

**ONLINE COPYRIGHT INFRINGEMENT:  
A CRITICAL ASSESSMENT OF THE EU AND UK APPROACHES TO THE CONCEPT OF  
“COMMUNICATION TO THE PUBLIC”**

By  
*Emma Nwagboo*

**I. INTRODUCTION:**

The internet is one of the most interesting and life changing events that occurred from the late 20<sup>th</sup> to the early 21<sup>st</sup> century.<sup>1</sup> It introduced a new and faster means of communication, trade and commerce and a swifter way of dispensing information.<sup>2</sup> The DNA of the internet is such that it almost replicates the physical world.

While the internet is celebrated for its new innovative means of commerce, information and communication, it also poses challenges for several concepts that had never been contemplated before: people’s privacy and intellectual properties (example, copyright). According to the Recording Industry Association of America (RIAA), the people’s preference in CDs declined from 940 million in 2000 to 615million in 2006.<sup>3</sup>

Over the years, there have been attempts by successive governments and policy makers to reform copyright regimes to accommodate the continuously changing technological innovations and for a better protection of right holders. The Judiciary, both at State and regional levels have equally shielded the right holders by its continuous interpretation of the available legislative instruments. However, there may be some loopholes in both the legislative and the judicial approaches to the control of copyright infringement on the internet (especially the already traditional non- service and non- joinder of the website operators to proceedings which is a threat to fair hearing). *The Pirate Bay* case lays the foundation for this criticism as will be discussed later in the essay.<sup>4</sup>

The first time a case on the copyright status of a website was entertained in court anywhere in the world was in 1996 in *Shetland Times Ltd v. Wills*.<sup>5</sup> It was the first time a court was faced with the responsibility of determining whether a heading of a body of a literary work qualifies as a distinct literary work, and also whether a website constitutes ‘cable programme’ under the then Copyright Designs and Patent

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<sup>1</sup> Andy Murray, *Information Technology Law*, (4<sup>th</sup> edition, Oxford University Press, 2019) 274

<sup>2</sup> *ibid*

<sup>3</sup> Xigen Li et al., ‘Deterrence Effect of Four Legal and Extralegal Factors on Online Copyright Infringement’ (2009) *Journal of Computer-Mediated Communication* Vol. 14 Issue 2, 308

<sup>4</sup> Poorna Mysoor, ‘A Pirate too needs to be heard: Procedural Compromises in Online Copyright Infringement Cases in the UK’ (2014) *Molecular Diversity Preservation International (MDPI) Journal*, 3, 560.

<sup>5</sup> (1997) SC 316.

Act.<sup>6</sup> In his wisdom, Lord Hamilton who made an interim ruling in favour of the claimant said,

*"However, in the light of the concession that a headline could be a literary work and since the headline in issue involves eight or so words designedly put together for the purpose of imparting information, it appears to me to be arguable that there was an infringement, at least in some instances, of s. 17."*<sup>7</sup>

Lord Hamilton would be criticised for extending the meaning of cable programme to cover a website.<sup>8</sup> The critics argued that the cable programme is a push media system where the service provider controls what the subscriber receives while a website is a pull media system where the subscriber controls the contents to receive.<sup>9</sup>

This case opened the first window of opportunity for copyright holders to challenge the infringement of their rights on the internet, especially in cases of web-linking. However, there has been a shift from the decision in the Shetland case in subsequent court decisions across other countries. The Federal Court of Germany in *Verlagsgruppe Handelsblatt GmbH v. Paperboy*,<sup>10</sup> held that copyright infringement does not arise where the contents of a copyright material are made available through hyperlink, either by way of ordinary links or deep links, more so, where the copyright owner makes available his work on the internet without any technological means of protecting same work.

In *Home A/S v. Ofir*,<sup>11</sup> the Danish court found in favour of Ofir, that the mere deep linking to Home's database does not amount to any copyright infringement under the Danish Law on copyright. Furthermore, this court addressed that web linking is a service rendered by providers to facilitate the ease of searches on the internet and helps in exchanging very incredible information.<sup>12</sup>

These three decisions from three different jurisdictions reveal the evolution of online copyright infringement and how it has been viewed over the years. Shetland's case sets the precedence for every internet copyright case today.<sup>13</sup> Even though Lord Hamilton unsuccessfully tried to classify websites as cable programme, right holders

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<sup>6</sup> The S.20 of the Copyright Designs and Patent Act has been rewritten and introduced by *The Copyright and Related Rights Regulations 2003 (SI 2003/2498)*.

