country-of-protection principle* within the meaning of Art. 110 Para. 1 of the IPRG (for details, see above, paragraphs 157 et seq.).

## VI. Conclusion

274 This Section E. has addressed the problem of open access from the user's point of view. The statutory limitations on copyright largely allow the user to use scientific works, including from the Internet. However, he can only benefit from these limitations if he actually has access to a copy of the work. The problem of how the user can access a scientific publication at a reasonable price is not a subject of the current URG.

## F. De lege ferenda approach

### I. Overview

275 The following sets out whether and how the open-access concept could be advanced by means of appropriate changes to legislation. There are a number of starting points for this. Access to scientific knowledge can be improved by changing the legal position of the user, the communicator of the work (repository operator) or the author.

276 The main interest is on a change of the URG (below, II.). However, changes to contract law (III.) or anti-trust law (IV.) are also possible. The remarks are rounded off with a conclusion (V.).

### II. Copyright limitations

#### 1. *To the user's benefit*

277 Statutory copyright limitations that allow the user to use scientific works for research purposes already exist in current law. As a matter of principle, it is sufficient for the purpose of research to be able to view the publication on a monitor, to download it to the user's computer and to print it. The user is already as a matter of principle entitled to make the corresponding reproductions by virtue of the statutory licence for internal use and the exemption for private use (Art. 19 Para. 1 a and c, URG, for further details see above, paragraphs 253 et seq.).

278 However, individual aspects of the statutory licence for internal use could be improved to take better account of the open-access principle. Thus for instance, internal use could, as is already the case for private use, be extended to permit the making of a complete copy of the work (cf. the restriction of Art. 19 Para. 3 a, URG in current law, and above, paragraphs 207 et seq.).

279 Leaving aside the fact that such an "improved" copyright limitation would also have to be examined for reasonableness with respect to the interests affected (in particular those of scientific publishers), such an approach ultimately fails to achieve the desired objective. This is due to the fact that the user can only profit from the copyright limitation if he already has access to a copy of the work. However, the limitation itself does not

confer on the user such a right of access (see above, paragraphs 257 et seq.).

## **2. To the benefit of the repository operator**

### **a) Statutory licence**

280 In order to facilitate the user's access to copies of scientific publications, it would be necessary to amend the law at the place that can guarantee access, namely the repository operator. With this in mind, attention should best be focused primarily not on the user's free access but rather on the *repository operator being able to make the work freely available*.

281 Here again, a copyright limitation to the repository operator's benefit does not of itself grant him right of access to a copy of the work. However, the repository operator is more likely than the user to have the financial possibilities to acquire a copy of the work, even an expensive one. In addition, it would be sufficient for one single repository operator to have lawful access to the copy. Once he has made the work available to the public, all other operators would, thanks to the copyright limitation, be able to deposit it in their own repositories.

282 If the repository operator were to be thus empowered without restrictions (i.e., without account being taken of the publisher's interests) *to make scientific publications available to the public without the rightholder's consent*, this would substantially improve the general availability of such works.

283 However, it should not be forgotten that the copyright limitations must satisfy the requirements of international law, in particular the three-step test. The latter lays down that limitations must firstly be restricted to specific special cases, secondly must not impair the normal exploitation of works and thirdly must not unreasonably prejudice the author's and the rightholder's legitimate interests.<sup>161</sup>

284 Against this background, a limitation cannot simply lay down that all scientific publications are to be made available to the public – leaving aside the fact that such a maximum solution would in any event have no

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<sup>161</sup> Art. 9 Para. 2 RBC, Art. 13 TRIPS, Art. 10 WCT.

chance of success at political level – but instead would have to carefully delimit the scope of application.

285 This is done in the following on the basis of the three-step test, applying the more recent trends in its interpretation, as particularly expressed in the Declaration for a Balanced Interpretation of the Three-Step Test, and as implicitly adopted by the more recent judicial practice of the Supreme Court;<sup>162</sup> as a matter of principle, the three steps are not to be considered in isolation, i.e. each separately, but are to be applied as an overall assessment consisting of three related factors.

