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Provisional text

OPINION OF ADVOCATE GENERAL

CAMPOS SÁNCHEZ-BORDONA

delivered on 12 September 2019 ([1](#))

Case C-666/18

IT Development SAS

v

Free Mobile SAS

(Request for a preliminary ruling from the Cour d'appel de Paris (Court of Appeal, Paris, France))

(Reference for a preliminary ruling — Copyright and related rights — Legal protection of computer programs — Licensing agreement for a computer program — Action for infringement brought by the author of the program against the licensee — Nature of the liability regime applicable)



1. The holder of the copyright in a computer program brought an action against one of its licensees (with which it had concluded a licensing agreement) on the ground that the latter had made modifications to that program without the former's consent. That action, brought before a French court of first instance, which dismissed it, was based on liability for copyright infringement (liability *ex delicto*) rather than on breach of the terms of the contract (liability *ex contractu*).

2. The appeal court is faced with the dilemma of whether to classify the defendant's conduct as constituting an infringement of the copyright (*contrefaçon*) in the program or a breach of its contractual

obligations. The issue before it lies in the fact that, according to a principle of French law, an action *ex delicto* can as a general rule be brought only where the parties are not bound by a contractual relationship.

3. The question referred for a preliminary ruling asks the Court of Justice to dispel those doubts by interpreting Directives 2004/48/EC (2) and 2009/24/EC. (3)

I. Legal framework

A. EU law

1. Directive 2009/24

4. According to recital 13:

‘The exclusive rights of the author to prevent the unauthorised reproduction of his work should be subject to a limited exception in the case of a computer program to allow the reproduction technically necessary for the use of that program by the lawful acquirer. This means that the acts of loading and running necessary for the use of a copy of a program which has been lawfully acquired, and the act of correction of its errors, may not be prohibited by contract. In the absence of specific contractual provisions, including when a copy of the program has been sold, any other act necessary for the use of the copy of a program may be performed in accordance with its intended purpose by a lawful acquirer of that copy.

5. Paragraph 1 of Article 4 (‘Restricted acts’) states:

‘Subject to the provisions of Articles 5 and 6, the exclusive rights of the rightholder within the meaning of Article 2 shall include the right to do or to authorise:

- (a) the permanent or temporary reproduction of a computer program by any means and in any form, in part or in whole; in so far as loading, displaying, running, transmission or storage of the computer program necessitate such reproduction, such acts shall be subject to authorisation by the rightholder;
- (b) the translation, adaptation, arrangement and any other alteration of a computer program and the reproduction of the results thereof, without prejudice to the rights of the person who alters the program;
- (c) any form of distribution to the public, including the rental, of the original computer program or of copies thereof.

6. Paragraph 1 of Article 5 (‘Exceptions to the restricted acts’) provides:

‘In the absence of specific contractual provisions, the acts referred to in points (a) and (b) of Article 4(1) shall not require authorisation by the rightholder where they are necessary for the use of the computer program by the lawful acquirer in accordance with its intended purpose, including for error correction.

7. Article 6 (‘Decompilation’) states:

‘1. The authorisation of the rightholder shall not be required where reproduction of the code and translation of its form within the meaning of points (a) and (b) of Article 4(1) are indispensable to obtain the information necessary to achieve the interoperability of an independently created computer program with other programs, provided that the following conditions are met:

- (a) those acts are performed by the licensee or by another person having a right to use a copy of a program, or on their behalf by a person authorised to do so;

...



2. The provisions of paragraph 1 shall not permit the information obtained through its application:
 - (a) to be used for goals other than to achieve the interoperability of the independently created computer program;
 - (b) to be given to others, except when necessary for the interoperability of the independently created computer program; or
 - (c) to be used for the development, production or marketing of a computer program substantially similar in its expression, or for any other act which infringes copyright.

3. In accordance with the provisions of the Berne Convention for the protection of Literary and Artistic Works, the provisions of this Article may not be interpreted in such a way as to allow its application to be used in a manner which unreasonably prejudices the rightholder's legitimate interests or conflicts with a normal exploitation of the computer program'.

2. *Directive 2004/48*

8. Recital 10 states:

'The objective of this Directive is to approximate legislative systems so as to ensure a high, equivalent and homogenous level of protection in the Internal Market'.

9. Recital 15 reads:

'This Directive should not affect substantive law on intellectual property ...'

10. Article 2 ('Scope') states:

'1. Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as those means may be more favourable for rightholders, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.

...

3. This Directive shall not affect:

- (a) the Community provisions governing the substantive law on intellectual property ...'

