Towards an updated EU Enforcement Directive? Selected topics and problems

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I. Introduction

Intellectual property infringements have taken considerable dimensions during the last years and have become a real threat both for right holders and consumers. A variety of international and European Union instruments have dealt with this issue but in a rather sporadic and incomplete manner in the sense that they are usually rather vague and general in nature, they leave considerable discretion to states, each one of them deals with different intellectual property rights and most of them were drafted when digital infringements were still at a premature stage.[1] The EU Enforcement Directive[2] was the first European Union instrument which dealt with the issue of IP enforcement in a more structured and organized manner providing Member States with a TRIPs Plus Element. Lately many initiatives have taken place in the area of IP enforcement.[3] However, the EU Enforcement Directive continues to be the most significant legal instrument in the area.

[1] For the situation today see for example <http://www.iccwbo.org/uploadedFiles/BASCAP/Pages/OECD-FullReport.pdf>; <http://www.iccwbo.org/uploadedFiles/BASCAP/Pages/Building%20a%20Digital%20Economy%20-%20TERA(1).pdf>.

[2] Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights, OJ L157/16, 30.04.2004.

[3] See indicatively, *At European Union level*:

- the relevant provisions of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (OJ No L 178/1 of 17.07.2000) and Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (OJ No L 167/10 of 22.6.2001);

In a recent assessment of the Directive on the basis of article 18, the European Commission came to the conclusion that it is difficult to assess the effectiveness of the Directive as this has been transposed late in many Member States although the expiry of the deadline for the implementation of the Directive was 29 April 2006.[4] On top of it a number of issues are pinpointed as being capable of improvement or change according to the requests/opinions by Member States, the industry and other stakeholders. One of these issues -perhaps the most important one- is the fact that this Directive falls short of dealing adequately with digital infringements whilst its relation with other EU Directives

- Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights;
- amended Proposal for a Directive of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights (COM (2006) 168 final of 26.4.2006);
- Commission Strategy for the Enforcement of Intellectual Property Rights in Third Countries of 2005 and to the Commission Staff Working Document 'IPR Enforcement Report 2009' (OJ No C129 of 26.5.2005);
- draft Report of the Committee on Legal Affairs on enhancing the enforcement of intellectual property rights in the internal Market, 13.1.2010, (2009/2178(INI));
- Resolution of the European Parliament on defining a new digital agenda for Europe: from i2010 to digital.eu, 5.5.2010, (2009/2225(INI));
- European Parliament, Resolution of 22 September 2010 on enforcement of intellectual property rights in the internal market (2009/2178(INI)), A7-0175/2010.
- draft Opinion of the Committee on Industry, Research and Energy for the Committee on Legal Affairs (European Parliament) on enforcement of intellectual property rights in the internal market, 29.01.2010, (2009/2178(INI));
- draft Opinion of the Committee on the Internal Market and Consumer Protection for the Committee on Legal Affairs (European Parliament) on enhancing the enforcement of intellectual property rights in the internal market, 5.02.2010, (2009/2178(INI));
- Council Resolution of 1 March 2010 on the enforcement of intellectual property rights in the internal market (OJ C 56/01);
- Commission Communication of 11 September 2009 on enhancing the enforcement of intellectual property rights in the internal market (COM (2009) 467 final);
- Resolution of 25 September 2008 on a comprehensive European anti-counterfeiting and anti-piracy plan including the European network for administrative cooperation referred to in it with a view to ensuring rapid exchanges of information and mutual assistance among the authorities engaged in the field of the enforcement of intellectual property rights (OJ C 253/1);
- Conclusions of 20 November 2008 on the development of legal offers of online cultural and creative content and the prevention and combating of piracy in the digital environment (OJ L 195/16);
- Commission Communication of 16 July 2008: 'An industrial property rights strategy for Europe', COM (2008)465 final; Commission Communication: 'Enhancing the enforcement of intellectual property rights in the internal market', COM(2009) 467 final.
- the Telecom Package (Directive 2009/140/EC of the European Parliament and of the Council of 25 November 2009 amending Directives 2002/21/EC on a common regulatory framework for

cutting across relevant issues in this field, is not without problems. On the basis of the above an updating of the Enforcement Directive has come on the EU agenda.

