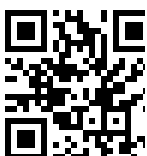
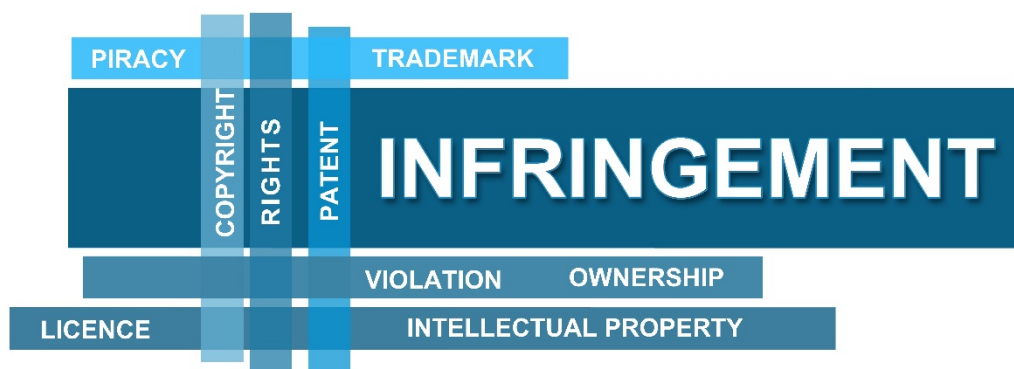


STUDY

Requested by the JURI committee



Cross Border Enforcement of Intellectual Property Rights in EU



Policy Department for Citizens' Rights and Constitutional Affairs

Directorate-General for Internal Policies

PE 703.387 - December 2021

EN

Cross Border Enforcement of Intellectual Property Rights in EU

Abstract

This study, commissioned by the European Parliament's Policy Department for Citizens' Rights and Constitutional Affairs at the request of the JURI Committee, aims to provide an overview of cross-border enforcement of intellectual property rights in the EU with a particular emphasis on copyright and related rights in the online environment. The study provides a detailed analysis of the current situation of cross-border IPR enforcement and formulates various policy recommendations to improve current IPR enforcement options among MS.

This document was requested by the European Parliament's Committee on Legal Affairs.

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List of Abbreviations

ADR	Alternative Dispute Resolution
AFNIC	Association française pour le nommage Internet en coopération (France)
AG	Advocate General
AGCOM	Authority for Communications Guarantees / Autorità per le Garanzie nelle Comunicazioni (Italy)
APRTEL	Associação dos Operadores de Telecomunicações / Association of Telecommunications Operators (Portugal)
BGH	Bundesgerichtshof / Federal Court of Justice (Germany)
BKartA	Bundeskartellamt / Federal Cartel Office (Germany)
BNetzA	Bundesnetzagentur / Federal Network Agency (Germany)
ccTLD	country code Top Level Domain
CFR	Charter of Fundamental Rights of the European Union
CJEU	Court of Justice of the European Union
CLIP	European Max-Planck Group on Conflict of Laws in Intellectual Property
CNIL	Commission nationale de l'informatique et des libertés (France)
CoC	Code of Conduct
CoP	Code of Practice
CUII	Clearingstelle Urheberrecht im Internet / Internet Copyright Clearing House (Germany)
DG CNECT	Directorate General Communications Networks, Content and Technology (European Commission)
DMCA	Digital Millennium Copyright Act (USA)
DNS	Domain Name System
DPI	Deep Packet Inspection
DSA	Proposal of 15 December 2020 on a Single Market for Digital Services (Digital Service Act) and amending Directive 2000/31/EC, COM(2020) 825
EDPPI	Committee for the Notification of Copyright and Related Rights Infringement on the Internet / Επιτροπή για τη Διαδικτυακή Προσβολή Πνευματικής Ιδιοκτησίας (Greece)
EEA	European Economic Area
ECD	Directive 2000/31/EC of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market [2000] OJ L 178/1
ECHR	European Convention of Human Rights
ECTHR	European Court of Human Rights

EIPPN	European Intellectual Property Prosecutors Network
EJCN	European Judicial Cybercrime Network
EJN	European Judicial Network in civil and commercial matters
EPC	European Patent Convention
EU	European Union
EUIPO	European Union Intellectual Property Office
EWHC(Ch)	High Court of Justice of England and Wales (Chancery Division) (UK)
GDP	gross domestic product
gTLD	generic Top-Level Domain
HADOPI	High Authority for the dissemination of works and the protection of rights on the internet / Haute Autorité pour la diffusion des œuvres et la protection des droits sur internet (France)
IAB	Internet Architecture Board
ICANN	Internet Corporation for Assigned Names and Numbers
IGAC	Inspectorate General for Cultural Activities / Inspeção Geral das Atividades Culturais (Portugal)
ICC	International Chamber of Commerce
IPC	Intellectual Property Commission / Comisión de Propiedad Intelectual (Spain)
IPR	Intellectual Property Right
IPRED	Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights [2004], OJ L 195/16; Corrigenda in OJ 2004 L 195/16 and OJ 2007 L 204/27
ISP	Internet Service Provider
ISPA	Internet Service Providers Association (Belgium)
JIT	Joint Investigation Team
LCIA	London Court of International Arbitration
MoU	Memorandum of Understanding
MPA	Motion Picture Association
MS	(EU) Member State
NTD	Notice-and-Takedown
OCSSP	Online Content-Sharing Service Provider
Ofcom	Office of Communications (UK)
OLAF	European Anti-Fraud Office
OSP	Online Service Provider
RTCL	Radio and Television Commission of Lithuania / Lietuvos radijo ir televizijos komisija

SPI	Shallow Packet Inspection
TEU	Treaty on European Union
TFEU	Treaty on the Functioning of the European Union
TPB	The Pirate Bay
TPM	Technological Protection Measure
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UDRP	Uniform Domain Name Dispute Resolution Policy
UEFA	Union of European Football Associations
UK	United Kingdom
UPC	Unified Patent Court
URL	Uniform Resource Locator
U.S.	United States of America
U.S.C.	United States Code
VPN	virtual private network
WIPO	World Intellectual Property Organization

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EXECUTIVE SUMMARY

This study aims to provide both an overview of the current state-of-play as well as a set of policy recommendations with respect to cross-border enforcement of intellectual property rights (IPRs) in the European Union (EU), with a particular emphasis on the enforcement of copyright and related rights in the online environment. The study utilises information drawn from a combination of legal texts, existing EU and Member States (MS) legislation, specialised literature and practical insights gathered from a range of legal experts and copyright stakeholders representing various cultural sectors, to evaluate currently available options for cross-border enforcement.

(A) The Legal Framework for Cross-Border IPR Infringements in the EU

The EU legal framework provides for some harmonised rules and tools facilitating cross-border enforcement in civil and criminal cases. The general framework is complemented by IPR-specific provisions articulated at the EU and national levels, with some important differences regarding industrial property rights and copyright enforcement. On the one hand, cross-border enforcement of industrial property rights is facilitated by a high level of harmonisation of substantive law (some of the rights are EU unitary rights) and some procedural harmonization. Recent legal developments could significantly improve the cross-border enforcement of patents in the EU. On the other hand, copyright and related rights' legal regime shows marked differences from industrial property rights, particularly with respect to the heterogenous national implementation of EU law, peculiar regimes for different cultural industries, and the absence of unitary titles.

(B) The Online Environment and Cross-Border IPR Infringements: The Challenge of Copyright and Related Rights

While problematic for a range of IPRs, cross-border patterns of online infringement have become particularly challenging to address for stakeholders involved in creative industries.¹ The amount of available infringing digital content across key media sectors (audiovisual, music, video games) generates a lucrative market of its own, as the average EU internet user in 2018 accessed pirated content 9.7 times per month.²

Despite the proliferation of infringing activities occurring online, developing adequate countermeasures has proven a longstanding challenge for policymakers. This is primarily due to the fact that **in the existing international framework the recognition and enforcement of IPRs remains largely territorial**. On an international level, given basic minimum standards of protection are fulfilled, copyright protection is “guaranteed on the basis of a patchwork of national copyright regimes and national copyright acts.”³ While this arrangement was once effective during a time when works were exploited on a limited, national basis, the online environment has dramatically altered the

¹ The same improvements which have facilitated exchanges of content online have also given rise to a wave of illegal activities concerning the infringement of IPRs. Infringers take full advantage of the unique characteristics of the online space to perpetrate infringements and commit illegal acts that, by their very nature, take place across borders: they may utilise multiple servers located in different MS or third countries, use “mirror” sites to perpetuate identical infringements on multiple websites, or coordinate with other infringers anonymously on worldwide networks. Given the ease and speed of uploading, accessing, and linking to infringing content, such acts can be carried out at-scale, often resulting in a high number of infringements occurring within a short timeframe.

² N. Wajzman, et. al., ‘[Online Copyright Infringement in the European Union: Music, Films and TV \(2017-2018\), Trends and Drivers](#)’ EUIPO, 2019, p. 7.

³ P. Torremans, ‘Jurisdiction for Cross-Border Intellectual Property Infringement Cases in Europe’, *Common Market Law Review*, Vol. 53(6), 2016, pp. 1625–1645.

magnitude and scope of the exchange of content, now occurring in larger volumes and at a global scale. Hence, one of the key challenges for improving the enforcement of IPRs in the EU, particularly for copyright, lies in building upon an existing system which prioritises national, territorially-limited measures for enforcing rights.

(C) The Status Quo of Online Enforcement Options in the EU: Voluntary, Administrative and Judicial Measures

Over the years, new procedures and remedies have been developed which attempt to reconcile rightholders' growing enforcement needs in online infringement contexts within previous nationally-based paradigms of enforcement.

One approach for regulating conduct in the online environment refocuses the obligations of enforcement primarily onto private parties rather than State actors. The terms "self-regulation", "co-regulation" or "private ordering" are used to refer to such systems of enforcement, which are created through the use of **voluntary agreements**, most of which are concluded between rightholder organisations and groups representing domestic Internet service providers. Taking the form of **Codes of Conduct, Codes of Practice, or Memorandums of Understanding**, these instruments provide a structure for collaboration between private parties to prevent infringements and other illegal activities without necessarily requiring institutional intervention.

According to stakeholders, the most effective voluntary agreements among MS were those that enabled rightholders to obtain relief against all major ISPs in the relevant national market. The voluntary systems in place in **Denmark, Portugal and Germany** involve the participation of all major ISPs in those jurisdictions, and are considered by rightholders as good examples of voluntary cooperation.

Along similar lines, one noteworthy measure that the EU promotes is the use of the **Counterfeit and Piracy Watch List** (Watch List), which was introduced as a means for raising awareness of infringement and enhancing the cooperation of enforcement among website operators, owners, local enforcement authorities and governments. The Watch List includes known and reported examples of marketplaces or service providers (whose operators or owners reside outside the EU) who are alleged to engage in, facilitate or benefit from IPR infringing activities. Based on submissions from the public, the European Commission's services (with the EUIPO, European Anti-Fraud Office (OLAF), and Europol) work to verify the information, though they explicitly disclaim any legal conclusions to be drawn from the List.

This leads into one of the biggest drawbacks for relying on voluntary options for enforcement, according to stakeholders: their **lack of authoritativeness**. That is, voluntary arrangements rely significantly on the goodwill of the parties to be carried out effectively, and therefore non-compliance with an agreement is unlikely to trigger severe consequences. Stakeholders cited some frustrations when relying on the use of voluntary means of enforcement, as responses from the corresponding intermediary or ISP were considered slow and/or inconsistent.

Another approach for regulating conduct in the online environment centres on the use of **administrative measures**, sometimes facilitated by the presence of specialised national authorities, which promise a rapid and cost-effective avenue for enforcement. In some EU MS, administrative authorities are specifically tasked with overseeing the enforcement process, and may also be tasked with **standardising procedures** for reporting online infringements of copyright and related rights. Administrative enforcement measures are typically designed with particular attention to the speed of decision making required to limit the damage that can occur in a short timeframe, and specialised administrative authorities are often equipped with the technical means and the capacity to handle the

high volume of requests necessary for effectively removing or preventing access to infringing content. While sometimes working in coordination with national courts, administrative authorities may act separately from the courts as an alternative or parallel track for enforcement.

Finally, **judicial enforcement** via national courts provides the classic means for recognising rights and obtaining relief for infringements. While the use of national court procedures ensure a fair balance of rights and rendered judgements have the force of law, this avenue for enforcement is often not preferred due to perceived high costs of litigation and time-intensive review of claims. Furthermore, national courts may not be sufficiently equipped with the technical capabilities or staffing required to deal with the phenomenon of online infringements, where large volumes of information need to be processed to properly deal with a widespread infringement. Nevertheless, over time national court practices have evolved to combat the threat of online infringement in new ways, paving the way for measures which block access to infringing content dynamically, shortly after it is uploaded, without the need of seeking new court orders, such as in the case of “dynamic” and “live” blocking injunction. Furthermore, as a matter of strategic litigation, for some rightholders national jurisprudence serves as guideposts for pursuing similar infringements in the future or in other MS jurisdictions, and may therefore carry an important precedential value for confronting new forms of infringements occurring online.

Given that these avenues of enforcement – voluntary, administrative and judicial – may all be considered well-developed at the MS level, **it is rare that they will have a “cross-border” dimension**. Specifically, once an order or judgement has been reached in one MS, it is very unlikely that another MS will automatically give full binding effect of that order within its jurisdiction. It is more usual that rightholders submit separate, additional claims for relief to the national administrative authorities or courts in other MS in order to obtain a remedy that can be applied within the respective jurisdiction.

(D) Main Findings

(1) Overall, cross-border enforcement in EU is rare phenomenon. Despite the cross-border nature of most infringements occurring online, stakeholders in some sectors reported no instances of/no experience with cross-border enforcement.

(2) Some stakeholders (rightholders) have avoided initiating proceedings in multiple MS on the basis of perceived costs involved and potentially lengthy timeframe (estimated to be 1yr.+ for obtaining relief in multiple MS).

(2.1) Regarding the timeframe of enforcement, some rightholders identified that the majority of the total commercial value for some works is concentrated around the time of its initial release (Likewise, this is also the time when there is the highest potential for economic harm to occur).

(2.2) To limit the amount of economic harm that can potentially occur from online infringements, some rightholders have suggested standardising a time period for initiating, approving and enforcing a claim, within a period lasting no longer than 72 hours.

(3) In general, stakeholders and experts have indicated that the preferred litigation strategy in cases of copyright infringements occurring online is to avoid the application of multiple laws (adopting a MS-by-MS approach). Rightholders tend to litigate either:

(3.1) in a single MS that is the most relevant for the infringement and whose outcome is predictable; OR

(3.2) by selecting the “most relevant” jurisdictions; OR

(3.3) a combination of the above two approaches, bringing a case in one MS and then, if successful, continuing the case in other jurisdictions.

(4) Given that there have been rare cases of enforcement occurring in multiple MS, in the cases that rightholders did seek relief in multiple MS against infringements, some patterns emerged. For example, there is an observable trend of rightholders favoring enforcement in “large” MS (Western Europe), likely due to a high perceived cost-to-impact ratio.

(5) Even in cases where international and European associations of rightholders were able to pool sufficient financial resources for carrying out enforcement actions on behalf of a large number of rightholders, they did not pursue legal actions in all MS.

(6) In jurisdictions where both administrative and judicial enforcement options were available, rightholders demonstrated a clear preference for pursuing infringements through the use of administrative procedures.

(7) Stakeholders express optimism for the future development and availability of administrative procedures for enforcement.

(E) Policy Recommendations

There is room to improve the current cross-border enforcement situation through introducing certain measures, both legislative and non-legislative in nature, which are oriented towards enhancing cooperation between MS authorities, and centralising certain functions at the EU level. In considering improvements to current voluntary, administrative and judicial enforcement measures, rightholders may benefit from a more streamlined experience for enforcing their rights across MS. As a result, the damage resulting from a significant number of online infringements occurring across multiple MS can be reduced. Proposed improvements to the current system include the following:

(1) Voluntary arrangements can begin to take on a cross-border dimension. Voluntary EU-wide enforcement of website blocking against infringing websites already blocked by courts in a certain number of MS can be one starting point to consider, along with reaching agreements between the largest European telecommunication network service providers.

(2) Cooperation between National Administrative Authorities could be enhanced through the following measures:

(2.1) Establishing a “contact committee” of national competent authorities to facilitate MS to MS exchanges of information regarding cross-border enforcement of infringements occurring in multiple MS, as well as coordinate on the formation of best practices for important elements of cross-border enforcement (i.e., uniform standardised practices for issuing and recognising administrative orders with a cross-border effect;

(2.2) Qualifying certain administrative authorities as “tribunals” within the meaning of the Brussels Recast Regulation in order to promote the mutual recognition of judgements rendered.

(3) The EU Watch List could be improved and expanded upon in the following ways:

(3.1) Improving the process through which the Watch List is established;

(3.2) enhancing an understanding of the List’s criteria and process by all stakeholders concerned;

(3.3) extending the List’s scope to also cover websites whose operators or owners reside in the EU.

- (4) A new administrative procedure for cross-border online copyright enforcement can be created at the EU level, facilitated and administered by a new EU level administrative authority specifically tasked with overseeing issues of cross-border infringements.
- (5) Awareness-raising efforts of existing IPR enforcement measures can help bridge existing knowledge gaps – particularly regarding existing EU tools for facilitating judicial enforcement in cross-border scenarios – and can be achieved via education initiatives and the promotion of existing judicial tools among IPR practitioners, rightholders, and judges.
- (6) The availability and use of cross-border civil investigative tools can be enhanced by, e.g., following the model of the Directive on the European Investigation Order in criminal matters, which creates a single instrument for executing investigative measures across MS territories.
- (7) A mutually-recognised EU blocking order for certain cases involving “obvious” infringements can be developed. Once rightholders to pursue an infringement action in one national court, a “fast-track” procedure should be made available for both recognizing and enforcing the judicial order once granted in multiple other MS where the same infringements are at stake.
- (8) Certain key legal concepts relevant to online copyright enforcement, such as “expeditious”, “obvious infringement” or “manifestly illegal (infringing) content”, can be clarified to a greater extent via EU legislation.
- (9) Copyright-sector specific enforcement measures can be considered and developed, which would favor the use of more qualitative assessments of the nature of the infringement and the rights at stake rather than quantitative thresholds of infringement.
- (10) In the long term, the harmonisation and unification of EU copyright law, e.g., by establishing a uniform EU copyright code, can eliminate cross-border conflicts regarding copyright enforcement.

I. STATE OF CROSS-BORDER IPR ENFORCEMENT IN THE EU

1. INTRODUCTION

1.1. Background

The European Parliament's Committee on Legal Affairs (JURI) commissioned the CEIPI to conduct a Study on the cross-border enforcement of intellectual property rights in the European Union, paying special attention to the situation regarding the cross-border enforcement of copyright and related rights in the online environment.

European Union (EU) law drives the development of intellectual property (IP) law of the EU Member States (MS). It provides for a number of unitary IP titles and harmonises MS' national laws on IP. Substantive IP provisions are complemented by rules on their enforcement. The importance of these rules for the functioning of the Single Digital Market is accentuated by the scope of the phenomenon of infringement in the digital era, which disrupts the application of commonly known rules.

From a substantive law perspective, copyright and related rights in the EU are harmonised to a degree through the application of EU Directives which are largely sectoral in nature. Yet, due to the limited degree of this harmonisation, MS' practices may vary considerably, leading to inconsistent levels of IPR protection as well as differences in the application and scope of exceptions and limitations.⁴ In the digital context, the legal uncertainty generated by such fragmentation is exacerbated by the fact that online infringements are often ubiquitous in nature, creating an unpredictable scenario for alleged infringers and intermediaries;⁵ in essence, they may be expected to appear before the courts of any or several of the 27 MS.⁶ It is in these respects that the digital environment tests the continued practice of territorial application of copyright laws in particular, and is likely to continue to be problematic for many stakeholders in the creative industry.

From an enforcement perspective, there are significant differences in the territorial enforcement of different types of IPRs in the EU related to their nature. This is less of the case with regard to the unitary IP titles, such as trade marks,⁷ designs⁸ and plant varieties⁹. In the area of patent law, the "unitary patent package" and the introduction of the Unified Patent Court (UPC)¹⁰ promises to harmonize this area, centralizing enforcement and thus bringing some much-needed coherency to the national patent

⁴ See, e.g., C. Geiger and F. Schönherr, '[Frequently Asked Questions \(FAQ\) of Consumers in relation to Copyright, Summary Report](#)' (project commissioned by the EUIPO 2017), (listing exceptions and limitations to copyright as one of the areas of major divergence in national copyright law).

⁵ See, e.g., D. Svantesson, 'Internet Jurisdiction and Intermediary Liability', in Frosio, G. (ed), *The Oxford Handbook of Online Intermediary Liability*, OUP, 2020, pp. 691-708; G. Frosio, 'Enforcement of European Rights on a Global Scale', in E. Rosati, E. (ed.), *Routledge Handbook of European Copyright Law*, Routledge, 2021, pp. 413-440.

⁶ The specific choice of law issues triggered by infringements occurring in the online environment are elaborated on further, *infra*, Section 5

⁷ [Regulation 2017/1001](#) of 14 June 2017 on the European Union trade mark, 16 June 2017.

⁸ [Regulation 6/2002](#) of 12 December 2001 on Community designs, 5 January 2002.

⁹ [Regulation 2100/94](#) of 27 July 1994 on Community plant variety rights, 1 September 1994.

¹⁰ [Regulation 1257/2012](#) of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, 31 December 2012; [Council Regulation 1260/2012](#) of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, 31 December 2012; [Agreement on a Unified Patent Court](#), 20 June 2013 (the date of entry into force TBD).

practices of MS. However, in the area of copyright law, rightholders enforcing their rights in the EU can only rely on national, although harmonised to a large extent, copyright titles, the application of general principles of EU law and private international law. These jurisdictional rules, while generally applicable, become difficult to apply in the online infringement context.¹¹

Beyond general regulations, the EU has already adopted specific measures aimed at harmonising the treatment of IPRs among MS. Primarily, the Enforcement Directive (IPRED) addresses national enforcement measures, procedures and remedies applicable horizontally to all IPRs¹². Special provisions regarding enforcement have also been included in sectoral directives applicable to specific IPRs¹³. The meaning and significance of some of these provisions have been further developed through jurisprudence at both the European and national levels. Nevertheless, the challenge of enforcement of IPRs in the online context is ongoing, as infringers leverage the ubiquity and anonymity of the online space to perpetrate large numbers of infringements across national borders.

To combat online infringements, new forms of injunctive relief have been contemplated and applied by administrative bodies and national courts, though these practices remain unharmonised across the EU. Legal remedies, such as blocking injunctions, offer rightholders the opportunity to stop infringing activities occurring online. Dynamic blocking injunctions, where available, further help to prevent new infringements from occurring on a continuous basis.¹⁴ “Live-blocking” or contemporaneous blocking orders have also been issued by national courts and other administrative bodies to prevent simultaneous broadcasting of infringing materials.¹⁵ Yet, the limited territorial (national) scope of such remedial measures¹⁶ renders them inefficient and ineffective when enforcing copyright and related rights, although harmonised, on a cross-border basis in the EU.

Given this background, in order to guarantee high levels of protection of IPRs in the EU, it therefore becomes imperative that improvements to the cross-border enforcement situation in the EU can be considered and applied consistently among MS.

1.2. Objective

The Study pursues a twofold objective. First, it analyses the **current situation** of cross-border IPR enforcement in the EU, with particular emphasis on **online copyright infringement actions** (Part I). Second, it offers **policy recommendations** to improve current IPR enforcement options among MSs, particularly in view of enhancing their cross-border applications (Part II).

¹¹ Torremans, Jurisdiction, *supra*.

¹² [Directive 2004/48/EC](#) of 29 April 2004 on the enforcement of intellectual property rights (IPRED), 30 April 2004.

¹³ For instance, [Directive 2019/790](#) of 17 April 2019 on copyright and related rights in the Digital Single Market (CDSM Directive), 17 May 2019, Art. 17 (pending implementation by MS).

¹⁴ For a survey on the availability of dynamic blocking injunctions in the MS, see G. Frosio and O. Bulayenko, ‘[Study on Dynamic Blocking Injunctions in the European Union: IPR enforcement case-law collection](#)’, EUIPO, 2021 (hereafter ‘Frosio and Bulayenko, op. cit.’). See also G. Frosio and O. Bulayenko, ‘[Website blocking injunctions in flux: static, dynamic and live](#)’, *JIPLP*, Vol.16(3), 2021.

¹⁵ See eg L. Panella, and M. Firrito, [Challenges facing sports event organizers in the digital environment European added value assessment](#), EPRS, December 2020.

¹⁶ See Frosio, and Bulayenko, op. cit., p. 46.

1.3. Scope

The Study analyses cross-border enforcement of IPRs broadly with a particular focus on online enforcement of copyright and related rights in the EU. The Study is focus on examining available and possible legal tools for cross-border online copyright enforcement, leaving aside the examination of technical means through which legal enforcement measures are implemented. Within this focus, the Study dedicates special attention to blatant wilful large-scale acts of copyright infringement online. Again, the present research reviews more closely civil and administrative measures, while referring to criminal measures to a more limited extent.

The Study aims at providing qualitative data on the state of cross-border enforcement of IPRs in EU by collecting stakeholders' and experts' inputs. In this regard, information related to the UK for the period preceding the UK's withdrawal from the EU, is also available in the present Study.¹⁷

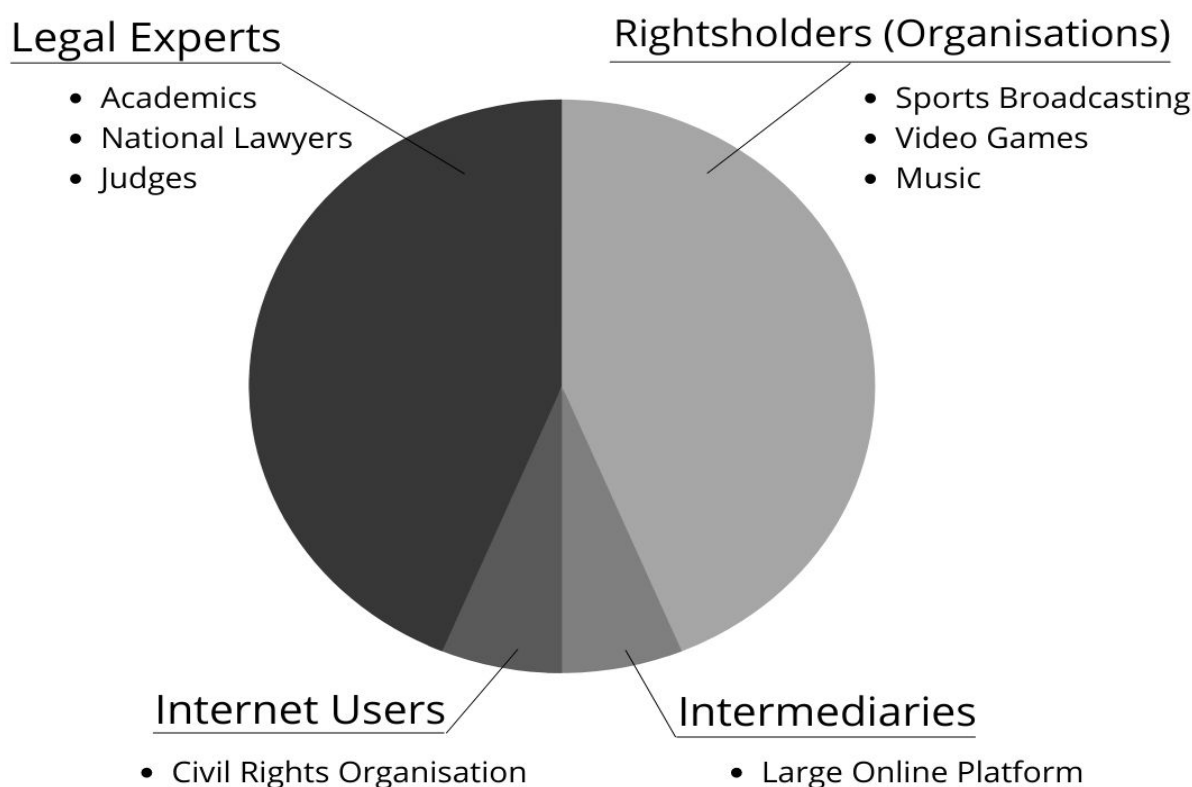
1.4. Methodology

The research was carried out through an intensive literature review, consultations with stakeholders and experts, as well as an in-depth analysis of collected information. The **literature review** included specialised analytical publications (studies, articles, blogposts, etc.), relevant laws, draft legislative texts, cases of judicial and administrative bodies, and texts agreed by stakeholders (codes of conduct, memoranda of understanding, etc.). For more details, see a list of references.

