

### III – Possible solutions to the problem

#### *A. The extent of the problem*

The previous analysis clearly shows that the extent of the problem is smaller than what might initially seem. Not all cases of different ownerships in overlaps generate an unjustified blocking effect or remain unregulated.

As seen, if the specific overlap regards cumulation with copyright, if there is an independent creation, there is no infringement. In cases of registered IPRs priority in time is the criterion: if there is a right prior in time the registration is invalid. As copyright arises out of creation or fixation and trade mark or designs out of registration, copyright will trump registration. The requirements of novelty and individual character in design law lead to a similar result.<sup>302</sup>

The blocking effect arising out of split ownerships depends on the extent a certain activity constitutes infringement. One will have to determine if the exploitation of the object falls within the scope of the IPR. This operation involves not only the infringement analysis but also an assessment of the interactions with freedom of expression and artistic creation, which might constitute important exceptions to infringement.<sup>303</sup>

Another clear principle is: one cannot legitimately register an achievement of someone else.<sup>304</sup> In those cases, usually the real owner will be able to claim the respective IPRs as its own in national courts or revoke it.

These rules are logically conceived but need to be tempered with other considerations, otherwise they will fail to solve the blocking effect arising out of split ownerships, leading not only to unfair results but to granting rights without any real utility, frustrating the very justification for such concessions.

Implied licences and good faith/estoppel are two recurring approaches to our problems in the previously analysed cases. Those, among other possible solutions, will be considered below.

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302 See n 163 .

303 A Ohly, ‘Areas of Overlap’ (n 184 ).

304 Nonetheless, registers do not require prove of authorisation or licensing (n 292 ).

B. A general solution?

As seen, in the EU overlap is the norm. One notable example of limiting copyright's action in light of other interests<sup>305</sup> is found in the CJEU decision *Dior v Evora*.<sup>306</sup> The Court held in a laconic statement<sup>307</sup> that a trade mark holder who also owned copyright in the bottles and packaging of his goods (Dior) could not enforce its copyright against a retailer where trade mark exhaustion had already operated. The reasoning, albeit inspiring,<sup>308</sup> has no direct utility to our problem, since exhaustion can only operate in regard to the same "origin" ("the proprietor or with his consent")<sup>309</sup> and our scenario is characterised by different ownership. Thus, unless some other solution operates, the actions by a certain IP right owner will violate the right of the other.

1. Avoiding the problem

a) Avoiding overlaps?

One obvious solution to the problems created would be to avoid overlaps. Even though there are "channelling" provisions,<sup>310</sup> rules that reduce the extent of the overlap such as a demanding copyright standard of originali-

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305 A Quaedvlieg 'Concurrence' (n 9 ) 28-29, presents the case as an example of negative convergence, a limitation of both right due to the "overriding interest of the free movement of goods within the internal market and the purpose of the exhaustion rule".

306 C-337/95 *Parfums Christian Dior SA* [1997] ECR I-06013.

307 Ibid para 58 "...there being no need to consider the question whether copyright and trade mark rights may be relied on simultaneously in respect of the same product – it is sufficient to hold that (...) the protection conferred by copyright as regards the reproduction of protected works in a reseller's advertising may not, in any event, be broader than what is conferred on a trade mark owner in the same circumstances".

308 Proposing legislative changes to copyright in the aftermath of the case see A Kur, 'The "Presentation Right" – Time to Create a New Limitation in Copyright Law?' [2000] IIC 308.

309 Art. 13 CTMR.

310 Using that terminology and making an US-based analysis see V R Moffat, 'Mutant Copyrights and Backdoor Patents: the Problem of Overlapping Intellectual Property Protection' (2004) 19 Berkeley Technology Law Journal 1473.

ty<sup>311</sup> or the exclusions of subject matter, like the general idea of functionality in designs and trademarks.<sup>312</sup> But as Annette Kur points out overlaps in themselves are not a problem, it is their potential to frustrate the balances of each specific IP Right that poses new challenges and requires a horizontal approach.<sup>313</sup> It is nonetheless an important reflection to make, whether the amount and extent of overlaps found in the present legal framework is justified and should be maintained,<sup>314</sup> as in some cases the solution can lie in preventing the overlap.<sup>315</sup>

