

# Judicial Cooperation in Online Intellectual Property Cases

---

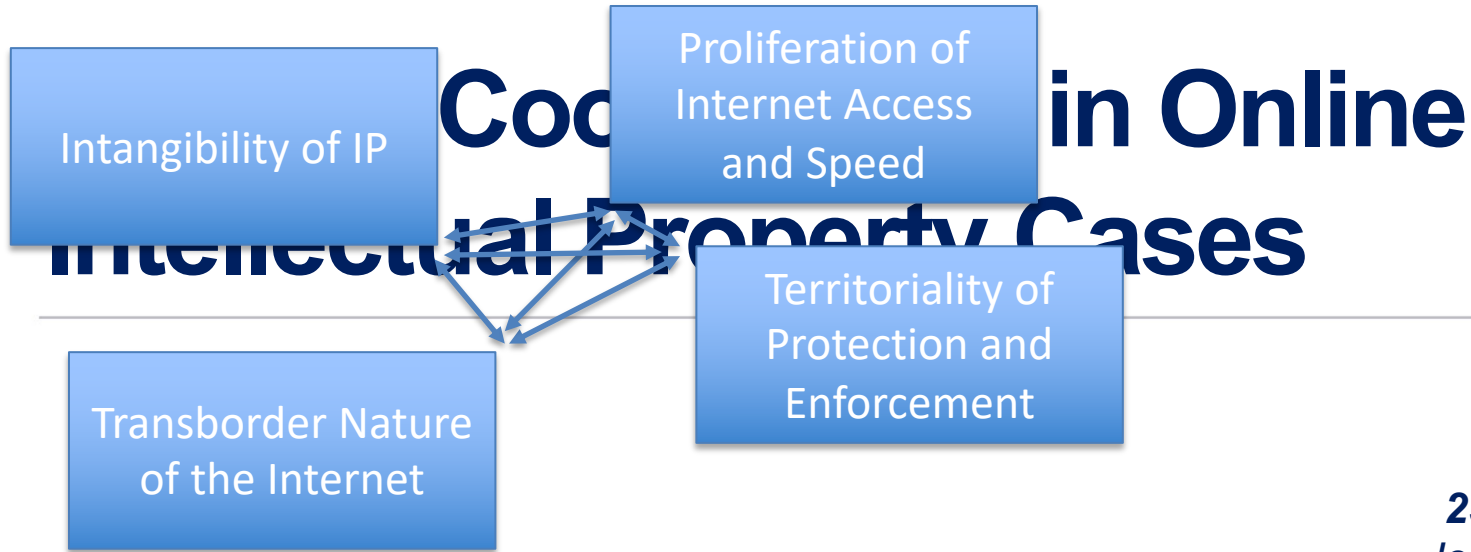
**25 May 2021**

*John Zacharia*

Zacharia Law, Washington DC, US

*Erling Vestergaard*

European Observatory on Infringements of Intellectual Property Rights  
European Union Intellectual Property Office (EUIPO)



**25 May 2021**

*John Zacharia*

Zacharia Law, Washington DC, US

*Erling Vestergaard*

European Observatory on Infringements of Intellectual Property Rights  
European Union Intellectual Property Office (EUIPO)

## Topics

- **The Online Legislative Measures Research Series**
- **Typical Online Intellectual Property Infringements**
- **Modalities for Combatting Online Intellectual Property Infringements**
- **Overview of Available Judicial Tools**
- **Gathering and Sharing Evidence**
- **International Legal Entanglement**
- **Take-away Points**

## The Online Legislative Measures Research Series

# The Online Legislative Measures Research Series

## The Online Legislative Measures Research Series

### THE OBSERVATORY STUDY

- Objective: Identify legal measures/tools related to international judicial cooperation in cases of online IP infringement.
- Builds upon the findings of the 2018 EUIPO Report *Study on Legislative Measures Related to Online IPR Infringements*



## The Online Legislative Measures Research Series

### THE OBSERVATORY STUDY

- Objective: Identify legal measures/tools related to international judicial cooperation in cases of online IP infringement.
- Builds upon the findings of the 2018 EUIPO Report *Study on Legislative Measures Related to Online IPR Infringements*
- Focus: Cooperation between EU Member States (MS) and between EU MS and non-EU countries.
- Focus on civil, criminal and administrative measures through case examples and mock cases.
- The report is available here: *International Judicial Cooperation in Cases*.
- The report was published on the 15 March 2021 when the EUIPO entered into a Service Level Agreement (SLA) with EUROJUST, the European Union Agency for Criminal Justice Cooperation.



## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



COMPARATIVE CASE STUDY ON  
ALTERNATIVE RESOLUTION SYSTEMS  
FOR DOMAIN NAME DISPUTES



2018  
Report

## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



IP ENFORCEMENT  
CASE-LAW COLLECTION ON THE BALANCE  
BETWEEN THE RIGHT OF INFORMATION  
AND FUNDAMENTAL RIGHTS  
IN THE EUROPEAN UNION



2018  
Report



## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



### IPR ENFORCEMENT CASE-LAW COLLECTION

THE LIABILITY AND OBLIGATIONS OF  
INTERMEDIARY SERVICE PROVIDERS  
IN THE EUROPEAN UNION



2019  
Report

## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



### ILLEGAL IPTV IN THE EUROPEAN UNION

RESEARCH ON ONLINE BUSINESS MODELS INFRINGING  
INTELLECTUAL PROPERTY RIGHTS — PHASE 3

Report



2019  
Report

## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



### STUDY ON DYNAMIC BLOCKING INJUNCTIONS IN THE EUROPEAN UNION

IPR ENFORCEMENT  
CASE-LAW COLLECTION



2021  
Report

## The Online Legislative Measures Research Series

# OTHER OBSERVATORY LEGAL REPORTS



### RECENT EUROPEAN CASE-LAW ON THE INFRINGEMENT AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS



2021  
Report

*This document presents summaries of selected important recent decisions relating to the infringement and enforcement of intellectual property rights (IPR). It is produced internally by the EUIPO and updated on a regular basis (usually once per month). The summaries are for information purposes only, and the selection of decisions is not exhaustive.*