The **stakeholder consultations** were carried out through the period of May-July 2021 by means of semi-structured interviews, complemented by a written questionnaire (Annex II). Some of the stakeholders completed their responses by submitting to the research team different documents, judicial decisions, publication and other information on cross-border copyright enforcement. In addition to stakeholders directly impacted by online copyright enforcement, the research team also consulted a number of legal experts, including academics, lawyers and judges. The research team made its best efforts to receive input from stakeholders from different domains:

¹⁷ The UK left the EU on 31 January 2020, when the withdrawal agreement entered into force. During the transitional period lasting until 31 December 2020, the UK continued to apply EU law and be a part of the Internal Market. The UK is covered by the analysis to an extent that it was EU Member State during the period covered by studied experiences and practices of cross-border IPR enforcement in the EU.

Figure 1. Distribution of Stakeholders and Experts Consulted



For a detailed list of persons and organisations consulted, see Annex I.

The **analysis** of the current IPR enforcement system in the EU was carried out specifically in terms of its **effectiveness in cross-border scenarios**. A broad range of voluntary, administrative, and judicial enforcement measures currently available in MS were identified and analysed, considering the views and practical experiences of the consulted stakeholders and experts.

For the purposes of this Study, infringements with a cross-border element involve two or more MS, and take place in the following scenarios: (i) the act giving rise to the infringement occurred outside the local jurisdiction (**location of the action**); (ii) at least one of the parties to the infringement is domiciled outside the local jurisdiction (**location of the party**); (iii) the infringement caused damage outside the local jurisdiction (**location of the damage**). The other possible scenario (infringed IPR is located outside the local jurisdiction) occurs more rarely, and is therefore outside the scope of the current Study.¹⁸

For the purposes of this Study, use of the term “intermediaries” will generally be in reference to hosting or access providers, unless further specified.¹⁹

Please note that the **review of MS-by-MS legal actions** in Section 6 against copyright infringing websites is based on an **analysis of 15 cases** of websites targeted for blocking or cessation, of which rightholders initiated or carried out enforcement actions (civil, criminal or administrative) of such websites in at least three MS. Litigation or blocking actions involving at least three MS was considered

¹⁸ For a further review of these categories see A. F. Christie, [Private International Law Issues in Online Intellectual Property Infringement Disputes with Cross-Border Elements: An Analysis of National Approaches](#). WIPO, 2015.

¹⁹ For a comprehensive taxonomical discussion of online intermediaries and service providers, see G. Dinwoodie, ‘Who Are Internet Intermediaries?’, in G. Frosio (ed.), *The Oxford Handbook of Online Intermediary Liability*, OUP, 2020, pp. 37-56.

to be the minimum sufficient number of MS for illustrating rightholders' choices in cross-border enforcement scenarios. Information on enforcement actions was obtained via publicly available records of court or administrative decisions, via stakeholders' inputs and literature review. Although the available sample of copyright-infringing websites against which enforcement actions were initiated in different MS is relatively limited (15), it represents some of the most notorious cases of cross-border enforcement in the EU in the period between 2006-2020.²⁰

1.5. Structure of Study

To address the objective set out above, the Study is organised in the following manner:

In line with the two objectives described above, Part I provides an overview of measures currently available for the enforcement of IPRs in cross-border contexts, with specific consideration of measures available for the enforcement of copyright and related rights in the online environment. From this evaluation of existing measures and practices of enforcement, Part II provides policy recommendations for improving the availability and use of cross-border enforcement mechanisms for copyright and related rights in the online environment.

After a brief introduction to the scope and methodology of the Study in Part I Section 1, Section 2 provides a broad **overview of the current EU legal framework on enforcement** in general, in both civil and criminal law contexts. This section identifies the numerous existing legal measures and tools already in place which directly and indirectly facilitate cross-border enforcement in the EU. Then, the section transitions to an overview of issues specific to the cross-border enforcement of IPRs in the EU, highlighting some particularities of enforcement of industrial property rights on one side and copyright and related rights on the other side.

Section 3, then, specifically discusses available enforcement options for IPRs, beginning with an overview of **voluntary enforcement measures** developed by private stakeholders, with or without governmental involvement. Later, the Section discusses measures developed by intermediaries on the basis of legal provisions (legislatively-mandated measures), and alternative dispute resolution (ADR) mechanisms.

Section 4 focuses on special **administrative bodies and procedures** currently in place in several MS for enforcing copyright and related rights online. Drawing from the experiences of stakeholders during the Study's consultation stage, several key national examples are analysed in further detail to highlight the advantages and limitations of existing administrative options for tackling infringing activities online.

Section 5 overviews existing **judicial means for cross-border enforcement of IPRs**. This Section outlines first the legal framework for establishing jurisdiction in cross-border cases, and recognising and enforcing judgments in other MS. Then the Section analyses issues pertaining to applicable law in the online copyright infringement context in EU.

Section 6 provides a practical look into the realities of **Member State-by-Member State legal actions (judicial and administrative) against cross-border copyright infringements** on the basis of information collected from publicly available sources and stakeholders during the consultation stage.

Section 7 then combines the analysis of the three main categories of existing enforcement measures (voluntary, administrative, judicial) by specifically considering their **cross-border applications**, and

²⁰ Watch List 2020, *infra*, pp. 16-35.

provides an **overall assessment of the effectiveness of currently available enforcement measures with respect to cross-border infringements**.

Part II, Section 8 concludes with an overview of **policy recommendations** for improving the cross-border enforcement of IPRs in the EU, particularly with respect to improving the cross-border enforcement of copyright and related rights in the online environment.

2. EU LEGAL FRAMEWORK ON ENFORCEMENT

The EU legal framework on cross-border enforcement has been developed independently via two separate bodies of law²¹. On one side, there are the general “horizontal” EU laws applicable to civil and commercial matters, and criminal proceedings (2.1). On the other side, there are “vertical” provisions that are applicable exclusively to IPRs (2.2). All these instruments should be considered as complementary layers of enforcement.

2.1. Cross-Border Enforcement in the EU: General Provisions

General EU provisions applicable to the cross-border enforcement of IPRs include provisions focusing on the civil and commercial matters (2.1.1) as well as tools relating to criminal law (2.1.2). These measures are complemented by other tools which facilitate cooperation between national judicial authorities and provide a framework for possible administrative enforcement, which can be available in specific cases of online IPR infringement (2.1.3).

2.1.1. Civil Law Provisions

Firstly, to improve the sound operation of the internal market, the EU legislator has been enhancing cross-border enforcement in civil matters through improvement of judicial cooperation between MS²². In this regard, a few Regulations have been enacted in order to regulate important private international law matters, including choice of jurisdiction, choice of law, and procedural aspects of mutual assistance between MS jurisdictions. These Regulations are applicable to “civil and commercial matters” that need to be understood as an autonomous notion of EU law²³. Even if the application of these provisions remains “horizontal”, some specific matters have been treated by separate Regulations²⁴, similar to the Brussels Recast Regulation. In this respect, IPRs have seen very limited specific developments in the field of private international law. Only unitary titles in the field of industrial property feature some specific rules (See Part 2.2.1). The lack of provisions targeting copyright infringement, and in particular in the online environment, has led to the creation of several draft rules by expert groups such as the CLIP Principles²⁵.

Table 1. EU Regulations facilitating cross-border enforcement in the EU

Matter	EU Regulation
Choice of jurisdiction and circulation of judgments in the EU	Regulation on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels I Recast) ²⁶
Choice of law	Regulation on the law applicable to contractual obligations (Rome I) ²⁷

	Regulation on the law applicable to non-contractual obligations (Rome II) ²⁸
Procedural aspects	Regulation on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters ²⁹
	Regulation on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents) ³⁰

Secondly, the EU created four “European procedures” to facilitate the swift and efficient recovery of outstanding debt. Even if the subject matter of these procedures is not directly related to IPRs, they could be applied to IPR claims as well. These procedures are intended to be exclusively applied to cross-border cases. These include the following procedures and orders:

²¹ J. Basedow, ‘Foundations of Private International Law in Intellectual Property’, in J. Basedow, T. Kono and A. Metzger (eds.), *Intellectual Property in the Global Arena - Jurisdiction, Applicable Law, and the Recognition of Judgments in Europe, Japan and the US*, Mohr Siebeck, 2010, pp. 3-4.

²² [Treaty on the Functioning of the European Union](#) [TFEU], 26 October 2012, Art. 81.

²³ Judgement in [Case C-420/07](#) - *Meletis Apostolides v David Charles Orams, et. al.*, European Court of Justice, 28 April 2009, ECLI:EU:C:2009:271, para. 40-41.

²⁴ For instance, matrimonial and parental judgments: [Regulation 2201/2003](#) of 27 November 2003 concerning jurisdiction and the recognition and enforcement of judgments in matrimonial matters and the matters of parental responsibility (Brussels II).

²⁵ ‘European Max Planck Group on Conflict of Laws in Intellectual Property’ in J. Basedow (ed.), *Conflict of Laws in Intellectual Property. The CLIP Principles and Commentary*, Oxford University Press, 2013. [Draft version](#).

²⁶ [Regulation 1215/2012](#) of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.

²⁷ [Regulation 593/2008](#) of 17 June 2008 on the law applicable to contractual obligations (Rome I).

²⁸ [Regulation 864/2007](#) of 11 July 2007 on the law applicable to non-contractual obligations (Rome II).

²⁹ [Regulation 2020/1783](#) of 25 November 2020 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters (taking of evidence) (recast). *Will replace as for 1 July 2022, the [Regulation 1206/2001](#) of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters.*

³⁰ [Regulation 2020/1784](#) of 25 November 2020 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents) (recast) (Regulation will apply from 1 July 2022); Replacing [Regulation 1393/2007](#) of 13 November 2007 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents).

(1) the **European order for payment procedure (EOP)**³¹, which is a written procedure covering cross-border monetary claims that are not contested. Once the EOP is ordered by a court of one MS, it can be enforced in another MS with no additional procedures.

(2) the **European Small Claims Procedure (ESCP)**³², which is a simplified and fast-track written procedure for handling cases of a maximal value of 5,000 euros. This procedure deals with both contested and uncontested cases and contains provisions of a procedural nature including for the holding of an oral hearing and the taking of evidence. Once the ESCP is issued by a jurisdiction of one MS, it can be enforced in another MS without any additional procedure.

(3) the **European Account Preservation Order (EAPO)**³³, which is a measure concerning the 'freezing' of bank accounts to prevent recalcitrant debtors, from moving funds out of or between accounts to the detriment of creditors' interests. This procedure applies to a debtor that has bank accounts situated in several MS. Under the EAPO procedure, a single order from the courts of one MS can 'freeze' any bank account of a debtor in any MS. The order should be issued ex parte. At the same time, the amount 'frozen' should reflect the amount of the creditor's legitimate claim.

(4) The fourth procedure, the **European Enforcement Order for uncontested claims (EEO)**³⁴, simplifies the enforcement of a judgment in a MS other than that in which it has been given by laying down minimum procedural standards. This Regulation covers all situations in which a creditor has obtained either a court decision against the debtor or has an enforceable document vouching or acknowledging the debt which requires the debtor's express consent in form of authentic instrument, or a settlement approved by a court. The judgment on an uncontested claim certified as a EEO in the MS of origin is recognized and enforced in other MS.

Thirdly, a few EU Directives were adopted with the aim of simplifying the resolution of cross-border civil cases. Two of them, in particular, should be mentioned:

(1) Directive 2002/8/EC³⁵ to improve access to justice in cross-border disputes by establishing minimum common rules relating to **legal aid** for such disputes. This Directive establishes the EU-wide rules on legal aid for people who cannot afford the legal help.

(2) Directive 2008/52/EC³⁶ on certain aspects of **mediation** in civil and commercial matters.

2.1.2. Criminal Law Provisions

Though crimes occurring in digital contexts often involve transnational elements, such crimes are still generally prosecuted by national authorities enforcing national laws. In fact, in criminal matters it is not possible to divide jurisdictional competency from applicable law.³⁷ To address the unique characteristics of crimes occurring in the borderless online space, the EU started to harmonize to a very

³¹ [Regulation 1896/2006](#) of 12 December 2006 creating a European order for payment procedure.

³² [Regulation 2015/2421](#) of 16 December 2015 amending Regulation 861/2007 establishing a European Small Claims Procedure and Regulation 1896/2006 creating European order for payment procedure.

³³ [Regulation 655/2014](#) of 15 May 2014 establishing a European Account Preservation Order procedure.

³⁴ [Regulation 805/2004](#) of 21 April 2004 creating a European Enforcement Order for uncontested claims.

³⁵ [Directive 2002/8/EC](#) of 27 January 2003 to improve access to justice in cross-border disputes by establishing minimum common rules relating to legal aid for such disputes.

³⁶ [Directive 2008/52/EC](#) of 21 May 2008 on certain aspects of mediation in civil and commercial matters.

³⁷ J. Azéma and J.-Ch. Galloux, *Droit de la propriété industrielle*, Précis Dalloz, 2017, p. 1221.

limited extent some criminal provisions to facilitate cross-border cooperation in criminal matters. In particular, IPR infringement is criminalized to some extent in the MS³⁸, including as a part of the transposition of the **Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)**³⁹ and is addressed in the **European Cybercrime Convention**⁴⁰. Criminal measures are available in all MS against IPTV infringers on a commercial scale.⁴¹

The EU legal and institutional framework offers some additional tools to assist national authorities prosecuting crimes with transnational qualities by enhancing evidence gathering, investigations and providing an infrastructure for mutual assistance between MS authorities. These measures may have an indirect effect on cross-border enforcement of IPRs, such as

- (1) the **Convention on Mutual Assistance in Criminal Matters**⁴² aiming at encouraging and facilitating mutual assistance between judicial, police and customs authorities on criminal matters, and to improve the speed and efficiency of judicial cooperation;
- (2) the **European Investigation Order Directive**⁴³ setting up a comprehensive system that allows MS to obtain evidence in other MS, for criminal cases that involve more than one MS (the Directive applies to all MS except Denmark and Ireland);
- (3) the **European arrest warrant ("EAW")**⁴⁴, a simplified cross-border judicial surrender procedure for the purpose of prosecution or executing a custodial sentence or detention order. A warrant issued by a judicial authority of one MS is valid in the entire EU territory. EAW constitutes a request by one MS' judicial authority to arrest a person in another and surrender them for prosecution, or to execute a custodial sentence or detention order issued by the first MS. Operational since 1 January 2004, the EAW replaced the lengthy extradition procedures that used to exist between MS.⁴⁵

³⁸ On the international norms on criminal enforcement of IPRs, see H. Grosse Ruse-Khan, 'Criminal enforcement and international IP law', in C. Geiger (ed.), *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research*, Edward Elgar, 2012, pp. 171-190, and T. Mylly, 'Criminal enforcement and European Union law', in C. Geiger, *ibid.*, pp. 213-244.

³⁹ Article 61 of TRIPS provides that Members shall provide for criminal procedures and penalties to be applied at least in cases of willful infringement of trade mark or copyright on a commercial scale. [Agreement on Trade-Related Aspects of Intellectual Property Rights](#), (TRIPS) WTO, 1994. For a comment on this obligation, C. Geiger and N. Kapyrina, 'Les procédures pénales dans l'Accord sur les ADPIC : à la recherche de l'équilibre', in C. Geiger (ed.), *Le droit international de la propriété intellectuelle lié au commerce : L'accord sur les ADPIC, bilan et perspectives*, LexisNexis, 2017, pp. 343-366.

⁴⁰ Article 10 of the European Cybercrime Convention provides for the criminalisation of offences related to infringements of copyright and related rights, where such acts are committed willfully, on a commercial scale and by means of a computer system. States parties to the Convention may reserve the right not to impose criminal liability in limited circumstances, provided that other effective remedies are available and that such reservation does not derogate from the international obligations. Only non-EU states made such reservations (Australia, Canada, Costa Rica, Israel and the USA).

⁴¹ M. Borghi, et al., '[Illegal IPTV in the European Union: Research on online business models infringing intellectual property rights](#)', Report for EUIPO, 2019, pp. 10 and 62.

⁴² [Council Act of 29 May 2000](#) establishing in accordance with Article 34 of the Treaty on European Union the Convention on Mutual Assistance in Criminal Matters between the Member States of the European Union.

⁴³ [Directive 2014/41/EU](#) of 3 April 2014 regarding the European Investigation Order in criminal matters.

⁴⁴ [Framework Decision of 13 June 2002](#) on the European arrest warrant and the surrender procedures between Member States (2002/584/JHA).

⁴⁵ European e-Justice Portal, [European Arrest Warrant](#).

Box 1. Cross-border enforcement of a European arrest warrant

In a Swedish criminal copyright infringement case against a Turkish national living in Germany, on 14 July 2015, the Swedish Prosecution Authority issued an EAW in the suspect's absence and demanded his extradition to Sweden to participate to the trial on charges of copyright infringement and gross money laundering. The suspect was accused of making available over 1400 copyright-protected films at least from January 2013 until July 2015 and making over EUR 1 500 000 in profits. On 28 October 2015, the German Federal Police Inspectorate of an airport notified Swedish authorities that the suspect had been checked the day before, entering Germany from Turkey. The Swedish court was informed that the suspect had his domicile in Germany. On 14 January 2016, the German authorities enforced the EAW and detained the suspect in a local prison, and later he was handed to Swedish authorities and placed in custody.

(4) the **mutual recognition to financial penalties** framework decision⁴⁶, which introduces specific measures, under the principle of mutual recognition, allowing a judicial or administrative authority to transmit a financial penalty directly to an authority in another MS, and to have that fine recognized and executed without any further formality.

(5) Finally, recognition and execution of **freezing orders on property and evidence** issued by a judicial authority of another MS is facilitated by the **Regulation on mutual recognition of freezing orders and confiscation orders**⁴⁷. This Regulation provides for cross-border recovery of criminal assets, thereby leading to more efficient freezing and confiscation of funds from illicit origins in criminal cases in the EU. Currently, EU institutions are working on improving measures which also aiming to **facilitate evidence gathering in criminal matters among MS**⁴⁸.

2.2. Cross-Border Enforcement of IPRs in the EU

EU legislation establishes the basic framework for IPR enforcement in the online context. The IPR Enforcement Directive (IPRED) harmonised to some extent non-criminal measures available for IPR enforcement in the EU. In the past, a European Commission's Proposal for a Directive on criminal enforcement of IPRs was withdrawn by the Commission after several years of discussions and criticism, due to a lack of political consensus.⁴⁹ Injunctions, provided by Art. 11 of the IPRED, have proven to be some of the most used civil remedies against online infringers and intermediaries whose services are used to infringe IPRs.

This broad, generalised EU legal framework on enforcement is complemented by IPR-specific rules articulated at the EU and national levels. On the one hand, industrial property rights have their own specific rules that to some extent will be applicable in lieu of the general provisions included in the Brussels I Recast Regulation (2.2.1). On the other hand, copyright and related rights presents a unique situation that can be distinguished from industrial property rights, particularly with respect to the differences in national legislative implementations of EU law, and the lack of a single EU copyright title.

⁴⁶ [Framework Decision 2005/214/JHA](#) of 24 February 2005 on the application of the principle of mutual recognition to financial penalties.

⁴⁷ [Regulation 2018/1805](#) of 14 November 2018 on the mutual recognition of freezing orders and confiscation orders.

⁴⁸ Proposal for a Regulation on European Production and Preservation Orders for electronic evidence in criminal matters, [COM/2018/225 final](#); Proposal for a Directive laying down harmonised rules on the appointment of legal representatives for the purpose of gathering evidence in criminal proceedings, [COM/2018/226 final](#).

⁴⁹ For analysis of the proposed text, see J. Gibson, 'The Directive Proposal on criminal sanctions', in C. Geiger (ed.), *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research*, Edward Elgar, 2012, pp. 245-266.

Additionally, within the copyright industry, several nuances related to the characteristics of the content in question may raise particular enforcement concerns of their own (2.2.2).

2.2.1. Industrial Property Rights

Among the industrial property rights, this Study briefly discusses EU trade marks and European patents. The former, as an EU unitary title, shows a high level of harmonisation of substantive law between MS, including harmonization of enforcement provisions. European patent law is not harmonised at the EU level, but some recent legal developments could lead to a significant improvement in the cross-border enforcement of patents in the EU.

a. EU trade marks

EU trade marks are unitary titles issued by the EUIPO and valid throughout the EU. The unitary TM title implies the harmonization of the substantive law and also contains provisions on the enforcement. Only special courts (EUTM courts) can deal with EUTM-related matters. The creation of these courts was intended to prevent forum shopping, increase foreseeability, and ensure the sound administration of justice.

The EUTM courts also enjoy a specific legal regime with regard to **international jurisdiction**. Thus, the rules laid down in the Brussels Recast Regulation apply only if the special rules contained in the EUTMR do not interfere with them. These special rules in the EUTMR consist of three **general rules** that are the following: **(1)** Defendant's domicile or defendant's establishment⁵⁰; **(2)** If the previous rule does not apply, the action can be brought in the courts of the plaintiff domicile or establishment⁵¹; **(3)** If the previous rules do not apply, the proceeding will be brought in Spain - court of the MS where the EUIPO has its seat⁵². In addition, the fourth **alternative rule** completes this list. This is the **(4) *forum loci delicti***⁵³ rule. According to this rule the competent court of a MS is the one in which the act of infringement has been committed or threatened, or in which an act giving rise to reasonable compensation has been committed. The ECJ has had the opportunity to rule on the application of this rule in the **AMS Neve case**⁵⁴ by introducing the targeting approach for the online trademark infringement⁵⁵.

The distinction between general and alternative jurisdiction has a direct impact on the extent of the court's jurisdiction. In the first case, the court has jurisdiction over the entire claim. This implies measures having an EU-wide effect and damages for the entirety of the harm suffered. On the contrary, in the presence of the alternative jurisdiction, the extent of the jurisdiction is limited to the acts committed in the territory where the court is located⁵⁶.

⁵⁰ EUTMR, Art. 125 (1).

⁵¹ EUTMR, Art. 125 (2).

⁵² EUTMR, Art. 125 (3).

⁵³ EUTMR, Art. 125 (5).

⁵⁴ See Judgment in [Case C-172/18](#) – *AMS Neve Ltd and Others. v Heritage Audio SL and Pedro Rodriguez Arribas*, European Court of Justice, 5 September 2019, ECLI:EU:C:2019:674.

⁵⁵ See L. Lundstedt, 'AMS Neve and Others (C-172/18): Looking for a Greater 'Degree of Consistency' Between the Special Jurisdiction Rule for EU Trade Marks and National Trade Marks', *GRUR Int.*, Vol. 69(4), 2020, pp. 355-364.

⁵⁶ EUTMR, Art. 126 (2).

If the injunctive relief is at issue, in principle the cease-and-desist order must be EU-wide⁵⁷, unless the defendant proves that the EUTM, in a given part of the EU, does not infringe the TM's function.

As regards the applicable law⁵⁸, the EUTM courts should apply the provisions of the EUTMR. However, for all matters not dealt with by the EUTMR the applicable law is the *lex fori*. This leads to the application of Rome II provisions (See Part. 5.2). Furthermore, as regards procedural rules, the EUTM court applies the national rules unless the EUTMR provides otherwise.

b. European patents

The harmonization of European patent law has been achieved through the European Patent Convention⁵⁹, which is not an EU legal instrument. Thus, substantive patent law within the MS is not currently harmonised by EU law, as opposed to EU trade marks.

As far as international jurisdiction is concerned, for the time being, European patent law does not contain any rules derogating from the Brussels Recast and Rome II Regulations. The application of the rule on exclusive jurisdiction⁶⁰ in the presence of counterclaim for invalidity makes European patent litigation mainly national. Indeed, the invalidity of the title is regularly invoked in patent infringement proceedings. This, in turn, can lead forum shopping in patent law, which can determine the outcome of a dispute depending on the jurisdiction chosen⁶¹.

However, this situation will change with the entry into force of the "Unitary patent package"⁶². The creation of a specialized court common to those MS which have ratified the UPC agreement, **will provide a basis for cross-border patent enforcement**. After the expiration of a seven-year 'opt-out' period,⁶³ the Unitary Patent Court (UPC) will have an exclusive competence to hear both actions relating to European patents with a unitary effect and cases involving mere European patents⁶⁴.

In anticipation of the establishment of the UPC, the Brussels I Regulation has been amended⁶⁵ to clarify that the UPC is a "jurisdiction" in the meaning of this Regulation. All judgments given by the UPC will be recognized and enforced in accordance with Brussels provisions. This amendment will facilitate the

⁵⁷ See Judgment in [Case C-235/09](#) – *DHL Express France SAS v Chronopost SA*, European Court of Justice, 12 April 2011, ECLI:EU:C:2011:238, para. 50.

⁵⁸ EUTMR, Art. 129.

⁵⁹ [European Patent Convention](#), EPC of 5 October 1973.

⁶⁰ Brussels Recast Regulation, Art. 24 (4): "The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties: [...] (4) in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defense, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place."

⁶¹ See D. Perkins and G. Mills, 'Patent infringement and forum shopping in Europe', *Fordham ILJ*, Vol. 20 (2), 1996, pp. 549-601.

⁶² [Regulation 1257/2012](#) of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection; [Regulation 1260/2012](#) of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements; [Agreement on a Unified Patent Court](#).

⁶³ Article 83(1) UPCA (before the expiration of the seven years opt-out period, the UPC will have limited competence to hear the cases relating to the EU patent).

⁶⁴ See P. A. Asensio, 'Regulation (EU) No 542/2014 and the International Jurisdiction of the Unified Patent Court,' *IIC*, Vol. 45(8), December 2014, pp. 868-888.

⁶⁵ [Regulation 542/2014](#) of 15 May 2014 amending Regulation 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice, 29 May 2014.

enforcement of UPC judgments in the non-contracting MS⁶⁶. In fact, Spain and Croatia have not signed “the unitary patent package”. Moreover, Poland has signed the EU Unitary patent Regulations but has not signed the UPC Agreement. For the moment, these three MS are not participating in the “unitary patent package”. Once, the UPC is in place, these three MS will continue to apply current provisions of the Brussels Recast Regulation.

2.2.2. Copyright and Related Rights

a. Substantive Laws

Copyright and related rights provide creators (authors and performers) and other rightholders (e.g., producers, broadcasters) with rights over works, phonograms, broadcasts and other subject matters, allowing them to control the manner in which such expressions are reproduced, distributed or communicated to the public.

Copyright and related rights are national rights, granted by national laws and applied by national courts.⁶⁷ The legal basis for international copyright protection stems from the principles of national treatment and minimum level of protection set out by international copyright treaties.⁶⁸ In the case of copyright and related rights, the principle of national treatment is enshrined at the international level through the Berne Convention, which guarantees foreign rightholders the same level of protection granted to nationals of the country in which protection is sought.⁶⁹ Copyright and related rights of MS are further harmonised by a set of EU Directives which are both horizontal (cross-sectoral) and vertical (sector-specific) in nature, as well as by a rich body of case-law of the Court of Justice of the European Union (CJEU). In spite of all these harmonisation achievements, there are a few particular challenges for cross-border copyright enforcement in comparison to the industrial property rights.

At the EU level, linked to the provisions of the IPRED⁷⁰ are copyright-specific enforcement provisions of Art. 8(3) of the InfoSoc Directive, which provides for injunctive relief against the intermediaries “whose services are used by a third party to infringe a copyright or a related rights”.⁷¹ These provisions are further reinforced by the generalised liability exemption regimes of Art. 12 (“mere conduits”), Art. 13

⁶⁶ See P. Véron, ‘Le règlement (UE) n° 542/2014 modifiant le règlement Bruxelles I (refonte) concernant les règles applicables à la juridiction unifiée du brevet et à la Cour de justice Benelux’, *JDI* 2/2016, LexisNexis, pp. 523-545.

⁶⁷ See eg, for the application of the principle of territoriality to copyright under EU law, Judgement in [Case C-170/12 - Pinckney v KDG Mediatech](#), European Court of Justice, October 2013, ECLI:EU:C:2013:635, and Judgement in [Case C-192/04 - Lagardère Active Broadcast v SPRE and GVL](#), European Court of Justice, July 2005, ECLI:EU:C:2005:475.

⁶⁸ Most notably by the Berne Convention, the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1961), TRIPS (1994), WIPO Copyright Treaty (1996) and WIPO Performances and Phonograms Treaty (1996).

