

Bird & Bird

Copyright enforcement – remedies and Courts

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Remedies

Damages

- Financial compensation
- Legal remedy as of right
- Compensatory and Punitive

Equitable Remedies

- Discretionary
- Financial compensation not enough



Interim vs Final Remedies for ©

Interim Relief

- Interim (interlocutory) Injunction
- Disclosure orders (e.g. Norwich Pharmacal orders)
- Freezing (*Mareva*) Injunctions
- Search and Seizure (*Anton Pillar*) orders



Final Relief

- Damages
- Delivery up
- Seizure of Infringing articles
- Forfeiture
- Declaration
- Final Injunction
- Publicity orders

Compensation – How much?

Election - damages v account of profits

1. Damages - just loss of C's profits?

Blayney v Colgau

2. No - “user principle”

Copyright usually exploited by licence – normal licence fee applied

Copyright not usually exploited by licence – right holder must show evidence to guide the court as to measure of loss/applicable royalty

OR

3. Account of Profits



Absolute vs Artisan (IPEC)

Unauthorised use of loft conversion photos...

- Absolute not in the business of selling photographs
- Technically no loss to Absolute
- Artisan purchased alternative stock images for £300

Compensatory Damages = £300



Absolute vs Artisan (IPEC) ctd.

Punitive Damages

Additional Damages (flagrancy)

(s.97(2) Copyright, designs and patents act 1988)

- Flagrancy of Infringement; and
- Any benefit accruing to the defendant by reason of infringement.

Punitive Damages = £6,000

Injunctions



Interim

- Just and convenient (s.37 Senior Courts Act 1981)

American Cyanamid Test

1. Serious issue to be tried
2. Balance of convenience
 - i. Would damages be an adequate remedy?
 - ii. Cross-undertaking in damages adequate?
 - iii. Any "special factors" to consider?

Procedure

*Civil Procedure Rules,
Practice Direction 25A*

- Application to court
- With or without notice
- Possible out of hours
- Witness statement in evidence
(Affidavits for freezing injunctions and search orders)

Injunctions



Final

Granted at the end of trial

- Copyright established and infringed
- Is there an ongoing threat?

Enforcement

Breach of order = Prison
Seizure of assets
Fines



Site Blocking Injunctions

s. 97A Copyright, designs and patents act 1988

Protection for intermediary Information Society Service Providers (ISS)

- "Mere conduits"
- Caches
- Hosts of information

*E-Commerce Directive (2001/31/EC); and
E-Commerce (EC Directive) Regulations 2002*

BUT

Site Blocking Injunctions – Key tool against online © infringers via ISPs (*s.97A CDPA 1988, Newzbin 2*)

- Copyright is being infringed
- ISP's services are being used to infringe copyright
- Where ISP has knowledge of the infringement
- Rights holder likely to have to pay the cost of the site blocking injunction (*Cartier v British Telecommunications*)

Other quirks ...

- No unjustified threats
- No need to register © to obtain remedies (c.f. USA)



References

Blayney (t/a Aardvark Jewelry) v Clogau St. David's Gold Mines Ltd & Ors, Court of Appeal - Civil Division, July 16, 2002, [2002] EWCA Civ 1007

Absolute Lofts South West London v Artisan Home Improvements [2015] EWHC 2632 (IPEC)

American Cyanamid Co (No 1) v Ethicon Ltd [1975] UKHL

Twentieth Century Fox Film Corporation and others v British Telecommunications plc [2011] EWHC 2714 Ch (Newzbin 2)

Cartier International AG and others v British Telecommunications Plc and another [2018] UKSC 28

Parallel court systems - overview

Civil v
Criminal

Civil

Copyright infringement

- Reproduction
- Public performance
- Communication to the public
- Distribution
- etc.

Criminal

Copyright offences

- Business use,
- of infringing copy,
- with knowledge/reason to believe infringing.
- Directors of companies can liable

Parallel court systems - overview



Civil v
Criminal

Civil

Normal IP
remedies

Criminal

- Imprisonment for up to 10 years
- Unlimited fine

Parallel court systems – procedure

Civil v
Criminal

Civil

- Enforced through civil litigation by rights owner
- Usually heard by specialist Judge

Criminal

- Enforced through criminal prosecution by Trading Standards (or private prosecution)
- Tried by criminal Judge + jury

Criminal Prosecution - example

R v Wayne Evans [2017] EWCA Crim 139

- WE operated free (unlicensed) music download service
- Over 600,000 downloads made, no profit by WE
- Sentenced to 12 months' imprisonment, upheld by Court of Appeal
- Court stressed importance of deterrence in sentencing
- Unless activity is very amateur, minor or short-lived, immediate custodial sentence likely to be appropriate

