bileta | British and Irish Law Education and Technology Association

BILETA Response to EC Consultation on the Evaluation and Modernization of the Legal Framework for the Enforcement of IPRED

This is a collaborative submission from a group of academics based in the UK with expertise in Information technology law and related areas.
The preparation of the response has been funded by the British and Irish Law Education Law and Technology Association (BILETA http://www.bileta.ac.uk/Home/)
This response has been prepared by Dr. Felipe Romero Moreno (University of Hertfordshire) and Dr. James Griffin (University of Exeter).
It has been approved by the Executive of BILETA and is therefore submitted on behalf of BILETA

In addition, this response is submitted by the following individuals:

Dr Abbe Brown, Reader in Law, Aberdeen University, UK
Dr Janice Denoncourt, Nottingham Trent University, UK

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Date: 19/04/2016 12:31:03

Public consultation on the evaluation and modernisation of the legal framework for the enforcement of intellectual property rights: Judiciary and Legal Profession

Fields marked with * are mandatory.

Objectives and General information

The views expressed in this public consultation document may not be interpreted as stating an official position of the European Commission.

You are invited to read the privacy statement[1] for information on how your personal data and contribution will be dealt with.

Please complete this section of the public consultation before moving to other sections.

Respondents with disabilities can request the questionnaire in .docx format and send their replies in email to the following address: GROW-IPRCONSULTATION@ec.europa.eu.

If you are an association representing several other organisations and intend to gather the views of your members by circulating the questionnaire to them, please send us a request in email and we will send you the questionnaire in .docx format. However, we ask you to introduce the aggregated answers into EU Survey. In such cases we will not consider answers submitted in other channels than EU Survey.

If you want to submit position papers or other information in addition to the information you share with the Commission in EU Survey, please send them to GROW-IPRCONSULTATION@ec.europa.eu and make reference to the "Case Id" displayed after you have concluded the online questionnaire. This helps the Commission to properly identify your contribution.

Given the volume of this consultation, you may wish to download a PDF version before responding to the survey online.

[1] Add link.

*** Please enter your name/organisation and contact details (address, e-mail, website, phone)**

Name of the organization: British and Irish Law Education and Technology Association (BILETA); e-mail: info@bileta.ac.uk; website: http://www.bileta.ac.uk/

*** Is your organisation registered in the Transparency Register of the European Commission and the European Parliament?**

In the interests of transparency, organisations (including, for example, NGOs, trade associations and commercial enterprises) are invited to provide the public with relevant information about themselves by registering in the Interest Representative Register and subscribing to its Code of Conduct

If you are a registered organisation, please indicate your Register ID number. Your contribution will then be considered as representing the views of your organisation

If your organisation is not registered, you have the opportunity to register now. Then return to this page to submit your contribution as a registered organisation.

Submissions from organisations that choose not to register will be treated as 'individual contributions' unless they are recognized as representative stakeholders via relevant Treaty Provisions.

- ○ Yes
- ◉ No
- ○ Non-applicable

*** Register ID number**

*** In the interests of transparency, your contribution will be published on the Commission's website. How do you want it to appear?**

- ◉ Under the name supplied? (I consent to the publication of all the information in my contribution, and I declare that none of it is subject to copyright restrictions that would prevent publication.)
- ○ Anonymously? (I consent to the publication of all the information in my contribution except my name/the name of my organisation, and I declare that none of it is subject to copyright restrictions that would prevent publication).
- ○ No publication - your answer will not be published and in principle will not be considered.

"Please note that your answers may be subject to a request for public access to documents under Regulation (EC) No 1049/2001."

A. Identification

*** You are a**

- Judge sitting at a specialised IP court
- Judge sitting at a specialised IP chamber in the general civil/commercial court
- IP-specialised single judge
- Judge sitting in the general civil/commercial court, reviewing IP cases
- Association representing the judiciary
- Legal counsellor
- Association representing the legal profession
- Legal academic
- Other

Please specify:

100 character(s) maximum

*** Please indicate your country of profession:**

Austria	Belgium	Bulgaria
Cyprus	Croatia	Czech Republic
Denmark	Estonia	Finland
France	Germany	Greece
Hungary	Ireland	Italy
Latvia	Lithuania	Luxembourg
Malta	Netherlands	Poland
Portugal	Romania	Slovakia
Slovenia	Spain	Sweden
United Kingdom	Other	

Please specify:

100 character(s) maximum

B. Your views and opinion on the scale of IPR infringements and general issues of IP litigation

*** To your knowledge and experience, are IPR-infringements cases taking a considerable part of the overall civil/commercial litigations in your country?**

- Yes
- No
- Don't know

Please specify:

1,500 character(s) maximum

Please explain:

What is approximately the percentage of IP cases of the overall civil/commercial litigation in your country?

%

*** Do you think that IP rightholders are frequently using litigation as a means of protecting their IPRs?**

- Yes
- No
- Don't know

*** In your opinion, what is the reason for this?**

- The costs for litigation and legal representation are too high
- Civil court proceedings take too long
- Procedures are too complex
- The outcome of litigation is not predictable
- Alternative dispute resolution mechanisms can achieve better results in terms of time and money
- There are other means available to protect IPR (notice-and-action procedures, voluntary cooperation with intermediaries, etc.)
- Other

Please specify:

500 character(s) maximum

*** In your experience, do SMEs litigate to protect their IPR?**

"SME"

According to Commission Recommendation of 6 May 2003 concerning the definition of micro, small and medium-sized enterprises, 2003/361/EC: enterprises which employ fewer than 250 persons and which have an annual turnover not exceeding EUR 50 million, and/or an annual balance sheet total not exceeding EUR 43 million (http://ec.europa.eu/growth/smes/business-friendly-environment/sme-definition/index_en.htm).

