

Bills Committee on the Copyright (Amendment) Bill 2011

Comparison of Copyright Laws in Hong Kong and Overseas Jurisdictions

At the meeting on 5 July, Members of the Bills Committee requested the Administration to provide a comparison of the key legislative proposals under the Copyright (Amendment) Bill 2011 (“the Bill”) with the copyright laws in overseas jurisdictions.

2. The requested information is attached at Annex, which briefly summarizes the key comparable provisions for general reference. The comparable provisions cited in the table may have different legal effects and applications having regard to the exact formulation of individual provisions, the overall copyright legislation and the legal system of each jurisdiction which vary from one another.

Background

3. The Administration introduced the Bill into the Legislative Council on 15 June 2011. Major proposals under the Bill include –

- (a) introducing a technology-neutral exclusive right for copyright owners to communicate their works through any mode of electronic transmission, with ancillary criminal liability against unauthorised communication of copyright works;
- (b) establishing a statutory “safe harbour” for online service providers (OSPs) so that their liability for copyright infringement occurring on their service platforms could be limited, provided that they meet certain prescribed conditions, including the taking of reasonable steps to limit or stop copyright infringement when being notified. The safe harbour is underpinned by a non-statutory Code of Practice which sets out practical guidelines and procedures for OSPs to follow when notified of infringing activities on their service platform;
- (c) introducing a copyright exception for temporary reproduction of copyright works (technically known as “caching”) by OSPs, which is technically required for the digital transmission process to function efficiently;
- (d) introducing a copyright exception for media shifting of sound recordings for private and domestic use under prescribed conditions; and
- (e) prescribing additional factors to assist the Court in considering the award of additional damages in civil proceedings pertaining to online infringement.

4. These proposals are formulated taking into account the views expressed by stakeholders in previous rounds of public consultation and the relevant developments in overseas jurisdictions.

Commerce and Economic Development Bureau
Intellectual Property Department
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Comparison of the Key Legislative Proposals under the Copyright (Amendment) Bill 2011 (“Bill”) with the Copyright Laws in Overseas Jurisdictions

Part 1: Exclusive Communication Right for Copyright Owners

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Definition	<p>Communication of a work to the public means the electronic communication of the work to the public, including —</p> <p>(a) the broadcasting of the work;</p> <p>(b) the inclusion of the work in a cable programme service; and</p> <p>(c) the making available of the work to the public.</p> <p>Proposed Ref: new ss.22(1)(fa) & 28A under Clauses 9(3) & 13 of the Bill</p>	<p>Communication to the public means communication to the public by electronic transmission, and in relation to a work includes —</p> <p>(a) the broadcasting of the work;</p> <p>(b) the making available to the public of the work by electronic transmission in such a way that members of the public may access it from a place and at a time individually chosen by them.</p> <p>Introduced in 2003 Ref: ss.16(1)(d) & 20, Copyright, Designs and Patents Act 1988 (“UK Act”)</p>	<p>“Communicate” means to transmit by electronic means a work or other subject matter, whether or not it is sent in response to a request, and includes —</p> <p>(a) the broadcasting of a work or other subject-matter;</p> <p>(b) the inclusion of a work or other subject-matter in a cable programme; and</p> <p>(c) the making available of a work or other subject-matter (on a network or otherwise) in such a way that the work or subject-matter may be accessed by any person from a place and at a time chosen by him.</p> <p>Introduced in 2005 Ref: ss.7(1), 26(1)(a)(iv)&(b)(iii), 83(c), 84(1)(d) & 85(1)(d), Copyright Act (“Singaporean Act”)</p>	<p>“Communicate” means to make available online or electronically transmit a work or other subject matter, including a performance or live performance.</p> <p>Introduced in 2001 Ref: ss.10(1), 22(6)&(6A), 31(1)(a)(iv)&(b)(iii), 85(1)(c), 86(c) & 87(c), Copyright Act 1968 (“Australian Act”)</p>	<p>“Communicate” means to transmit or make available by means of a communication technology, including by means of a telecommunications system or electronic retrieval system.</p> <p>Introduced in 2008 Ref: ss.2(1) & 33, Copyright Act 1994 (“New Zealand Act”)</p>	<p>No specific right But US courts have construed that certain acts commonly included under the right of communication could be covered by the exclusive right of reproduction, public distribution and public performance.</p>