<sup>7</sup> (n 2) 319

<sup>8</sup> Andy Murray (n 1) 277.

<sup>9</sup> *ibid*

<sup>10</sup> (2005) ECDR 7.

<sup>11</sup> This is a 2006 unreported case before the Danish Maritime and Commercial Court. Discussed in Andy Murray (n5) 279.

<sup>12</sup> Murray (n 5) 279

<sup>13</sup> *ibid*

were conscientized of the availability of copyright on the internet space.<sup>14</sup> It was the start of a new era on copyright.

This essay will focus on the attitude of the European Union (EU) as a regional umbrella and that of the United Kingdom (UK) towards copyright infringement online by critically examining the available legislative instruments and court decisions. The notion, "Communication to the public" has been at the centre of many court decisions in the UK, like *Football Association Premier League v. QC Leisure*<sup>15</sup>. This essay will consider the judicial definition of communication to the public under the EU and UK copyright regimes. Furthermore, it will also consider the opinions of scholars on the already judicially and legislative accepted absence of the website operators and users from the proceedings, while also examining some notable judicial decisions that have contributed to this- consequently buttressing the point.

## II. THE NOTION: COMMUNICATION TO THE PUBLIC

In an effort to control peer to peer (P2P) file sharing, the UK came up with the Digital Economy Act (DEA) of 2010.<sup>16</sup> However, this Act has been replaced by the new DEA 2017 which substantially moved away from the 2010 Act provisions. Section 32 of the 2017 Act amends section 107 of the Copyright Designs and Patent Act (CDPA) 1988 by extending the criminal liability for online copyright infringement from two years to ten years.<sup>17</sup> Also, the prejudicial effect of the CDPA is replaced with "loss" and "gain" under the DEA 2017.<sup>18</sup> The new requirement by the Act is that the accused has *knowledge* of the infringement or has *reason to possess the knowledge* of the infringement. What this means is, an infringement occurs when a person with intention to make gain for himself or for another, knowingly *communicates to the public* a copyright material without the knowledge of the original owner, thereby causing risk or loss to the original owner (emphasis supplied by me).<sup>19</sup>

When can a work be said to be communicated to the public? There have been both UK and EU judicial approach to this issue. Communication to the public remains one of the exclusive rights of copyright owners "that have been harmonised by the Information Society (InfoSoc) Directive 2001/29/EC as was established in 2006 case C-306/05, *Sociedad General de Autores y Editores de Espana (SGAE) v Rafael Hoteles*,

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<sup>14</sup> *ibid*

<sup>15</sup> (2008) EWHC 1411 (Ch); [2008] 3 C.M.L.R. 12

<sup>16</sup> Robin Mansell et al., 'Copyright Infringement online: The case of the Digital Economy Act judicial review in the United Kingdom' (2013) Sage Journals, 3.

<sup>17</sup> DEA C.30 (2017) Section 32 (3)

<sup>18</sup> Scott Flannigan, 'Digital Economy Act extends online copyright infringement penalties' (2017)

<<https://andersonstrthern.co.uk/news-insight/digital-economy-act-extends-online-copyright-infringement-penalties/>>last assessed 4<sup>th</sup> January, 2020. Scott analyses the loss and gain approach of the new DEA in determining the criminal liability of the accused infringer.

<sup>19</sup> DEA C.30 (2017) section (32)(2)

ECLI:EU:C:2006:764.”<sup>20</sup> Even though the Directive does not give an explicit definition of ‘communication to the public’, the notion must receive “an autonomous and uniform interpretation” in every EU country.<sup>21</sup> The Court of Justice of the European Union (CJEU) has entertained some notable cases on the notion.

In *Svensson and others v Retriever Sverige AB*,<sup>22</sup> Retriever, a Swedish company operating a website uses hyperlink to make articles from other websites available to its subscribers. Svensson and other journalists brought an action for online copyright infringement against Retriever for making available to the users, hyperlinks to journalists’ articles without authorisation. When the case came before the CJEU for preliminary ruling by the Svea Court of Appeal, four questions came up for consideration:

1. Whether anyone other than the owner of a work who provides links to a copyright work on his website, “communicates the work to the public” within the intent of Article 3(1) of Directive 2001/29/EC?
2. Whether the consideration in question one is affected if the copyright work to which a link is provided for is put on a website that can be freely assessed by anyone with no restriction by the owner?
3. Whether there should be a change in the (1) if there is a difference where the link when clicked on, leads the user to another website and where the link simply opens on the same website?
4. Finally, whether member states can give a broader protection to right holders by allowing the notion of communication to the public to cover more than what is intended under the Article 3(1) of Directive 2001/29/EC?