- Yes
- No

- ○ Don't know

*** In your opinion, what is the reason for this?**

- ◉ The costs for litigation and legal representation are too high
- ○ Civil court proceedings take too long
- ○ Procedures are too complex
- ○ The outcome of litigation is not predictable
- ○ Alternative dispute resolution mechanisms can achieve better results in terms of time and money
- ○ There are other means available to protect IPR (notice-and-action procedures, voluntary cooperation with intermediaries, etc.)
- ○ Other

Please specify:

500 character(s) maximum

C. Functioning of key provisions of Directive 2004/48/EC on the enforcement of intellectual property rights

This section aims to provide the Commission with stakeholder' views, opinions and information about the functioning of the overall enforcement framework and of key provisions of IPRED.

C.1. Overall functioning of the enforcement framework

In which Member State(s) do you litigate most?

at most 3 choice(s)

- ☐ Austria
- ☐ Belgium
- ☐ Bulgaria
- ☐ Cyprus
- ☐ Croatia
- ☐ Czech Republic
- ☐ Denmark
- ☐ Estonia
- ☐ Finland
- ☐ France
- ☐ Germany
- ☐ Greece
- ☐ Hungary
- ☐ Ireland
- ☐ Italy
- ☐ Latvia
- ☐ Lithuania
- ☐ Luxembourg
- ☐ Malta
- ☐ Netherlands
- ☐ Poland
- ☐ Portugal
- ☐ Romania
- ☐ Slovakia
- ☐ Slovenia
- ☐ Spain
- ☐ Sweden
- ☐ United Kingdom

For these jurisdictions please provide your overall experience and satisfaction with the legal framework for civil enforcement of IPR (please indicate Member State concerned first)?

	Overall experience and satisfaction
Member State 1:	
Member State 2:	
Member State 3:	

Do you think that the existing rules – as provided by the Directive and implemented at national level – have helped effectively in protecting IP and preventing IPR infringements?

- ○ Yes
- ○ No
- ◉ Partly
- ○ No opinion

Please explain:

1,500 character(s) maximum

There is a requirement of effectiveness under Art. 3(2) Intellectual Property Rights Enforcement Directive 2004/48/EC (IPRED) requires that remedies for the enforcement of intellectual property rights. This reflects similar provisions in Art. 19(1) of the Treaty on European Union and Art. 41(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).
In the UK, the notion of effectiveness for remedies in enforcement of IP was discussed in Cartier [2014] EWCH 3354 (Ch). At para 173 the court argued that it was wrong to interpret Art. 3(2) of IPRED in order to require that rightholders establish that there would be likely to be a reduction in the infringement of their rights. The court stated that Art 3(2) was equally applicable to offline and online infringements. To support its view, the court at para 174 made express reference to paragraphs [58], [61], and [62] of C-314/12 UPC. At para 236:
'Overall, the conclusion which I draw from the evidence is that, in the section 97A context, blocking of targeted websites has proved reasonably effective in reducing use of those websites in the UK. No doubt it is the casual, inexperienced or lazy users who stop visiting those websites, whereas the experienced and determined users circumvent the blocking measures; but that does not mean that it is not a worthwhile outcome'.

C.2. Measures, procedures and remedies provided for by IPRED

Responses to this section should be based on the overall experience with the measures,

procedures and remedies provided for by IPRED as implemented and applied at national level. If appropriate please specify in your response, to the extent possible, particular national issues or practices and the jurisdiction concerned.

C.2.1 Evidence (Articles 6 and 7)

*** Would you consider that the measures provided by IPRED are effective means for presenting, obtaining and preserving evidence?**

- ○ Yes
- ◉ No
- ○ No opinion

* Please explain:

1,500 character(s) maximum

Please explain:

Within the UK, the measures provided by IPRED might not be considered effective means for presenting, obtaining and preserving evidence, particularly online. In EMI [2013] EWCH 379 (Ch) the court assessed the copyright infringement detection system which assessed whether users the websites infringed copyright and whether the ISPs had actual knowledge of those infringements. However, UK courts have not assessed whether such a copyright infringement detection system is good enough to preserve digital evidence. This is particularly the case when in 2014 Harbor Labs' Evaluation of the system in question recommended that the system should be able to track, in both a tamper-resistant and tamper-evident way, every step of the case-building and notification procedure. Furthermore, it was stated that a system should adopt supplementary internal security policies to protect gathered information and any derivative metadata.

*** In view of your experience with the implementation and application of the rules for having access to and preserving evidence do you see a need to adjust the application of that measure, in particular with regard to preserving evidence in the digital environment and in cross-border cases?**

- ◉ Yes
- ○ No
- ○ No opinion

* Please explain:

1,500 character(s) maximum

See C.2.1 above.

C.2.2. Right of information (Article 8)

What are the requirements for a request for information to be proportionate and justified when exercising the right of information against an infringer?

1,500 character(s) maximum

It should be noted that UK rules focus upon initial uploaders and also web sites that facilitate access to infringing material.
The jurisdiction to allow a prospective claimant to obtain information in order to seek redress for an arguable wrong was recognised by the House of Lords in Norwich Pharmacal [1974] AC 133 which can be used to reveal the c hain of infringers. As noted by the Supreme Court in Viagogo [2012] UKSC 5 5 [para 44], the correct approach to considering proportionality in such a n instance is that neither Article 1 of the First Protocol to the ECHR/Ar t. 17(2) of the Charter, nor Art. 8(1) ECHR/Article 7 of the Charter and A rt. 8 of the Charter had precedence over the other; where the values under the two Articles were in conflict, the 'proportionality test' must be appl ied to each.
The Supreme Court took the view that "it is not necessary that an applican t intends to bring legal proceedings in respect of the arguable wrong" – s ee Viagogo [para 15]. This contrasts with the EDPS' opinion that under Ar t. 8 Data Protection Directive 95/46/EC, the monitoring of infringing beha viour to detect online copyright infringement can be performed in the cont ext of specific, existing or future court proceedings to establish, pursue or defend legal claims. However, random or blanket monitoring would be unl awful C-360/10, SABAM v Netlog NV. Indeed, this rule that surveillance mea sures must be limited in scope was emphasized by the ECtHR in Klass (App N o 5029/71) [para 83].

What are the requirements for a request for information to be proportionate and justified when exercising this right of information against another person (e.g. an intermediary)?

