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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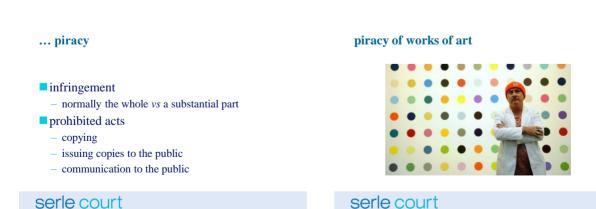
Topics to be covered

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

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copyright ...





Harry Potter ... and Leopard walk up to Dragon



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infringement: Temple Island Collections Ltd v New English Teas Ltd [2012] EWPCC 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)
- *Filmpeler*, 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 sentencingRelated Rights• R v Wayne Evans• designs - registered / unregistered• [2017] EWCA Crim 139• performance / recording rights• [2017] 1 Cr App R (S) 56• database rights• 7 factors relevant to sentencing
- usually custodial• designs - registered / unregisteredSerle courtserle court

main types of relief that are available

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

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Topic 6: Provisional Measures and

Final Relief in Civil Proceedings

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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 injuncted 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 injuncted 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 Cl 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
- tortous 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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tortous 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
- destructionforfeiture
- Ionenure

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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