



CIVIL ENFORCEMENT OF COPYRIGHTS
AN ANTHOLOGY FOR IP PRACTITIONERS

(ENFORCEMENT SUB-COMMITTEE)

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Disclaimer

All information provided by the International Trademark Association in this document is provided to the public as a source an expansion of a previously performed copyright civil enforcement survey, no publication, whether in written or electronic form, can take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of the relevant country. While efforts have been made to ensure the accuracy of the information in this document, it should not be treated as the basis for formulating business decisions without professional advice. We emphasize that intellectual property laws vary from country to country, and between jurisdictions within some countries. The information included in this document will not be relevant or accurate for all countries or states.

Executive Summary

After completing a broad criminal copyright enforcement survey that covered a total of forty-four countries, the Enforcement Subcommittee of the Copyright Committee, working from a questionnaire created during the prior term, expanded on the copyright civil enforcement survey. Commenced during that term to complete this revised and expanded edition.

The survey now includes thirty-two jurisdictions from five regions: seven in the Americas (Argentina, Brazil, Canada, Chile, Costa Rica, Peru, and the United States), eleven in Europe (England and Wales, France, Greece, Italy, Poland, Portugal, Russia, Spain, Sweden, Switzerland and Ukraine), nine in Asia (China, India, Japan, Macau, Malaysia, Philippines, Singapore, Taiwan and Vietnam), two in Oceania (Australia and New Zealand) and three in the Middle East (Israel, Saudi Arabia and United Arab Emirates).

All of those countries ratified or acceded to the Berne Convention for the Protection of Literary and Artistic Works. As a result, there are a number of similarities in their approaches to enforcement, albeit with some differences.

One notable observation is that, in all countries except for the United States, registration is not a prerequisite to initiate any copyright enforcement action. Following its accession to the Berne Convention in 1989, the United States has permitted enforcement without registration—with the exception of any work falling within the statutory definition of a “United States work.” For any such work, registration (and not merely the filing of an application) remains a prerequisite for the initiation of an enforcement proceeding.

This survey also reveals that, in most profiled countries, courts have the discretion in awarding the *quantum* of damages regardless whether the plaintiff had claimed statutory damages or not. Typically, there is both a minimum and a maximum threshold for statutory damages, which can be awarded in Canada, China, Singapore and United States. In Brazil, Poland, and United Arab Emirates, it is common for the court to appoint an expert to determine suitable compensation.

In this survey, IP practitioners can find useful information on requirements for obtaining copyright protection, standing to initiate a civil case, available remedies and much more.

Please note that the information contained in this survey is intended solely as a preliminary guide to assess possible strategies for civil copyright enforcement. It should not be relied upon as legal advice or counsel of any kind. Because laws and their interpretation are always changing, the accuracy of the survey cannot be guaranteed at any given time.

Members of the Enforcement Committee and corresponding counsel from around the world have kindly participated in the creation and revision of this survey, and they all have our gratitude. We would especially like to offer our great thanks to Lorne M. Lipkus, who edited the first edition of the survey and, for this revised edition, the members of the 2022-2023 civil enforcement survey task force: Carlos Simões (editor), Rodrigo Carneiro, Wency Yu and Awanika Anand.

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Argentina

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1. What "works" are subject to copyright (List in alphabetical order)?

Section 1 of the Argentine Copyright Law sets forth the various works protected by the statute including the following:

- Architectural works
- Artistic works
- Cinematographic works
- Choreographic works
- Computer program
- Databases
- Derivative works, new versions, compilations and translations.
- Drawings, paintings and sculptural works.
- Engravings
- Literary works
- Maps, plans and other printed matter.
- Musical works and plays.
- Pantomime works.
- Photographs
- Phonograms
- Plastic works
- Scientific works
- Titles and characters forming an integral part of a work.
- Works of applied art.
- Writings (dictionaries, books, almanacs and articles):.

2. Is there an exhaustive list of copyrightable works?

There is no exhaustive list of copyrightable works in the Argentine Copyright Law. In fact, the end of the above-mentioned section 1 reads as follows:

“For the purposes of the present law, scientific, literary and artistic works comprise ... in conclusion, any scientific, literary, artistic and didactic production, whatever the process whereby it is reproduced.”

The expression “in conclusion” at the end of the final part of this first paragraph shows that this is not a closed list.

3. If no exhaustive list, outline requirements for obtaining copyright protection?

The Argentine copyright does not expressly set forth the specific requirements needed to attain legal protection. Nonetheless, from the basic principles implicit in the statute and its various

provisions it is possible to infer that works have to be original and expressed by any means or fixed in any medium, tangible or intangible.

4. Is copyright registration required to initiate a civil case?

No copyright registration is required to initiate a civil case. Any kind of evidence that demonstrates the authorship of the intellectual work that is being infringed is admitted by courts. However, Section 63 of the Copyright Law states that lack of copyright registration within three months from publication of a work results in the suspension of the author's economic rights over that work and there have been courts who applied this criterion, particularly, in connection literary works.

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A

6. What types of infringement can be used to initiate a civil case?

Any unauthorized usage of the work, by any means, can be used to initiate a civil case, unless it falls within one of the exceptions established by the Argentine Copyright Law.

The Copyright Law grants authors reproduction rights, performing rights, adaptation rights, translation rights and moral rights. The violation of any of such rights constitutes a copyright infringement.

7. Who has standing to initiate a civil case?

- Copyright holders
- Licensees if authorized to pursue such action
- Collective management societies of author rights and related rights
- As regards works in the public domain, any Argentine citizen has standing to file a complaint before the Argentine Copyright Authority in relation to mutilations through additions, transpositions, mistranslations, errors of concept and deficiencies. In addition, such actions can be initiated ex officio.

8. Do multiple authors all have to join the lawsuit?

There is no such requirement. Each coauthor may, individually defend his own rights against third parties without the acquiescence of others.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

The Argentine courts have jurisdiction over nonresident counterfeiters who commit an infringement within the national territory or whose acts produce effects in the territory.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- Temporary and Permanent injunction:
- Damages (economic and noneconomic damages)
- Delivery up or destruction of infringing goods
- Publication of the court decision
- Attorneys' fees and litigation costs

12. Damages/Profits: If available, how do the courts measure damages?

Section 165 of the Code of Civil and Commercial Procedure allows judges to reasonably determine the amount of damages when they are legally established but not accurately quantified. In such cases, damages are assessed by resorting to various parameters depending on the circumstances of the case and may include the following:

- Profits either lost by the copyright holder or obtained by the infringer.
- Lost chance.
- Copyright owner expenses resulting from the infringement.
- Moral damages

There are no punitive damages.

13. Damages/Profits: Are there legal minimums and maximums to damages?

There are no legal minimums and maximums damages. Damages awards depend on the courts' criteria and vary on a case-by-case basis.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Courts may determine the destruction of goods seized.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

There are no specialized courts to adjudicate copyright infringement cases. Copyright cases are heard and enforced before ordinary civil or criminal courts.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The Civil and Commercial Code provides for a 5-year-term statute of limitations for civil actions.

17. Key Challenges of Civil Action

Although a registration is not required to claim and enforce copyright protection, the copyright owner is encouraged to maintain sufficient evidence of the authorship to avoid any dispute on the copyright ownership in a potential court action.

18. Key Benefits of Civil Action

Civil actions allow copyright owners to obtain enforceable judgments, which affirm their ownership over a work and to obtain the withdrawal and destruction of the infringing goods. They also allow the plaintiff to obtain enforceable decisions for compensation.

Australia

Contributor: Gina Tresidder, *Russell Kennedy Lawyers*

1. What ‘Works’ are subject to Copyright?

Copyright protection arises in two separate categories of material; ‘works’ and ‘subject matter other than works’.

Works may be of literary, dramatic, musical or artistic form. Subject matter other than works exhaustively include sound recordings, cinematograph films, television broadcasts, sound broadcasts and published editions of literary, dramatic, musical or artistic works.

2. Is there an exhaustive list of Copyrightable works?

Yes. In alphabetical order, copyright legislation exhaustively protects the following works and subject matter:

- Artistic works;
- Cinematographic films;
- Dramatic works;
- Literary works;
- Musical works;
- Published editions of artistic works;
- Published editions of dramatic works;
- Published editions of literary works;
- Published editions of musical works;
- Sound broadcasts;
- Sound recordings; and
- Television broadcasts.

Computer programs are protected by copyright as a “literary work”, in the same way as books or poems.

No specific law exists in Australia protecting databases. As with computer programs, databases may be protected by copyright law as a “literary work”, noting that the definition of “literary work” includes “a table, or compilation, expressed in words, figures or symbols”. However, in order to be protected by copyright, a database will need to meet the other general requirements for the protection of works, including that a human author be involved in reducing the database to material form, and that there be some intellectual effort in the creation of that material form. This significantly limits the protection afforded to databases under Australian copyright law. Copyright protection does not apply to material outside the scope of these categories.

3. If no Exhaustive List, outline requirements for obtaining Copyright protection.

Australian law sets out an exhaustive list of copyrightable works and subject matter as set out above.

However, works and subject matter that fall within one of these categories must also satisfy various requirements for copyright protection to apply.

The general requirements for the protection of works are as follows:

- The works must be ‘original’;
- The works must be in material form;
- Copyright must not have expired; and
- The author must have been a ‘qualified person’ (an Australian citizen or resident) at the time the work was made. (See below regarding foreign works.)

In addition to these requirements, a published copyrightable work must have first been published in Australia.

The general requirements for the protection of subject matter other than works are as follows:

- The subject matter must be in material form;
- Copyright must not have expired; and
- The maker must have been a ‘qualified person’ (an Australian citizen or resident, or an incorporated body corporate) at the time of the making, or the material must have been made in Australia, or if published, the material must have been first published in Australia. (See below regarding foreign subject matter.)

Separately, copyright protection only applies to television and sound broadcasts made in Australia under a licence or made by federal government broadcasters.

Regarding foreign works and subject matter, the Copyright (International Protection) Regulations 1969 (Cth) give effect to Australia’s obligations under various copyright Conventions to which it is a party. The Regulations expand protection of the Copyright Act 1968 (Cth) to foreign works and subject matter that originate in another Convention country. Material originating in non-Convention countries may also be protected provided the country has reciprocal arrangements to protect Australian copyright material.

4. Is Copyright registration required to initiate a Civil case?

There is no system for registration under Australian copyright law. Instead, copyright arises automatically upon the creation of copyrightable material subject to satisfying any applicable requirements outlined above.

5. Are there any exceptions to the registration requirement to initiate a Civil case?

There is no system for registration under Australian copyright law.

6. What types of infringement can be used to initiate a Civil case?

There are three main types of infringement:

- **Direct infringement** – a person may infringe copyright by doing any act comprised in the copyright without authorisation of the copyright owner.
- **Indirect infringement** – a person may infringe copyright by engaging in certain commercial dealings, including unauthorised import, sale or hire, of articles where the person knew or ought reasonably to have known that the making or importing of the article infringed copyright.
- **Authorising infringement** – a person may also infringe copyright by authorising, sanctioning or approving an act that infringes copyright.

7. Who has standing to initiate a Civil case?

Only the owner or exclusive licensee of the copyright can bring a civil action for infringement of copyright.

8. Do Multiple Authors all have to Join the Lawsuit?

As noted above, only the owner or exclusive licensee of the copyright can bring a civil action for infringement of copyright.

However, assuming that multiple authors of a particular work are also joint owners then the answer is ‘no’, a joint owner of copyright may bring an infringement action without joining the co-owners. Formally, a joint owner who does not consent to being joined as an applicant must be made a respondent to the proceeding but does not play any practical role in the proceeding.

9. Is there Prosecution for Copyright Infringement in the Digital Medium/Electronic Medium/Mobile Network/Internet?

Yes. The general copyright legal provisions apply to infringement in digital media, electronic media, mobile networks and the Internet.

There are specific provisions in the Copyright Act that prohibit the circumvention of “technological protection measures” designed to prevent the infringement of copyright in a work or other subject matter.

Action for copyright infringement can also be taken against a “carriage service provider” (internet service provider) but there are limitations on the remedies that can be awarded based on the “safe harbour provisions” enacted to follow the US Digital Millennium Copyright Act. Where a carriage service provider meets certain criteria directed at expeditiously removing access to any infringing material upon notification, then they will generally not be liable for damages or an account of profits.

In addition, a new section was added to the Copyright Act in 2016, which allows a copyright owner to apply to the court for an injunction against an internet service provider to disable access to an online location outside Australia that infringes or facilitates the infringement of copyright.

10. If Online Copyright Infringement is Actionable will Courts Exercise a Long-Arm Jurisdiction Over a Counterfeiter that is Outside the Territorial Jurisdiction of the Local Court?

The jurisdiction of the Copyright Act extends to acts outside Australia that cause acts of infringement in Australia. It is possible to authorise infringements of copyright within Australia even though the acts of authorisation take place wholly outside Australia.

In addition, a new section was added to the Copyright Act in 2016, which allows a copyright owner to apply to the court for an injunction against an internet service provider to disable access to an online location outside Australia that infringes or facilitates the infringement of copyright.

11. List the Remedies Provided for Infringement in the Jurisdiction (Injunction/Damages and Profits/Statutory Damages/Seizure and Disposition of Infringing Articles/Attorney Fees and COsts).

- Interim (or interlocutory) and permanent injunctions;
- Ex parte interlocutory relief, such as an Anton Piller Order allowing the plaintiff to enter the defendant's premises to search for infringing goods or documents, or a Mareva Injunction, to prevent the defendant from disposing of assets to defeat any judgment obtained;
- Either damages or an account of profits (not both). In appropriate circumstances the court also has the discretion to award additional (i.e. punitive or exemplary) damages based on any relevant factors such as, for example, the flagrancy of the infringement;
- An order for delivery up of infringing copies or of any device used or intended to be used for making infringing copies; and
- Attorney fees and costs.

12. Damages/Profits, If Available – How do the Courts Measure Damages?

The courts may order damages or an account of profits but not both.

Regarding damages, the court will determine the appropriate method of calculation in the circumstances. Methods include:

- calculating the 'depreciation of the value of the copyright', namely, the fee the infringer would have had to pay to use the copyright lawfully;
- where the defendant has diverted sales from the plaintiff, calculating the loss in profit had the plaintiff made those sales; and
- the 'going rate' paid by others in comparable circumstances.

The court may also consider damages 'at large' or a nominal amount of damages where actual damages cannot be proven.

As noted above, in appropriate circumstances the court also has the discretion to award additional (i.e. punitive or exemplary) damages based on any relevant factors such as, for example, the flagrancy of the infringement.

Damages are not available where the defendant was not aware, and had no reasonable grounds for suspecting, that the act in question was an infringement of copyright. This is called ‘innocent infringement’. However, the plaintiff may still be entitled to an account of profits in such cases.

Where the plaintiff elects to seek an account of profits, the plaintiff will be entitled to the amount of profit made by the defendant that may fairly be attributed to the infringing act. A proportion of overheads and fixed costs may be deducted from the calculation of the defendant’s profit provided they are attributable to the production and sale of the infringing products.