1,500 character(s) maximum

Jurisdiction to allow a prospective claimant to obtain information in orde r to seek redress for an arguable wrong was recognised by the House of Lor ds in Norwich Pharmacal. Moreover, the correct approach to considering pro portionality was confirmed by the Supreme Court in Viagogo [para 44]. In t he UK, in assessing whether internet intermediaries such as ISPs can be or dered to disclose information on alleged infringers to judicial authoritie s, the courts generally take into account some factors such as a) the vuln erability of the users, b) the inability of would-be defendants to afford special legal advice, and c) the propensity for even innocent subscribers to pay up instead of being accused of unlawfully downloading pornography – see Golden Eye [2012] EWCA Civ 1740 [para 26].
This contrasts with the EDPS' opinion that to strike a balance between the provision of information on the identity of the infringer and the protect ion of privacy and data protection. The threshold for disclosure assesses a) whether the alleged infringement reaches a commercial scale –see C-324/

09 L'Oréal [para 55] and C-275/06 Promusicae [AG para 1119]; b) a sufficient evidence of infringement – C-461/10 Bonnier [para 58] - applicant must to prove; and c) sufficient gravity in the wrongdoing and considerable harm to the right holder favours the disclosure of information –C-275/06 Promusicae [AG 106], [AG 108], [AG 118], [AG 119] and C-461/10 Bonnier [58].

How do you define "commercial scale" in your jurisdiction?

1,500 character(s) maximum

In the UK the typical legal action identifies monetary choke points for infringing sites – e.g. by restricting the funding of pirate sites. Without advertising revenue (EMI [2013] EWCH 379 Ch [para. 59]) or payment processing services (Cartier [2014] EWCH 3354 Ch [250]), sites become commercially unviable.
Section 2A CDPA 1988 provides the legal basis for proceeding against providers of infringing material. Enforcement relies on right holders detecting the infringement. The right holder needs to notify the website operator, hosting provider or domain registrar that there is a high level of infringing content on a particular website and request removal, through a cease and desist request. The right holder then needs to send a notice and takedown request to the relevant ISP, under s.18 & s.19 EC Directive Regulations 2012. If such an approach is not successful, then an injunction may be applied for under s.97A CDPA 1988. This provision allows an order an ISP to block subscriber access to an infringing website. There is also the possibility to involve the Police Intellectual Property Crime Unit to disrupt advertising revenue and de-registering domain names, provided that evidence is shown for criminal infringement.

What is the scope of the assessment of the admissibility and the merits of a request for information?

1,500 character(s) maximum

Jurisdiction to allow a claimant to obtain information to seek redress for an arguable wrong was recognised in Norwich Pharmacal [1974] AC 133. Subsequently, Viagogo [2012] UKSC 55 [para 16, 17] states there is a need for flexibility and discretion in granting the remedy. Viagogo also stated it was not necessary that an applicant intended to bring legal proceedings in respect of the arguable wrong. Lastly, Viagogo stated the need to order disclosure will be found to exist only if it is a "necessary and proportionate response in all the circumstances"- see Ashworth [2002] 1 WLR 2033 [para 36 & 57], and that the test of necessity did not require the remedy to be one of last resort - see R (Mohamed) [2009] 1 WLR 2579 [para 94].
Viagogo [para 17] requires consideration for proportionality purposes: a) whether the respondent to the application knew or ought to have known that he was facilitating arguable wrongdoing b) whether the order might reveal the names of innocent persons as well as wrongdoers, and if so whether such innocent persons will suffer any harm as a result c) the degree of confidentiality of the information sought d) the privacy rights under Article

8 of the ECHR the individuals whose identity was to be disclosed e) the ri ghts and freedoms under the EU data protection regime of the individuals w hose identity was to be disclosed f) the public interest in maintaining th e confidentiality of journalistic sources.

What is the burden of proof and evidence required to demonstrate the existence of an infringement?

1,500 character(s) maximum

It is not possible under existing UK law to know the exact burdens and sta ndard of proof for evidence that right holders need to meet in order to de monstrate the existence of an infringement. However, under the processes t o demonstrate whether a service provider "has actual knowledge" of an infr ingement, there is the possibility to consider notice and whether that not ice included details of the location of the infringing content and the det ails of the unlawful activity or content.
In EMI [2013] EWCH 379 (Ch) the High Court assessed the effectiveness of M arkMonitor's infringement detection system. Based on MarkMonitor evidence, the court concluded that both UK users and website operators infringed the claimants' copyrights on a large scale - see paragraphs 25 - 27 and 89. Ho wever, these monitoring systems are not subject to a prior check/supervisi on from State authorities (the courts or the data protection authorities). Indeed, the review of such systems is generally carried out a posteriori b y security experts such as, Dr Clayton (who recommends robust gathering of evidence via 'hygiene checks' and a 'doctrine of perfection'), but more wo rryingly, by the private sector like Stroz Friedberg's Independent Expert Assessment of MarkMonitor Antipiracy Methodologies in the US.

What are the procedural safeguards in your jurisdiction to ensure the proportionate use, the relevance of the information for the identification of an infringer and the accuracy and correctness of the identification of the infringer, in particular when information is to be provided by a third person, for example an intermediary service provider, for such purposes?

1,500 character(s) maximum

As noted before, in terms of commercial-scale online copyright infringemen t, the UK approach focuses on both initial uploaders and those websites pr oviding and facilitating access to infringing material.
Exact details of the use, relevance, accuracy, and correctness of the info rmation, which right holders must rely upon in order to identify initial u ploaders and subsequently notify ISP are not available. However, the DEA 2 010 (which is unlikely to be fully implemented) contains provisions that w ould ensure accuracy and robustness of right holder evidence-gathering tec hniques and the process of ISP matching IP addresses to subscribers – for discussion see Golden Eye [2012] EWHC 723 Ch [103].
Since initial uploaders are generally hosting companies located in France and Germany, it is difficult to identify the users behind such initial upl oaders as their servers are hired by individuals residing in other countri

es. Moreover, there are practical issues when seeking to identify those who run and own large website or services which facilitate commercial-scale infringement as website operators change domain registrant details repeatedly.

In your experience, what are the main reasons for not obtaining the requested information?

