



IP ITeasers 032:

Update on the risks of using online platform takedown procedures

This week's IP ITeaser is written by [Stephanie Wickenden](#) entitled "**Update on the risks of using online platform takedown procedures**":

Each of the major social media platforms, as well as online marketplaces, have an IPR takedown procedure. Links to the major platforms' policies have been helpfully collected by [DACS](https://bit.ly/2wmolkj) (<https://bit.ly/2wmolkj>). Unless disputed, a takedown request usually results in the material complained of being taken down without any further investigation. Takedown processes are a swift and valuable way for rights holders address infringement, however they are not risk-free as emphasised by two recent judgments.

In *Shenzhen Carku Technology Co Ltd v Noco Co* [2022] EWHC 2034 Meade J found that a takedown notice sent to Amazon by the Claimant in respect of the Defendant's products amounted to an unjustified threat under s.70 of the Patents Act 1977, where that patent was found to be invalid. This case provides helpful clarification on what constitutes a "communication" and "threat of proceedings" for the purposes of a statutory unjustified threats in the context of takedown notices (see paras 222-255).

HHJ Hacon recently considered takedown notices in respect of unregistered rights in *Costa v Dissociadid Ltd* [2022] EWHC 1934. The Claimant obtained the removal of some of the Defendants' videos from YouTube by claiming that he was a joint author of material included in them. The contested material was removed from a number of the Defendants' videos which remained on YouTube before they too were taken down on the basis of the original

objections. With no statutory provision for unlawful threats in copyright, the Defendants counterclaimed with the tortious allegation of causing loss by unlawful means. HHJ Hacon found that the Claimant's failure to withdraw the allegation that the videos contained the contested work, after he became aware it had been removed from at least some of those remaining, was found to be a deceit against YouTube. This provided the "unlawful" element required for the tort. A distinction was made as to the allegation of joint authorship per se as, whilst the claim turned out to be false, it was honestly made.

Claiming infringement of copyright, unregistered designs and passing off has traditionally been associated with far less risk given the lack of statutory unjustified threats provisions. However, *Costa V Dissociadid* should act as a stark reminder that unregistered IPR owners and their representatives that they are not immune from the risks of using online takedown procedures.

[John Eldridge](#) acted for the Claimant and [Thomas Elias](#) acted for the Defendants in *Costa v Dissociadid Ltd*.