⁶⁹ Berne Convention for the Protection of Literary and Artistic Works, 9 September 1886, as revised at Stockholm on 14 July 1967 (Berne Convention), Art. 5(2).

⁷⁰ The limited copyright scope of the injunctions is, then, extended to IPR enforcement at large by the IPRED, which provides that ‘Member States shall also ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right, without prejudice to Article 8(3) of Directive 2001/29/EC’. See IPRED, art. 11.

⁷¹ [Directive 2001/29/EC](#) of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (InfoSoc Directive) OJ L 167, 22.6.2001, p. 10–19. For a comment of Art. 8(3), J. Nordemann, ‘Website Blocking under EU Copyright Law’, in E. Rosati (ed.), *The Routledge Handbook of EU Copyright Law*, Routledge, 2021, pp. 361–374.

(caching) and Art. 14 (hosting) of the E-Commerce Directive ("ECD")⁷² applying horizontally to all forms of illegal activity and content, obliging information society service providers to remove or disable access to illegal content once known or upon court order. In the Copyright in the Digital Single Market Directive (CDSM Directive),⁷³ adopted in 2019, its Art. 17 further elaborates rules on the liability of online content-sharing service providers for the infringement of copyright and related rights online, thus creating a vertical liability regime that applies as *lex specialis* next to the general ECD liability regime.⁷⁴ Meanwhile, the European Parliament has called for legislative proposals that will provide 'harmonised requirements for digital service providers to apply effective, coherent, transparent and fair procedures and procedural safeguards to address illegal content in line with national and European law, including via a harmonised notice-and-action procedure'.⁷⁵ To this end, the Digital Services Act reproduces unchanged the liability exemptions provided for by the ECD, in particular the hosting exemption and the principle of no general monitoring obligations,⁷⁶ while introducing for the first time in EU law a legislatively-mandated notice-and-action system.⁷⁷ Actually, the DSA proposal strengthens even further the ECD knowledge-and-take-down approach by clarifying in the negative the *vexata questio* whether voluntary monitoring makes DSPs ineligible for the liability exemption. DSPs shall not be deprived of the protection granted by liability exemptions "solely because they carry out voluntary own-initiative investigations or other activities aimed at detecting, identifying and removing, or disabling of access to, illegal content, or take the necessary measures to comply with the requirements of Union law, including those set out in this Regulation".⁷⁸

While the discussion of the DSA proposal is ongoing and the new regulation will take quite some time before being enacted into legislation (if that is the case), the MS' reception of the CDSM Directive should have already occurred by the deadline of 7 June 2021. However, the provisions of the CDSM Directive have so far been transposed only by a few MS,⁷⁹ and the state of play of this transposition seems quite inconsistent at the moment with very different approaches taken by MS, such as in the cases of Germany or France.⁸⁰ Yet, even the transposition and practical application of longstanding legislative provisions – Art. 11 of the IPRED, Art. 8(3) of the InfoSoc Directive, and Arts. 12, 13 and 14 of

⁷² [Directive 2000/31/EC](#) of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (E-Commerce Directive, ECD), 17 July 2000.

⁷³ CDSM Directive.

⁷⁴ See, e.g., J. Quintais and S. Schwemer, 'The Interplay between the Digital Services Act and Sector Regulation: How Special is Copyright?', SSRN Research Paper No. 3841606/2021, 7 May 2021; M. Husovec and J. Quintais, 'How to License Article 17? Exploring the Implementation Options for the New EU Rules on Content-Sharing Platforms', *GRUR International*, Vol. 4, 2021.

⁷⁵ [Resolution](#) of 20 October 2020 on the Digital Services Act and fundamental rights issues posed, (EP Resolution on the DSA and FR), European Parliament, point 25. Proposals have been also made in Niombo Lomba and Tatjana Evas, [Digital service act: European added value assessment](#), European Parliament, October 2020, including a series of research papers as annexes: C. Tarin and others, "Annex I: Quantitative assessment of the European added value of a digital services act"; G. Spindler, "Annex II: Digital services act: Adapting commercial and civil law rules for commercial entities operating online: Legal assessment"; J. Nordemann and others, "Annex III: Digital services act: Improving the functioning of the single market".

⁷⁶ See Proposal for a Regulation on a Single Market for Digital Services (Digital Services Act) and amending Directive 2000/31/EC (DSA Proposal), [COM\(2020\) 825 final](#), European Commission, 15 December 2020, arts. 5 and 7.

⁷⁷ Ibid.

⁷⁸ Ibid., art. 6.

⁷⁹ [Copyright: Commission calls on Member States to comply with EU rules on copyright in the Digital Single Market](#), European Commission, 26 July 2021.

⁸⁰ See, e.g., [Copyright in the Digital Single Market Directive – Implementation](#), CREATe website.

the ECD – vary among MS.⁸¹ For example, the same types of blocking orders (e.g., “static”, “dynamic”, “live”), a form of injunctive relief, are not available in all MS.⁸² In addition, the determination of conditions and procedures for granting blocking orders has also been left to the national laws of MS, which in turn affects the speed and costs of measures available.⁸³ Recital 59 of the InfoSoc Directive states that “The conditions and modalities relating to such injunctions should be left to the national law of the Member States”, Recital 23 of the IPRED reaffirms “The conditions and procedures relating to such injunctions should be left to the national law of the Member States”, and Art. 14(3), in the same vein, reiterates that “This Article shall not [...] affect the possibility for Member States of establishing procedures governing the removal or disabling of access to information”. Hence, in some MS, blocking injunctions can be imposed only by courts, while in others by administrative bodies and/or courts.⁸⁴

Finally, it is also worth noting that, unlike in most of domains of industrial property rights, harmonisation in the domain of copyright and related rights was not undertaken through Regulations, which are directly applicable, but through Directives, which only create obligations as to the goals to be achieved by the Directive text, and leave MS free with regard to the means for achieving such goals. This is one of the reasons explaining some of the large variations in the scope of “harmonised” national laws of MS. Consequently, the absence of a common applicable law creates challenges for cross-border enforcement of copyright and related rights.

b. Sector-Specific Enforcement Issues

The characteristics of the different sectors of the copyright industry reveals some additional, unique enforcement needs depending on the type of content in question.

For example, the stakeholder consultations highlighted a few particular issues pertaining to copyright infringements of video games. In the video game industry, copyrighted content has a “non-linear” form; unlike a music file that can be played from beginning to end, game files are consumed (played) with user input. As a result, “digital fingerprinting” technologies commonplace to the music and audiovisual industry used to scan uploaded content for infringement cannot be applied in the same way. Game files are also comparatively larger in size, and therefore cannot be easily hosted on certain online services. Some video game companies also have controlled online marketplaces for content, making any appearance of content outside the marketplace an infringement. In these respects, services such as digital lockers, and websites providing links to download large files (including social media), are the most important sources of infringement given the unique characteristics of copyrighted game content.

In the sports broadcasting industry, as an initial matter, not all MS provide protection for broadcasters under copyright or related rights. Additionally, the “live” nature of content requires rapid action, as the value of the content is concentrated at the time of, or shortly after, its initial broadcast.⁸⁵ Accordingly, given the specific characteristics of the content in this sector, a tailored approach to its enforcement was deemed necessary. The 2017 decision of the UK High Court in *FAPL v. BT* provided a means for

⁸¹ As also confirmed during the stakeholder consultations.

⁸² See Frosio and Bulayenko, op. cit.

⁸³ Ibid.

⁸⁴ Ibid.

⁸⁵ For a related Study on live blocking injunctions in the sports broadcasting context, see Panella and Firrito, op. cit.

injunctive relief against streaming servers, with the order effective during the times the content is broadcasted.⁸⁶

As far as improving the cross-border enforcement status quo, while maintaining the territorial scope of rights and their enforcement may be preferred by rightholders in some creative industry sectors (e.g., music, audiovisual), it is still the case that the phenomenon of large commercial-scale infringement in the online context regularly occurs in a few or all EU jurisdictions simultaneously. Although injunctive relief could be obtained in one MS, borderless online infringements originating from the same source could be continued in another MS, requiring enforcement actions in multiple MS for essentially the same matters (see Tables 2 and 3 with examples of legal actions in different MS against the same infringing websites).

Based on these observations, the current horizontal approach to enforcing IPRs may not be sufficient considering the nuances of each copyright sector and each type of infringement in question. As discussed in greater detail in Section 8. Policy Recommendations, more tailored approaches to enforcement can perhaps be considered to ensure that such measures are effective and proportional to the harm caused by the infringing activity.

2.3. Enforcement Cooperation Tools

Based on principles of mutual trust and legal cooperation between MS, cross-border enforcement at the EU level is not only dealt by formal legally binding acts, but also includes other generalised and IPR-specific institutionalised tools which serve to promote cooperative efforts between EU judicial authorities.

One key cooperative measure between MS in civil matters is the **European Judicial Network in civil and commercial matters** (EJN)⁸⁷. Created by the EU Commission, the EJN is an informal, flexible structure, whose aim is to improve, simplify and expedite effective judicial cooperation between the MS in civil and commercial matters. Similarly, the **European Judicial Training Network**⁸⁸ provides an opportunity for justice professionals representing different MS to become familiarised with one another's legal systems, and promotes mutual recognition and cross-border cooperation between judicial authorities. Moreover, the **E-Justice Portal**⁸⁹ plays an informative role by providing a platform for gathering information on MS judicial systems in 23 languages, thereby improving access to justice throughout the EU.

For criminal matters, cooperation between different MS also takes place via judicial networks and institutionalised means of cooperation. Two important EU authorities collaborate closely with national judicial authorities, and operate with a broad mandate: (1) the **European Union Agency for Criminal Justice Cooperation** (EUROJUST), which aims at fighting serious organised cross-border crimes, facilitating investigations and prosecutorial tasks which involve two or more MS; and (2) the **European**

⁸⁶ See [Football Association Premier League v British Telecommunications](#) [2017] EWHC 480 (Ch). In the UK, sports broadcasts are protected by copyright under the Copyright, Designs and Patents Act of 1988. See also, for further discussion of live blocking injunctions of sports broadcasts, Frosio and Bulayenko, op. cit.

⁸⁷ [Council Decision of 28 May 2001](#) establishing a European Judicial Network in civil and commercial matters.

⁸⁸ Communication on judicial training in the European Union, [COM/2006/0356 final](#), European Commission, 29 June 2006.

⁸⁹ [European e-Justice Portal](#).

Union's law enforcement agency (Europol), which centres its operations on large-scale criminal and terrorist networks.

The European Multidisciplinary Platform Against Criminal Threats (**EMPACT**) is a security initiative driven by EU MS to identify, prioritise and address threats posed by organised and serious international crime. In 2021, EMPACT became a permanent instrument,⁹⁰ and "Intellectual property (IP) crime, counterfeiting of goods and currencies" was set as one of its ten priorities for the fight against serious and organised crime between 2022 and 2025⁹¹.

Exchange of information between members of the judiciary, also through trainings, plays an important role for the development of common European enforcement practices. It is notably manifested through the so-called "**legal entanglement**", when judges of one MS refer to the judgements in other MS. For example, a civil court decision of 2015 in the UK regarding Popcorn Time was relied upon in the same year in a criminal case in Denmark, and then also in Belgium and Italy.⁹² In 2020, the Irish court referred to the UK case on blocking injunctions.⁹³ Additionally, there are judicial networks in place which focus their efforts on specific domains, including:

(1) **IP matters**, such as in the case of the **European Intellectual Property Prosecutors Network** (EIPPN) aiming to facilitate the exchange of knowledge and expertise between judicial authorities, as well as reinforce the collective investigating and prosecuting capacity of judicial authorities to address cross-border IPR conflicts. In addition, the **European Observatory on Infringements of Intellectual Property Rights** is hosted and managed by the European Union Intellectual Property Office (EUIPO) since 2012⁹⁴, and consists of a network of experts and specialist stakeholders. The Observatory brings together representatives from EU bodies, authorities in EU countries, businesses, and civil society organisations in order to share information and best practices, formulate comprehensive studies relevant to the IPR field, raise public awareness on IPRs and infringement, strengthen cooperation between IPR stakeholders, and develop better tools for addressing the infringements of IPRs occurring online.⁹⁵

(2) **Joint Investigation**, such as in the case of the **Network of National Experts on Joint Investigation Teams**⁹⁶. This Network was established in 2005 to facilitate the work of legal practitioners, as well as to encourage the use of JITs and contribute to the sharing of experience and

⁹⁰ Council of the European Union, [Council conclusions on the permanent continuation of the EU Policy Cycle for organised and serious international crime: EMPACT 2022+](#), 26 February 2021, 6481/21.

⁹¹ Council of the European Union, [Council conclusions setting the EU's priorities for the fight against serious and organised crime for EMPACT 2022 - 2025](#), 12 May 2021, 8665/21.

⁹² 'International judicial cooperation in intellectual property cases: Study on legislative measures related to online intellectual property infringements: phase 2' EUIPO, 2021, p. 70.

⁹³ Frosio, G. and Bulayenko, O., 'Study on Dynamic Blocking Injunctions in the European Union: IPR enforcement case-law collection', EUIPO, 2021, pp. 57-58.

⁹⁴ [Regulation 386/2012](#) of 19 April 2012 on entrusting the Office for Harmonization in the Internal Market (Trade Marks and Designs) with tasks related to the enforcement of intellectual property rights, including the assembling of public and private-sector representatives as a European Observatory on Infringements of Intellectual Property Rights.

⁹⁵ Commission Staff Working Document accompanying the document Report from the Commission to the European Parliament, the Council and the European Economic and Social Committee evaluation of the Application of the Regulation (EU) No 386/2012 of 19 April 2012, [SWD\(2020\) 282 final](#), European Commission, 24 November 2020.

⁹⁶ [Council Framework Decision of 13 June 2002](#) on joint investigation teams, p. 1-3.

best practice in using this tool. Since 2005, the JITs Network Secretariat has organised annual meetings of the JITs Network with support from Eurojust and Europol. The meetings provide a forum for JIT practitioners from the Member States and relevant EU institutions to share experience and challenges and propose solutions from a practitioner's point of view.

(3) Cybercrimes, such as in the case of the **European Judicial Cybercrime Network**. This Network was established in 2016 to foster contacts between practitioners specialised in countering the challenges posed by cybercrime, cyber-enabled crime and investigations in cyberspace, and to increase the efficiency of investigations and prosecutions. The EJCEN facilitates and enhances cooperation between competent judicial authorities by enabling the exchange of expertise, best practice and other relevant knowledge regarding the investigation and prosecution of cybercrime.

Another key measure enhancing the cooperation of enforcement is the **Counterfeit and Piracy Watch List** (Watch List), a list published by the European Commission designed to encourage operators, owners, local enforcement authorities and governments to take action and/or adopt measures towards reducing the availability of IPR infringing goods and services in marketplaces.⁹⁷ The Watch List includes known and reported examples of marketplaces or service providers (whose operators or owners reside outside the EU) who reportedly engage in, facilitate or benefit from IPR infringing activities.⁹⁸ The List covers four main sectors relevant to the protection of IPRs: 1) online marketplaces offering copyright-protected content; 2) e-commerce platforms; 3) online pharmacies and service providers facilitating the sales of medicines; and 4) physical marketplaces, providing subcategories within each of the four broad categories. The Watch List is currently in its second iteration since 2018 and provides several positive examples of developments in the international IPR enforcement arena resulting from its first round.⁹⁹

In assembling the Watch List, Commission services periodically consult with stakeholders during the consultation process, and work to 'ensure that the information is accurate to the best of their knowledge and duly verified'.¹⁰⁰ The List is further administered with the assistance of European institutions such as the EUIPO, European Anti-Fraud Office (OLAF), and Europol. Nonetheless, the Watch List is not a legally-binding instrument, as the Commission makes no representations as to the legality or illegality of the websites or services that it lists.¹⁰¹

From the consultations, rightholders and legal practitioners were generally aware about the Watch List and considered it as a somewhat useful tool for sharing information and bringing awareness of infringers committing illegal activity on a commercial scale. Several rightholder groups have recounted their experiences with using the Watch List and submitting contributions to the European Commission for addition to the Watch List. However, the non-binding nature of the Watch List, as well as the self-imposed limitations on the legal commitment of the Commission, limit its efficacy and usefulness in enforcement proceedings. During stakeholder consultations, some rightholders reported to have attempted to use the list as evidence in judicial proceedings, for example, without much success.

⁹⁷ '[Commission Staff Working Document: Counterfeit & Piracy Watch List](#)', (Watch List 2020) European Commission (2nd Ed.), 14 December 2020; [Commission Staff Working Document: Counterfeit & Piracy Watch List](#)', (Watch List 2018) European Commission, 7 December 2018.

⁹⁸ Watch List 2020, p. 5.

⁹⁹ Ibid., pp. 13-15.

¹⁰⁰ Ibid., p. 6.

¹⁰¹ Ibid.

A concern raised by some stakeholders with respect to the Watch List relates to the lack of fundamental rights or procedural safeguards when listing allegedly infringing services. First, it was unclear to what extent Internet users or consumer groups were able to contribute to the Watch List, or to which extent such organisations are able to dispute the status of the services listed *ex post*. Part of this concern stems from the fact that the majority of stakeholders who participated in the public consultation on the Watch List belonged to rightholder groups, whereas the involvement of user and consumer groups was much more limited.¹⁰² Additionally, third parties can propose that websites or marketplaces should be included on the List without being required to produce any proof of a violation of IPRs, and without publicly disclosing their identity.

Another issue raised was that, while the Commission openly states that it “does not purport to make findings of legal violations” in its Watch List initiative, the essential purpose of the list is ‘to target those involved in commercial-scale infringements of intellectual property rights’.¹⁰³ Accordingly, it has been argued that such mixed messages may still imply the European Commission’s stance on the illegality of the service listed, and that the disclaiming language contained in the text of the Watch List may be insufficient in preventing a potential reputational loss on behalf of a website or marketplace which has been unfairly listed.¹⁰⁴

In spite of criticism, the approach of the Watch List could also be described as a prudent one. The European Commission does not automatically add to the list the services received from rightholders. Following its adopted methodology, the Commission’s services invest effort into cross-checking multiple sources of information, including existence of judicial or administrative blocking orders against the reported websites. The prudence of this approach could be also underscored by the fact that the Commission’s services did not add to the list all online infringing services against which multiple blocking orders had been issued in different MS.¹⁰⁵

As a policy measure for combatting wilful large-scale online copyright infringement, the Watch List initiative is generally viewed as a step in the right direction. However, its various shortcomings related to its authoritativeness and the adequacy of its procedural safeguards leave ample room for improvement. Some of these options are discussed in further detail below (Section 8. Policy Recommendations).

¹⁰² [Public Consultation on the Counterfeit and Piracy Watch List](#), European Commission, 1 June 2020.

¹⁰³ Watch List (2018), p. 3; [Watch List: Commission sets sights on counterfeit and piracy hotspots](#) European Commission News Archive, 7 December 2018.

¹⁰⁴ Letter from a stakeholder to Carlo Pettinato Head of Unit, DG Trade re: the Counterfeit and Piracy Watch List, 7 October 2020.

¹⁰⁵ E.g., out of 15 services listed in Tables 2 and 3, only 8 were listed in the Watch List 2020 (see Annex III to the Study).

3. VOLUNTARY MEASURES

The EU has prioritized the use of voluntary and self-regulatory measures in the context of tackling illegal content online.¹⁰⁶ These measures, involving the adoption of codes of conduct, codes of practice, memoranda of understanding, and other voluntary arrangements, are specifically encouraged in several Directives related to the enforcement of IPRs.¹⁰⁷ In general, these “self-regulatory” arrangements prioritize the role of private actors in developing enforcement solutions within a specific industry, incorporating varying degrees of State support to facilitate their administration.¹⁰⁸ Their common denominator is that they go beyond the baseline legal expectations created by the legal liability framework. Inherently, their common trajectory is towards more proactive tackling of illegal or otherwise objectionable content. In practice, miscellaneous forms of ‘responsible’ behaviours beyond the law have been recently emerging via multiple enforcement tools applied by different categories of online service providers.¹⁰⁹ They are usually applied via codes of conducts and standardization, while targeting a vast array of online intermediaries, such as (1) DNS providers in the case of private DNS content regulation, (2) access providers for website blocking and graduate response; (3) search engines, in the case of online search manipulation; (4) hosting providers, deploying proactive monitoring and filtering strategies; and (5) online advertisement and payment providers, in the case of payment blockades and follow-the-money strategies.¹¹⁰

Such voluntary measures, except in some exceptional cases, are used for mono-territorial online copyright enforcement. The present Section analyses the state of voluntary measures for the purpose of evaluating their effectiveness¹¹¹ and formulating policy recommendations on their use for cross-border online copyright enforcement in the EU¹¹².

3.1. Codes of Conduct, Codes of Practice, & Memoranda of Understanding

Codes of conduct (CoCs) and Codes of Practice (CoPs) are non-binding, voluntary agreements primarily negotiated between private parties; rightholders on one hand, and online intermediaries, including ISPs, on the other. These agreements often include measures to be adopted by intermediaries, such as “obligations to warn infringing subscribers, preserve traffic data, reveal

¹⁰⁶ [Commission Recommendation of 1 March 2018](#) on measures to effectively tackle illegal content online.

¹⁰⁷ ECD, Art. 16; IPRED, Art. 17.

¹⁰⁸ C. T. Marsden, ‘Co- and Self-regulation in European Media and Internet Sectors: The Results of Oxford University’s Study’ in C. Möller (ed.), *The Media Freedom Internet Cookbook: Amsterdam Internet Conference of the OSCE Representative on Freedom of the Media.*, Arnaud Amouroux, 2004, p. 76-100.

¹⁰⁹ In fact, these enforcement strategies are actually deployed through a larger spectrum of policy options that spans from legally-mandated obligations to private ordering. Even the same type of enforcement arrangements, can be the result of a private ordering scheme, ad-hoc governmental policy administered by agencies, or the application of legislatively-mandated obligations.

¹¹⁰ For a broad overview of the emergence of these voluntary measures and online enforcement strategies, see G. Frosio, ‘Why Keep a Dog and Bark Yourself? From Intermediary Liability to Responsibility’, *Oxford Journal of Int’l Law & Inf. Tech.*, Vol. 25, 2018, pp. 1-33; G. Frosio and M. Husovec, ‘Intermediary Accountability and Responsibility’, in G. Frosio (ed.), *The Oxford Handbook of Online Intermediary Liability*, Oxford University Press, 2020, pp. 613-630; G. Frosio, ‘Regulatory Shift in State Intervention: From Intermediary Liability to Responsibility’, in E. Celeste, A. Heldt, C. Iglesias Keller (eds.), *Constitutionalising Social Media*, Hart Publishing, forthcoming 2021, Chapter 10.

¹¹¹ See Section 7.2. below.

¹¹² See Section 8.1. below.

subscribers' identities or even terminate their accounts."¹¹³ Some agreements may reference legal regimes that are not necessarily applied in the targeted jurisdiction (i.e., reference to the U.S. "notice-and-takedown" regime), while other codes may go as far as to impose specific filtering and monitoring obligations on potentially infringing activities.¹¹⁴

Voluntary measures and private ordering schemes are often rationalized via state-driven Code of Conducts and standardization processes. These have been emerging quite consistently in the EU. The wider deployment of CoCs has increasingly become an EU-brokered self-regulatory mechanism increasing responsibility on the behalf of the regulated parties. The ECD already provides that MS and the Commission must encourage the 'drawing up of codes of conduct at Community level by trade, professional and consumer associations or organisations designed to contribute to the proper implementation of Articles 5 to 15'.¹¹⁵

Another related voluntary measure adopted by stakeholders within an industry is a **Memorandum of Understanding (MoU)**. Like CoCs and CoPs, these measures may not have a legally binding quality, but may provide a means for recognizing an industry-wide consensus on an issue. By becoming a party to a MoU, the associations agree to commit to awareness-raising on a particular issue, including encouraging other associations to join or respect its principles.

At the EU level, the 'Memorandum of Understanding on the sale of counterfeit goods via the internet' was concluded between several major Internet platforms and rightholder groups, aimed at fighting IPR infringements by preventing offers of counterfeit goods in online marketplaces.¹¹⁶ Along similar lines, the "Memorandum of understanding on online advertising and IPR" is a voluntary agreement reached with advertisers and IPR owners covering the EEA to minimise advertising on IPR infringing websites and mobile applications.¹¹⁷ In the case of the MoU on online advertising and IPR, associations have agreed to support a 'follow the money' approach to IPR infringements, stymying the flow of advertising revenues for IPR infringers operating on a commercial scale.¹¹⁸

Relatedly, the EU further utilizes various other soft-law instruments to articulate the direction of policy in a particular sector. With respect to the enforcement of copyright online, the 2017 Communication

¹¹³ P.B. Hugenholtz, 'Codes of Conduct and Copyright Enforcement in Cyberspace', in I. Stamatoudi (ed.), *Copyright Enforcement and the Internet*, Kluwer Law International, 2010, pp. 303-320.

¹¹⁴ Ibid. Recently, the European Commission adopted CoCs against hate speech and against disinformation. See [Code of Practice on Disinformation](#), European Commission, 28 September 2018. In particular, the European Commission has coordinated an EU-wide self-regulatory efforts by which online platforms should be directed to fight hate speech, incitement to terrorism and prevent cyber-bullying. See Communication on Tackling Illegal Content Online: Towards an Enhanced Responsibility of Online Platforms, [COM\(2017\) 555 final](#), European Commission, 28 September 2017, p. 10. Several other documents coming out of the EU on anti-radicalization and countering extremism, such as the EU Parliament's Civil Liberties committee draft report on anti-radicalization, emphasize a stronger role for intermediaries in policing online content. See [Directive 2017/541/EU](#) of 15 March 2017 on combating terrorism; [Report](#) on Prevention of Radicalization and Recruitment of European Citizens by Terrorist Organizations, European Parliament, 3 November 2015. See also, to the same effect, the UK Counter Extremism Strategy: [Command Paper: Counter-Extremism Strategy](#), Cmd 9148, Home Department (UK), October 2015.

¹¹⁵ ECD, art. 16.

¹¹⁶ [Memorandum of Understanding on the sale of counterfeit goods via the internet](#), European Commission, 2016.

¹¹⁷ [Memorandum Of Understanding On Online Advertising And Intellectual Property Rights](#), European Commission, 21 June 2018.

¹¹⁸ Ibid.

on Tackling Illegal Content¹¹⁹ and the 2018 Recommendation on Measures to Effectively Tackle Illegal Content Online¹²⁰ have been implemented by the Commission to encourage hosting providers in adopting voluntary monitoring practices. With these initiatives, the European Commission has been also trying to **standardize procedures** between the notifying parties and technologies used to implement enforcement actions via soft-law by creating a set of expectations that should be followed by the intermediaries. On one side, the Communication *Tackling Illegal Content Online* endorses the view that 'in order to ensure a high quality of notices and faster removal of illegal content, *criteria* based notably on respect for fundamental rights and of democratic values could be agreed by the industry at EU level' through self-regulatory mechanisms.¹²¹ On the other side, the Communication mentions that this can be also done 'within the EU standardisation framework, under which a particular entity can be considered a trusted flagger'.¹²² Sufficient flexibility to take account of content-specific characteristics and the role of the trusted flagger should be obtained via a number of additional criteria, including 'internal training standards, process standards and quality assurance, as well as legal safeguards as regards independence, conflicts of interest, protection of privacy and personal data, as a non-exhaustive list'.¹²³ In particular, especially in the domain of terrorist propaganda, extremism, and hate speech, as mentioned, the European Commission 'encourages that the notices from trusted flaggers should be able to be fast-tracked by the platform', and user-friendly anonymous notification systems.¹²⁴ The proposed DSA might take this standardization further by legislatively-mandating standards for content moderation, such as notice-and-action mechanisms, trusted flaggers schemes and CoCs.¹²⁵

At the MS level, several examples exist of voluntary arrangements (CoCs, CoPs, and MOUs) relevant for the enforcement of copyright and related rights online. In **Denmark**, the 'Code of Conduct for handling decisions by the courts of law or authorities concerning blocking of websites due to rights infringements' is a voluntary measure adopted by rightholders and ISPs to support court-ordered Domain Name System (DNS) blocking.¹²⁶ According to the Code, after obtaining a website blocking order from either a court or public authority with respect to one Danish ISP, the same order can be used to notify other Danish ISPs to block access to the infringing website. This "one stop shop" procedure for enforcing a blocking order among Danish ISPs also features a temporal requirement, obliging ISPs to comply as soon as possible and "within 7 working days of the [Danish Telecom Industry Association] having communicated the decision at the latest."¹²⁷ Furthermore, the Code provides for a means of blocking additional DNS addresses in cases where the rightholder documents identical content appearing on a website which has been reconfigured to a different address.¹²⁸ From the stakeholder

¹¹⁹ Communication on Tackling Illegal Content Online, op. cit.