II. Problem issues and open questions

A. Scope of protection

The Directive relates to civil law measures concerning the enforcement of intellectual property rights. Criminal sanctions were dropped before the Directive's adoption and became the content of another draft directive.[5] This Directive presents a blend of civil law and civil law procedure but by no means constitutes a reflection of a civil law tradition. It is rather a compromise between the civil law and the common law traditions or -even better- a collection (puzzle) of various procedures found in different Member States which were thought to be useful and effective with regard to enforcement (a best practices approach). What also needs to be kept in mind is that this Directive does not intend to harmonise the enforcement regime in all Member States in a uniform manner

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electronic communications networks and services, 2002/19/EC on access to, and interconnection of, electronic communications networks and associated facilities, and 2002/20/EC on the authorisation of electronic communications networks and services (OJ L 337/37);

- Decision 2009/371/JHA of 6 April 2009 establishing the European Police Office (Europol) (OJ L 121/37);
- Decision 2002/187/JHA of 28 February 2002 setting up Eurojust with a view of reinforcing the fight against serious crime (OJ L 63/1);
- Conclusions of 24 September 2009 on "Making the internal market work better" (Council Document 13024/09);
- Commission Recommendation 2009/524/EC of 29 June 2009 on measures to improve the functioning of the single market (OJ L 176/17);
- the European Observatory on Counterfeiting and Piracy;
- proposals for the review of the Brussels I Regulation (Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ L 12/1)); see, for example, Report from the Commission to the European Parliament, the Council and the European Economic and Social Committee on the application of Council Regulation (EC) No 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (COM(2009) 174 final);
- the setting up of ENISA: the European Network and Information Security Agency, working for the EU Institutions and Member States and dealing with security issues of the European Union (http://www.enisa.europa.eu/about-enisa).

At international level:

- The Anti-counterfeiting Trade Agreement (ACTA);
- the Advisory Committee on Enforcement (ACE) approved by the WIPO General Assembly at its 23rd September to 1st October 2002 session.

[4] See Report on the enforcement of intellectual property rights (COM (2010) 779), and Analysis of the application of Directive 2004/48/EC on the enforcement of intellectual property rights in the Member States (SEC (2010) 1589).

[5] Amended Proposal for a Directive of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights (COM (2006) 168 final of 26.4.2006).

since it only provides for minimum harmonization, i.e. leaves Member States free to introduce (or retain) stricter provisions favourable to rightholders, if they so wish. This however has taken place in reality with regard to only few provisions in the Directive.[6] There are also several voluntary provisions that have not been implemented by some Member States.[7]

The Directive was meant to apply to any infringement of intellectual property rights whether these rights were provided for by European Union law or the law of the Member States.[8] This formed a rather flexible approach but at the same time it was open to multiple interpretations. Following a Member States' request the European Commission published a statement which contained a minimum list of the intellectual property rights that were covered by the Directive.[9] This statement clarified that amongst the rights covered by the Directive are copyright and related rights, the sui generis right of a database maker, rights of the creator of the topographies of a semiconductor product, trademark rights, design rights, patent rights, including rights derived from supplementary protection certificates, geographical indications, utility model rights, plant

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[6] "*One of the examples where some Member States have gone beyond the Directive's wording was the right of information (Article 8) which, according to the Directive, is limited to the activities carried out on a commercial scale if the request is not directed towards the infringer. A significant number of Member States (e.g. Denmark, Estonia, Greece, France, Lithuania, Slovak Republic) have gone beyond the 'commercial scale' requirement (of which there is no definition in the Directive) and introduced this measure for all infringements […]. Another example where Member States have gone beyond the Directive's provisions was damages. As far as damages are concerned, most Member States did not specifically implement the Directive's provisions as they felt that their national laws already covered them sufficiently. However, as far as lump sum damages are concerned, some Member States (e.g. Austria, Belgium, Greece, Czech Republic, Lithuania, Poland, Romania, Slovenia) have moved beyond the Directive's provisions and introduced multiple damages awards. Such multiple (mostly double) awards are available for copyright (and rights related to copyright) infringements or for infringements committed in bad faith". European Commission Staff Working Document, "Analysis of the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States Accompanying document to the Report from the Commission to the Council, the European Parliament and the European Social Committee on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights*" COM(2010) 779 final (Brussels, 22.12.2010 SEC(2010) 1589 final), p. 5.