286 The existence of a *specific special case* (step 1) in this sense is to be assumed if there is a basic justification for a limitation on copyright.<sup>163</sup> Such a justification for the postulate of general access to scientific publications can be derived from the constitutional right of the freedom of science (Art. 20, Const.).<sup>164</sup>

287 It is then necessary to ensure that the *normal exploitation* of the work is not impaired (step 2). The normal exploitation of works by publishers is basically by means of printing and distributing the work. This exploitation can indeed be impaired by online media. Whether the normal exploitation is impaired or not cannot, in the digital environment in particular, be conditional upon the medium, but rather must be based on whether the limitation would lead to a substantial fall in sales or not.<sup>165</sup>

288 In order to safeguard normal exploitation in this sense, such a limitation would have to be limited to contributions to *journals* and be subject to a *waiting period*.<sup>166</sup> Journals focus more or less on what is current and they are mainly normally exploited within a certain period of time after publication. For this reason, the normal exploitation of scientific publications can be restricted to a certain period of time, even if they can still be exploited after this time, for instance in an online archive. The period within which scientific articles become “dated” varies from subject to subject. For this

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<sup>162</sup> BGE 133 III 473 et seq. E. 6; see also HANSEN, p. 385 et seq. The original English text of the Declaration is at IIC 2008, p. 707, and, in German translation, at: [www.ip.mpg.de/ww/de/pub/aktuelles/declaration\\_on\\_the\\_three\\_step\\_/declaration.cfm](http://www.ip.mpg.de/ww/de/pub/aktuelles/declaration_on_the_three_step_/declaration.cfm).

<sup>163</sup> SENFTLEBEN, p. 207.

<sup>164</sup> HANSEN, p. 385.

<sup>165</sup> SENFTLEBEN, p. 208 et seq.

<sup>166</sup> Likewise SANDBERGER, p. 822 (in part by applying test step 1); HANSEN, p. 382, 385 et seq. (waiting period), 384 (restriction to periodicals).

reason it is not easy to lay down a general and at the same time appropriate waiting period.<sup>167</sup> A period of *one year* is proposed here.

289 That the copyright limitation does not directly benefit the use but rather the communicator of the work, in particular the repository operator, is of significance since the operator is potentially in competition with the rightholder. However, this fact is not sufficient for an assumption that such a limitation would be prohibited.<sup>168</sup> Thus the current law already provides for such limitations for instance to permit the simultaneous and unchanged rendering of broadcasts perceivable (Art. 37 b in conjunction with Art. 22 Para. 1, URG), which *inter alia* permits the holding of public viewings of football matches;<sup>169</sup> this limitation likewise does not directly benefit the user but rather the communicator. Moreover, in this second step account must be taken of the fact that a payment to be made by the party entitled to use will at least in part compensate the losses incurred by the rightholder.

290 Finally, a copyright limitation must not unreasonably prejudice the *legitimate interests* of authors and rightholders (step 3). This restriction ensures that the intervention is reasonable. The limitation must, in particular, not be more extensive than is necessary to achieve the objective. In order to ensure reasonableness, various aspects must be examined:

- *Subject to remuneration.* In order to mitigate the disadvantages suffered by the rightholder – in particular scientific publishers – resulting from a copyright limitation, an obligation to pay remuneration is required.<sup>170</sup> This gives the limitation the form of a statutory licence, the reasonable remuneration being laid down in the rates charged by the collecting societies (cf. Art. 46 et seq., URG). The consequence is that the rightholder has no direct influence on the amount of the remuneration, which instead is determined in formalised proceedings (Arts. 55 et seq., URG).
- *Restriction to publicly financed contributions.* The interest in the general availability of scientific works is, as a matter of principle, of

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<sup>167</sup> Cf. HILTY, *Urheberrecht und Wissenschaft*, p. 192.

<sup>168</sup> HILTY, *Zwangslizenzen*, p. 637.

<sup>169</sup> BARRELET AND EGLOFF, Art. 22 note 3.