	Very relevant	Relevant	Less relevant	Not relevant
Unjustified/disproportionate request	◉	○	○	○
Protection of confidentiality of information	◉	○	○	○
Right to respect for private life and/or right to protection of personal data	◉	○	○	○
Information not available (anymore)	○	○	◉	○
Information provided in the request inaccurate	○	○	◉	○
Other	◉	○	○	○

Please specify:

500 character(s) maximum

The Supreme Court in Viagogo [2012] UKSC 55 [para 17] also requires consideration of a) whether the respondent to the application knew or ought to have known that he was facilitating arguable wrongdoing b) whether the order might reveal the names of innocent persons as well as wrongdoers, and if so whether such innocent persons will suffer any harm as a result.

*** In view of your experience with the application of the right of information do you think that the existing rules have helped effectively in protecting IP and preventing IPR infringements?**

- ☑ Yes
- ☐ No
- ☐ No opinion

Please explain:

1,500 character(s) maximum

Online, Norwich Pharmacal orders have been effective to a large extent in protecting IP and preventing IPR infringements, as demonstrated by the 'sp

eculative invoicing' letters for online copyright infringement which have been deployed over the last decades in the UK. Letters were sent demanding payment threatening court action unless fees were paid – as made famous by the actions of inter alia the law firm ACS Law. Thousands of internet subs cribers were alleged to have had their Internet connections used for small -scale copyright infringement (typically using file sharing sites). The na mes and addresses of users were obtained through a Norwich Pharmacal orde r.

*** Do you consider the application of the rules on the right of information to be clear and unambiguous, in particular with regard to requests for information held by intermediaries?**

- [ ] Yes
- [x] No
- [ ] No opinion

Please explain:

1,500 character(s) maximum

In Viagogo [2012] UKSC 55 [17] the Supreme Court stated that the essential purpose of granting a Norwich Pharmacal order was to do justice. Relevant factors include consideration of the degree of confidentiality of the info rmation sought, the privacy rights under Article 8 ECHR with regard to dis closure of identity, and the rights and freedoms under the EU data protect ion regime of the individuals whose identity was to be disclosed. As noted by the EDPS, however, the problem is that at EU level the relationship bet ween Art 8 IPRED, the Data Protection Directive 95/46/EC, the E-Privacy Di rective 2002/58/EC, and C-275/06 Promusicae is unclear. The EDPS noted tha t the legal framework is fragmented as it involves three Directives that c over different topics, thus rendering the interplay between them ambiguou s.

*** In view of your experience with the application of the right of information do you see a need to adjust the provisions for the application of that measure?**

- (•) Yes
- ( ) No
- ( ) No opinion

* Please explain:

1,500 character(s) maximum

See below explanation.

*** Do you see a need to clarify the criteria used to reconcile the requirements of the right to**

respect for private life/right to protection of personal data on the one hand and the right to effective remedy on the other hand when assessing requests for disclosure of personal data for the purpose of initiating judicial proceedings?

- (•) Yes
- ( ) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

The EDPS has stressed the need for clarification with regard to the limits to the permitted monitoring of infringers. Random or blanket monitoring by the private sector (e.g. MarkMonitor) would be unlawful following C-360-10 Netlog. However, further to Art 8 Data Protection Directive 95/46/EC, monitoring of infringing behaviour can be performed to establish, pursue or defend legal claims. It would be useful for to have clarification as to what those circumstances are, e.g. with regard to content trackers.
The EDPS has also seen a need to ensure a balance approach to transferring infringer details in the context of court proceedings. Greater guidance on the nature of permissible infringement and the factors to establish 'commercial scale' would be particularly useful particularly where small scale infringements have taken place over a long period of time for financial advantage.

C.2.3. Procedures and courts, damages and legal costs (Articles 3, 13 and 14)

In your experience, what are the reasons for taking infringer to court?

	Very relevant	Relevant	Less relevant	Not relevant
Damages	( )	( )	(•)	( )
Provisional and precautionary measures	( )	( )	(•)	( )
Injunctions	( )	( )	(•)	( )
Other	( )	( )	(•)	( )

Please specify:

500 character(s) maximum

*** Do you encounter specific problems when dealing with legal actions in a cross-border**

situation (applicant or defendant incorporated or resident in another EU Member State)?

- ○ Yes
- ◉ No

***** Please explain:

1,500 character(s) maximum

In your jurisdiction the award of damages as a compensation for the prejudice suffered as a result of an infringement can include?

	Yes	No
Lost profit	☑	☐
Unfair profits	☑	☐
Moral prejudice	☑	☐
Lump sum	☑	☐
Other	☑	☑

Please specify:

500 character(s) maximum

N/A section

*** In your jurisdiction damages are usually granted in full?**

- ○ Yes
- ○ No
- ◉ Don't know

*** What are the main reasons for not granting damages in full?**

- ☐ Limitations in law
- ☐ Unjustified request / lack of evidence
- ☐ Other

Please specify:

1,500 character(s) maximum

*** Is it possible in your jurisdiction for the right holder to claim damages from a third party who actively and knowingly facilitates infringements of IPRs?**

- (•) Yes
- ( ) No
- ( ) Don't know

Please specify:

1,500 character(s) maximum

A general rule in the UK is that if damages are possible within an action, then an injunction should not be granted - American Cyanamid v Ethicon [1975] AC 396 – this may have implications for any copyright action. Third parties with regard to actively and knowingly facilitating infringement can be caught by the right of authorisation. In Newzbin, the court upheld such liability – as summarised by the court: "126 The defendant is liable to the claimants for infringement of their copyrights because it has authorised the copying of the claimants' films; has procured and engaged with its premium members in a common design to copy the claimants' films; and has communicated the claimants' films to the public." (at para 126). Damages may then be claimed on a finding of a breach of authorisation for that breach as with any other authorisation claim –using the principles of General Tire and Rubber Company v Firestone Tyre and Rubber Company Limited [1975] 1 WLR 819 . It should be noted that for authorisation to succeed there needs to be another primary act of infringement, i.e. infringement of the act of reproduction.