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- 311 As already stated it remains to be seen how much independence Member States retain in the aftermath of *Infopaq*.
- 312 For an overview regarding trade marks and copyrights see G Dinwoodie, 'Trademark and copyright' (n 5 ) 506-517 and A Quaedvlieg, 'Protection of Three-Dimensional Models as a Trademark' in J Ginsburg and J Besek (eds) (n 5 ) 576. On the topic of functionality see v.g. J Cornwell, 'Dyson and Samsung Compared: Functionality and Aesthetics in the Design Infringement Analysis' [2013] EIPR 273; J Du Mont and M Janis, 'Functionality in Design Protection Systems' (2012) 19 Journal of Intellectual Property Law 261.
- 313 'Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality' in J Drexler, R Hilty, L Boy and C Godt (eds) (n 16 ) 139, 149 ("...separating between the different regimes is not an aim in itself, in the sense that the system of intellectual property law must be kept in an 'orderly' state. Instead, [the exclusion] draws its justification from the balance that must be achieved between the protection of creations, innovations and the informational value of distinctive signs, on the one hand, and free competition on the other."). See also J-C Galloux (n ) 89 (overlaps are an unavoidable consequence of the diversity of IPRs); G Dinwoodie 'Trademark and copyright' (n 5 ) 521 "such grand plans for a unified system of intellectual property are (like a general rule governing cumulation) too grand, and perhaps too fundamental, a response to the problem".
- 314 A Quaedvlieg, 'Concurrence' (n 9 ) 26 ("Concurrent protection might in fact prove to be a sophisticated legal answer to the insatiable and multiform needs of an information and marketing economy"). In the same vein see also T Cook, 'How IPRs, like Nature, Abhor a Vacuum, and What Can Happen When They Fill it – Lacunae and Overlaps in Intellectual Property' (2012) 17 JIPR 296.
- 315 As mentioned above (n 249 ) the database maker right was to have a subsidiary nature, which would have avoided the problem of ownership altogether. G Dinwoodie 'Trademark and copyright' (n 5 ) 519 ("We should (...) be hesitant to impose an overarching "cumulation principle""); A Kur 'Exceptions' (n 14 ) 597 fn9 mentions critically the Danish solution according to which there could be no copyright in an object created with the intention to be used as a trademark.

b) Avoiding differences in ownership?

Another way of looking at the issue is from the ownership perspective. Developing parallel rules of ownership in the cases of overlaps would also solve the problem. There are different rules regarding copyright ownership throughout the EU and these remain deeply entrenched in national traditions. It seems unnecessary (and probably unfeasible) to undertake such a deep harmonization effort.<sup>316</sup> A less drastic solution like the one found in the computer program directive has the potential to achieve the same goals. Furthermore, even in countries, like the UK, with work-for-hire provisions, the problems are still occurring. The equitable ownership of copyright is a solution very specific to common law<sup>317</sup> and in clear contradiction both with the formal requirements – and, in monistic systems, the possibility – of assignment. An interesting solution found in the Wittem's group proposal for a European Copyright Code<sup>318</sup> consists in a work for hire provision (limited to economic rights)<sup>319</sup> combined with an implied licence approach to commissioned works.<sup>320</sup>

## 2. Prevalence

To solve some problems posed by overlaps some commentators submit the prevalence of the regime with the most significant relation with the case.<sup>321</sup> Finding which regime that is – in a private-international law like reasoning – requires systematic and teleological considerations, considering

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316 Lucas and Lucas (n 71 ) seem to suggest that harmonization might follow from the notion of originality adopted in *Infopaq*. Rejecting Kreutzer's proposal of introducing exceptions to the creator's principle see M Leistner, 'Book Review – Till Kreutzer, Das Modell des deutschen Urheberrechts und Regelungsalternativen' [2011] JIPITEC 165, 167.

317 A Rahmatian (n 84 ) 300. Additionally, "... an equitable owner of copyright work cannot enforce its rights against a third party who buys the legal copyright in good faith without notice of the equitable owner's rights." (T Golder and A Mayer (n 20 ) 168).