<sup>170</sup> SANDBERGER, p. 822; HANSEN, p. 386.

greater importance than the interests of the publishers if the works have been predominantly financed from public funds. The statutory provision is to be restricted to such works.<sup>171</sup>

- *Restriction to non-commercial use.* The limitation should only privilege non-commercial communicators of scientific publications.
- *Restriction to a specific circle of persons?* In German law, a similar copyright limitation is restricted to a circle of persons for their own scientific research.<sup>172</sup> However, such a restriction is difficult to handle if it is to genuinely include all researchers and not only the exchange of information within a university, an institute or a group of researchers.<sup>173</sup> Against this background, it is preferable to provide for general availability in accordance with the open-access postulate, even if this means charging higher rates in order to compensate the rightholders' legitimate interests.

291 On the basis of these remarks the following is the proposed wording of a statutory copyright limitation to promote the open access principle:<sup>174</sup>

<sup>1</sup> *Scientific works published in journals and predominantly financed from public research funds can be made available to the public after the expiry of one year after publication provided that this does not pursue a commercial purpose.*

<sup>2</sup> *Anyone who makes the work available pursuant to Paragraph 1 shall owe the author remuneration. The claims to remuneration can only be asserted by licensed collecting societies.*

#### b) *Compulsory licence*

292 Unlike the statutory licence, a compulsory licence means that neither a direct statutory right to use nor an obligation to pay remuneration in the

<sup>171</sup> HILTY, *Urheberrecht und Wissenschaft*, p. 191; SANDBERGER, p. 822 (applying test step 1).

<sup>172</sup> See Sec. 52a Para. 1 No. 2 of the German UrhG: "It shall be permissible to make available to the public: Previously published parts of works, works of limited size, and individual contributions to newspapers and magazines (articles) exclusively for a limited circle of persons for their own scientific research, provided this is required for the particular purpose and is justified for the pursuit of non-commercial purposes."

<sup>173</sup> The German provision is construed restrictively and does not cover making a work accessible to an entire university or an entire faculty: HECKMANN AND WEBER, p. 996 with further references.

<sup>174</sup> Similarly the proposals in HANSEN, p. 384, and HILTY, *Urheberrecht und Wissenschaft*, p. 192, for German law (the latter proposal does not provide for a provision based on limitations but instead based on copyright contract law).

specific form of a tariff arises. The compulsory licence means simply – but nevertheless – that the rightholder is obliged by law to grant a licence to use the work to any party that satisfies the statutory conditions, the conditions – in particular the compensation – being freely negotiable or determined by the court in the event of a dispute.<sup>175</sup>

293 The legal institution of the compulsory licence has practically fallen into disuse. The current URG only contains one rather insignificant compulsory licence, in Art. 23. It has been supplanted in the course of uncontrolled mass use, replaced by the collective assertion of rights by performing rights societies. The business models that have now taken centre stage and that are based on a combination of online communication and technical protection measures have however at least in part returned to the rightholders the power to control the use of their works, and for this reason the restriction on the freedom of contract in the form of a compulsory licence is once again acquiring the significance it had in past decades when it provided valuable services.<sup>176</sup>

294 Against this background, the introduction of a specific compulsory licence aimed at satisfying the needs of the scientific community is indeed worthy of consideration. In the light of the three-step test, it could be subject to restrictions on the basis of criteria similar to those that have been discussed for the statutory licence<sup>177</sup> (see above, paragraphs 283 et seq.).

295 As compared with the statutory licence, the compulsory licence would above all have the advantage that the remuneration would not be fixed in a rigid tariff but would be negotiable with the rightholder – who in the case of scientific publications will usually be the publisher – and for this reason can be set more appropriately to the interests involved.<sup>178</sup> This means, in particular, that if the financial compensation was appropriate there would be no need for a waiting period. In order to ensure its efficiency, the compulsory licence could also be coupled with procedural measures (e.g. the payment of a deposit in order to obtain entitlement without delay if the amount of compensation is disputed).

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175 REHBINDER, *Urheberrecht*, Paragraph 141; BARRELET AND EGLOFF, Art. 19 note 2.

176 For more details, HILTY, *Zwangslizenzen*, p. 641.

177 On the applicability of the three-step test to compulsory licences, see HILTY, *Zwangslizenzen*, p. 642.

178 HILTY, *Zwangslizenzen*, p. 640 et seq. For criticism see HANSEN, p. 383, who sees a weakness of this approach in the fact that the question of costs is ultimately left to the courts.