*** Overall, in view of your experience with the application of the rules for setting damages do you think that the existing rules have helped effectively in protecting IP and preventing IPR infringements?**

- ( ) Yes
- ( ) No
- (•) No opinion

Please explain:

1,500 character(s) maximum

*** In view of your experience with the application of the rules for the calculation of damages do you see a need to adjust the application of that measure?**

- ( ) Yes
- ( ) No
- (•) No opinion

Please explain:

1,500 character(s) maximum

In your jurisdiction the reimbursement of legal costs incurred by the successful party can cover?

	Yes	No
Court fees for instituting proceedings	☑	☐
Other court fees	☑	☑
External expert(s) costs	☑	☑
In-house costs	☑	☑
Attorney's charge	☑	☑
Additional attorney's fees	☑	☑
Other	☑	☑

Please specify:

500 character(s) maximum

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Double selections = we do not know
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* **Are there any limitations on the recoverability of legal costs stipulated in the legislation/established by case law in your jurisdiction?**

- ○ Yes
- ○ No
- ◉ Don't know

Please explain:

1,500 character(s) maximum

* **In view of your experience with the application of the rules for the reimbursement of legal costs do you think that the existing rules have helped effectively in protecting IP and**

preventing IPR infringements?

- Yes
- No
- No opinion

Please explain:

1,500 character(s) maximum

*** In view of your experience with the application of the rules for the reimbursement of legal costs do you see a need to adjust the application of that measure?**

- Yes
- No
- No opinion

***** Please explain:

1,500 character(s) maximum

C.2.4. Provisional and precautionary measures and injunctions (Articles 9 and 11)

*** From your experience what kind of provisional measures and injunctions are most frequently requested?**

- Provisional measures against an infringer
- Injunction against an infringer
- Provisional measures against an intermediary
- Injunction against an intermediary
- Don't know

*** What is usually the geographical scope of the provisional measures and injunction requested?**

- Domestic
- Another EU jurisdiction
- Non-EU jurisdiction
- Multi-jurisdictional
- Don't know

From your experience what are the reasons for applying for a provisional and precautionary measures?

	Very		Less	Not

	relevant	Relevant	relevant	relevant
Prevent an imminent infringement	☑	☐	☐	☐
Forbid the continuation of an alleged infringement	☑	☐	☐	☐
Lodging of guarantees	☐	☑	☐	☐
Seizure or delivery up of the goods suspected of infringing an IPR	☑	☐	☐	☐
Blocking alleged infringer's bank accounts and other assets	☑	☐	☐	☐
Precautionary seizure of other movable and immovable property of the alleged infringer	☑	☐	☐	☐
Other	☐	☐	☐	☑

Please specify:

500 character(s) maximum

What are the reasons for not obtaining provisional and precautionary measures against an infringer?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☑	☐	☐	☐

Measure requested disproportionate	☐	☐	☑	☐
No likelihood of success on the merits of the case	☐	☐	☑	☐
Protection of confidentiality of information	☐	☐	☑	☐
Request for a security or an equivalent assurance	☐	☐	☑	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☑	☐
No commercial scale infringement	☑	☐	☐	☐
Infringer established in another jurisdiction	☐	☐	☑	☐
Other	☐	☐	☐	☑

Please specify:

500 character(s) maximum

Against which type of intermediary provisional and precautionary measures and injunctions are most frequently requested?

For the purpose of this consultation:

"Advertising service provider"Advertising agencies, advertising broker

"Contract manufacturing service provider"Contract manufacturing is an outsourcing of certain production activities previously performed by the manufacturer to a third-party. This may concern certain components for the product or the assembly of the whole product.

"Business-to-business data storage provider"Data storage space and related management services for commercial user.

"Business-to-consumer data storage provider"File-storing or file-sharing services for personal media files and data

"Content hosting platform"Platforms providing to the user access to audio and video files, images or text documents.

"Press and media company"Newspaper, broadcaster

- [x] Advertising service provider
- [ ] Business-to-business data storage provider
- [x] Content hosting platform
- [ ] Domain name registry
- [x] Internet Access Provider
- [ ] Press and media company
- [x] Payment service provider
- [ ] Search engine
- [ ] Transport and logistics company
- [ ] Other
- [ ] Contract manufacturing service provider
- [ ] Business-to-consumer data storage provider
- [ ] Domain name registrar
- [ ] DNS hosting service provider
- [ ] Mobile apps marketplace
- [ ] Online marketplace
- [ ] Retailer
- [ ] Social media platform
- [ ] Wholesaler

Please specify:

500 character(s) maximum

*** In your jurisdiction does the availability of provisional and precautionary measures against an intermediary depend on whether or not the infringer has been identified?**

- ( ) Yes
- ( ) No
- (•) Don't know

Please explain:

1,500 character(s) maximum

*** Is it possible in your jurisdiction to obtain provisional and precautionary measures against any intermediary or is such a measure subject to an active involvement (responsibility/liability) of the intermediary in the infringement?**

- ( ) Any intermediary
- ( ) Only intermediaries actively involved in the infringement
- (•) Don't know

*** What are the criteria for determining if an intermediary is actively involved in the infringement?**

1,500 character(s) maximum

In your experience, what are the reasons for not obtaining provisional and precautionary measures against an intermediary?

	Very		Less	Not

	relevant	Relevant	relevant	relevant
Insufficient evidence	☑	☐	☐	☐
Measure requested disproportionate	☐	☐	☑	☐
No sufficient link between the intermediary and the infringement	☐	☐	☑	☐
No likelihood of success on the merits of the case	☐	☐	☑	☐
Protection of confidentiality of information	☐	☐	☑	☐
Request for a security or an equivalent assurance	☐	☐	☑	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☑	☐
No commercial scale infringement	☑	☐	☐	☐
Intermediary established in another jurisdiction	☐	☐	☑	☐
Other	☐	☐	☐	☑

Please specify:

500 character(s) maximum

*** Are you aware of problems in cases of application for provisional and precautionary**

measures in a cross-border situation (for example infringer or intermediary established in another Member State)?