318 Available at < <http://www.copyrightcode.eu/> > accessed 31 August 2013.

319 Art. 2.5.

320 Art. 2.6.

321 A Quaedvlieg 'Overlap/Relationship' (n 63 ) 490. This was the solution found by the Supreme Court of Russia for infringement in a design and copyright cumulation scenario (for an analysis see Annex I).

the essential function of each IPR. Even if such approach is adopted, it does not solve all cases as two or more rights might be on equal proximity to the case. Antoon Quaedvlieg calls this “cases of perfect concurrence” and though he finds them rare he also admits “in those cases only hierarchy can solve the problem”.<sup>322</sup>

If this might be an efficient solution when dealing with questions of infringement and exceptions (the use of several rights by the same owner in a combined way to strengthen her position); in our case, allowing the prevalence of one right would mean the total irrelevance of the other. It would be meaningless to hold copyright if the design right belonging to someone else would prevail.<sup>323</sup> It is conceivable that this prevalence would only turn one right from property into liability,<sup>324</sup> the owner of the “losing” right would only be entitled to remuneration but would not be able to exclude the owner of the “winning” right. This is in line with the solution found in Italy for connected works.<sup>325</sup> Unless the hierarchy, or at least some criteria for the qualification are expressly stated (or developed by jurisprudence) the outcome is excessive legal uncertainty.<sup>326</sup>

### 3. Contractual or quasi-contractual solutions

#### a) Implied licence

In the context of a contract, it is possible to extract consequences even though they are not expressly mentioned. Under English law, these are called implied terms, which can be implied by law, in fact and on the basis of custom or trade usage.<sup>327</sup> For terms to be implied, as summarized by the Privy

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322 Ibid.

323 F Verkade (n 19 ) 71.

324 On the distinction see the classic article by G Calabresi and A Melamed, ‘Property rules, liability rules, and inalienability: one view of the cathedral’ [1982] HLR 1089.

325 See supra n 122 .

326 A Quaedvlieg ‘Overlap/Relationship’ (n 63 ) 492 (“Establishing the most significant relationship is a legal technique, not a bundle of ready-made answers”). F Verkade (n 19 ) 73 (“...this is what lawyers are brought up on, and it’s good for employment in the legal profession.”).

327 N Andrews, *Contract Law* (CUP 2011) 353 ff. Also S Whittaker and R Zimmerman, ‘Good faith in European contract law: surveying the legal landscape’ in S Whittaker and R Zimmerman (eds) (n 159 ) 46.

Council in *BP refinery (Westernport) Pty Ltd v Shire of Hastings*,<sup>328</sup> they must: “(a) be reasonable and equitable; (b) be necessary to give business efficacy to the contract, so that no term will be implied if the contract is effective without it; (c) be so obvious that ‘it goes without saying’; (d) be capable of clear expression; (e) not contradict any express term of the contract.”.<sup>329</sup>

This is somehow a functional equivalent to a general criterion of commercial good faith.<sup>330</sup> In the IP field the implied terms can be either an assignment or a licence. Due to the reluctance of most author’s rights systems to deprive authors from their copyright and the usual formal requirements for assignment, the notion that is more apt to be considered is the one of implied licence.

In certain situations even though no express authorization is granted, it results from the circumstances that specific acts, which would otherwise be infringement, were authorized. For instance, if a reader writes to a newspaper, it can be presumed that the publication is authorized.<sup>331</sup> Along the same lines, if an investor pays the employee to create a database or the company commissions a designer to produce a logo, it can be said that a licence results from the circumstances.<sup>332</sup> Under German Law, according to the “purpose of transfer” doctrine (*Zweckübertragungslehre*)<sup>333</sup> a licence might be implied if it results from the objectives of a certain contract. This rule has a big practical significance and often leads to results equivalent to the work for hire doctrine.<sup>334</sup>

The thesis of implied licences in the context of employment, limited to the needs of the employer is contentious. In France, despite having some

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328 180 CLR 266 (1977).

329 For the discussion on the officious bystander and business efficacy tests and the doctrine in general see R Austen-Baker, *Implied Terms in English Contract Law* (EE 2011).

