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The Scope of Jurisdiction in Cross-Border Intellectual Property Disputes: Tackling Online Copyright Infringements

Abstract: The aim of this paper is to analyse critically the problems stemming from the current model of enforcing protection in cases of online copyright infringements. The Internet allows for the easy dissemination and exploitation of copyrighted works globally. Remote and immediate access to content may result in simultaneous infringement on a worldwide scale. There is a long history of disputes over the enforcement of protection with regard to online copyright infringement, and while new laws and judgments are passed there are still no effective remedies nor consensus regarding a common approach to the problem of the multiplicity of applicable laws and jurisdictions in the event of infringement – a problem that derives mainly from the principle of the territoriality of intellectual property rights. Throughout the years there have been many attempts to solve it, mostly in the form of soft law instruments. None of the recommendations are binding, therefore the obligation to reconcile the right to the protection of copyright with the limits of the jurisdiction falls on national courts. As a consequence, the current legal status quo does not provide sufficient predictability to the outcome of litigation.

Keywords: enforcement of copyright, extraterritorial scope of remedies, jurisdiction, online copyright infringement

Introduction

The enforcement of protection in cases of digital copyright infringement is a complex issue often addressed by courts in cross-border disputes. New methods of sharing and copying works allow for easy access worldwide, which further contributes to the complexity. Enforcing copyright protection requires establishing which court has jurisdiction over the dispute; the next step is determining the law, or rather

laws, applicable to a particular online copyright infringement.¹ There is also the matter of remedies, namely what remedies may be granted (an issue directly connected with the choice of law) and the territorial scope of those remedies. Should they be restricted to the territory of the forum state, be EU-wide, or maybe have a global effect? Lastly, once the judgment is delivered issues of the recognition and enforcement of foreign judgments remain to be addressed.

The digital single market and the free movement of goods and services are among the priorities set by the EU and other modern economies. Intellectual property plays a key role in the development of the digital single market. Therefore it is of crucial importance to ensure legal certainty in the area of the protection and exploitation of intellectual property (IP) rights. Intellectual property rights are territorial, so accordingly the scope of protection is granted by national laws. The rule of territoriality, while it has a historic and legal foundation in international treaties, is at the same time the source of many problems when it comes to online infringements.² Industrial property rights raise fewer concerns because their protection is directly linked with the state where the particular right was registered. Applying the rule of *lex loci protectionis* in these cases stems from the territoriality principle.

It is more difficult with copyright, due to the minimal standards adopted by most countries on the basis of a system of international agreements.³ A work is protected by copyright from the moment it is created, without the need for registration or further formalities coming from principles of national treatment and the minimal level of protection set forth in the above-mentioned treaties.⁴ Owing to those treaties, the level of harmonisation in IP law is growing and national laws are

1 Connected with the issue of copyright infringement is a problem of the multiplicity of laws that govern the initial ownership rules. For comprehensive analysis see M. van Eechoud, Alternatives to the Lex Protectionis as the Choice-of-Law Rule for Initial Ownership of Copyright, (in:) J. Drexler, A. Kur (eds.), Intellectual Property and Private International Law. Heading for the Future, Oxford 2005, pp. 289–306.

2 Despite increasing harmonisation of national laws in respect of copyright, national courts approach similar problems differently, e.g. in the case of the scope of economic rights (see K. Klafkowska-Waśniowska, Zamieszczanie odesłań internetowych a zakres autorskich praw majątkowych, 'Białostockie Studia Prawnicze' 2015, vol. 19, pp. 51–62) or the criteria of protection for selected copyrighted works (see I. Matusiak, Konsekwencje (braku) zmian przepisów prawa autorskiego a status prawny gier komputerowych, "Białostockie Studia Prawnicze" 2015, vol. 19, pp. 63–76).

3 Among them the Berne Convention for the Protection of Literary and Artistic Works (1886), the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, the Geneva Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms, the Beijing Treaty on Audiovisual Performances, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) or the World Intellectual Property Organization (WIPO) Copyright Treaty.