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Criminal sanctions	<p>Against unauthorised communication to the public conducted</p> <p>(a) for the purpose of or in the course of any trade or business that consists of communicating works to the public for profit or reward; or</p> <p>(b) to such an extent as to affect prejudicially the copyright owner.¹</p> <p>Proposed Ref: new s.118(8B) under Clause 51(7) of the Bill</p>	<p>Against unauthorised communication to the public conducted</p> <p>(a) in the course of business; or</p> <p>(b) (other than in the course of business) to such an extent as to affect prejudicially the copyright owner,</p> <p>if the defendant knows or has reason to believe that he is infringing copyright in the work.</p> <p>Introduced in 2003 Ref: s.107(2A), UK Act</p>	<p>No specific offence</p> <p>But subject to a general offence of willful copyright infringement where:</p> <p>(a) the extent is significant²; or</p> <p>(b) the act is done to obtain a commercial advantage.</p> <p>Ref: s.136(3A), Singaporean Act</p>	<p>Against unauthorised communication of works or other subject matters to the public</p> <p>(a) conducted with the intention of trading or obtaining a commercial advantage or profit; or</p> <p>(b) where the extent of communication affects prejudicially the copyright owner.</p> <p>Introduced in 2001 Ref: s.132AA & 132AI, Australian Act³</p>	<p>No specific offence (except if a person causes a recording known to be illicit⁴ to be communicated to the public)</p> <p>Ref: s.198(2)(b), New Zealand Act</p>	<p>No specific offence</p> <p>But subject to a general offence of willful copyright infringement committed:-</p> <p>(a) for purposes of commercial advantage or private financial gain;</p> <p>(b) by the reproduction or distribution, including by electronic means over a prescribed limit; or</p> <p>(c) by the distribution of a work being prepared for commercial distribution, by making it available on a computer network accessible to members of the public, if such person knew or should have known that the work was intended for commercial distribution.</p> <p>Ref: s.506(a)(1), U.S. Copyright Law</p>

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Factors for determining “prejudice”	<p>Proposed</p> <p>(a) the purpose of the act in question;</p> <p>(b) the nature of the copyright work, including its commercial value;</p> <p>(c) the amount and substantiality of the portion distributed/communicated in relation to the work as a whole;</p> <p>(d) the mode of distribution/communication; and</p> <p>(e) the economic prejudice caused to the copyright owner as a consequence of this act including its effect on the potential market for or value of the work.</p> <p>Ref: new s.118(2AA) and s.118(8C) under Clause 51 of the Bill</p>	No	No	No	No	No

¹ The proposed criminal sanctions mirror the existing offences under s. 118(1). Similarly, it is a statutory defence if a defendant did not know and had no reason to believe that he was infringing the copyright in the work by communicating the work.

² S.136(6A) of the Singaporean Act provides that “in determining whether the extent of the infringement is **significant**, the court shall have regard to (a) the volume of any articles that are infringing copies; (b) the value of any articles that are infringing copies; (c) whether the infringement has a substantial prejudicial impact on the owner of the copyright; and (d) all other relevant matters”.

³ According to section 132AA of the Australian Act, distribution in the context of the prejudicial distribution offence under section 132AI covers distribution by way of communication.

⁴ An “illicit recording” is a recording of a performance made without the performer’s consent and otherwise than for private or domestic use.