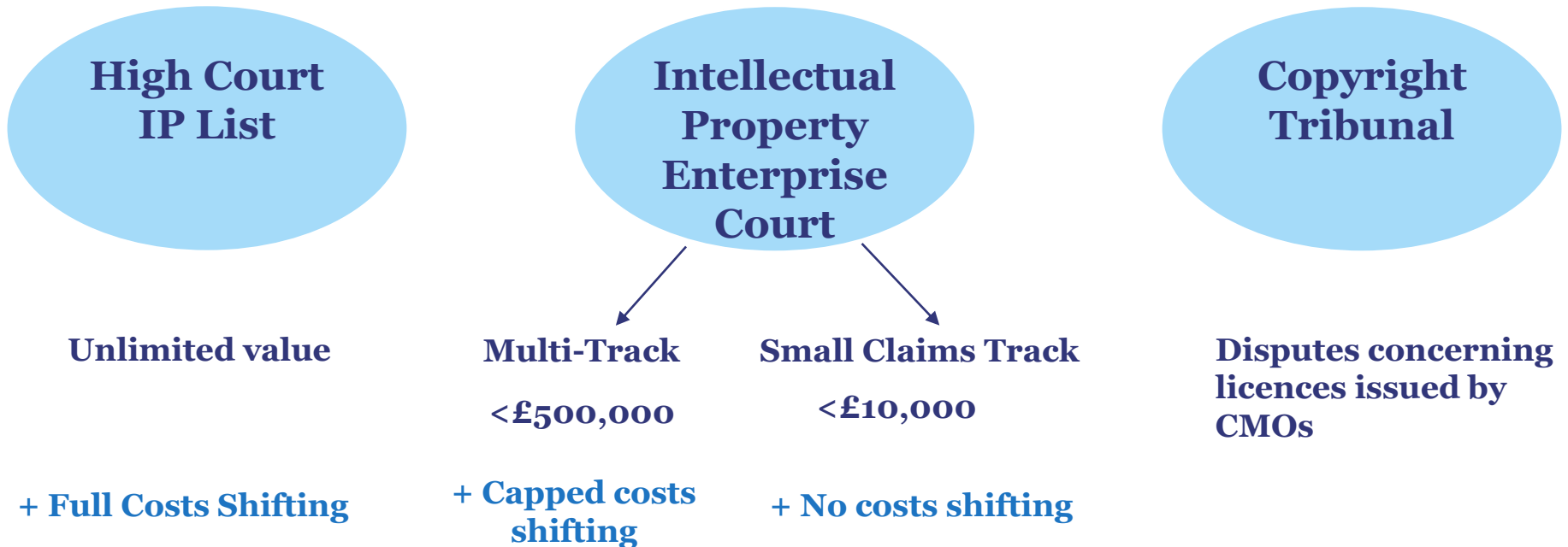
Alternative criminal route - PIPCU

The Police Intellectual Property Crime Unit

- Mission – 'to deter serious and organised IP crime'
- Focus on counterfeit goods and digital piracy
- Operation Creative:
 - Partnership with UK ad industry & rights holders
 - Websites reported for © infringement
 - PIPCU evaluation
 - Warning given
 - Suspension of site, advert replacement, infringing website list

Civil Court system

3 specialist Courts



High Court IP List

- Primary Court for IP claims
- Most cases heard by specialist IP Judges (former barristers)
- Trials of any length, most often 3 days – 2 weeks



Sir Richard Arnold



Sir Colin Birss



The Hon. Mr Justice Meade



The Hon. Mr Justice Mellor

IPEC

Multi Track

- Heard by His Honour Judge Hacon, or a Deputy Judge
- Costs capping
- Typically:
 - Trial < 2 days
 - Little/no expert evidence
 - Little cross-examination



Anatomy of a claim

Warner/Sony v Tune-In

- Letter before action *March 2017*
- Claim issued *November 2017*
- 'Pleadings' close end *Jan 2018*
- Costs budgets prepared for Case Management Conference, heard *May+June 2018* – trial to be based on a sample
- Disclosure *September 2018* (D discloses 13,000 docs)
- Witness Statements *December 2018*
- Trial *May 2019* (5 days, 8 witnesses in total)
- Second trial *September 2019* (not usual!)
- Judgment *December 2019*
- Court of Appeal hearing *February 2021*
- Court of Appeal judgment *March 2021*
- Petition to Supreme Court *filed April 2021*

ANY QUESTIONS?

Thank you & Bird & Bird

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