¹²⁰ '[Commission Recommendation on Measures to Effectively Tackle Illegal Content Online](#)', European Commission 1 March 2018.

¹²¹ See Communication on Tackling Illegal Content Online, op. cit., s. 3.2.1.

¹²² Ibid.

¹²³ Ibid.

¹²⁴ Ibid., s. 3.2.1. and 3.2.3.

¹²⁵ See DSA Proposal, art. 14-24.

¹²⁶ Telecommunications Industry Association in Denmark, "[Code of Conduct for handling decisions by the courts of law or authorities concerning blocking of websites due to rights infringements](#)", 14 September 2014. This Code was updated in June 2020 to facilitate the blocking of "proxy" websites without the need to return to the court.

¹²⁷ Ibid.

¹²⁸ Ibid.

consultations, the Danish model was highlighted as comparatively highly efficient and effective due in large part to its streamlined procedure, even considering the fact that a court order is a prerequisite for website blocking. Rightholders also report that their ability to submit blocking applications with respect to many different categories of infringing websites (e.g., stream ripping, BitTorrent indexing sites and linking sites) provides an additional advantage of the Danish system over that of other MS. In **Germany**, one voluntary arrangement between German Internet access providers and rightholders involves coordination with an administrative authority (Federal Network Agency, "BNetzA") to effectuate DNS blocking¹²⁹ without the need for a court order. The independent "Internet Copyright Clearing House" ("Clearingstelle Urheberrecht im Internet", "CUII") was established in 2021 under a jointly agreed CoC that provides a procedure for blocking infringements by targeting 'structurally copyright-infringing websites', or websites where mass infringement is a key element of its business model.¹³⁰ Once the CUII committee reaches a unanimous decision, the Federal Network Agency then examines the possible effect of the blocking order under the EU Net Neutrality Regulation.¹³¹ If the Federal Network Agency does not express any concerns, Internet access providers effect the blocking order. In **Belgium**, members of the Belgian Internet Service Providers Association (ISPA) have agreed to coordinate with judicial police in addressing complaints related to illegal activity on the Internet, including copyright infringement.¹³² In the **UK**, a voluntary Code of Practice is in place between rightholders associations such as the MPA, and major search engines such as Google, Bing, and Yahoo!, which concerns the demotion of certain copyright infringing website results.¹³³ In **Italy**, a specific regulatory framework for the development of CoCs exists, allowing ISPs to implement codes of self-conduct which regulate the review of claims concerning, among others, unlawful behaviours of their clients. Business, professional or consumer associations or organizations may therefore promote the adoption of CoCs, and transmit such codes to the Ministry of Productive Activities and the European Commission.¹³⁴

Finally, some jurisdictions have put in place MoUs which feature a governmental body as a facilitator to the agreement. In **Portugal**, a voluntary administrative procedure was put in place in 2015 for website blocking, established by way of an MoU negotiated between rightholder association Movimento Cívico Anti-Pirataria na Internet ("MAPiNET") and the Portuguese Association of Telecommunications Operators ("Associação dos Operadores de Telecomunicações", "APRTEL"), along with other parties such as advertisers and consumer trade associations.¹³⁵ The administrative procedure is carried out by the Inspectorate General for Cultural Activities ("Inspecção Geral das

¹²⁹ "DNS blocking" is effectuated by a DNS server, and prevents a website's name from being assigned to an IP address, thereby restricting users' direct access to a website.

¹³⁰ The determination of a "structurally infringing website" is initially reached through the unanimous recommendation of the 'clearing house'. See '[Joint solution for dealing with structurally infringing websites on the Internet: Internet access providers and rights holders set up independent "clearing house"](#)', Press Release, CUII, 11 March 2021.

¹³¹ See Regulation 2015(2120 of the European parliament and the Council on measures for access to the open Internet and amending Directive 2002/22 / EC on universal service and user rights in electronic communications networks and services and Regulation (EU) No. 531/2012 on roaming in public mobile networks in the Union (2015) OJ L 310/1.

¹³² [ISPA Code of Conduct](#) [BE].

¹³³ '[Code of Practice on Search and Copyright](#)' [UK], 17 February 2017.

¹³⁴ See Legislative Decree 70/2003 [IT], art 18.

¹³⁵ [Memorando de Entendimento](#) (in Portuguese), 2015.

Atividades Culturais", "IGAC"), a governmental body for cultural affairs, which reviews complaints raised by rightholders and communicates blocking decisions to ISPs.¹³⁶

One relevant legal concern to be considered when developing voluntary arrangements involving online intermediaries and other stakeholders/rightholders) is compliance with competition law. For example, competition law issues were recently brought to the attention of the German Federal Cartel Office ("Bundeskartellamt", "BKartA") in the course of the creation of the CUII¹³⁷. Earlier, similar concerns were considered with regard to "Hinweisstelle Online-Werbeschaltung und Urheberrecht (HOWU)", a discontinued private initiative to cut advertising revenues of allegedly illegal websites¹³⁸. In this regard, Article 101 of the TFEU prohibits agreements between undertakings, decisions by associations of undertakings, and concerted practices which may affect trade between MS and which have as their object or effect the prevention, restriction or distortion of competition within the internal market.

Competition law assessments involve examination of the impact of agreements among companies on the interests of competitors (e.g., competing ISPs) and consumers, who might lose access to some online resources without a choice of switching to a different ISP. Of course, consumers' access to illegal websites shall be disregarded in competition law assessment. In this context, competition law would be concerned by a concerted collective action of a group of private companies against a third party whose services they consider to be illegal. The establishment of the illegality of the anticompetitive behaviour involves complex legal assessments. The CJEU has provided some guidance that might be relevant for IPR infringement as well by deciding a case where a group of Slovenian banks agreed to limit accessed to their services to a competing company on the basis of the group's decision that the third-party's conduct was allegedly illegal. In this case, according to the CJEU:

[...], it is apparent from the order for reference that the agreement entered into by the banks concerned specifically had as its object the restriction of competition and that none of the banks had challenged the legality of Akcenta's [competing company's] business before they were investigated in the case giving rise to the main proceedings. The alleged illegality of Akcenta's situation is therefore irrelevant for the purpose of determining whether the conditions for an infringement of the competition rules are met. [...] Moreover, it is for public authorities and not private undertakings or associations of undertakings to ensure compliance with statutory requirements. The Czech Government's description of Akcenta's situation is evidence enough of the fact that the application of statutory provisions may call for complex assessments which are not within the area of responsibility of those private undertakings or associations of undertakings. [...] It follows from those considerations [...] that Article 101 TFEU must be interpreted as meaning that the fact that an undertaking that is adversely affected by an agreement whose object is the restriction of competition was allegedly operating illegally on the relevant market at the time when the agreement was concluded is of no relevance to the question whether the agreement constitutes an infringement of that provision.¹³⁹

¹³⁶ See [IGAC website](#).

¹³⁷ '[Keine Einwände gegen Start der Clearingstelle Urheberrecht im Internet](#)', BKartA, Press Release, 11 March 2021

¹³⁸ Tätigkeitsbericht_2015/2016, BT-Drs. 18/12760, BKartA, pp. 97-98; Handelsblatt, '[Kartellamt stoppt Initiative gegen Piraterie](#)', 21 April 2015.

¹³⁹ Judgement in [Case C-68/12](#), *Protimonopolný úrad Slovenskej republiky v Slovenská sporiteľňa*, European Court of Justice, February 2013, ECLI:EU:C:2013:71, paras. 19-21.

Given the fact that some Internet intermediaries are vertically integrated companies with businesses in different areas (e.g., offering simultaneously Internet access services as well as music, video or other copyright-related services to consumers), the possible lack of impartiality of private parties in qualifying some activities as lawful or unlawful and enforcing their legal qualifications accordingly, bears the risk of hindering legal activities that might later be recognised as such by state courts. Such concerns were also raised during the stakeholder consultations. For this reason, particular attention should be paid to the safeguards provided by private arrangements for mitigating the aforementioned risk. Such safeguards could include, for example, (1) the definition of a threshold of obviousness of the illegal nature of the websites' activities (according to a notion of "manifestly illegal content") as well as (2) procedural and structural due process standards to which the voluntary mechanism must conform with.

3.2. Legislatively-Mandated Measures: Notice and Takedown, Knowledge and Action

The notions of "**notice and takedown**" and "**notice and action**" ("**knowledge and action**") refer to legal regimes which limit intermediaries' liability, conditional on those intermediaries blocking or removing access to infringing content after being notified or becoming aware that their services are used for illegal activities. Such a regime was first introduced in the US, and a few years later in EU law, followed by national transpositions in MS legislation.

The US regime, being historically first and accompanied by a detailed notification procedure required by the Digital Millennium Copyright Act (DMCA), had a significant impact on both the development of industry practices to remove or block access to notified content, as well as the adoption of a similar mechanism in the EU.¹⁴⁰ The "notice and takedown" regime under U.S. law is contained in Section 512 of Title 17 U.S.C., and codifies a "safe-harbour" rule for online service providers (OSP) against liability for the copyright infringements of its users. After rightholders submit a notice to the OSP (pursuant to the conditions of Section 512(c)), the OSP is obliged to remove or block access to the infringing content expeditiously. The "notice and takedown" regime also foresees the use of a "counter notice" procedure, where subscribers are given the opportunity to object to a takedown decision. In an empirical Study conducted on the effectiveness of the notice and takedown regime after 20 years, it was found that users rarely used the counter notice mechanism, even in cases where the initial rightholder notice was clearly invalid.¹⁴¹

The so-called "notice and action" (or "knowledge and action") regime under EU law is provided by Art. 14 of the ECD, and applies a similar regime which limits the liability of hosting service providers for information stored on its service.¹⁴² However, hosting service providers are only exempted from liability if they do not possess "actual knowledge" or awareness of the illegal activities or content; once

¹⁴⁰ See also K. Erickson and M. Kretschmer, 'Empirical Approaches to Intermediary Liability', in G. Frosio (ed.), *The Oxford Handbook of Online Intermediary Liability*, OUP, 2020, p. 106.

¹⁴¹ J. Urban et al., '[Notice and Takedown in Everyday Practice](#)', UC Berkeley Law, 2017, p. 45-46.

¹⁴² The 2019 CDSM Directive affects the application of this established limited liability regime for certain online content-sharing service providers (OCSSPs), making them directly liable for 'unauthorised acts of communication to the public, including making available to the public, of copyright-protected works and other subject matter', unless the OCSSP fulfils requirements to limit their liability under Art. 17(4). As of this writing, Member States are still in the implementation stage of this Directive.

they obtain such knowledge, the service provider is obliged to act expeditiously to remove or disable access to information. In the EU, the evidentiary standards required for substantiating a claim of “actual knowledge” or awareness of the hosting service provider varies considerably among MS jurisdictions.¹⁴³ In addition, the EU has never legislatively-mandated a knowledge-and-action procedure, although this has been on the legislative agenda since the enactment of the ECD.¹⁴⁴ Of course, the lack of an EU-wide consistent procedure has caused the emergence of multiple MS approaches and has been detrimental to cross-border enforcement of IPRs online. However, as already mentioned, the recent DSA Proposal aims to ‘apply effective, coherent, transparent and fair procedures and procedural safeguards to address illegal content [...], including via a harmonised notice-and-action procedure’.¹⁴⁵ In particular, the DSA will ensure transparency of the process and human oversight in the context of content removal,¹⁴⁶ as well as notice, counter notice and complaint procedures, in order ‘to allow content owners and uploaders to defend their rights adequately and in a timely manner, and to ensure that removal or blocking decisions are legal, accurate, well-founded, protect users and respect fundamental rights’.¹⁴⁷ Particular attention should be paid to procedural rights under the notice-and-actions mechanism that the DSA should regulate by providing safeguards to fundamental rights.¹⁴⁸ In order to do so, the DSA must provide guidance regarding: (i) the right to issue a notice and the form of notices;¹⁴⁹ (ii) procedural safeguard for processing notices and for final decision-making,¹⁵⁰ with a special regime that might be applied to trusted flaggers;¹⁵¹ (iii) safeguards against the abuse of the system allowing to sanction parties that systematically and repeatedly submit wrongful notices¹⁵² (or manifestly illegal content);¹⁵³ (iii) transparency reports;¹⁵⁴ (iv) access to internal complaint mechanisms that should be transparent, effective, fair and expeditious;¹⁵⁵ as well as (v) the possibility to resort to out-of-court dispute settlement mechanisms and judicial redress.¹⁵⁶

Meanwhile, voluntary arrangements in the EU may make references to “notice and takedown” or “notice and action”/“knowledge and action” regimes. According to the stakeholders consulted, some reference the use of the “notice-and-takedown” regime as the prevalent legal mechanism for dealing with online copyright infringements. However, some EU rightholder groups were careful to distinguish

¹⁴³ [‘Overview of the legal framework of notice-and-action procedures in Member States’](#), European Commission, 2016.

¹⁴⁴ See ECD, art. 21.

¹⁴⁵ EP Resolution on the DSA and FR, point 25.

¹⁴⁶ See Spindler, *op. cit.*, pp. 193-203 (discussing content moderation and control).

¹⁴⁷ EP Resolution on the DSA and FR, points 11 and 29.

¹⁴⁸ See DSA Proposal, Recital 41.

¹⁴⁹ *ibid.*, art 14(1).

¹⁵⁰ *ibid.*, art 14(6) and art. 15(4).

¹⁵¹ *ibid.*, art. 19.

¹⁵² *ibid.*, Recital 57, art. 14(2)(d) and art 20(2). In particular, the status of “trusted flagger” can be revoked, following an investigation, if, *inter alia*, the trusted flagger “submitted a significant number of insufficiently precise or inadequately substantiated notices”. *ibid.*, art. 19(5-6).

¹⁵³ *ibid.*, art. 20(1) (suspension should occur for a reasonable period of time and after having issued a prior warning).

¹⁵⁴ *ibid.*, art. 13.

¹⁵⁵ *ibid.*, art. 17.

¹⁵⁶ *ibid.*, art. 18.

the legal regimes, citing “notice and action”/“knowledge and action” as the legal mechanism of choice in dealing with online copyright infringements. While “notice and takedown” terminology is usually in reference to the US legal regime, the term appears in some voluntary agreements in the EU, and seem to refer to the use of notice systems for content takedowns in a broader sense. From stakeholders’ experiences with these voluntary agreements, there did not seem to be any practical legal consequences of the use of notice and takedown vs. notice and action/knowledge and action terminology which might have potentially limited their enforceability in EU contexts.¹⁵⁷

In **the Netherlands**, for example, the ‘Notice-and-Take-Down Code of Conduct’ (NTD Code) offers a voluntary set of guidelines on procedure governing the interactions between notifiers, content providers and intermediaries.¹⁵⁸ This Code does not reference the “notice and action” terminology, instead opting for the use of more general language prioritizing the existing arrangements of intermediaries. Again, in **the UK**, the ‘Code of Practice on Search and Copyright’ provides a voluntary code of practice for search engines to reduce the appearance of websites hosting infringing material when users perform searches using their services. While the text of the Code refers to a procedure of rightholder “notice” about infringing content to online service providers, footnotes 3-5 specifically reference the DMCA standard as “a commonly used and understood method.”¹⁵⁹

3.3. Availability of Alternative Dispute Resolution Mechanisms

The development and use of alternative dispute resolution (ADR) mechanisms have drawn much attention in recent years as out-of-court means for solving international disputes in a manner overcoming some disadvantages inherent to the national court systems. Availability of ADR does not prejudice the right of access to a tribunal, but complaints a choice of tools for dispute resolution. Mediation and arbitration are the most commonly used forms of ADR mechanisms for the settlement of IPR disputes.

Mediation is “a structured process, however named or referred to, whereby two or more parties to a dispute attempt by themselves, on a voluntary basis, to reach an agreement on the settlement of their dispute with the assistance of a mediator. This process may be initiated by the parties or suggested or ordered by a court or prescribed by the law of a Member State”.¹⁶⁰ Mediation is a consensual process, where the mediator cannot impose a decision, and the settlement agreement has the legal force of a contract. The Mediation Directive harmonises rules applicable to mediation in cross-border disputes in the EU.¹⁶¹ Arbitration, while also being a consensual procedure, leads to a binding decision (arbitral award). International enforcement of arbitral awards in cross-border cases is facilitated by the New York Convention, ratified by all MS.¹⁶²

Much of the cross-border arbitration is today organised through internationalized rules and services of established organisations (e.g., WIPO Arbitration Rules, the International Chamber of Commerce (ICC)

¹⁵⁷ With respect to the UK Code of Practice, note that this conclusion refers to stakeholders’ experiences prior to the UK’s exit from the EU.

¹⁵⁸ [‘Notice-and-Take-Down Code of Conduct’](#) [NL], 13 December 2018.

¹⁵⁹ [Code of Practice on Search and Copyright](#) [UK], 17 February 2017.

¹⁶⁰ [Directive 2008/52/EC](#) of 21 May 2008 on certain aspects of mediation in civil and commercial matters (Mediation Directive), 24 May 2008, Art. 3(a).

¹⁶¹ Ibid.

¹⁶² Convention on the Recognition and Enforcement of Foreign Arbitral Awards (1958).

Arbitration Rules, the London Court of International Arbitration (LCIA)). Under the auspices of the EUIPO Boards of Appeal, ADR Service offers IPR dispute resolution services.¹⁶³ The UPC system foresees the establishment of an ADR Centre for the settlement of patent disputes.¹⁶⁴ In the domain of copyright, the Collective Rights Management Directive¹⁶⁵ requires the availability of ADR mechanisms, and the Satellite and Cable Directive¹⁶⁶ and the Transmissions and Retransmissions Directive¹⁶⁷ refer to mediation.

ADR procedures are used as an alternative to traditional national court proceedings because they offer some flexibility to the parties with regard to the appointment of arbiters and mediators, choice of rules of procedures and confidentiality. They could offer a number of advantages in case of cross-border disputes, and the arbitral awards can be enforced internationally.

Yet, a relatively low, although increasing, number of copyright disputes were resolved through ADR mechanisms,¹⁶⁸ and even fewer of them were copyright infringement cases.¹⁶⁹ A recent survey on the use of ADRs for resolution of business-to-business digital copyright and content-related disputes showed a significant number of rightholders around the world used arbitration and mediation for resolution of non-contractual disputes, although both ADR mechanisms remain to be more frequently used in contractual disputes.¹⁷⁰ Stakeholder consultations demonstrated that rightholders do not have much experience using ADR mechanisms to combat large-scale copyright infringements. This situation could be explained by the fact that parties to a dispute have to agree to an arbitration and/or mediation process, unlike in the case of traditional court litigation or with the initiation of procedures in front of administrative bodies. Wilful copyright infringers are not known for being cooperative and agreeing to go through an ADR process.

A rightholder expressed a view that it would be helpful in some situations if the disputes regarding copyright-infringing content could be resolved through an arrangement similar to the Uniform

¹⁶³ Decision No 2013-3 of the Presidium of the EUIPO Boards of Appeal of 5 July 2013 on the amicable settlement of disputes. EUIPO ADR Service: [ADR Service](#), EUIPO Website: <https://euiipo.europa.eu/ohimportal/en/adr-service>

¹⁶⁴ S. Granata, 'The Patent Mediation and Arbitration Centre: a centre of opportunities', in C Geiger, C. Nard and X. Seuba (eds.), *Intellectual Property and the Judiciary*, Edward Elgar, 2018, pp. 255-264.

¹⁶⁵ [Directive 2014/26/EU](#) of 26 February 2014 on collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online use in the internal market, 20 March 2014, Art. 34.

¹⁶⁶ [Council Directive 93/83/EEC](#) of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, 6 October 1993, Art. 11.

¹⁶⁷ [Directive 2019/789](#) of 17 April 2019 laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of television and radio programmes, 17 May 2019, Art. 6.

¹⁶⁸ O. Bulayenko et. al., [Emerging Issues on Collective Licensing Practices in the Digital Environment](#), Ecorys / IViR study for the DG CNECT of the European Commission, (2021), pp. 103-107 (reflecting results of 4 surveys on experiences of rightholders, collective management organisations, online music service providers and national competent authorities with the use ADR for resolution of disputes related to multi-territorial licensing of online music rights in the EU).

¹⁶⁹ See [WIPO Caseload Summary](#), covering WIPO mediation, arbitration, expert determination cases and good offices requests filings in the period 2011-2020 and reporting that 21% of all cases were those concerned with copyright, within which "Infringements" was one of seven categories of cases. In addition, the percentage of WIPO ADR cases concerned with copyright in 2016 was 7%. See WIPO ADR Center, *Resolving IP and Technology Disputes Through WIPO ADR: Getting back to business*, WIPO Publication No. 799E/2016, 2016, p. 5.

¹⁷⁰ WIPO, [Alternative Dispute Resolution Mechanisms for Business-to-Business Digital Copyright and Content-Related Disputes: A report on the results of the WIPO-MCST Survey](#), 2021, pp. 44-45.

Domain Name Dispute Resolution Policy (UDRP).¹⁷¹ The UDRP was established for the resolution of disputes between a domain name registrant and a third party over the abusive registration and use of a domain name in the generic top-level domains (gTLDs) (e.g., .com, .org, .info, .net), and those country code top-level domains (ccTLDs) (e.g., .fr for France and .it for Italy) that have adopted the UDRP on a voluntary basis. Any person or entity wishing to register a domain name in the gTLDs and ccTLDs concerned is required to agree to the terms and conditions of the UDRP.¹⁷²

¹⁷¹ [Uniform Domain Name Dispute Resolution Policy](#), approved by the Internet Corporation for Assigned Names and Numbers (ICANN), 24 October 1999.

¹⁷² [WIPO Guide to the Uniform Domain Name Dispute Resolution Policy](#).

4. ADMINISTRATIVE MEASURES

The number of difficulties inherent in enforcing copyright in the digital environment have given way to the development of administrative procedures and specialised administrative bodies to combat online infringements. For now, only a few MS provide such administrative measures for combatting online copyright infringement. The present Section reviews the state of administrative measures for the purpose of evaluating their effectiveness¹⁷³ and formulating policy recommendations on their use for cross-border online copyright enforcement in the EU¹⁷⁴.

4.1 Administrative Procedures

In some MS, voluntary arrangements are complemented by administrative procedures established by national governments to target copyright infringements in online contexts. These procedures may be facilitated by existing national authorities, which may hold a broader institutional mandate.

In **Portugal**, the MOU mentioned above is administered with the assistance of the Inspectorate General for Cultural Activities ("Inspecção Geral das Atividades Culturais", "IGAC"), a governmental body for cultural affairs. According to the administrative procedure in place, the IGAC reviews complaints raised by rightholders and communicates blocking decisions to ISPs.¹⁷⁵ Every month MAPiNET (rightholder organisation) may report to the IGAC up to 100 websites (including those circumventing blocking orders), providing evidence that such sites contain at least 500 links to infringing content, or that the percentage of infringing content on the site is at least 66%.¹⁷⁶ According to a 2019 Study, the IGAC evaluates claims within an average period of 48 hours, and instructs ISPs to place DNS blocks on the websites within a 48-hour period.¹⁷⁷ It is also noteworthy that these blocks are only valid for a period of up to one year. In 2018, the MoU was amended to include "live blocking" for sports content (which is protected under Portuguese IP law). Additionally, the MoU provides for the creation of a legal content aggregator for the benefit of the public, following an initiative at the EUIPO to develop a pan-European legal content aggregator (Agorateka).¹⁷⁸

In **Germany**, the voluntary administrative procedure in place between German Internet access providers and rightholders involves coordination with a federal administrative authority (Federal Network Agency, "BNetzA") to effectuate DNS blocking¹⁷⁹. Complaints are submitted to the "Internet Copyright Clearing House" ("Clearingstelle Urheberrecht im Internet", "CUII"), an independent committee, which evaluates whether the website in question is considered 'structurally copyright-infringing', or alternatively, whether mass infringement is a key element of the website's business model.¹⁸⁰ Once the CUII reaches its decision, the Federal Network Agency examines the possible effect

¹⁷³ See Section 7.3. below

¹⁷⁴ See Section 8.2 below

¹⁷⁵ [IGAC website](#).

¹⁷⁶ 'Anti-piracy strategies of cultural and sport content: 2019 International Survey', HADOPI, p. 9.

¹⁷⁷ Ibid.

¹⁷⁸ [Ofertas Legais website](#).

¹⁷⁹ "DNS blocking" is effectuated by a DNS server, and prevents a website's name from being assigned to an IP address, thereby restricting users' direct access to a website.

¹⁸⁰ The determination of a "structurally infringing website" is initially reached through the unanimous recommendation of the 'clearing house'. See '[Joint solution for dealing with structurally infringing websites on the Internet: Internet access providers and rights holders set up independent "clearing house"](#)', Press Release (CUII, 11 March 2021).

of the blocking order under the EU Net Neutrality Regulation.¹⁸¹ If the Federal Network Agency does not express any concerns, Internet access providers effect the blocking order.

4.2. Administrative Authorities

In some MS jurisdictions, specialised administrative authorities are installed with a specific mandate to handle the enforcement of copyright and related rights in the online environment. These administrative authorities, while sometimes working in coordination with national courts, may act separately from the courts as an alternative or parallel track for enforcement.

In general, as opposed to focusing on locating and pursuing individual infringing users,¹⁸² most administrative authorities target their efforts towards intermediaries. Once an administrative authority issues an order, the intermediaries in question are tasked with carrying out the order against infringing operators using its services. Customarily, use of the administrative procedure does not preclude the filing of civil or criminal actions before ordinary courts, depending on the jurisdiction. Finally, administrative courts and national judiciaries are typically entitled to review the decisions of administrative authorities, which provides a safeguard against any potential abuses of power.

In line with the provisions of Art. 12(3), 13(1)(e) and (2), and 14(3) of the ECD, referring to a capacity of an administrative authority to “order [...] removal or disablement” or “of requiring the service provider to terminate or prevent an infringement”, some MS have adopted enforcement models in which administrative authorities are competent to issue website blocking orders or take-down orders, as in the case of Spain, Italy, Greece and Lithuania.¹⁸³

As a more recent development, in France the Autorité de régulation de la communication audiovisuelle et numérique (ARCOM) has similarly been established as an “anti-piracy agency”, merging the previously existing Hadopi (La Haute Autorité pour la diffusion des œuvres et la protection des droits sur internet est une autorité publique indépendante) and CSA (Conseil supérieur de l’audiovisuel).¹⁸⁴ Its broad mandate, which will eventually also incorporate the enforcement of content takedowns pursuant to the proposed Digital Services Act, interestingly includes the establishment of a system which is particularly responsive to “mirror” sites, which are often used to perpetuate infringements after a blocking order has already been issued against one or more infringing sites.¹⁸⁵

The following administrative authorities in the EU are further competent to order blocking injunctions: (i) the Intellectual Property Commission (“Comisión de Propiedad Intelectual”, “IPC”) (Spain)¹⁸⁶; (ii) the Authority for Communications Guarantees (“Autorità per le Garanzie nelle Comunicazioni”, “AGCOM”)

¹⁸¹ See [Regulation 2015/2120](#) of 25 November 2015 on measures for access to the open Internet and [Regulation 531/2012](#) of 25 November 2015 on roaming in public mobile networks in the Union.

¹⁸² This was the focus of a previous measure and administrative body in place in France known as the Hadopi (now ARCOM). This approach, incorporating a “graduated response” system for Internet users allegedly committing infringements, was not widely adopted in the EU. For critical analysis, see C. Geiger, ‘Counterfeiting and the music industry: towards a criminalization of end users? The French ‘HADOPI’ example’, in C. Geiger (ed.), *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research*, Edward Elgar, 2012, pp. 386- 402.

¹⁸³ See A. Cogo and M. Ricolfi, ‘Administrative Enforcement of Copyright Infringement in Europe’, in G. Frosio (ed), *The Oxford Handbook of Online Intermediary Liability*, OUP, 2020, pp. 586-602.

¹⁸⁴ Law No. [2021-1382](#) of 25 October 2021 [France], Chapters 1-7.

¹⁸⁵ *Ibid.*, Art. L. 331-27.-I.

¹⁸⁶ See Law [1889/2011](#) of 30 December 2011 [Spain], Chapters 6-7.