[7] "As an example, many Member States have opted for non-transposition of the alternative measures provided for in Article 12 of the Directive (e.g. Austria, Belgium, France, Luxembourg, the Netherlands, and Slovenia). Likewise, many Member States (e.g. Czech Republic, Greece, Hungary, Malta, and Poland) have opted for non-implementation of description orders (Article 7(1)), which are often available in criminal proceedings only", *op. cit.* p. 6.

[8] Article 2(1).

[9] Statement by the Commission concerning Article 2 of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights (2005/295/EC).

variety rights and trade names in so far as these are protected as exclusive property rights in the national law of the Member State concerned.

Although this statement was considered to be helpful it still did not clarify the area exhaustively. Questions remained as to domain names, trade secrets and know-how, appellations of origin and unfair competition law (in particular parasitic copies and other forms of commercial misbehavior). In a series of meetings that took place concerning issues of enforcement at the level of the European Council, many suggestions were made. One suggestion was to draft a new minimum list of intellectual property rights covered by the Directive. Another suggestion was to draft an exhaustive list of intellectual property rights covered by the Directive. These lists could either be in the Preamble to the Directive (a non-exhaustive list is found there currently) or within the actual text of the Directive. However, reservations were made regarding the extension of the Directive's scope. Such an extension did not seem to be welcome by most Member States. As a whole, however, the fact that the European Union chose to have a legal instrument applicable to all intellectual property rights and not only to those covered by the *acquis communautaire* or Community rights alone was regarded as an important step forward with rather positive effects on the single market. This is so irrespective of the fact that the European Union was criticised in the past for such a holistic approach.

B. **infringements on the Internet, intermediaries and issues pending**

The notion of an 'intermediary' is rather broad in the Directive aiming to cover any third party whose services are used to infringe an intellectual property right be it a transporter, intermediate trader or Internet platform. That means that it is irrelevant for the purposes of the Directive whether this person or entity is in direct contractual relationship with the infringer or not as well as whether s/he is in good faith when acting or not. In other words the liability of the intermediary is also irrelevant for the purposes of the Directive in the sense that measures may also imposed on the intermediary as means to stop or prevent further infringements to which it contributes or facilitates.[10]

[10] See I. Stamatoudi, "Data Protection, Secrecy of Communications and Copyright Protection. Conflicts and Convergences. The Example of Promusicae v. Telefonica" I. Stamatoudi (ed), Copyright Enforcement and the Internet, Information Law Series (B. Hugenholtz (general editor), Kluwer Law International, 2010, at 199. See also I. Stamatoudi, «Ethics, Reality and the Law: The Example of *Promusicae v. Telefonica* & *LSG v. TELE2*» [2010] 63 Revue Hellénique de droit International 921; I. Stamatoudi, «Ethics, Codes of Conduct and P2P», 3rd International Seminar on Information Law 2010 "An Information Law for the 21st Century", Ionio University, Corfu, 25-26 June 2010, Nomiki Vivliothiki, Athens, 2010, 476, and I. Stamatoudi «The role of Internet Service Providers. Ethics, Reality and the Law: The Example of *Promusicae v. Telefonica*», 8th International Conference, Computer Ethics: Philosophical Enquiry, Ionio University, Corfu, 26-28 June 2009, Nomiki Vivliothiki, Athens, 2009, 750. See also J. Raynard, Intellectual Property Enforcement in Europe: Acquis and Future Plans, Intervention lors de la conférence organisée par le CEIPI dans le cadre du réseau EIPIN sur le thème «Constructing European IP:

However, the fact that ***injunctions***, for example, can be applied for and taken irrespective of the liability of internet service providers is not entirely clear in the Directive and merits perhaps further clarification.[11]