### III. Binding contract law

#### 1. *To the author's benefit*

296 A further approach that would promote the open-access principle and in particular the “green road” (see above, paragraphs 12 et seq.) would be to introduce a binding provision in the relationship between the author and publisher.<sup>179</sup> For this purpose the publishing contract law contained in the OR would no doubt be the more appropriate place than the URG.

297 A provision that would be aimed unilaterally at enforcing the open-access principle could consist of a *mandatory prohibition on the assignability of online rights to scientific publications*, meaning that publishers could only be granted a licence to these rights (on the difference between assignment and license, see above, paragraphs 65 et seq.). This would mean that the rights that the author requires in order to deposit his work in a repository would in any event remain with him by virtue of the law.<sup>180</sup>

298 Since the publishing contract law in the OR is at present entirely non-mandatory, such a binding provision would constitute an innovation, which is admittedly no dogmatic obstacle but is likely to considerably hinder political implementation. There is generally doubt as to whether the legislature would be willing to adapt publishing contract law, which has remained unchanged since the 1911 amendment.

299 Against this background, preference should be given to a less extensive proposal that is based, as far as possible, on the existing provisions. A proposal, that with a minimum modification of the current law could achieve a significant effect to the benefit of the open-access postulate, would be to declare Art. 382 Para. 3 of the OR to be *binding with respect to scientific works*.<sup>181</sup>

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<sup>179</sup> See the corresponding proposal for German law in HILTY, *Urheberrecht und Wissenschaft*, p. 192, and HANSEN, p. 387. These proposals were taken up by the German upper house but were not pursued any further by the government; for further details see HECKMANN AND WEBER, p. 995 et seq.

<sup>180</sup> The same direction is adopted by EGLOFF, p. 715, who, to supplement Art. 14 of the Copyright Act, proposes a binding provision to the benefit of the scientific author allowing the latter, even after he has transferred the user rights to his work, to document it on his personal Internet site or that of the institute for which he works.

<sup>181</sup> Generally on the justification for science-specific provisions in copyright law, see HILTY, *Sündenbock Urheberrecht?*, p. 128 et seq.

300 This would mean that the author was in any event permitted – i.e. even where the contractual provision differed – to publish his contributions to journals or collective volumes elsewhere three months after first publication, i.e. also to deposit it in a repository (for further details on Art. 382 Para. 3 of the OR, see above, paragraphs 90 et seq.). Since the three-month period is relatively short, the binding provision could also lay down a waiting period of six months or one year.

301 The disadvantage of such a proposal, that takes as its starting point the person of the author, is that the open-access notion is only promoted if the author actually makes use of his right to deposit in the repository<sup>182</sup> (or is obliged to do so by university law, see below, paragraphs 302 et seq.). In the case of a statutory copyright limitation, on the other hand, the repository operator is not reliant on the author becoming active but can instead deposit the author's works on his own initiative.

## 2. *To the repository operator's benefit*

302 Another starting point is to be found in the relationship between the author and the repository operator. If the author is employed by a public law repository operator (e.g. a university), he could be obliged by binding statutory provisions to deposit his works in the employer's repository or another repository.<sup>183</sup> For the Swiss technical universities, such a provision could be implemented in the Swiss Technical Universities Act,<sup>184</sup> and for the University of Zurich in the Cantonal Universities Act.<sup>185</sup>

303 This approach can a priori only have an effect where there is a public law employment relationship between the repository operator and the author. Whether such binding restrictions on the author's power to dispose of his works is recommendable can however be doubted. Not only does it constitute a deterioration in his working conditions but also weakens his position as against the publishers (for further details, see above, paragraphs

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<sup>182</sup> EGLOFF, p. 712.

<sup>183</sup> The same approach is adopted by PFLÜGER AND ERTMANN, p. 441 et seq., who propose a provision obliging an author employed at a university to offer his work to the university for publication; if the work is not published within two months, the author would be entitled to dispose over it without restrictions. For details and a (justified) criticism of this proposal, see HANSEN, p. 379 et seq.