4 However, the scope of protection, limitation periods, remedies available in the event of a breach and other requirements are subject to national laws.

converging, but still, the territorial character of IP rights prevails. In EU law, industrial property rights are mostly harmonised; trademark law and design law may serve as the best examples. Copyright is not completely unified but is heading in that direction with 13 directives and two regulations dedicated to copyright.⁵ However, copyright legislation refers primarily to substantive law. As a result, there is little harmonisation when it comes to rules governing the jurisdiction and choice of law regarding intellectual property rights, which remain a bone of contention among stakeholders to new treaties.

This paper is focused on a selected part of enforcement mechanisms, mainly the jurisdiction in cross-border disputes regarding copyright infringement via the Internet. Since some of the infringements will qualify for criminal and/or civil liability, the analysis is limited to the civil enforcement mechanism covered by private international law (PIL). The main objective of the paper is to analyse the problems stemming from the current model of enforcement of online copyright infringements. In order to achieve this, the methodology used was descriptive research based on the analysis of case law and literature. The paper's theoretical framework is based mainly on EU law. It provides an overview of the problems that copyright holders face while enforcing protection of their works shared online.

The debate on the applicable rules of conflict regarding online copyright infringement is decades old. In the meantime there have been many attempts to provide some guidelines for cross-border copyright disputes. In the absence of uniform conflict-of-law rules in private international law concerning intellectual property rights, it is up to national courts to decide on the validity of the claim and the scope of protection. What are the consequences of such a framework for the copyright holder and the alleged infringer? Parties are faced with the prospect of a piecemeal approach to litigation due to the rule of territoriality, which limits the jurisdiction and results in its fragmentation. On the one hand, the existing model leaves open the possibility of 'forum shopping', to the detriment of the defendant and other users of the copyrighted work. On the other hand, narrow jurisdictional claims do not provide sufficient measures for claimants (especially small claimants who are natural persons) to stop the infringement. This paper contributes to the discussion, advocating for the need to introduce new rules and for further changes to be made to the existing model.

This section is followed by an overview of relevant case law, selected issues concerning remedies, the recognition and enforcement of IP judgments, and conclusions.

5 For a list of copyright legislation, see <https://digital-strategy.ec.europa.eu/en/policies/copyright-legislation> (12.12.2021).

1. The Scope of Jurisdiction

Digital copyright in most cases is ubiquitous and universal. In the online environment, borders and territoriality concerns seem to vanish. The reason for this is immediate and easy access to infringing content. If copyrighted work is available online, infringement might automatically cause harm in numerous places. There are certain forms of limiting access to copyrighted work; examples would be geo-blocking and similar targeted measures which are included in injunctions ordered by courts in IP rights disputes. The remedies most frequently used involve IP address blocking, Domain Name System (DNS) website blocking, Uniform Resource Locator (URL) filtering and other related blocking mechanisms.⁶ Grounds for the use of other measures designed to provide protection of copyright are included in the open catalogue of 'technical measures' defined in Article 6(3) Directive 2001/29 / EC.⁷ However, geo-blocking tools are not the best solution, especially as they are easy to circumvent with existing technical means, even though such circumvention constitutes infringement.⁸ Furthermore, it refers only to measures that aim to protect specific copyright, rather than measures that only prevent users from accessing the work from different locations.⁹ Also, seamless access to online content is stressed in the EU as one of the key goals, in the long run, of the Digital Single Market Strategy,¹⁰ therefore applied measures should be specifically designed to protect particular copyrights – not to mention that geo-blocking in certain circumstances gives grounds for anti-trust concerns.¹¹

6 EUIPO, Study on Dynamic Blocking Injunctions in the European Union, https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/reports/2021_Dynamic_Blocking_Injunctions/2021_Study_on_Dynamic_Blocking_Injunctions_in_the_European_Union_FullR_en.pdf (12.12.2021), p. 49.

7 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 (O.J. 2001 L 167, 22.06.2001, pp. 10–19).

8 R. Polčák, Territoriality of Copyright Law, (in:) P. Szczepanik, P. Zahrádka, J. Macek and P. Stepan (eds.), *Digital Peripheries. The Online Circulation of Audiovisual Content from the Small Market Perspective*, New York 2020, pp. 70–71.