Part 2: “Safe Harbour” for Online Service Providers (“OSPs”)

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Eligible OSPs	Providers of any online service	Providers of transmission, caching and storage services	Providers of transmission, caching, storage and information location tools services	Providers of transmission, caching, storage and information location tools services	Providers of transmission, caching and storage services	Providers of transmission, caching, storage and information location tools services
Scope of limitation of liability	<p>Damages or any other pecuniary remedy</p> <p>Proposed Ref: new s.88B under Clause 45 of the Bill</p>	<p>Damages, other pecuniary remedy or any criminal sanction</p> <p>Nevertheless, injunctive measures could be granted if OSPs have actual knowledge of another person using their service to infringe copyright (Ref: s.97A, UK Act)</p> <p>Introduced in 2002 Ref: Regulations 17, 18 & 19, The Electronic Commerce (EC Directive) Regulations 2002)</p>	<p>Monetary reliefs</p> <p>Nevertheless, specified forms of injunctive or equitable relief may be granted⁵</p> <p>Introduced in 2005 Ref: s.193B(1), 193C(1) & 193D(1), Singaporean Act</p>	<p>Monetary reliefs</p> <p>Nevertheless, specified forms of injunctive or equitable relief may be granted (see also footnote 5)</p> <p>Introduced in 2005 Ref: s.116AG, Australian Act</p>	<p>Any relief (except injunctive relief)</p> <p>Introduced in 2008 Ref: s. 92B, 92C & 92E, New Zealand Act</p>	<p>Monetary reliefs</p> <p>Nevertheless, specified forms of injunctive or equitable relief may be granted (see also footnote 5)</p> <p>Introduced in 1998 Ref: s.512(a), (b)(1), (c)(1) & (d), US Copyright Law</p>

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Major conditions that OSPs must fulfill in order to qualify for the Safe Harbour: (a) tackling infringement after acquiring knowledge of infringement	(applicable to all OSPs) Take reasonable steps to limit or stop the infringement as soon as practicable	(applicable to OSPs which provide storage services) Act expeditiously to remove or disable access to the allegedly infringing material	(applicable to OSPs which provide caching, storage or information location tools services) Act expeditiously to remove or disable access to the allegedly infringing material	(applicable to OSPs which provide storage or information location tools services) Act expeditiously to remove or disable access to the allegedly infringing material	(applicable to OSPs which provide storage services) Delete the allegedly infringing material or prevent access to it as soon as possible	(applicable to OSPs which provide storage or information location tools services) Act expeditiously to remove or disable access to the allegedly infringing material
(b) not receiving financial benefit directly attributable to the infringement	Applicable to all OSPs	No	Applicable to OSPs which provide storage or information location tools services ⁶	Applicable to OSPs which provide storage or information location tools services (see also Note 6)	No	Applicable to OSPs which provide storage or information location tools services (see also Note 6)
Supplemental rules/codes for OSPs' compliance on limitation of their liability	Non-statutory Code of Practice to be published by the Secretary for Commerce and Economic Development Ref: s.88(I) under Clause 45 of the Bill	No	Subsidiary legislation: Copyright (Network Service Provider) Regulations 2005	Subsidiary legislation: Part 3A in Copyright Regulations 1969	Subsidiary legislation: s. 5B of Copyright (General Matters) Regulations 1995	No

⁵ For example, an order requiring an OSP to take reasonable steps to disable access to an online location outside the country, or an order requiring an OSP to terminate a specified account.

⁶ Provided that the OSPs have the right and ability to control the infringing activity.