Addressing questions one to three in its ruling, the court considered that if the provision of hyperlinks to protected works amount to communication to the public, then such a communication may need the authorisation of the rights holder. The court further held that the hyperlink provided by the website has to be assessable to a large number of people to be able to constitute ‘public’. What then is *public*? The court defines public to mean *a new public*. In other words, a public not envisaged by the right holder when authorising the original communication of the copyright work to the public. The court in its judgement, found that the defendant did not communicate the works to a new public not envisaged by the claimants. The court further held that member states have no power to expand the protection under Directive 2001/29/EC.

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<sup>20</sup> Christina Angelopoulos, ‘Communication to the public and accessory copyright infringement’ (2017) Cambridge Law Journals Vol 76, pp 496-499

<sup>21</sup> *ibid*

<sup>22</sup> C466/12

In a more recent case, *StichtingBrein v Ziggo BV and XS4ALL Internet BV*,<sup>23</sup> the case concerned The Pirate Bay website (TPB). Stichting, a Dutch company brought an application for injunction before the Dutch court against service providers, Ziggo and XS4ALL, to block users' access to the file sharing website, TPB. The Dutch Supreme Court went further to hold that before such an injunction can be granted, there is need to determine if the third party (TPB) is guilty of an infringement. Can it be said that TPB communicated a protected work to the public?

The case was referred to the CJEU for consideration. In its ruling, the court pointed out that the first thing to determine was whether there was an actual communication to the public by TPB. The court found that there was no way the operators of TPB were not aware of the links provided by peers in their website which were in infringement of copyright. Therefore, TPB did communicate the work to a *new public* that was not considered by the right holder when the authorisation for the first communication to the public was made or, TPB did communicate the work to the public through a new technical means not envisaged by the right holder at the initial authorisation.

These cases clearly illustrate the EU judicial approach to the right of communication to the public. It need be noted that there is a clear difference between the two cases. While the contents to which hyperlinks were provided for in Svensson's case were legal content,<sup>24</sup> that was not the case in Ziggo's case. The links on TPB's website were infringing copyrights of the owners. It is equally clear that the operators of the TPB were aware of the activities on their website. According to the CJEU, the website index categorised the uploaded infringing works based on their genres and popularity, while also checking the appropriateness of the songs in the categories.<sup>25</sup> On this, TPB operators played a very noticeable part in the infringements on their platform.<sup>26</sup>

The section 97A of the CDPA avails copyright holders with the opportunity to apply to the High Court for an injunction against any service provider who is in "actual knowledge" of an ongoing infringement on its platform in the UK.<sup>27</sup> This section of the Law operates under the authority of the Article 8 of the InfoSoc Directive. By the Regulation 2 of the Electronic Commerce Directive (ECD) 2002, a 'service provider' is

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<sup>23</sup> C-610/15

<sup>24</sup> Mysoor (n 3) 570

<sup>25</sup> Jan Bernd Nordemann, 'Recent CJEU case law on communication to the public and its application in Germany: A new EU concept of liability' (2018) *Journal of Intellectual Property Law and Practice* Vol. 13 No. 9, 746

<sup>26</sup> *ibid*

<sup>27</sup> *Copyright Designs and Patent Act 1988 C.30, S 97A, introduced by the Copyright and Related Rights Regulation 2003 (SI/2498).*

any person providing an information society service.<sup>28</sup> Information society service on the other hand is any service provided for a fee, by any electronic machine for the storage and processing of data and upon being requested by a receiver of the service.<sup>29</sup>

In order to determine if the service provider has “actual knowledge” of the alleged infringement under section 97A, consideration should be made to the relevant circumstances. This includes whether the right holder officially notified the service provider about the infringement by ‘another person’ and if the notice reveals enough evidence that will enable the service provider to identify the right holder and the details of the notification.<sup>30</sup>