9 *Ibidem*, p. 71.

10 Mostly as a part of the Digital Single Market Strategy for Europe. See Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions: *A Digital Single Market Strategy for Europe*, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A52015DC0192> (12.12.2021).

11 Regulation (EU) No. 2018/302 of the European Parliament and of the Council of 28 February 2018 on addressing unjustified geo-blocking and other forms of discrimination based on customers' nationality, place of residence or place of establishment within the internal market, and amending Regulations (EC) No. 2006/2004, (EU) No. 2017/2394 and Directive 2009/22/EC (O.J. L 60I, 02.03.2018, pp. 1–15). However, the regulation excludes two categories, i.e. audiovisual products and content subject to copyright, from its scope of application.

The progressive approximation of national laws and minimal standards set by international treaties, as was mentioned before, do not eliminate the necessity of introducing rules of conflict in cases of cross-border infringements. In the EU some guidance is provided by the Rome I regulation,¹² the Rome II regulation¹³ and the Brussels Ia regulation.¹⁴ Jointly, they introduce general rules regarding jurisdiction, applicable law, and the recognition and enforcement of judgments.¹⁵

Crucial for establishing jurisdiction in the EU is Article 7(2) of the Brussels Ia regulation which provides that in matters relating to tort, delict or quasi-delict, a person domiciled in another Member State may be sued in the courts of the place where the harmful event occurred or may occur. The CJEU in its case law has stated that the regulation covers ‘both the place where the damage occurred and the place of the event giving rise to it’.¹⁶

Conflict-of-law rules can also be found in provisions of national laws regarding private international law. National rules may differ from the rules provided by EU law, but provisions of national laws cannot go beyond EU regulations. The rules of conflict of law help determine the connecting factors in IP disputes for the purpose of jurisdiction and choice of law. The problematic elements include, among others, a different place of residence of both parties, distinguishing the place where the harmful event occurred, the location of the infringing activity, and estimating the damage caused. The source of the infringement will also imply specific rules, e.g. whether it is a breach of contractual or non-contractual obligations. A lot will depend on how the copyright holder formulates the claim, and whether it will be a claim of infringement of moral rights or economic rights. The Rome II regulation, in Article 8, refers to the rule of territoriality with regard to the choice of law for economic rights. The same applies when it comes to the scope of jurisdiction based on the Brussels Ia regulation, because protection of economic rights is granted for the territory of a specific Member State. The court will usually decide whether it has judicial competence over the dispute based on where the damage has occurred or whether the infringing content was accessible within the territory of a specific Member State. This, however, may differ in the case of infringements of moral rights. Due to their nature, which greatly resemble personality rights, it was discussed that is possible that the

12 Regulation (EC) No. 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (O.J. 2008 L 177/6).

13 Regulation (EC) No. 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (O.J. 2007 L 199/40).

14 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 (O.J. 2012 L 351/1).

15 For an overview of regulations and other international conventions, see A. Kur, U. Maunsbach, Choice of Law and Intellectual Property Rights, “Oslo Law Review” 2019, vol. 6, no. 1, pp. 44–61.

16 Judgment of 03.10.2013, Pinckney (C 170/12), ECLI:EU:C:2013:635, para. 26.

court of the Member State where the victim is domiciled might have jurisdiction over the whole dispute and issue injunctions with effects beyond the territory of the forum Member State.¹⁷ Through the years, the CJEU has provided interpretation of the relevant provisions of the Brussels Ia regulation relating to online copyright disputes.