13. Damages/Profits – Are there Legal Minimums and Maximums to Damages?

There are no legal minimums or maximums to awards of damages or an account of profits.

However, in some circumstances damages or an account of profits will not be available, for example, in the case of ‘innocent infringement’. ‘Safe harbour’ provisions also restrict remedies in actions against carriage service providers that have been found liable for authorising copyright infringements.

14. Post Seizure – How are the Goods Dealt with at the end of Civil Lawsuit?

The Copyright Act allows for an application to be made that infringing copies be forfeited to the copyright owner or destroyed.

15. Court – Is there a specialised Court to Adjudicate Copyright Infringement Cases?

There is no specialized court to exclusively adjudicate copyright infringement cases in Australia.

The Federal Court of Australia is the primary venue for copyright infringement cases. There is an Intellectual Property National Practice Area within the Federal Court of Australia, including a Copyright and Industrial Design Sub-area. The Federal Circuit and Family Court of Australia also has jurisdiction to adjudicate copyright infringement cases. State courts have jurisdiction within the limits of their jurisdictions, whether such limits are as to locality, subject matter or otherwise.

The High Court of Australia has no original jurisdiction to hear copyright matters but may hear appeals by special leave, which is only granted rarely.

16. Limitation, if Applicable – What is the Time Limit for the Commencement of Legal Proceedings?

An action for infringement of copyright must be brought within 6 years from the time the infringement took place.

17. Key Challenges of Civil Action

A key challenge of filing a civil action for copyright infringement in Australia is that statutory damages are not available so it is possible to succeed in establishing infringement only to be awarded nominal damages if actual damage cannot be proven.

18. Key Benefits of Civil Action

The key benefits of filing a civil action for copyright infringement in Australia include:

- there is no system requiring registration of copyright before filing infringement proceedings;
- civil action has a significant deterrent effect on other would-be infringers; and
- Australia has an effective mechanism to obtain an injunction against an internet service provider to disable access to an online location outside Australia that infringes or facilitates the infringement of copyright. This is now being used regularly by copyright owners.
-

Brazil

Contributor: Tânia Aoki Carneiro, *T. Aoki Advogados*

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) Texts of literary, artistic or scientific works;
- 2) Conferences, speeches, sermons and other works of the same nature;
- 3) Dramatic and dramatic-musical works;
- 4) Choreographic and pantomime works, whose scenic execution is fixed in writing or in any other way;
- 5) Musical compositions, whether or not lettered;
- 6) Audiovisual works, including cinematographic works;
- 7) Photographic works and those produced by any process analogous to photography;
- 8) The works of drawing, painting, engraving, sculpture, lithography and kinetic art;
- 9) Illustrations, geographical charts and other works of the same nature;
- 10) Projects, sketches and plastic works concerning geography, engineering, topography, architecture, landscaping, set design and science;
- 11) The adaptations, translations and other transformations of original works, presented as new intellectual creation;
- 12) Computer programs;
- 13) Collections or compilations, anthologies, encyclopedias, dictionaries, databases and other works that, by their selection, organization or arrangement of their content, constitute an intellectual creation.

2. Is there an exhaustive list of copyrightable works?

There is not an exhaustive list of copyrightable works protected in Brazil. Pursuant to article 7 of the Brazilian Copyright Law (Law nº 9.610/98), all the intellectual creations expressed by any means or fixed in any medium, tangible or intangible, known or to be invented in the future, are protected.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

Works need to be original and expressed by any means or fixed in any medium, tangible or intangible.

4. Is copyright registration required to initiate a civil case?

The copyright protection is not subject to registration. Therefore, a copyright registration certificate is not required to initiate a civil case. Any kind of evidence that demonstrates the authorship of the intellectual work that is being infringed is admitted by courts.

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A

6. What types of infringement can be used to initiate a civil case?

Direct copyright infringement: any unauthorized usage of the work, by any means, is actionable, unless it falls within one of the exceptions established by the Brazilian Copyright Law.

7. Who has standing to initiate a civil case?

1) Copyright owner 2) Licensee if authorized to pursue such action

8. Do multiple authors all have to join the lawsuit?

No, there is no such requirement. Each coauthor may, individually, without the acquiescence of others, defend his own rights against third parties.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

The Brazilian courts have jurisdiction over a nonresident counterfeiter who commits wrongdoing within the national territory or whose acts produce effects in the territory.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- 1) Temporary and permanent injunction
- 2) Damages (economic and noneconomic damages)
- 3) Seizure of counterfeit items
- 4) Attorney's fees and costs

12. Damages/Profits: If available, how do the courts measure damages?

1) Economic damages: compensation of all the losses suffered by the copyright owner, including lost profits if proved. If the number of unlawful copies of a literary, artistic or scientific work is unknown, the Brazilian Copyright Law provides for damages in the amount of 3.000 copies, besides the value of the seized ones. This legal presumption has already been denied by the courts.

2) Pain and suffering (noneconomic damages): there are no rules as to the measurement of noneconomic damages, so damages are awarded at the discretion of the court based on the circumstances of the case.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

The court may determine the destruction of goods seized, as well as of the matrices, molds, and other instruments used for the practice of the unlawful conduct. The machines, equipment and supplies used by the counterfeiter may also be confiscated or even destroyed if they only serve the illicit purpose.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

No, the copyright infringement cases are heard by regular civil courts. In some states, there are courts specialized in industrial property, which does not encompass copyright law.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The Civil Code provides for a 3-year-term to claim damages, counting from the date of the infringement. As to the injunctive relief, the plaintiff has 10 years from the date of the infringement to initiate legal proceedings. If the infringement is continuous, a new 10-year-term runs daily.

17. Key Challenges of Civil Action

Although a registration is not required to claim copyright protection, the copyright owner is encouraged to maintain sufficient written record of the authorship in order to avoid any dispute on the copyright ownership in a future court action. Also, if the counterfeiter is not an established company, it may be difficult to actually receive the damages awarded by the court. In such cases, an injunctive relief may be more beneficial to the copyright owner.

18. Key Benefits of Civil Action

The copyright owner is able to cease the copyright infringement immediately by obtaining an ex parte preliminary injunction, if he demonstrates that there is likelihood of success on the merits and irreparable harm. The provisional remedies are really effective and, depending on the state where the action is brought, they are enforced in a few days by the court officials.

Canada

Contributor: Lorne M. Lipkus, *Kestenberg Siegal Lipkus LLP*

1. What "works" are subject to copyright (List in alphabetical order)?

1. artistic work (includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works;)
2. compilations;
3. computer program;
4. dramatic works(includes (a) any piece for recitation, choreographic work or mime, the scenic arrangement or acting form of which is fixed in writing or otherwise, 'every original literary, dramatic musical and artistic work; (b) any cinematographic work, and (c) any compilation of dramatic works;
5. engravings;
6. literary work includes tables, computer programs and compilations of literary works;
7. musical work;
8. photographs includes photo-lithograph and any work expressed by any process analogous to photography;
9. sculpture.

2. Is there an exhaustive list of copyrightable works?

YES to some extent and law refers to groups or types of works with flexible definition to allow all copyrightable works to be included.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

Original literary, dramatic, musical and artistic work if any one of the following conditions is met:

- (a) in the case of any work, whether published or unpublished, including a cinematographic work, the author was, at the date of the making of the work, a citizen or subject of, or a person ordinarily resident in, a treaty country;
- (b) in the case of a cinematographic work, whether published or unpublished, the maker, at the date of the making of the cinematographic work, (i) if a corporation, had its headquarters in a treaty country, or (ii) if a natural person, was a citizen or subject of, or a person ordinarily resident in, a treaty country; or
- (c) in the case of a published work, including a cinematographic work, (i) in relation to subparagraph 2.2(1)(a)(i), the first publication in such a quantity as to satisfy the reasonable demands of the public, having regard to the nature of the work, occurred in a treaty country, or (ii) in relation to subparagraph 2.2(1)(a)(ii) or (iii), the first publication occurred in a treaty country.

4. Is copyright registration required to initiate a civil case?

No, however, it affords the copyright owner certain evidentiary presumptions in an infringement action.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No

6. What types of infringement can be used to initiate a civil case?

There are 2 types of copyright infringement: direct infringement and secondary infringement.

7. Who has standing to initiate a civil case?

- 1) Copyright owner & any person deriving any right, title or interest from the owner by assignment or grant in writing; owner of moral rights; and
- 2) exclusive licensee, if authorized to pursue such action

8. Do multiple authors all have to join the lawsuit?

The Act recognises a work of joint authorship, but it does not state whether those rights can be exploited jointly by its authors or if each author may exercise the right separately from the other.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

On-line intermediaries who post infringing content are subject to Canada's Notice & Notice regime. Notice by the rights holder of an infringement is given to the intermediary or ISP and the ISP is legislatively obligated to give notice to the alleged infringer, but is not required to disable or remove access to the alleged infringing content. ISPs must retain records of the identity of subscribers to whom notices have been forwarded and subject to a court order, release that information to the rights holder.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Canada has ordered injunctions with world-wide application, but extra-territorial enforcement is subject to the jurisdiction & laws of the relevant country. Typically a cause of action is best initiated in the jurisdiction where the defendant resides or has assets. Enforceability of a domestic order in a foreign jurisdiction depends upon the foreign jurisdiction.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- Damages and profits, or minimum compensatory damages, or in the alternative, may elect to receive statutory damages.

- Injunctions (interim/interlocutory/permanent);
- Mandatory orders, like delivery up & destruction of the work and of all plates/molds etc. used for the production of infringing copies;
- Extraordinary remedies, like Anton Piller Orders & Mareva Orders;
- Exemplary &/or punitive damages;
- Possession of all infringing copies of that work or other subject-matter, and of all plates used or intended to be used for the production of infringing copies; and
- Costs are awarded to a successful litigant though rarely on a full indemnification basis and at the discretion of the court.

12. Damages/Profits: If available, how do the courts measure damages?

35 (1) Where a person infringes copyright, the person is liable to pay such damages to the owner of the copyright as the owner has suffered due to the infringement and, in addition to those damages, such part of the profits that the infringer has made from the infringement and that were not taken into account in calculating the damages as the court considers just. Proof of profits (2) In proving profits, (a) the plaintiff shall be required to prove only receipts or revenues derived from the infringement; and (b) the defendant shall be required to prove every element of cost that the defendant claims.

13. Damages/Profits: Are there legal minimums and maximums to damages?

There is no minimum or maximum threshold for general damages. There is a minimum / maximum threshold for statutory damages as follows:

- (a) a sum of not less than \$500 and not more than \$20,000 with respect to all infringements involved in the proceedings for each work or other subject-matter, if the infringements are for commercial purposes; and
- (b) a sum of not less than \$100 and not more than \$5,000 that the court considers just, with respect to all infringements involved in the proceedings for all works or other subject-matter, if the infringements are for non-commercial purposes.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

A court order may include, delivery up and/or destruction.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

Yes, the Federal Courts of Canada have jurisdiction to deal with IP cases, though provincial courts have concurrent jurisdiction.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Limitation or prescription period for civil remedies:

(a) the proceedings for the act or omission giving rise to a remedy are commenced within 3 years after it occurred, in the case where the plaintiff knew, or could reasonably have been expected to know, of the act or omission at the time it occurred; or

(b) the proceedings for the act or omission giving rise to a remedy are commenced within 3 years after the time when the plaintiff firstly knew of it, or could reasonably have been expected to know of it, in the case where the plaintiff did not know, and could not reasonably have been expected to know, of the act or omission at the time it occurred.

17. Key Challenges of Civil Action

Judges have discretion in awarding damages even in respect of statutory damages. Litigation is costly and it is rare to recover all of a litigants costs;

18. Key Benefits of Civil Action

Successful litigation can provide affirmation of rights, provide compensation for damage sustained and deter prospective infringement.

Chile

Contributor: Alessandri Attorneys at Law

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) Adaptations, translations and other transformations of a work, authorized by its author.
- 2) Architectural projects, sketches and models.
- 3) Books and writings.
- 4) Cinematographic works.
- 5) Computer programs, whatever the mode or form of expression, as source program or object program, including preparatory documentation, technical description and user manuals.
- 6) Compilations of data or other materials, in machine-readable or other form, which, by reason of the selection or arrangement of their contents, constitute intellectual creations. This protection does not cover the data or materials themselves, and is without prejudice to any copyright subsisting in the data or materials contained in the compilation.
- 7) Lectures, speeches and memoirs.
- 8) Musical compositions.
- 9) Paintings, drawings, illustrations.
- 10) Photographs, engravings and lithographs.
- 11) Radio and TV programs, whether original or adaptations of literary works.
- 12) Sculptures.
- 13) Scenographies and their sketches.
- 14) Software.
- 15) Theatrical and choreographic works.
- 16) Videograms, slideshows.
- 17) Works related to topography and geography.

2. Is there an exhaustive list of copyrightable works?

There is an exhaustive list of copyrightable works protected in Chile. This list is found in article 3 of the Chilean Intellectual Property Law (Law n° 17.336).

3. If no exhaustive list, outline requirements for obtaining copyright protection.

4. Is copyright registration required to initiate a civil case?

It is not necessary.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No.

6. What types of infringement can be used to initiate a civil case?

From the article 79 of the Chilean Intellectual Property Law provide for a series of conducts that constitute offenses and/or crimes against intellectual property. These are the following:

- 1) Use works, interpretations, productions and broadcasts protected by copyright or related rights, without the express authorization of the copyright holder.
- 2) Falsifying a performance sheet (list of musical works or phonograms performed).
- 3) Falsifying data in financial statements (in the context of a publishing contract).
- 4) Collect royalties or grant licenses in respect of works, or performances, or phonograms without being authorized to do so.
- 5) Falsifying works, or editing, reproducing or distributing them falsely displaying the name of the authorized publisher, suppressing or changing the name of the author or the title of the work, or maliciously altering its text.
- 6) Knowingly reproducing, distributing, making available or communicating to the public a work belonging to the public domain or to the common cultural heritage under a name other than that of the true author.
- 7) Attributing or claiming economic rights over works in the public domain or common cultural heritage.
- 8) Omitting the preparation of the corresponding performance forms by whoever is obliged to pay in remuneration for the performance or communication to the public of protected works.
- 9) To have for sale, market or rent directly to the public copies of works, performances or phonograms, whatever their medium, reproduced in violation of the provisions of the Law on Intellectual Property.
- 10) For profit to manufacture, import, bring into the country, hold or acquire for commercial distribution copies of works, performances or phonograms, whatever their medium, that have been reproduced in violation of the provisions of the Intellectual Property Law.
- 11) Delete or alter any rights management information.
- 12) Distributing or importing for distribution, rights management information, knowing that such information has been altered without authorization.
- 13) Distributing, importing for distribution, broadcasting, communicating or making available to the public copies of works or phonograms, knowing that the rights management information has been removed or altered without authorization.

7. Who has standing to initiate a civil case?

- 1) The holder of the intellectual property rights.
- 2) Any person, since there is public action in the case of this type of offenses.