The Enforcement Directive does not provide for the liability (or non-liability) of internet service providers (and intermediaries in general). Its focus is rather on enforcement than liability. The E-Commerce Directive[12] is more specific on liability. ISPs are exempt from liability when they serve as a "mere conduit" (Article 12),[13] provide "temporary caching" (Article 13)[14] or host services (Article 14).[15] In this latter case though, in order not to be liable they have to act expeditiously to remove or to disable access to the information as

Achievements and New Perspectives», Strasbourg, European Parliament, 25 February 2011, Edward Elgar Publishing (in print); the conference organized by the Facultés Universitaires Saint Louis, the Université Libre de Bruxelles and the Université de Liège on «Quelles réponses juridiques au téléchargement d'oeuvre sur internet ? Perspectives belges et européennes», Université Libre de Bruxelles, Bruxelles, 14 December 2010, Larcier (in print). See also Ch. Geiger, J. Raynard and C. Rodà, L'application de la directive du 29 avril 2004 relative au respect des droits de propriété intellectuelle dans les États Membres. Observations du CEIPI sur le rapport d'évaluation de la Commission européenne du 22 décembre 2010, <http://www.ceipi.edu/index.php?id=8601>.

[11] Injunctions against intermediaries whose services are used by a third party to infringe copyright or related rights were already provided for in Article 8(3) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society (OJ L 167, 22.6.2001, p. 10).

[12] Directive 2000/31/EC of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce), OJ L 178/1, 17.7.2000.

[13] 1. Where an information society service is provided that consists of the transmission in a communication network of information provided by a recipient of the service, or the provision of access to a communication network, Member States shall ensure that the service provider is not liable for the information transmitted, on condition that the provider:
(a) does not initiate the transmission;
(b) does not select the receiver of the transmission; and
(c) does not select or modify the information contained in the transmission.
2. The acts of transmission and of provision of access referred to in paragraph 1 include the automatic, intermediate and transient storage of the information transmitted in so far as this takes place for the sole purpose of carrying out the transmission in the communication network, and provided that the information is not stored for any period longer than is reasonably necessary for the transmission.
3. This Article shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement.

[14] communication network of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the automatic, intermediate and temporary storage of that information, performed for the sole purpose of making more efficient the information's onward transmission to other recipients of the service upon their request, on condition that:
(a) the provider does not modify the information;
(b) the provider complies with conditions on access to the information;
(c) the provider complies with rules regarding the updating of the information, specified in a manner widely recognised and used by industry;

soon as they become aware or gain knowledge of illegal activity or information. In relation to mere conduit and caching the Directive also refers to the fact that it does not affect the possibility of Member States' judicial or administrative systems to require an ISP to terminate or prevent an infringement. In relation to hosting it is also added that it does not affect the possibility for Member States of establishing procedures governing the removal or disabling of access to information.

Article 15 sums up that in all the aforementioned cases service providers have no obligation to monitor the information which they transmit or store or actively seek facts or circumstances indicating illegal activity. However, Member States may establish obligations on service providers to promptly inform the competent public authorities of alleged illegal activities undertaken or information provided by recipients of their service or obligations to communicate to the competent authorities, at their request, information enabling the identification of recipients of their service with whom they have storage agreements. That means that Member States are prevented from imposing a monitoring obligation on service providers only with respect to obligations of a general nature; this does not concern monitoring obligations in a specific case and, in particular, does not affect orders by national authorities in accordance with national legislation.[16] In addition the Directive does not affect the possibility for Member States of requiring service providers, who host information provided by recipients of their service, to apply

(d) the provider does not interfere with the lawful use of technology, widely recognised and used by industry, to obtain data on the use of the information; and
(e) the provider acts expeditiously to remove or to disable access to the information it has stored upon obtaining actual knowledge of the fact that the information at the initial source of the transmission has been removed from the network, or access to it has been disabled, or that a court or an administrative authority has ordered such removal or disablement.
2. This Article shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement.