It would be an oversimplification to state that when infringing content is put online the effects and damage caused by the infringing activity takes place simultaneously in every country based solely on the fact that the content can be accessed there. Furthermore, it leads to the assumption that every country with access to infringing content potentially has jurisdiction over the dispute. However, for practical reasons, it is highly doubtful that the rightholder would file a claim in every country which grants protection for the work (with digital copyright, it would easily translate into most of the countries in the world). Hence the underlying need to delimit and determine the connecting factor for jurisdiction in cross-border disputes: whether it will be the country of the victim's centre of interest or the country where damage occurred (where the content was accessible), as opposed to the general rule of jurisdiction based on the defendant's domicile. The former, namely the doctrine of 'centre of interest', was used in cases of the infringement of personality rights on the Internet. It favours the interests of the rightholder, particularly if it coincides with their place of residence. This approach was adopted by the CJEU in the landmark cases of *eDate Advertising*¹⁸ and *Bolagsupplysningen*.¹⁹ Both cases dealt with defamatory content put online, the first regarding a natural person claiming infringement of personality rights, in the second the plaintiff being a legal person. In both cases the court located the damage caused by the infringement in the Member State of the victim's centre of interest.²⁰ In the case of *Bolagsupplysningen*, the court also specified that the action for the rectification or removal of the infringing content without territorial delimitation can 'only be made before a court with jurisdiction to rule on the entirety of an application for compensation for damage', that is, the court of the Member State in which the victim's centre of interests is located.²¹ The sole jurisdiction of a court of a Member State in respect of all the damage caused by defamatory content placed on-

17 See L. Lundstedt, *Putting Right Holders in the Centre: Bolagsupplysningen and Ilsjan (C-194/16): What Does It Mean for International Jurisdiction over Transborder Intellectual Property Infringement Disputes?* "IIC – International Review of Intellectual Property and Competition Law" 2018, vol. 49, pp. 1022–1047. The analysis was based on judgment in personality rights but the author conducted analysis which concluded that the same reasoning may be applied to moral rights in copyright.

18 Judgment of 25.10.2011 on the case of *eDate Advertising and others (C 509/09 and C 161/10)*, ECLI:EU:C:2011:685.

19 Judgment of 17.10.2017 on the case of *Bolagsupplysningen OÜ, Ingrid Ilsjan v. Svensk Handel AB (C 194/16)*, ECLI:EU:C:2017:766.

20 *eDate*, *op. cit.*, para. 52; *Bolagsupplysningen*, *op. cit.*, para. 44.

21 *Ibidem*, para 48.

line was later confirmed by Advocate General (AG) Wathelet, in his opinion in case C 618/15.²²

It is justified to apply the argumentation of the CJEU regarding the attribution of sole jurisdiction, based on the ‘centre of interest’ doctrine in personality rights cases, to moral rights violations.²³ However, the court also stated that courts of Member States in which infringing content is accessible have jurisdiction only in respect of the damage caused in the territory of that Member State. Following that reasoning, it means that the jurisdiction of those courts is limited to deciding about damages and issuing injunctions with effect only in their respective territories.

These conclusions correspond to cases of the online copyright infringement of economic rights. The CJEU distinguishes in its case law between infringements of personality rights and infringement of copyright (as well as industrial property rights), claiming that only in the former case may a rightholder ‘choose to bring an action in one forum in respect of all of the damage caused.’²⁴ Since economic rights are subjected to the principle of territoriality, the protection granted by each Member State is limited to its territory. As a result, the court noted that the doctrine of ‘centre of interest’ cannot be applied in those circumstances. Following that reasoning, the court of the Member State has jurisdiction only to rule on the damage caused in the territory of the Member State where it is situated.²⁵

Consequently, it will all boil down to the identification of the place where the alleged damage occurred, or may occur in the case of online copyright infringement. As was already stated, the CJEU stresses that the place where the harmful event occurred covers both the place where the damage occurred and the place of the event giving rise to it. Further analysis of the case law of the CJEU might provide some clarification as to where the damage might be located. The CJEU noted that the causal event is not crucial for the purpose of attributing jurisdiction due to the nature of infringement.²⁶ Damage can occur only in a Member State where a particular right is protected.²⁷ Another connecting factor is the accessibility of the infringing content, which designates the territorial jurisdiction of Member States’ courts. In principle, damage is caused in every place where content is available via the Internet,²⁸ which

22 Opinion of Advocate General Wathelet of 09.11.2016, *Concurrence Sàrl v. Samsung Electronics France SAS and Amazon Services Europe Sàrl* (C 618/15), ECLI:EU:C:2016:843, para. 85–86.