(Italy)¹⁸⁷; (iii) the Committee for the Notification of Copyright and Related Rights Infringement on the Internet ("Επιτροπή για τη Διαδικτυακή Προσβολή Πνευματικής Ιδιοκτησίας", "EDPPI") (Greece)¹⁸⁸; and (iv) the Radio and Television Commission of Lithuania ("Lietuvos radijo ir televizijos komisija", "RTCL") (Lithuania)¹⁸⁹.

Based on feedback gathered during the Study's consultation stage, stakeholders had the most experience with administrative authorities and procedures available in **Spain** and **Italy**.

In **Spain**, the IPC was initially introduced in 2011 as an administrative body working under the Spanish Ministry of Culture, and provides one of the first examples of administrative online enforcement for copyright in Europe.¹⁹⁰ The Second Section ("Sección Segunda") of the IPC is specifically tasked with "safeguarding of intellectual property rights, against their violation by those responsible for services of the information society",¹⁹¹ and is responsible for administering a procedure for obtaining injunctive relief against infringements with a commercial purpose.

In 2014, the authority of the IPC's Second Section was expanded in order to carry out expedited administrative procedures for domestic rightholders pursuing online copyright infringements, compelling ISPs to take down illegal content or block access to websites violating copyright legislation, whether directly or indirectly (i.e., by providing lists of links to unlawful content).¹⁹² Rightholders may raise claims to the Second Section against websites failing to comply with an initial takedown request. This administrative procedure also foregoes the need for judicial authorisation, as the Second Section notifies ISPs directly once a decision has been reached.

As far as the cross-border dimensions of a national administrative authority's functions, Spanish law anticipates the need for cooperation between national authorities in effectuating restrictions against service providers located in jurisdictions outside Spain. According to the LSSI, (and related to the functions of the IPC's Second Section as a 'national competent authority'), there is a provision which specifies an "intra-Community cooperation procedure" for imposing restrictions on Information Society Services derived from any EU MS or Member of the European Economic Area (EEA) other than Spain.¹⁹³ In Art. 8 of the LSSI, when the competent national body agrees to establish restrictions that affect an information society service provider established in its jurisdiction,

- a) The competent body shall require the Member State in which the affected provider is established to adopt the appropriate measures. In the event that they are not adopted or are insufficient, said body will notify, in advance, the European Commission or, where appropriate,

¹⁸⁷ See Law No. 249/1997 of 31 July 1997 [Italy].

¹⁸⁸ See Law 2121/1993 [Greece], Art. 66E.

¹⁸⁹ See Law on Copyright and Related Rights [Lithuania], Art. 78.

¹⁹⁰ See Law [1889/2011](#) of 30 December 2011 [Spain].

¹⁹¹ *Ibid.*, Art. 13(1)(in Spanish).

¹⁹² See Law [21/2014](#) of 4 November 2014 [Spain].

¹⁹³ See [Law 34/2002](#) (Law on Information Society Services, "LSSI") of 11 July 2002 [Spain], Art. 8, (providing for 'Restrictions on the provision of services and intra-community cooperation procedure'). In the 2002 version of the law, Art. 8(1)(e) listed 'safeguarding intellectual property rights' as a specific ground for invoking the intra-community cooperation procedure. However, in the modifications to this Law in 2007, this specific ground for invoking the procedure was removed. See Law [56/2007](#) [Spain], Art. 4 (modifying Art. 8 LSSI). It is therefore questionable whether such a procedure can still be invoked in cases requiring injunctive relief over copyright infringements located in foreign EU or EEA MS.

the Joint Committee of the European Economic Area and the Member State in question of the measures it intends to adopt.

b) In urgent cases, the competent body may adopt the appropriate measures, notifying the Member State of origin and the European Commission or, where appropriate, the Joint Committee of the European Economic Area as soon as possible and, in any case, at most, within a period of fifteen days from its adoption. Likewise, [the competent body] must indicate the cause of said urgency.¹⁹⁴

The presence of this measure in Spanish national law indicates that cooperative measures, such as an intra-community procedure for coordinating with national authorities, already exist to facilitate the enforcement of measures against intermediaries situated outside the reach of the application of domestic laws. Such legal provisions recognise the territorial limits of the application of national law, and encourage collaborative enforcement efforts with other MS in the interest of providing adequate safeguards for fundamental rights and freedoms without prejudice to the application of foreign MS laws. However, given the example below (Box 2), it is unclear how frequently such cooperative measures are invoked in copyright enforcement scenarios in particular, even in cases meriting some level of coordination with another MS' national competent authorities.

Box 2. Competences of Administrative Authorities: A Case of Extra-Territorial Jurisdiction?

While in principle it is understood that administrative authorities established under national law typically cannot regulate the conduct of parties located in other MSs or third countries, in 2015 the IPC's Second Section requested an ISP established in the Netherlands to identify the owners of websites offering infringing content to Spanish citizens.¹⁹⁵ In 2016, the request was challenged by the Dutch ISP in the Administrative Section of Spain's National High Court, on the grounds that the IPC cannot exercise its authority beyond its national borders. According to the ISP, another issue was that the *intra-Community cooperation procedure* [Art. 8.3 LSSI]¹⁹⁶ was not used, which would have rather compelled the IPC to communicate with the corresponding national authorities in the Netherlands in order to fulfil the request or take appropriate action over its domestic ISP (a process likely to have taken more time than the 'summary procedure' available under Law 1889/2011).

In its decision, the Court dismissed the Dutch ISP's appeal. In its interpretation, according to Art. 4.2 LSSI, the ICS had exercised its jurisdiction appropriately, relying on the fact that the ISP directed its services to the Spanish territory. This decision was criticised by some, who viewed the Court's decision as enabling the ICS to unilaterally [...] exert its authority over a foreign ISP which should rather only be subject to the law of the MS in which it is established, regardless of where its activities are targeted.¹⁹⁷

¹⁹⁴ Ibid.

¹⁹⁵ Law 1889/2011 [Spain], Chapter 7. See also, LSSI, Art. 4.2.

¹⁹⁶ LSSI, Art. 8.3 'Restrictions on the provision of services and intra-community cooperation procedure' (modified by Law 56/2007 [Spain], Art. 4).

¹⁹⁷ A. López-Tarruella Martínez, 'On the competence and the procedure to follow regarding Section 2 of the Intellectual Property Commission to take action against webpages hosted abroad' (in Spanish), Diario LA LEY, nº 8889, 27 December 2016, Editorial Wolters Kluwer; 'Effectiveness of the "Sinde Law" against websites hosted abroad and European Union law', Salvador Ferrandis & Partners, 23 December 2016.

In **Italy**, the AGCOM, an independent administrative authority established in 1997,¹⁹⁸ was empowered to deal with the issue of online copyright enforcement soon after the Spanish measures were adopted, gaining a broad mandate in the protection of copyright and related rights.¹⁹⁹ It is authorised to intervene not only in specific situations concerning 'the violation of the exclusive right of make available works and protected materials on a webpage,' but also in situations where the general 'offer of products, components and services' is in 'violation of copyright and related rights.'²⁰⁰ In 2013, its mandate was expanded to address complaints specifically involving infringements allegedly committed through the "advertising, promotion or description of copyright and related rights", thus covering instances of indirect infringement.²⁰¹ In 2018, AGCOM improved its offering of protective measures for rightholders through modifying its 'fast track' procedure 'with tighter deadlines...based on a preliminary assessment of facts, where there is an alleged threat of imminent, serious and irreparable harm', among other changes.²⁰²

AGCOM provides for two types of remedies. If the server hosting infringing works is located in Italy, infringing items are subjected to selective removal, and other measures may be adopted to prevent uploading.²⁰³ However, in cases where the server is located outside Italy, AGCOM may issue a blocking order, used in the event of a 'massive infringement'.²⁰⁴ Though the blocking order is not directed towards foreign hosting providers themselves, AGCOM will list additional websites to which the blocking order must be extended so that the access provider (operating in Italy) limits access to works (or links to the works) from the Italian territory.²⁰⁵ Hence, the administrative measures in place in Italy also seem to anticipate the cross-border effect of enforcement actions to a degree, in cases where enforcement measures are directed only towards domestic access providers, but may have an effect on the ability of foreign users to access content.

Rightholders' impressions of AGCOM's administrative procedures for enforcement have been generally positive, due to the speed of the procedure and the potential scale of the enforcement. In practical terms, the operation of this administrative enforcement mechanism has led to more than 700 domain names being blacklisted, according to data from 2019.²⁰⁶

¹⁹⁸ Law No. 249/1997 [Italy], 31 July 1997.

¹⁹⁹ [Regolamento In Materia Di Tutela Del Diritto D'autore Sulle Reti Di Comunicazione Elettronica E Procedure Attuative Ai Sensi Del Decreto Legislativo 9 Aprile 2003](#), N. 70 [AGCOM Regulation].

²⁰⁰ Ibid.

²⁰¹ [AGCOM Regulation](#) (modified by Delibera N. 680/13/CONS [Italy], 12 December 2013).

²⁰² [Delibera N. 490/18/Cons](#) [Italy], 16 October 2018. For comment, see Campus G., [Italian public enforcement of online copyright infringement: new powers and procedures for AGCOM](#), Kluwer Copyright Blog, 14 December 2018.

²⁰³ AGCOM Regulation, Art. 8(3), Art. 1, ff.

²⁰⁴ Ibid., Art. 8(3).

²⁰⁵ In such cases, service providers acting as "mere conduits" may be subjected to complying with the order. See also, Cogo and Ricolfi, 601.

²⁰⁶ Cogo and Ricolfi, 607.

5. JUDICIAL MEASURES AGAINST CROSS-BORDER INFRINGEMENTS OF IPRS

Traditionally, matters regarding copyright enforcement have involved raising a dispute in court. Most of these proceedings have taken place in civil courts, where copyright holders request injunctive relief against alleged infringers, and/or submit damages claims to judges. In cross-border litigation, once the court is seized, two key issues must be raised immediately. The first is the question of the competent court to hear the case. It is possible that the dispute is brought or may be brought in more than one MS. In this situation, it is the Brussels Recast Regulation that provides the necessary indications for determining the competent jurisdiction. Furthermore, this Regulation also contains rules on the recognition of judgments given in one MS and submitted in another MS. The second question is that of the applicable law. In civil matters, the law applied by the courts does not necessarily have to be national. The judges of a MS may have to apply foreign law or even multiple foreign laws where appropriate. This point is governed by the Rome II Regulation and adds further complexity to copyright litigation which is not fully harmonized nor unified at the EU level. Despite the numerous European rules in this area, the stakeholder consultations demonstrated that these rules are not well known and applied by copyright stakeholders. The present sections analyse the extent to which EU legal mechanisms facilitate litigation against cross-border online copyright infringement in the EU.

5.1. Cross-Border Enforcement under Brussels Recast Regulation

The Brussels Recast Regulation establishes the common rules applicable to the choice of jurisdiction as well as the recognition of judgments in cross-border litigation in MS. This legal framework is very promising especially after the Recast of the Brussels Regulation, which abolished the need of exequatur for the recognition of the judgment in other MS. However, these rules are rarely applied in the context of online copyright infringements.

In the framework of cross-border disputes, **the choice of jurisdiction** relates to the determination of the place where the rightsholder can bring an action against the alleged infringer and obtain damages for the prejudice suffered.

Example: The copyright infringement takes place in three Member States: Italy, France and Germany. The question is which court the rightsholder may bring a legal action – the German, French or Italian court?

The Brussels Recast Regulation specifies a number of criteria for identifying the competent jurisdiction. However, depending on the criterion selected, the extent of the jurisdiction of the court seized differs. In some cases, the court may rule on the entire case, while in others it may rule only on the infringement committed in the national territory.

Example: The German court has been seized by the rightsholder. In some cases, this court may decide on the entire case, including the infringement committed in Italy and France. On the contrary, in other cases, it may only take into consideration the infringement committed in Germany. Therefore, the rightsholder will have to bring independent actions before the Italian and French courts to stop the infringement in three countries and obtain the complete relief.

The relevant criteria for defining the competent jurisdiction for copyright owners under the Brussels Recast Regulations are the following:

(1) The main criterion is the **defendant's domicile**²⁰⁷. In this situation, the competent jurisdiction has the power to issue an **EU-wide judgment** with an extraterritorial effect. This means that the court in the competent jurisdiction may adjudicate on all damage suffered in several MS, and order an injunction covering more than one MS.

Example: The German court can decide on the copyright infringement and order relief for the claim covering not only Germany but also Italy and France.

At first sight, this rule seems to be very attractive for rightholders. However, in the context of online infringement the major problem for rightholders relates to **the defendant's identification**. In fact, very often the defendant's identity and localisation are unknown, and rightholders have limited possibilities to identify the infringer. In addition, even if the defendant can be localised and identified, often he will **be situated in a third country**, which automatically excludes the application of the Brussels Recast Regulation.

(2) The other option at rightholders' disposal to define the competent jurisdiction is based on **the forum delicti**²⁰⁸, which is the place where the harmful event occurred or may occur. This place includes both the place where damage occurs and the place where the damaging act was performed. Under the application of this rule, the scope of the judgment is limited to the national territory of the MS concerned and no EU-wide measures can be applied.

Example: If jurisdiction is determined by the forum delicti rule, and Germany is the place where the damage occurred, the German court would be unable to deliver a judgement on the infringement concerning Italy and France. Therefore, in order to obtain damages arising in the territory of the three MS, in this scenario the plaintiff must seek legal redress in each MS separately.

This rule was envisioned for classical tort-based legal actions in which it is easy to define two possible jurisdictions. The problem arises with **online infringement**, where this rule leads to potential competences of multiple MS jurisdictions, as the infringement may potentially occur in each MS given that the websites are generally accessible in the whole territory of the EU. In the context of copyright infringement, the CJEU has had an opportunity to discuss the application of this provision. Especially, two copyright cases are of particular importance - the Pinckney Case²⁰⁹ and The Hejduk Case²¹⁰.

²⁰⁷ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ L 351, 20.12.2012, p. 1–32 ([Brussels Recast Regulation](#)), Art. 4.

²⁰⁸ Ibid. Art. 7(2).

²⁰⁹ Judgment in [Case C-170/12](#) – *Pinckney v KDG Mediatech AG*, European Court of Justice, 3 October 2013, ECLI:EU:C:2013:635.

²¹⁰ Judgment in [Case C-441/13](#) – *Pez Hejduk v EnergieAgentur.NRW GmbH*, European Court of Justice, 22 January 2015, ECLI:EU:C:2015:28.

Box 3. Pinckney Case: a French resident, M. Pinckney brought an action against an Austrian company, Mediatech, who reproduced his songs on CDs. They were marketed by UK companies via a website accessible from France.

A French court held that it had jurisdiction to hear the case. The court ruled that the accessibility of the website to the French public was sufficient to establish a substantial connection between the facts and the alleged damage. The jurisdiction of this court was challenged by the defendant, who argued that Austrian or UK courts should have had jurisdiction over the case: the Austrian court because the defendant had its seat and manufactured CDs there, and the UK court because it was the place where the infringement had occurred.

The CJEU ruled that the accessibility of the website reproducing the copyright protected work in one MS justifies the competency of the court of that MS to hear the copyright infringement case. It is not necessary to prove that the alleged infringing activity was 'directed to' the MS in which the court seized is situated. However, the CJEU specified that the court of this MS has jurisdiction only to determine the damage caused within the MS.

Box 4. Hejduk Case: Ms Hejduk, an Austrian photographer, brought an action against a website reproducing her photographs without authorisation. An Austrian court ruled that Ms. Hejduk's copyright was infringed. The question raised by the referring court was whether the Austrian court was competent to hear the case. In fact, the defendant stated that his website was not directed to the Austrian public and that the mere fact that it was accessible from Austria is not sufficient to confer jurisdiction to Austrian courts. The CJEU rejected these observations and confirmed its approach in previous decisions. Thus, in the case of online infringement, the mere fact that a website is accessible in a MS where damage occurs is sufficient to justify the jurisdiction of that MS' court.

The accessibility approach that is applied in copyright cases by the CJEU is criticized by some stakeholders and academics. The main critique concerns its inconsistency with the Brussels Recast Regulation objectives²¹¹ of foreseeability and proximity²¹². The accessibility rule may lead to the attribution of jurisdiction to a court that lacks a connection with the case even the jurisdiction where the infringement is non-existent²¹³. It results in a situation where the enforcement may become unbalanced as it favours the rightsholder; the defendant may be sued potentially in any MS. However, some point out that this criticism has to be tempered by the fact that even if the rightholder can

²¹¹ Brussels Recast Regulation, Rec. 13, 15, 16.

²¹² L. Lundstedt, 'Jurisdiction and choice of law in online copyright cases' in E. Rosati (ed.), *The Routledge Handbook of EU Copyright Law*, Routledge, 2021, p. 399.

²¹³ E. Rosati, 'International Jurisdiction in Online EU Trade Mark Infringement Cases: Where is the Place of Infringement Located?', *EIPR*, 2016, 38 (8), p. 488.

hypothetically bring an action in 27 MS, such actions will be limited on the one hand by the rules on applicable law²¹⁴ (see section 5.2), on the other hand, by the fact that the jurisdiction is limited to damage within its territory.

An alternative solution would be to switch to a 'targeting' approach in copyright matters. This approach has been already applied in EUTM²¹⁵ as well as regarding the database right²¹⁶. It consists in choice of jurisdiction of MS that was targeted by the website. Moreover, it is important to note that none of the initiatives dealing with private international law rules for IPR include an accessibility approach. The soft law proposals of such rules include the ALI Principles²¹⁷, CLIP Principles²¹⁸, Transparency Proposal²¹⁹ and Joint Korean-Japanese Principles²²⁰. All these proposals were considered for creation of ILA Guidelines²²¹. For instance, the latter²²² creates a basis for a jurisdiction where substantial damage is caused, but only when it can be anticipated that an injury would arise in the State.

(3) Finally, the rule **on multiple defendants**²²³ applies to the situation of connected cases where it is expedient to hear them together to avoid the risk of an irreconcilable judgment if cases are heard separately.

Example: Two copyright alleged infringers can be identified in two MS: Germany and France. The copyright infringement concerns exactly the same work and the same facts. Instead of having two separate legal proceedings, one of the judges can decide to rule two cases in order to avoid the risk of having the contradictory judgments.

The CJEU had an opportunity to discuss the application of this rule to copyright claim in the **Painer case**²²⁴. Ms. Painer brought a legal action against Austrian and German publishers having reproduced her photographs. The Austrian jurisdiction introduced a preliminary question asking whether the multiple defendant rule applies to actions against several defendants for substantially identical copyright infringements brought on national legal grounds which vary. The CJEU stressed that a difference in legal bases between such actions does not, in itself, preclude the application of multiple defendant rule. However, the outcome of the application of this rule should be foreseeable by

²¹⁴ L. Lundstedt, 'Jurisdiction and choice of law in online copyright cases', op. cit. p. 400.

²¹⁵ See Judgment in [Case C-172/18 – AMS Neve Ltd et. al. v Heritage Audio SL](#), European Court of Justice, 5 September 2019, ECLI:EU:C:2019:674.

²¹⁶ See Judgment in [Case C-173/11 – Football Dataco Ltd et. al. v Sportradar GmbH and Sportradar](#), European Court of Justice, 18 October 2012, ECLI:EU:C:2012:642.

²¹⁷ American Law Institute, Intellectual Property: Principles Governing Jurisdiction, Choice of Law and Judgments in Transnational Disputes, ALI Publishers, 2008.

²¹⁸ European Max Planck Group on Conflict of Laws in Intellectual Property, Conflict of Laws in Intellectual Property (Text and Commentary), OUP, 2013; [The draft of Principles for Conflicts of Laws in Intellectual Property](#), 25 March 2011.

²¹⁹ Japanese Transparency Proposal on Jurisdiction, Choice of Law, Recognition and Enforcement of Foreign Judgments in Intellectual Property, see the English text in Annex III, in J. Basedow, T. Kono and A. Metzger (eds.), *Intellectual Property in the Global Arena*, Mohr Siebeck, 2010, pp. 394-402.

²²⁰ Joint Proposal by Members of the Private International Law Association of Korea and Japan, see *The Quarterly Review of Corporation Law and Society*, 2011, pp. 112-163.

²²¹ International Law Association, 'Guidelines: "Intellectual Property in Private International Law"', See [Fifth Committee Report](#), 2020, pp. 5-42.

²²² Ibid. Guideline 5 (b).

²²³ Brussels Recast Regulation, Art. 8.

²²⁴ Judgment in [Case C-145/10 – Eva Maria Painer v Standard Verlags GmbH et al.](#), European Court of Justice, 1 December 2011, ECLI:EU:C:2011:798.

defendants²²⁵. Moreover, the court seized needs to assess whether there is a risk of irreconcilable judgments if those actions were determined separately.

The Brussels Recast Regulation also contains rules on **the recognition and enforcement of judgments**. This concerns a case where a judgment given in one MS is recognised or enforced in another MS. The Recast of Brussels Regulation has considerably improved the recognition of judgments by abolishing the requirement of exequatur between the MS. Thus, there is no special procedure required neither for a recognition of a judgment²²⁶ nor for the enforcement of a judgment²²⁷. To recognize a judgment in another MS, the party shall produce a copy of the judgment and add a certificate which the court of origin issues at the request of any interested party.²²⁸ In certain situations, the addressed jurisdiction may require a translation of the judgment. The recognition of the judgment may be refused by the addressed jurisdiction if the judgment is challenged in the MS of origin or if a ground for refusal is successfully raised. This might be the case if there is a public policy consideration, a lack of respect for the requirement of due process or if the judgment is contrary to another judgment given between the same parties involving the same cause of action. The procedure for the enforcement of judgments is similar to that for the recognition of judgments in terms of the documents to be submitted and the grounds for refusal. The enforcement of a judgment is governed by the law of the MS addressed²²⁹.

These rules on recognition and enforcement are of particular interest to copyright owners as they concern not only final judgments but also **interim judgments**²³⁰. They include interim and protective measures as provided for in articles 6 and 7 of the IPRED²³¹. However, these provisions are not applicable in the case of *ex parte* measures, unless the decision containing the measure is served on the defendant before enforcement.²³² Furthermore, it is important to note that the Brussels Recast Regulations provides that the decision on interim or protective measures may be given both by the court having jurisdiction on the substance of the matter and by the court which does not have jurisdiction²³³.

In spite of all the above-mentioned simplifications, rightholders have had very little experience with the recognition and enforcement of judgments in other MS. This lack of experience is due to the following factors:

(1) **Speed of the procedure.** The very limited experiences with these provisions were fruitful for stakeholders, but they were not satisfied with the speed of the procedure. The latter depends on the jurisdiction, with some jurisdictions rated as very fast (e.g., Germany) and others as too slow (e.g., Italy, France). In two cases mentioned by stakeholders the procedure took more than one year, and this long delay had a considerable impact on the effectiveness of the measure (e.g., the preliminary injunction).

²²⁵ Ibid. Para. 81.

²²⁶ Brussels Recast Regulation, Art. 36 (1).

²²⁷ Ibid, Art. 39.

²²⁸ Ibid. Arts. 37 and 53.

²²⁹ Ibid. Art. 41 (1).

²³⁰ Ibid. Art. 2 (a).

²³¹ Ibid. Rec. 25.

²³² Ibid. Art. 2 (a).

²³³ Ibid. Art. 35.

(2) **Lack of awareness** of the simplified recognition/enforcement procedure.

(3) **Lack of availability** of certain enforcement measures (e.g., live blocking injunctions²³⁴) in some MS.

5.2. Applicable Law

Once the competent jurisdiction has been established, the second issue is to define the applicable law²³⁵. In general, the current legal framework leads to **a distributive application of laws**. It means that the judge dealing with the cross-border case needs to apply several national laws instead of one. This approach is consistent with the territoriality principle of national IPRs. However, according to stakeholder consultations and opinions expressed in the academia, this approach seems inadequate to deal with the issue of cross-border copyright online infringement.

The Rome II Regulation²³⁶ lays down rules to define the law applicable to actions with cross-border elements. As a general rule²³⁷, the law applicable to the case is the law of the MS in which the damage occurs. However, in the context of IPRs²³⁸, a special rule²³⁹ provides for the application of the ***lex loci protectionis***²⁴⁰. In fact, this rule—that applies the law of the MS for which the protection is sought — has its origin in the territorial approach²⁴¹ of IPRs derived from the Berne Convention²⁴² and Paris Convention²⁴³. The rules in these conventions do not deal directly with international private law issues, but they affect international private law solutions. This concerns in particular the principle of national treatment, which is clearly linked to the territorial application of IPRs and the principle of a minimum level of protection. The latter principle leaves room for countries to make specific provisions on IPRs in their national laws. This is in line with the imperatives of private international law since, in the presence of harmonisation of substantive law, the question of conflict of laws loses its relevance²⁴⁴.

The *lex loci protectionis* rule can be easily applied to IPRs which require registration²⁴⁵. Thus, the protection conferred by the title applies only in the given national territory. For example, in the case of infringement of German and French patents, the competent court will apply both German and French laws to the alleged infringement. The German law will apply to the infringement committed in Germany and inversely the French law will apply to the infringement committed in France. Similarly,

²³⁴ Frosio and Bulayenko, op. cit., pp. 39-41.

²³⁵ This section covers hypothesis of the copyright online infringement. Thus, the application of the [Regulation 593/2008](#) on the applicable law to contractual obligations (Rome I) is outside the scope of this study.

²³⁶ [Regulation 864/2007](#) on the law applicable to non-contractual obligations (Rome II Regulation).

²³⁷ Ibid. Art. 4.

²³⁸ Ibid. Rec. 26, the term 'intellectual property rights' covers all types of IPRs, including industrial property rights and copyright.

²³⁹ Ibid. Art. 8.

²⁴⁰ On the history and application of this provision see A. Kur, U. Maunsbach, 'Choice of Law and Intellectual Property Rights', *Oslo Law Review*, Vol. 6, No. I-2019, pp. 51-61.

²⁴¹ P. Torremans, 'The law applicable to copyright infringement on the Internet', *NIPR*, Vol. 4, 2016, pp. 687-695.

²⁴² Berne Convention, Art. 5.

²⁴³ Paris Convention, Art. 6quinquies.

²⁴⁴ See A. Kur, U. Maunsbach, 'Choice of Law and Intellectual Property Rights', op.cit., pp. 46-47.

²⁴⁵ Ibid. p. 48.

unitary EU titles with uniform substantive law rules do not raise major difficulties either²⁴⁶. For example, if an EU Trademark is infringed in several MS, the applicable law will be the EUTMR²⁴⁷.

The application of this provision becomes more controversial in the case of **online copyright infringement**. The absence of registration of the copyrighted work leads its potential protection in all MS and thus hypothetical application of 27 national laws.

Torremans' observation that in the context of copyright infringement, the *lex loci protectionis* rule is considered "unrealistic" in practice²⁴⁸, and this observation was confirmed by the results of the stakeholders' consultation. The main reasons mentioned are the following:

- (1) for a judge, it becomes very complicated to apply 27 different national laws, although harmonized yet different in many respects, with a sufficient level of knowledge of all of them;
- (2) for stakeholders, **the burden of proof** of 27 laws is too high. It increases transaction costs, such as cost of translations, expertise, and research to become familiar with foreign law;
- (3) for stakeholders, it also leads to **uncertainty** about the outcome of the proceedings. In particular, if there is no important national case-law showing the application of several laws.

Secondly, stakeholders and experts have indicated that **the current preferred litigation strategy is to avoid the application of multiple laws** (See Section 6). Rightsholders generally choose to litigate:

- (1) in a single MS that is the most relevant for the infringement and whose outcome is predictable; OR
- (2) on a MS-by-MS basis by selecting the most relevant jurisdictions; OR
- (3) a combination of the above two approaches, bringing a case in one MS and then, if successful, continuing the case in other jurisdictions.

The reason for this strategy is **time**. In the case of the application of several laws, the legal procedure takes a lot of time (time for obtaining expertise, counter-expertise, translations, etc.). Stakeholders stressed that they need a **quick and effective tool** to enforce their rights. Especially in the case of online infringement, there is a high risk that the infringer will move from one server to another, or create multiple identical websites, etc. If the enforcement takes too long (e.g., years), it loses its relevance for rightholders.

It is worth mentioning that solutions for changes have been proposed in the context of *soft law* instruments. For instance, the CLIP Principles propose a new rule for ubiquitous copyright infringements in the EU. This rule would lead to the application of the law that has a minimum connection²⁴⁹ to the court of the MS territory. In other words, in cases of ubiquitous infringements, it prevents rightholders from abusing their ability to bring suit in any MS and apply the laws of any MS by requiring that there is a minimum connection to the court and the law applicable. The Transparency

²⁴⁶ See Judgment in Joined Cases [C-24/16 and C-25/16](#) – *Nintendo Co. Ltd v BigBen Interactive GmbH and BigBen Interactive SA*, European Court of Justice, 27 September 2017, ECLI:EU:C:2017:724.