8. Do multiple authors all have to join the lawsuit?

No. Any one of the co-author may initiate an infringement litigation.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Providers of digital media, electronic media, mobile network or Internet services shall not be held responsible for the data transmitted provided that they comply with the following conditions (article 85 M, Law n° 17.336):

- 1) Do not modify or select the content of the transmission. For these purposes, technological manipulation of the material necessary to facilitate transmission over the network, such as the splitting of packets, shall not be considered modification of the content.
- 2) Do not initiate the transmission.
- 3) Do not select the recipients of the information.

This limitation of liability includes the automatic storage or automatic and temporary copy of the transmitted data, technically necessary to execute the transmission, provided that this automatic storage or copy is not accessible to the general public and is not kept in storage for longer than reasonably necessary to carry out the communication.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

In general, in virtue of the civil procedure rules, it is possible for the local court to exercise its jurisdiction outside the specific jurisdictional territory through letters rogatory, if necessary.

Nevertheless, it is important to note that this is only the general and supplementary rule since Chilean law has not provided any special regulation on jurisdiction and competence applicable to online copyright infringement cases.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

In an action for an infringement of copyright, the types of relief that the court may grant include:

- 1) Cessation of the infringing activity:
 - a) Destruction or exclusion from trade.
 - b) Precautionary measures.

The owner may request the following precautionary measures:

- The suspension of the exploitation of the works, artistic performances or related contributions.
- The prohibition to enter into acts or contracts on specific goods, including the prohibition to promote or advertise these.
- The withholding of illegal copies.
- The retention of materials, machinery and implements used for the infringing activity or the production of illegal copies.
- The removal or withdrawal of devices that have been used in unauthorized public communication.
- The appointment of one or more interveners.
- The seizure of the proceeds from the exploitation of works, artistic performances or related contributions.

- c) Delivery of information: In the case of civil proceedings brought by those affected by copyright infringement, the owner may request that the court order the infringer to provide any information concerning the persons involved in the infringement and the channels of production and distribution of the illegal copies of works, artistic performances or related contributions.
- 2) Compensation for damages: In all cases of infringement of copyrights or related rights, the owner may request compensation for the economic and moral damages caused.

12. Damages/Profits: If available, how do the courts measure damages?

The type of damage must be distinguished:

- 1) Property damage: the legitimate retail value of the goods on which the infringement is based.
- 2) Moral damages: the circumstances of the infringement, the seriousness of the injury, the harm caused to the author's reputation and the objective degree of unlawful dissemination of the work.

13. Damages/Profits: Are there legal minimums and maximums to damages?.

There is a maximum in relation to the seriousness of the infraction, which is 2,000 monthly tax units (UTM) per infraction.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

In most cases, the goods are incinerated as the court, the prosecutor and the victim reach an agreement with the offender to pay for the incineration. In cases where this does not occur, the goods are stored in police facilities or bonded warehouses. The fate of these goods is uncertain as it will depend on the particular case and the decision of Customs.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Strictly speaking, there are no specialized courts in matters of intellectual property.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There is no limitation period for commencement of legal proceedings for infringement on the intellectual property law. Notwithstanding the foregoing, it is governed by the ordinary statute of limitations established in the Chilean Civil Code.

17. Key Challenges of Civil Action

- i. Coordination with public authorities to detect infringements and counterfeit goods.
- ii. Accurate identification of the offender.
- iii. Execution of the incineration when granted by the court. There are procedural difficulties in compelling the infringer to pay for the incineration or destruction of the goods.

18. Key Benefits of Civil Action

- i. Cessation of the litigious acts.
- ii. Damages awarded.
- iii. Deter potential infringers in relation to infringement of intellectual property law.

China

Contributor: Shirley Fu, Beijing Wanrui Law Firm

Verifier: Wency Yu, Anjie & Broad

1. What "works" are subject to copyright (List in alphabetical order)?

The term "works" includes, among other things, works in the fields of literature, art, natural sciences, social sciences, engineering and technology, etc., which are created in any of the following forms:

- (1) written works;
- (2) oral works;
- (3) musical, dramatic, quyi, choreographic and acrobatic works;
- (4) works of the fine arts and architecture;
- (5) photographic works;
- (6) cinematographic works and works created by a process analogous to cinematography;
- (7) graphic works such as drawings of engineering designs and product designs, maps and sketches, and model works;
- (8) computer software; and
- (9) other works as provided for in laws and administrative regulations.

2. Is there an exhaustive list of copyrightable works?

It is not exhaustive. The definition of works includes an "etc." and a catch-all provision, i.e. "(9) other works as provided for in laws and administrative regulations".

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

- The work shall be created independently by the author and could not be copied from other people's work;
- The work should be made with a minimal degree of creativity and embodies the ideas and emotions of the author;
- The work can be expressed in a certain form.

4. Is copyright registration required to initiate a civil case?

No, however, it is significantly easier to evidence copyright infringement if you do hold a copyright registration. A registration is considered prima-facie evidence of copyright ownership.

5. Are there any exceptions to the registration requirement to initiate a civil case?

Not applicable.

6. What types of infringement can be used to initiate a civil case?

- (1) publishing a work without permission of the copyright owner;
- (2) publishing a work of joint authorship as a work created solely by oneself, without permission of the other co-authors;
- (3) having one's name mentioned in another person's work in the creation of which one has taken no part, in order to seek personal fame and gain;
- (4) distorting or mutilating a work created by another person;
- (5) plagiarizing a work created by another person;
- (6) exploiting a work for exhibition or film-making or in a manner analogous to film-making, or for adaptation, translation, annotation, or for other purposes, without permission of the copyright owner, except where otherwise provided for in this Law;
- (7) exploiting a work created by another person without paying remuneration as one should;
- (8) renting a cinematographic work or a work created by a process analogous to cinematography, computer software, or products of sound recording or video recording, without permission of the copyright owner or the owner of the rights related to the copyright, except where otherwise provided for in this Law;
- (9) exploiting the typographical design of a published book or periodical, without permission of the publisher;
- (10) live broadcasting, communicating to the public, or recording a performance, without permission of the performer; or
- (11) committing other acts infringing upon the copyright and the rights related to the copyright.

7. Who has standing to initiate a civil case?

1. The copyright owner may sue; The owner includes author, co-author, etc.
2. The exclusive copyright licensee may sue. The sole copyright licensee may also sue, if the licensor does not sue. The non-exclusive copyright licensee can sue only if permitted by the licensor.
3. The Copyright Collective Management Organization may sue according to the regulations of the organization and the entrustment of the copyright owners.
4. The inheritor and legatee of the copyright may sue if the copyright is still during the protection period.

8. Do multiple authors all have to join the lawsuit?

No- Any of the co-author may initiate an infringement litigation.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. If certain threshold is met, online infringement for purposes of making profits would be subject to criminal liabilities. Infringers can be sent to jail for up to 10 years plus fines.

10. If online copyright infringement is actionable, will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

If the infringement act is conducted in China, or if the counterfeiter domiciles in China, the local court may exercise a long-arm jurisdiction.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Civil remedies include:

- Injunction;
- Damages (compensatory / punitive damages);
- Attorney's fees and costs;
- Eliminating the bad effects of the infringement act;
- Making an apology

Administrative remedies (available only when public rights and interests are impaired) include:

- Injunction;
- Fines;
- Confiscation and destruction of infringement products;
- Confiscation and destruction of the material, tools and instruments mainly used to conduct infringement.

12. Damages/Profits: If available, how do the courts measure damages?

Damages are measured by:

- (i) actual losses suffered by the right owner;
- (ii) illegal gains of the infringer, or
- (iii) license fees, if (i) and (ii) are difficult to calculate.

If none of the above can be determined, the court may award statutory damages of no less than 500 RMB and no more than 5,000,000 RMB, depending on circumstances of the case.

In case of willful infringement and serious circumstances, the court may also award punitive damages (up to five times of the base amount discussed above).

13. Damages/Profits: Are there legal minimums and maximums to damages?

Statutory damages: Where the actual losses of the right owner or the unlawful gains of the infringer cannot be determined, the People's Court shall, in light of the circumstances of the infringement, decide on a compensation amounting to no less than 500 RMB but no more than 5,000,000 RMB. .

14. Post Seizure: How are goods dealt with at end of civil lawsuit?

The court may order confiscation of the infringement products, as well as materials and instruments mainly used for infringement.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

Generally copyright infringement cases shall be heard by intermediate courts. However, depending on location, some courts of lower level (i.e. district courts) can hear copyright cases too. Some IP courts (in major cities) can hear copyright infringement cases, depending on location and/or the amount of claim.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The Statute of Limitation for copyright infringement is 3 years from the date the copyright owner knows or should know the infringement. After the expiration of the three year limitation, if the infringement is still ongoing at the time of filing the lawsuit, the court shall order cease of infringement, but the court can only award damages for infringement conducted within three years from the date of commencement of legal proceedings.

17. Key Challenges of Civil Action

Copyright owners may face different challenges depending on circumstances of the cases. Common challenges include:

- Discovery proceedings are not available in China.
- Proving copyright ownership may be challenging, if the right holder did not have a copyright registration in place;
- Proving the amount of actual losses suffered by the copyright owner, or the profits made by the infringer may be challenging;
- For online infringement, identifying the infringer could be challenging.
- After being ordered by court to pay damages, some defendants (especially those who are individuals or small entities) are not cooperative.
- Piercing the corporate veil is usually difficult, so when the infringement are conducted in the name of a company, it is usually difficult to go after the real infringer (the individual behind the company).

18. Key Benefits of Civil Action

As administrative enforcement and criminal enforcement is available in limited circumstances, civil action is the main route for copyright infringement in China.

By filing a civil action, a copyright owner may recover compensatory damages, or even punitive damages, from the infringer.

Costa Rica

Contributor: Fabiola Sáenz Quesada, *Consortium Legal*

1. What "works" are subject to copyright (List in alphabetical order)?

Chapter 1 of the Costa Rican Copyright Law sets forth the various works protected by the statute including the following:

- Books
- Choreographic and mimed works
- Cinematographic works
- Computer programs
- Conferences
- Derived works, like adaptations, translations and other transformations of original works that have been authorized by the authors
- Dramatic musical works
- Engraving
- Lectures
- Letters and other writings
- Lithography
- Musical compositions with or without words
- Pamphlets
- Photographic works and works expressed by a process analogous to photography
- Sculpture
- Sermons and other works of similar nature
- Speeches
- Works of applied art such as illustrations, maps, plans, sketches and three-dimensional works relating to geography, topography, architecture or science
- Works of drawing, painting, architecture

2. Is there an exhaustive list of copyrightable works?

There is no exhaustive list of copyrightable works in the Costa Rican Copyright Law. In fact, at the beginning of the above-mentioned Chapter 1 reads as follows:

“Literary and artistic works” shall be taken to mean all productions in the literary and artistic domain, whatever the form of expression thereof, such as:”

The expression “such as” shows that this is not a closed list.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

The Costa Rican copyright does not expressly set forth the specific requirements needed to attain legal protection. Nonetheless, the copyright application must contain the name and address of the author or their legal representative; the title and a detailed description of the

work, that works have to be original and expressed by any means or fixed in any medium, tangible or intangible. The application must contain the registration fees required by law.

4. Is copyright registration required to initiate a civil case?

No copyright registration is required to initiate a civil case. Any kind of evidence that demonstrates the authorship of the intellectual work that is being infringed is admitted by courts.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No.

6. What types of infringement can be used to initiate a civil case?

Any unauthorized usage of the work, by any means, can be used to initiate a civil case, unless it falls within one of the exceptions established by the Costa Rican Copyright Law.

7. Who has standing to initiate a civil case?

- Copyright holders
- Licensees if authorized to pursue such action

8. Do multiple authors all have to join the lawsuit?

There is no such requirement. Each coauthor may, individually defend his own rights against third parties without the acquiescence of others.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

No, Costa Rican law will only apply to any party that commits a punishable event in the territory of the Republic. But there is the exception of the exequatur process, in this case the Chambers of the Supreme Court of Justice will be in charge of resolving these processes, according to the corresponding matter, to make the resolution issued by a foreign court legally enforceable or executable in our country.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

- Temporary injunction
- Damages (economic and noneconomic damages)

- Goods may be seized or even destroyed
- Attorneys' fees and litigation costs

12. Damages/Profits: If available, how do the courts measure damages?

The damages caused by civil and criminal infractions against copyright shall be fixed by the judge and may be based on an expert opinion. The Judge must consider, among other elements, the value of the good or service that is the object of the violation, based on the suggested retail price or other legitimate measure of value presented by the right holder.

13. Damages/Profits: Are there legal minimums and maximums to damages?

Yes, there are predetermined compensations as an alternative to the damages suffered, at the request of the right holder, the judge in accordance with due process, may use predetermined indemnities.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Courts may determine the destruction of goods seized.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Copyright cases are heard and enforced before ordinary civil or criminal courts and Court of Administrative Registration.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The limitation varies depending upon the nature of the offense, criminal or civil cases.

17. Key Challenges of Civil Action

Although a registration is not required to claim and enforce copyright protection, the copyright owner is encouraged to maintain sufficient evidence of the authorship to avoid any dispute on the copyright ownership in a potential court action.

18. Key Benefits of Civil Action

Civil actions allow copyright owners to obtain enforceable judgments, which affirm their ownership over a work and to obtain the withdrawal and destruction of the infringing goods. They also allow the plaintiff to obtain enforceable decisions for compensation.

England and Wales

Contributor: Kostyantyn Lobov, *Harbottle & Lewis LLP*

1. What "works" are subject to copyright (List in alphabetical order)?

Pursuant to Section 1 of the Copyright, Designs and Patents Act 1988 (CDPA); copyright subsists in the following works –

- (a) Artistic works (detailed in Section 3(1) CDPA) which include graphic works, photographs, sculptures or collages (irrespective of artistic quality), works of architecture (including buildings) and works of artistic craftsmanship. This is a broad category of works and one of the categories most frequently relied upon;
- (b) Broadcasts (detailed in Section 6 CDPA) which are defined as an electronic transmission of visual images, sounds or other information that are either (i) transmitted for simultaneous reception by members of the public and are capable of being lawfully received by them or (ii) transmitted at a time determined solely by the person making the transmission for presentation to members of the public;
- (c) Computer programs and their preparatory design materials (detailed in Section 3(1)(b)-(c) CDPA);
- (d) Databases (detailed in Section 3A CDPA), which are a collection of independent works, data or other materials which constitute the author's own intellectual creation and are (i) arranged in a systematic or methodical way; and (ii) individually accessible by electronic or other means;
- (e) Dramatic works (detailed in Section 3(1) CDPA) which refer to works of action, with or without words or music, which are capable of being performed before an audience e.g. plays, dances and mimes;
- (f) Films (detailed in Section 5B CDPA) which cover recordings on any medium from which a moving image may by any means be produced. Additionally, soundtracks to films are treated as part of the film;
- (g) Literary works (detailed in Section 3(1) CDPA) which consist of any work other than a dramatic or musical work which is written, spoken or sung. There is no requirement of literary or artistic merit. This is another broad category which can include, for example, a list of customers or set of instructions;
- (h) Musical works (detailed in Section 3(1) CDPA). If the music is accompanied by words or lyrics, they may be protected separately as a literary work;
- (i) Sound recordings (detailed in Section 5A CDPA). These are defined as a recording of sounds from which the sounds may be reproduced or a recording of the whole or

part of a literary, dramatic or musical work, from which sounds reproducing the work (or part of it) may be produced; and

- (j) Typographical arrangements of published editions (detailed in Section 8 CDPA) which cover the published editions of the whole or any part of one or more literary, dramatic or musical works.