23 L. Lundstedt, *Putting Right Holders*, *op. cit.*, pp. 1033–1039.

24 Pinckney, *op. cit.*, para. 36.

25 *Ibidem*, para. 45; Judgment of 03.04.2014 on the case of *Hi Hotel HCF Sàrl v. Uwe Spoering* (C 387/12), ECLI:EU:C:2014:215, para. 40.

26 Judgment of 22.01.2015 on the case of *Pez Hejduk v. EnergieAgentur* (C 441/13), ECLI:EU:C:2015:28, para. 23–26.

27 Pinckney, *op. cit.*, para. 33; later confirmed in Hejduk, *op. cit.*, para. 29; *Concurrence Sàrl*, *op. cit.*, para. 30–31.

28 *Ibidem*, para. 56.

clearly may encompass most of the world. In order to limit the jurisdiction, AG Wa-thelet, in his opinion to case C 618/15, noted that damage will usually take the form of financial loss, and ‘with respect to copyrights, the financial loss is usually sustained where copies of the infringing material are sold or issued to the public.’²⁹

The existing model of enforcement allows the rightholder to pursue a claim in every state where copyrighted work was accessible online and where according to national law its unlawful use constitutes an infringement. Such a situation contributes to ‘forum shopping’ and encourages the rightholder to cherry-pick jurisdictions offering the most favourable conditions regarding available remedies, rules of evidence, etc. – though it is not likely that claimants will abuse that possibility.³⁰ On the contrary, where infringing content is put online and at the same time copyrighted work is protected in all countries where it is accessible, seeking an injunction or damages in every state where harm was caused will prove to be burdensome and excessively difficult for the rightholder, as well as for the defendant.

2. Remedies

There is less uncertainty regarding the territorial scope of jurisdiction in cases of online copyright infringement compared to the issue of choosing between multiple jurisdictions, which stems from the territoriality of those rights and the approach to the choice of jurisdiction based on where the harmful event occurred or may occur (the CJEU has confirmed that the connecting factor is accessibility to infringing content). There have been no groundbreaking changes in the established case law of the CJEU concerning jurisdiction in recent years. In fact, the most dynamic developing field in the enforcement of IP rights are remedies specific to the location of the infringement, the Internet, mostly in the form of new injunctions of a technical nature aimed at blocking copyrighted content. These include injunctions obliging Internet intermediaries to apply measures disabling access to specific content and other mechanisms allowing for targeted action such as geo-blocking tools. A study on Dynamic Blocking Injunctions in the European Union prepared by EUIPO shows that copyright infringements are the main focus of these measures in the EU.³¹ Not surprisingly this area of enforcement is similarly marked by several uncertainties, particularly regarding the territorial scope of the remedies but also the lack of uniformity between types of remedies available under national laws.

According to general rules, a court which has jurisdiction over a dispute is competent to order measures aimed at terminating the infringement. Applied measures involve injunctions intended to prevent or stop the infringement and measures se-

29 *Ibidem*, para. 58.

30 A. Kur and U. Maunsbach, Choice of Law, *op. cit.*

31 EUIPO, Study on Dynamic Blocking Injunctions, *op. cit.*, p. 60.

curing compensation. Drawing on the case law of the CJEU, a Member State's court may apply measures only with respect to the infringing act (and the damage caused by it) having effects within the territory of that Member State.

The possible extraterritorial effect of remedies was analysed in cases dealing with personality rights.³² The court noted that currently, EU law does not contain 'any limitation, including a territorial limitation, on the scope of the measures which Member States are entitled to adopt',³³ therefore it does not preclude those 'measures from producing effects worldwide'.³⁴ In the opinion to case C 18/18, AG Szpunar expressed the same opinion in relation to defamatory content, stating that a 'court of a Member State may, as a general rule, adjudicate on the removal of content outside the territory of that Member State, as the territorial extent of its jurisdiction is universal',³⁵ also adding that 'a court of a Member State may be prevented from adjudicating on a removal worldwide not because of a question of jurisdiction but, possibly, because of a question of substance'. Therefore, concerns may arise where a worldwide injunction for infringement of rights is issued and third states do not consider the infringing act a violation of their laws.