²⁴⁷ The national law comes into play, only in respect of matters that are not governed by the EUTMR.

²⁴⁸ P. Torremans, 'The law applicable to copyright infringement on the Internet', op.cit.

²⁴⁹ CLIP, Art. 3:602 De minimis rule. For a comment, CLIP (2013), *Conflict of Laws in Intellectual Property: The CLIP Principles and Commentary*, OUP, pp. 308-313.

Proposal²⁵⁰ opts for a market impact rule: the applicable law would be defined as the law of the country where the results of the exploitation of IPR occur.

Further suggestions on improving applicable law's determination are discussed in the Policy Recommendations (See Section 8.3 below).

6. MEMBER STATE-BY-MEMBER STATE LEGAL ACTIONS AGAINST CROSS-BORDER COPYRIGHT INFRINGEMENTS

Multiple practical challenges for establishing jurisdiction, applying foreign law and providing evidence (see Section 5.1) result in a situation where the **predominant approach for enforcing copyright online in the EU is MS-by-MS actions**. This enforcement approach to cross-border infringements in the EU would exempt rightholders from dealing with different issues related to choice of law, but requires them to carry out legal actions (administrative and/or judicial, where possible facilitated by voluntary arrangements) separately, in multiple MS. Such actions could be taken in succession or in parallel in multiple MS. Appeals to judicial and/or administrative decisions, if any, also have to be carried out in all MS concerned.

Table 2 below, which has been compiled according to publicly available records of cases and stakeholders' inputs, illustrates cases where rightholders carried out MS-by-MS enforcement actions (judicial or administrative) against the same infringing website²⁵¹ in at least three MS. Many of these legal actions were carried out by the same rightholders. For example, one stakeholder carried out copyright enforcement actions against 9 of these websites (against each of the websites it undertook legal action in at least in 3 MS, against one on them in 4 MS, against another one in 5 MS, and another website in 8 MS).

Table 2. Member State-by-Member State copyright enforcement actions against infringing websites operating across the EU²⁵²

Domain name ²⁵³	Type of website	Member State of Action (Date of Order)
Rarbg.to	BitTorrent indexing site	Belgium (2018) Denmark (2017) France (2020) Finland (2018) Greece (2019) Ireland (2018) Italy (2017) Portugal (2015)

²⁵⁰ Japanese Transparency Proposal on Jurisdiction, Choice of Law, Recognition and Enforcement of Foreign Judgments in Intellectual Property, op.cit., §301.

²⁵¹ Sometimes the same websites, online services, infringing content or software were hosted under different domain names.

²⁵² This information was established on the basis of stakeholders' input during the consultations, and matched to the extent possible with publicly available information. See Watch List 2020, pp. 21, 23, 26, 27 and 29-31 (citing national enforcement decisions), Borghi, M, et al., '[Illegal IPTV in the European Union: Research on online business models infringing intellectual property rights](#)', Report for EUIPO, 2019, p. 73, and publicly available decisions of administrative bodies and courts.

²⁵³ Including related domain names in some cases.

		UK (2014)
1337x.to	BitTorrent indexing site	Austria (2017) Belgium (2018) Denmark (2016) Greece (2018) Ireland (2018) Italy (2018) Spain (2018)
Torrentreactor.net	BitTorrent indexing site	Belgium (2013) Denmark (2016) France (2016) Italy (2012)
Popcorn Time	Making available software for streaming using BitTorrent protocol	Belgium (2015) Denmark (2017) Italy (2015) UK (2015)
2conv.com	Stream ripping	Denmark (2018) Italy (2019) Spain (2019)
Convertio.io	Stream ripping	Denmark (2019) Italy (2019) Spain (2020)
Flvto.biz	Stream ripping	Denmark (2018) Italy (2018) Spain (2019)
Mp3-youtube.download	Stream ripping	Denmark (2019) Italy (2019) Spain (2020)
yout.com	Stream ripping	Denmark (2020) Italy (2019) Spain (2020)
Libgen.is	Downloading site	France (2019) Greece (2019) Italy (2018) UK (2015)
Swatchseries.to	Linking site	Belgium (2018) Denmark (2018) Italy (2020)
Rojadirecta	Linking site	France (2015) Italy (2011) Spain (2018)
Rlsbb.ru	Linking site	Belgium (2018) Denmark (2018)

		Italy (2015) Portugal (2015)
Newalbumreleases.net	Linking site	Denmark (2016) France (2019) Greece (2019) Italy (2017) Portugal (2015)

One of the most notorious cases of MS-by-MS enforcement actions against an infringing website, is that against The Pirate Bay (TPB), a BitTorrent indexing website, engaging in wilful large-scale cross-border online copyright infringement. The below table illustrates various legal actions carried out against TPB by one of the stakeholders.

Table 3 Enforcement actions against The Pirate Bay by a stakeholder in the EU ²⁵⁴		
Member State	Year	Action
Sweden	2006	Criminal proceedings against TPB first filed. Matter included proceedings in the Swedish District Court, Court of Appeal and Supreme Court.
Denmark	2008	Civil injunction proceedings against ISP intermediaries first filed. Matter included proceedings in the Danish Enforcement Court, Court of Appeal and Supreme Court.
Ireland	2008	Civil injunction proceedings against an ISP intermediary filed.
Italy	2008	Civil injunction proceedings against an ISP intermediary first filed. Matter included proceedings in the Criminal Court, Appeal Court and Supreme Court.
Sweden	2009	Civil proceedings against TPB first filed. Matter included proceedings in the Swedish District Court, Court of Appeal and an application to appeal to the Supreme Court.
Sweden	2009	Civil injunction proceedings against an ISP intermediary first filed. Matter included proceedings in the Swedish District Court and Court of Appeal.
Netherlands	2009	Civil proceedings against individuals brought by BREIN.
Netherlands	2009	Civil injunction proceedings brought against an ISP intermediary.
Belgium	2010	Civil injunction proceedings against ISP intermediaries filed in 2010, with Appeal Court proceedings.
Finland	2011	Civil injunction proceedings brought against ISP intermediaries.

²⁵⁴ This information was established on the basis of stakeholders' input during the consultations, and matched to the extent possible with publicly available information. See Watch List 2020, p. 25 (citing national enforcement decisions) and publicly available decisions of administrative bodies and courts.

UK	2012	Civil injunction proceedings brought against ISP intermediaries.
Belgium	2013	Criminal proceedings against operators of TPB.
France	2014	Civil injunction proceedings brought against ISP intermediaries.
Austria	2015	Civil injunction proceedings against ISP intermediaries first filed, with Appeal Court proceedings.
Portugal	2015	Civil injunction proceedings brought against ISP intermediaries.
Spain	2015	Administrative injunction proceedings brought against ISP intermediaries.
Romania	2016	Civil injunction proceedings brought against ISP intermediaries.
Greece	2020	Administrative proceedings brought against ISP intermediaries.

Furthermore, at the European level, in 2017 the CJEU found that the activities of TPB were directly infringing the right of communication to the public.²⁵⁵ Also, TPB is listed in both editions, 2018 and 2020, of the European Commission's Watch List.²⁵⁶ In 2013, the European Court of Human Rights rejected the application of co-founders of TPB, condemned by the Swedish court to prison sentence and damages, as "manifestly ill-founded".²⁵⁷ Outside the EU, TPB is also blocked in multiple third countries, including some non-EU EEA Member States, such as Argentina, Australia, Iceland, India, Norway, Russia, Singapore and the UK.²⁵⁸ Over a decade of legal actions through criminal, administrative and civil procedures, at national and European levels, that found TPB liable in most instances, might justify some policy questions. In particular, is this multiplication of repetitive legal actions an efficient allocation of private and public money that serves well online copyright enforcement in the Single Digital Market? Is this justified from a public policy perspective? Perhaps, the history of legal actions against TPB suggests that there is an urgent need to facilitate online cross-border enforcement in the EU.

In none of the studied cases (Tables 2 and 3) of MS-by-MS legal actions against infringing websites, rightholders pursued remedies in all MS. It is plausible that some infringers may stop their operations after multiple legal actions in different MS, and that it becomes unnecessary to pursue further actions in other MS. Yet, the studied cases demonstrate that multiple wilful infringing operations continue despite being blocked in some MS, thus requiring additional resources for continuing enforcement actions in other MS. The enforcement cases mentioned above also demonstrate that rightholders do not undertake enforcement actions in all MS with the same intensity, and that some MS are chosen more often than others.

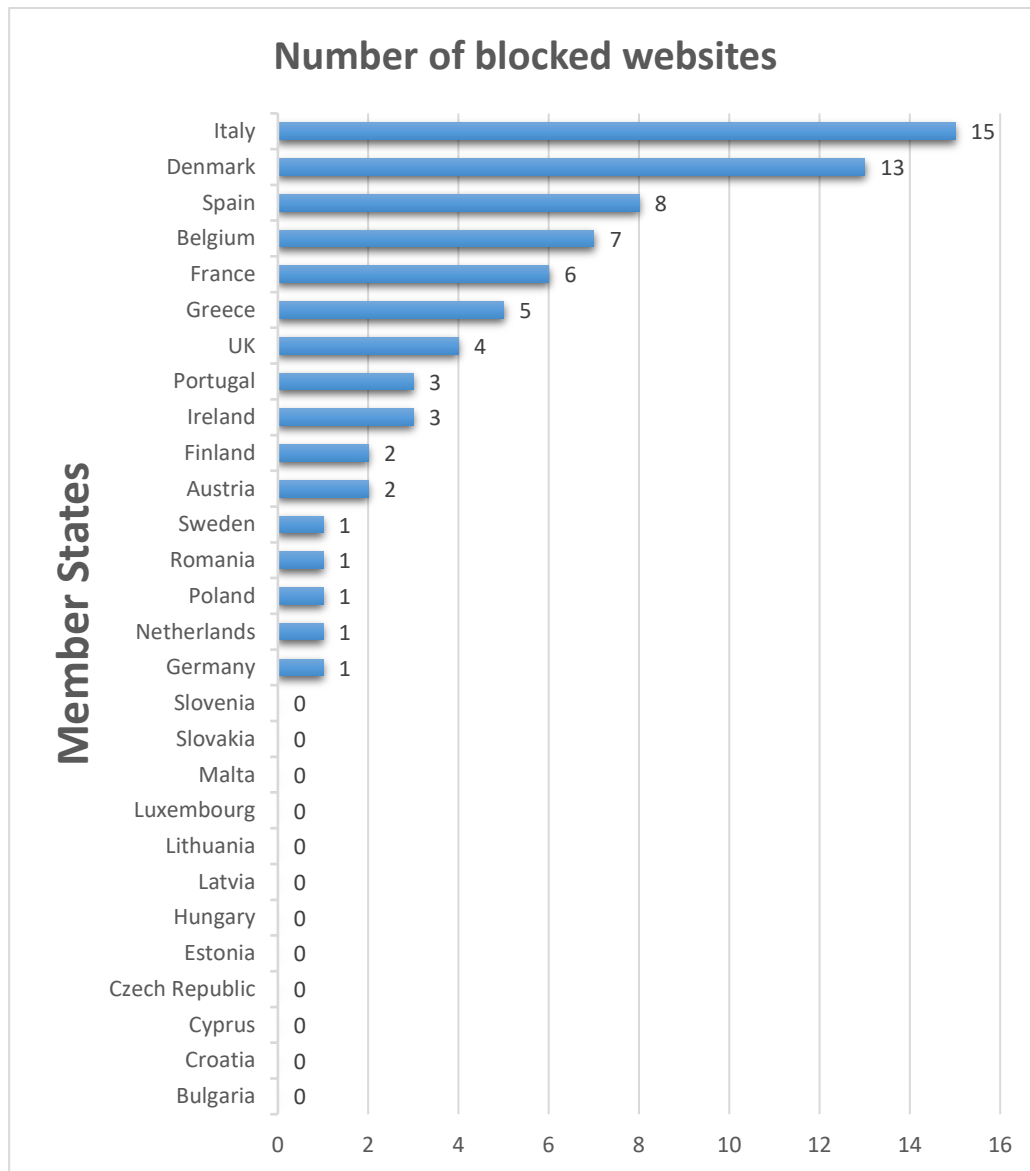
²⁵⁵ Judgment in [Case C-610-15](#), *Stichting Brein v Ziggo BV and XS4All Internet BV*, European Court of Justice, June 2017, ECLI:EU:C:2017:456.

²⁵⁶ Watch List 2020, pp. 24-25; and Watch List 2018, pp. 16-17.

²⁵⁷ ECtHR, *Neij and Sundekolmisoppi v. Sweden* (dec.), no. 40397/12, 19 February 2013.

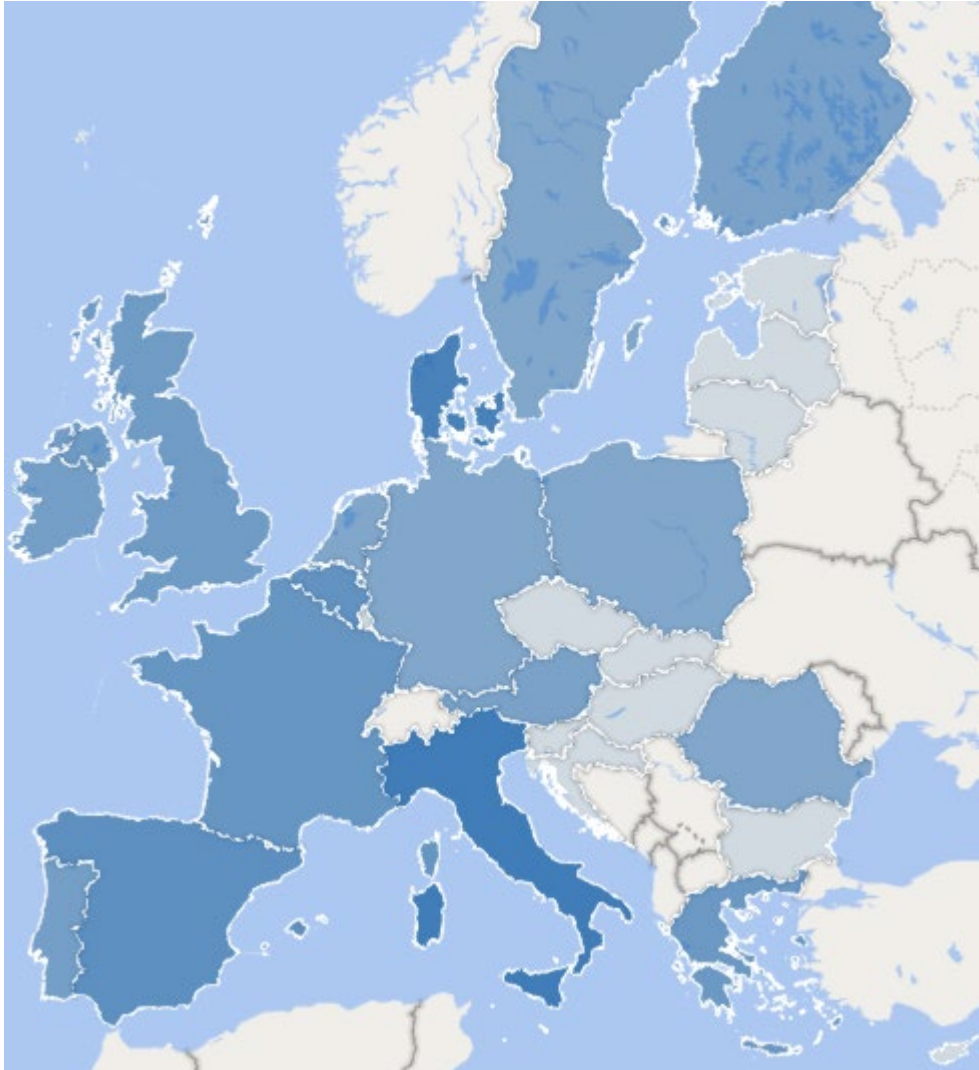
²⁵⁸ Watch List 2020, p. 25.

Figure 2. Member States of copyright enforcement actions against studied infringing websites operating across the EU²⁵⁹



²⁵⁹ The figure combines information from Tables 2 and 3, and a decision of the German Hamburg District Court of 2010 blocking access to TPB (injunction proceedings against a provider of Internet routing services). This case is not covered by Table 3, as it was initiated by a different rightholder.

Figure 3. Intensity of legal action in Member States against 15 infringing websites operating across the EU²⁶⁰ [The darker MS colour on the map, the higher the number of copyright enforcement actions, ranging from ■ (actions against all 15 copyright infringing websites) to ■ (zero/0)].



The cost hurdles involved in the MS-by-MS approach in the enforcement of online copyright infringements in the EU requires rightholders to make choices about MS where to pursue legal actions. As per the feedback received, even international and European associations of rightholders pooling resources for carrying out enforcement on behalf of a large number of rightholders did not pursue legal actions in all MS. The stakeholder consultations also demonstrated that rightholders are confronted with the need to make strategic choices about MS on where to initiate enforcement actions. Such choices are made, most notably, by considering costs/efforts versus the expected impact. According to the studied cases (figures 2 and 3), the largest number of enforcement actions initiated against websites infringing copyright and related rights in the EU are made in the Western European MS. All the MS with a lower number of copyright enforcement actions are among the MS that joined the EU

²⁶⁰ On the basis of Figure 2.

following the Eastern enlargement in 2004.²⁶¹ In this regard, only one action against infringing websites was carried out in Poland and Romania, and zero in others. Although the available sample of copyright-infringing websites against which enforcement actions were initiated in different MS is relatively limited (15), it represents some of the most notorious cases in the period 2006-2020.²⁶² A probable hypothesis for explaining the geographical allocation of enforcement action is that, under the MS-by-MS enforcement approach, rightholders prioritise actions in relatively larger and/or richer MS,²⁶³ where they could gain a relatively higher impact for the protection of their economic interests.

Another circumstance that is reflected by the intensity (number) of legal enforcement actions carried out in different MS is the availability of voluntary and/or administrative measures complementing the judicial system in the period concerned (2006-2020). The legal systems of Italy, Denmark, Spain, Greece and Portugal provide for administrative and/or voluntary measures for online copyright enforcement, which were also appreciated by rightholders during the stakeholder consultations. This fact is reflected in the above mapping of the intensity of legal actions, apart from Lithuania, where the administrative enforcement system was not used in the studied cases.²⁶⁴ A lack of appropriate legal remedies could be a reason for an absence of legal enforcement actions.

On a final note, it is worth highlighting a trifecta of limitations of the enforcement scenario just described. First, from a general market perspective, MS-by-MS litigation might make it unattractive for rightholders to run their business in the "Digital Single Market." Second, from a public policy perspective, it is also unsatisfactory that copyright and related rights are mostly enforced in some (mostly larger and/or richer) MS. Third, the continued availability of infringing websites in some (mostly smaller and/or less wealthy) MS is also unsatisfactory from the perspective of affirming and developing the culture of access to copyrighted works through legitimate services. Development of pan-EU solutions, permitting rightholders to overcome the limitations of the MS-by-MS approach, would greatly facilitate the establishment of the Digital Single Market as well as ensure the equitable treatment of businesses and citizens regardless of the MS of their residence.

²⁶¹ The Eastern EU enlargement included: Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta Poland, Slovakia, and Slovenia (in 2004), Bulgaria and Romania (in 2007), and Croatia (in 2013).

²⁶² Watch List 2020, pp. 16-35.

²⁶³ [National Accounts \(Including GDP\), Data, Main Tables](#), Eurostat.

²⁶⁴ Some of the consulted stakeholders that used administrative procedures in other MS also reported to have no experience of referring cases to the RTCL.

7. OVERALL EFFECTIVENESS EVALUATION

The present evaluation of effectiveness of different measures for copyright enforcement against wilful large-scale online infringements builds upon the preceding analysis, literature review and the input received during the consultations with stakeholders and experts in the field. To the extent possible, the evaluation compares the effectiveness of different types of enforcement measures (voluntary, administrative and judicial).

7.1. Evaluation of Effectiveness of Different Technological Solutions

Different primary blocking techniques (blocking of IP addresses, blocking of DNS, blocking of Uniform Resource Locator (URL), techniques which examine network traffic at a high level Shallow Packet Inspection (SPI) or more detailed level Deep Packet Inspection (DPI)) as well as hybrid blocking techniques combining DNS blocking with other techniques (DNS and URL; DNS and SPI; and DNS and DPI) imply different costs and speed of implementation, integrity of network performance, impact on legitimate services and law abiding Internet users, as well as on blocking effectiveness and difficulty of circumvention.²⁶⁵ Yet, it is important to affirm that no technical solution implementing any of the legal enforcement measures ensures that the infringing content remaining online is 100% not accessible.²⁶⁶ Depending on the technical approach adopted for blocking, techniques of various complexity could be used for overcoming them. Many of such techniques are quite easily available to Internet users (e.g., use of a virtual private network (VPN), use of an alternative DNS resolver, use of an anonymous proxy https).²⁶⁷ Similarly, infringing services relying on blocked Internet resources could be rapidly reconfigured to use non-blocked resources (e.g., by moving to another domain name, network or by using alternative syntaxes for expressing the same resource name).²⁶⁸ The fact of absolute technological block of access being acknowledged, it is important to underline that the EU law does not place 100% effectiveness as a condition for granting a website blocking injunction. The CJEU, after recognising that that “it is possible that a means of putting a complete end to the infringements of the intellectual property right does not exist or is not in practice achievable, as a result of which some measures taken might be capable of being circumvented in one way or another”, concluded that it is sufficient that the measures taken by the ISP under court’s injunction “have the effect of preventing unauthorised access to the protected subject-matter or, at least, of making it difficult to achieve and of seriously discouraging internet users who are using the services of the addressee of that injunction from accessing the subject-matter that has been made available to them in breach of the intellectual property right”.²⁶⁹ Website blocking contributes to an overall reduction of online copyright infringement, even if this enforcement measure could be circumvented.²⁷⁰ The fact that it could be

²⁶⁵ [“Site Blocking” to reduce online copyright infringement: A review of section 17 and 18 of the Digital Economy Act](#), Ofcom, 27 May 2011, p. 4.

²⁶⁶ [Consequences of DNS-based Internet filtering](#), AFNIC Scientific Council, p. 4; Ofcom, *ibid.*, p. 5.

²⁶⁷ AFNIC Scientific Council, *ibid.*

²⁶⁸ R. Barnes, A. Cooper, O. Kolkman, D. Thaler and E. Nordmark, [Technical Considerations for Internet Service Blocking and Filtering](#), IAB, 2016, pp. 13 and 21 (looking at the efficacy of rendezvous-based blocking, including the DNS, by examining how easy it is for a resource or service to avoid being blocked).

²⁶⁹ Judgement in [Case C-314/12 – UPC Telekabel Wien v Constantin Film and Others](#), European Court of Justice, March 2014, ECLI:EU:C:2014:192, paras. 60 and 64.

²⁷⁰ Ofcom, *ibid.*, p. 6.

bypassed does not mean that it is necessarily bypassed, the circumvention being dependent on a number of factors, such as the Internet user's knowledge and skills, convenience and availability of circumvention techniques, attractiveness of available licit offers. Available evidence points towards efficacy of blocking measures to reduce usage of blocked websites.²⁷¹ For example, the recent empirical data on effects of blocking injunctions suggests 75% reduction of visits of blocked websites in Denmark (going over 86% and up to 95% in some instances)²⁷² and 69.7% in Portugal.²⁷³

7.2. Evaluation of Voluntary Measures for Enforcement

In reflecting on the overall effectiveness of existing voluntary measures (CoCs, CoPs and MoUs) for online copyright enforcement, the consulted stakeholders and legal experts had mixed impressions. According to stakeholders, the most effective voluntary measures are those that enable rightholders to obtain relief against all major ISPs in the relevant national market. Such arrangements are considered more effective, as they reduce the risk of users accessing infringing sites using a different ISP, and are more efficient by reducing duplicative work for rightholders. Additionally, having all major ISPs covered by the same voluntary agreement ensures a level playing field for ISPs operating in the territory. The voluntary systems in place in Denmark, Portugal and Germany involve the participation of all major ISPs in those jurisdictions, and are considered by rightholders as good examples of voluntary cooperation. Yet, at the moment of the inquiry, the CUII, created under the German voluntary arrangement, has only considered its first few cases,²⁷⁴ and hence stakeholders could not report yet on the effectiveness of its operation. The operation of Danish and Portuguese arrangements was considered effective by rightholders.

Furthermore, it was generally acknowledged that the successfulness of voluntary measures depends on genuine cooperation, goodwill, and commitment of the parties. While governments may play a role in encouraging the adoption of a voluntary measure,²⁷⁵ the practicalities of enforcement generally remain at the discretion of the parties. As some rightholder groups pointed out, despite the presence of a voluntary measure, in some instances enforcement can be lacking in terms of efficiency and efficacy of the measures deployed by intermediaries, including ISPs. In the sports broadcasting sector, for example, it was emphasized that the timeliness of removals after the submission of takedown requests to intermediaries is not satisfactory under voluntary agreements such as CoCs. It can result in inconsistent enforcement on the side of intermediaries, and provides an insufficient remedy for time-sensitive infringements, such as live broadcasting of sports events.²⁷⁶

Some stakeholders also raised concerns over the lack of cooperation between the parties to voluntary agreements and related third parties, such as Internet users. Particularly, it seemed unclear how such agreements are able to ensure that sufficient procedural safeguards (e.g., due process) are in place,

²⁷¹ N. Cory, 'How Website Blocking Is Curbing Digital Piracy Without "Breaking the Internet"', Information Technology & Innovation Foundation; and [Cartier International AG v. British Sky Broadcasting Ltd.](#), EWHC (Ch) 3354 [UK], 17 October 2014, paras. 218-237.

²⁷² [Report on Share With Care 2 campaign](#) carried out in the period October 2018 until the end of 2019, April 2020 pp. 2-8.

²⁷³ 'Site blocking efficacy in Portugal: September 2015 to October 2016', INCOPRO, May 2017, p. 3.

²⁷⁴ [Recommendations](#), CUII website.

²⁷⁵ See, e.g., Denmark, Germany, Belgium, UK, Italy and Portugal, in 3.2

²⁷⁶ See, for a broader discussion about timeline for removal and blocking of infringing live streams of sports event, Frosio and Bulayenko, JIPLP, op. cit, pp. 10-11.

possibly affecting the balance of fundamental rights of Internet users.²⁷⁷ This issue was raised, for example, with regard to the German CUII procedure, though other stakeholders maintained that the system was properly balanced and in conformity with national constitutional and EU laws.²⁷⁸

A final limitation of voluntary measures of enforcement is the fact that agreements are typically negotiated between domestic private parties, and administered on a limited, territorial basis. As demonstrated by the examples in Section 3 above, such agreements have been reached only between rightholder groups and domestic service providers and/or applied only in the targeted territory,²⁷⁹ even when signed by actors operating in multiple MS.

7.3. Evaluation of Administrative Measures for Enforcement

Generally, stakeholders positively evaluated the use of administrative measures and specialised administrative authorities to facilitate the enforcement of copyright and related rights in the online environment. Rightholders have expressed their openness to testing new administrative procedures as they are introduced and developed in MS, and are optimistic that in time such procedures can steadily improve and become more efficient as administrative authorities gain experience. From a rightholder perspective, administrative processes are perceived as more expeditious and cost-effective than obtaining a court order, and are perceived as more reliable than enforcement through voluntary measures alone. Also, the costs of administrative procedures were also described by some rightholders and experts as being standardised and more predictable than that of court proceedings. Therefore, administrative enforcement measures tend to be favoured as a means of enforcement in comparison with other available options.

However, with respect to the use of expedited administrative procedures to effect blocking orders, a concern was expressed that an administrative procedure may not provide much opportunity for Internet users or allegedly infringing website operators to dispute an order. On the side of Internet users and allegedly infringing website operators, the absence of certain due process guarantees (customary for court proceedings²⁸⁰), including limitations on their ability to dispute a claim, and disruptions to their legitimate business operations, may raise some concerns. Especially in the case of Internet users (and the public-at-large), access to legitimate information, and the use of services for legitimate purposes, may be impeded by an overbroad blocking order effectuated against an entire website or domain. Such user activities are protected by fundamental freedoms of expression and information, and therefore need to be carefully counterbalanced against the need of rightholders to stop or prevent infringing activities.²⁸¹

²⁷⁷ See, e.g., for a discussion of this balance and related private ordering pitfalls, the literature cited at fn 110.