- ○ Yes
- ◉ No

* Please explain:

1,500 character(s) maximum

* **Are you aware of problems when executing provisional and precautionary measures in a cross-border situation (judicial authority in another jurisdiction and infringer or intermediary established in your jurisdiction)?**

- ○ Yes
- ◉ No

* Please explain:

1,500 character(s) maximum

* **In your jurisdiction can an injunction against an infringer be issued only to stop an actual infringement or also to prevent further infringements in the future?**

- ○ Only actual infringement
- ○ Also further infringements in the future
- ◉ Don't know

* **How do you define "further infringements"?**

1,500 character(s) maximum

What are the reasons for not obtaining an injunction against an infringer?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☑	☐	☐	☐
Measure requested disproportionate	☐	☐	☑	☐
Protection of confidentiality of information	☐	☐	☑	☐
Right to respect				

for private life and/or right to protection of personal data	☐	☐	☑	☐
No commercial scale infringement	☑	☐	☐	☐
Infringer established in another jurisdiction	☐	☐	☑	☐
Other	☐	☐	☐	☑

Please specify:

500 character(s) maximum

What are the reasons for applying for an injunction against an intermediary with regard to a third party using its services infringing an IPR?

	Very relevant	Relevant	Less relevant	Not relevant
Block access to infringing content online	☑	☐	☐	☐
Stay down of infringing content online	☑	☐	☐	☐
Adopt technical measures such as filtering	☐	☑	☐	☐
De-indexing infringing websites	☐	☑	☐	☐
Permanent termination of domain	☐	☑	☐	☐
Permanent termination of subscriber account	☐	☐	☑	☐
Discontinue providing payment services	☐	☑	☐	☐
Discontinue providing advertising services	☐	☑	☐	☐
Discontinue providing transport services	☐	☐	☑	☐
Discontinue manufacturing of infringing products	☐	☐	☑	☐
Termination of lease for commercial premises	☐	☐	☑	☐
Other	☐	☐	☐	☐

Please specify:

500 character(s) maximum

*** Is it possible in your jurisdiction to obtain an injunction against any intermediary or is an injunction subject to an active involvement (responsibility/liability) of the intermediary in the infringement?**

- ○ Any intermediary
- ◉ Only intermediaries actively involved in the infringement
- ○ Don't know

*** What are the criteria for determining if an intermediary is actively involved in the infringement?**

1,500 character(s) maximum

Within the UK, under s.97A CDPA 1988 claimants can seek an injunction which empowers the High Court 'to grant an injunction against a service provider, where that service provider has actual knowledge of another person using their service to infringe copyright'. In Fox [2011] EWHC 1981 (Ch) an ISPs services were being used to infringe copyright by both the operators of the Usenet indexing site Newzbin2 and its users. The Court stated that since the ISP had been notified by the claimants, the ISP had 'actual knowledge: 'It found that: "..[the ISP] knows that the users and operators of Newbin2 infringe copyright on a large scale, and in particular infringe the copyrights of the Studios in large numbers of their films and television programmes, it knows that the users of Newzbin2 include BT subscribers, and it knows that those users use its service to receive infringing copies of copyright works made available to them by Newzbin2" Fox at paras 157-158.

*** In your jurisdiction can an injunction against an intermediary be issued only to stop an actual infringement or also to prevent further infringements in the future?**

- ○ Only actual infringement
- ◉ Also further infringements in the future
- ○ Don't know

How do courts define "further infringements" without imposing on intermediaries general monitoring obligation in the meaning of the E-commerce Directive?

1,500 character(s) maximum

In Case C-70/10 Scarlet Extended SA v SABAM [2011] E.C.R. I-11959 the CJEU stated that preventive monitoring of the type which requires observation of all communications on the network is too broad. The court held that an order which would require this would fall foul of Art 15 of the E-Commerce Directive because it requires the imposition of a general obligation to monitor: "In the light of the foregoing, it must be held that the injunction imposed on the ISP concerned requiring it to install the contested filtering system would oblige it to actively monitor all the data relating to each of its customers in order to prevent any future infringement of intellectual-property rights. It follows that that injunction would require the ISP to carry out general monitoring, something which is prohibited by Articl

e 15(1) of Directive 2000/31."

* **Is it possible in your jurisdiction to obtain an injunction against an internet intermediary forbidding the continued access to the material that is allegedly infringing IPR when that injunction does not specify the exact measures which that access provider must take?**

- ○ Yes
- ◉ No
- ○ Don't know

How do courts guarantee the judicial oversight of the measures chosen by the intermediary with regard to the need to ensure compliance with the fundamental right of internet users to freedom of information?

1,500 character(s) maximum

To you knowledge what are the reasons for not obtaining an injunction against an intermediary?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☑	☐	☐	☐
No sufficient link between the intermediary and the infringement	☑	☐	☐	☐
Measure requested disproportionate	☑	☐	☐	☐
Protection of confidentiality of information	☐	☐	☑	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☑	☐
No commercial scale infringement	☑	☐	☐	☐
Intermediary established in	☐	☐	☑	☐

another jurisdiction				
Other	☑	☐	☐	☐

Please specify:

500 character(s) maximum

Other principles to be applied are:
a) Effectiveness
b) Dissuasiveness
c) Not unnecessarily complicated or costly
d) Avoidance of barriers to legitimate trade
e) Safeguards against abuse: (i) the ISPs, the target website operators, and the ISPs' subscribers can apply to the Court to discharge or vary the orders; (ii) the blocking order pop-up should contain relevant legal information; (iii) the injunction should be limited in time. – see Cartier [2016] EWCH 339 (Ch) [22].

*** Are you aware of problems in cases of application for an injunction in a cross-border situation (for example infringer or intermediary established in another Member State)?**

- ○ Yes
- ◉ No

* Please explain:

1,500 character(s) maximum

*** Are you aware of problems when executing an injunction in a cross-border situation (judicial authority in another jurisdiction and infringer or intermediary established in your jurisdiction)?**

- ◉ Yes
- ○ No

* Please explain:

1,500 character(s) maximum

The UK approach focuses on both initial uploaders and those websites providing and facilitating access to infringing material. However, initial uploaders are generally hosting companies located in France and Germany – and this makes it difficult to the users who are behind those uploaders. In addition to that problem, those who run large websites and services often change domain registrant details repeatedly - see EMI [2013] EWCH 379 Ch [63].