It is up to Member States' courts to take necessary measures and make sure they are consistent with international law. AG Szpunar also recommended that "it follows from the foregoing considerations that the court of a Member State may, in theory, adjudicate on the removal worldwide of information disseminated via the internet. However, owing to the differences between, on the one hand, national laws and, on the other, the protection of the private life and personality rights provided for in those laws, and in order to respect the widely recognised fundamental rights, such a court must, rather, adopt an approach of self-limitation. Therefore, in the interest of international comity (...) that course should, as far as possible, limit the extraterritorial effects of its junctions concerning harm to private life and personality rights. The implementation of a removal obligation should not go beyond what is necessary to achieve the protection of the injured person".³⁶ Consequently, courts of Member States face the challenge of implementing measures that achieve its goal and are proportionate with regard to fundamental rights and international rules. It might be observed that the CJEU shifts the burden and leaves it up to national courts to make a final decision on the territorial scope of imposed measures and the scope of exercised jurisdiction.

32 Judgment of 24.09.2019 on the case of Google LLC v. Commission nationale de l'informatique et des libertés (CNIL) (C 507/17), ECLI:EU:C:2019:772; Judgment of 03.12.2019 on the case of Eva Glawischnig-Piesczek v. Facebook Ireland Limited (C 18/18), ECLI:EU:C:2019:821.

33 *Ibidem*, para. 49.

34 *Ibidem*, para. 50.

35 Opinion of AG Szpunar of 04.06.2019 on the case of Eva Glawischnig-Piesczek, *op. cit.*, para. 86.

36 *Ibidem*, para. 100.

Though the conclusions on the extraterritorial scope of injunctions presented in the case law refer to personality rights, it seems that the reasoning behind them could be, at least partially, applied to copyright. Despite the fact that courts of Member States are allowed to order cross-border measures in certain circumstances, the question of the enforceability of such measures remains, which is the issue discussed in the next paragraph.

3. Recognition and Enforcement of IP Judgments

Regardless of the fact that the court of a Member State might have a wide jurisdiction or may even rule on the entire dispute and issue an injunction with extraterritorial effects, if it is not recognised or enforced in third states the problem remains. Recently, a new legal instrument was adopted, the Convention on the Recognition and Enforcement of Foreign Judgments in Civil or Commercial Matters, the so-called Hague Judgments Convention, which has not yet entered into force.³⁷ During the work on the convention no consensus could be reached by the delegates, which further shows the scale of the problem in relation to IP rights.³⁸ Therefore, there are no specific rules regarding IP in the Hague Judgments Convention, even though work on the convention started over a dozen years ago.

The recognition and enforcement of cross-border IP judgments might be quite a complex issue. Within the EU it is slightly easier because of the process of harmonisation and CJEU case law. Chapter III of the Brussels Ia regulation specifies that judgments in civil and commercial matters given in Member States are generally recognised and enforced without special procedures, unless the judgment qualifies for refusal under Article 45 of Brussels Ia. Accordingly, the recognition and enforcement of a judgment shall be refused only in cases where 1) such recognition is manifestly contrary to public policy in the Member State addressed, 2) judgment was given in default of appearance, if the defendant was not duly served when the proceedings were instituted, 3) it is irreconcilable with a judgment given between the same parties in the Member State addressed, and 4) it is irreconcilable with an earlier judgment given in another Member State or in a third state involving the same cause of action and between the same parties, provided that the earlier judgment fulfils the conditions necessary for its recognition in the Member State addressed.

37 Convention of 2 July 2019 on the Recognition and Enforcement of Foreign Judgments in Civil or Commercial Matters (not yet in force), <https://www.hcch.net/en/instruments/conventions/full-text/?cid=137> (12.12.2021).

38 See L. Lundstedt, *The Newly Adopted Hague Judgments Convention: A Missed Opportunity for Intellectual Property*, 'IIC – International Review of Intellectual Property and Competition Law' 2019, vol. 50, pp. 933–936.