<sup>184</sup> ETH Act, SR 414.110.

<sup>185</sup> Universities Act of the Cantons of Zurich (Regulation No. 415.11).

187 et seq.). In addition, there are also constitutional reservations concerning the guarantee of the freedom of science (Art. 20, Const.).<sup>186</sup>

#### IV. Anti-trust law

304 The remarks on antitrust law have shown that scientific publishers, even if they market journals that are indispensable from the point of view of science, are as a general rule not regarded as market-dominant within the meaning of Art. 7 of the KG and for this reason are not subject to the corresponding controls on abuse (see above, paragraphs 218 et seq.). A proposal that would subject publishers to greater obligations in particular with respect to pricing in the interests of science would thus require an adjustment of the basic concepts of antitrust law, which would, however, go beyond the limits of the present legal opinion.

#### V. Conclusion

305 This Section F. sets out possible amendments of the law. Various approaches are conceivable to facilitate access to scientific publications.

306 The easiest to fit into the current concept of the URG would be to establish a *statutory licence* that would permit the repository operator, within specific limits, to make works available to the general public without the consent of the rightholder.

307 The alternative that seems at first sight to go further would be the legal institution of the *compulsory license*. On closer examination, it takes better account firstly of the interests of the publisher, who is not required to take the long route via the collective assertion of rights but is merely required to conclude a licence contract (in the form of an individual contract). It also appears to take optimum account of the public interest, since the plurality of suppliers of the same content would create the competitive situation that at present is often absent. Of course, this does not automatically promote the idea of open access, since the beneficiaries of a compulsory license are not automatically entitled to offer this content free of charge unless they are backed by public funds that finance the costs – which also arise in open access – of such a business model.

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SANDBERGER, p. 820 et seq.; DORSCHER, p. 243 et seq.; HANSEN, p. 379 et seq.; HILTY AND BAJON, p. 262.

308 Another proposal worth considering is one that starts from the person of the author. Thus the current provision in *publishing contract law* according to which articles can be published elsewhere (hence also in a repository) three months after first publication could be declared binding with respect to scientific works.

## **G. Conclusion**

### **I. The question**

309 The present expert opinion sets out the legal conditions that apply to access to scientific publications and other scientific data. The focus is on questions surrounding repositories, i.e. Internet servers that are operated for the purpose of making scientific knowledge available free of charge.

### **II. Basic principles**

310 The concept of open access in this present opinion is treated as meaning free access to scientific knowledge via the Internet. The purpose of such access is above all to secure the fundamental conditions needed for free and high quality research. The aspect of long-term archiving also plays a role.

311 In the this opinion, the primary issue concerns questions of the “green road”, i.e. parallel publication of works by conventional publishers on the one hand and repositories on the other. The opinion does not go into depth on the conditions of the “golden road”, i.e. publication a priori – because the author from the start decides to adopt this approach – exclusively or mainly in an open-access media product.

312 The relevant legal basis is to be found above all in copyright law, competition law and contract law. Account must also be taken of international private law that in international constellations serves to determine the applicable law, which in many cases will not be Swiss law. Other fields of the law may also be involved in the question of access to scientific publications, in particular constitutional law, criminal law and public law.

### **III. From the author’s point of view**

313 By creating the work, the author receives all the copyright in it. He can himself decide whether he wishes to publish the work and whether he wishes to do this under open-access conditions (“golden road”), through a conventional publisher or – if he retains the rights necessary as against the publisher – the two in parallel (“green road”).

314 Whether a publishing contract is concluded between the author and the publisher depends on whether the parties have been able to agree on the

essential aspects. Standard terms of business also require the parties' consent, i.e. the STBs of one party do not apply automatically to the other party if the latter has not accepted them.