11. Article 3 ('General obligation') provides:

'1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time limits or unwarranted delays.

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.'



B. *French law: Code la propriété intellectuelle* (4)

12. Article L122-6 states:

'Subject to the provisions of Article L122-6-1, the right of exploitation held by the author of a software package shall include the right to do and to authorise:

1. The permanent or temporary reproduction of a software package ...

2. The translation, adaptation, arrangement or any other alteration of a software package and the reproduction of the resultant software ...
 3. The marketing, for consideration or free of charge, including rental, of the copy or copies of a software package by any means ...'
13. Article L122-6-1 provides:
- 'I. The acts provided for in Article L122-6(1) and (2), including the correction of errors, shall not be subject to authorisation by the author where they are necessary to allow the software to be used, in accordance with its intended purpose, by the person entitled to use it.
- However, the author may reserve for himself by contract the right to correct errors and to determine the specific conditions to which the acts provided for in Article L122-6(1) and (2), which are necessary to allow the software to be used, in accordance with its intended purpose, by the person entitled to use it, will be subject'.
14. In accordance with Article L335-3:
- '...
- A breach of any of the rights which the author of a software package holds under Article L122-6 shall also constitute an *infringement of copyright*.
- ...'

II. Facts of the dispute and question referred for a preliminary ruling

15. By a contract signed on 25 August 2010, (5) the company Free Mobile, a mobile telephone operator, obtained a licence to use the 'ClickOnSite' software package. The owner of the copyright of that software package was the company IT Development.
16. On 18 June 2015, (6) IT Development brought an action against Free Mobile for infringement of the copyright (*contrefaçon*) in the ClickOnSite software package and sought compensation for the damage it had suffered. More specifically, it accused Free Mobile of having modified the software's source code, in particular by introducing new forms, thus breaching the sixth clause of the licensing agreement.
17. Free Mobile opposed the action, considering it to be inadmissible and unfounded. It also brought a counterclaim for abuse of process.
18. The Tribunal de grande instance de Paris (Regional Court, Paris, France), by judgment given on 6 January 2017, declared the claims of liability *ex delicto* raised by IT Development inadmissible and dismissed the counterclaim.
19. IT Development brought an appeal against that judgment before the Cour d'appel de Paris (Court of Appeal, Paris, France), laying emphasis in its appeal on the claims it had raised at first instance 'under the heading of copyright infringement' but adding to them the claim, in the alternative, that Free Mobile be ordered 'on the basis of the contract between them' to compensate it for the damage caused.
20. Free Mobile contended that the judgment at first instance should be upheld, except as regards the dismissal of the counterclaim.
21. The appeal court has considered it necessary to refer a question for a preliminary ruling, and gives the following reasons for doing so:
- Since the 19th century, French civil liability law has been based on the principle of non-cumulation of liability *ex delicto*, on the one hand, and liability *ex contractu*, on the other, which means: (a) that a person cannot incur liability on both grounds at the same time; and (b) that, where the parties are bound by a valid contract and the loss suffered by one is the result of the



non-performance or defective performance of contractual obligations by the other, non-contractual liability is discarded in favour of contractual liability.

- French law regards copyright infringement (*contrefaçon*), originally a criminal offence, as being associated with liability *ex delicto* rather than with breach of contract.
- Accordingly, given that the parties were bound by the contract of 25 August 2010 and the damage was alleged to have arisen from a breach of the terms of that contract, the court of first instance, in its decision, ruled out liability *ex delicto* in favour of liability *ex contractu*. Consequently, it held the action for copyright infringement, inasmuch as it was to be treated as an action for a declaration of non-contractual liability, to be inadmissible.
- However, IT Development’s submission that ‘an action for copyright infringement is not by nature a non-contractual action but can also arise from a breach of contract’ is not without relevance.
- The French concept of *contrefaçon*, after all, is defined in its broadest sense as any breach of an intellectual property right and, in Article L335-3 of the CPI, as ‘the breach of any of the rights [held by] an author of a software package’ (under Article L122-6 of the CPI).
- Neither those provisions nor any other provision of French law governing *contrefaçon* expressly provides that such an infringement is present only where the parties are not bound by a contract.
- Although capable of being classified as exceptions to the aforementioned principle of non-cumulation, some provisions of French law show that, in the case of patents and trade marks, an action for infringement can be brought against a licensee who has exceeded the limits of his agreement. [\(7\)](#)
- Articles L122-6 and L122-6-1 of the CPI, which provide for the determination by contract of the arrangements for the modification of a software package, do not rule out an action for infringement in such cases. The same is true of Articles 4 and 5 of Directive 2009/24, which those articles of the CPI incorporate into domestic law.
- Finally, Article 2 of Directive 2004/48 stipulates in general that the measures, procedures and remedies for which it provides are to apply to any infringement of intellectual property rights without distinction as to whether or not their infringement arises from a breach of contract.