[15] 1. Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the information stored at the request of a recipient of the service, on condition that:
(a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or
(b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.
2. Paragraph 1 shall not apply when the recipient of the service is acting under the authority or the control of the provider.
3. This Article shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement, nor does it affect the possibility for Member States of establishing procedures governing the removal or disabling of access to information.

[16] Recital 47 to the E-commerce Directive.

duties of care which can reasonably be expected from them, and which are specified by national law in order to detect and prevent certain types of illegal activities.[17]

Given the fact that ISPs provide to their customers access to the Internet, facilitate the exchange of protected material, host sites and servers and form the only basic and essential facility for any online communication, they can play a useful role in reducing infringements on the Internet regardless of their liability.

The ***right of information*** may also be exercised in order to obtain information by internet service providers with regard to infringements committed on their networks and platforms including the identity of the persons engaging in illegal conduct. This right, however, may clash with privacy laws, i.e. the protection of personal data and the secrecy of communications.[18] There a balance has to be struck between these rights as they both form fundamental rights recognized by the Charter of Fundamental Rights of the European Union.[19] This has also been concluded in two rather recent judgments of the Court of Justice of the European Union, which in fact leave it up to Member States to find the appropriate solutions reflecting this balance.[20] We need, however, to admit that finding a solution is not an easy task since it refers to a politically heated issue, which touches on the sensitivities of all the parties and stakeholders concerned. In addition to that any national solutions chosen so far, such as for example the HADOPI system in France, the UK Digital Economy Act, the Code of Conduct for ISPs in the Netherlands, the Memorandum of Agreements concluded between rightholders and ISPs in Ireland or the recent laws in Italy and Spain have not paid off so far in order for their results to be appreciated in substance.[21] That means that we need to wait a bit longer in order to appreciate the actual results or the beffects of those initiatives.

From the above it is clear that the Enforcement Directive is rather neutral when it comes to the liability of Internet Service Providers.[22] This is not the case with the E-Commerce Directive, which is more specific on this point. ISPs do not have a general monitoring

[17] Recital 48 to the E-commerce Directive.

[18] See for example the 2009 Study on Online Copyright Enforcement and Data Protection in Selected Member States (Hunton & Williams, Brussels, <http://ec.europa.eu/internal_market/iprenforcement/docs/study-online-enforcement_en.pdf>.

[19] Charter of Fundamenta.l Rights of the European Union (2000/C 364/01), OJ C364, 18.12.2000, p. 1.

[20] Judgment of 29 January 2008 in the case C-275/06 Productores de Música de España (Promusicae) v. Telefónica de España SAU; judgment of 19 February 2009 in the case C-557/07 LSG-Gesellschaft zur Wahrnehmung von Leistungschutzrechten GMBH v. Tele2 Telecommunication GMBH. See also the Scarlet case C-70/100 and the Netlog case C-360/10, which are currently pending before the CJEU.

[21] For more national initiatives in this area see the site of the Hellenic Copyright Organisation www.opi.gr.

[22] The issue of liability of ISPs is also discussed at WIPO level since at the end of March 2011 officials agreed to plan a meeting on internet service provider liability < http://www.ip-watch.org/weblog/2011/04/04/wipo-slowly-advances-industrial-design-treaty-eyes-isp-liability-for-trademarks/?utm_source=monthly&utm_medium=email&utm_campaign=alerts>.

obligation but when they gain knowledge of the infringement, duties arise. For this reason there is currently discussion as to which of the two legal instruments is more appropriate for accommodating an effective regime of combating piracy on the Internet and regulating the role of ISPs. Other legal instruments have also been proposed such as the Trade Mark Directive (I believe with little success since their scope is by definition limited).

Another issue is whether one can request information by intermediaries which they are not obliged to retain. There may be cases where the data required has either not been stored or by the time it is requested has been erased either because ISPs have not retained it out of their free will or because they were obliged to erase it by privacy laws. There is European Union legislation which deals with **data retention** (data retention is dealt with at EU level only in the Data Retention Directive[23] and in the e-privacy Directive[24]) and which needs to be seen in conjunction and in conformity with any 'new regime' of enforcement in the area of infringements on the Internet.