In order to be protected, literary, dramatic, musical and artistic works must be original and fixated (i.e. recorded in some form).

2. Is there an exhaustive list of copyrightable works?

The list of works provided by the CDPA was intended to be a ‘closed’ list. However, the decision of the Court of Justice of the European Union in *Cofemel v G-Star Raw* (C-683/17) (which was handed down before Brexit and was therefore incorporated into English law) has cast some doubt over this. In *Cofemel*, the court stated that the only requirements for a work to qualify for copyright protection in the EU were:

- a. That the work must be original – meaning an expression of the author’s own intellectual creation (i.e. where the author has made free and creative choices); and
- b. That the subject matter must be identifiable with sufficient precision and objectivity (i.e. the work should be expressed in a manner which makes it clearly identifiable, even though its expression does not necessarily have to be in permanent form).

Once a work has fulfilled these two requirements, copyright protection arises automatically and Member States may not impose additional hurdles to obtaining copyright protection.

There is therefore some tension between *Cofemel* and the English ‘closed list’ approach which, at the time of writing, has not yet been fully resolved. Recent English court decisions have endorsed the *Cofemel* approach, but concluded that the work, in that particular case, could in any event fit into one of the closed list categories.

Whilst it may be a ‘closed list’, as noted above, some of the categories of copyright work are quite broad and open to interpretation, which in practice means that a copyright holder will usually be able to comfortably fit its creation into one of them.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

There are two key requirements – Originality and Fixation.

- a. Originality:
 - i. The work must be original. The CDPA does not define a standard of originality, but case law indicates that the threshold for originality is relatively low. For example, most artistic works are not required to have any artistic merit as such.

- ii. English courts have now largely adopted the harmonised EU standard of originality, namely that the work must be the “author’s own intellectual creation”.

b. Fixation:

- i. The work must be recorded or exist in a permanent form (as opposed to, for example, existing only in the mind of its author).
- ii. For most copyright works this happens as a matter of course (e.g. photographs, software code). But, for example, an original impromptu speech, which exists only in the mind of the speaker, may not be protected by copyright unless it is recorded in some form. The act of fixation does not necessarily need to be done by the author themselves.

There are also Qualification requirements to qualify for English copyright protection, which are set out in Sections 153-156 CDPA 1988. Qualification can be by reference to the citizenship or domicile of the author, or by the place of creation, publication or broadcast of the work. The UK is a signatory of the Berne Convention and therefore offers reciprocal protection to qualifying works created in other signatory states.

4. Is copyright registration required to initiate a civil case?

There is no system of copyright registration in England & Wales. If the specific criteria in relation to the relevant work (pursuant to the CDPA 1988) are fulfilled, copyright protection will arise automatically to protect the work from the moment of its creation.

The copyright owner will normally be required to prove the subsistence and ownership of copyright when bringing a civil copyright infringement claim.

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A.

6. What types of infringement can be used to initiate a civil case?

There are two forms of copyright infringement: primary and secondary.

- a. **Primary infringement** (s. 16 CDPA 1988) – this is where copyright in a work is infringed by a person who, without the permission of the copyright owner does (or authorises another to do) any of the acts listed below in relation to the whole work or any substantial part of it, either directly or indirectly:
 - i. Copying the work;
 - ii. Issuing copies of the work to the public;
 - iii. Renting or lending the work to the public.
 - iv. Performing, showing or playing the work in public; and

- v. Communicate the work to the public.

“Substantial part” is both a quantitative and qualitative test. Therefore, copying a mathematically small percentage of a work could still be infringing, if that part of the work is significant or important in some way.

Primary infringement is a strict liability tort, meaning that it is not necessary to show knowledge or intention on the part of the Defendant in order to establish liability.

- b. **Secondary infringement** (ss. 22-26 CDPA 1988) – these acts require the Defendant to have certain knowledge or reason to believe that certain acts were carried out in relation to an infringing copy of the work. Secondary infringement usually involves one of the following:
 - i. Dealing with infringing copies once they have been made – where an infringer is only liable if they knew or had reason to believe that they were dealing with an infringing copy of a protected work;
 - ii. Facilitating copying by providing the equipment or means to enable the copying to take place. Examples include:
 - Importing an infringing copy of a work into the UK, for uses other than for private and domestic use;
 - Possessing, selling, hiring, distribution, exhibiting or dealing with infringing copies in the course of business. It is also an infringement to distribute infringing copies outside of the course of business if this distribution prejudices the copyright owner;
 - Providing the means/equipment for making infringing copies; and
 - In the context of performances, allowing the performance of a literary, dramatic or musical work(s) in public.

7. Who has standing to initiate a civil case?

A claim for copyright infringement can be brought by the following person(s):

- a. The legal owner of copyright;
- b. Joint owners of copyright;
- c. An equitable owner (who is entitled to bring an action and seek interim relief, but cannot seek final relief remedies unless they have joined the legal owner as a party to their action or obtained an assignment of title);

- d. An exclusive licensee (except against the copyright owner); and
- e. In certain circumstances, a non-exclusive licensee may also bring a claim if the infringing act was directly connected to a licensed act under the scope of their licence; the licence is in writing signed by or on behalf of the copyright owner; and it expressly grants the non-exclusive licensee a right of action.

8. Do multiple authors all have to join the lawsuit?

If the authors are joint owners of the copyright in question, they will all need to join the claim for copyright infringement in order to uphold it.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

The infringing acts set out in Q6 above can apply in the same way if they are committed in a digital medium. For example, reproducing the whole or a substantial part of a copyright work on a website or as an app can constitute infringement.

Intermediaries such as Internet Service Providers (ISPs) benefit from certain exemptions to acts of copyright infringement which are carried out by third parties who use their services, under the Electronic Commerce (EC Directive) Regulations 2002. For example, where the ISP is simply acting as a mere conduit of information; caching information; or providing hosting services to a third party. However, ISPs have to meet certain requirements to benefit from these defences.

In the case of “hosting” (one of the most commonly relied upon exemptions), the ISP:

- (1) Must not have actual knowledge of unlawful activity or information and, where a claim for damages is made, is not aware of facts or circumstances from which it would have been apparent to the service provider that the activity or information was unlawful; and
- (2) Upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.

Copyright infringement can also constitute a criminal offence pursuant to Sections 107 and 198 of the CDPA. These criminal offences are often deployed against organised crime groups who are dealing for profit in fake branded goods or pirated products. However, not all cases that fall within the criminal law provisions will be dealt with as criminal offences – in many cases (usually business to business cases) disputes are resolved via civil law rather than a criminal law action.

In certain circumstances, criminal proceedings may be available (both for online and traditional copyright infringement and usually where copyright has been deliberately and flagrantly infringed) and the penalties for these offences vary under Section 107(1) CDPA from 3 months' imprisonment and/or a £3,000 fine to a maximum penalty of 10 years' imprisonment and/or an unlimited fine, depending on the severity of the infringement. The main bodies for the

enforcement of the criminal offences are the Police and national Trading Standard authorities. In some cases, it is also possible for a copyright owner to bring a private prosecution directly against the infringing party.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

A court can exercise jurisdiction over a copyright infringer who is outside of the jurisdiction; however, whether or not they will exercise such powers is fact-specific and dependent on the circumstances of each case.

The court will consider what links there are to tie the infringing act and/or the copyright infringer to England & Wales, in order to justify the court taking jurisdiction.

Pursuant to the Brussels I Recast Regulation (as incorporated into English Law under the Civil Jurisdiction and Judgments (Amendment) (EU Exit) Regulations 2019), claims for intellectual property disputes can be brought in the jurisdiction where the harmful event occurs.

One method to establish a link between the harmful event and the English jurisdiction is to show that the copyright infringer has targeted its services or content at the English public, for example by using a .uk domain name, and displaying prices in pounds sterling.

Where the defendant is domiciled in the jurisdiction, it is in some cases possible to obtain a cross-border injunction if the copyright infringement occurs in another signatory state to the Brussels I Recast Regulation.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Interim remedies (i.e. before a trial):

- i. Interim injunctions, which can compel the Defendant to either do, or to refrain from doing, a specific act. The Claimant must show that there is a serious issue to be tried, and that the balance of convenience justifies the granting of an interim injunction, as opposed to maintaining the status quo;
- ii. Search and seizure orders, requiring a Defendant to allow the Claimant's solicitors to enter their premises and to search for and remove all infringing items covered by the order;
- iii. Freezing orders, preventing the disposal of infringing items or other assets by the Defendant;
- iv. Third-party disclosure orders, requiring 'innocent' third parties who are mixed up in the infringement to disclose information as to the identity of the

wrongdoer. For example, this could be used to obtain information from ISPs, hosting providers or financial institutions which provide services to the infringer.

Final remedies (i.e. at the end of a trial):

- v. Permanent injunctions to prevent future infringements;
- vi. Monetary remedies in the form of damages or an account of profits (at the Claimant's choice):
 - Damages compensate for the loss suffered by the Claimant due to the Defendant's wrongful conduct;
 - An account of profits requires the Defendant to pay the profits they have made as a result of committing the infringing acts, to the Claimant.

Before making a choice between damages or an account of profits, the Claimant can obtain disclosure of information from the Defendant to allow it to consider which form of relief is a better option.

- vii. Delivery up or destruction of the infringing items;
- viii. Publication and dissemination of the judgment at the Defendant's expense;
- ix. Legal costs (although the award of costs is always at the Court's discretion, a successful Claimant would typically expect to recover at least a proportion of its costs);
- x. Interest on the recovered sums.

Copyright infringement cases are conducted as split trials, meaning there is first a decision on liability, followed by an assessment of damages or profits, as the case may be. In practice, parties often reach settlement after the decision on liability (if not sooner).

12. Damages/Profits: If available, how do the courts measure damages?

As mentioned above, a successful Claimant can choose between damages or an account of the Defendant's profits (but not both). These remedies are awarded at the discretion of the Court; there is no statutory scale specifying the sum which must be awarded.

Damages are compensatory in nature. The Court will seek to award a sum which puts the Claimant in the position in which it would have been had the infringement not occurred. Depending on the subject matter, this could be quantified as direct losses of sales, or the calculation of a notional royalty (which would have been paid by a willing licensee to a willing licensor). The Court's assessment will be based on evidence submitted by the parties.

Pursuant to s.97(2) CDPA 1988, in cases of flagrant or repeated copyright infringement, it is possible for additional damages to be awarded to take into account any serious reputational damage, distress, financial repercussions caused by the Defendant's conduct. There is no fixed scale or measure for such additional damages – the Court has wide discretion in this regard.

An account of profits seeks to disgorge the profits made by the Defendant as a result of the infringing acts it has committed. The calculation of profits can be an elaborate process, sometimes requiring a 'mini trial' in itself, as the parties argue over which sums are directly connected to the infringement and which overheads can be deducted from that revenue. For that reason, it is more common for Claimants to opt for damages, or for cases to settle after the decision on liability (if not sooner).

13. Damages/Profits: Are there legal minimums and maximums to damages?

This is dependent on the Court where the case is being heard:

- a. Cases in the High Court are not subject to any maximum limit on value of damages, profits or legal costs which can be awarded. The High Court is usually the most appropriate venue for cases which are worth more than £100,000; are more complex; and/or will require more substantial amounts of evidence. The recovery of costs is not capped in the High Court, but most proceedings will be subject to a costs management order, which broadly means that the parties will be required to prepare and submit detailed costs budgets for approval by the court.
- b. The Intellectual Property Enterprise Court (IPEC) is an offshoot of the High Court which specialises in intellectual property disputes (patents, trade marks, passing off, design and copyright infringements) and is intended to be used for shorter, less complex cases and claims of lower value. It has a simplified and more front-loaded procedure, as well as restrictions on disclosure and the types and amount of evidence which can be relied upon. IPEC has two tracks:
 - i. The small claims track is for suitable claims with a value of up to £10,000. Recovery of costs on the small claims track is highly restricted. Interim remedies (such as interim injunctions, freezing orders and search and seizure orders) are not available on the small claims track.
 - ii. The multi-track is for claims with a value between £10,000 and £500,000. The upper end of this range is the limit of what can be recovered through damages or an account of profits. Recovery of legal costs by a successful Claimant is capped at £50,000. The full suite of other interim and final remedies is also available.

14. Post Seizure: How are goods dealt with at end of civil lawsuit?

If the Court has ordered for the infringing goods to be delivered up, a designated party will be identified (for example: the IP owner, their solicitors or in certain instances the Court) to receive

the goods on a designated date and at a specific address. This ensures the infringing goods do not find their way back onto the market.

If the Court has ordered that the infringing goods be destroyed, this will need to be arranged by the Defendant through a third party, usually at its own expense. The destruction would typically need to be confirmed by an affidavit.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

The Chancery Division (Intellectual Property List) of the High Court is staffed by experienced Judges and Masters who are specialists in IP, so there is no shortage of expertise.

The IPEC (as discussed above) is also staffed by an IP specialist Judge.

The UK also has a Copyright tribunal, however this body does not deal with copyright infringement cases. It exists to resolve UK commercial licensing disputes between copyright owners or their agents or collecting societies, and people who use copyright material in their business. The disputes the tribunal is asked to resolve usually relate to the terms and conditions of licences, or the refusal by a collecting society to provide a licence.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There is no special limitation period for copyright claims, so the normal period of 6 years for actions in tort applies. However, this 6 year period is triggered from:

- a. The date of each infringing act (or, if there are repeated acts, the date of the last infringing act); or
- b. When the harm becomes known to the Claimant (however this is subject to considerations of when the Claimant reasonably ought to have been aware of the harm).

In practice, for infringements which take place on an ongoing basis (for example online, or through repeated sales) the limitation period is constantly refreshed, so it is relatively rare for limitation to be an issue.

17. Key Challenges of Civil Action

The challenges of each case are inevitably different. Being one of the oldest and most well-established jurisdictions for IP claims, the procedural elements of copyright litigation in English Courts are well-trodden and on the whole tend to work smoothly. Most of the challenges are therefore evidential in nature, and include:

- a. Evidencing chain of title – the Claimant will be required to show that it owns the rights it claims to own, and that it has standing to bring an action for copyright infringement. This can be a challenge if the documentation relating to the rights is incomplete,

particularly for older rights created by individuals who are deceased or no longer with the business.

- b. Identifying the Defendant(s) – this may require forensic investigations using private investigators, and can be challenging in the case of blockchain-based businesses which operate anonymously or through an offshore-based company.
- c. Becoming aware of and obtaining evidence of infringement – in some cases Claimants may need to move quickly to secure evidence of infringement before it dissipates or is removed.