22. On that basis, the Cour d’appel de Paris (Court of Appeal, Paris) has referred the following question to the Court of Justice for a preliminary ruling:

‘Does a software licensee’s non-compliance with the terms of a software licence agreement (by expiry of a trial period, by exceeding the number of authorised users or some other limit, such as the number of processors which may be used to execute the software instructions, or by modifying the source code of the software where the licence reserves that right to the initial rightholder) constitute:

- an infringement (for the purposes of Directive 2004/48 of 29 April 2004) of a right of the author of the software that is reserved by Article 4 of Directive 2009/24/EC of 23 April 2009 on the legal protection of computer programs,
- or may it comply with a separate system of legal rules, such as the system of rules on contractual liability under ordinary law?’



III. Procedure before the Court of Justice and arguments of the parties

23. The order for reference was received at the Court of Justice on 25 October 2018.

24. Written observations have been lodged by the companies IT Development and Free Mobile, the French Government and the Commission. A hearing was not held as the Court did not consider it essential.

IV. Analysis of the question referred

A. Preliminary observations

1. The scope of the question referred

25. Free Mobile states that the question referred is, in part, inadmissible because it is hypothetical so far as concerns three of the alleged breaches of contract listed in the order for reference (expiry of the trial period, exceeding of the number of authorised users and exceeding of another unit of measure). It is only the possible breach of contract on grounds of modification of the source code that bears some relation to the dispute in the main proceedings.

26. The referring court presents the four situations described above on the same basis, as being manifestations of a single behaviour, but Free Mobile is right to say that they are not necessarily identical from a legal point of view and, in particular, that the first three are unrelated to the facts at issue. It is not therefore appropriate to extend the answer to the question referred to those forms of conduct.

27. Directive 2009/24 is specifically concerned with the legal protection of computer programs, which the Member States must treat for copyright purposes as literary works within the meaning of the Berne Convention of 9 September 1886 (Article 1(1)).

28. Computer programs nonetheless exhibit special features which call for treatment different to that afforded to other works protected by copyright. In order for the acquirer of the program to be able to use it in accordance with its intended purpose, certain rights which, by law, form part of the monopoly typically held by a holder of intellectual property rights are excluded, again by law, precisely because of the particular nature of the protected work.

29. In keeping with that regime, while Article 4 of Directive 2009/24 confers exclusive rights on the author of a computer program, (8) Articles 5 and 6 create certain exceptions or 'internal limits' to those rights, which are statute-based. (9)

30. Article 5(1) of Directive 2009/24 allows changes to be made, by contract, to the protection regime and exceptions provided for by the Directive itself. Although, in principle, authorisation by the copyright holder is not required for certain actions, it is possible, by means of specific contractual clauses, agreed with the licensee, for the author of the program to recover exclusivity in relation to some of the rights listed in Article 4. In those circumstances, the legal basis of the author's rights will be contractual rather than statutory; at the same time, the liability of a licensee who infringes the author's exclusive rights will also be contract- rather than statute-based.

31. It is for the referring court to determine whether the circumstances of the dispute are consistent with the factual scenarios provided for in Directive 2009/24 (and the national legislation transposing it), in particular Article 5(1), as regards the program author's rights being reserved by contract.

32. If they are, the substance of the dispute could only be classified as contractual. The principle of non-cumulation applicable in French law, and the compatibility of which with Directive 2004/48 and 2009/24 underlies the question referred for a preliminary ruling, would not therefore come into play.

33. The following reflections look at the question referred from a broader perspective, that is to say in the event that the conduct of the licensee can be simultaneously classified as a breach of contract and as an infringement of a general duty to respect the author's rights as defined by law (a corollary, ultimately, of the *alterum non laedere* rule). In that event, the principle of non-cumulation would apply.



2. Substance: the matter at issue

34. The French Government and the Commission consider that Directive 2004/48 does not prescribe a particular liability regime. The answer to the questions raised is therefore to be determined in accordance with the procedural autonomy of the Member States, subject to the principles of equivalence and effectiveness.

35. The parties to the originating dispute and the Commission have put forward other arguments in support of their respective positions. First of all, they refer to the judgment of 18 April 2013, (10) given on appeal, in which the Court ruled on the — contractual or non-contractual — nature of a dispute that bears some similarities to the present case.