*Find more key IPR enforcement decisions on EUIPO's [eSearch Case Law](#).*



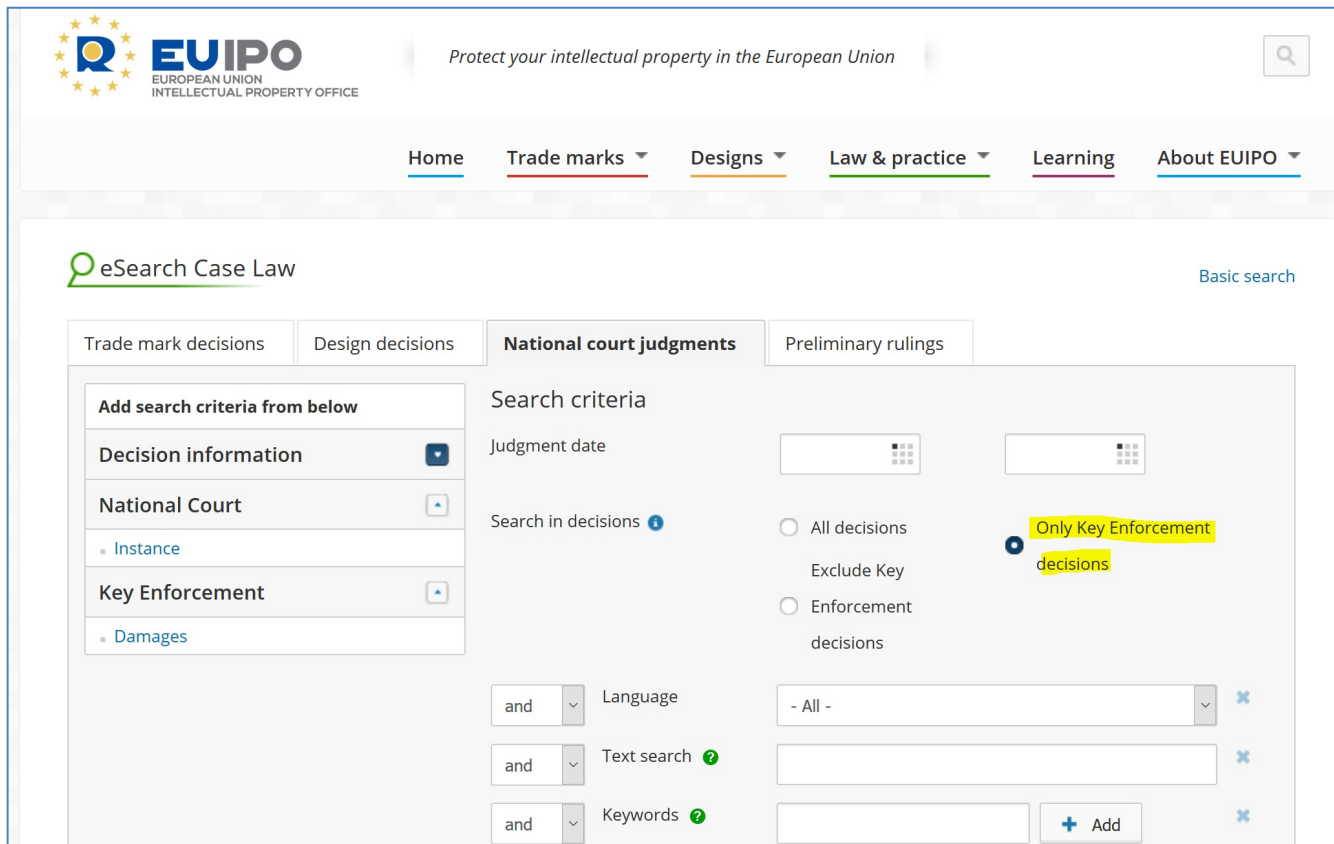
April 2021

## The Online Legislative Measures Research Series

# CASE LAW DATABASE



<https://euipo.europa.eu/eSearchCLW/>



The screenshot shows the EUIPO Case Law Database search interface. At the top, the EUIPO logo and tagline "Protect your intellectual property in the European Union" are visible. Below the logo is a navigation menu with options: Home, Trade marks, Designs, Law & practice, Learning, and About EUIPO. The main heading is "eSearch Case Law" with a "Basic search" link on the right. The search criteria are categorized into four tabs: Trade mark decisions, Design decisions, National court judgments (selected), and Preliminary rulings. Under "National court judgments", there are two expandable sections: "Decision information" (with a dropdown arrow) and "Key Enforcement" (with a dropdown arrow). The "Key Enforcement" section is currently expanded, showing "Instance" and "Damages". The "Search criteria" section includes "Judgment date" with two date pickers, "Search in decisions" with radio buttons for "All decisions", "Exclude Key decisions", and "Enforcement decisions", and "Language" with a dropdown menu set to "- All -". There are also input fields for "Text search" and "Keywords", each with a green question mark icon. A "+ Add" button is located at the bottom right of the search criteria section.

## Typical Online Intellectual Property Infringements

# Typical Online Intellectual Property Infringements

## Typical Online Intellectual Property Infringements

### 4 COMMON TYPES OF ONLINE IP INFRINGEMENTS

#### Illegal sharing/ distribution of copyright-protected works

- Distributing illegal copies of copyright-protected works through file sharing (e.g. streaming - IPTV piracy).