*** In view of your experience with the application of the rules for provisional and precautionary measures and injunctions do you see a need to adjust the application of these measures?**

- (•) Yes
- ( ) No
- ( ) No opinion

*** Should the Directive explicitly establish that all types of intermediaries can be injuncted?**

- ( ) Yes
- (•) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

Injunctions should be subject to an active involvement (responsibility/liability) of the intermediary in the infringement see Fox [2011] EWHC 1981 (Ch) at paras 157 - 158. This will enable compatibility with the proportionality principle in OJ/C 83/206 Protocol (No 2) on the Application of the Principles of Subsidiarity and Proportionality annexed to the TEU and TFEU.

*** Should the Directive explicitly establish that no specific liability or responsibility (violation of any duty of care) of the intermediary is required to issue an injunction?**

- ( ) Yes
- (•) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

As per the last response, in terms of proportionality, further to Fox [2011] EWHC 1981 (Ch) at paras 157 and 158, in order to obtain an injunction against any intermediary such a measure must be subject to an active involvement (responsibility/liability) of the intermediary in the infringement.

*** Should the Directive explicitly establish that national courts must be allowed to order intermediaries to take measures aimed not only at bringing to an end infringements already committed against IPR using their services, but also at preventing further infringements?**

- (•) Yes
- ( ) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

This has not only been recognised at the domestic level by the High Court in Fox [2011] EWHC 1981 (Ch) at paragraph 156 and also at the EU level by the CJEU in C-324/09 L'Oréal at paras 131-134.

*** In that respect should the Directive establish criteria on how preventing further infringements is to be undertaken (in the on-line context without establishing a general monitoring obligation under the E-Commerce Directive)?**

- (•) Yes
- ( ) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

At the domestic level, the UK courts have not yet set out criteria on how preventing further infringements is to be undertaken without imposing a general monitoring obligation under the E-Commerce Directive. In Fox [2011] EWHC 1981 (Ch) the court found that s.97A CDPA 1988 had to be understood and applied in line with the guidance given by the CJEU in C-324/09 L'Oréal:

'In my judgment the Court's reasoning demonstrates that the jurisdiction is not confined to the prevention of the continuation, or even repetition, of infringements of which the service provider has actual knowledge. On the contrary, an injunction may be granted requiring the service provider "to take measures which contribute to … preventing further infringements of that kind". Although such measures may consist of an order suspending the subscriber's account or an order for disclosure of the subscriber's identity, the Court of Justice makes it clear at [143] that these examples are not exhaustive, and that other kinds of measures may also be ordered'- Fox para 156.

*** Do you see a need for criteria defining the proportionality of an injunction?**

- (•) Yes
- ( ) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

There is a need for criteria. This could comprise firstly of defining what is understood by the adoption of 'strictly targeted' measures that serve to bring an end to a third party's infringement without thereby impacting users who are employing the provider's services so as to legally access inf

ormation see C-314/12 UPC [56]. There is also a need to know how users assert their rights once the injunctions adopted by ISPs are known see UPC at para 56. It would be useful to know what is meant by the reference in UPC (para 62) to measures having the effect of preventing access to infringing content or, at least, of making it difficult to attain and of seriously discouraging users to access such content. Likewise, it would be useful to know, further to the Advocate General's opinion see C-314/12 UPC [62] what is to be understood by the holding that among several appropriate measures, recourse needs to be have to the 'least onerous'. Details as to how the complexity, costs and duration of the measures is to be assessed per UPC, the Advocate General's opinion at 104, would also be useful. Lastly, if exceptional circumstances justify the blocking of unlawful material, how should internet intermediaries may be able to direct the measure to the material that is unlawful and avoid targeting individuals or institutions that are not the ones responsible for the unlawful publication and have not supported its content.

*** Do you see a need for a definition of the term "intermediary" in the Directive?**

- (•) Yes
- ( ) No
- ( ) No opinion

Please explain:

1,500 character(s) maximum

The term 'intermediary' in IPRED is unclear. The CJEU case-law has given some guidance in this respect. In line with the CJEU jurisprudence it is clear that intermediaries would include Internet Service Providers (see C-70/10 Scarlet and C-314/12 UPC); operators of online social networking platforms (hosting services) (C-360/10 Netlog); and operators of online auctions (hosting services) C-324/09 eBay. However, the CJEU found that in C-131/12 Google that search engines are to be considered 'data controllers' for the purposes of data protection. That CJEU approach contrasts with the opinion of both, the Advocate General in C-131/12 Google and the Article 29 Working Party, which consider that search engines are to be regarded as internet intermediaries. In this respect, some clarification would be welcome.

*** Do you see a need for a clarification on how to balance the effective implementation of a measure and the right to freedom of information of users in case of a provisional measure or injunction prohibiting an internet service provider from allowing its customers access to allegedly IPR infringing material without specifying the measures which that service provider must take?**

- (•) Yes
- ( ) No

- ○ No opinion

Please explain:

1,500 character(s) maximum

In general terms, there is a need for clarification on the individuals affected by the injunctions, the communications impacted by the injunctions, and the time taken by the injunctions. Moreover, as noted above, there is a need for criteria defining the proportionality of the injunction (see the answer three questions above).

*** Do you see a need for other amendments to the provisions on provisional and precautionary measures and on injunctions?**

- ◉ Yes
- ○ No
- ○ No opinion

Please explain:

1,500 character(s) maximum

See previous question.

C.2.5. Publication of judicial decisions

*** In your experience, do parties request in legal proceedings instituted for infringement of an IPR the decision to be published in full or in part?**

- ○ Yes
- ○ No
- ◉ Don't know

Please explain:

1,500 character(s) maximum

*** Are judicial decisions related to the enforcement of intellectual property rights publicly available in your jurisdiction?**

- ◉ Yes
- ○ No
- ○ Don't know

Please provide detail and reference:

1,500 character(s) maximum

There are generally available online.