36. Free Mobile also cites Article 8 of Regulation (EC) No 864/2007, (11) under which any infringement of an intellectual property right creates a non-contractual obligation to make reparation.

37. Finally, Free Mobile and the Commission refer to the Court's case-law concerning Regulation (EU) No 1215/2012, (12) in accordance with which non-contractual liability has a residual character under EU law.

38. Account being taken of the fact that, if any of those arguments were to prevail, it might not be necessary to analyse Directives 2009/24 and 2004/48, I shall deal with them first, although, before doing so, I shall look at the principle of non-cumulation in the French legal system.

B. The principle of non-cumulation in French law: exceptions

39. The principle of non-cumulation has as its starting point a fact which may at one and the same time constitute the non-performance (or defective performance) of a contract and the breach of a statute-based duty. As a result, compensation might be claimed on two legal grounds — contractual and non-contractual — the procedural regimes associated with which are usually different. (13)

40. In that situation, it is possible for the applicant to be given a choice between the aforementioned two legal positions (Netherlands, Germany and the United Kingdom) or for one position to be favoured to the exclusion of the other (France and Belgium). In the latter case, the term 'non-cumulation' might be replaced with that of 'no choice'.

41. The principle of non-cumulation has been justified on various grounds. First, from a practical point of view, it ensures that the choice of applicable liability regime does not lie at the discretion of the applicant; this protects the agreement and preserves the binding nature of contracts. Secondly, it avoids an over-extensive civil liability regime (such as that under Article 1242 of the French *Code civil* (Civil Code)) for which the parties did not provide and which is capable of jeopardising the contractual balance.

42. It is worth recalling, however, that the French legal system permits exceptions to the aforementioned principle: this is true in particular of patents and trade marks. (14) In both cases, there is some precedent for this approach in EU law. (15)

43. Among the reasons that would explain the derogations from the no-choice principle in those fields are considerations linked to the exhaustion of industrial property rights that would not be relevant to copyright. (16) Much as this explanation may seem inadequate in the case of computer programs, (17) the fact is that the licensing of computer programs does not benefit, either in EU law or French law, from provisions similar to those applicable to trade marks or patents. In France, therefore, this field is subject to the non-cumulation rule, although its implementation is fraught with a number of difficulties. (18)

C. Classification in other contexts: Systran and the 'Rome II' Regulation

1. The judgment in Systran

44. In the judgment in *Systran*, the Court ruled on a dispute that bears some similarities with that under examination here when giving judgment on an appeal lodged against the judgment of the General Court of 26 December 2010. (19)

45. According to the facts of that case, the Commission and the Systran Group were bound for a number of years by a series of contracts for the use by the former of a machine translation program owned by the latter. The Commission later went on to use the services of another supplier for the maintenance and linguistic enhancement of its machine translation system. Systran took the view that, by that conduct, the Commission had infringed its intellectual property rights and on that basis brought an action before the General Court.



46. The Commission sought to have the action declared inadmissible on the ground that the General Court lacked jurisdiction owing to the contractual nature of the dispute: in the absence of an arbitration clause, disputes of that nature fall within the jurisdiction of the national courts. That plea having been dismissed, the Commission lodged an appeal.

47. The Court of Justice set aside the judgment of the General Court for infringement of the rules of jurisdiction, inasmuch as it had wrongly held the dispute to be non-contractual.

48. The finding as to the contractual nature of dispute was reached in the context of the division between the EU courts and the national courts of jurisdiction to hear and determine actions for damages directed against EU institutions. The Court of Justice held that the concept of non-contractual liability within the meaning of Article 235 EC and the second paragraph of Article 288 EC (now Article 268 TFEU and the second paragraph of Article 340 TFEU) is autonomous and must be interpreted in the light of its purpose, which is to permit the aforementioned division. (20)

49. I am not saying that the judgment in *Systran* does not have some lessons to teach us for the purposes of this case. I do not believe, however, that that judgment supports the inference of a corollary as to which classification of liability (contractual or non-contractual) is applicable in a completely different context such as that of the transposition of Directives 2009/24 and 2004/48.

50. The objectives of those directives are to harmonise the substantive protection of intellectual property interests in computer programmes, on the one hand, and the mechanisms for the procedural protection of intellectual property rights, on the other, both far removed from the purpose with which the judgment in *Systran* was exclusively concerned. This reinforces the conclusion that the reasoning adopted in that judgment cannot replace the principles which, in the domestic legal systems of the Member States, inform the two types of liability in question and determine the procedure applicable to each.