#### Sales and distribution of IPR-infringing goods

- Online marketplaces are increasingly being used to sell illicit goods such as pirated software and counterfeit medicines, clothes and mobile phones. The same occurs on social media platforms.

#### Cybersquatting and other IPR-infringing uses of domain names

- Domain names previously used for various purposes (e.g. commercial businesses, embassies or politicians) are systematically re-registered to operate as e-shops selling counterfeit goods.

#### Fraud, extortion and other traditional cybercrime offences

- Phishing scams are malicious attempts to acquire money or sensitive information or to install malware that is initiated through contact with victims via emails, posts on social media, blogs, etc.

## Typical Online Intellectual Property Infringements

### 4 COMMON TYPES OF ONLINE IP INFRINGEMENTS

#### **Disclaimers for the next 2 slides**

- purely qualitative non-quantitative slides;
- very significant national legislative and procedural differences.



## Typical Online Intellectual Property Infringements

### COPYRIGHT CASES

Civil Copyright  
Infringement

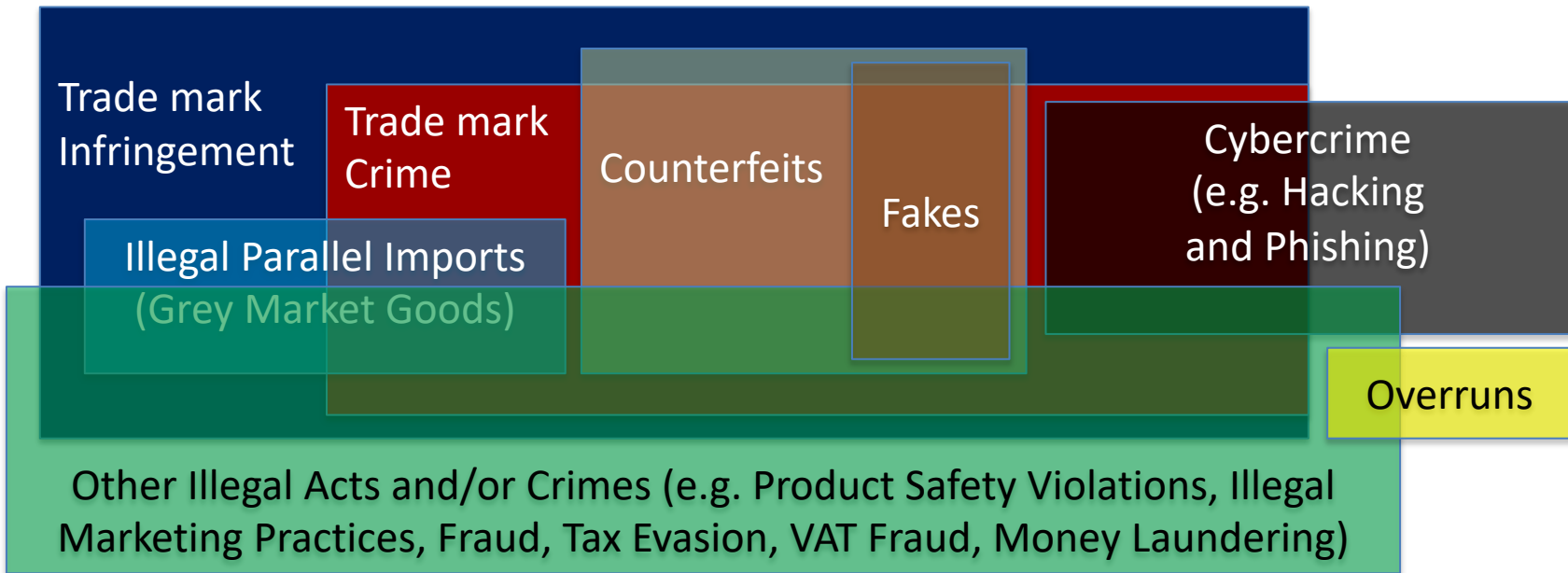
Copyright  
Crime

Cybercrime (incl Cybercrime  
Convention Art. 10)

Other Criminal Acts (e.g. Conditional  
Access Violations, Tax and VAT Fraud,  
Money Laundering)

## Typical Online Intellectual Property Infringements

### TRADE MARK CASES



## Modalities for Combatting Online Intellectual Property Infringements

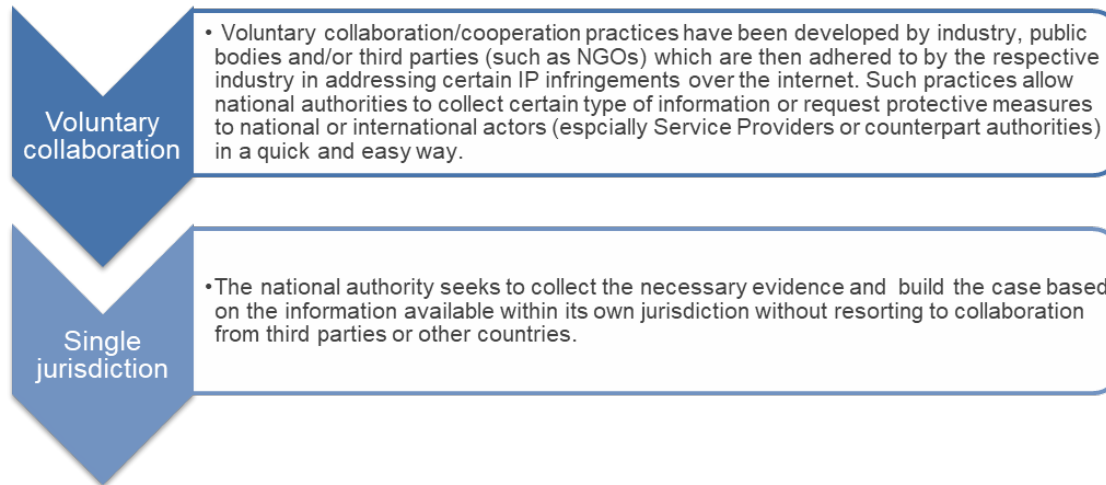
# Modalities for Combatting Online Intellectual Property Infringements