There are also a number of benefits to bringing a copyright infringement action in the English courts:

- a. Parties benefit from the involvement of experienced, full-time IP specialist judges who sit in the High Court and in the IPEC;
- b. Detailed rules governing civil litigation ensure that cases are generally dealt with expeditiously. In cases without significant complicating factors, it can be possible to get to trial in the High Court within 12-18 months.
- c. Pending trial, there is a broad and varied set of interim remedies available, and robust mechanisms for enforcing those remedies;
- d. The IPEC provides a suitable alternative venue for simpler or lower value claims;
- e. The ability to recover legal costs in the event of a successful claim or defence (subject to the Court's discretion); and
- f. The perceived 'weight' of an English judgment on the international stage can make it easier to enforce it in other jurisdictions.

France

Contributor: Jehan-Philippe Jacquey, *Gilbey Legal*

1. What "works" are subject to copyright (List in alphabetical order)?

Article L.112-2 of the French IPC provides a non-exhaustive list of works that are eligible for protection:

- Books, pamphlets and other literary, artistic and scientific writings.
- Choreographic works, circus acts and feats and dumb-show works, the acting form of which is set down in writing or in another way.
- Cinematographic works and other works consisting of sequences of moving images, with or without sound, together referred to as audiovisual works.
- Creations of seasonal industries of dress and articles of fashion.
- Dramatic or dramatico-musical works.
- Graphical and typographical works.
- Illustrations, geographical maps.
- Lectures, addresses, sermons, pleadings and other works of that nature.
- Musical compositions with or without words.
- Photographic works and works produced by techniques analogous to photography.
- Plans, sketches and three-dimensional works relative to geography, topography, architecture and science.
- Software, including preparatory design material.
- Works of drawing, painting, architecture, sculpture, engraving and lithography.
- Works of applied art.

2. Is there an exhaustive list of copyrightable works?

No.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

All works of intellectual creation are protected by author rights law in France, on the sole basis of their creation, and without any formal requirements.

The following conditions must however be met to be eligible to author rights protection:

1. the work must be fixed in a material form;
2. the work must be original. A work is considered original if it is reflected with the personality of its author.

In summary, it is required to precisely identify the work at issue, with a specific date, and be in a position to describe its original characters.

4. Is copyright registration required to initiate a civil case?

NO: Registration is not required to enforce author rights since original works are protected from their creation.

It is however sometimes helpful to have some registrations (Enveloppe Soleau, blockchain registrations etc... as there is indeed no specific register for author rights) in order to evidence without any possible contestation the date of creation claimed.

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A

6. What types of infringement can be used to initiate a civil case?

Slavishy copy or work producing an overall similar impression.

7. Who has standing to initiate a civil case?

1. Author rights owner, author, co-author or their legal successor

2. Exclusive licensee

Licensees/distributors who are not owners of any copyright cannot claim copyright infringement but can secure damages for their own prejudice on the grounds of unfair competition.

By way of exception, the beneficiaries of an exclusive right of use licensed by a producer of phonograms or videograms (unless the licence agreement provides otherwise) are entitled to act in author rights litigation.

3. Organizations of collective management of author rights and related rights

8. Do multiple authors all have to join the lawsuit?

Should a work be authored by two persons in collaboration, it may be co-owned by both of them.

Article L 113-2-1 of the French IPC states that, “*Work of collaboration’ shall mean a work in the creation of which more than one natural person has participated.*” In that event, several natural persons will share in the ownership of the copyright.

Article L 113-3 of the French IPC states that, “[A] *work of collaboration shall be the joint property of its authors. The authors shall exercise their rights by common agreement*”

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

YES.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

YES, but only if the litigious work is directed, or at least available, to the French consumers.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

1. Temporary and permanent injunctions
2. Damages (economic and noneconomic damages)
3. Seizure/Destruction of the infringing works
4. Publications when and if convenient
5. Attorney's fees and costs

12. Damages/Profits: If available, how do the courts measure damages?

Article L.331-1-3 of the French IPC :To set the damages, the jurisdiction is considering:

1. Negative economic consequences resulting from the harm to the author rights, including loss of earnings;
 2. The moral prejudice;
 3. The benefit made by the infringer of the right, including the economies of intellectual investment, materials and promotions;
- Alternatively and if claimed by the author, a lump sum superior to the royalties that would have been awarded in a regular license agreement.

There are no punitive damages.

13. Damages/Profits: Are there legal minimums and maximums to damages?

NO. It depends on the quantities of the litigious works sold by the infringer.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

Seizure or destruction under the supervision of a bailiff, under penalties following the notification of the decision ordering the same.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

YES: ten specialised civil courts of first instance (Tribunal Judiciaire) have exclusive jurisdiction over author rights matters, namely Paris, Bordeaux, Lille, Lyon, Marseille, Nanterre, Nancy, Rennes, Strasbourg and Fort de France.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings.?

A valid author's rights is enforceable within five years from the date on which the claimant should have been aware of the litigious facts.

17. Key Challenges of Civil Action

Whilst French courts have always been protective of author rights, they are becoming highly demanding when it comes to the validity of the said right, and in particular regarding the originality of the claimed work.

There are numerous available defences such as:

- Contesting the eligibility to author rights protection.
- Legal exceptions, including private and free performances exclusively carried out within the family circle, copies or reproductions reserved strictly for the private use of the copier and not intended for collective use, analyses and quotations provided that they are justified by the critical, polemic, educational, scientific or informative nature of the work they are extracted from; press reviews, the publishing or the broadcasting of speeches as long as they are considered current news, reproduction of works in catalogues of judicial sales, made available for the public for the sole purpose of describing the works of art offered before a sale to be held in France, reproduction or performance of a work extract used as an illustration for an educational purpose, parody, pastiche and caricature, etc...

18. Key Benefits of Civil Action

Acknowledgment of the author rights by the court.

Cessation of the litigious acts.

Damages awarded.

Always useful to discourage future potential infringers without having to initiate full civil court action.

Germany

Contributor: Rainer Böhm, *Eisenführ Speiser*

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) Artistic works, including works of architecture and of applied art and drafts of such works
- 2) Cinematographic works, including works produced by processes similar to cinematography
- 3) Illustrations of a scientific or technical nature, such as drawings, plans, maps, sketches, tables and three-dimensional representations
- 4) Literary works, such as written works, speeches and computer programs
- 5) Musical works
- 6) Pantomimic works, including works of dance
- 7) Photographic works, including works produced by processes similar to photography

(see Section 2 (1) of the Act on Copyright and Related Rights (Urheberrechtsgesetz - UrhG))

2. Is there an exhaustive list of copyrightable works?

No, not exhaustive, there can be other types of "work", that are not included in the list. The legislation is open for new developments in arts, literature and science.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

A "work" needs to be an own intellectual creation of the author (s. S. 2 (2) UrhG). It requires personal and intellectual activity in the sense of intellectual content and design. Individuality and a "creative height" need to be identified. Further, the work term is neutral in terms of purpose, which means, that any aesthetic design can constitute a work within the meaning of S. 2 (2) UrhG.

4. Is copyright registration required to initiate a civil case?

No, with its creation or publication, a work is automatically protected by copyright. By this, the author can assert all his rights, which he is entitled to under his copyright. However, various methods can help to evidence the copyright and therefore a copyright infringement in court, such as: a notarial proof of priority, a registered letter with post stamp to yourself, a Creative Commons license or a copyright notice.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No exception, as there is no registration requirement. In court, the rights holder must state and prove that he/she holds the relevant rights.

6. What types of infringement can be used to initiate a civil case?

- 1) The infringer violates: an exclusive right of an author
- 2) - an author's moral right
- 3) - a neighboring right protected under the Copyright Act

7. Who has standing to initiate a civil case?

- 1) Copyright holder: author can sue for infringement of his or her rights unless these rights have been exclusively licensed to someone else
- 2) Exclusive licensee: within the scope of the exclusive license, the licensee has standing to sue
- 3) Non-exclusive licensee: not generally entitled to enforce, but may be authorised to do so
- 4) Collecting societies: have standing to sue under general principles, e.g. if they have been granted an exclusive license

8. Do multiple authors all have to join the lawsuit?

No, each joint author shall be entitled to assert claims arising from violations of the joint copyright; he may, however, demand performance only to all of the joint authors (see S. 8 (2) UrhG)

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

There are no specific liabilities, remedies or defenses for online infringement. They are identical as to any other cases of copyright infringement.

However, the German implementation of the European E-Commerce-Directive into the Telemedia Act as well as the detailed implementation of the amended Art. 17 of the Directive on Copyright in the Digital Single Market (DSM-RL) into the German Act on the Copyright Liability of Online Content Sharing Service Providers (Urheberrechts-Diensteanbieter-Gesetz – UrhDaG) shaped the conditions, under which certain internet service- and platform providers can be liable for copyright infringements.

Additionally, the Federal Civil Court and many more Regional and Higher Regional Courts adapt the criteria for a liability of intermediaries and host providers set up by the European Court of Justice in their recent decisions.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

German law does not recognize a long arm jurisdiction. However, if the counterfeiter offers or advertises products on the internet, which are directed to potential customers, jurisdiction by virtue of tort can be established. German Courts adopt these principles quite broadly. As there are no specific remedies for online infringement, the question of jurisdiction is

answered by the general rules of German Code of Civil Procedure. German courts will exercise a long-arm jurisdiction, if the infringement took place in Germany and the injured party has its residence or location in Germany as well. The local jurisdiction becomes an international jurisdiction. The place of the counterfeiter/defendant is irrelevant.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The rights holder is mainly entitled to the following reliefs against a copyright infringer:

- 1) Injunction to cease and desist the infringing action
- 2) Compensation for damages (if defendant acted with intent or negligence) if not, restitution under general principles of unjust enrichment is possible
 - 2.1) Actual lost profits
 - 2.2) Fair compensation, usually based on a market royalty rate
 - 2.3) Accounting of infringer's profits resulting from use of the infringed work
 - 2.4) Court and lawyer's fees
- 3) Delivery-up or destruction of infringing goods in the possession or ownership of the infringer
- 4) Publication of the court decision
- 5) Removal of infringing goods from the distribution chain, including a recall of products
- 6) Pronunciation of a declaratory judgment
- 7) Rendering of necessary information
- 8) Claims against third parties possessing infringing reproductions of the work, using infringing services or providing services for infringing actions or being involved in the production, distribution or provision of such goods and services

12. Damages/Profits: If available, how do the courts measure damages?

The entitled party is free to choose between three different methods. The level of loss can either be determined using what is referred to as the licensing analogy or the entitled party can demand surrender of the profit it has itself lost or the profit that the infringer has made. When calculating the damages, any profit obtained by the infringer as a result of the infringement of the right may be taken into account, as well as the lost profits of the injured party.

Entitlement to damages may also be assessed on the basis of the amount the infringer would have had to pay in equitable remuneration if the infringer had requested authorization to use the rights infringed (license analogy).

In copyright infringement matters, the license analogy seems to be the most commonly used way to calculate damages.

There is no basis for punitive damages in German law.

13. Damages/Profits: Are there legal minimums and maximums to damages?

There are no legal minimums and maximums to damages. The court has discretion to determine the amount of damages.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

German law provides for a destruction order against those liable as parties at least inducing infringement. Requirements apart from a copyright infringement is to establish that the infringing product is directly or indirectly possessed or owned by the infringing party within Germany.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Yes, some Courts have assigned benches handling copyright and design cases.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

According to S. 102 sentence 1 of the Copyright Act, remedies provided for infringement are subject to limitation.

The *regular* limitation period is three years under S. 195 German Civil Code. The commencement date is determined by S. 199 (1) of the German Civil Code and begins (a) at the end of the year in which the claim shall have arisen (S. 199 (1) no. 1 of the German Civil Code) and (b) the claimant shall have become aware of the circumstances giving rise to the claim and the identity of the infringer or should have become so aware without gross negligence (S. 199 (1) no. 2 of the German Civil Code).

If the injured party shall have either no knowledge or grossly negligent ignorance, *claims for damages* shall become absolutely limited ten years from the date on which they shall have arisen (S. 199 (3) No. 1 of the German Civil Code) and thirty years from the date on which the act, breach of duty or other event giving rise to the damage shall have been committed (S. 199 (3) No. 2 of the German Civil Code). *Other claims that are not claims for damages* shall become absolutely limited ten years after shall have arisen, irrespective of knowledge or grossly negligent ignorance pursuant to S. 199 (4) of the German Civil Code.

The statutory limitation period for legal action against copyright infringements is three years from the end of the year in which the rights holder became aware of the infringing acts.

If the rights holder does not learn about the infringing acts, the statutory limitation period will be ten years starting from the date on which the rights holder first incurred damages due to the infringement.

The absolute limitation period (that is, without knowledge of the infringement and regardless of damages incurred) is thirty years starting from the infringing act.

An application for a preliminary injunction must be filed within a certain time period, which is usually one month after having gained knowledge of the infringement and the infringer.'

17. Key Challenges of Civil Action

Civil proceedings in Germany need to be held in German language. However, the District Courts in Hamburg and Munich have assigned international matters to benches which hear cases in English language. This development is encouraging. Furthermore and more Courts are prepared to hear cases by way of Videoconferencing.

18. Key Benefits of Civil Action

Civil proceedings guarantee the applicant to directly enforce the decision.

Decisions of the civil courts are recognized and enforceable in Germany and in all EU member states by virtue of the Brussels I Regulation. In addition, Germany has concluded bilateral agreements with many countries that guarantee the mutual recognition and enforceability of court decisions.

Civil proceedings can be relatively inexpensive.

Court costs depend on the amount in dispute and are determined according to legal cost tables. At the regional court, fees do not increase even if three judges instead of a single judge are responsible for the decision. The court costs are lower if there is no oral hearing or an amicable agreement between the parties.

Civil proceedings can be relatively fast.

In Germany, compared to other countries, a first instance judgment can be obtained relatively quickly. According to current statistics, it takes 13 months until the regional court announces a decision.

Civil proceedings offer efficient legal protection.

Civil proceedings offer efficient legal protection through the granting of interim injunctions and summary proceedings.

German legislation is developing rapidly to provide better and more assured prosecution of copyrights. Examples are the New rules on equitable remuneration for authors and performers (Gesetz zur verbesserten Durchsetzung des Anspruchs der Urheber und ausübenden Künstler auf angemessene Vergütung), a new exception for scientific research and education (Urheberrechts-Wissensgesellschafts-Gesetz (UrhWissG)) and an amendment to the Telemedia Act concerning WLAN providers and last but not least, the detailed implementation of the amended Art. 17 of the Directive on Copyright in the Digital Single Market (DSM-RL) into the German Act on the Copyright Liability of Online Content Sharing Service Providers (Urheberrechts-Diensteanbieter-Gesetz – UrhDaG).

India

Contributor: Awanika Anand, *Britannia Industries Limited*

1. What "works" are subject to copyright (List in alphabetical order)?

- a. Artistic Works, Architectural works
- b. Cinematograph Films
- c. Dramatic Works, Derivative works
- d. Literary Works
- e. Musical Works
- f. Sound Recordings

2. Is there an exhaustive list of copyrightable works?

There is no exhaustive list available of copyrightable works in the legislation.

3. (If no exhaustive list) List requirements for obtaining copyright protection?