315 If the parties have concluded a publishing contract, the publishing contract law contained in the OR applies, but – since it is entirely non-mandatory – only to the extent that the parties have not concluded provisions to the contrary. The law contains not only rules concerning the grant of rights (Art. 381 Para. 1, OR) but also concerning the exercise of the rights (Art. 382, OR). For the entitlement to deposit the work in a repository, a distinction must be made between three constellations:

- Scientific journal articles and contributions to collective volumes dealing with a topic in depth can only be deposited in a repository at the earliest three months after date of publication (Art. 382 Para. 3, OR).
- Current-affairs related reports can be deposited at any time, i.e. without a waiting period (Art. 382 Para. 2, OR).
- Other works, in particular monographs and textbooks, can, as a matter of principle, not be deposited in a repository by the author unless he deposits a version that cannot be correctly cited (citability being subject to different requirements in the different subjects) and that does not constitute a direct competition with the publisher's version (Art. 382 Para. 1, OR).

316 As mentioned, the parties are at liberty to depart from the publishing contract law in the OR. If they have concluded a provision concerning the grant of rights, the said Arts. 381 and 382 of the OR in particular do not apply to them. The parties are absolutely at liberty to adopt a provision concerning the deposit in a repository. This may for instance be a provision laying down that the author is prohibited from depositing the work in a repository, or that he can only deposit it on his personal Internet site but not elsewhere, or that he can only deposit the work in the form of the accepted manuscript but not in the form of the publisher's pdf.

317 Without a provision concerning the publisher's pdf, the author can make use of it without restriction provided that he holds the necessary rights to the work. However, the trademark rights (e.g. to a publisher's trademark logo) remain reserved. In the present author's opinion, the publisher's pdf (as an achievement by the publisher) is not protected separately against adoption by the copyright holder on the basis of Art. 5 c of the UWG.

However, it cannot be entirely excluded that a court would decide differently.

318 If the parties concluded the contract before the possibilities of the Internet became generally known (approx. 1995), the question arises whether the contract also includes the online rights. This must be determined by construction. If for instance the contract provides for the assignment of “all copyright”, this also includes the online rights not known at the time. Swiss law does not contain a prohibition of the grant of rights with respect to unknown types of use.

319 The remarks so far show that within the limits of the publishing contract law of the OR, the parties are at liberty to adopt the “green road” and to allow the deposit of the work in a repository by the author alongside the publication by the publisher. However, whether this freedom of contract can be used appropriately depends to a large extent on the publisher's market power, and that of the author concluding the contracts. In practice, it is, as a matter of principle, the publishers that unilaterally lay down the contractual conditions.

320 If a copyright work has been created by more than one person as joint authors, a contract concerning this work, as a matter of principle, requires the consent of all joint authors. However, the joint authors can agree a different consent requirement (Art. 7 Para. 2, URG).

321 In international constellations, it must first be clarified whether there is a Swiss legal venue at all. If this is the case, the applicable law must be determined in accordance with the Swiss IPRG. A distinction must be made between contract law and specifically copyright law questions. Publishing contract law aspects are, as a matter of principle, subject to the laws of the country in which the publisher has its place of business (Art. 117 Para. 2, IPRG). Copyright aspects are subject to the country-of-protection principle, according to which the law of the country applies for which protection is claimed (Art. 110 Para. 1, IPRG); if for instance the author is required to remove a specific work from an Internet server located in Switzerland, Swiss law applies to this extent. The parties can also choose a law within the limits of the IPRG.

#### IV. From the repository operator's point of view

322 The deposit of works in a repository requires the repository operator to hold the right of reproduction (Art. 10 Para. 2 a, URG) and the right to make this work available (Art. 10 Para. 2 c, URG). The mere referral to works by means of hyperlinks as a matter of principle requires no copyright in the works in question.

323 The entitlement to the works to be deposited can be obtained by the repository operator either from the author or from the publisher, depending on who holds the necessary rights. If the publisher makes works freely available on the Internet, this of itself cannot be used to derive a right of the repository operator to deposit the work in his repository. Nor is this right provided as a matter of principle by a subscription to an (online or printed) journal. If the rights are held by the publisher, the repository operator cannot circumvent the requirement to obtain the publisher's consent by storing a slightly modified version of the work or a different layout (e.g. without the publisher's page numbers).