## Modalities for Combatting Online Intellectual Property Infringements

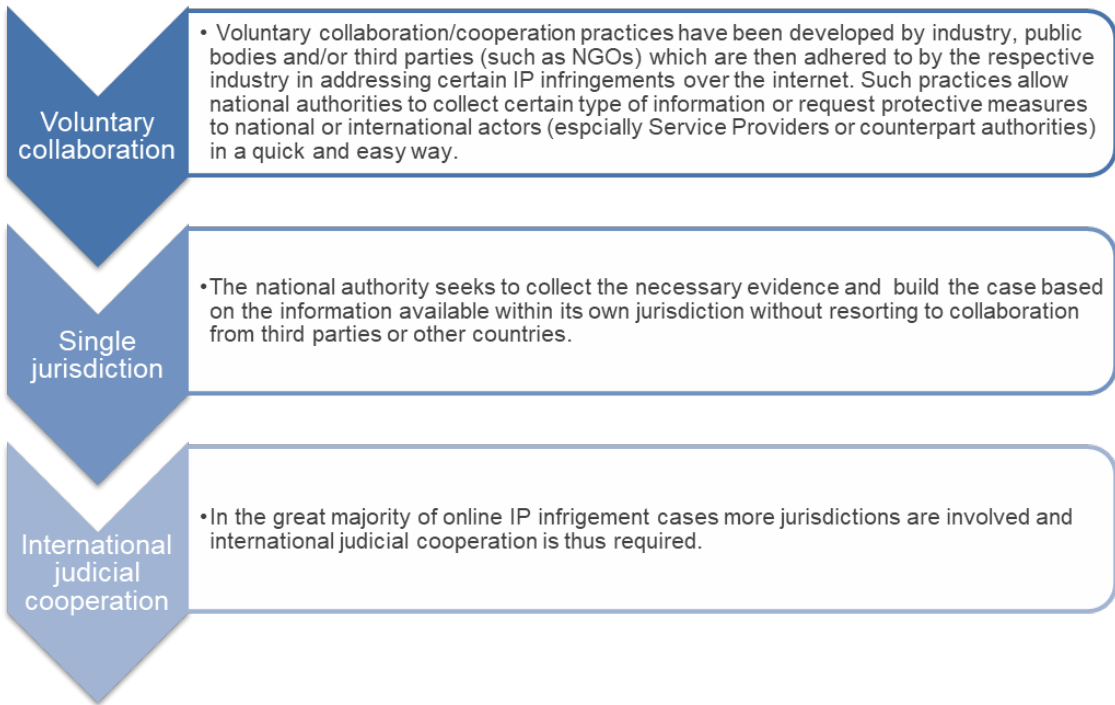
### Voluntary collaboration

- Voluntary collaboration/cooperation practices have been developed by industry, public bodies and/or third parties (such as NGOs) which are then adhered to by the respective industry in addressing certain IP infringements over the internet. Such practices allow national authorities to collect certain type of information or request protective measures to national or international actors (especially Service Providers or counterpart authorities) in a quick and easy way.

## Modalities for Combatting Online Intellectual Property Infringements



## Modalities for Combatting Online Intellectual Property Infringements



## Overview of Available Judicial Tools

# Overview of Available Judicial Tools

## Overview of Available Judicial Tools

# MAIN AREAS FOR JUDICIAL COOPERATION IN ONLINE IP INFRINGEMENT CASES

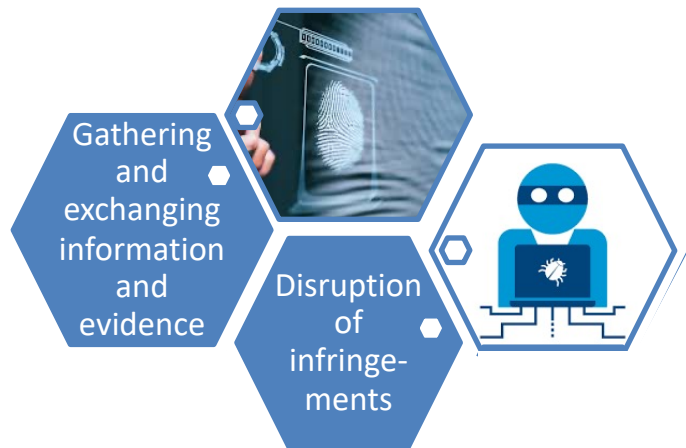
Gathering  
and  
exchanging  
information  
and  
evidence