Part 3: Exception/Limitation for Temporary Reproduction/Caching Activities by OSPs

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Comparison of conditions for the exception	<p>(a) the sole purpose of the making and storage of the copy is to enable more efficient transmission of the work through a network;</p> <p>(b) the making and storage of the copy forms an automatic and essential part of a technological process, which neither modifies the work, nor interferes with the lawful use of technology to obtain data on the use of the work;</p> <p>(c) the storage is temporary;</p> <p>(d) the service provider updates the database in which the copy is stored in accordance with reasonable industry practice;</p> <p>(e) the service provider complies with conditions (if any) on access to the work; and</p> <p>(f) the service provider promptly removes the copy or disable access to the copy when either of the following facts comes to the service provider’s actual knowledge:</p> <p>(i) the work has been removed from the original source from which the copy was made; or</p> <p>(ii) access to the work at the original source from which the copy was made has been disabled.</p> <p>Proposed Ref: s.65A under Clause 41 of the Bill</p>	<p>Contain conditions similar to proposed conditions (a) to (f) in Clause 41 of the Bill.</p> <p>Condition (f) in UK context has included one more factor; please refer to Regulation 18(b)(v) of The Electronic Commerce (EC Directive) Regulations 2002.</p> <p>Introduced in 2002 Ref: Regulation 18, The Electronic Commerce (EC Directive) Regulations 2002</p>	<p>Contain conditions similar to proposed conditions (a), (b), (d) to (f) in Clause 41 of the Bill.</p> <p>Conditions (b), (d) and (f) in the Singaporean context contain further provisions in its corresponding legislation; please refer to s.193C(2)(a) and (b) of the Singaporean Act, and regulation 4(b) of Copyright (Network Service Provider) Regulations 2005 (“Singaporean Regulation”) respectively.</p> <p>Introduced in 2005 Ref: s.193C of Singaporean Act & Regulation 4 of the Singaporean Regulation</p>	<p>Contain conditions similar to proposed conditions (a), (b), (d) to (f) in Clause 41 of the Bill.</p> <p>Conditions (b) and (f) in the Australian context contain further provisions in its corresponding legislation; please refer to s.116AH(1) Item 3 conditions (4) and (3) of Australian Act respectively.</p> <p>Please refer to s.116AH(1) Item 1 of Australian Act for other applicable conditions.</p> <p>Introduced in 2005 Ref: s.116AH(1) of Australian Act</p>	<p>Contain conditions similar to proposed conditions (a) to (f) in Clause 41 of the Bill.</p> <p>Condition (f) in New Zealand context has included one more factor; please refer to s.92E(2)(c) of New Zealand Act.</p> <p>Introduced in 2008 Ref: s.92E of New Zealand Act</p>	<p>Contain conditions similar to proposed conditions (a) to (f) in Clause 41 of the Bill.</p> <p>Conditions (b), (d) and (f) in the US context contain further provisions in its corresponding legislation; please refer to s.512(b)(2)(C), (B) and (E) of US Copyright Act respectively.</p> <p>Introduced in 1998 Ref: s.512(b) of US Copyright Act</p>

Part 4: Media Shifting Exception

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Type of copyright work	Non-infringing copy of a sound recording only	No specific exception	No specific exception	Non-infringing copy of- (a) book, newspaper or periodical publication (b) photograph (c) a videotape embodying a cinematograph film in analog form (d) sound recording	Non-infringing copy of a sound recording only The sound recording is not a communication work or part thereof	No copyright infringement action may be brought based on the non-commercial use by a consumer of a <i>digital audio recording device</i> , a <i>digital audio recording medium</i> , an analog recording device or an analog recording medium for making <i>digital musical recordings</i> or analog musical recordings. ⁷
No. of copy allowed	One	N/A	N/A	For (a): one For (b): one (from hard copy to electronic form or vice versa) For (c): one in electronic form For (d): no specific restriction of copies stored in one's devices	One	N/A
Permitted usage	Private and domestic use ⁸	N/A	N/A	Private and domestic use	Personal use	N/A
Ownership	Owner must retain both the original and private copies made.	N/A	N/A	No specific provision on ownership But disposal of the original of (a), (b), (c) and (d) may render the copy made therefrom an infringing copy. ⁹	Owner must retain both the original copy and any copy made therefrom.	N/A

