Software Registers For Public

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Registration of programs provides certainty, public inspection; infringement actions assisted

This article examines the concept of Public Registers for Software Programs, and it asks whether there is a need to consider such a system within the United Kingdom and create a more harmonized approach within the European Union and worldwide.

Historically, the concept of registration of copyright works arose from the creation of the Stationers Company in London and various Decrees of the Star Chamber during the Sixteenth Century. While many laws at that time were intended to control printing, during the Seventeenth Century registration of copyright works with the Stationers Company was required in order to assist in the prevention of infringement, piracy, and importation of infringing copies.[1]

The Statute of Anne in 1709 specifically provided for titles to books to be registered in the Register Book of Stationers Company. The Copyright Act of 1842 contained provisions for Registration at Stationers Hall, although such requirement was not compulsory but was necessary before any action could be brought against infringers.

By Act of Parliament, Registration of Copyright terminated in 1923 in the United Kingdom, and since that date it has been enshrined within English law. There are no formalities that need to be observed in the United Kingdom in order for a work to receive copyright protection. There is no requirement under United Kingdom laws for a work to include a Copyright Notice or for it to be registered anywhere. Copyright Notices may have value to protect works in certain foreign countries, but they are not a prerequisite to protection in the United Kingdom.[2]

Section 3(1) of the Copyright Designs & Patents Act 1988 provides that "Literary Work" means any work other than a dramatic or music work that is written, spoken or sung and includes (1) a table or compilation and (b) a computer program.

Computer Programs were not specifically dealt with in the Copyright Act of 1956, but the Copyright (Computer Software) Amendment Act of 1985 provided that the 1956 act applied in relation to a computer program as it applied in relation to a Literary Work. Therefore, a computer program was treated as a Literary Work without actually saying it. Now, Section 3(1) of the 1988 Act formally identifies computer programs as being specifically benefited by copyright protection.

If a computer program is to benefit from copyright protection it must be original, and copyright will not subsist unless and until it is recorded in writing or otherwise. In addition, the computer program must satisfy the requirements relating to authorship or first publication that are set out in the 1988 Act.

Under U.K. law, the first owner of copyright in a computer program will, as a general rule, be the author subject to certain exceptions.

Where computer programs are generated during employment the ownership usually will vest in the employer, although there are exceptions. An example is where a computer program was generated by an employee outside the scope of his normal duties or outside his normal working hours. Many employers attempt to cover these situations by providing for ownership to vest in the employer under a contract of employment in all circumstances.

An area where difficulties occasionally arise is where computer programs are generated by freelance programmers and contractors who are, in effect, self-employed. Here the Law is well established that unless there is an agreement in writing to the contrary, ownership remains with the self-employed programmer.

United Kingdom copyright in software programs is protected overseas by means of two main conventions, the Berne Convention and the Universal Copyright Convention. Both oblige member countries to apply certain minimum standards to all copyright works originating from other member countries.

Signatories to the Berne Convention, therefore, should accord to U.K. software programs the same rights as accorded under U.K. law. Consequently, no formalities are required for protection, not even the use of copyright logos.

However, under the Universal Copyright Convention it is understood that in some cases formalities may be necessary, such as registration and renewal of Copyright, in order for copyright protection to be afforded in certain countries that are signatories to the Universal Copyright Convention. Broadly speaking, software programs have been best protected by display, on the packaging and within the program, of the usual Copyright Legend (©name of author, date of first publication) and, where appropriate, registration.

It has become standard practice for software programs to display copyright legends as a means of putting infringers on notice whether those programs are sold or

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published in countries that are only members of the Universal Copyright Convention.

When Stationers Hall ceased to be the statutory place for registration of copyright works in 1923 it continued to operate, and indeed does so today, as a voluntary register. It provides, among other things, for computer programs to be deposited upon first publication and afforded the benefit of registration. Authors of copyright works and computer programs occasionally send copies in the mail to themselves as a means of providing proof of date of origination, or they lodge the programs or a print of source code with a notary public for the same reason. If, however, within the United Kingdom no formalities are required for copyright protection to be afforded, why is it necessary for these additional steps to be taken?

