

Blocking Orders In Trade Mark cases

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Overview

1. Legal basis for trade mark blocking injunctions
2. Threshold requirements
3. Cartier v British Sky Broadcasting
4. Methods of blocking
5. Form of Order
6. Procedure
7. The cost of blocking
8. Effectiveness of blocking orders

Legal Basis for jurisdiction

- Copyright
 - Article Section 97A of the CDPA 1988, and
 - Article 8 of the E-Commerce Directive
- Trade Marks
 - Section 37(1) of the Senior Courts Act 1981
 - Article 11 of the Enforcement Directive

Threshold Requirements

1. The Respondents are service providers
2. The users and/or operators of the Target Websites are infringing the Applicant's intellectual property rights
3. The users and/or operators of the Target Websites use the Respondents' services
4. The Respondents have actual knowledge of this

Cartier v British Sky Broadcasting

Court has general jurisdiction to grant injunction under s.37(1) of the Senior Courts Act 1981:

The High Court may by order (whether interlocutory or final) grant an injunction ...in all cases in which it appears to be just and convenient to do so.

Principles to be applied

- Necessary
- Effective
- Dissuasive
- Not unnecessarily complicated or costly
- Avoid barriers to legitimate trade
- Fair and equitable
- Proportionate

Necessary

1. Is the objection that the site is selling counterfeits or is it a foreign site that should not be targeted at UK customers?
2. Can you get the site taken down?
3. Does the site host other content?
4. If so, is the other content legitimate?
5. Is any legitimate content *de minimis*?

Blocking Methods

- Each of the ISPs uses a different method of blocking – *See Cartier case paras 25-65*
- Some methods are more effective than others
- Some methods are capable of finer tuning so that different pages of a website can be blocked

Blocking Methods

The main methods of blocking are:

1. Domain Name System (DNS) blocking
2. Internet Protocol (IP) address blocking
3. Deep Packet Inspection (DPI) based URL blocking
4. Two stage blocking
5. Geo-blocking

Accuracy

- It must be possible to isolate, with reasonable certainty, the infringing websites or pages, from legitimate content
- Therefore, not necessarily appropriate where a few infringing items occur amongst other genuine, non-infringing, items. More of a problem with trade marks than with copyright.

Problems

1. Over blocking has occurred on a few occasions including blocking the website hosting the Radio Times apparently caused by an error in notification.
2. All methods of blocking can be circumvented – some with greater ease than others. The main methods are the use of proxy servers and VPNs with end to end encryption.

Flexibility

- The Orders granted are flexible, allowing the rightholders to notify different URLs/IP addresses to limit the ability of Target Websites to move in order to avoid the effect of the injunctions

Form of Order

1.The Defendant shall ...adopt the following technical means to block ...access to the Target Websites, their domains and sub-domains and any other IP address or URL notified to the Defendant whose sole or predominant purpose is to enable or facilitate access to a Target Website:
 - i. IP blocking in respect of each and every IP address from which each of the Target Websites operate and which is:
 - i. Notified in writing to the Defendant by the Applicants; and
 - ii. That the server with the notified IP address does not also host a site that is not part of a Target Website.

Form of Order

- ii. IP address re-routing in respect of all IP addresses that provide access to each and every URL available from each of the Target Websites and their domains and sub-domains and which URL is notified in writing to the Defendant by the Claimants; and
 - iii. URL blocking in respect of each and every URL available from each of the Target Websites and their domains and sub-domains and which is notified in writing to the Defendant by the Claimants....
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3. ...The Defendant is wholly reliant on the Claimants accurately identifying the IP addresses and/or URLs from which the Target Websites operate and which should be blocked ...

Procedure

- The ISPs won't block without a Court order but will agree a form of order they won't oppose
- Most applications are now dealt with on paper unless they involve a new element that hasn't been considered by the Court before
- The Applicant can request it is dealt with on paper but it is for the Court to decide if it is appropriate

Costs

- The cost of implementation will be borne by the ISPs – subject to Supreme Court...
- The costs of the application will be borne by the rightholders except so far as increased by resistance by the ISPs
- The cost of monitoring the websites and identifying other addresses to block will be borne by the rightholders

Costs to the Rightholders

- Approximately £14,000 per website for the Application
- Approximately £3,600 per website per year to monitor the server locations and domain name used by Target Websites

Costs to the ISPs

- The ISPs have incurred a capital cost in setting up their blocking mechanisms. At the moment, they receive no contribution from the rightholders but Arnold J has left it open as to what happens if a surge in applications requires further investment
- The ISPs have running costs which they must pay
- The ISPs have appealed to the Supreme Court

Killing the Goose that Laid the Golden Eggs

Effectiveness

Section 97A Orders have been shown to have some effect.

“...there is no reason to believe that the blocking would be materially less effective in reducing UK traffic to the Target Websites than the blocking ... by the section 97A orders. If anything, it is probable that it will be more effective ... users have little brand loyalty to websites like the Target Websites, whereas... TPB do have quite a loyal user base.”

THE END

Any questions?

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