Summarily, there are three important elements to consider under s. 97A before an injunction can be granted: service provider, actual knowledge and actual person.<sup>31</sup> Surprisingly, section 97A does not explain who an actual person is. However, an actual person in the intent of the section should mean ‘a third party’ since section 97A is operating on the authority of the Article 8(3) of the InfoSoc Directive.<sup>32</sup>

### **III. INJUNCTIONS TO STOP INFRINGEMENTS AND TO PREVENT FUTURE INFRINGEMENTS**

EU courts have been conscious of stopping not only an existing infringement, but also preventing future infringements. This was the question before the CJEU in *L’Oreal v eBay*.<sup>33</sup> The High Court of England and Wales referred the case to the CJEU to determine whether the provision in Article 11 of Directive 2004/48/EC<sup>34</sup> (The Enforcement Directive) empowers the courts to grant injunctions not only to repress existing infringements, but also to control any likely infringement in the future. According to the CJEU, the purpose of the injunctions in the first sentence of the Enforcement Directive differs in effect from the ones in the third sentence of the Directive. The first sentence seeks to address future infringements, while the third sentence seeks to address the more complicated position of intermediaries who owe their services to users to infringe the intellectual property rights of applicants.<sup>35</sup> It should be noted that while Article 8(3) of the InfoSoc Directive applies to copyright

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<sup>28</sup> *Electronic Commerce (EC Directive) Regulations 2002 No. 2013, Regulation 2.*

<sup>29</sup> *ibid*

<sup>30</sup> Mysoor (n 3) 556

<sup>31</sup> *ibid*

<sup>32</sup> *Information Society Directive 2001/29/EC, Art. 8(3)*

<sup>33</sup> *L’Oreal SA and Others v. eBay International AG and Others, C-320/09 EU: C:2011:474.*

<sup>34</sup> Directive 2004/48/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

<sup>35</sup> Eleonora Rosati, ‘Intermediary IP injunctions in the EU and UK experiences: when less (harmonisation) is more?’ (2017) *Journal of Intellectual Property Law and Practice* Vol. 12 No. 4, 340

holders, Article 11 of the Directive 2004/48/EC applies to every case of intellectual property right.

#### IV. THE COSTS OF INJUNCTIONS

The wordings of Directive 2001/29/EC suggest that the intermediaries may take pre-emptive measures to stop third parties from using their platforms to infringe on the rights of others.<sup>36</sup> This can be read in parallel to Arnold J's undertaking in *Cartier v BskyB*<sup>37</sup> (although not a copyright case, but was decided based on the legislative principle in s. 97A of CDPA). The Judge noted that the position of Recital 59 in the preamble to the InfoSoc Directive suggests that it is economically efficient to grant injunctions against intermediaries because they are *lowest cost avoiders* of infringement.<sup>38</sup> So, it is more logically acceptable for intermediaries to take actions to prevent intellectual property rights infringements on their platforms than it is for rightholders to take direct actions against individual infringers.<sup>39</sup> This is without prejudice to other available sanctions and remedies to the rightholder against the infringer.<sup>40</sup> Going by this, intermediaries will take proactive measures like installation of filtering systems to take down infringing materials from their platforms. Recital 59 to the InfoSoc directive intimates the intermediaries with the responsibility of bringing infringing activities that occur on their platforms to an end. In the exact phrase used in the recital, intermediaries are "best placed" to stop such infringements.

However, UK Supreme Court held in *Cartier's* case,<sup>41</sup> that domestic law requires that innocent intermediaries should bear no costs for implementing the court injunctions. This is because, neither Directive 2001/29/EC, Directive 2004/48/EC nor CJEU decisions (notably the decision in *L'Oreal's* case) specifically lay down the guidance on how to allot costs of intermediary injunctions.<sup>42</sup> According to Lord Sumption, the order could have been made based on the ordinary principles of equity and not from the power derived from the European Law.<sup>43</sup> It is therefore a matter of individual member States to determine on how the costs should be distributed. This is

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<sup>36</sup>F Rizzuto, 'The Liability of online intermediary service providers for infringements of intellectual property rights' (2012) CTLR vol 18, 11

<sup>37</sup>*Cartier International AG and Others v. British Sky Broadcasting Limited and Others* (2014) EWHC 3354 (Ch).

<sup>38</sup>Rosati (n 32) 340

<sup>39</sup>ibid

<sup>40</sup>Eleonora Rosati, 'UK Supreme Court holds that intermediaries have to bear no costs of injunctions against them' (2018) Journal of Intellectual Property Law and Practice Vol. 13 No 12, 933-935

<sup>41</sup>*Cartier International AG and Others v British Telecommunications Plc and Anor* (2018) UKSC 28.