One easily notices that the plurality of regulations at EU level on topics which cross each other create on occasions conflicts or clashes which cannot be sorted out easily. One more of them, is the issue of **confidentiality**. Confidentiality covers different information in different Member States. That means two things: First, not all information, which will allow parties to pursue their rights or pursue their rights effectively, can be obtained. Second, even if such information is made available in one Member State this does not means that it can be used with no problems in other Member States. Concrete provisions on information which is or which is not confidential should be provided for in order for infringements to be combated effectively on the Internet throughout the European Union.

C. Collection of evidence and cross-border collection of evidence on the Internet

Cross-border collection of evidence presents a general problem and not one relating only to infringements on the Internet. However, we shall focus on the latter. Given the fact that sites may be established anywhere in the world and operate anywhere in the world, too, cross-border collection of evidence is necessary. This collection does not so much present problems with regard to the particular nature or kind of the information that needs to be gathered (as in other cases where you need for example to specify the exact character,

[23] Directive 2006/24/EC on the retention of data generated or processed in connection with the provision of publicly available electronic communications services or of public communications networks and amending Directive 2002/58/EC, OJ L 105, 13.4.2006, p. 54.

[24] Directive 2002/58/EC of the European Parliament and of the Council of 12 July 2002 concerning the processing of personal data and the protection of privacy in the electronic communications sector (Directive on privacy and electronic communications), OJ L 201, 31.7.2002, p. 37.

location, reference numbers and contents of the requested documents, sometimes even the page numbers of the defendant's commercial records)[25] but rather to the gathering itself from two points of view. First, it is difficult to issue orders for the gathering of evidence abroad. Even if these orders are issued and they do not correspond to a known form of order abroad they cannot be executed. On top of everything even if they correspond to a relevant order abroad it is not certain again that this order will be executed, especially if it is considered to impinge on other rights such as the right of privacy. In cases of infringements on the internet on many cases data is required to prove that infringements are conducted on a commercial scale. Without this data it is difficult to prove the seriousness and extent of the infringement. Second, the evidence that may be collected in these cases (such as screenshots) does not carry a certain weight in all cases. Since screenshots reflect the situation in a particular moment in time they are not always accepted by the courts as full evidence or even if accepted it is in the courts' complete discretion as to how they shall assess it.

Various proposals have been made as to how this situation can be amended. An improvement of the rules on jurisdiction of the courts to issue provisional measures has been proposed as well as the provision of the ability to transform a measure granted by a foreign court into one known in the State where this measure is intended to apply. The free circulation of measures ordered *ex parte* within the European Union has also been proposed. This is also an issue which is examined in the context of the upcoming revision of Council Regulation (EC) No 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels I Regulation).[26]

Article 6(1) seems also to present some problems. According to it *"if the rightholder has presented reasonably accessible evidence sufficient to support his claims and has, in substantiating those claims,* ***specified evidence*** *which lies in the control of the opposing party the competent judicial authority may order that the opposing party produce evidence* ***under its control"***. The two issues which present problems as these problems have been reported by various Member States are the 'specified evidence' and the notion of 'control'. Given the flexibility of the wording, some national courts require very

[25] See *European Commission Staff Working Document, "Analysis of the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States Accompanying document to the Report from the Commission to the Council, the European Parliament and the European Social Committee on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights*" COM(2010) 779 final (Brussels, 22.12.2010 SEC(2010) 1589 final), p. 9.

[26] Also in relation to article 5(3) the question needs to be asked whether the restriction to local damage makes sense in an internet context where infringement of copyright material happens everywhere. The risk of limiting the provision to local damage only may result in endless fragmentation and an inability to enforce rights effectively.

specific and accurate description as to the evidence required. For example, in order for bank accounts to be disclosed data should be made available to the court as to the banks at issue, the numbers of the accounts, the names on the accounts and so on. As it becomes apparent it is not easy for one to submit all this information. On top of it the notion of 'control' is not specified. It is not clear whether it only refers to evidence in the possession of the party that is required to disclose or also to evidence that this person can get hold of after reasonable search. The prevailing view seems to be the first one.