* **Do you see a need for / added value in a more systematic dissemination of the information concerning the decision in legal proceedings instituted for infringement of an IPR?**

- ○ Yes
- ○ No
- ◉ No opinion

Please explain:

1,500 character(s) maximum

C.6. Other issues

Do you think that the existing rules strike the right balance between the need to effectively protect IPR and preventing IPR infringements and the need to protect fundamental rights including the right to respect for private life, the right to protection of personal data, the freedom to conduct a business as well as the freedom of information?

- ○ Yes
- ◉ No
- ○ No opinion

* Please explain:

1,500 character(s) maximum

To safeguard the proportionate use of the information for the identificati on of an infringer, State authorities should be required to ensure that in fringer monitoring is limited in scope, in time, and in the number of moni tored infringers State authorities should also be required to check and au thorize right holder evidence-gathering techniques and ISP retention and d isclosure regarding information about uploaders. As noted above, for reaso ns of proportionality with IPRED there should be clarification as to the i ndividuals affected, the impact and the length of the injunction.

* **Are there any other provisions of the Directive which, in your view, would need to be improved?**

- ○ Yes
- ○ No
- ◉ No opinion

* Please specify the relevant provisions and explain.

3,000 character(s) maximum

D. Issues outside the scope of the current legal framework

D.1. Specialised courts

* **Do you have in your jurisdiction dedicated courts, courts' chamber or judges specialised in IP matters?**

- (•) Yes
- ( ) No
- ( ) Don't know

* **Which rights were covered by the competence of the court?**

- [x] Copyright
- [ ] Community design rights
- [ ] National trademark rights
- [x] Patent rights (including rights derived from supplementary protection certificates)
- [ ] Rights of the creator of the topographies of a semiconductor product
- [ ] Sui generis right of a database maker
- [ ] Utility model rights
- [ ] Don't know
- [ ] Community trademark rights
- [ ] Rights related to copyright
- [ ] National design rights
- [ ] Geographical indications
- [ ] Plant variety rights
- [ ] Trade names (in so far as these are protected as exclusive property rights in the national law concerned)
- [ ] Other

Please specify:

500 character(s) maximum

* **Does legal action at a court specialised in IPR matters provide an added value compared to legal actions at other courts?**

- ( ) Yes
- ( ) No
- (•) No opinion

Please explain:

1,500 character(s) maximum

* **Please specify the added value:**

- [ ] Shorter proceedings
- [ ] Lower costs
- [ ] Build expertise
- [ ] Court proceedings more fit-for-purpose
- [ ] Other

Please specify:

500 character(s) maximum

D.2. Alternative procedures

* **In your view and with regard to civil litigation in the area of IPR enforcement do any of the following procedures provide an added value or alternative to court proceedings worth considering?**

at most 7 choice(s)

- [x] Fast track procedure
- [ ] Arbitration
- [ ] Mediation
- [ ] Fact-finding procedures
- [x] Online dispute resolution
- [ ] Cease and desist procedures
- [ ] Other

Please specify:

500 character(s) maximum

D.3. Other issues outside the scope of the current legal framework

* **Do you identify any other issue outside the scope of the current legal framework that should be considered in view of the intention to modernise the enforcement of IPR?**

- (•) Yes
- ( ) No
- ( ) No opinion

* Please specify:

3,000 character(s) maximum

IPRED needs to clarify to what extent monitoring by the private sector carried out to detect unlawful activity is legitimate when there is no previous involvement of State authorities.

E. Other comments

*** Do you have any other comments?**

- Yes
- No

* Please specify:

3,000 character(s) maximum

Useful links

Enforcement of intellectual property rights (http://ec.europa.eu/growth/industry/intellectual-property/enforcement/index_en.htm)

The Single Market Strategy (http://europa.eu/rapid/press-release_MEMO-15-5910_en.htm)

The Digital Single Market Strategy (http://europa.eu/rapid/press-release_MEMO-15-4920_en.htm)

Background Documents

[DE] Datenschutzerklärung (/eusurvey/files/6b3f6f9f-fbbc-41a1-8f2c-b9a758dd5b45)

[DE] Hintergrund (/eusurvey/files/d4a4dfac-6727-4f34-b5b9-fd9a4a35415d)

[EN] Background information (/eusurvey/files/d7d4225a-b4d3-4b88-ba51-ac199c2c5fbd)

[EN] Privacy statement (/eusurvey/files/bdb37dfc-4bb6-4b76-8e30-e29507d2b92d)

[ES] Antecedentes (/eusurvey/files/96ab9918-056e-49f8-bd56-025d50e98d74)

[ES] Declaración de confidencialidad (/eusurvey/files/0008481f-5985-434e-acee-a29247d96246)

[FR] Contexte (/eusurvey/files/e5215029-8bbc-4cd4-ad61-46a9ac967711)

[FR] Déclaration relative à la protection de la vie privée (/eusurvey/files/ae799bbe-6492-42e9-b9df-8a619da5bcd1)

[IT] Contesto (/eusurvey/files/7079e177-0398-489c-9ed3-8c1ffc5141c9)

[IT] Informativa sulla privacy (/eusurvey/files/66f8f74e-5e5f-40a9-ac30-230b52dc12d6)

[PL] Kontekst (/eusurvey/files/b243ed40-dd6d-411b-8b9c-00d1c533b87a)

[PL] Oświadczenie o ochronie prywatności (/eusurvey/files/1894672a-bff5-4032-bb88-5b5fe3cbb697)

Contact

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BILETA Response to EC Consultation on the Evaluation and Modernization of the Legal Framework for the Enforcement of IPRED

This is a collaborative submission from a group of academics based in the UK with expertise in Information technology law and related areas.
The preparation of the response has been funded by the British and Irish Law Education Law and Technology Association (BILETA http://www.bileta.ac.uk/Home/)
This response has been prepared by Dr. Felipe Romero Moreno (University of Hertfordshire) and Dr. James Griffin (University of Exeter).
It has been approved by the Executive of BILETA and is therefore submitted on behalf of BILETA

In addition, this response is submitted by the following individuals:

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