<sup>42</sup>Rosati (n 37)

<sup>43</sup>*Cartier* (n 38) paragraph 15.

quite different from the position of the French Court of Cassation, which has ruled that internet service providers were to bear the costs injunctions made against them.<sup>44</sup>

However, the incidence of costs need be done within the bounds of limited rules already set by the EU legislative principles to achieve an effective and fair system.<sup>45</sup>

## **V. JUDICIAL ATTITUDE IN UK AND THE JURISDICTIONAL REQUIREMENT OF SECTION 97A.**

In UK, section 97A of CDPA empowers the court to grant remedies for copyright infringements on the internet, but does not make provisions for who the parties to the action should be. It presupposes that the court should follow other procedures in determining who the parties to each case should be.<sup>46</sup>

In TPB case,<sup>47</sup> the claimants who are record companies sued six major internet service providers in the UK for copyright infringement of their works by the service providers' users. One major question that came up for consideration was whether a finding of liability can be made by the court even in the absence of the alleged infringers. Arnold J in his judgement identifies a reason for acceptability of the infringer's absence: both section 97A of CDPA and Article 8(3) of the InfoSoc Directive do not make any jurisdictional requirement for the addition of the infringer (in this case, TPB) as a party to the proceeding. This decision has far reaching implications and raises concern for the rule, 'hear both parties (*audi alterem partem*)'.<sup>48</sup> The statement is not based on facts from the case, but of law in the interpretation of section 97A which means that regardless of the facts in any case, the joinder of the website operators and users are not statutorily required.

Website by statutory interpretation is also a service provider.<sup>49</sup> Going by this, Arnold J's decision to exclude the website operators from joining the proceeding under section 97A may be wrong. The definition of service providers under the Law is broad enough to accommodate website operators and if any injunction is to be ordered against service providers, website operators may need to be joined in the action.<sup>50</sup>

In an earlier decision by Arnold J,<sup>51</sup> he also dispensed with joining of the Newzbin2 website operators while granting an injunction under Section 97A. This is

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<sup>44</sup> *Societe Francaise du Radiotelephone v Union des Producteurs de Cinema* (2017) 16-18595

<sup>45</sup> Rosati (n 37)

<sup>46</sup> Mysoor (n 3) 557.

<sup>47</sup> *Dramatico Entertainment Ltd & 8 Ors v British Sky Broadcasting Ltd & 5 Ors* (2012) EWHC 268 (Ch).

<sup>48</sup> Mysoor (n 3)

<sup>49</sup> Regulation 2 of the Electronic Commerce (eDirective) Regulation 2002, SI 2002/2013

<sup>50</sup> *ibid*

<sup>51</sup> *Twentieth Century Fox Film Corporation v British Telecommunications Plc* (2011) EWHC 1981 (Ch).



actually a precedent to the TPB case considering the times when the two cases were decided. It need be pointed out that when the Newzbin1 case came up,<sup>52</sup> the website operators were joined in the case and duly availed the opportunity of defending themselves. However, the injunction against the direct infringers in Newzbin1 didn't stop the infringement. It is argued that this might have prompted Arnold J's decision to allow the exclusion of the operators of the Newzbin2 website from the proceeding.<sup>53</sup>

Unlike in the TPB case where no interest was expressed by the operators and users of the website to appear in the case, a user of the Newzbin2 website wrote a letter to the court requesting to be heard which Arnold J granted.<sup>54</sup> However, Arnold J rejected his evidence on the basis of late filing. This decision is criticised for asking the impossible from the applicant, since he was not added as a defendant in the action from the start.<sup>55</sup> In TPB, Arnold J did make an order that rules out the users of the website from participating in proceedings under Section 97A.<sup>56</sup>

Arnold J has however defended his decision to exclude the service of the processes on and appearance of the website users from the proceedings on grounds of convenience. Considering that it would be disproportionately onerous for all users in a mass online copyright infringement which sometimes can run into millions to be joined and served by the claimants.<sup>57</sup> To this extent, his decision is considered reasonable.<sup>58</sup> However, it still does not justify why website operators should not be joined in an action that has everything to do with them.<sup>59</sup>

