

WIPO Workshop on Building Respect for Intellectual Property for Members of the Judiciary

Michael Edenborough QC
Kingston, Jamaica
2 and 3 May 2019

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Topics to be covered

- 4: Copyright Piracy (45 mins)
- 6: Provisional Measures and Final Relief in Civil Proceedings (45 mins)

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Topic 4: Copyright Piracy

copyright ...

- copyright work
 - literary, artistic, music, film
- subsistence
 - qualification, not expired
- ownership – author, employer

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... piracy

- infringement
 - normally the whole vs a substantial part
- prohibited acts
 - copying
 - issuing copies to the public
 - communication to the public

piracy of works of art



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**Harry Potter ...
and Leopard walk up to Dragon**



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infringement: Temple Island Collections Ltd v New English Teas Ltd [2012] EWPC 1; [2012] FSR 9



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no infringement: Kerr v New Yorker Magazine Inc 63 F. Supp 2d 320 (SDNYU 1999)



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sports merchandising



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Klingon: copyright in a fictional language

- Star Trek: Axanar (*Paramount Pictures Corp v Axanar Productions Inc. 2:15-CV-09938-RGK-E*)



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communication to the public

- *Stichting Brein v Ziggo* Case C-610/15, 14th June 2017 (the *Pirate Bay* case)
- *Filmpeleer*, Case C-527/15, 26th April 2017
- sale of a multimedia player with pre-installed apps that allow access to protected works amounts to a communications to the public

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hyperlinking

- *GS Media* C-160/15
- hyperlinking to unauthorised content not a communication to the public, if
 - no financial gain
 - did not know illegal nature of the publication

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database of complaints

- The Lumen database of complaints and requests for removal of online materials
- *Google Inc* Case №. 18 W 826/17, 7th June 2017
- Higher Regional Court of Munich

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deterrent sentencing

- *R v Wayne Evans*
- [2017] EWCA Crim 139
- [2017] 1 Cr App R (S) 56
- 7 factors relevant to sentencing
 - usually custodial

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Related Rights

- designs – registered / unregistered
- performance / recording rights
- moral rights
- database rights
- data protection

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Topic 6: Provisional Measures and Final Relief in Civil Proceedings

main types of relief that are available

- injunctions
- declarations
- financial relief
- legal costs and expenses
- disposal, destruction, forfeiture
- disclosure
- miscellaneous

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preliminary considerations: jurisdiction

- jurisdiction
 - subject matter
 - parties
 - first seized / stays
 - geographical

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preliminary considerations: interim vs final

- interim remedies discretionary
 - balance of justice / injustice
 - preservation of the *status quo ante*
 - aid resolution of dispute
- final remedies
 - some discretionary, some as of right
 - all must be exercised judicially

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Injunctions

- mandatory / prohibitory
- interim / final
- special forms
 - freezing orders of assets
 - preservation of evidence / search orders
 - anti-suit
 - *ne exeat regno*

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trading premises

- relief against landlords who rent premises to vendors selling pirated or counterfeit goods without the necessary licences
- Case C-494/15 *Tommy Hilfiger*: injunction against the landlord to stop leasing to TM infringers

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intermediaries

- Case C-484/14 *McFadden*
 - mere intermediary service provider not liable
 - but may be enjoined or forced to impose a password to prevent future infringement
 - cannot be forced to monitor the traffic
- *FAPL v BT* [2017] EWHC 480 Ch, 13 Mar 17
 - injunction to stop a streaming service

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blocking injunctions

- *Cartier v BSB* [2018] UKSC 28, 13 June 18
 - an ISP may be enjoined to block a site infringing trade marks (or copyright)
 - the ISP should be indemnified for the costs of implementing the order

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Declarations

- **infringement / non-infringement**
- **validity / invalidity**
- **ownership**

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Financial

- enquiries as to damages
 - compensate the CI for loss and damage
 - lost sales
 - lost licence fee
 - royalties
- additional or exemplary damages
- account of profits
 - deprive the Df of unjust enrichment
 - apportionment

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types of damages

- statutory fixed damages
- tortious damages for loss and damage suffered
 - foreseeable, causative, not excluded
- additional / exemplary damages
 - additional fine for nefarious behaviour
- but innocent infringement
 - no damages / injunction in certain cases

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tortious damages

- compensatory not penal
- burden of proof upon the wronged party to prove its loss and damage, *e.g.* lost sales
- irrelevant that wrong-doer could have competed lawfully
- rough and ready approach
- often results in under compensation

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collateral loss and damage

- convoyed goods and services
- spring-board / bridgehead losses
- loss to a subsidiary, claimed by parent
- reputational loss and damage

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account of profits

- to deprive the wrong-doer of its unjustified enrichment
- causation
 - which profits attributable to the infringement?
- what can be set-off?
 - fixed / variable overheads

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Legal Costs and Expenses

- none
- fixed: Case C-57/15 *United Video Properties*
- scale costs
- standard basis
- indemnity basis
- wasted costs
- *pro bono* costs
- experts' costs and other disbursements
- official costs, e.g. court fees

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Disposal

- infringing goods
 - issue of title to the goods / third parties' interests
 - delivery-up
 - destruction
 - forfeiture
- non-infringing goods
 - labels, tags, dust covers
 - printing dies, computer files
 - dedicated machinery

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Disclosure

- pre-action disclosure
 - against a prospective Df
 - to seek information about a prospective Df
- final, e.g. suppliers and customers

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Miscellaneous

- erasure of infringing sign
- appointment of receiver – confiscation of assets
- publication orders
- constructive trusts
- certificate of contested validity of a trade mark
- preserving confidential information
 - *in camera* hearings
 - redacted judgments / super injunctions
 - sealed evidence

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- MA (Natural Sciences) (Cantab)
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- All areas of IP law and practice, in particular trade marks and passing-off, copyright and designs, and patents and confidential information.

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