²⁷⁸ For a critique of the CUII, see J. Reda and J. Selinger, '[Netzsperrungen durch die CUII: Private Rechtsdurchsetzung zulasten der Grundrechte Dritter \(Network blocking by the CUII: Private law enforcement at the expense of the fundamental rights of third parties\)](#)', *Verfassungsblog*, 24 March 2021.

²⁷⁹ See, e.g., '[Notice-and-Take-Down Code of Conduct](#)' [NL]; '[Code of Practice on Search and Copyright](#)' [UK].

²⁸⁰ J. Griffiths, 'Enforcement of intellectual property rights and the right to a fair trial', in C. Geiger (ed.), *Research Handbook on Intellectual Property and Human Rights*, Edward Elgar, pp. 438-454.

²⁸¹ See, e.g., stressing this point, a long line of case law from the European Court of Human Rights, including ECtHR, Judgement of 18 December 2012, *Ahmet Yildirim v Turkey*, App. no. 3111/10, ECtHR, Judgement of 23 June 2020, *Vladimir Kharitonov v. Russia*, App. no. 10795/14, ECtHR, Judgement of 23 June 2020, *Flavus and Others v. Russia*, App. nos 12468/15, 23489/15 and 19074/16, ECtHR, Judgement of 23 June 2020, *Bulgakov v. Russia*, App. no. 20159/15, Judgement of 23 June 2020, ECtHR, *Engels v. Russia* App. no. 61919/16. See also Opinion of AG Villalón in Case C-314/12 – *UPC Telekabel Wien*, European Court of

Additionally, the scope of the administrative order is often restricted to the territory in which protection is sought, which can be burdensome on the side of rightholders faced with widespread infringements involving multiple MS. Other than a seemingly exceptional case from Spain (discussed above),²⁸² according to the stakeholders and experts consulted, administrative orders are typically only directed against domestic intermediaries, notably ISPs. Currently there are no EU mechanisms for the direct recognition and enforcement of administrative orders obtained in one MS against intermediaries operating in other MS.

7.4. Evaluation of Judicial Measures for Cross-Border Enforcement of IPRs

Courts play a vital role in ensuring that the outcomes of copyright enforcement proceedings remain balanced, fair, and are applied consistently. Though proceedings raised in civil courts have become rarer in the online infringement context, there are several benefits to initiating court proceedings in a national court.

First, judgements rendered by the national court are mandatory for execution, and their effective implementation is ensured through the state machinery of law enforcement, in contrast to voluntary arrangements. In the same way, during the course of a judicial proceeding, judges can also compel the production of evidence, and may be better situated to compel the production of evidence from another jurisdiction, if such information is necessary for the resolution of a case. This is an important ability given the countervailing privacy rights and privileges which safeguard the identities of alleged infringers, as well as the ability of service providers to conduct their businesses. In this respect, the authority of the court can be significant in comparison to the ability of individual or small group of rightholders in obtaining the same types of information.

Second, relating to the cross-border dimensions of judgements rendered by national courts, the principles of mutual recognition of decisions, as well as judicial cooperation, are already well-established and facilitated by EU mechanisms and rules. Rules on judicial cooperation in civil matters (a.k.a. private international law) comprise a distinctive segment of EU legal practice, and are critical for addressing the many complex cross-border enforcement scenarios that may arise in the exchange of goods and services EU-wide. As addressed in the Brussels Recast Regulation,²⁸³ and confirmed by the EU Treaties,²⁸⁴ measures facilitating judicial cooperation, approximation of laws, and mutual recognition of judicial decisions are prioritised with the ultimate policy goal of reducing barriers between MS judicial systems, and thereby promoting a well-functioning Single Market. In this regard, since there is already a strong existing framework in place for judicial cooperation and mutual recognition of judgements, focusing such principles specifically towards improving the resolution of cross-border cases involving online copyright infringements seems quite feasible, and may prove beneficial for rightholders faced with the resource-intensive task of litigating in multiple MS.²⁸⁵

Justice, 2013, ECLI:EU:C: 2013:781, para 82 (noting that '[a]lthough it is true that, in substance, the expressions of opinion and information in question are those of the ISP's customers, the ISP can nevertheless rely on that fundamental right by virtue of its function of publishing its customers' expressions of opinion and providing them with information').

²⁸² Section 4.2 (Box 2).

²⁸³ Brussels Recast Regulation, Recital para. 3.

²⁸⁴ TFEU, Art. 81.

²⁸⁵ Tables 2 and 3 on enforcement actions on a MS-by-MS basis.

Third, raising an issue before a national court, and receiving a definitive judgement on the matter, can serve to expand the reach of current enforcement without resorting to legislative action. In the case of *FAPL v. BT*, for example, the ruling of the UK High Court proved to carry important precedential value in the expansion of the enforcement tool of blocking orders in a dynamic infringement context.²⁸⁶ In this way, national court decisions can also be used to clarify certain concepts, address new technological developments affecting the enforcement of rights, and balance the interests in users and rightholders in an evolving legal landscape.

Despite these positive aspects of judicial enforcement, in general, much of copyright enforcement in the online environment has shifted away from the use of court proceedings in favour of using voluntary, and administrative measures.

Primarily, rightholder groups cited the high costs and lengthy timeframe of initiating judicial proceedings against infringements occurring online. Most of the consulted groups engage in a “cost-benefit” calculation to determine which enforcement strategy is suited their needs in specific cases of infringement. For some infringements involving a high volume of websites or webpages, rightholders opted for the use of administrative measures, where data on multiple infringements could be reviewed in bulk and then directly submitted to intermediaries within a short amount of time. Similar procedures may not be available when rightholders attempt to enforce rights in a national court, and in some jurisdictions national courts may not be sufficiently equipped or specialised to handle such requests in a timely (or cost-effective) manner. Conversely, some rightholders may choose to litigate in spite of the high costs of initiating a court proceeding if the resulting judgment will be beneficial in the long run. According to rightholder groups in several sectors, such has been the case regarding the choice of litigating in the UK, as the court proceedings were considered particularly costly, but worthwhile in terms of setting useful precedents.

Additionally, in observing rightholders’ preferences for the use of administrative versus judicial measures, in jurisdictions where both options were available, it was observed that rightholders mainly pursued infringements through utilising administrative procedures. According to data collected in the study (see tables 2 and 3), 5 out of 5 websites blocked in Greece and at least 9 out of 14 websites blocked in Italy, were blocked by orders of administrative authorities, EDPPI and AGCOM, respectively. In fact, the stakeholder consultations also demonstrated perceived uncertainty as to the availability of blocking injunctions as a judicial measure in Greece.²⁸⁷ It therefore seems that, at least in some MS where both court and administrative measures are available, rightholders tend to favour administrative procedures over court litigation.

Nevertheless, this transition has its drawbacks, particularly with respect to preserving due process safeguards, ensuring the recognition of fundamental rights interests of third parties such as Internet users and the public at large. Administrative and court procedures have a number of differences in

²⁸⁶ See [Football Association Premier League v British Telecommunications](#) [2017] EWHC 480 (Ch). In the UK, sports broadcasts are protected by copyright under the Copyright, Designs and Patents Act of 1988. See also, for further discussion of live blocking injunctions of sports broadcasts, Frosio and Bulayenko, op. cit.

²⁸⁷ The first three and, arguably only, Greek court decisions implementing interim measures for website blocking, according to art. 64A Greek Copyright Act had different outcomes. All of them issued by the Single Person First Instance Court of Athens (interim measures procedure): No 4658/2012 (implements blocking), No 13478/2014 (rejects blocking) and 10452/2015 rejects for procedural reasons, without entering into the substance). Theódoros Chίου (2016), ‘Πνευματική ιδιοκτησία και αποκλεισμός πρόσβασης σε ιστοτόπους: η αναλογικότητα σε έναν ψηφιακό κόσμο’ (‘Copyright law and website blocking: Proportionality in a digital world’), ΧρΙΔ (‘ChrID’), Vol. 3, pp. 230-239 (§32ff).

composition, level of independence of decision-makers, and in the overall organisation of the processes,²⁸⁸ which make the guarantee of the due process more challenging to sustain. Given the challenges that rightholders experience with using judicial measures against cross-border online copyright infringements in the EU, it seems that policy action further facilitating cross-border judicial enforcement in the EU with regard to wilful large-scale infringements is desired, especially in recognising the important societal position of the judicial system in upholding the rule of law. This option will be further explored in Section 8, Policy Recommendations.

7.5. General Limitations to the Overall Effectiveness of Cross-Border Enforcement

In evaluating the overall effectiveness of cross-border copyright enforcement online in the EU across the three main categories of enforcement measures (voluntary, administrative, and judicial) several recurring issues arise.

First, the online environment causes obstacles to the effective enforcement in multiple MS. In this regard, for rightholders, the task of identifying direct infringers has been characterised as very challenging or sometimes practically impossible. On the Internet, identities can be easily concealed, and the disclosure of private Internet user information is strictly regulated by EU²⁸⁹ and national laws on personal data protection. Websites can also be run by multiple people in multiple jurisdictions, within or outside the EU. In cases where direct infringers have been located and identified, often rightholders find it more costly to start legal action against an individual than to devote the same resources towards secondary infringers whose networks are used to infringe copyrights. In this regard, as discussed above, rightholders have dedicated the majority of their resources to enforcement efforts targeting intermediaries, whose services are used for online copyright infringements. Intermediaries (e.g., ISPs) are relatively well-positioned to stop or lower the infringement, blocking the availability of infringing content (e.g., through DNS blocks) to Internet users in the EU.²⁹⁰ Thus, from a rightholder's perspective, targeting intermediaries as opposed to direct infringers is a more cost-efficient enforcement strategy.

Another set of general issues relates to the lack of consistency in both the availability of measures and procedures for enforcing IPRs in the MSs, as well as in the definition and interpretation of key terminology of EU instruments as they have been implemented by MS. In this context, judicial and legislatively-mandated voluntary enforcement measures are available through the EU, although the exact remedies available are not the same in spite of harmonisation efforts. National courts may also apply differing national laws and adhere to different evidentiary standards which can produce a lack of predictability or certainty when litigating infringements in multiple MS' courts. In a number of MS, these enforcement measures are complemented by additional administrative measures and pure

²⁸⁸ See generally, Cogo and Ricolfi.

²⁸⁹ [Regulation 2016/679](#) of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data (General Data Protection Regulation), 4 May 2016; Charter of Fundamental Rights of the EU, Arts. 7 and 8, and European Convention on Human Rights, Art. 8. Judgements in [Case C-70/10 - Scarlet Extended v SABAM](#), European Court of Justice, November 2011, ECLI:EU:C:2011:771; [Case C-360/10 - SABAM v Netlog](#), 1 European Court of Justice, February 2012, ECLI:EU:C:2012:85; [Case C-275/06 - Promusicae v Telefónica de España](#), European Court of Justice, January 2008, ECLI:EU:C:2008:54.

²⁹⁰ See, e.g., on enforcement strategies enlisting intermediaries, R. Kraakman, 'Gatekeepers: The Anatomy of a Third-Party Enforcement Strategy', *Journal of Law, Economics and Organization*, 2(1), 1986, p. 53; W. Fisher, [CopyrightX: Lecture 11.1](#), Supplements to Copyright: Secondary Liability, 18 February 2014, 7:50 (applying Kraakman's framework to copyright infringement).

voluntary arrangements among stakeholders. Such voluntary agreements reached between rightholders and intermediaries, differ considerably in their scope, and are commonly upheld by virtue of the parties' goodwill towards recognising and preventing illegal activities. Administrative mechanisms, offering a specialised procedure for online infringements or recognising a specific administrative body to support enforcement actions, have enjoyed considerable success and in some MS are being used more frequently than judicial remedies for online copyright infringements.

Following these observations, differing national implementations of EU Directives, particularly the ECD, creates further consistency issues regarding the interpretation of key terminology relevant to the enforcement of IPRs among MS. In the case of infringement of copyright and related rights in the online environment, the ECD has provided a basis for enforcement which centres on a limited liability regime for service providers. As already mentioned, under the ECD, hosting providers cannot be held liable for users' infringing activities unless they obtain "actual knowledge" of those activities. When obtaining such "actual knowledge", the service provider must act "expeditiously" to remove or disable access to the information in order to avoid liability for the infringement, and benefit from the liability exemption regime.²⁹¹ The legal construction of the provisions above differ significantly among MS. Due to their inherent vagueness, these provisions have been repeatedly interpreted by the CJEU and national courts, which in turn have been applying in their peculiar ways the CJEU jurisprudence on point, multiplying fragmentation and inconsistent approaches at the EU level.²⁹²

Consequently, private actors may disagree as to the correct interpretation of several legal standards that serve to define the scope of the ECD's liability exemptions, thus creating legal uncertainties that impact the enforcement of even purely voluntary arrangements, as well as administrative and judicial enforcement procedures. In particular, one recurring concern for rightholders is the **lack of a common understanding of acting "expeditiously", under Art. 14 of the ECD, to remove or prevent access to infringing content**. This concept has not been clearly defined in national law or by existing judicial practice. The standard is also not well-defined by industry practice, as demonstrated by a lack of consistency in the timeframes included in voluntary agreements (if a timeframe is mentioned at all). As a result, rightholders have reported instances of slow enforcement, which can result in significant damage given the ease of infringement in the online environment. Along the same lines, among the MS there is a **lack of clarity and common understandings of what constitutes "manifestly infringing content" (the threshold of "obviousness" of infringements)** for which no equity-based assessment is currently needed.²⁹³

This lack of clarity creates obstacles for rightholders pursuing infringements in multiple MS. When utilizing certain administrative procedures or judicial means for enforcement, some evidentiary thresholds may require rightholders to prove that a certain percentage of the website is hosting illicit content (e.g., 90%), or to prove that a certain number of webpages in a domain is hosting infringing content, among other metrics. These differing thresholds generate costs on the side of rightholders

²⁹¹ Note that this limited liability/safe harbour regime for intermediaries refers to the situation prior to the passage of the 2019 CDSM Directive.

²⁹² A. Hoffmann, and A. Gasparotti, [Liability for illegal content online: Weaknesses of the EU legal framework and possible plans of the EU Commission to address them in a "Digital Services Act"](#), CEP Study, 2020.

²⁹³ See, for discussion on definition of manifestly illegal content, [Resolution on the Digital Services Act and fundamental rights issues posed](#), European Parliament, 20 October 2020, 2020/2022(INI), Provisional edition, P9_TA-PROV(2020)0274, point 33. Moreover Resolution on the Digital Services Act: adapting commercial and civil law rules for commercial entities operating online, European Parliament, 20 October 2020, 2020/2019(INL). Provisional edition, P9_TA-PROV(2020)0273, suggests defining it as the content which "unmistakably and without requiring in-depth examination [is] in breach of legal provisions regulating the legality of content on the internet".

pursuing infringements in multiple EU jurisdictions, as well as considerable legal uncertainties for both rightholders and users. Such differences also limit the scalability of legal strategies for enforcement across multiple MS, as rightholders may find difficulties in using the same evidence to fulfil the requirements for raising a claim of infringement from one MS to another.

Third, there is yet another related set of problems: obstacles to providing effective cross-border enforcement measures across MS can also relate to **practical issues**. The cost of translating orders or final judgements, for example, can limit the ability of rightholders to pursue identical infringements occurring in multiple MS. In the same sense, obtaining evidence of infringement in multiple MS in multiple languages may prove difficult, especially for rightholders who lack the financial means to develop monitoring software or to contract with a third-party capable of monitoring infringements in multiple MS. Furthermore, a **lack of knowledge or understanding of available measures** to pursue cross-border enforcement creates a barrier to effective enforcement. Limited stakeholders' experiences with the use of such available mechanisms may give the false impression that such options are comparatively riskier than litigating on a MS-by-MS basis.

From the stakeholder consultation's responses, due to the limited amount of attempts to pursue cross-border enforcement, it is difficult to reach a definitive conclusion on the effectiveness of cross-border enforcement measures currently available. Overall, it seems that, for multiple reasons, the current situation does not make cross-border enforcement a viable option for rightholders.

II. IMPROVEMENTS TO CROSS-BORDER IPR ENFORCEMENT IN EU

8. POLICY RECOMMENDATIONS

Several solutions have already been identified which might mitigate the effects of diverging copyright laws among EU Member States, and thus promote a more effective and consistent application of cross-border injunctive relief and IP enforcement. In this context, it is worth noting that cross-border enforcement of IPRs, with emphasis on wilful large-scale online copyright infringement, cannot be sufficiently achieved through national actions of MS. In line with the principle of subsidiarity,²⁹⁴ an EU-level action is appropriate for facilitating EU cross-border enforcement due to the scale, effect and multi-territorial dimension of infringing activities.

The following pages provide an overview of suggested measures which may improve the current state of cross-border IPR enforcement. These solutions encompass a range of private (voluntary), administrative and judicial measures that can be adopted at the EU or national levels. While not prescriptive, this list may provide some insights into improvements that can be made from a stakeholders' perspective, and thereby serve to inform future policy discussions.

8.1. Development of Cross-Border Voluntary Arrangements

As an initial suggestion, EU-wide voluntary arrangements facilitating online cross-border copyright enforcement in EU ("top-down" approach) might be further considered. The European Commission has a mandate to encourage "the drawing up of codes of conduct at Community level, by trade, professional and consumer associations or organisations, designed to contribute to the proper implementation of Articles 5 to 15 [of the ECD]".²⁹⁵ Such arrangements could provide for voluntary EU-wide enforcement of website blocking against infringing websites already blocked by courts in a certain number of MS, especially since some rightholders and intermediaries are active in multiple MS. Of course, these arrangements would be facilitated by the fact that the largest European telecommunication network service providers (e.g., Deutsche Telekom, Vodafone, Orange, Telenor, Telia, Liberty Global, Tele2) operate in different MS via their national market subsidiaries.²⁹⁶

Also, it is important that the development of cooperation arrangements involving major intermediaries provides for procedural and structural safeguards ensuring compliance with EU competition rules.

8.2. Development of Cross-Border Administrative Cooperation and Measures

One of the main findings of the Study was that, in comparison with other available enforcement options, rightholders tend to prefer using administrative procedures for enforcing their rights. Given the streamlined processes for submitting claims and comparatively low costs to raising a dispute in

²⁹⁴ Treaty on European Union (TEU), Art. 5.

²⁹⁵ ECD, Art. 16(1)(a).

²⁹⁶ In fact, it would likely be easier to conclude such multi-territorial, or even pan-EU, arrangements if well-functioning voluntary CoCs covering similar matters and based on similar procedures were already in place in a multiple MS. In this case, pan-EU arrangements would scale-up the provisions of national mechanisms, where a consensus has already been reached ("bottom-up" approach). Unfortunately, this is not the case. It seems that one of the important reasons for the conclusion of dissimilar CoCs in different MS, and sometimes their absence in others, is different copyright laws and enforcement practices.

court, administrative procedures are sometimes the sole means of enforcement selected by rightholders in pursuing online copyright infringements in a MS.

However, the availability of administrative procedures for tackling online infringement claims is still relatively limited. Thus far, only a few MS have established administrative procedures or appointed a specialised administrative authority for handling cases of online copyright infringement. While rapidly developing, administrative enforcement measures are still limited by their territorial reach, and their effectiveness in cross-border cases could be improved.

8.2.1. Enhancing Cooperation between National Administrative Authorities

In several sectors which are connected to the enforcement of copyright and related rights in online contexts, specific measures have been contemplated which endeavour to facilitate coordination between national authorities in the resolution of cases affecting multiple MS.²⁹⁷ For example, the InfoSoc Directive established a Contact Committee of national competent authorities for exchange of information and coordination on different issues pertaining to the implementation of the Directive and its impact.²⁹⁸ The Directorate General Communications Networks, Content and Technology (DG CNECT) of the European Commission fosters work of the Committee. According to Art. 12(4)(a)-(c) of the InfoSoc Directive, the tasks of the Committee include: "(a) to examine the *impact of this Directive* on the functioning of the internal market, and to highlight any difficulties; (b) to organise consultations on all questions deriving from the *application of this Directive*; (c) to facilitate the exchange of information on relevant *developments in [...] case-law*." (emphasis added).

As the blocking orders issued by administrative authorities commonly rely on Art. 8(3) of the InfoSoc Directive and/or national laws transposing the Directive, the Contact Committee could be a suitable forum for exchanging best practices and coordinating developments related to administrative blocking orders. Such coordination work could, notably, address the issue of cross-border effect and/or recognition of administrative orders and the issue of upholding a certain harmonised high standard of independence and due process. The development of such common standards is a necessary condition for cross-border recognition and enforcement of administrative blocking orders issued in one MS to apply to another MS. Decisions of administrative authorities, which fulfil the requirement for being qualified as "tribunals" under the Brussels Recast Regulation, could also be recognised and enforced under the existing EU legal framework for judgments in civil and commercial matters (see Section 5.1.).

Under the proposed DSA, a "European Board for Digital Services" is also already envisioned, taking the form of "an independent advisory group of Digital Services Coordinators" to advise national Digital Services Coordinators and the European Commission on matters relating to the "supervision of the providers of intermediary services".²⁹⁹ Generally, the Board provides a means to promote the coordination of Member State authorities, as well as manage tasks related to delivering advisory opinions and dispute resolution.³⁰⁰ Among its functions, the Board is tasked with several

²⁹⁷ In the domain of collective licensing of copyright and related rights, Art. 41 of the Collective Rights Management Directive instituted an Expert Group. The Group is composed of representatives of national competent authorities and chaired by a representative of the European Commission.

²⁹⁸ Art. 12(3) of the InfoSoc Directive.

²⁹⁹ DSA Proposal, 'Section 2: European Board for Digital Services'.

³⁰⁰ *Ibid.*, Art. 47.

responsibilities, including those aimed at facilitating national authorities with cross-border supervision and investigation of matters involving multiple Member States.³⁰¹

8.2.2. Improving and Expanding the EU Watch List

As described in Section 2.4 above, the EU Watch List is the European Commission's leading tool for raising awareness of infringing websites accessible in the EU and operating from third countries. The List could become more authoritative and useful for facilitating cross-border online IPR enforcement in the EU by (1) improving the process through which the Watch List is established, (2) enhancing understanding of the List's criteria and process by all stakeholders concerned as well as (3) extending the List's scope to also cover websites whose operators or owners reside in the EU. In this regard, a reliable source of all information about all legal enforcement actions (judicial and administrative) undertaken to take down or block access to all major infringing websites accessible in the EU, regardless of the place of residence of their operators, could be useful not only for setting public policies aiming at tackling online infringements but also in judicial and administrative procedures.

8.2.3. Creation of EU administrative procedure for cross-border online copyright enforcement

While the use of voluntary and self-regulatory measures has been generally encouraged ("bottom up" approach), given the shortcomings of such arrangements,³⁰² it has been readily acknowledged that the ultimate responsibility for enforcing laws, deciding the legality of online activities, and ordering hosting service providers to remove or disable access to illegal content, should ideally rest with independent competent authorities.³⁰³ In pursuing infringements occurring online, given the involvement of multiple MS across the EU, and particularly in cases involving the balancing of users' fundamental rights with the interests of rightholders, some EU institutions and scholars have suggested the introduction of EU entities, bodies or agencies. An EU level actor may help to provide a centralising point of exchange and coordination for national-level authorities, as well as carry out assessments and supervisory tasks which may make more sense to conduct on an EU, as opposed to national, level ("top down" approach).³⁰⁴ Proposals in the context of the implementation of the proposed DSA, consider introducing an independent, EU-level authority to facilitate the

³⁰¹ See, in particular, *ibid*, Art. 45 (Cross-border cooperation among Digital Services Coordinators), Recital 46.

³⁰² Drawing from the conclusions reached in this Study, specifically with regard to the effectiveness of voluntary and self-regulatory arrangements for the enforcement of rights in the online environment, several common issues were identified. These included a general lack of transparency, a lack of appropriate safeguards against fundamental rights violations committed through unjust blocking practices, and limited avenues of appeal for a blocking decision (e.g., access to judicial redress).

³⁰³ EP Resolution on the DSA and FR, point 11.

³⁰⁴ In addition to the examples below, some scholars have generally advocated for a shift away from mechanisms of enforcement relying on privately-ordered arrangements towards more co-regulation, facilitated by the presence of a governmental actor to ensure procedural transparency, fairness, and respect for the balance of fundamental rights of parties affected by infringements. S. Kulk, 'Internet Intermediaries and Copyright Law. Towards a Future-proof EU Legal Framework', November 2018. See also, M. Perel and N. Elkin-Koren, 'Accountability in Algorithmic Copyright Enforcement', Vol. 19(3), *Stanford Technology Law Review*, 2016, pp. 473-533 (finding that maintaining transparency over copyright-enforcing algorithms should not lie exclusively with online intermediaries, but should be supplemented by increasing the competences of public regulators, e.g., by introducing "a trusted advisory committee within the Federal Trade Commission").

implementation and enforcement of the new EU liability regime for online platforms.³⁰⁵ According to the European Value Added Assessment conducted in October 2020, Spindler contends that differing Member State regulatory and enforcement practices in the field of e-commerce merits the introduction of a specialized EU institution which can serve to centralize control mechanisms over online platforms and their use of algorithms.³⁰⁶ He also identifies the danger of “regulatory arbitrage,” finding that, absent any centralizing authority or accountability mechanism at the EU level, Member States “might be inclined to implement low enforcement standards to be more attractive to platform operators, posing the risk of a regulatory ‘race to the bottom’.”³⁰⁷

As mentioned, administrative procedures have been already set up in several MS to enforce copyright infringement online, with considerable success among rightholders as a better alternative to judicial procedures.³⁰⁸ However, as customarily the national enforcement procedures have limited territorial scope, they are little effective in tackling EU cross-border infringements. On the basis of the principle of subsidiarity, given the scale, effect and multi-territorial dimension of infringing activities, the creation of an EU-wide mechanism for administrative enforcement could effectively cover the entire Single Market, while lowering public and private transaction costs of MS-by-MS enforcement actions.³⁰⁹ Thus, with respect to the deficiencies already identified in cross-border enforcement of copyright and related rights, enhancing the competences of an EU-level public regulator, or alternatively introducing a new, independent EU-level authority for facilitating cross-border enforcement, may help to bridge several existing gaps in national, territorially-based enforcement measures. Of course, the successful implementation of such an independent body might entail a complex process as it would require broad political support among MS, many of which do not have administrative procedures in place.³¹⁰

8.3. Improvement of Judicial Cross-Border Enforcement

As outlined in Section 2, a number of measures already promote collaborative practices among national judicial authorities, recognising the fact that effective delivery of justice in one MS may crucially rely on information and circumstances present in another MS. This is especially the case with online copyright enforcement actions, where the impact of infringements might be cross-border and alleged infringers utilise many different strategies for evading identification, with most of these strategies involving conduct in multiple MS.

Nevertheless, some improvements can be considered for existing means of judicial enforcement, which may ultimately help rightholders—and the judicial system—reduce the overall costs of litigating in multiple MS, and at the same time provide the benefit of increasing the authoritativeness of a judicial order in pursuing the same infringements or infringing services in other EU jurisdictions.

³⁰⁵ For a broader analysis on different institutional options for advancing EU copyright reform, including the possibility of introducing an independent, EU-level body for copyright and related rights, see N. Mangal, ‘EU Copyright Reform: An Institutional Approach’ Ph.D. thesis under the direction of C. Geiger, University of Strasbourg, QMUL, forthcoming 2022.

³⁰⁶ Spindler, *op. cit.*, p. 223.

³⁰⁷ *Ibid.*

³⁰⁸ See Sections 6 and 7.3.

³⁰⁹ Spindler, *op. cit.*, p. 223 and N. Mangal, ‘EU Copyright Reform: An Institutional Approach’ Ph.D. thesis under the direction of C. Geiger, University of Strasbourg, QMUL, forthcoming 2022.

³¹⁰ See Section 4.

8.3.1. Raising Awareness of Existing Enforcement Measures

Based on inferences drawn from the consultation stage, it seemed that there was a lack of knowledge or awareness of existing EU tools for facilitating judicial enforcement in cross-border scenarios. From the feedback of stakeholders and experts, the legal expertise often provided by a national firm is chiefly centred on a knowledge of existing national law and previous practices. Complex cross-border issues that involve the application of complex private international law rules may be avoided given their challenging nature to apply and the presence of more straightforward, simpler adjudicative national workarounds. Actually, during the stakeholder consultations, only three cases of judicial cross-border copyright enforcement actions were identified (including provisional/preliminary measures), all with reportedly positive outcomes for rightholders. As observed in Section 6, rightholders commonly pursue online cross-border copyright infringements on a MS-by-MS basis. Likewise, strategies for enforcement which may consist of raising a claim's cross-border elements before a national judge, seemed to be disfavoured by both legal practitioners and rightholder groups and described as "risky" legal strategies, at least partly due to a general lack of experience with using available legal mechanisms in a national court. As a result, neither legal practitioners nor rightholders listed much experience with raising claims before courts with a specifically cross-border legal element, even given the fact that the infringements in question occurred across MS borders.