Since 2011 when first the right holders successfully used section 97A to require service providers to prevent users from accessing infringing websites, many cases have come up for consideration. And the likelihood of the courts to grant the injunction remains high, in as much as the right holders can prove that the service providers have actual knowledge of the infringements occurring within their platform. In the light of the above decisions, the major target of the right holder is the service provider.<sup>60</sup>

In *1967 Limited v British Sky Broadcasting Limited*,<sup>61</sup> the Claimants who were in possession of about 99% interests of all sound recordings distributed in UK sued the major service providers in the UK for a blocking order against 21 websites who used

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<sup>52</sup> Twentieth Century Fox Films Corporation v Newzbin Ltd (2010) EWHC 608 (Ch)

<sup>53</sup> Mysoor (n 3) 557

<sup>54</sup> *ibid* 560.

<sup>55</sup> *ibid*

<sup>56</sup> (2012) EWHC.

<sup>57</sup> Mysoor (n 3) 560.

<sup>58</sup> *ibid*

<sup>59</sup> *ibid* 559

<sup>60</sup> Grace Pead et al., 'Mounting Blocks: internet service providers ordered to block 21 copyright infringing music sharing websites' (2015) *Journal of Intellectual Property Law and Practice*, Vol. 10 No 5, pg 332.

<sup>61</sup> *1967 Limited &Ors v British Sky Broadcasting Limited &Ors* (2014) EWHC 3444

the Bittorrent peer to peer file sharing protocol to infringe on the Claimants' rights just like in the TPB case. Arnold J made a legal analysis of the case by classifying four ingredients that need to be available before the court can exercise jurisdiction to grant a section 97A injunction. First, there must be evidence to show that the defendants are service providers. Second, evidence must be provided to show that there was an infringement of the claimant's copyright by the website operators. Third, the users and or website operators must have used the platforms of the defendants to infringe the claimants' copyright. Fourth, it must be established that the Defendants have actual knowledge of the infringement.

Arnold J had no challenge finding that the UK users of the 21 target websites infringed the copyright. First, by section 17 of the CDPA, the users downloaded torrent files referencing protected content, and the content was *copied* to the users' computers or devices. Second, by section 20 of CDPA, there was communication to the public when the UK users uploaded protected contents to the internet. The Judge further identified three requirements for communication to the public:

- (a) Copyright protected content must have been communicated by electronic transmission.
- (b) The communication must have been made to the public.
- (c) Such communication to the public must have taken place in the UK.

The operators of the websites were held to infringe copyright by enabling the communication of protected contents to the public, authorising infringement by indexing torrent files to enable easy download by users, and by inducing users to commit infringement as joint tortfeasors with the UK users.

However, Arnold J held the order should be such that when users try loading the pages of the blocked websites, a notice stating that the website has been blocked need to be displayed. And the displayed notice must also notify affected users of their rights to apply to the court to discharge or vary the court order.

This case is significant in showing the continuous willingness of UK courts in granting injunctions against internet service providers requesting them to block access to certain websites that are found to infringe copyright.<sup>62</sup> However, it does not do enough to accommodate the appearance of both the website operators and the users in the court to defend themselves. Although, it gives room for affected users to make application to the court for either to discharge the order or vary same subject to available evidence.<sup>63</sup>

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<sup>62</sup> Pead (n 55) 334

<sup>63</sup> See note 57.

Other injunctions have also been granted recently. In *UEFA v. BT Plc* (UEFA case),<sup>64</sup> the UK High Court granted an order against the major internet service providers in the UK asking them to block access to the illegal internet streams of UEFA football matches. Arnold J identified the similarity between this case and other cases he entertained earlier (*Football Association Premier League Ltd v British Telecommunications Plc & Ors* [2017] EWHC 480 (Ch) and *Football Association Premier League Ltd v British Telecommunications Plc* [2017] EWHC 1877 (Ch)). The service providers are always willing to comply with the orders, but Arnold J was mindful of appropriateness of the order against the operators of the websites and the users before granting the orders. Arnold J also reiterated the four requirements he expressed in the *1967 Limited* case,<sup>65</sup> to satisfy the jurisdictional requirements of section 97A.

