

Bills Committee on the Copyright (Amendment) Bill 2014

Derogatory Treatment

Purpose

At the meeting of 7 May 2015, Members requested the Administration to provide a paper on “derogatory treatment” under section 92 of the Copyright Ordinance (Cap. 528) for reference. This paper provides the information as requested.

Introduction

2. Broadly speaking, there are two categories of rights in relation to copyright works, namely (a) alienable *economic rights* which allow copyright owners to derive financial reward or benefit from the exploitation of their works; and (b) inalienable *moral rights* which allow the authors of literary, dramatic, musical and artistic works, and the directors of films to preserve their relationship with the creation of their works. Under the existing copyright regime of Hong Kong, the “right to object to derogatory treatment” is one of the established moral rights enjoyed by authors and directors.

International obligation

3. Article 6bis(1) of the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) provides that –

“Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation.”

4. The Berne Convention recognises the moral rights of the author to (a) be identified as the author or director of his work (the paternity right); and (b) object to any derogatory treatment of his work (the integrity right). The Berne Convention is applicable to Hong Kong. We have fulfilled the international treaty obligation to protect these two kinds

of moral rights through incorporating appropriate provisions into the Copyright Ordinance since its enactment in 1997. Similar provisions are found in the copyright laws of other common law jurisdictions such as Australia, Canada, New Zealand and the United Kingdom (UK).

Moral rights under the Copyright Ordinance

5. Division IV of Part II of the Copyright Ordinance affords protection to three kinds of moral rights¹, namely –

- (a) the right to be identified as author or director;²
- (b) the right to object to derogatory treatment of a work;³ and
- (c) the right not to have a work falsely attributed to him as author or director.⁴

6. While the economic rights relating to copyright works are assignable, the moral rights are not.⁵ In this regard, the right to be identified as the author or director, and the right to object to derogatory treatment of a work remain to be held by the author or director regardless of any transfer of the economic rights, whereas the right to object to false attribution may be exercised by someone other than the author or director.

7. An author or director may commence proceedings against an infringer of his moral rights to seek appropriate remedies, such as injunction and damages. Such action is civil in nature. In other words, an infringement of the moral rights (including the integrity right against derogatory treatment) does not attract criminal liability.

Meaning of “derogatory treatment”

8. Section 92 of the Copyright Ordinance, which is modelled on section 80 of the UK Copyright, Designs and Patents Act 1988, defines the concept of “derogatory treatment” and specifies certain acts (e.g.

¹ Although these three kinds of rights are all termed moral rights, only the paternity and integrity rights as respectively stated in paragraphs 4, 5(a) and (b) are “authors’ rights” as contemplated by the Berne Convention.

² Section 89(1), Copyright Ordinance.

³ Section 92(1), Copyright Ordinance.

⁴ Section 96(1), Copyright Ordinance.

⁵ Section 105, Copyright Ordinance.

commercial publication and performance in public of a derogatory treatment of a work) which would amount to infringement of the integrity right.

9. According to section 92, “treatment” of a work means “any addition to, deletion from or alteration to or adaptation of the work”, but excludes a translation of a literary or dramatic work; or an arrangement or transcription of a musical work involving no more than a change of key or register.⁶ In addition, the treatment of a work is derogatory if it amounts to being prejudicial to the honour or reputation of the author or director through (a) distortion; (b) mutilation; or (c) other modifications of this work.⁷ Details are as follows –

- (a) a distortion of a work involves some form of twisting or perversion of it;
- (b) mutilation of a work involves some form of cutting or destruction so as to render it imperfect; and
- (c) other modifications of a work may cover any addition to, deletion from or alteration to or adaptation of the work which, although not a distortion or mutilation, is nevertheless prejudicial to the honour or reputation of the author or director.

10. To the best of our knowledge, there is no local judicial decision about infringement of integrity right yet. There have been a number of decided cases in the UK⁸ which held that–

- (a) the mere fact that the author or director is himself aggrieved by what has occurred is insufficient to support a claim for derogatory treatment;
- (b) not any treatment of a work is actionable as an infringement of the integrity right; and

⁶ Section 92(2)(a), Copyright Ordinance.

⁷ Section 92(2)(b), Copyright Ordinance, and paragraphs 11-43 and 11-44 of *Copinger and Skone James on Copyright* (Vol. One, 16th Edition).

⁸ *Confetti Records Ltd v Warner Music UK Ltd* [2003] EWHC 1274 (Ch), *Pasterfield v Denham and Another* [1999] F.S.R. 168 and *Tidy v Trustees of the Natural History Museum* [1995] 39 I.P.R. 50.