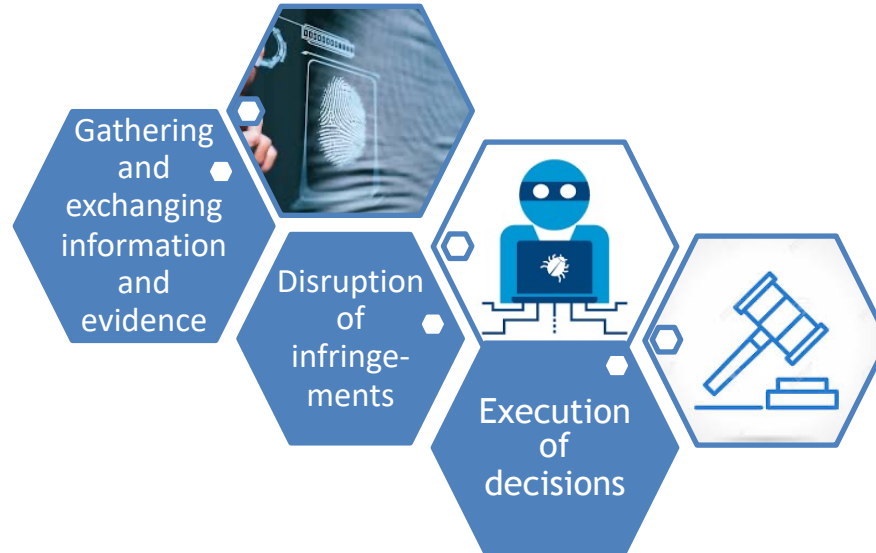
## Overview of Available Judicial Tools

# MAIN AREAS FOR JUDICIAL COOPERATION IN ONLINE IP INFRINGEMENT CASES



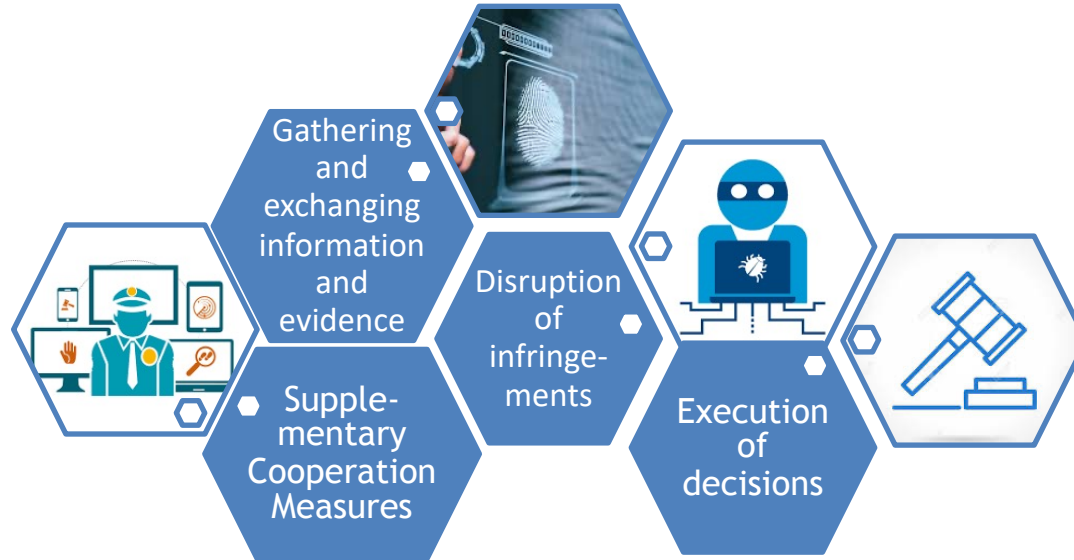
## Overview of Available Judicial Tools

# MAIN AREAS FOR JUDICIAL COOPERATION IN ONLINE IP INFRINGEMENT CASES



## Overview of Available Judicial Tools

# MAIN AREAS FOR JUDICIAL COOPERATION IN ONLINE IP INFRINGEMENT CASES



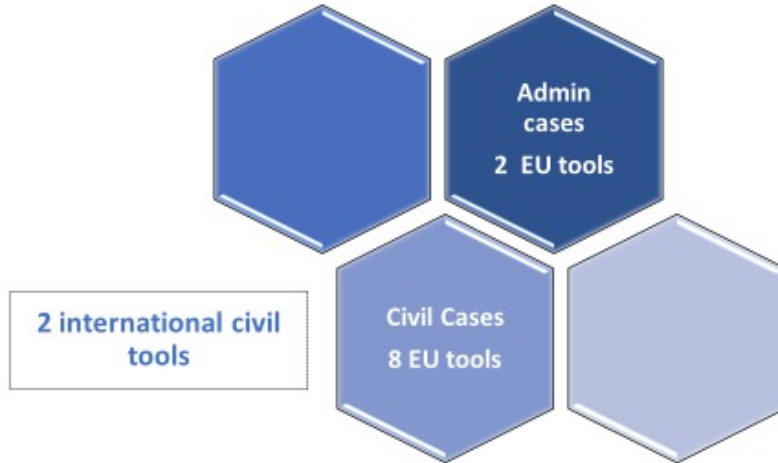
## Overview of Available Judicial Tools

# VARIETY OF JUDICIAL COOPERATION INSTRUMENTS



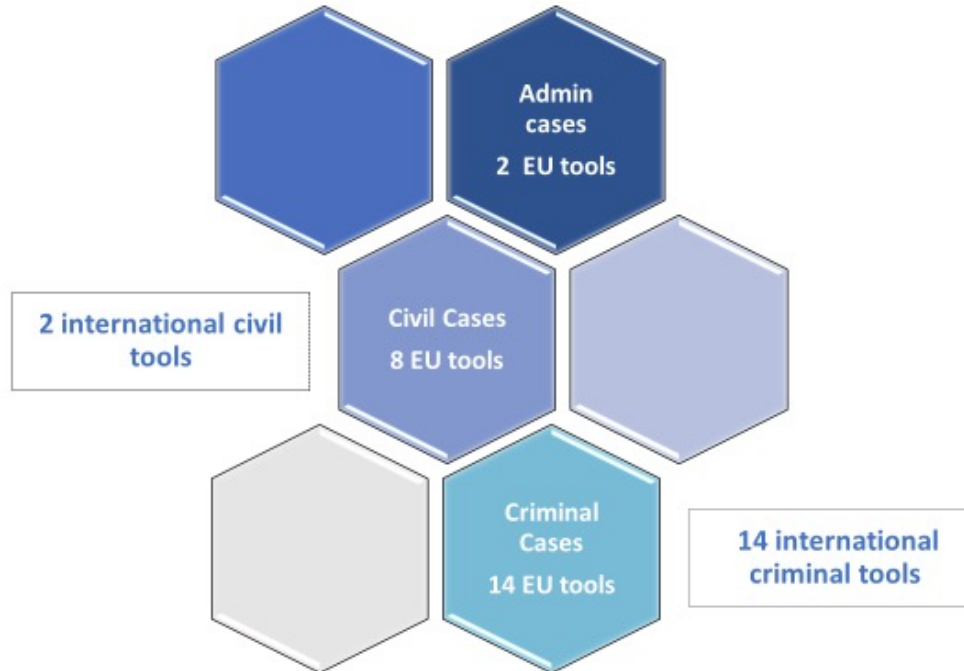
## Overview of Available Judicial Tools

### VARIETY OF JUDICIAL COOPERATION INSTRUMENTS



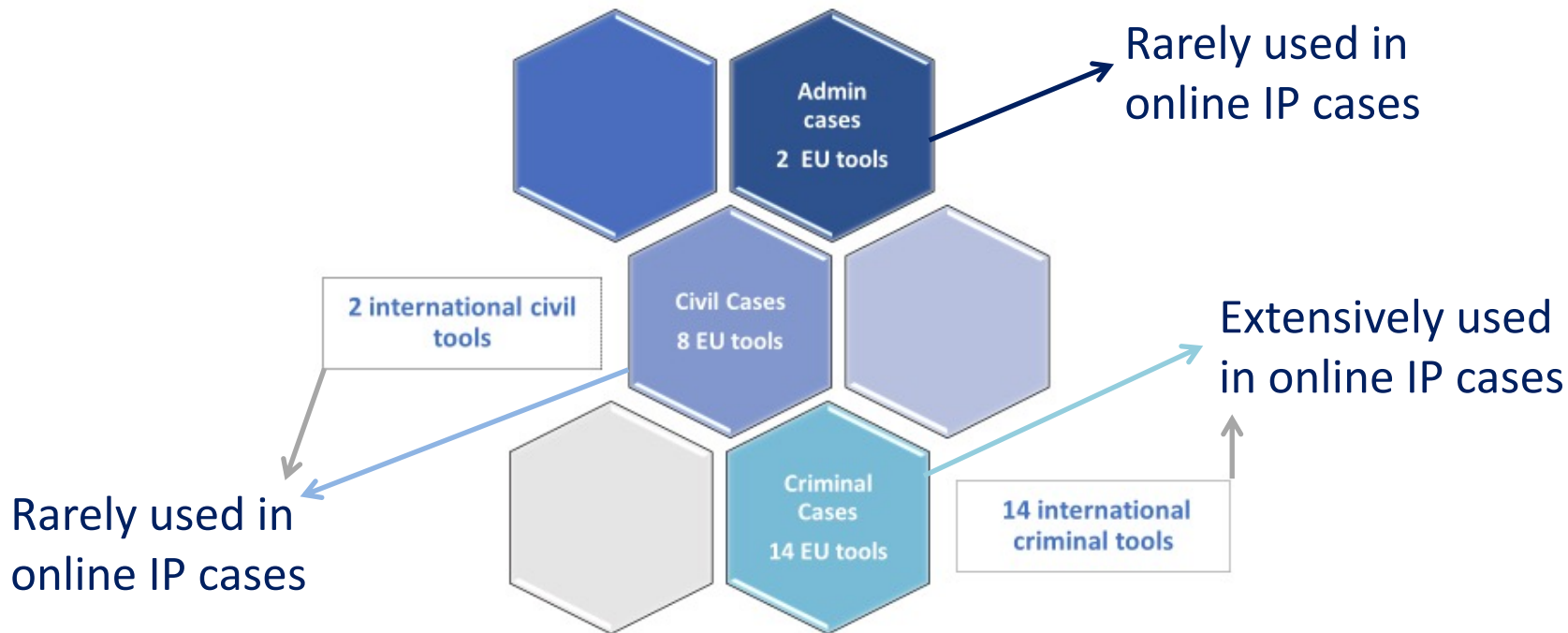
## Overview of Available Judicial Tools

### VARIETY OF JUDICIAL COOPERATION INSTRUMENTS



## Overview of Available Judicial Tools

### VARIETY OF JUDICIAL COOPERATION INSTRUMENTS



## Overview of Available Judicial Tools

### CYBERCRIME CONVENTION, COUNCIL OF EUROPE 2001 (CETS 185)

- Ratified/acceded: 50 countries.
- Signed: 5 countries.
- Invited: 12 countries.
- **Direct reach: 67 countries.**
- But legislation in 20 other countries largely comply with Cybercrime Convention.
- And legislation in more than 45 additional countries draws on the Cybercrime Convention.
- **Total reach: 130+ countries.**





