

WIPO Regional Seminar
Combating the spread of pirated
products: experience and prospects

Michael Edenborough QC
Issyk Kul, Kyrgyz Republic
23-24 June 2016

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Topics to be covered

- 6: recent jurisprudence on copyright
- 10: recent developments in judicial remedies
- 13: alternative dispute resolution

Topic 6
recent jurisprudence on copyright

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Infringement of video clips

- *England and Wales Cricket Board v Tixaq Ltd* [2016] EWHC 575 (Ch), Arnold J
- use of 8 second video clips of TV broadcasts
- reporting defences did not avail Dfs

Copyright in compilations

- usually involve much work, but often with little or no literary contribution
- often very valuable and misappropriated
- *Global Yellow Pages v Promedia Directories Pte Ltd* (Singapore, [2016] SGHC 9, 28 Jan 16)
 - rejects mere sweat-of-the-brow effort
 - requires some creativity or intellectual effort

Open access Wi-fi

- *McFadden* C-484/14
- AG's Opinion 16 Mar 16
- free, public wi-fi provider not liable for copyright infringement
- but may be enjoined

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Hyperlinking

- *GS Media* C-160/15
- AG's Opinion, 7th April 2016
- hyperlinking to unauthorised content not an infringement
- not a communication to the public

Communication to the public

- *Reha Training* C-117/15, 31st May 2016
- Info Soc Dir art. 3(1) and Rental and Lending Rights Dir art. 8(2) to be construed the same
- requires:
 - new public
 - transmission

Klingon: copyright in a fictional language

■ Star Trek: Axanar



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digital rights management (DRM)

- obscurity is a greater threat than piracy
- organised wholesale copying vs file-sharing by enthusiasts
- Tim O'Reilly of O'Reilly Media: “Give the wookie what he wants”: multi-media, free access to redundant material, fair price

Topic 10
recent developments in judicial remedies

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conventional remedies

- damages
- injunctions – interim and final
- declarations
- delivery-up / destruction
- litigation costs
- information about trade channels
- speedy trials / summary relief

more advanced remedies

- pre-action disclosure
 - against a prospective Df
 - to seek information about a prospective Df
- search and seizure
- freezing assets
- confiscation of assets
- preserving confidential information

other causes of action

- health and safety – especially for pharmaceutical / medicinal products, but also car parts and the like
- labelling and misleading advertising
 - consumer protection
- fraud and money laundering, tax avoidance
- employment laws

trans-shipment

- customs and border controls
- goods legal in country of origin and country of destination, but not legal in transit country
 - free trade zones

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trading premises

- relief against landlords who rent premises to vendors selling pirated or counterfeit goods without the necessary licences
- Louis Vuitton successful in the USA, but not Australia
- usually need guilty knowledge of the landlords – put on notice

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preparatory acts

- labels, dust covers
- printing dies, computer files
- dedicated machinery

internet issues

■ ISPs

- safe haven – subsequent knowledge
- geo-blocking
- transfer of domain names (and all passwords)
- take down of whole sites

■ suspending particular contributors / members within a given site

Topic 13

alternative dispute resolution

Differences from Judicial Proceedings

- must involve at least two parties
- consensual
- confidential
- procedural
- different relief

Consent

- courts have jurisdiction over the parties
 - *in rem* or *in personam*
- ADR has varying degrees of consent, *e.g.*:
 - arbitration – bound by decision
 - mediation – have to agree to decision

Confidentiality

- court hearing and judgments are usually open for all to see – limited exceptions:
 - hearings (or parts) in private
 - redacted judgments
- ADR normally confidential:
 - process
 - relief
 - very existence

Process

- court procedure determined by its rules
- ADR very variable, *e.g.*:
 - akin to court procedure: *e.g.* arbitration
 - mediation – simplified process
 - facilitative
 - evaluative
 - negotiation – completely informal, no adjudicator
 - toss of a coin

Remedies

- court bound by legislation
 - can affect public records
- ADR private *vs* public enforcement:
 - cannot affect public records directly
 - undertaking *vs* injunctions
 - no declarations *in rem*
 - not bound by national boundaries
 - other solutions possible

Other points

- expert determination
 - particularly useful in keeping confidential each parties' evidence from each other
- in parallel with court proceedings
 - first instance / on appeal
- settlement agreements
 - enforceability / illegality
 - registration

Michael Edenborough QC

■ Contact Details:

- Serle Court, 6 New Square, Lincoln's Inn, WC2A 3QS, UK
- (t) + 44 (0)20 7242 6105
- (e) MEdenborough@SerleCourt.co.uk

■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon).

■ All areas of intellectual property law and practice, in particular trade marks, copyright and designs, and patents. Mainly appellate work or problems.

■ Appeared before the General Court and Court of Justice of the European Union (Luxembourg), and in the European Patent Office (Legal and Technical Boards of Appeal and Opposition Division) (Munich). Acted for the UK Comptroller-General of Patents, the UK Registrar of Trade Marks, the UK government and AIPPI UK Group.