2. The classification in the ‘Rome II’ Regulation

51. The arguments to the effect that infringements of intellectual property rights are caught by the ‘Rome II’ Regulation on the law applicable to non-contractual obligations must also be rejected.

52. Contrary to what Free Mobile suggests, that regulation does not treat the infringement of an intellectual property right as a harmful act that gives rise to a non-contractual obligation. What it establishes is the law applicable to ‘a non-contractual obligation arising from an infringement of an intellectual property right’ (Article 8(1)). If, as may occur in the case of computer programs, the origin of the exclusive rights of the program’s author which are being infringed is a contract, (21) the law applicable will not be decided in accordance with the Rome II Regulation but in accordance with Regulation (EC) No 593/2008. (22)

D. The residual nature of non-contractual liability: Regulation No 1215/2012

53. The argument based on the definition of non-contractual liability provided by the Court of Justice in connection with Regulation No 1215/2012 is not to be endorsed either.

54. That definition, which certainly appears to confer secondary status on non-contractual liability, serves only to draw a dividing line between paragraphs 1 and 2 of Article 7 of the aforementioned regulation, thus avoiding an overlap that would render those paragraphs partially useless. That dividing line is drawn in the context of the determination of international jurisdiction in cross-border cases and is informed by principle specific to that context. As such, it cannot be exported to different contexts such as that of the present reference for a preliminary ruling.

E. Protection of computer programs

1. Scope of Directives 2009/24 and 2004/48

(a) Directive 2009/24

55. Directive 2009/24 takes as its premiss the paramount importance of information technology to the industrial development of the European Union. Noting the adverse effects which certain discrepancies in the

laws of the Member States have on the functioning of the internal market in relation to computer programs, it contains substantive rules [\(23\)](#) aimed at removing those discrepancies.

56. The Directive includes within its scope protection for the rights of a program author both within the framework of the contractual relationship of which that program is the subject and in the relationship between the author and third parties. In particular, there are exceptions to the exclusive rights (referred to in Article 4) that typically come into their own in the context of a contract: this is the case with the exception enjoyed by the lawful acquirer of the program (Article 5(1)) or the ‘person having a right to use the ... program’ (Article 5(2)). An explicit reference to the relationship between the rightholder and the licensee appears in Article 6(1)(a).

(b) Directive 2004/48

57. Directive 2004/48, unlike Directive 2009/24, contains procedural rather than substantive rules. Its starting point is the need to have effective means of protecting intellectual property given that, without them, innovation and creativity are discouraged and investment diminished (recital 3). In order to limit the inequalities that exist between the Member States in relation to those means and their potential to distort the internal market, it lays down common procedural or procedure-related provisions.

58. The scope of Directive 2004/48 is defined in three ways: the object protected (the rights), the perimeter of protection (infringements) and the protective measures (harmonised enforcement mechanisms).

59. As regards the object, the measures, procedures and remedies provided for by the Directive are to apply ‘to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned’ (Article 2 of the Directive, in line with recital 13). [\(24\)](#)

60. In this case, since the copyright concerned is provided for both in Directive 2009/24 and in the CPI (Articles L112-2, L122-6 and L122-6 1), it is covered by Directive 2004/48.

61. As regards the infringements to which Directive 2004/48 applies, this must be given an autonomous interpretation that takes into account the context and objectives of that provision. The adjective ‘any’ in Article 2 and the overall purpose of the Directive support an interpretation to the effect that it applies to any infringement, including one deriving from the breach of a contractual clause relating to the exploitation of an intellectual property right, and, therefore, to rights which are by law exclusive to their holder.

62. As regards protective measures, Article 2(2) does not displace the protection specifically provided for in other Community acts. These include Article 7 of Directive 91/250 (now Article 7 of Directive 2009/24). Given that the situations governed by the latter provision are not the same as those described in the reference for a preliminary ruling, this aspect of the Directive does not contradict the previous conclusion with respect to its application.

2. Measures, procedures and remedies for protecting the rights enjoyed by the author of the computer program

(a) Directive 2009/24

63. Directive 2009/24 imposes on the national legislature an obligation to protect computer programs with the right enjoyed by the author of a literary work, but does not associate that obligation with a preferred or exclusive legal regime. In other words, it does not take a stance on whether a claim for copyright infringement that arises from a breach of contract must be channelled through the liability regime provided for under ordinary law or may be covered by another regime such as that available in France for infringements of intellectual property rights.