330 N Andrews (n 327 ) 375. See also n 159 .

331 W Cornish, D Llewlyn and T Aplin (n 32 ) 536-537.

332 In that sense see the decision of the Munich Regional Court of 13 June 2007 ZUM-RD [2007] 498, 502.

333 Pursuant to § 31(5) UrhG when a contract does not expressly mention the forms of exploitation covered these are to be determined according to the purpose of the contract.

334 T Dreier and G Schulze (n 13) § 43 rn1. In a certain sense the German solution is even wider as it also covers commissioned works; A Metzger (n90) 83; H-P Götting, ‘Urheberrechtliche und vertragsrechtliche Grundlagen’ in F-K Beier et al. (eds) (n 268) 53, 72.

defenders<sup>335</sup> this thesis is denied by the majority<sup>336</sup> for it would, as Strowel points out, deprive L 111-3 of meaning.<sup>337</sup> In Germany an implied licence is normally accepted inasmuch the creation results from the nature of the contract.<sup>338</sup>

In the different context of exhaustion the CJEU has dealt with the concept of implied licence. The issue in *Davidoff*<sup>339</sup> was whether the consent of the trade mark holder could be implied or had to be explicit. The Court held that the licence “may be implied, where it is to be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market”,<sup>340</sup> however it could not be inferred just from the absence of action by the owner.<sup>341</sup> According to Taina Pihlajarinne,<sup>342</sup> implied licence “has been seen more like an act similar to assignment and declaration of intent, on the basis of which the other party can act in good faith”.

## b) Abuse of rights

As Lenaerts writes: “the concept of abuse of rights refers to situations in which a right is formally exercised in conformity with the conditions laid down in the rule granting the right, but where the legal outcome is against

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335 See supra n 263. For a comparative overview see A Lucas-Schloetter, *Les droits d’auteur des salariés en Europe continentale* (Cahiers IRPI 2004).

336 Lucas and Lucas (n 71 ) citing a decision of the French *Cour de cassation*. See also L Drai, *Le Droit du Travail Intellectuel* (LGDJ 2005).

337 (n 70) 326. The same position is found in Portugal (M V Rocha, ‘A titularidade das criações intelectuais no âmbito da relação de trabalho’ in *Nos 20 anos do Código das Sociedades Comerciais* (Coimbra Ed 2007) 167).

338 § 43 UrhG. For a recent decision regarding the work of an architect working for the State see BGH [2011] GRUR 59. See also BGH [1991] GRUR 523 *Grabungsmaterialien*; T Fuchs, ‘Der Arbeitnehmerurheber im System des § 43 UrhG’ [2006] GRUR 561; R Kraßer, ‘Urheberrecht in Arbeits-, Dienst- und Auftragsverhältnissen’ in F-K Beier et al. (eds) (n 268 ) 77.

339 Joined Cases C-414/99 to C-416/99 *Zino Davidoff* [2001] ECR I-8691.

340 Ibid para 47.

341 Ibid para 60.

342 ‘Setting the limits for the implied license in copyright and linking discourse – the European perspective’ [2012] IIC 700,702.

the objective of that rule”.<sup>343</sup> The notion is strongly related to the concept of good faith.<sup>344</sup>

This argument, explored earlier, goes: it is against good faith, constitutes contradictory behaviour and defeats the purpose of IPRs to use their blocking effect in certain situations of split ownership of overlaps.<sup>345</sup> If that was the circumstance in several of the analysed scenarios, it is nonetheless true that the application of this doctrine is very much dependent on the specific facts of each case.<sup>346</sup> Furthermore, even in blatant cases of “contradictory behaviour” there might be some reluctance to use this mechanism.<sup>347</sup>

Nonetheless, Axel Metzger<sup>348</sup> rightly points out that there is normative support in articles 8(2) and 41(2) TRIPS and article 3(2) of Directive 2004/48 on the enforcement of intellectual property rights to hold that under certain conditions (such as the one under scrutiny) the doctrine of abuse might trump the exercise of IPRs.

#### 4. Expanding copyright-internal solutions by analogy

Although there are no provisions regulating inter-IPRs conflicts of ownership, some regimes, most notably copyright and patents, have mechanisms to deal with conflicts resulting from joint ownership.<sup>349</sup> Often this is also achieved by applying the general rules of private law on common property or common tenancy.<sup>350</sup>

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343 (n 160 ) 1122.