There are three basic requirements for copyright protection: that which is to be protected

- a. must be a work of authorship**
- b. it must be original and**
- c. it must be fixed in a tangible medium of expression.**

To gain copyright protection the work should have the following-

- 1) The work must be original (Original meaning, created from inspiration and not borrowed from any other existing sources. The work must have been created for the first time)
- 2) It must be fixed in some measurable form. The presentation of the work must be descriptive and physical and must be capable of being recognized in a fixed form/recognized in its nature.
- 3) First publication An original work should not be published before.
- 4) Work published after the death of the author; at the time of death, the author must be a citizen of India.
- 5) In the event of work published in India, the author must be a citizen of India at that time.

Copyright protection is not provided for;

- 1) Works not fixed in tangible form.
- 2) Titles, names, short phrases, slogans, methods, factual information, symbols or designs – however,
- 3) trademark law may provide some protection to these works.
- 4) Ideas or concepts, procedures, process, plans, principles, discoveries, and guidelines – however, in such cases patent or trade secret law may provide protections to these works.
- 5) Works that are already in the public domain and original authorship is not traceable are not covered under copyright law.
- 6) Copyright works that are already expired.

4. Is copyright registration required to initiate a civil case?

No

5. Are there any exceptions to the registration requirement to initiate a civil case?

Registration of copyright is not a pre-requisite to initiate a civil action, since copyright subsists from the inception of the work and the balance of convenience lies with the person asserting such right. While there are no exceptions to the registration requirement to initiate a civil case, it is advisable to seek a registration in order to have a valid proof of ownership. This also reduces the burden of proof on the claimant to establish their rights in the work. Once registered, the proof of registration is considered a prima facie evidence in the court of law.

In the case of *Dhiraj Dharamdas Dewani (Appellant) Vs M/s Sonal Info Systems Pvt Ltd*. It was held that unless a copyright owner has a registration for its work, an infringer cannot be deemed

to have knowledge about the owner of the copyright and such knowledge cannot be attributed unless the provisions regarding registration of copyright, publication thereof etc., are complied with.

6. What types of infringement can be used to initiate a civil case?

Primary and Secondary infringement.

Primary Infringement – When the actual act of copying takes place.

Secondary Infringement - unauthorised dealings like selling the pirated books, importing, etc.

The difference between the two being the presence of knowledge with the infringer. In the case of Primary Infringement knowledge of infringement may or may not be present with the infringer.

7. Is there a specialized court(s) to adjudicate copyright infringement cases.?

Civil litigation

The issues related to filing a civil suit including jurisdictional aspects involved are as follows:-

- 1) **Section 62 (1) of the Copyright Act 1957** entails that the suit for infringement cannot be instituted in any court which is inferior to the **District court** having jurisdiction.
- 2) **Notwithstanding, what has been expressed above, there is no bar for filing of such suit in any court which is superior to the District court.**
- 3) The Expression , “**District Court having Jurisdiction**”, in section 62 (2) of the act includes:-
 - A District court within the local limits of whose jurisdiction, at the time of execution of the suit or other proceeding, the person executing the suit or other proceeding resides or carries on business or possibly work for gain.
 - Where there are more than one such persons, any of them actually and voluntarily resides or carries on business or possibly work for gain.
- 4) **Section 62 (2) of the Copyright Act 1957, is an exception to Section 20 of the Civil Procedure Code, 1908**, since clause (c) to Section 20 of the Civil Procedure Code, 1908, pertains to the place where the cause of action wholly or partly arises whereas Section 62 (2) of the Copyright Act 1957 is silent about the similar provision. Therefore in the matter of jurisdiction, following case laws merit consideration:-
 - In the case of *Mohan Meakin Ltd V Kashmir Dreamland Distilleries Would, AIR 1990 , J & K 42*, it was held that it is not necessary that the residents must be permanent or that the office must be registered office. Even if local office is within jurisdiction of the court, it can entertain suit.
 - In **Indian Performing Rights Society Ltd. v. Sanjay Dalia,** the Decision of Delhi High Court was upheld by Honourable Supreme Court of India in not entertaining the suit of infringement at

Delhi. In this case, the plaintiff was carrying on business through a branch office in Delhi, though, their head office was in Mumbai. The alleged 'infringement' had taken place in Mumbai. The Apex Court had the following observations in the said case :-

- The suit can be filed by the plaintiff at a place where he is residing or carrying on business or personally works for gain.
 - However, he need not travel to file a suit to a place where defendant is residing or cause of action wholly or in part arises.
 - On the other hand, if the plaintiff is residing or carrying on business etc. at a place where cause of action, wholly or in part, has also arisen, he has to file a suit at that place.
- 5) **Cease & Desist Notice:** Before filing of the infringement suit, it is always advisable to file a Cease and Desist notice to the infringer, the importance of which has been emphasised upon by the Honourable Supreme Court of India in **Midas Hygiene Industries P. Ltd. and Anr. v. Sudhir Bhatia and Ors., 2004 (3) SCC 90**, especially in the matter of obtaining **injunctions** from the court. While filing **the Cease and Desist Notice**, it is important to incorporate the following in the said **Cease and Desist Notice** issued to the infringer :-

- Name of the Parties.
 - The fact that the work in question is protected by the copyright.
 - The date of the creation of the work i.e when it came into existence.
 - The date of the first publication of the work.
 - The date when copyright registration was done in respect of the work in question . {If at all the registration of copyright was done in favour of the work in question}
 - The description of the manner in which the copyright was violated/infringed upon.
 - A demand of compensation for the loss suffered due to infringement.
 - A demand upon the infringing party to Cease and Desist from any infringing action so as to stop the infringer from violating the rights of the copyright holder.
- 6) **Take down notice under Copyright Rules 2013:** With the advent of technology and an era of digitization, there is a lot of content availability on the World Wide Web which is vulnerable to infringement. Vide section 78 of the Copyright Act, 1957, the Parliament set up Copyright Rules, 2013. Rule 75 of the Copyright Rules, 2013, mandates upon a person whose copyright has been infringed on the internet to serve a notice to the intermediary for taking down of the

infringing content. According to rule 75 (2), a take-down notice must contain the following particulars:-

- Description of the Work.
- Details establishing that the complainant is the owner or exclusive licensee of copyright in the work.
- Details establishing that :-
 - the copy of the work which is the subject matter of transient or incidental storage is an infringing copy of the matter of transient **or**
 - Incidental storage is an infringing copy of the work owned by the complainant and that the allegedly infringing act is not covered under section 52 or any other act that is permitted by the Act.
- Details of the location where transient or incidental storage of the work is taking place.
- Details of the person, if known, who is responsible for uploading the work infringing the copyright of the complainant.
- Undertaking that the complainant shall file an infringement suit in the competent court against the person responsible for uploading the infringing copy and produce the orders of the competent court having jurisdiction, within 21 days from the receipt of the notice.

8. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Civil Remedies

In case, owner of a copyright is of the view that its copyright is infringed as per the provisions of Section 51 of the Act, the owner can initiate civil proceedings against the infringer.

It is always advisable to send a “*Cease and Desist Notice*” to the infringer before approaching the Court. The Hon’ble Supreme Court in, *Midas Hygiene Industries P. Ltd. and Anr. vs. Sudhir Bhatia and Ors., 2004 (3) SCC 90*, held that a cease and desist notice acts as a very important and useful tool for adjudicating cases relating to copyright infringement in favour of the copyright holder. Rule 75 of the Copyright Rules, 2013 further provides for contents of a “*Take Down Notice*” that can be sent by the Copyright Owner to the infringer. It is always favourable to exhaust these remedies before approaching the Court. As per Section 55 (1) of the Act, a copyright owner is entitled to file a suit for injunction, damages, accounts, etc. against the infringer before Court having jurisdiction. However, in case the infringer proves in court that on the date of infringement, the infringer wasn’t aware about existence of copyright in favour of the owner, the copyright owner in such a case can only claim injunction and no other remedy like damages or accounts. The types of

injunctions a copyright owner can claim are Anton Piller order, Mareva junction, permanent & interim/interlocutory injunctions. The awarding of cost in favour of any party to the suit shall be within the discretion of the Court.

Section 60 of the Act provides protection to a person whose being threatened by an owner of a copyright with respect to initiating legal proceedings in respect of an alleged infringement of the copyright. In case a person is being threatened, the person can institute a declaratory suit and claim injunction against such threats and recover damages, in case the same have been sustained by the person due to the threats. Delhi High Court, in *Super Cassette Industries Ltd. Vs. Bathla Cassettes India (P) Ltd*, AIR 1994 Del 237, held that once a suit for infringement for copyright is filed by the person whose given the threat, the suit under Section 60 becomes infructuous as the section ceases to apply in such a situation. Section 62 of the Act, plays an important role in determining the jurisdiction of the court where a party can institute a suit. Section 62 (1) clearly states that a civil suit shall be instituted in District Court having jurisdiction. Section 62 (2) of the Act, acts an exception to Section 20 of the Code of Civil Procedure, 1908 and states that a suit can also be instituted where the person filing the suit voluntarily resides or carries on business or personally works for gain.

The Hon'ble Supreme Court of India, *Indian Performing Rights Society Ltd. v. Sanjay Dalia*, 2015 (10) SCC 161, held that the provisions of Section 62 of the Copyright Act have to be interpreted in the purposive manner. It was held a suit can be filed by the plaintiff at a place where he is residing or carrying on business or personally works for gain. He need not travel to file a suit to a place where the defendant is residing or cause of action wholly or in part arises. However, if the plaintiff is residing or carrying on business, etc. at a place where the cause of action, wholly or in part, has also arisen, he has to file a suit at that place.

9. Do multiple authors all have to join the lawsuit?

Yes. In a work with multiple authors, every author will own copyright, but only to the extent of their contribution in the work.

For example, if a book has two authors, both of them will own the copyright in the content that they have contributed to the book.

10. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. In order to prove copyright infringement, the Plaintiff will have to show that:

- 1) The intermediary had knowledge or means of examining the content in question;
- 2) The group/channel admins have control over the infringing content shared on the channels or groups, to see if they generally exercise editorial control (such as removing posts or filtering messaged), or if they permit unlawful activity despite knowledge of the same;
- 3) Non-compliance by the intermediary of the latest Intermediary Rules, thereby stripping it of its 'safe harbour' protection.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Available remedies

12. What remedies are available against a copyright infringer?

The remedies provided by the Copyright Act, 1957 against infringement of copyright are:

- civil remedies - these provide for injunctions, damages, rendition of accounts, delivery and destruction of infringing copies and damages for conversion;
- criminal remedies - these provide for imprisonment, fines, seizure of infringing copies and delivery of infringing copies to the owner; and
- border enforcement - the Act also provides for prohibition of import and destruction of imported goods that infringe the copyright of a person with the assistance of the customs authorities of India.

13. Can attorneys' fees and costs be claimed in an action for copyright infringement?

Yes. Requests for costs are a standard request in infringement suits. Under section 89 of the Civil Procedure Code, if the dispute is settled between parties, the court may also refund the court fees. The percentage of refund depends upon the court and cannot be pre-empted.

The Commercial Courts, Commercial Division and Commercial Division Appellate Division of High Courts Act 2015 (Commercial Courts Act), by way of new amendments, specifically provides for payments of costs, when such costs will be awarded and the method of calculation.

14. Damages/Profits: If available, how do the courts measure damages?

Monetary damages

15. Are monetary damages available for copyright infringement?

Yes, besides damages the copyright owner can also claim rendition of account of profits.

Money damages in copyright infringement actions are commonly awarded under some combination of three legal theories:

- 1) actual damages
- 2) profits, and
- 3) statutory damages.

Sometimes known as compensatory damages, "actual damages" consist of the amount of any demonstrable loss the copyright owner suffered as a result of the infringing activity. This loss may be from lost sales, lost licensing revenue, or any other provable financial loss directly attributable to the infringement.

This second form of copyright damages consists of any money the infringer earned as a result of the infringement. These damages are awarded only if they exceed the amount of profits lost by the copyright owner (actual damages) as a result of the infringement.

As an alternative to actual damages and profits of the infringer, the Copyright Act allows statutory damages. As its name implies, statutory damage amounts are set forth in the Copyright Act and may be awarded by a judge or jury. Given the difficulties that can arise in proving actual damages and infringer's profits, copyright owners often look to statutory damages to recover their losses.

However, statutory damages are not available for:

- (1) any infringement of an unpublished work commenced before the effective date of its registration; or
- (2) any infringement of copyright commenced after first publication of the work and before the effective date of registration, unless such registration is made within three months after the first

publication of the work. Registration of a work is therefore vital not only to bringing a copyright infringement lawsuit but also to ensuring that statutory damages are available as a remedy.

16. Damages/Profits: Are there legal minimums and maximums to damages?

Criminal enforcement

17. Are there criminal copyright provisions? What are they?

Yes. The Copyright Act, 1957 has provided for enforcement of copyright through a series of penal provisions under Chapter 13 of the Act. The following are the principal penal provisions under the Act:

- 1) Under section 63, where any person knowingly infringes or abets infringement of the copyright in a work and any other right as covered by the Copyright Act, 1957 (broadcast reproduction rights, performers' rights, moral rights, etc), such person may be punished with imprisonment of a minimum term of six months and a maximum term of three years, and a fine of between 50,000 and 200,000 rupees.
- 2) Section 65A penalises circumvention of effective technological measures that may be applied to copies of a work with the purpose of protecting any of the rights conferred under the Act (ie, copyright, performance rights). The punishment under this provision is imprisonment that may extend to two years and payment of a fine. Section 65A was inserted by the Copyright (Amendment) Act, 2012.
- 3) Section 65B makes unauthorised removal or alteration of 'rights management information' punishable with imprisonment of up to two years and payment of a fine. The provision makes the unauthorised distribution, broadcast or communication to the public of copies of the work punishable in the same manner if the person is aware that electronic rights management information in the copy has been removed or altered. Section 65B was inserted by the Copyright (Amendment) Act, 2012.
- 4) Section 63A provides for enhanced penalty on second or subsequent convictions under section 63 (see point (i)).
- 5) Other provisions in the chapter provide penalties for offences such as using infringing copies of a computer program, making or possessing plates for the purpose of making infringing copies of works, and making false entries in the Register of Copyrights.

18. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Limitation period

19. Is there a time limit for seeking remedies?

Yes. The period of limitation for filing a suit for damages for infringement of copyright is three years from the date of such infringement.

Limitation period in case of online Infringement

20. Are there any specific liabilities, remedies or defences for online copyright infringement?

Yes. The 2012 amendments to the Act introduced certain provisions that are specifically relevant to copyright infringement and the internet.

Under the fair use provisions of the Act, section 52(1)(b) provides that transient or incidental storage of a work or performance purely in the technical process of electronic transmission or communication to the public does not constitute infringement of copyright. This provision provides safe harbour to internet service providers that may have incidentally stored infringing copies of a work for the purpose of transmission of data.

Section 52(1)(c) further provides that transient or incidental storage of a work or performance for the purpose of providing electronic links, access or integration that is not expressly prohibited by the rights holder would not be infringement of copyright, unless the person responsible is aware of infringement or has reasonable grounds for believing that such storage is that of an infringing copy.