(b) Directive 2004/48

64. Directive 2004/48 also does not prescribe a particular form of procedure for claiming damages in the event of a breach of contract giving rise to a copyright infringement. [\(25\)](#)

65. Article 3 of the Directive, on the other hand, requires that the measures, procedures and remedies which the Member States adopt in order to enforce intellectual property rights meet the following conditions: they must be fair, equitable, effective, proportionate and dissuasive, and not unnecessarily complicated or costly; they must not entail unreasonable time limits or unwarranted delays; and they must be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

66. Those conditions do not support the inference that Directive 2004/48 inclines towards giving preference to the judicial protection which, in France, takes the form of an *action en contrefaçon* (action for copyright infringement). (26)

67. In the abstract, it might be thought that a claim brought within the procedural framework specific to copyright infringement in France affords greater protection to the author of a computer program: cases are assigned to certain courts (Article L331-1 of the CPI); the reparation regime includes the possibility of obtaining an award of damages in addition to full reparation (Article L331-1-3 of the CPI); and applicants have access to the measures connected with *saisie-contrefaçon* (confiscation of works infringing intellectual property rights) provided for in Articles L332-1 to L332-4 of the CPI. However, even if that were the case, (27) the fact that the aforementioned rules are not applicable to an action based on a contract (and, by extension, that the applicant is not given a choice between an action for copyright infringement and an action for breach of contract under ordinary law) does not necessarily imply that the protection rules under Directive 2004/48 have been infringed.

68. The EU legislature does not require the measures, procedures and remedies adopted in the Member States to protect intellectual property to exhibit the qualities listed in Article 3 of Directive 2004/48 to the greatest degree, which is to say that they should be the *most* effective or the *most* dissuasive or create the *least* barriers to legitimate trade. It must not be forgotten that the Directive is based on minimum standards (Article 2(1)).

69. On the face of it, there is no reason to believe that, when national law channels a claim for intellectual property infringement through the contractual liability regime under ordinary law, it does so by means of measures, procedures or remedies which do not satisfy the requirements of Article 3 of Directive 2004/48. In any event, this is a matter for assessment by the referring court.

70. It is essential, on the other hand, that any procedure open to the holder of the right concerned should meet all of the requirements of Directive 2004/48, including those in Article 3 and the rest. Thus, for example, if Article 13 requires that damages be set in the light of ‘all appropriate aspects’, some of which it specifically mentions, the compatibility of national law with that provision requires that such an assessment be carried out in the course of the adjudication of both an action for copyright infringement and an action based on contractual liability under ordinary law. Subject to that reservation, there are no grounds for objection — from the point of view of EU law — to either of the aforementioned two remedies or, by extension, to the principle of non-cumulation.

F. Procedural autonomy and limits on the freedom of the national legislature

71. Directive 2004/48 has a restricted scope (28) and its level of protection, I will say again, is ‘minimal’. As I have already stated, the matters which it does not govern include the remedy or type of action to be used to bring a claim for damages in the event of an infringement of intellectual property rights which is at the same time a breach of contract. (29)



72. Now, in the absence of procedural rules originating in Directive 2004/48 or in order to build on those which it contains, it is for the national legislature to establish the procedural framework intended to enforce the rights to which that directive refers. It must do so with due regard for the rules of the Directive itself and, in any event, for the principles of equivalence and effectiveness. (30)

1. Equivalence

73. The condition of equivalence means that national procedural legislation cannot treat claims based on EU law any less favourably than similar claims based on domestic law. The analysis comprises two stages,

the first being to identify a comparable remedy in the national legal system, and the second to carry out the comparison itself.

74. Although it is for the national court to determine whether the situation described (less favourable treatment) is present in the case of copyright in computer programs in France, there is nothing in the documents before the Court to indicate that this is so. On the contrary, there would appear to be a single regime which is applicable without distinction to any infringement of those rights (and which includes a prohibition against cumulating actions in the manner described above). Given, therefore, that there are no equivalence issues, the debate is confined to the context of the principle of the effectiveness of the procedural mechanisms provided for in national law.

75. The referring court does mention, however, the different treatment afforded to an action for copyright infringement of a computer program as compared with actions for infringements of patents and trade marks. To my mind, however, there is insufficient material on the basis of which to carry out a comparison between the former and the latter.

76. In the first place, an action for infringement of patents and trade marks serves to protect the rightholder's statute-based exclusive rights. In the case of computer programs, on the other hand, certain acts which, under the ordinary intellectual property regime, would require authorisation by the rightholder, are exempt from that requirement by law, with the result that the rightholder recovers exclusivity only if this is agreed by contract. Depending on the act in question, therefore, the starting point may be different from that in the case of patents and trade marks.