344 Ibid 1145 ff; In IP the concept is used v.g. in the trade mark context (52 (1)(b) CTMR). The interpretation by the CJEU has been quite demanding, see Cases C-529/07 *Lindt* [2009] ECR I-04893 and C-320/12 *Malaysia* (CJEU 27 June 2013). On the rule in detail see A Tsoutsanis, *Trade mark registrations in bad faith* (OUP 2010).

345 F Verkade (n 19 ) 75.

346 Ibid (“...could in certain circumstances...”). See also the CJEU in *Malaysia* (n 344 ) at para 36 (“...in order to determine the existence of bad faith, it is necessary to carry out an overall assessment, taking into account all the factors relevant to the particular case...”).

347 See n 201 .

348 ‘Abuse of Law in EC Private Law: A (re-)construction from fragments’ in R de La Feria and S Vogenauer (eds), *Prohibition of Abuse of Law: A New General Principle in EC Law?* (Hart Publishing 2010) 235, 245.

349 See n 107 .

350 Ibid.



As Antoon Quaadvlieg<sup>351</sup> puts it “...cases of negative convergence will not always result in simple allowing one regime to take priority over another. Their effects can be much more subtle and sophisticated. For example, the weight of the core regime can result in the provisions of other regimes being subject to a different interpretation.”

In this section I shall consider the applicability of copyright specific solutions to the split ownership problem of overlaps by means of analogy. I do not regard patent provisions as a possible general solution since the potential of cumulation for patents is rather low<sup>352</sup> and there are more sensibilities regarding copyright that need to be accommodated.

#### a) On Analogy

Whenever there is a loophole in the law, an unforeseen situation which requires intervention of the law, legal doctrine speaks of gaps or *lacunae* (*Lücken* in German).<sup>353</sup> Claus-Wilhelm Canaris defined it as “incompleteness contrary to the plan of the positive law (i.e. the law within the inner limits of the possible meaning of its text and customary law)”.<sup>354</sup> The means to fill these gaps or *lacunae* rely mainly on analogy.<sup>355</sup>

There is a deep debate among legal philosophers on the extent to which these happen.<sup>356</sup> It can be said that legal reasoning somehow differs among

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351 ‘Concurrence’ (n 9 ) 30.

352 E Derclaye and M Leistner (n10 ) 89 ff.

353 On the topic see *inter alia* R Dworkin, ‘On Gaps in the Law’ in P Amselek and N MacCormick (eds), *Controversies about Law’s Ontology* (Edinburgh University Press 1991) 84-90; C-W Canaris, *Die Festsetzung von Lücken im Gesetz* (2<sup>nd</sup> edn, Dunckner & Humboldt 1983) and K Larenz, *Methodenlehre der Rechtswissenschaft* (6<sup>th</sup> edn, Springer 1991) 401 ff.

354 Ibid, 30: “Eine Lücke ist eine planwidrige Unvollständigkeit des positive Rechts (d.h. des Gesetzes innerhalb der Grenzen seines möglichen Wortsinnes und des Gewohnheitsrechts)”.

355 There is a distinction between intra-systematic processes (out of which analogy is paramount) and extra-systematic interventions, such as relying on equity, administrative decision or legislative action.

356 For a good summary of the deductivism and inductivism approaches and defending that not even deductivism presupposes a gapless law, see N MacCormick, *Rhetoric and the Rule of Law – A theory of Legal Reasoning* (OUP 2005) 52 ff.

common lawyers (who, when applying precedent, reason by analogy)<sup>357</sup> and civil lawyers (who usually depart from codified law and employ analogy mainly as a means to fill the gaps of the statute).<sup>358</sup> Nonetheless both systems are faced with scenarios which demand a legal answer although such an answer is not directly given.<sup>359</sup> It can be added that, whenever a civil lawyer reasons on the basis of precedent or a common lawyer interprets statute, their methodologies might to a certain extent converge or even swap.