Under section 52(1)(c), if the owner of a copyright work, in a written complaint to the person responsible for digitally storing an infringing copy of the work, complains that such transient or incidental storage is an infringement, then the person responsible would have to refrain from facilitating access to the infringing copy of the work for a period of 21 days. If within 21 days, the person responsible does not receive an order from a competent court that directs the person responsible to refrain from providing access, then access may be resumed at the end of that period.

Therefore, if A, the owner of a short story, finds that his or her short story has been published on the website of B, he or she may write a complaint to B declaring that B must refrain from providing the public with access to A's short story. B would then have to remove A's short story from visibility or accessibility on his or her website for 21 days, within which time A must persuade a competent court that it should order the complete removal of the infringing version or copy of the work. If the court does not issue such an order within that period of time, then B may resume making the short story available to the public on his or her website. This provision was inserted in the Act by the Copyright (Amendment) Act, 2012 which came into force on 21 June 2012. It is yet to be used in practice.

Apart from the above-mentioned provisions, the entire scheme of the Copyright Act makes it amply clear that all the provisions of the Act must be applied to electronic and digital media in the same manner they are applied to conventional media. The Copyright (Amendment) Act, 2012 has also clarified this in many places. Remedies against copyright infringement on the internet are not dealt with separately under that Act as the provisions sufficiently cover all forms of exploitation of works, including exploitation over the internet, and the remedies for copyright infringement would apply to the internet as they would to any other medium or platform.

Indonesia

Contributor: *Chamelia Sari, PRAWIRANEGARA Intellectual Property*

1. What "works" are subject to copyright (List in alphabetical order)?

The term "works" refers to works in the fields of science, art, and literature, which are created in any of the following forms:

- (1) books, pamphlets, presentations of published works, and all other written works;
- (2) discourse, lectures, speeches and other similar creations;
- (3) teaching materials made for the benefit of education and science;
- (4) songs and/or music with or without subtitles;
- (5) drama, musical drama, dance, choreography, wayang puppet, and mime;
- (6) works of art in all forms such as paintings, drawings, carvings, calligraphy, sculptures, or collages;
- (7) works of applied art;
- (8) architectural works;
- (9) maps;
- (10) batik art or other motif art;
- (11) photographic works;
- (12) Portraits;
- (13) cinematographic works;
- (14) translation, interpretation, adaptation, anthology, database, adaptation, arrangement, modification and other works resulting from the transformation;
- (15) translation, adaptation, arrangement, transformation, or modification of traditional cultural expressions;
- (16) compilation of works or data, either in a format that can be read with a computer program or other media;
- (17) compilation of traditional cultural expressions as long as the compilation is an original work;
- (18) video games; and
- (19) Computer programs.

2. Is there an exhaustive list of copyrightable works?

Yes, it is listed on Article 40 Copyright Law No. 28 Year 2014.

3. If no exhaustive list, list requirements for obtaining copyright protection.

Based on the criteria on Article 40, here are the works that can be protected under copyright:

1. Works that are protected include works in the fields of science, art and literature.
2. Work must be original and not copied from another party.
3. Works that have not been published or have not been made public but have been realized in a tangible form that allows reproduction of said Works.

4. Is copyright registration required to initiate a civil case?

Even though it is not mandatory to file a registration for copyright work(s), it is better to have the registration. The registration certificate can be used as evidence in Court, proving that the person holding the registration certificate is the true owner of the copyright work.

5. Are there any exceptions to the registration requirement to initiate a civil case?

Copyright registration is not mandatory according to Copyright Law No. 28/2014. However, in Indonesia the argument applies "*whoever postulates something, he must be able to prove the argument*". Thus, registration is required to show evidence that the person concerned does have legal standing to file a lawsuit. Beside registration certificate, the court and the judges will also examine whether the person who hold the certificate is the person who created the subject copyright work(s). For example, if he really the artist who painted the paintings, he should be able to shown to the judges that he can paint the disputed painting. It also applies to the songwriter and other copyright's work creator.

6. What types of infringement can be used to initiate a civil case?

- Reproduction, publishing and/or distribution of a copyrighted work – including electronic information; for commercial purposes – without the permission and consent of the author or copyright holder.
- Non-payment of royalties for a creation (eg a book or song) to the Author.
- Breach of a license agreement by one party.
- Changing, mutilating or modifying a copyrighted work without the permission and consent of the Author.
- Piracy of a copyrighted work (copyright piracy).
- Registration of a creation that does not belong to him/her.
- Broadcasting and recording a performance for commercial purposes without the permission and consent of the author, copyright holder and performer of the performance;
- Broadcasting and recording a performance for commercial purposes without the permission and knowledge of the author, copyright holder and performer of the performance;
- Commercial use, reproduction, announcement, distribution or communication of a portrait without the consent of the person being photographed for advertising purposes in both electronic and non-electronic media without the permission of the person concerned.

7. Who has standing to initiate a civil case?

- Author
- Copyright holder
- Heirs
- Exclusive Licensee holder (licensee may also sue under approval of the licensor)
- Performer
- Collective Management Agency
- Producer.

8. Do multiple authors all have to join the lawsuit?

It is not mandatory to join the lawsuit. However, sometimes a co-author needs to be present at court and explain their copyright work(s) in front of judges. For example, the songwriter in a band probably needs to join the lawsuit if they wrote the songs together.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, according to Law No. 28/2014, anyone who violates the economic rights or moral rights of the Copyright Holder whose copyright is listed in Article 40 can be prosecuted legally.

If sufficient evidence is found based on the results of the verification of the report at the request of the complainant, the Minister recommends to the minister who administers government affairs in the field of telecommunications and information technology to close part or all of the content that violates Copyright in the electronic system or make the electronic system services inaccessible.

10. Damages/Profits: If available, how do the courts measure damages?

Unfortunately, the guidelines that serve as a reference regarding the calculation of compensation submitted by the plaintiff (copyright holder) are currently not regulated in the Copyright Law.

Because there are no standard rules yet, in practice the plaintiff usually requests compensation based on the proceeds from the sale of goods or services which constitute copyright infringement.

The compensation amount is determined by calculating how many products have been sold, multiplied by the selling price of the product. There are times when the plaintiff does not get the expected results because the defendant often argues that their product is not selling well and they hand over the product which is the result of copyright infringement to the plaintiff, and then hand it over to the police to be destroyed.

11. If online copyright infringement is actionable, will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Copyright law is territorial and applies on a national scale. In the event of a copyright infringement committed by a person from another country, a lawsuit for infringement must be brought to the court of the country of the person who committed the violation, and will be prosecuted under the provisions of the copyright law of the country's jurisdiction, not under the Indonesian Copyright Law

Specifically, if the infringement is carried out online, as happened in the case of a song that is uploaded on an online platform that belongs to foreign provider, the creator or copyright holder can send a notification to the service provider's platform.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- Injunction;
- Fines
- Letter of Apology
- Confiscation and destruction of infringement products;

13. Damages/Profits: Are there legal minimums and maximums to damages?

There is no minimum or maximum limit in compensation claims.

However, when filing a lawsuit, the plaintiff must convey the basis for calculating the lawsuit he has suffered, so that the compensation demanded meets the limits of reasonableness, ability and justice for the defendant.

14. Post Seizure: How are goods dealt with at end of civil lawsuit?

Products resulting from copyright infringement are confiscated by the court and then destroyed.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

According to Article 95 of Law no. 28/2014 concerning Copyright, Copyright dispute resolution can be done through alternative dispute resolution, arbitration, or court. The competent court is the Commercial Court. Courts other than the Commercial Court are not authorized to handle Copyright dispute resolution.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

In the Copyright Law, there is no time limitation of for taking legal proceeding. As long as the copyright owned by the Plaintiff is still valid, then the Plaintiff as the legitimate copyright holder can take legal action to the court.

17. Key Challenges of Civil Action

- vast territory of Indonesia
- possibility of the defendant eliminating or hiding evidence
- lack of standard rules regarding how compensation is calculated
- Plaintiff has not registered his copyright at the IP office in Indonesia
- Difficulties in tracing the whereabouts of copyright violators in cyberspace
- Even though the court has decided, the claim for compensation is not always fulfilled by the Defendant

18. Key Benefits of Civil Action

- the plaintiff can file a claim for damages against the defendant
- the time required from filing a lawsuit to obtaining a decision is relatively short, which is only 90 days or 3 months.
- The Plaintiff can still file a criminal action

Israel

Contributor: *Luzzatto Law Firm of The Luzzatto Group*

1. What "works" are subject to copyright (List in alphabetical order)?

The works that can be subject to copyright are defined in section 4(a) of the "Israel: Copyright Act, 2007", and must be original works:

- Artistic creation
- Dramatic work
- Literary work
- Musical work

All of the above must be fixed, in any form.

In addition, sound recordings can also be subject to copyright.

Provided that it fulfills one of the conditions set forth in section 8 or that copyright subsists in said works pursuant to Order in accordance with section 9.

2. Is there an exhaustive list of copyrightable works?

The works protected by copyright are defined in the Israeli Copyright Act, 2007.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

As stated above, the list is fixed by the Israeli law, and if necessary, judgments and rulings of the courts in Israel clarify which works are protected and under what conditions and circumstances.

4. Is copyright registration required to initiate a civil case?

There is no registration requirement to obtain copyright in Israel, therefore registration is not required in order to initiate a civil procedure.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No. As written above, in Israel there is no requirement to register copyrights to obtain legal protection.

6. What types of infringement can be used to initiate a civil case?

According to sec 11 of the Israeli Copyright Act, 2007, the copyright owner has the exclusive right to perform one or more actions on the work, or a substantial part of it, as detailed below, depending on the type of work:

- (1) Copying as stated in section 12 - regarding all types of works;
- (2) publication - regarding an unpublished work;
- (3) Public performance as mentioned in section 13 - regarding a literary work, a dramatic work, a musical work and a record;
- (4) Broadcasting as mentioned in section 14 - regarding all types of works;
- (5) making the work available to the public as stated in section 15 - regarding all types of works;
- (6) Making a derivative work as mentioned in section 16, and doing the actions enumerated in paragraphs (1) to (5) in the derivative work as mentioned - regarding a literary work, an artistic work that is not a font, a dramatic work and a musical work;
- (7) Rental as mentioned in section 17 - regarding a record, a cinematic work and a computer program.

A person who does in relation to a work, any of the acts specified above, or who authorizes another person to perform any such act, without the consent of the copyright owner, infringes the copyright, unless such act is permitted pursuant to the provisions of Chapter 4, which relates to Permitted Uses, such as Fair Use.

7. Who has standing to initiate a civil case?

The copyright owner (who does not have to be the author himself, except when it comes to the moral right, which is reserved for the author only and cannot be transferred) whose rights has been infringed, has a standing to initiate a civil case in Israel.

In addition, if a unique license has been granted, the license holder can also initiate a civil case.

A lawsuit due to the infringement of a moral right may be filed by the author, and if the infringement was committed after his death - by his relatives; For this matter, "relative" - spouse, offspring, parent or sibling.

8. Do multiple authors all have to join the lawsuit?

According to the Copyright Law, a plaintiff who files a claim as stated in subsection (a), shall add as a party any person who is entitled to sue according to the provisions of said subsection, but the court may, at the request of the plaintiff, exempt him from adding such a party.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

In accordance with Section 7(b) of the Israeli Civil Procedure Regulations, 2018-57, a lawsuit due to publication or trade on the Internet, shall be filed with the court in whose jurisdiction the place of residence or place of business of the respondent or plaintiff is located; if the plaintiff is a "practitioner" as defined in the Consumer Protection Law, 2018 A-1981, the claim will be filed at the respondent's place of business or residence only.

Therefore, in the case of a practitioner (one who sells property or provides a service through a business, including a manufacturer) as defined in the Israeli Consumer Protection Law, 1981, the lawsuit will be filed at the respondent 's place of business or residence only.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The remedies provided for copyright infringement in Israel are as follows:

- Injunctions
- Damages:
 - Compensation with proof for actual damages.
 - Award without proof of damages in an amount not exceeding NIS 100,000.
- Profits
- destruction of goods,
- an order for rendering accounts,
- an order for transfer of ownership,
- a collection order and an "Anton Piller" order (seizure of assets)

12. Damages/Profits: If available, how do the courts measure damages?

In awarding damages without proof of damages, the court may consider, inter alia, the following:

- (1) The scope of the infringement;
- (2) The duration of the infringement;
- (3) The severity of the infringement;
- (4) The actual injury caused to the plaintiff according to the assessment of the court;
- (5) The benefit derived by the respondent from the infringement, according to the assessment of the court;
- (6) The character of the respondent's activity;
- (7) The nature of the relationship between the respondent and the plaintiff.
- (8) Good faith of the respondent.

If the plaintiff chooses to prove his damage, he will have to provide evidence for the claimed amount. For example, a professional photographer can rely on previous licensing agreements for the use of his photos as a measure of its value, and/or the respondent's sales data regarding photos sold without approval.

When determining the amount of compensation, the court also takes into account whether it is a single act of infringement versus several separate acts, the good faith of the infringer and his actions after learning that he is infringing copyrights, the occupation of the work's author and whether he sells his works and at what price, the scope of the infringement, and more.

13. Damages/Profits: Are there legal minimums and maximums to damages?

The statutory compensation (without proof of damage) is limited to NIS 100,000. Damages compensation requiring proof of damage is not limited.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

According to Israeli law, the infringing goods are not considered the property of the copyright holder. However, at the end of the legal proceedings, the plaintiff may ask the court to order the transfer of ownership of the infringing goods to him. The court may also issue an order to destroy the infringing goods or to perform any other action related to it.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

In Israel there is no court specializing in copyrights, and the substantive authority depends on the value of the lawsuit, which is derived from the requested remedies, when in principle a claim value of over NIS 2.5 million is under the jurisdiction of the district court.

When both monetary relief in an amount lower than NIS 2.5 million and non-monetary relief valued at less than NIS 2.5 million are claimed, the burden of proving that the accumulation of these reliefs removes the claim from the jurisdiction of the Magistrate's Court and brings it within the scope of the district court's jurisdiction, is imposed on the plaintiff.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

In the matter of copyrights, the statute of limitations is seven years. The limitation period begins from the day the cause of action arose. An exception to this is when the plaintiff was not aware of the facts related to the cause of his claim, for reasons beyond his control, then the limitation period will begin on the day the plaintiff became aware of those facts.

In addition, in accordance with the legislation and case law in Israel, if the plaintiff delayed filing the lawsuit, this delay to act will also be taken into account, and can influence the amount of compensation he will receive, if any.

17. Key Challenges of Civil Action

When conducting legal proceedings in Israel in the field of copyright, one should be aware of the following:

First, it must be taken into account that managing legal proceedings can be expensive, and in contrast, the rate of compensation in the field of copyright is not always high. Therefore, it is not always economically "efficient" to act, especially when to the plaintiff is a private person, as opposed to an organization or company.

In addition, it should be considered that in Israel, as a rule, the burden of proof is placed on the plaintiff, and therefore the plaintiff will have to prove his claim in full, including being the owner of the copyright (since there is no regulated copyright registration mechanism in Israel, this may create some difficulty. However, today in the digital age it is much easier to prove ownership of a work than in the past), the act of infringement, that the defendant is the perpetrator of the infringement, proof of damages and more.