77. In the second place, both in France and internationally, the debate about whether computer programs should be protected by patent or copyright has ended in favour of the latter. Under Article L611-10(2)(c) of the CPI, computer programs are not patentable.

2. Effectiveness

78. From the point of view of the principle of effectiveness, the decisive criterion for the purposes of this case is whether the French legislation applicable to the protection of computer programs makes it impossible or excessively difficult to exercise the copyright conferred by EU law by denying the author of a program access to an action for copyright infringement where (and because) the infringement of those rights entails at the same time a breach of contract.

79. In my opinion, the mere existence of the action for a declaration of contractual liability makes it possible to say that the judicial protection of copyright is not *impossible*.

80. Neither do I believe that the French legislation in this area makes it *excessively difficult* to exercise that right, to the point of deterring the person concerned from initiating judicial proceedings. Even if it could be stated with certainty that, in the abstract, the person concerned would be in a better position by pursuing his claim through an action for copyright infringement, the reach of the principle of effectiveness, as a limit on the procedural autonomy of the national legislature, is not so extensive.

81. So far as that principle is concerned, what matters is not which option will better protect the rights of the author of the computer program but whether the option that is available makes it excessively difficult for the author to defend himself.

82. As I have already stated, there is no reason to assume, on the face of it, that the measures, procedures and remedies applicable to a contract-based claim in France give rise to such difficulties to the point, in practice, of hindering the protection of the rights from which copyright holders in computer programs benefit.

83. It nonetheless falls to the referring court to establish whether, in the light of the relevant evidence, this is true of the action for a declaration of contractual liability.



V. Conclusion

84. In the light of the foregoing, I propose that the Court's answer to the question referred for a preliminary ruling by the Cour d'appel de Paris (Court of Appeal, Paris, France) should be as follows:

Articles 4 and 5 of Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs, in conjunction with Article 3 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, must be interpreted as meaning that:

- The modification of a computer program's source code in breach of a licensing agreement constitutes an infringement of the intellectual property rights enjoyed by the holder of the copyright in that program, provided that that modification is not exempt from authorisation under Articles 5 and 6 of Directive 2009/24.
- The legal basis for the action which a holder of the copyright in a computer program may bring against the licensee for infringement of the former's rights is contractual where the licensing agreement itself reserves such rights for the author of the program, in accordance with Article 5(1) of Directive 2009/24.
- It is for the national legislature to determine, with due regard for the provisions of Directive 2004/48 and the principles of equivalence and effectiveness, the procedural arrangements necessary to protect the copyright in the computer program against infringement, where such infringement simultaneously entails an infringement of copyright and a breach of contract.

1 Original language: Spanish.

2 Directive of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45).

3 Directive of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (OJ 2009 L 111, p. 16). Directive 2009/24 codifies the content of Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (OJ 1991 L 122, p. 42), which had previously been amended.

4 Directive 2009/24 was incorporated into the Code de la propriété intellectuelle (Intellectual property code; 'CPI').

5 Amended pursuant to an appendix of 1 April 2012.

6 It had previously arranged for a confiscation of property in breach of copyright to be carried out on 22 May 2015 at the premises of another company that is a subcontractor of Free Mobile.

7 In this regard, it cites two articles from the CPI: Article L613-8, third paragraph, governing patent licences, and Article L714-1, governing trade mark licences.

8 The Court has interpreted Article 1(2) of Directive 91/250 as meaning that it applies to the expression in any form of a computer program, including the source code (judgment of 22 December 2010, *Bezpečnostní softwarová asociace*, C-393/09, [EU:C:2010:816](#), paragraph 35).

9 As regards the exceptions to the acts subject to restrictions under Article 5 of Directive 91/250 (which is identical to Article 5 of Directive 2009/24) in the case of a licensing agreement, see judgment of 2 May 2012, *SAS Institute* (C-406/10, [EU:C:2012:259](#)).

10 *Commission v Systran and Systran Luxembourg* (C-103/11 P, 'judgment in Systran', [EU:C:2013:245](#)).

11 Regulation of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations ('Rome II') (OJ 2007 L 199, p. 40).

12 Regulation of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2012 L 351, p. 1).

13 In terms, typically, of jurisdiction, limitation of the respective actions, proof or extent of the reparation.

[14](#) See footnote 7 above, which reflects the citation of the corresponding French laws, of which mention is made by the referring court.