The first challenge in dealing with these situations lies in identifying them. There are cases in which the law is silent on the matter precisely because it chose to do so. Leaving the matter unregulated was a conscious and deliberate choice.<sup>360</sup> Then, there is there is no gap, it's a space "free from the law".<sup>361</sup>

Other instances occur when the law bars the use of analogy, as regarding criminal sanctions, tax incidence and other limitations of fundamental rights.<sup>362</sup> No matter how logical it might seem to extend the law to those

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357 D Hunter, 'Reason is too large: Analogy and precedent in law' 50 *Emory Law Journal* (2001) 1197, 1222. This is contested by F Schauer, 'Why Precedent in Law (and Elsewhere) is Not Totally (or Even Substantially) about Analogy' KSG Working Paper No. RWP07-036 (2007) 3 <<http://ssrn.com/abstract=1747148>> ("An argument from precedent does require an initial determination of relevant similarity, but from there the paths diverge, and the typical use of precedent, especially by judges, bears far less affinity to analogical reasoning than most psychologists and perhaps even some lawyers appear to believe").

358 J Holland and J Webb, *Learning Legal Rules* (7<sup>th</sup> edn, OUP 2010) 381; K Langenbucher, 'Argument by Analogy in European Law' 57 (2008) *Cambridge Law Journal* 481, 482 ff.

359 This is to be distinguished from the necessary interpretation of general terms that always happens due to the open texture of the law (see e.g. H Hart, *The concept of law* (3<sup>rd</sup> edn, OUP 2012) 126 ff.). Nonetheless, it should be noted that the difference between extending the scope of the text to encompass new situations and going into analogy is just one of degree.

360 Karl Larenz calls this an "eloquent silence" (*Beredetes Schweigen*) (n353 ) at 370. K Langenbucher (n358 ) 485 ("...the mere fact that a novel case does not fall under a role in the Code does not in itself entail the conclusion that there is a gap."). Such a reasoning was used e.g. in Case 30/88 *Hellenic Republic v Commission* [1989] ECR I-3711 AG Opinion of AG Tesouro para 19.

361 C-W Canaris (n353) 40-44.

362 K Langenbucher (n358) 486.

situations, reasoning by analogy is not allowed.<sup>363</sup> Thus, the gap is left unfilled.

If one has identified a (real) gap and there is no impediment to analogy, the next step will be identifying a similar case which has a defined solution in the law and, on the basis of that similarity, extend the application of such solution in order to fill in the gap. It should be stressed that this determination of similarity has always to be done with the *ratio legis* in mind.<sup>364</sup> One needs to interpret the law in order to find out why it contains a certain command and, only after such an interpretation has been done, can one ascertain if the case at hand bears or not the similarity that justifies analogy.<sup>365</sup>

Sometimes it is not possible to find a comparable solution in the law and, as the judge cannot excuse himself from deciding,<sup>366</sup> the Court will have to create a legal solution for the case. But even then the idea is that the legal solution to create is to be taken from the system, to establish a rule as the legislator would have established.

When one extends the application of a single norm to a case, it is said to be *analogia legis* (*Gesetzanalogie*), in case there is the need to create a rule, building on legal principles, then it is called *analogia iuris* (*Rechtanalogie*).<sup>367</sup>

In the situation under analysis, there is an unforeseen situation which requires the intervention of the law. It is unforeseen for no specific regulation of ownership in the case of overlaps is found in statutes. Although some channelling provisions partially avoid overlapping protection, these do not

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363 A much debated issue (with different outcomes in different jurisdictions) was whether the taking of electricity amounted to theft and if the prohibition of analogy in criminal law barred it. On the topic see C W Maris, 'Milking the Meter.' in P Nerhot (ed), *Legal Knowledge and Analogy* (Springer1991) 71-106.

364 Ibid 488. Article 10(2) of the Portuguese Civil Code puts it rather clear, stating: "There is analogy whenever the justifying reasons for the solution found in the law are also to be found in the unforeseen case". This was inspired by art. 1 of the Swiss Civil Code.

365 As follows from the definition given by Canaris, the difference between analogy and interpretation is the text of the law. If the solution can still be found in the text, it is interpretation, if not then we enter the realm of lacunae and its filling, C-W Canaris (n353 ) 197.