While it remains paramount and desirable to protect the creative industry, the decision to exclude interest parties from the proceedings poses as a threat to justice.<sup>66</sup> Arnold J clarifies the reason why the operators of the TPB website could not be joined. According to the Judge, the operators of the website were in the habit of ridiculing complaints from rights holders, and had expressed every intention to disregard appearance by continuously evading services of court processes in a civil suit they were made parties to in Sweden. Therefore, Arnold J based his argument on the available facts that reflect how TPB reacted towards copyright infringement in the past to rule out their appearance in court.<sup>67</sup>

One would believe that if the facts in other cases are different, Arnold J will give a different ruling and order for their appearance in court. Disappointedly, this has not been the case where the facts show that the operators have not expressed any intention to evade service of the court processes under the section 97A proceeding.

The TPB case might have set a dangerous precedent. Claimants in subsequent cases continue to ride on the support and authority of the TPB case to ignore the appearance of the website operators whom ordinarily, are interested parties to every Section 97A proceeding. In *EMI v. BSKyB* (EMI case),<sup>68</sup> the claimants tried being cautious by asking for the directions of the court on whether to serve the operators of the website,<sup>69</sup> however, Arnold J clearly confirmed that there was no statutory

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<sup>64</sup> *Union des Association European de Football v British Telecommunications Plc & Ors* (2017) EWHC 3414 (Ch)

<sup>65</sup> See note 56

<sup>66</sup> Mysoor (n 3) 559

<sup>67</sup> *ibid*

<sup>68</sup> *EMI Records Limited v. British Sky Broadcasting Ltd* (2013) EWHC 3479 (Ch).

<sup>69</sup> *ibid*, para. 9.

requirement on the claimants to effect service of court processes on the website operators just as in the TPB case.<sup>70</sup>

Unlike the EMI case, the claimants in FAPL's case never sought for any direction from the court on whether to serve the court processes on the website operators.<sup>71</sup> At this point, it appears that the non- service of applications on the website operators is a settled law.

In *Paramount v BSKyB*,<sup>72</sup> the applicants even went a step further by not only ignoring the service of the court processes on the website operators, but also referring to the website as "Target Website" without identifying the operators.<sup>73</sup> It appears like there is no reason at all to raise the issue of serving the applications on the website operators and users anymore. However, Arnold J added in the FAPL case (and also followed same in the UEFA case) that anybody (referring to the operators and users of the website) who claims to be affected by the order under section 97A can apply to court for the variance or discharge of the order in as much as it affects the applicant.<sup>74</sup>

As already stated earlier,<sup>75</sup> Newzbin1 is a proof that content providers are willing to put up a defence in a section 97A proceeding.<sup>76</sup>

## VI. CONCLUSION

The InfoSoc Directive is the most instrumental EU legislative instrument to online copyright infringement. The section 97A of CDPA is a state law that operates under the umbrage of the InfoSoc directive.

Under the Digital Economy Act of 2017, it is not only a civil wrong, but also a criminal offence to communicate a copyright protected work to the public without the permission of the right holder.<sup>77</sup> While the notion does not enjoy a statutory definition, it has gone through judicial interpretation from the EU and UK courts.

The existence of online copyright infringement remains an undeniable fact. The need to protect the creative industry cannot be overemphasised. However, there is need to also consider the interests and rights of both the website operators and users alike. Having considered the jurisdiction under section 97A, the courts may need to always balance the scale of justice in the light of all interest parties. I consider the argument of Arnold J for the non-joinder of users on grounds of impracticability, a

<sup>70</sup> Ibid, paras 10-13.

<sup>71</sup> Football Association Premier League Ltd v British Sky Broadcasting Ltd (2013) EWHC 3479 (Ch)

<sup>72</sup> Paramount Home Entertainment Ltd v British Sky Broadcasting Ltd (2014) EWHC 937.

<sup>73</sup> Ibid, para 3.

<sup>74</sup> Football Association Premier League Ltd v British Sky Broadcasting Ltd (2013)

<sup>75</sup> See n. 49.

<sup>76</sup> Mysoor (n 3) 562

<sup>77</sup> See n. 17.

reasonable one. However, where a user expresses interest to be joined in a section 97A proceeding, having established locus, the court may make an order for his joinder to the proceeding. The right of the website operators to be heard should not be ousted by both legislative and judicial wisdoms.

A target website may also provide non-infringing contents. Therefore, there is need for flexibility in the Law to accommodate all situations without causing an injury to any party.<sup>78</sup>

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Intellectual property law scholar

For more information



Email- [emmanwagboo@nigerianbar.ng](mailto:emmanwagboo@nigerianbar.ng)

Tel- +2348037193620

MIPLG

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<sup>78</sup>Mysoor (n.3).