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Provisions	Proposed Ref: new s.76A under Clause 44 of the Bill	N/A	It seems that in appropriate circumstances, media shifting activities may fall within a general “fair dealing” provision in the Singaporean Act. ¹⁰	Introduced in 2006 Ref: ss.43C, 47J, 110AA & 109A of the Australian Act	Introduced in 2008 Ref: s.81A of the New Zealand Act	It seems possible that certain kinds of media shifting activities may fall within the “fair use” copyright exception in the US Copyright Law (see s.107 of the US Copyright Law).
Technological protection measure	Subject to existing provisions against anti-circumvention	N/A	N/A	No circumvention of technological protection measure is allowed	N/A	N/A

⁷ S.1008, Chapter 10 entitled “Digital Audio Recording Devices and Media” as added by the Audio Home Recording Act 1992 to the US Copyright Law (Title 17 of the United States Code). This section also provides that no copyright infringement action may be brought based on the manufacture, importation, or distribution of the digital audio recording device or medium. In addition, royalties are imposed on the manufacture, distribution or importation of digital audio recording devices and digital audio recording media. All digital audio recording devices imported, manufactured or distributed should also include prescribed copying control systems.

⁸ Use of the private copy beyond the scope of the exception or in breach of any condition of the exception would render a private copy as an infringing copy.

⁹ Dealing with (selling, letting for hire, by way of trade offered or exposed for sale or hire, or distributed for the purpose of trade or otherwise) the copy made from the original of (a), (b) and (c) would render it an infringing copy. For (d), a copy will become an infringing copy if either the original or the copy is dealt with as aforementioned. In addition, if the original or the copy is used for causing the sound recording to be heard in public or is used for broadcasting the sound recording, this would also render the copy an infringing copy.

¹⁰ S.109 of the Singaporean Act which has come into force since January 2005.

Part 5: Additional Damages for Copyright Infringement

	Hong Kong	UK	Singapore	Australia	New Zealand	US
Specific factors	<p>Existing factors (s.108(2)):</p> <p>(a) the flagrancy of the infringement;</p> <p>(b) any benefit accruing to the defendant by reason of the infringement; and</p> <p>(c) the completeness, accuracy and reliability of the defendant's business accounts and records.</p> <p>Proposed additional factors</p> <p>(d) the conduct of the defendant after the act constituting the infringement occurred, including but not limited to the conduct of the defendant after having been informed of the infringement; and</p> <p>(e) the likelihood of widespread circulation of infringing copies as a result of the infringement.</p> <p>Proposed Ref: s.108(2)(d)&(e) under Clause 49(3) of the Bill</p>	<p>(a) the flagrancy of the infringement; and</p> <p>(b) any benefit accruing to the defendant by reason of the infringement.</p> <p>Introduced in 1988 Ref: s.97 of the UK Act</p>	<p>(a) the flagrancy of the infringement;</p> <p>(b) any benefit shown to have accrued to the defendant by reason of the infringement; and</p> <p>(c) all other relevant matters.</p> <p>Amended in January 2005 Ref: s.119(4) of the Singaporean Act</p>	<p>(a) the flagrancy of the infringement;</p> <p>(b) any benefit shown to have accrued to the defendant by reason of the infringement;</p> <p>(c) whether the infringement involved the conversion of a work or other subject-matter from hardcopy or analog form into a digital or other electronic machine-readable form;</p> <p>(d) the conduct of the defendant after the act constituting the infringement or, if relevant, after the defendant was informed that the defendant had allegedly infringed the plaintiff's copyright;</p> <p>(e) the need to deter similar infringements of copyright; and</p> <p>(f) all other relevant matters.</p> <p>Amended in April 2003 Ref: s.115(4) of the Australian Act</p>	<p>(a) the flagrancy of the infringement; and</p> <p>(b) any benefit accruing to the defendant by reason of the infringement.</p> <p>Introduced in 1994 Ref: s.121(2) of the New Zealand Act</p>	<p>No equivalent provision</p>