Perhaps the problem lies with the relative infancy of the computer industry and, in particular, the software sector. In long-established traditional industries it has been common practice for designs, drawings and other original copyright work to be meticulously recorded and stored in order to provide evidence of authorship. Yet, within the software industry, such logical steps are not always followed. This lack of good housekeeping has become the cause of difficulties in infringement proceedings.

The 1988 Act introduced several opportunities for infringers to be brought to court by means of civil proceedings and also by criminal proceedings. Section 96 of the 1988 Act provides that an infringement of copyright is actionable by the copyright owner. Section 104 provides certain presumptions in proceedings brought in civil actions. For example, where a name purporting to be that of the author appears on copies of the work as published or on the work when it is made, the person whose name appears should be presumed, until the contrary is provided, (a) to be the author of the work, and (b) to have made it in circumstances not falling within Section 11(2), 163, 165 or 168 (works produced in course of employment, Crown copyright, parliamentary copyright or copyright of certain international organizations.

This clearly follows traditional U.K. law that no formalities are required for protection and that copyright vests in the person who created the copyright work and, in the case of computer programs, wrote or caused to be generated the software program.

Recently, there has been an increase in the use of proceedings under the 1988 Act in the Magistrates' Court to seek remedies against software pirates and other blatant infringers of copyright in software programs.

It is for the prosecution to demonstrate that ownership of the infringed program is untainted and were Section 104 of the 1988 Act to apply to criminal proceedings there would be no difficulty. However, criminal liability is defined within Section 107 of the 1988 Act. Under Section 107(6) it is provided that, *inter alia*, Section 104 does not apply to proceedings for an offense under this Section. In other words, the presumption of ownership is not automatic, and the court can call on the prosecution to prove ownership.

That has recently been the tactic in a number of piracy actions brought under Section 107 of the 1988 Act. When Magistrates have asked for proof of copyright, unless there has been registration at Stationers Hall or there are clear in-house records or notarization, the prosecution have been put in a difficult position.

The Model Provisions on the Protection of Computer Software were the result of six years' work carried out by the International Bureau of WIPO from 1971 through 1977.[4] During preparation of the Model Provisions, the Advisory Group of Governmental Experts considered, *inter alia*, the desirability of any system of legal protection incorporating a system for the registration or deposit of computer software or for the compliance with other formalities. Moreover, the Advisory Group in 1976 considered the question of an International Treaty for the protection of computer software that could provide for a minimum level of protection for computer software and a system of recognition of the efforts of an International Registration or Deposit of Computer Software by the contracting states to such International Treaty.

The model provisions do not make the protection of computer software dependent on its deposit or registration with a national authority. They state that countries interested in the Model Provisions might like to consider the desirability of including in their laws a Mandatory Provision for Deposit or Registration of Computer Software.

The basic argument in favor of a Mandatory System of Deposit is that in return for the special protection accorded, the proprietor of the rights in Computer Software should be obliged to deposit it. Such a requirement would ensure the eventual disclosure of the software to the public with the consequent advancement of the arts. It would also enable third parties to direct their efforts to creating computer software in new fields. Moreover, the deposit would promote the dissemination of computer software, facilitate its sale or licensing and increase certainty concerning the object of protection in each case that would otherwise be difficult to define. These arguments apply, to some extent, also the the less-strict requirement for the Registration of Computer Software under which the proprietor would simply have to provide particulars of the computer software together with an abstract, which would be disclosed to the public.

A further argumenty in favor of a Mandatory System of Deposit or Registration is that the proprietor should give to the public notice that a certain item of software is protected as well as an indication of when the term of protection expires.

A problem of a Mandatory System is the administrative headaches of a system for classification and indexing and of maintenance. Another disadvantage is the fact that Mandatory Disclosure might place an unnecessary expenditure burden on software creators and it might cause them to reveal trade secrets.

A secondary concept of WIPO was the Optional Deposit System. The proprietor deposits the computer program and accompanying documentation with a National Authority. So, a limited amount of information is available to the public. An Optional Deposit System enables the public to have direct access to nonsecret software, provides the depositor with evidence of the prior existence of the software, and through publication enables the public to know what type of software is available. It is inevitable that concerns have been expressed about an optional system. If it were optional what would be the advantage of using it. Even if it were used what would be the legitimacy of it, and even if registration on a voluntary basis were obtained what would it achieve against someone who fractionally changed the details of a Registered Program and then registered that also. Moreover, there is the fact that after several years the program might be unsuitable or corrupted, and there is the sheer volume of programs to be coped with.