## **BIBLIOGRAPHY**

### **EU and UK Cases**

1967 Limited and others v British Sky Broadcasting Limited and others (2014) EWHC 3444

Cartier International AG and others v British Sky Broadcasting Limited and others (2014) EWCH 3354 (Ch)

Cartier International AG and others v British Sky Broadcasting Limited and others (2018) UKSC 28

Dramatico Entertainment Ltd and others v British Sky Broadcasting Ltd and others (2012) EWHC 268 (Ch)

EMI Records Limited v British Sky Broadcasting Limited (2013) EWCH 3479

Football Association Premier League Ltd v QC leisure and others (2008) EWHC 1411 (Ch)

Football Association Premier League Ltd v British Sky Broadcasting Ltd (2013) EWCH 3497

Homes A/S v Ofir (unreported)

L'Oreal SA and others v eBay International AG and others, C-320/09 EU:C:2011:474

Nils Svensson and others v Retriever Sverige AB C466/12

Paramount Home Entertainment Ltd v British Sky Broadcasting Ltd (2014) EWCH 937

Shetland Times Ltd v Dr Jonathan Wills (1997) SC 316

Societe Francaise du Radiotelephone v Union des Producteurs de Cinema (2017) 16-18

Stichting Brein v Ziggo BV and XS4ALL Internet BV C-610/15

Twentieth Century Fox Films Corporation v. British Telecommunications Plc (2011) EWCH 1981 (Ch)

Twentieth Century Fox Films Corporation v Newzbin Ltd (2010) EWCH 608 (Ch)

Union des Association European de Football v British Telecommunications Plc and others (2017) EWHC 3414 (Ch)

Verlagsgruppe Handelsblat GmbH v Paperboy (2005) ECDR 7

### **Legislations and Statutes**

Copyright Designs and Patent Act C.30, 1998 (UK)

Copyright and Related Rights Regulations 2003 SI 2003/2498 (UK)

Digital Economy Act 2017 (UK)

Directive 2004/48/EC of the European Parliament and of the Council of 22 May 2001 (EU)

Electronic Commerce (EC Directive) Regulation 2002, SI 2002/2013 (EU)

Information Society Directive 2001/29/EC (EU)

### **Books and Journal Articles**

Angelopoulos, Christina, 'Communication to the public and accessory copyright infringement' (2017) Cambridge Law Journals vol 76

Li, Xigen and Nergadze, Nico, 'Deterrence effect of four legal and extralegal factors on online copyright infringement' (2009) Journal of Computer Mediated Communication vol 14

Mansell, Robin and Steinmueller, Edward, 'Copyright infringement online: the case of the Digital Economy Act judicial review in the United Kingdom' (2013) Sage Journals 3

Murray, Andrew, Information Technology Law, (4<sup>th</sup> edition, Oxford University Press, 2019)

Mysoor Poorna, 'A Pirate too needs to be heard: procedural compromises in online copyright infringement cases in the UK' (2014) Molecular Diversity Preservation International Journal (MDPI) 3

Nordemann, Jan Bernd, 'Recent CJEU case Law on Communication to the public and its application in Germany: a new EUN concept of liability' (2018) Journal of Intellectual Property Law and Practice vol 13, no 9

Pead, Grace, Montagnon, Rachel and Moir Andrew, 'Mounting Blocks: internet service providers ordered to block 21 copyright infringing music sharing websites' (2015) Journal of Intellectual Property Law and Practice, vol 10, no 5

Rizzuto, Francesco, 'The liability of online intermediary service providers for infringements of intellectual property rights (2012) Computer and Telecommunications Law Review Vol 18

Rosati, Eleonora, 'Intermediary IP injunctions in the EU and UK experiences: when less (harmonisation) is more?' (2017) Journal of Intellectual Property Law and Practice vol 12, no 4

Rosati, Eleonora, 'UK Supreme Court holds that intermediaries have to bear no costs on injunctions against them' (2018) Journal of Intellectual Property Law and Practice vol 13, no 12

### **Online Sources**

Scott Flannigan, 'Digital Economy Act extends online copyright infringement penalties' (2017) <<https://andersonstrthern.co.uk/news-insight/digital-economy-act-extends-online-copyright-infringement-penalties/>> last assessed 4<sup>th</sup> January, 2020