Therefore, a simple, cost-effective means for improving judicial enforcement in cross-border scenarios could involve education initiatives (including case studies) and the promotion of existing judicial EU tools facilitating cross-border enforcement among the IPR practitioners, rightholders, and judges. Greater levels of education on existing judicial measures may translate into more experimentation with their applications in national courts, and ultimately may start to create a stronger basis for future enforcement strategies regarding cross-border infringements, such as a corpus of jurisprudential precedents. In time, this process will enhance legal certainty and rightholders' willingness to pursue cross-border enforcement actions.

8.3.2. Enhanced (Civil) Investigative Tools Available for Pursuing Online Infringements

Thus far, we have generally considered judicial tools and procedures available for civil matters.³¹¹ In the area of criminal enforcement, however, there are additional enforcement tools available which tend to be viewed as more comprehensive and effective in terms of dealing with illegal conduct online.

For example, one measure identified in Section 2.2.2 is the Directive on the European Investigation Order in criminal matters (EIO Directive), which creates a "single, efficient and flexible instrument" for executing cross-border investigative measures, and is invoked with respect to gathering electronic data in other MS territories.³¹² One of the main motivations of the EIO Directive was to extend the principle of mutual recognition to evidence-gathering in criminal proceedings, and achieves this goal through, on the one hand, simplifying and unifying the procedures for carrying out investigative

³¹¹ The focus of the present Study has been based on stakeholders' experiences with using civil enforcement measures (used in the vast majority of online copyright infringement cases). For more on the availability of enforcement measures enhancing institutional cooperation for criminal IP infringements, see '[International judicial cooperation in intellectual property cases: Study on legislative measures related to online intellectual property infringements: phase 2](#)' EUIPO, 2021.

³¹² [Directive](#) on the European Investigation Order in criminal matters. For further analysis, see M. Stefan and G. González Fuster, '[Cross-border access to electronic data through judicial cooperation in criminal matters: state of the art and latest developments in the EU and the US](#)'. CEPS Paper in Liberty and Security in Europe, No 2018-07, November 2018 (updated May 2019).

measures in other MS, and on the other hand, reducing "...possible grounds of refusal by limiting the degree of discretion that [was previously] left to the [national] authorities...".³¹³ For improving the speed of requests for cross-border investigative measures,³¹⁴ granted that the EIO request relates to an offence falling within specific parameters,³¹⁵ the Directive standardises the timeframe during which competent authorities of MS must decide to recognise and execute the request (30 days maximum), as well as the time to execute the request effectively (90 days).³¹⁶ Depending on the seriousness of the offense or other urgent circumstances, the Directive provides an expedited, 24-hour deadline for provisional measures, i.e., preservation of data.³¹⁷ Finally, a general standard for the speed of processing an investigative measure is established, with competent authorities tasked with carrying out the procedure with the "same celerity and priority as for a similar domestic case."³¹⁸ In addition to improving the speed of issuing EIOs, the Directive provides for a broad range of investigative measures which go beyond measures for preserving existing evidence, but extends to the possibility of requesting a foreign MS to "to conduct new investigative measures directed at obtaining and transferring information – including electronic data – previously unavailable to the competent authorities, with minimum formality".³¹⁹

These measures establishing procedural consistencies for cross-border investigative requests, as well as the broad range and availability of other investigative measures, may provide some indications for similar measures in the realm of civil enforcement. As contemplated by the EIO Directive, and as identified by stakeholders familiar with criminal IP enforcement measures, providing clearer timeframes for decision-making may help to increase the level of legal certainty in using judicial measures for enforcement. In the same sense, simplifying procedures for litigating cross-border IP disputes, by for example placing reasonable limitations on the discretion of judges in special cases (depending on the seriousness/urgency of the request, as commonly-agreed to among EU MS), may help to increase the overall uniformity and predictability of using judicial means of enforcement when infringements involve multiple MS.

8.3.3. Development of cross-border EU injunctions for wilful large-scale online copyright infringements

Judicial cooperative measures in the area of copyright enforcement may be usefully expanded by offering a mutually-recognised blocking order for certain cases involving "obvious" infringements. The general idea is for rightholders to pursue an infringement action in one national court, and to have available a "fast-track" for both recognizing and enforcing the judicial order once granted in multiple other MS where the same infringements are at stake. In other words, successfully obtaining an order of this kind from one MS would presume a finding of infringement in the other MS. This type of order could be made available only for cases of "obvious" infringements, where it is perhaps more likely MS can approach some common ground. To implement such an order, MS may be required to reach

³¹³ Stefan and González Fuster, p. 23.

³¹⁴ The following brief description of the procedural requirements for effecting an EIO is drawn from the text of Stefan and González Fuster. See *ibid*.

³¹⁵ Offences requiring an EIO order must be punishable in the issuing Member State by a custodial sentence or involve a detention order for a maximum period of at least three years, and must fall within one of the 32 categories of offences listed in Annex D of the Directive.

³¹⁶ EIO Directive, Art. 12.

³¹⁷ *ibid*, Art. 32(2).

³¹⁸ *ibid*, Art. 12(2)-(4).

³¹⁹ *ibid*, Art. 1; Stefan and González Fuster, p. 23.

consensuses on what criteria may constitute an “obvious” infringement, and national judiciaries must be able to make such determinations **based on similar evidentiary grounds** and **within a predictable timeframe**. Concerning evidence, one useful element of a potential fast track, cross-border judicial procedure could include creating a set of uniform evidentiary standards for obvious cases of online infringements, whereby rightholders are able to gather and submit the necessary information for proving a case of obvious infringement online only once for the same infringement occurring in other MS. In particular, among national courts, setting universally acceptable evidentiary standards regarding certain types of evidence which are typical for proving obvious infringements can be specified for infringements either 1) within a specific copyright sector; 2) depending on the form of infringement (i.e., infringements of works via use of a digital locker vs. a video streaming service); or 3) both. Furthermore, based on stakeholders’ input, a common overall timeframe for a fast-track procedure – from initiating a cross-border proceeding in one MS, processing the request, communicating the judgement and carrying out the related enforcement actions among related MS – should ideally be a period lasting no longer than 72 hours. For particularly urgent cases of obvious cross-border infringements (i.e., the commercial value of the copyrighted work is dependent on a specific release window), given that the uniform evidentiary criteria and other formalities are satisfied, the timeframe for effecting an order would ideally be shorter. Of course, the option should remain for alleged infringers to appeal such a mutually-recognised order before a national court.

8.4. Developing Tailored Approaches to Enforcement for Different Copyright Sectors

The unique characteristics of different types of copyrighted content inform the nature and manner of their infringement. As briefly discussed in Section 2.3.2(b), enforcement concerns can vary considerably between each copyright content sector, and addressing such concerns may not involve a single, one-size-fits-all approach to enforcement. To cope with the ever-changing ecosystem of infringing activity occurring online, effective enforcement strategies must also involve the application of flexible and adaptable legal tools that can respond to new enforcement needs as they emerge.

As indicated by the relatively recent development of ‘dynamic’ blocking injunctions among MS,³²⁰ sector-specific considerations of the content at stake in infringement actions can be used to inform the nature of legal remedies available. Indeed, stakeholders during the consultation period advocated for more qualitative assessments of infringing activities in the interest of obtaining relief that is both effective and proportional to the harm caused.

Using the ‘notice-and-takedown’ regime as a starting point, one can imagine modified regimes of enforcement depending on the type of liability at stake. In addressing a range of illegal activities online, Angelopoulos and Smet contemplate a ‘vertical’ scheme of enforcement, where measures correspond to the offense, thereby ensuring that there is ample opportunity for balancing interests between stakeholders.³²¹ For claims of copyright infringement, for example, where intermediaries are placed in a position to ‘overblock’ content under the current notice-and-takedown regime, they suggest that utilising a ‘notice-and-notice’ system which would rather shift the role of the intermediary back to that of a ‘middleman’, where notices of infringement are merely forwarded to the alleged infringer to

³²⁰ Frosio and Bulayenko, op. cit.

³²¹ See Angelopoulos, C. and Smet, S., ‘[Notice-and-Fair-Balance: How to Reach a Compromise between Fundamental Rights in European Intermediary Liability](#)’, *Journal of Media Law*, Vol. 8(2), 2016. pp. 266-301.

address. This approach would be in contrast to the 'notice-wait-and-takedown' measures suggested for defamation cases, providing users with a limited opportunity (one week) to "convince the intermediary of the lawfulness of her speech" before resorting to a takedown.³²²

In the same spirit, perhaps enforcement measures should also begin to respond to the unique characteristics of the content in question and the nature of the infringement. By way of example, the characteristics of copyrighted video game content available online (large file size, controlled online marketplace for legal content, non-linear form of the work) may call for specific enforcement measures which may be different from other types of copyrighted content available in digital formats (e.g., musical and audiovisual works). In the gaming industry, the presence of a tightly-controlled legal online marketplace for games means that the appearance of content outside the marketplace is automatically considered infringing. The same may not be the case for other creative works available through multiple channels online, yet this seemingly advantageous arrangement for detecting infringements is not reflected by currently available enforcement options for gaming industry rightholders.

As suggested in other areas of the Study, there is a growing interest in developing enforcement measures which go beyond establishing quantitative thresholds of infringing activities, and instead involve more qualitative assessments of the nature of the infringement and the rights at stake. In the future, developing tailored approaches to enforcement which take into account some unique qualities of types of creative content may help to balance enforcement measures from a fundamental rights perspective, and may ultimately provide more satisfactory enforcement results for rightholders pursuing infringements in a rapidly-evolving online environment.

8.5. Possible Further Harmonisation and Unification of EU Copyright Law?

Regarding long term legislative changes to be considered, revising existing legislation (either at the EU or national level) to clarify certain concepts that are critical to the effective enforcement of IPRs may improve legal certainty in enforcement practices. In cases of online copyright infringement, legal concepts such as "expeditious", "obvious infringement" or "manifestly illegal (infringing) content" can be defined more clearly and applied consistently across MS.

8.5.1. Further harmonisation of EU copyright law

While many existing national laws on copyright and related rights are considered harmonised to a large extent, national differences may persist in the enforcement of rights and the availability of legal remedies. As cited above, and discussed in Section 7.5, differing national implementations of EU Directives create consistency issues which may hinder the cross-border enforcement of IPRs in the EU, which in turn generates costs for rightholders pursuing infringements in multiple MS, as well as administrative and enforcement costs on the side of national governments and judiciaries.

A more consistent implementation and interpretation of legal concepts relevant to copyright enforcement online should be achieved among MS. This may be accomplished via the introduction of EU legislation clarifying to a greater extent certain key concepts of online infringement and harmonising procedural requirements. Also, clarifying categories—and related obligations—of certain key enforcement players can help to harmonise enforcement practices in the EU.

³²² Ibid., 23.

According to the stakeholder consultation, it has been reported that there is some consensus among rightholders on a permissible timeframe for “expeditious” content takedowns in some copyright sectors.³²³ According to the rightholders’ feedback, a response exceeding 72 hours would be considered too slow.³²⁴ On the other side, the proposed reform in the DSA would also distinguish different typologies of online intermediaries, including (i) providers of intermediary services, (ii) micro or small enterprises, (iii) providers of online platforms, and (iii) very large online platforms³²⁵, in order to attach to them different graduated liability regimes proportionately to the scale of reach as well as the technical and operational capacities of the digital service providers.³²⁶ In particular, very large online platforms will have to abide to stricter standards, including applying mitigation measures as a result of a risk assessment and independent audit that they must carry out.³²⁷

Though MS ultimately possess a significant deal of discretion in the implementation of EU law, it is in the interest of the MS’ citizens to adopt measures which are efficient and effective in dealing with an ever-growing number of cross-border infringements, as long as users’ and online businesses’ fundamental rights are adequately preserved. Actually, a proportional approach to the obligations of DSPs might better safeguard fundamental rights (both users’ rights, such as freedom of expression, online businesses’ rights, such as freedom to conduct a business) while preserving interests of rightholders, which are seriously threatened in particular by massive infringements occurring on major online platforms.³²⁸

Finally, for the future development of cross-border enforcement actions relying on different national copyright laws, establishing a threshold of obviousness of infringing activities required to trigger administrative and judicial enforcement measures can be accomplished by clearly defining the notion of “manifestly infringing content”. In this regard, the pending judgement before the CJEU on the compliance of Art. 17, CDSM Directive with the EU Charter might clarify the notion.³²⁹ In this context, as also suggested by the feedback gained through the stakeholder consultation, due to the changing nature of infringing activities occurring online, there should be room for more qualitative determinations on the “obviousness” criteria of infringements. Specifically, quantitative standards such as percentages of infringing content or numbers of webpages making available infringing content should not be the sole indicators in determining whether a website should be blocked or its content taken down. Some rightholders argue that judges and/or administrative authorities need to be able to take a more nuanced view of the activities and purposes of allegedly infringing websites rather than simply relying on a quantitative assessment. Websites providing instructions on how to “hack”

³²³ Unfortunately, no feedback was received by other stakeholders of this point.

³²⁴ Actually, some rightholders have contracted with third-party vendors to monitor content takedowns, and use a “traffic light” system to rate the expediency of intermediary compliance with a takedown notice or order.

³²⁵ DSA Proposal, art. 2 (f), (h), art. 16, and art. 25.

³²⁶ EP Resolution on the DSA and FRs, point 27.

³²⁷ DSA Proposal, art. 26-28.

³²⁸ Cf. G. Frosio, ‘Reforming the C-DSM Reform: a User-Based Copyright Theory for Commonplace Creativity’, *IIC*, Vol. 52(6), 2020, pp. 721, 727-728 (discussing the limited nuances included instead in Art. 17 of Directive 2019/790/EU, in terms of the categories of intermediaries covered by the obligations therein, and the negative externalities on start-ups and smaller platforms of such new obligations).

³²⁹ See C-401/19, Republic of Poland v European Parliament, Council of the European Union

technology to commit copyright infringements may therefore fall within the scope of such a qualitative assessment, and can be taken down accordingly.

8.5.2. Partial unification of EU copyright law

Cross-border online copyright enforcement in the EU is often more complex than in the field of EU trade marks, designs or plant varieties. Cross-border enforcement measures imply the enforcement of harmonised but different national rights, with differing scope and varying exceptions and limitations.³³⁰ As a longer term solution, the establishment of copyright and/or related rights as unitary IPR titles,³³¹ at least of online rights, would solve some of the issues specific to cross-border copyright enforcement. A portion of the consulted stakeholders are against the creation of a unitary copyright title, yet the consulted stakeholders also affirmed that in their experience it is not feasible to expect national judges to consistently apply the different copyright laws of multiple MS in cross-border cases.³³² Thus, without further harmonisation and/or establishment of a unitary title(s), the development of cross-border enforcement actions will continue to be limited, especially in the context of more complex cases that go beyond the enforcement of merely “manifestly infringing content”. In sum, a unitary title may be key to smoother cross-border enforcement of IPRs, including copyright and related rights.

³³⁰ See Section 2 above.

³³¹ On the legal basis of Art. 118 of the TFEU.

³³² See Section 5.2 above

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ANNEX I. STAKEHOLDERS AND EXPERTS CONSULTED

1 . Stakeholders

Union européenne de radio-télévision (UER) / European Broadcasting Union (EBU)	Vincent Sneed, EU Policy Adviser, EBU
Nintendo	Neil Boyd, Head of European IP & IP Enforcement, Nintendo Sebastian Scholl, Senior European Legal Advisor, Nintendo
International Federation of the Phonographic Industry (IFPI)	Agnieszka Horak, Senior Legal Counsel, IFPI Anna Zardo, Head of EU Parliament and Government Affairs, IFPI Kristina Janušauskaitė, Director of European Legal Affairs, European Office, IFPI Lodovico Benvenuti, Director European Office, IFPI Melissa Morgia, Deputy Director of Global Litigation, IFPI
European Grouping of Societies of Authors and Composers (GESAC)	Burak Özgen, General Counsel, GESAC
Sports Rights Owners Coalition (SROC)	Mark Lichtenhein, Chairman, SROC
The Premier League	Mathieu Moreuil, Director of International Football Relations and EU Affairs, The Premier League
LaLiga	Laura Vilches, Head of European Public Affairs, LaLiga
control © / GFF	Julia Reda, Leader of the control © project of Gesellschaft für Freiheitsrechte (GFF), Shuttleworth Foundation Fellow and Former Member of the European Parliament
Google / YouTube	Cédric Manara, Director, Head of Copyright, Google

2 . Experts / academics

Theódoros Chíou, Partner, Theódoros Chíou & Partners, and Creator, IPrights GR, Greece
Aurelio López-Tarruella Martínez, Associate Professor of Private International Law, University of Alicante, Spain
Stefan Martin, Member of Boards of Appeal, EUIPO
Jan Bernd Nordemann, Partner, NORDEMANN law firm, Germany
Paul Torremans, Professor of IP law, University of Nottingham, UK
Gilles Vercken, Partner, Vercken & Gaullier law firm, France
Erling Vestergaard, IP Enforcement Expert, EUIPO

ANNEX II WRITTEN QUESTIONNAIRE

Study on Cross-Border Enforcement of Intellectual Property Rights in the EU

Stakeholders questionnaire

The research team of the Centre of International Intellectual Property Studies (CEIPI), University of Strasbourg, was commissioned to carry out a **Study on Cross Border enforcement of intellectual property rights in the EU**, under the framework contract IP/C/JURI/FWC/2019-001/LOT3/C1. The objective of the study is to **analyse** existing issues with cross-border enforcement and to provide the legal committee of the European Parliament with **policy recommendations** for improving the situation. According to the terms of the study, the research team is conducting **consultations with stakeholders** on their experiences with **cross-border copyright enforcement in the online environment** (e.g., websites, marketplaces, online content-sharing services, social media).

In this questionnaire, **the distinction between direct infringers and intermediaries** refers to the situation **prior to the adoption of the 2019 Copyright in the Digital Single Market Directive**.

For the purpose of this questionnaire the term **cross-border enforcement** of copyright in the EU refers to the measures (voluntary, administrative or judicial; interim or final) that are covering **more than one Member State of the EU**. The enforcement of copyright involving third countries is excluded from the scope of this research.

Please note that your experiences involving the **UK** preceding its exit from the EU are relevant for our study and you can mention them in the questionnaire.

I.	General Questions	2
II.	Voluntary and Out-of-Court Measures	2
III.	Administrative Measures	3
IV.	Judicial Measures	3
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I. General Questions

- 1 Please identify the responding organization:
- 2 Please briefly describe **your organization's experiences** with cross-border enforcement proceedings (e.g. voluntary, administrative and judicial) in the EU, indicating whether your organisation engaged in cross-border online copyright enforcement directly and/or through its members, and the Member States in which you have the most experience.
- 3 What are your organization's **main challenges** in **obtaining** cross-border copyright enforcement measures covering several or all Member States?

- 4 What are your organization's **main challenges** in **recognizing and enforcing** copyright enforcement measures in Member States?

II. Voluntary and Out-of-Court Measures

This section differentiates between purely voluntary measures adopted exclusively between stakeholders and state-imposed/state-regulated alternatives to court proceedings.

- 5 What is your experience with utilizing **voluntary measures** (agreements with other stakeholders regarding enforcement, codes of conduct, memoranda of understanding, etc.) in online copyright infringement disputes involving more than one Member State? Please, provide **examples** of such voluntary arrangements, indicate whether they apply to/differentiate between direct infringers and intermediaries.
- 6 Of the voluntary measures available, which would you consider the **most/least effective** and why?
- 7 What is your experience with the use of **out-of-court measures** (e.g., mediation, arbitration) for online copyright enforcement? Of the out-of-court measures, which would you consider the **most/least effective** and why?
- 8 What is your experience with the **notice-and-takedown** procedure for online copyright infringement in terms of its **cross-border effect**? Which practices/regulations do you consider the **most/least effective** and why?

III. Administrative Measures

- 9 What is your experience of **obtaining an administrative order** for enforcing copyright from a national authority?

Please indicate, if possible:

- name of the authority(ies) and/or its(their) Member State(s);
- type of infringement concerned;
- action directed against direct infringer/intermediaries;
- comparison of the effectiveness of such measures with that obtained through court proceedings.

- 10 Do you have any experience **applying for an administrative order with cross-border effect** from a national authority?

If yes, please, indicate if possible:

- name of the authority(ies) and/or its(their) Member State(s);
- type of infringement concerned;
- action directed against direct infringer/intermediaries;
- whether cross-border administrative order was granted or refused, or is still pending;
- the main issues / obstacles for granting such orders.

- 11 Is there a procedure used to establish **non-compliance with an administrative order** issued in another Member State? If so, what are your experiences, and would you consider them sufficient?

IV. Judicial Measures

A. Obtaining a preliminary injunction/interim measure with cross-border effect

- 12 What is your experience with requesting a national court to issue an **interim measure which was supposed to be applied in more than one Member State**? If yes, which Member State would you consider the most/least effective and why (e.g., in terms of speed, costs)? Please specify whether the measures involved actions against direct infringers/ intermediaries.
- 13 In the Brussels I Recast Regulation^[1], have you used Art. 35^[2] **to apply for provisional, including protective, measures** before national courts? Specifically, have you applied for a provisional, including protective, measure before the court of the Member State that is not competent on the substance of matter? Could you please describe your experiences and specify, if applicable, in which Member States such measures might be granted easily and in which not?
- 14 Have you experienced the refusal of, and/or difficulties of, **enforcement** in any of the Member States **of an interim measure** obtained in another Member State? If so, please, briefly indicate the reasons for such refusal and/or difficulties of enforcement referring to specific Member States.
- 15 Please, provide any additional information/comment on the interim enforcement measures in the cross-border context that you consider relevant for the present study.

B. Obtaining evidence from other Member States

- 16 Have you used the measures available in the EU law (**Evidence Regulation**^[3], **European Account Preservation Order**^[4]) aiming to facilitate gathering of evidence? If yes, please briefly describe your experiences including the effectiveness of these measures.
- 17 What **obstacles** have you encountered in **obtaining evidence** from multiple Member States in a cross-border copyright enforcement proceeding? Please explain the most relevant of them, indicating the Member States, specifying the circumstances of the infringement and whether the action concerned the direct infringer or intermediaries.
- 18 What **obstacles** have you encountered in **using expedited procedures** for obtaining evidence from multiple Member States in a cross-border copyright enforcement proceeding?

C. Obtaining a judgement with cross-border effect

- 19 Which **factors** have led you to litigate on a **MS-by-MS basis** versus litigating in a **single Member State** to obtain a judgement with cross-border effect (judgment issued by one Member State covering several Member States)? Please compare the availability/effectiveness of measures, distinguishing between measures against direct infringers or intermediaries. Feel free to provide some examples, specifying Member States.

- 20 What are the **main difficulties** that you have encountered with **obtaining a judgment with cross-border effect**? Please distinguish between judgments against direct infringers and intermediaries, and illustrate your experiences by providing examples from the Member States.
- 21 From your experiences, please indicate **leading national cases** for obtaining a judgment with cross-border effect in the EU.

D. Recognizing and enforcing a judgement with cross-border effect

*In this section, "judgement" means a **final decision on merits** rendered in one Member State and intended to be enforced or recognised in another Member State.*

- 22 What is your experience applying the Brussels I Recast Regulation to **recognize/enforce a judgment in another Member State** in the online copyright infringement context? Please differentiate your experiences with enforcing judgments against direct infringers and intermediaries, indicating any challenges or difficulties you may have encountered. Please illustrate your experiences by providing examples from the Member States.
- 23 What obstacles have you encountered in using **expedited procedures** for enforcing a cross-border judgement in an online copyright infringement proceeding? Please differentiate your experiences with enforcing judgments against direct infringers and intermediaries, indicating any challenges or difficulties you may have encountered. Please illustrate your experiences by providing examples from the Member States.
- 24 What is your experience with a **refusal of recognition** (e.g. on the grounds of public order consideration, due process) of a judgment related to online copyright infringement intended to be recognized/enforced in another Member State? Please illustrate your experiences by providing examples from the Member States.
- 25 From your experiences, please indicate **leading national cases** for recognizing/enforcing a judgment with cross-border effect in the EU.
- 26 How would you compare your copyright cross-border recognition/enforcement experiences in **different Member States** (by giving examples of/indicating the most/least effective national enforcement practices)?

V. Policy recommendations

- 27 Has your organisation considered what policy / regulatory changes could be helpful for overcoming some of the issues of cross-border copyright online enforcement you identified above? If yes, please feel free to write it here and/or send it as an annex.

We are notably interested in the:

- improvement of the cross-border effect of legal actions against **direct infringers**;
- improvement of the cross-border effect of legal actions against **intermediaries**;
- **expedited procedures** to use evidence and recognise judgements from courts of other Member States;

- **recognition/enforcement**, including through expedited procedures, of judgments obtained in a Member State against intermediaries contributing or supporting an illegal service.

28 If you would like to communicate to us **any other information, document or opinion** on a relevant issue that we have not asked you about, please, write it here and/or send it as an annex.

^[1] Regulation (EU) No 1215/2012 of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters *OJ L 351, 20.12.2012, p. 1–32*.

^[2] Article 35 of Brussels I Recast provides a possibility for rightholder to apply for provisional, including protective, measure before the Member State EU MS Court which is not necessarily competent on the substance of matter. The wording of art. 35 Brussels I Recast: *"Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State, even if the courts of another Member State have jurisdiction as to the substance of the matter."*

^[3] Council Regulation (EC) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters, *OJ L 174, 27.6.2001, p. 1–24*.

^[4] Regulation (EU) No 655/2014 of 15 May 2014 establishing a European Account Preservation Order procedure to facilitate cross-border debt recovery in civil and commercial matters, *OJ L 189, 27.6.2014, p. 59–92*.

ANNEX III ONLINE SERVICE PROVIDERS OFFERING OR FACILITATING ACCESS TO COPYRIGHT-PROTECTED CONTENT (EU WATCH LIST 2020)³³³

I. Cyberlockers

1. Uptobox - uptobox.com
2. Rapidgator - rapidgator.net
3. Uploaded - uploaded.net (ul.to, uploaded.to)
4. 4shared – 4shared.com
5. Wi.to and Ddl.to
6. Dbree - dbree.org

II. Stream-ripping services

7. Y2mate and YouTubeconverter - y2mate.com and youtubeconverter.io
8. Savefrom - Savefrom.net
9. Flvto and 2conv - Flvto.biz and 2conv.com

III. Linking or referring websites

10. Fullhdfilmizlesene - Fullhdfilmizlesene.com or Fullhdfilmizlesene.org
11. Seasonvar - Seasonvar.ru
12. Swatchseries - Swatchseries.to
13. Rlsbb - Rlsbb.ru
14. Rezka.ag

IV. Peer-to-peer and BitTorrent indexing websites

15. The Pirate Bay - ThePirateBay.org
16. Rarbg - Rarbg.to
17. Rutracker - Rutracker.org
18. 1337x - 1337x.to

³³³ According to the EU Watch List 2020, pp. 17-34.

V. Unlicensed download sites

- 19. Music Bazaar - Music-Bazaar.com and Music-Bazaar.mobi
- 20. Sci-hub (Sci-hub.tw; sci-hub.cc; sci-hub.ac; sci-hub.bz; sci-hub.ren; sci-hub-im; sci-hub.shop)
- 21. Library Genesis - Libgen.is and mirror sites

VI. Websites for Piracy Apps

- 22. Popcorn Time

VII. Hosting providers

- 23. Private Layer

VIII. Unlicensed IPTV services

- 24. King365tv.com
- 25. VolkalIPTV.com
- 26. Electrotv-sat.com

IX. Social media

- 27. VK.com (V Kontakte)
- 28. Telegram

This study, commissioned by the European Parliament's Policy Department for Citizens' Rights and Constitutional Affairs at the request of the JURI Committee, aims to provide an overview of cross-border enforcement of intellectual property rights in the EU with a particular emphasis on copyright and related rights in the online environment. The study provides a detailed analysis of the current situation of cross-border IPR enforcement and formulates various policy recommendations to improve current IPR enforcement options among MS.

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