D. Infringements committed on a commercial scale

The notion of commercial scale is another issue which is not properly harmonized in all Member States. A general definition is provided for in Recital 14 of the Directive (according to which "*acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end consumers acting in good faith"*). Some Member States have provided for their own definitions (only few of them),[27] which however differ. Some others have chosen to extend the measures (i.e. allow communication of banking, financial or commercial documents) provided for infringements committed on a commercial scale to other infringements, too. However, Member States do not seem to be positive for having a general harmonized definition of 'commercial scale' given the fact that their national systems have so far dealt with this issue adequately and have developed considerable jurisprudence in this respect.

III.Conclusions

The enforcement Directive seems to have worked well so far with no substantial problems. This is so despite the fact that it constitutes a puzzle of good practices, some of them unknown to some Member States. However, one may argue that the Directive was transposed late into the laws of the Member States and actual practice and case law are not indicative as to what worked well and what did not work well so far. Greece forms a characteristic example in this respect since it is only now that tries to align itself to the

[27] E.g. Germany, Czech Republic, Romania, Slovenia. Italian scholars seem to conclude that "on a commercial scale" means "in the course of trade". The definition is often given by using the notion of "commercial purpose" and defining it as *"purposes aimed at direct or indirect economic or commercial gain"* or similar. Different e.g. Germany for copyright infringements ("number or severity of infringements"). *European Commission Staff Working Document, "Analysis of the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States Accompanying document to the Report from the Commission to the Council, the European Parliament and the European Social Committee on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights*" COM (2010) 779 final (Brussels, 22.12.2010 SEC(2010) 1589 final), p. 9.

Directive's obligations regarding trademarks and patents. Copyright has been aligned properly and within the deadline.

Taking into account the various points that have been raised so far in the Commission's report, none of them seems to carry considerable weight -for the time being- in order for Member States to actually push forward the amendment/updating of the Directive apart from one: the role of intermediaries and in particular internet service providers concerning large scale intellectual property infringements on the Internet. However, a decision has to be made whether the enforcement Directive is the right instrument for accommodating such a provision. One also needs to take into account the fact that this issue is being currently discussed (or tackled) on other levels, too. One forum which currently holds informal discussions of this kind is the World Intellectual Property Organisation.

At European Union level this issue has been indirectly dealt with in the Telecoms package,[28] whilst the e-commerce Directive and the trademark Directive form alternative options. Very recently on 24 May 2011 the European Commission has announced a formal strategy concerning intellectual property rights, which aims at modernising the existing legal framework in which IPRs operate.[29] According to the European

[28] In the Telecoms Package it was decided that no measures restricting end-users' access to the Internet may be taken unless they are appropriate, proportionate and necessary within a democratic society and never without a prior, fair and impartial procedure that includes the right to be heard and respects the presumption of innocence and the right to privacy (Amendment 46 (ex 138) of the Telecom Package, which amends Art. 1 para. 3a) of Directive 2002/22/EC of the European Parliament and of the Council of 7 Mar. 2002 on universal service and users' rights relating to electronic communications networks and services (Universal Service Directive) '3a. Measures taken by Member States regarding end-users' access to or use of services and applications through electronic communications networks shall respect the fundamental rights and freedoms of natural persons, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms and general principles of Community law. Any of these measures regarding end-users' access to or use of service and applications through electronic communications networks liable to restrict those fundamental rights or freedoms may only be imposed if they are appropriate, proportionate and necessary within a democratic society, and their implementation shall be subject to adequate procedural safeguards in conformity with the European Convention for the Protection of Human Rights and Fundamental Freedoms and with general principles of Community law, including effective judicial protection and due process. Accordingly, these measures may only be taken with due respect for the principle of presumption of innocence and the right to privacy. A prior fair and impartial procedure shall be guaranteed, including the right to be heard of the person or persons concerned, subject to the need for appropriate conditions and procedural arrangements in duly substantiated cases of urgency in conformity with European Convention for the Protection of Human Rights and Fundamental Freedoms. The right to an effective and timely judicial review shall be guaranteed'. The Telecom Package: (Directive 2009/140/EC of the European Parliament and of the Council of 25 November 2009 amending Directives 2002/21/EC on a common regulatory framework for electronic communications networks and services, 2002/19/EC on access to, and interconnection of, electronic communications networks and associated facilities, and 2002/20/EC on the authorization of electronic communications networks and services (OJ L 337/37)).