While registration at Stationers Hall is possible it is not commonly known or indeed widely used. It may remain relatively unused because of lack of credibility that such registration may give to the copyright holder. There are other bodies within the United Kingdom that might be better placed to operate a Registration system. Examples are the Patent Office or the National Computer Centre. However, there would have to be a demand from industry for such a Register to be set up.

It is interesting that within other Member States of the European Union Public Registers for Software Programs have been set up by legislation within the last few years. Portugal, Spain, and Italy have the availability of registration for software programs, which may be of use in infringement proceedings.[5] Furthermore, there are similar registers within several of the South American jurisdictions as well as voluntary registers operating in several other EU Member States. Within NAFTA, Mexico operates a registration system and Canada has a voluntary system at the Canadian Patent Office.

Even though the United States now adheres to the Berne Convention in respect of foreign works, registration of copyright may not now be required. However, although Berne Convention works whose origin is not the United States are exempt from the requirement to register before an infringement suit can be brought, a person seeking the exemption bears the burden of proving to the court that the work is not subject to the registration requirement. A copyright owner who registers before or within five years of first publication receives the benefit of a legal presumption in court. It is called the "prima facie evidentiary weight" by which the court will presume the facts stated in the Copyright Certificate of Registration are true and the Copyright is valid. Another benefit of timely registration is that the copyright owner of works registered for copyright protection within three months of publication or before infringement is eligible for an award of attorney's fees and statutory damages.[6] Further, Federal Registration and payment of further fees allows the burden of antipiracy policing to be passed on to the U.S. Customs Office in the case of importation of pirated software programs.

Apart from moral rights that were introduced into the United Kingdom law by the Copyright Designs and Patents Act of 1988, most other traditional intellectual property rights have the benefit of a registration system (patents, trademarks and designs). Therefore, why should there not be a Public Register for Software Programs in the United Kingdom, albeit operated on a non-statutory basis, as a means of listing of works for public inspection. It would also be useful for further proof of ownership and publication date in the case of infringement proceedings, particularly in the light of the comments made above regarding Section 107(6) of the 1988 Act.

A recent survey of software companies in the telecommunications business and educational and entertainment sectors indicated a considerable interest in a registration system, highlighted a lack of knowledge of the existence of public registers in other countries, and revealed a remarkable lack of "best practice" in the area of in-house copyright protection.

As PC software is more widely used, not only for business use but also for home use and home entertainment, as multimedia spreads into business, home and educational sectors, and as the advance of digital technology allows almost instant access to a global network of copyright products infringement is going to remain at the forefront of the activities of the antipiracy bodies.

Civil actions are all well and good, and in many cases they are the correct proceedings. However, the intention of the BSA, FAST and ELSPA is to make an example of infringers and pirates of software. Criminal proceedings are felt to be the most likely way to provide the publicity to educate the vastly growing user base as to the need for good software practice. If registration of software programs provides more certainty and more availability for public inspections, infringement actions can also be assisted, and furthermore, the criteria for the issue of a Certificate of Registration or deposit may be dependent upon or bring about an improvement in "best practice" such as software companies keeping definitive lists of authors, details of program creation, and improved copyright care.[7]

REFERENCES

1. Copinger & Skone James on Copyright. 13th Edition. Chapter 1.
2. Publishing & Multi-Media Law by Michael Henry.
3. Information courtesy of the Federation Against Software Theft 1995.
4. Introduction to WIPO Model Provisions on the Protection of Computer Software.
5. Portuguese Decree Law Number 252/94, 20 October 1994. Article 12; Title vii of the Spanish Intellectual Property Law, 11 November, 1987 Article 100; and Italian Regulation concerning the Special Public Register for Software Programs adopted by Decree Number 244 of the President of the Council of Ministries on 3 January 1994.
6. U.S. Copyright Office, Library of Congress, Washington DC 20559, Circular 93 Highlights of U.S. Adherence to the Berne Convention.
7. Private survey of cross-section of Software Companies carried out by the Writer 1995.