324 The deposit of works is permissible without the rightholder's consent if it is covered by a statutory copyright limitation. This would above all be the limitation for internal use (Art. 19 Para. 1 c, URG), according to which scientific organisations and, in particular, universities are permitted to reproduce works already published and make them available for internal use. However, the limitation for internal use does not apply to complete sales copies. Thus for instance entire books cannot be made available within the university without the rightholder's consent.

325 A further copyright limitation allows the repository operator to create archive copies without the rightholder's consent (Art. 24 Para. 1<sup>bis</sup>, URG). However, these archive copies must not be made available to the public without the rightholder's consent.

326 The repository operator can, as a general rule, derive nothing to his benefit from anti-trust law. Admittedly, market-dominant publishers must not as a matter of principle refuse the commencement of business relationships (Art. 7 Para. 2 a, KG) or impose unreasonable prices or terms of business (Art. 7 Para. 2 c). However, according to current anti-trust law, scientific publishers will only be qualified as market-dominant in rare exceptional cases.

327 If works are deposited in a repository without permission, the repository operator thereby as a matter of principle commits a breach of copyright. The injured party can require the repository operator in particular to eliminate the infringement and to pay damages. The repository operator could secure himself against such an action by agreeing with the author that the latter will indemnify him in the event of an infringement. In purely practical terms, a shifting of the risk to the author could be counterproductive and lead to the author a priori refusing to deposit works in the repository.

328 The applicable law must be determined in international constellations. A distinction is to be made here between contractual and copyright issues. If for instance a publisher files an action against the repository operator on the grounds of a breach of copyright without there being a contract between the two parties, the issue is one of copyright, which is subject to the country-of-protection principle. In such a case, the laws of the country apply for which protection is claimed (Art. 110 Para. 1, IPRG).

## V. From the user's point of view

329 In order to download scientific works from the Internet, the user requires the corresponding copyright powers. He largely receives the corresponding entitlement through the statutory copyright limitations concerning temporary reproductions (Art. 24a, URG) and above all private and internal use (Art. 19 Para. 1 a and c, URG).

330 However, the user can only benefit from these limitations if he has possession of or access to a copy of the work. Otherwise, the statutory permission to use the work is useless. The limitation does not, namely, give him a right of access to scientific publications. Admittedly, the law allows him to circumvent technical protection measures (such as access controls or copyright protection), but it prohibits the trade in corresponding circumvention tools, with the result that a user who is not technically skilled cannot easily make use of his circumvention right.

331 For uses by the user that are, exceptionally, not covered by the copyright limitations, the user requires the rightholder's consent, i.e., depending on the situation, that of the author, the publisher or the repository operator. Without the necessary entitlement, an action can be brought against the user by the rightholder for breach of copyright, but as a matter of principle

the rightholder will not take the effort of commencing litigation against an individual user.

332 In international constellations, the law applicable to breaches of copyright is, as a matter of principle, determined by the country-of-protection principle (Art. 110 Para. 1, IPRG). If the user has committed breaches of copyright in Switzerland, Swiss law applies.

## VI. De lege ferenda approaches

333 There are a number of starting points for amendments to the law that would take increased account of the open access principle. In the first place, a *copyright limitation* would be possible that would permit making scientific works available to the public. Because of the requirements of international law, and in particular those of the three-step test, the scope of application of such a limitation would have to be restricted in a number of respects.

334 The present legal opinion proposes a copyright statutory licence to permit making works available but subject to remuneration. An alternative would also be a compulsory license. Both provisions would only apply to articles in journals that are predominantly financed by public funds. In addition, making available to the public without the author's consent would only be permissible for non-commercial purposes and only after one year has expired following first publication.

335 A further approach is to be found in *binding contract law provisions*. Thus, for instance, the provision in current publishing contract law, according to which articles in journals and collected volumes can be made available elsewhere three months after publication, could be declared binding for scientific works.

336 Another contract law approach is to be found in the relationship between the author and the repository operator. If the author is employed by the repository operator, i.e. for instance as a university scientist, the author could be obliged by his contract of employment to release his works for open access use. However, such an obligation would be dubious since it would restrict the scientist's freedom to dispose of his publications, and would to this extent – although in the name of the freedom of science – constitute a deterioration in his working conditions.