[15](#) In the case of patents, in Article 43 of the failed Luxembourg Convention of 15 December 1975, which was ratified by France (Law No 77-681 of 30 June 1977, *Journal Officiel* (French State Gazette) of 1 July 1977, p. 3479). In the case of trade marks, this is the result of transposing Article 8(2) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25). That provision is reproduced in Article 25(2) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1). See also Article 25(2) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

[16](#) P. Léger, 'La nature de la responsabilité dans l'hypothèse de la violation du périmètre d'une licence de logiciel', *Recueil Dalloz*, 2018, p. 1320, under the heading I.A.

[17](#) See Article 4(2) of Directive 2009/24 and the judgment of 12 October 2016, *Ranks and Vasiļevičs* (C-166/15, [EU:C:2016:762](#)).

[18](#) Thus, the Cour d'appel de Paris (Court of Appeal, Paris), in its decision of 10 May 2016 (Paris, pôle 5, n.º 14/25055. <https://www.doctrine.fr/d/CA/Paris/2016/R4668A71A97317DB905E0>), declared inadmissible an action for infringement of copyright in a case concerning a disagreement between the parties with respect to the scope of a licence and whether it included computer programs. A year earlier, the Cour d'appel de Versailles (Court of Appeal, Versailles, France), in the judgment of 1 September 2015 (n.º 13/08074), had held that an action relating to the exploitation of a program for the benefit of third parties not specified at the time when the [licensing] agreement was concluded, concerned 'the economic rights granted and falls under the heading of both contractual liability and copyright infringement'. There are, nonetheless, different readings of that decision: see Hadadd, S., and Casanova, A. (RLDI, 2015, n.º 121). In the decision of 23 May 2007, *Sté Tech — Airport c/ Sté Arkad Informatique et autre*, n.º 06/09541, RLDI 2007, n.º 28, obs. L. Costes et J.-B. Auroux, the Cour d'appel de Paris (Court of Appeal, Paris) upheld an action for infringement by use of software beyond the scope of the [licensing] agreement.

[19](#) *Systran and Systran Luxembourg v Commission* (T-19/07, [EU:T:2010:526](#)).

[20](#) Judgment in *Systran*, paragraph 62.

[21](#) See point 30 of this Opinion.

[22](#) Regulation of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I) (OJ 2008 L 177, p. 6).

[23](#) With the exception of Article 7 thereof, Directive 2009/24 has no procedural provisions.

[24](#) The French version of Article 2 refers to the *infringements* provided for by national or EU law ('à toute atteinte aux droits de propriété intellectuelle prévue'), while, in the German, Spanish, Italian and Portuguese versions, it is the intellectual property rights which are provided for; the same is true of the French version of recital 13 of the Directive. The French version of Article 2 of the Proposal for a Directive, COM(2003) 46 final, is the same and there are no proposed amendments in this regard in the Report of the Parliament of 5 December 2003, A5-0468/2003. The English version of Article 2(1) is neutral and does not make it possible to tell whether it is in keeping with the French. If there are discrepancies between the language versions of a provision of EU law, that provision must be interpreted in accordance with the scheme and purpose of the legislation of which it forms part. This supports the view that it is the intellectual property rights that must be provided for in national or EU law.

[25](#) In the context of evaluating the need for harmonisation in this area, the Commission proposal stated that 'account must be taken of the legal traditions and situation of each Member State'. See COM(2003) 46, p. 17. Furthermore, Member States are bound by international instruments on intellectual and industrial property which are administered by WIPO, as well as by the Agreement on Trade-Related Aspects of Intellectual Property ('TRIPS'), which contain provisions on the protection of intellectual property rights. The Directive expressly states that it must not affect Member States' international obligations under those instruments (see recitals 4 to 6).

[26](#) Under its various headings, Article L331 of the CPI governs civil actions and claims relating to literary and artistic property. In particular, Article L331-1-4 refers to 'orders for payment of damages for infringement of intellectual property rights'.

[27](#) In return, the applicant must prove the originality of the program warranting its protection under copyright rather than by contract. Other features, such as limitation periods, are identical irrespective of the type of action.

[28](#) Judgment of 10 April 2014, *ACI Adam and Others* (C-435/12, [EU:C:2014:254](#)), paragraph 61.

[29](#) Neither does it deal with other matters likely to vary depending on the type of action, such as the nature of the court (ordinary or specialised) that will hear and determine any disputes that may arise or the time limits for bringing proceedings. Even in matters which it does address, and the rules governing which have had to be transposed into the national legal systems, the degree of precision in Directive 2004/48 is not always the same, some provisions being specific while others are more open.

[30](#) See judgment of 21 June 2017, *W and Others* (C-621/15, [EU:C:2017:484](#)), paragraph 25.

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