- (c) only when the treatment in question (be it distortion, mutilation or otherwise) is prejudicial to the honour or reputation of the author or director, does it amount to derogatory treatment.⁹

11. In reviewing the UK case law, a legal scholar opines that there can be no breach of the integrity right “without evidence of prejudice to honour or reputation”. It has also been held that the existence of such prejudice must be objectively demonstrated. In providing objective evidence of prejudice, the following factors have been considered to be of relevance –

- (a) public association of the author with the treatment complained of;
- (b) the existing reputation of the author;
- (c) the author’s own intended exploitation of the work; and

⁹ In *Pasterfield v Denham and Another* [1999] F.S.R. 168, the claimants argued that their drawings had been subject to derogatory treatment because certain details had been omitted or altered and colours had been changed by the defendants. The court held that in order to succeed in a claim for derogatory treatment of a work, a claimant had to prove that “the treatment accorded to his work is either a distortion or mutilation that prejudices his honour or reputation as an artist. It is not sufficient that the author is himself aggrieved by what has occurred.” Upon reviewing the facts of the case, the judge also opined that while there were trivial differences between the original and altered works, “it would be wrong to elevate such differences to derogatory treatment”. The judge therefore held that the claimants’ evidence failed to establish that there was an objective prejudice to honour or reputation. This decision was cited with approval in a higher court in *Confetti Records Ltd v Warner Music UK Ltd* [2003] EWHC 1274 (Ch). In a more recent case, the Patents County Court seems to have taken a somewhat different approach. In *Delves-Broughton v House of Harlot Ltd* [2012] EWPC 29, [2012] Info. T.L.R. 343, the defendant displayed on its website a photograph taken by the plaintiff of a model in a forest wearing a garment supplied by the defendant. Changes made by the defendant to the photograph included the removal of the forest background, reversal of the image and cropping it to a smaller image. The learned recorder held that since “considerable time and effort went into the composition or creation of the original photograph, and it was important to the photographer that the forest background appeared in the particular photograph for artistic reasons”, the changes made amounted to a distortion and concluded that there was derogatory treatment of the work, despite no mutilation of the original photograph or prejudice to the honour or reputation of the plaintiff was found. This case has been criticised as a departure from the precedents that a copyright work is subject to derogatory treatment only when the claimant is able to demonstrate that the distortion or mutilation of the work has caused prejudice to the honour or reputation of the author or director – an approach which follows Article 6bis of the Berne Convention. Given that the court did not refer to any precedent in this case and the parties were not legally represented, the issue of whether the treatment of the work amounted to a prejudice to the author’s honour and reputation was not examined. It is questionable whether this case is a good precedent to follow.

(d) the public's ability to recognise the allegedly derogatory nature of the treatment of a work.”¹⁰

12. The following Australian case illustrates a successful claim on the right of integrity. In *Perez and others v Fernandez* [2012] FMCA 2, the applicant was an internationally renowned performing artist whilst the respondent was a DJ and concert promoter in Australia. The respondent deleted a part from the applicant's song, *Bon, Bon*, ripped from a CD and edited the song with a recording containing words spoken by the applicant, which was originally provided to the respondent for the promotion of the applicant's concerts in Australia. The altered version was uploaded to the respondent's website and played in nightclubs where he worked as a DJ. Such alteration was alleged by the applicant to amount to derogatory treatment of the song which infringed his moral right of integrity under Australia's Copyright Act 1968 (Copyright Act).¹¹

13. The court found that the respondent's combination of the words spoken with the *Bon, Bon* song made it sound to the listener that the applicant was positively referring to the respondent at the beginning of the song and such reference formed part of the original work. It also found that the changes made to the song must be regarded as a “distortion” or “alteration” (if not a “mutilation”) of the work, which was material and thereby satisfying the first element in the definition of “derogatory treatment” in the Copyright Act.

14. The court further found that the respondent's treatment of the song was “prejudicial to the author's honour or reputation” in the following two ways:

(a) The court considered that there will be a class of listeners who upon listening to *Bon, Bon* for the first time through the respondent's website presumed that the altered song was the original song which was indeed written and performed by the applicant with reference to the respondent. The court accepted evidence from the applicant that artists in the hip-

¹⁰ John Griffiths, “Not Such a ‘Timid Thing’: The United Kingdom's Integrity Right and Freedom of Expression” in *Copyright and Free Speech* (edited by J. Griffiths and U. Suthersanen), Oxford University Press (2005), p. 220.

¹¹ Section 195AI provides that the author of a work has a right of integrity of authorship in respect of the work, which is “the right not to have the work subjected to derogatory treatment”. Section 195AJ provides that “derogatory treatment” in relation to a musical work means the doing of anything that results in a material distortion of, the mutilation of, or a material alteration to, or doing anything else to the work that is prejudicial to the author's honour or reputation.

hop/ rap genre go to great lengths to choose which DJ(s) they associate with and these associations form a central part of their reputation. It then held that in the circumstances, the fact that the reference to the respondent in the altered song had not been authorised by the applicant should be regarded as prejudicial to the applicant per se.

- (b) The court also considered that there will be an alternate class of listeners who were more intimately aware of both the applicant's music and the respondent as well as the legal proceedings between the two in relation to the failed concerts. The court opined that these listeners would know the significance of the applicant's associations as an artist and would understand the alterations to the song made by the respondent to be mocking the applicant's reputation.

15. Accordingly, the court concluded that both elements, i.e., distortion to the work and treatment which was prejudicial to the author's honour and reputation, constituted derogatory treatment. The approach adopted by the court in this case was in line with the principles well-established in the UK cases as summarised in paragraph 10 above.

Moral rights under the Copyright (Amendment) Bill 2014 (the Bill)

16. The Bill does not change the existing legal framework for the protection of moral rights. It remains the case that an infringement of the moral rights (including the right to object to derogatory treatment) does not attract criminal liability.

17. Members are invited to note the information provided in this paper.

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