366 N Luhmann, *Law as a Social System* (OUP 2004) 281. *Non liquet* as a reason not to decide only occurs in international law (cf. P Weil, 'The Court Cannot Conclude Definitively...Non Liqueur Revisited' (1997) 36 Columbia Journal of Transnational Law 109).

367 C W Maris (n363 ) 71, 75-79. J Holland and J Webb (n358 ) 382.

ban overlaps and there are provisions in the law that specifically allow it.<sup>368</sup> It is submitted that the situation is problematic and there was no intention to leave it unregulated. Furthermore, this is not a space outside the realm of law. The problem exists precisely due to imperfect interaction of the existing laws.

It can be argued that a proposal that extends copyright solutions by analogy can represent a limitation of the IPR of these people and limitations, as exceptions, should be limited to the minimum and respect the three-step test.<sup>369</sup> Additionally, it can be argued that there should not be room for analogy in exceptional cases.

This whole construction does not seem to hold true. The only question to be answered is whether, according to the *ratio legis* of a certain legal solution one considers applying by analogy, there is room for due differentiation or, on the other hand, the situation under analysis fits well and is similar, in its relevant aspects, to the situation explicitly considered by the lawmaker. If the latter is verified then one can proceed with the analogy. One good way of measuring the solution is considering how it works and whether the results achieved seem fair and sensible.

#### b) Connected works

As seen, connected works are works which, albeit independent, are combined for joint exploitation.<sup>370</sup> The situation envisaged is slightly different from the problem in hand. In the overlap situation there is no act of combination and the different IPRs are not independent, i.e. capable of separate exploitation. But there also significant commonalities: the use of the combined object is only possible in common and each of the authors has the power to prevent exploitation. Since the commercial interest will often lie only in the exploitation of the common object<sup>371</sup> such difference plays no significant role.

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368 See supra **III.B.1.**

369 About the test in detail cf. M Senftleben, *Copyright, Limitations and the Three-step Test* (Kluwer Law International 2004).

370 See **I.B.2.b)2.**

371 Which has an “unitary artistic effect, stronger than the sum of the combined works”, E Ulmer (n 61 ) 194.

The solutions found in the national legislation seem to provide a good basis for solving conflicts. The German solution, relying on good faith, allows for a great deal of flexibility.<sup>372</sup> The Italian solution promotes legal certainty in the cases where it designates the “prevailing” work.<sup>373</sup> When applying such solution by analogy, although a similar reasoning is possible, it faces most of the obstacles of the prevalence approach.<sup>374</sup> It is nonetheless better in comparison because, unlike prevalence, it safeguards the interests of the “eschewed” owner, which will still be entitled to payment. This represents the equivalent to a compulsory licence or a levy. The “eschewed” owner's right in that situation is reduced to a remuneration right.

### c) Joint works

The qualification of joint works requires a tighter collaboration.<sup>375</sup> This is also due to the impossibility of exploiting each author's contribution separately. It is precisely this aspect that renders the concept of joint works particularly suitable to regulate the phenomenon of split ownership in cases of overlaps.<sup>376</sup> Even in face of those situations where unanimity is still required<sup>377</sup> there are mechanisms in place, such as court mediation, to overcome the blocking situation.

It must be added that in several jurisdictions there will be no real difference concerning joint works and connected works, since their respective regimes will lead anyhow to the general rules of private law on common property, common tenancy<sup>378</sup> or joint collaboration.<sup>379</sup> Applying the general rules of civil law might be another way of achieving a similar result. As said by Peukert<sup>380</sup> “the specific problem posed by joint ownership pertains to internal disputes. The necessity to agree on a mode of exploitation increases

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372 § 9 UrhG.

373 Arts. 33-37 ItalCa, see n 122 .

374 See **III.B**.

375 At least under the adopted definition (at **I.B.2.b**) 1).

376 S Chalton seems to suggest it, howbeit implicitly (n 262 ) at 181.

377 T Margoni and M Perry (n 122 ) 32 call it “the anticommons threat”.

378 K Garnett, G Davies and G Harbottle (n 132 ) 333. This is the case in Portugal by article 15 PTCA.

379 As in the German case (see n 118 ).

380 (n 44) 214.

transaction costs and can prevent desirable uses. Therefore, the law should help to coordinate the internal operations of the group”.