[29] Communication from the commission to the European parliament, the council, the European economic and social committee and the committee of the regions a single market for intellectual property rights

Commission's press release "this will benefit the EU's growth and competitiveness which is delivered through the single market".[30] IP actions and/or concerns are provided for in the Digital Agenda for Europe[31] where seven actions relate directly or indirectly to IP rights (including the revision of the enforcement directive and the e-commerce directive), in Europe 2020 Strategy,[32] in the Annual Growth Survey 2011,[33] in the Single Market Act[34] and in the Innovation Union.[35] It is very likely that the European Union will try to be more concrete in involving ISPs into the combat of piracy on the Internet. This however will be done not by reason of the fact that it believes that ISPs should incur some kind of liability but because there is no other stakeholder that can offer effective services in that particular field. Also any measures taken will be within the liability framework it has provided for ISPs in the e-commerce Directive. In the meantime a number of national initiatives leading to legal or soft law solutions have taken place following the general trend towards the effective protection of rightholders and the limitation of the ISPs' 'asylum'.[36] The fact is that the longer the European Union waits to regulate in this field the harder will be for it to find a solution that will be acceptable to

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boosting creativity and innovation to provide economic growth, high quality jobs and first class products and services in Europe, 24.5.2011, COM(2011) 287 final.

[30] <http://europa.eu/rapid/pressreleasesaction.do?reference=ip/11/630&format=html&aged=0&language=en&guilanguage=en>.

[31] COM (2010) 245.

[32] COM (2010) 2020.

[33] COM (2011) 11.

[34] COM (2011) 206.

[35] COM (2010) 546.

[36] For example the infamous French HADOPI law, which stipulates a graduated punishment mechanism for alleged copyright infringements on the Internet (Law No. 2009-1311 of 28 Oct. 2009 relating to the criminal protection of copyright on the Internet (Official Journal, 29 Oct. 2009)), the UK Digital Economy Act 2010 (http://www.legislation.gov.uk/ukpga/2010/24/contents), the Dutch Notice and Take Down Code of Conduct (In October 2008, the Netherlands designed a 'Notice-and-Take-Down Code of Conduct'. This Code provides for ISP liability especially in cases of hosting services where illegal content is involved and this is brought to the ISP's attention) and so on (Sweden (On 1 Apr. 2009, a new law was adopted in Sweden, which is based on the EU Enforcement Directive. This law allows copyright holders to obtain a court order forcing ISPs to provide the IP addresses identifying which computers have been sharing copyrighted material. See http://news.bbc.co.uk/2/hi/technology/7978853.stm), Germany (German legislation which was passed in the German Parliament on 18 Jun. 2009. This legislation obliges ISPs to filter websites allegedly containing child abuse material. The secret filtering list shall be put together by the German Federal Police and transmitted to ISPs once a day with only occasional checks by a five-member monitoring body), Italy (On 26 January 2010, the Italian Government proposed legislation on the basis of which ISPs shall be responsible for their audiovisual content and liable for copyright infringement by users), Spain (On 8 January 2010, the Spanish Government passed the Law for Sustainable Economy. This Law provides, amongst other issues, for the creation of an Intellectual Property Commission (IPC) which, together with a judge, will deal with complaints concerning alleged illegal downloading. This law will give the authorities the possibility to shut down file-sharing sites within a few days from the date the complaint is filed with IPC. Within four days from such date, the court is to decide whether a certain site is infringing the law or not. See www.edri.org/edrigram/number8.1/spain-law-file-sharing). For more information see the relevant section on the Hellenic Copyright Organisation site www.opi.gr and I. Stamatoudi (ed), Copyright Enforcement and the Internet, Information Law Series (B. Hugenholtz (general editor), Kluwer Law International, 2010.

all Member States given the fact that some of them have already proceeded with their own solutions.