When it comes to enforcement of cross-border remedies in the EU, again the Brussels Ia regulation provides some guidance: it states the general rule that injunctions ordered by courts of Member States are enforceable within the EU. Remedies ordered by courts from non-EU countries are not subjected to this presumption, therefore they are not usually enforceable in Member States.³⁹

Conclusions

The issue of jurisdiction in cases of online infringement was a subject of many articles pointing to different problems in the interface between IP law and PIL. This remains problematic, and many doubts and questions are still unresolved. On the EU level, the continuing process of harmonisation allows for a partial convergence of national laws and PIL rules but does not provide sufficient predictability. Also, the case law regarding the scope of jurisdiction in cross-border copyright disputes is scarce.

The CJEU stated that EU law does not preclude a court of a Member State from imposing worldwide measures. It has broad discretion to apply necessary measures, which include extending the territorial scope of the injunction, but only in exceptional circumstances. A similar approach would certainly benefit parties in cross-border copyright disputes. Within the EU legal framework, jurisdiction in cases of online copyright infringement is based on the test for the location of harm caused by the online infringement, which can be derived from the case law of the CJEU. Hence, the accessibility of copyrighted content may be sufficient to establish jurisdiction in online copyright infringement cases. The underlying problem of the test is that it results in a multiplicity of eligible jurisdictions. Taking into account infringement of a ubiquitous nature, and seeking injunction in each and every country where content is accessible, would be excessive. Problems with enforcement might deter some right-holders from enforcing protection, due to the resources needed (expenses, time, etc.) to pursue the claim in multiple jurisdictions and the uncertain outcome of the litigation.

There is no unanimity as to how to approach the issue at hand; rather the core of the problem is tiptoed around. National courts are generally cautious in their judgments, though there are cases where national courts refer in their judgments to similar cases in other jurisdictions. This is still not a common practice, but some trends might be observed.⁴⁰ The study prepared by EUIPO also points to the same conclusion, calling the phenomenon ‘legal entanglements.’⁴¹ Another tendency that can be

39 EUIPO, Study on Dynamic Blocking Injunctions, *op. cit.*, p. 46.

40 G. Frosio, Enforcement of European Rights on a Global Scale, (in:) E. Rosati (ed.), Handbook of European Copyright Law, London 2021, pp. 413–440.

41 EUIPO, Study on Dynamic Blocking Injunctions, *op. cit.*, p. 57–58.

observed refers to the biggest online platforms, which have introduced private systems devoted to tackling copyright infringement.

Numerous soft law initiatives relating to cross-border IP rights enforcement have proposed possible solutions in the form of a complete set of new rules or guidelines on the existing framework. The main instruments include Principles for Conflict of Laws in Intellectual Property (CLIP) by the European Max Planck Group,⁴² Intellectual Property Principles Governing Jurisdiction in Intellectual Property by the American Law Institute (ALI), the Hague Conference (HCCH) principles,⁴³ the initiative of members of the Private International Law Association of the republics of Korea and Japan, Guidelines on Intellectual Property and Private International Law ('Kyoto Guidelines') by the International Law Association,⁴⁴ the World Intellectual Property Organization (WIPO) guidelines,⁴⁵ and other private proposals referring strictly to IP rights, aimed at tackling the fragmentation of jurisdiction.⁴⁶ However, as time goes on, there is no consensus nor changes on the horizon in the near future. This only further stresses the need to take action toward limiting the problems arising from the enforcement of protection in relation to online copyright infringement, such as the multiplicity of jurisdictions. A set of clear rules that would provide an alternative to current conflicting principles is desired.

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46 For a specific proposition of a set of new rules see O. Feraci, Digital Rights and Jurisdiction: The European Approach to Online Defamation and IPRs Infringements, (in:) E. Carpanelli, N. Lazzerini, *Use and Misuse of New Technologies. Contemporary Challenges in International and European Law*, New York 2019, pp. 299–302; M. Świerczyński, Intellectual Property and Private International Law: High Time for a Dedicated EU Rome IP Regulation? "Zeszyty Naukowe Uniwersytetu Jagiellońskiego" 2016 vol. 132, pp. 176–186.

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