## Overview of Available Judicial Tools

# CYBERCRIME CONVENTION, ARTICLE 10

### Cybercrime Convention Article 10 - Offences Related To Infringements Of Copyright And Related Rights

1. Each Party shall adopt such legislative and other measures as may be necessary to establish as criminal offences under its domestic law the infringement of copyright, as defined under the law of that Party, pursuant to the obligations it has undertaken under the Paris Act of 24 July 1971 revising the Bern Convention for the Protection of Literary and Artistic Works, the Agreement on Trade-Related Aspects of Intellectual Property Rights and the WIPO Copyright Treaty, with the exception of any moral rights conferred by such conventions, where such acts are committed wilfully, on a commercial scale and by means of a computer system.
2. Each Party shall adopt such legislative and other measures as may be necessary to establish as criminal offences under its domestic law the infringement of related rights, as defined under the law of that Party, pursuant to the obligations it has undertaken under the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (Rome Convention), the Agreement on Trade-Related Aspects of Intellectual Property Rights and the WIPO Performances and Phonograms Treaty, with the exception of any moral rights conferred by such conventions, where such acts are committed wilfully, on a commercial scale and by means of a computer system.
3. A Party may reserve the right not to impose criminal liability under paragraphs 1 and 2 of this article in limited circumstances, provided that other effective remedies are available and that such reservation does not derogate from the Party's international obligations set forth in the international instruments referred to in paragraphs 1 and 2 of this article.

## Overview of Available Judicial Tools

### BILATERAL MUTUAL LEGAL ASSISTANCE TREATIES/AGREEMENTS AND ROGATORY LETTERS

For example:

- the agreement on mutual legal assistance between the EU and the United States of America (EU-US MLAA);
- the agreement on mutual legal assistance in criminal matters between the EU and Japan;
- letters rogatory to request judicial assistance via diplomatic channels from a country that is neither a party to the Hague Conventions nor authorizes foreign parties to make direct requests in their courts.



## Gathering and Sharing Evidence

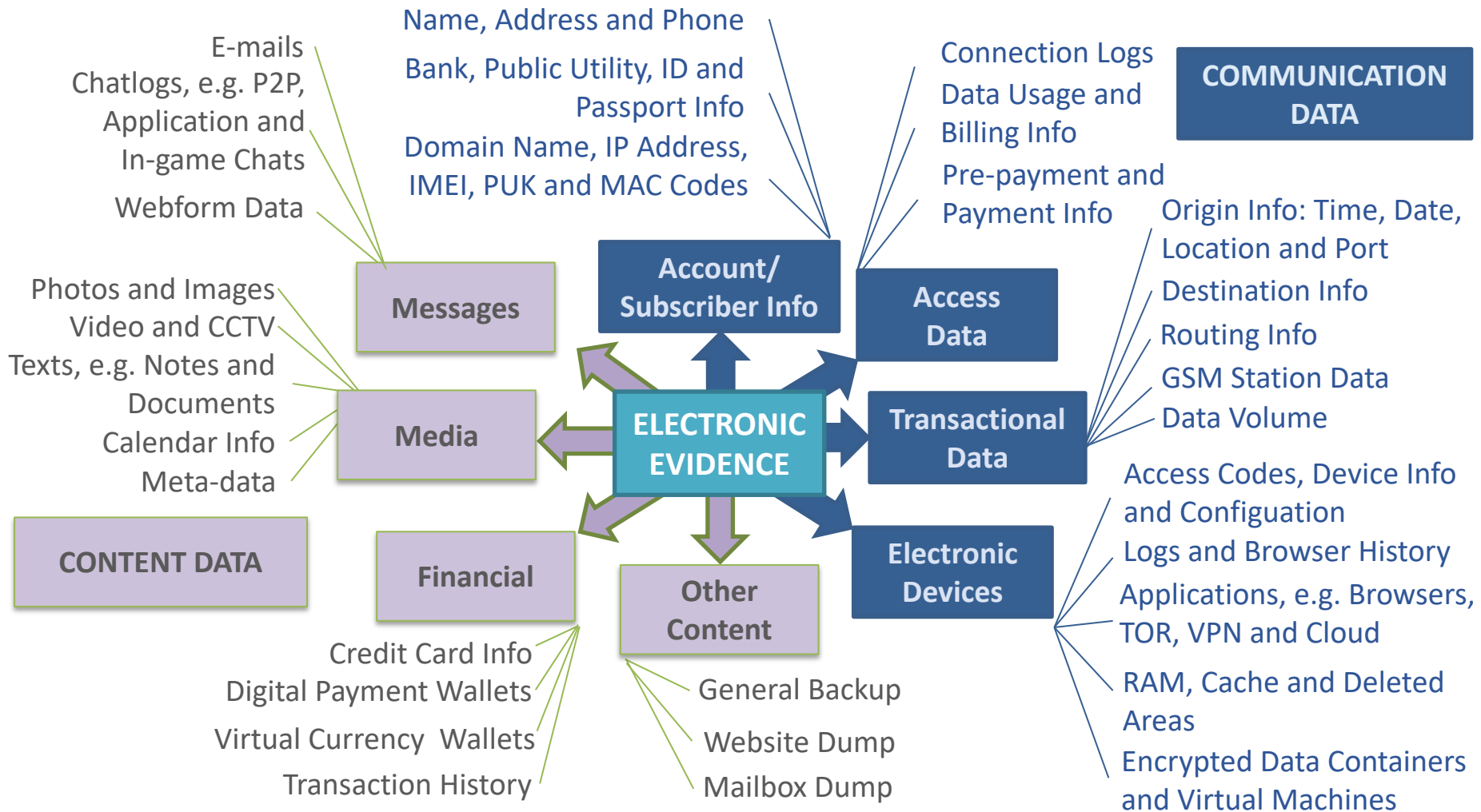
# Gathering and Sharing Evidence

## Gathering and Sharing Evidence

### DIGITAL EVIDENCE

- IP prosecutors and lawyers are hunters and gatherers, just like cave men and women.
- But what are they hunting and gathering?
- Digital evidence
  - subscriber information (name and address, IP address, originating IP address, length and type of service (including start date), MAC address/code, bank account or credit card information);
  - transactional/access data (Logs that record date and time of account usage, IP addresses of sites accessed, e-mail addresses/names of others with whom the subscriber communicated);
  - content data (E-mails, photos/images, videos, chats).





## Gathering and Sharing Evidence

### PRESERVATION OF EVIDENCE

- Before digital evidence can be gathered and shared, it must be preserved.
- The 24/7 Cybercrime Network was created in 1997 by the Group of Seven (G7) countries to permit member countries to expeditiously preserve electronic data in other member countries for all online crimes, including online IP crimes.
- Once the digital evidence is preserved, then it may be obtained through formal legal channels.



## Gathering and Sharing Evidence

### MUTUAL LEGAL ASSISTANCE TO OBTAIN DIGITAL EVIDENCE WITHIN THE EU IN CRIMINAL MATTERS

- The **European Investigation Order (EIO) Directive (2014/41/EU)** is the primary tool used in the EU (except DK and Ireland) to request digital (and non-digital) evidence (including on bank accounts, banking transactions and other financial operations).
- **EU Convention on Mutual Legal Assistance in Criminal Matters (2000)** is still to some extent used to:
  - obtain evidence and serve documents;
  - request hearing by video or teleconference;
  - request permission to intercept communications.
- The **Framework Decision 2006/960/JHA** establishes the rules under which MS law enforcement authorities may exchange existing information and intelligence effectively and expeditiously for the purpose of conducting criminal investigations or criminal intelligence operations.



## Gathering and Sharing Evidence

### MUTUAL LEGAL ASSISTANCE TO OBTAIN DIGITAL EVIDENCE AT THE INTERNATIONAL LEVEL IN CRIMINAL MATTERS

- **Cybercrime Convention**
  - assistance for accessing stored computer data related to offences against/by means of computers, and collection of evidence in electronic form in relation to any criminal offence.
- **Bilateral mutual legal assistance treaties and agreements.**
- **Convention on the counterfeiting of medical products and similar crimes involving threats to public health (Medicrime Convention).**





## Gathering and Sharing Evidence

### SUPPLEMENTARY COOPERATION MEASURES: JOINT INVESTIGATIVE TEAM (JITS)

- **MLA Convention** Article 13.
- **Framework Decision 2002/465/JHA** on joint investigation teams (JITs) includes information on
  - the purposes for setting up JITs;
  - data to include in the request;
  - general conditions of operation in EU MS;
  - powers of the different members of the team and applicable law;
  - and criminal and civil liability of foreign officials operating in the JIT.
- **JITs Network**, working with EUROPOL and EUROJUST.



## Gathering and Sharing Evidence

### JUDICIAL COOPERATION TO OBTAIN DIGITAL EVIDENCE WITHIN THE EU IN CIVIL MATTERS

- **Council Regulation (EC) No 1206/2001** on cooperation between the courts of the EU MS in the taking of evidence in civil or commercial matters:
  - standardised request forms in all EU languages;
  - telephone & videoconferencing;
  - a guide is available.
- **Regulation (EC) No 1393/2007** on the service in EU MS of judicial and extrajudicial documents in civil or commercial matters:
  - fast-track channels & uniform procedures for transmitting documents;
  - standards forms;
  - applies only to service on persons whose address is known.



## Gathering and Sharing Evidence

### REQUEST FOR DIGITAL EVIDENCE AT THE INTERNATIONAL LEVEL IN CIVIL MATTERS

- The main tool for civil cases is **The Hague Evidence Convention**.
- It specifies procedures to compel the production of evidence abroad.
- A **Practical Handbook** on the operation of the Evidence Convention including commentaries on the major issues raised by practice since its adoption in 1970.
- To obtain evidence from countries that are not signatories to The Hague Evidence Convention, civil parties must use the more cumbersome **Letters Rogatory** process.



## International Legal Entanglement

# International Legal Entanglement

## International Legal Entanglement

### CRIMINAL CASE ENTANGLEMENT

- In 2015, a civil court decision in the UK determined that the PopcornTime app was illegal.
- Later, criminal actions were taken in Denmark and Norway against persons promoting the app and the .dk and .no domains were seized.
- Prosecutors referred to the UK decision and the interim domain seizure decisions in the two countries also supported each other.
- In 2019, the Norwegian Supreme Court confiscated the .no domain.
- In 2020, the Norwegian ruling was referred to before the Danish Supreme Court that convicted the defendant.



## International Legal Entanglement

### CIVIL CASE ENTANGLEMENT

- In a 2020 judgment from the High Court of Ireland dealing with a dynamic blocking order against several ISPs with the aim of combating the illegal IPTV streaming of live sporting events, the Irish judge referred several times to the judgments of the High Court of England and Wales in similar (if not identical) cases.



## Take-away Points

# Take-away Points

## Take-away Points

- Some tools have been in existence for many years, others are relatively new but few were created especially with the online environment in mind (the Cybercrime Convention is an important and notable exception).
- Generally international judicial cooperation is challenged by the length of processes when obtaining evidence, disrupting infringements, and executing decisions.
- Delays in execution, or refusal of legal assistance requests are sometimes the result of:
  - a lack of precision in the requests, or
  - a lack of clarity regarding the connection between the facts in the request and the assistance being requested, or
  - poor quality of translations.
- Civil judicial cooperation are generally effective but suffers from lengthy and expensive procedures, limited available remedies (especially in regards to online infringements).
- Criminal instruments have recently been simplified and sped up the process for receiving information and evidences and further initiatives are ongoing.





[www.euipo.europa.eu](http://www.euipo.europa.eu)



---

@EU\_IPO



---

EUIPO

Thank you