Another thing that can cause difficulty is the fact that, as of today, there are no courts specializing in intellectual property, and therefore there is a considerable chance that the lawsuit will be conducted before a judge without expertise or an in-depth background in the field.

Compounding the difficulties in some cases, if the infringement is carried out by someone in the Palestinian territories, the legal process may be complicated because of issues related to jurisdiction.

18. Key Benefits of Civil Action

The handling of the enforcement of intellectual property rights in Israel is in a constant trend of improvement, and we can see that the court's rulings also place great emphasis on maintaining intellectual property rights. This fact helps to create a deterrent towards potential infringers, and a large part of the disputes in the field are resolved through alternative dispute resolution methods, such as conducting negotiations outside of the court, mediation and arbitration.

In addition, the authorities in Israel, such as customs and the Israel Police, also work to protect these rights, and the ability to locate and handle infringing goods is only getting more and more sophisticated.

Italy

Contributor: Marco Francetti & Marina Cristofori - Studio Legale Jacobacci & Associati – Milano

1. What "works" are subject to copyright (List in alphabetical order)?

Article 2 of Law No. 633 of 22 April 1941 (Italian Copyright Law) (ICL) provides that the following works can be protected by copyright:

- 1) architectural plans and works;
- 2) cinematographic artworks, whether silent or with sound form, provided they are not mere documentaries;
- 3) choreographic works and pantomimic works;
- 4) computer programs, in whatever form they are expressed, provided that they are original and result from the author's own intellectual creation. Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, shall be excluded from the protection afforded by this Law. The term "computer program" shall include their preparatory design materials;
- 5) databases, meant as collections of works, data or other independent materials which are systematically or methodically arranged and can be individually accessed by electronic or other means. The copyright protection for databases shall not extend to their contents and shall be without prejudice to any rights subsisting in said contents;
- 6) figurative artworks such as works of sculpture, painting, drawing, engraving, including scenic art;
- 7) industrial designs which themselves have a creative and artistic value;
- 8) literary, dramatic, scientific, didactic and religious works;
- 9) musical works and compositions, musical drama, and musical variations that themselves constitute original works;
- 10) photographic artworks and works expressed with processes analogous to photograph, provided they are not simple photographs.

2. Is there an exhaustive list of copyrightable works?

It is disputed whether the list of copyrightable works provided in the ICL is closed or open, but the prevailing opinion is that it is open.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

Article 1 of ICL and Article 2575 of the Italian Civil Code (CC) provide that a work can be protected by copyright if it is of a creative nature. In order to be protected, the work must be objectively new and have some expressive complexity, which in the literary-scientific field concerns both the so-called internal form, i.e. the way in which the concepts are organised in view of their exposition, and the external form, where not strictly and univocally dictated by the content, but the result of an autonomous work of synthesis.

Although a particularly high level of creativity is not required, it is common ground that copyright protection does not extend to the mere idea, i.e. the mere information contained in the alleged work, since it is necessary that it be expressed in a concrete form.

4. Is copyright registration required to initiate a civil case?

Copyright registration, deposit or notice for existence is not required to initiate a civil case. Copyright is obtained with the creation of the work and therefore no deposit is necessary to obtain the right, being sufficient to prove to be the author of the work. However, in order to facilitate proof of authorship, it is advisable to deposit the work with a body that certifies its date.

5. Are there any exceptions to the registration requirement to initiate a civil case?

As there is no registration requirement, the author shall prove to be the creator of the work and the date of creation.

6. What types of infringement can be used to initiate a civil case?

In Italian copyright law, the violation of rights can occur, both of a moral and patrimonial nature.

The typical copyright infringement cases are:

- the unlawful use of the work;
- the infringement of the work;
- violation of the moral right;
- violation of a neighboring right.

7. Who has standing to initiate a civil case?

According to art. 156 of ICL, any person having reason to fear the infringement of an exploitation right belonging to him under this Law, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, either by the infringer or by an intermediary whose services have been used for that infringement, may start legal proceedings to ensure that his right be recognized and the infringement forbidden.

Therefore, are entitled to bring proceedings: the right holders; after their death, the heirs and legatees; the exclusive licensee of the economic exploitation rights.

8. Do multiple authors all have to join the lawsuit?

All co-authors shall take part in the proceedings concerning the declaration of their status of co-authors, but not in the event of infringement of their rights by third parties. However, in case one of the co-author claims the infringement of its right by another co-author, again all co-author have to join the lawsuit.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes: copyright infringement is prosecuted also in the digital medium/electronic medium/mobile network/Internet, but without specific provisions. The provisions regarding general copyright infringements apply.

Moreover, the Italian Guarantor Authority for Media on December 12, 2013 has approved a Regulation on copyright protection of digital media, which provide for a special procedure aimed at removing the infringing materials from the web.

According to the Regulation, if a qualified person considers that a digital work has been made available on an Internet page in violation of the Copyright Act, he may submit a complaint to the Authority, requesting its removal.

If the infringer's work is not removed voluntarily the Authority shall take the following measures:

- if the server is located in Italy, it orders the service providers who carry out the hosting activities the selective removal of digital works and to take the necessary measures to prevent their upload or, in case of violations of a massive character, to disable access to those digital works;
- if the server is located outside Italy, it may order service providers who carry out activities of mere conduit to disable access to the site.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

If the website reproducing infringed copyrighted work is accessible by Italy or in any case intended for the Italian consumers, the Court may exercise a long-arm jurisdiction over a counterfeiter that is outside its territorial jurisdiction.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The proceedings on the merit regarding copyright infringement is aimed at obtaining:

- the declaration of infringement;
- a declaration of non-infringement;
- a permanent injunction against the infringer;
- a penalty in the event of non-compliance and/or delay in complying with the order given;
- the withdrawal from the market of the infringing goods;
- the destruction of the infringing goods, at the infringer's expenses;
- damage compensation;
- publication of the decision on a national newspaper or on a specialized magazine / website/social network;

- payment of the legal fees and costs (including those related to the preliminary order procedure).

12. Damages/Profits: If available, how do the courts measure damages?

Article 158 of ICL establishes two criteria for determining the amount of compensation for damages, which should be assessed in the light of all the relevant facts of the individual case. In the event of infringement of copyright the right holder may claim compensation for damages and loss of profit, which shall be calculated taking into account also the unlawful profits. The judge may also award damages as a lump sum based on at least the amount of the royalties that would have been due if the infringer had asked the owner for permission to use the right (so called “cost of consent”), i.e. the amount resulting from the application of a market level royalty should the infringer have obtained a regular license.

13. Damages/Profits: Are there legal minimums and maximums to damages?

There are no legal minimums/maximums to damages.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

In case of declaration of infringement, the Judge either order the destruction of the infringing good. However, seizure may not be granted in works resulting from the contribution of several persons, except in cases of particular gravity or when the copyright infringement is ascribed to all co-authors.

The judicial authority may also order, in particularly serious cases, the seizure of the revenues due to the author of the disputed work or product.

The seizure is intended for the safekeeping of objects which the final judgment may order to be destroyed or assigned to the right holder, upon their request.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

Copyright is enforced before the no. 22 Specialized IP Courts, set up by Legislative Decree n. 168/2003, as modified by Law 27/2012, which renamed them to Business Courts, having exclusive jurisdiction in cases involving trademarks, patents, vegetal varieties, utility models, designs, copyright and unfair competition matters related with IP rights.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The actions provided for the protection of intellectual property rights are subject to the ordinary ten-year limitation period, except for actions for damages which are subject to a five-year limitation period from the day on which the event occurred. However, in the case of infringements consisting of several acts, the limitation period runs from the end of the whole infringement.

Moreover, regarding preliminary relief, the national case law considers the requirement of periculum in mora as lacking if the applicant waited for more than 6-7 months after the sending of a Cease and Desist letter before starting the interim proceedings.

17. Key Challenges of Civil Action

Actions on the merit regarding copyright infringement in Italy last approximately 18/24 months (depending on the complexity of the issues involved and on the need of a technical expert). However, the National Recovery and Resilience Plan recently approved has brought a number of specific measures affecting the judicial system. These include, in particular, the provision of reforms aimed at speeding up the running of trials, and specific allocations for the digitization of judicial proceedings, for the management of the backlog of civil and criminal cases and for the efficiency of judicial buildings. These developments are efficient and encouraging.

18. Key Benefits of Civil Action

Civil action in Italy offers a satisfactory price-quality ratio: it is not expensive, is able to obtain enforcement measures identical/very similar to those of other European states and has an average duration.

Moreover, the winning party is entitled to recover all of its legal fees and costs from the losing party, even if, in practice, national courts usually award only part of the legal costs of the winning party (i.e. around 60/70%).

Our procedural system provides two main kinds of actions aimed at obtaining the protection of IP rights:

- 1) Preliminary actions: aimed to obtain preliminary injunctions, seizure, Judicial description, recall orders, publication of the decision; negative declaration of infringement. Those proceedings are very brief (6-7 months) and cost effective!
- 2) Actions on the merit: are necessary in order to confirm the effectiveness of urgent measures granted by the Court, except for injunctions. Moreover, the damage compensation can only be obtained through an action on the merit. Those proceedings are a bit longer but very effective.

Finally it is worth mentioning that the Judges who are part of the Business Courts are highly qualified and experienced in the field of intellectual property rights.

Japan

Contributor: Takehiro Kaneko, *TMI Associates*

1. What "works" are subject to copyright (List in alphabetical order)?

- i. architecture;
- ii. choreography and pantomime;
- iii. cinematographic works;
- iv. computer programming;
- v. maps and other diagrammatic works of an academic nature, such as plans, charts, and models;
- vi. musical works;
- vii. novels, scenarios, articles, lectures, and other literary works;
- viii. paintings, woodblock prints, sculptures, and other works of fine art; and,
- ix. photographic works.

2. Is there an exhaustive list of copyrightable works?

No, the works mentioned in the previous answer is merely an illustrative listing.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

The requirements for obtaining copyright protection are:

- i. The work is an expression of thoughts or sentiments and not a fact or idea;
- ii. The work needs creativity; and
- iii. The work falls within the category of literary, academic, artistic, or musical domain.

4. Is copyright registration required to initiate a civil case?

No, it is not.

5. Are there any exceptions to the registration requirement to initiate a civil case?

As mentioned above, registration is not a requirement to initiate a civil case.

6. What types of infringement can be used to initiate a civil case?

- i) The copyright consists of the following rights so any action that falls within the following without the copyright holder's permission
 - i. right to reproduce the work.
 - ii. right to give a stage performance or musical performance of the work with the purpose of having it seen or heard publicly
 - iii. right to publicly present a work via an on-screen presentation.

- iv. right to transmit to the public that work (this includes the right to make the work available for transmission, if the work is to be transmitted to the public via automatic public transmission).
- v. right to recite the work publicly.
- vi. for an artistic work or of an unpublished photographic work, the right to publicly exhibit the original work.
- vii. for a cinematographic work, the right to distribute copies of that cinematographic work.
- viii. right to make the work available to the public through the transfer of the original work or a copy of the work
- ix. right to make the work available to the public by renting out copies of the work
- x. right to translate the work, compose a musical arrangement of it, reformulate it, dramatize it, make a cinematographic adaptation of it, or otherwise adapt the work.
- ii) Also, moral rights are recognized under Japanese Copyright Act so any infringement to the following moral rights can be used to initiate a civil case:
 - i. for a work not yet made public, the right to make available or present that work to the public. The same applies to any derivative work derived from an original work that has not yet been made public;
 - ii. the right to decide whether to use the author's true name or pseudonym to indicate the name of the author on the original work or in connection with the work at the time it is made available or presented to the public, or to decide that the author's name will not be indicated in connection with that work; and
 - iii. the right to preserve the integrity of that work and its title and is not to be made to suffer any alteration, cut, or other modification thereto that is contrary to the author's intention.
- iii) Furthermore, Print Rights (the right to reproduce the unaltered original work for the purpose of distribution, and the right to transmit the unaltered work to the public using a copy of that work that has been recorded on a recording medium) and Neighboring Rights (certain rights granted to Performers, Producers of phonograms, Broadcasters, Cablecasters) are recognized under Japanese Copyright Act so any infringement to these rights could also be used to initiate a civil case.

7. Who has standing to initiate a civil case?

For a copyright infringement, the owner of the copyright has the standing.

For a moral rights infringement, the author of the work has the standing.

For a Print Rights infringement, the owner of the Print Rights (this would be the publisher in most cases) has the standing.

For a neighboring rights infringement, the owner of the neighboring rights (Performers, Producers of phonograms, Broadcasters, Cablecasters) has the standing.

8. Do multiple authors all have to join the lawsuit?

No, any one of them can bring a lawsuit themselves.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

It cannot be said that the Japanese Court has taken an aggressive measure against this topic but it is considered that if the transmission is from Japan or is meant to be targeted to Japan, Japanese local court may have jurisdiction.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- Injunction
- damages and profits
- order to seize and/or dispose the infringing articles
- attorneys' fees and costs
- measures to restore the author's or performer's honor

12. Damages/Profits: If available, how do the courts measure damages?

(i) Article 114 of the Japanese Copyright Act provides as follows

- i. If the owner of the copyright claims compensation for damage incurred due to infringement, against a person that, intentionally or due to negligence, infringes the owner's copyright, print rights, or neighboring rights, and the infringer has transferred an object that was made through the relevant act of infringement or has made a transmission to the public that constitutes an act of infringement, the amount calculated by multiplying the number of objects so transferred or the number of copies of the work or performance, etc. that have been made as a result of the public's receipt of that transmission to the public, by the amount of profit per unit from objects (including copies transmitted and received) that the owner of the copyright, etc. could have sold if there had been no act of infringement, may be fixed as the amount of damage that the owner of the copyright, etc. has incurred, within the limits of an amount proportionate to the ability of the owner of the copyright, etc. to sell those objects or engage in other related acts; provided, however, that if there are circumstances due to which the owner of the copyright, etc. would have been unable to sell a number of objects equivalent to all or part of the number transferred, etc., an amount proportionate to the number of objects corresponding to such circumstances is deducted from the amount of damage thus calculated.
- ii. If a copyright owner, the owner of print rights, or the owner of neighboring rights claims compensation for damage incurred due to infringement, against a person that, intentionally or due to negligence, infringes the owner's copyright, print rights, or neighboring rights, and the infringer has made a profit from the act of infringement, the amount of that profit is presumed to be the amount of damage that the copyright owner, the owner of print rights, or the owner of neighboring rights has incurred.

- iii. The copyright owner, the owner of print rights, or owner of neighboring rights may fix the amount of damages incurred as being equivalent to the amount of money that the owner should have received in connection with the exercise of the copyright, print right or neighboring right, and may claim compensation therefor against a person that, intentionally or due to negligence, infringes the owner's copyright, print rights or neighboring right.
- iv. The provisions of the preceding paragraph do not preclude any claim to compensation for damage in excess of the amount referred to therein. In such a case, the court may consider the absence of intent or gross negligence by the person that infringed the copyright, print rights, or neighboring rights, in fixing the amount of compensation for the damage.

(ii) Additionally, Article 114-5 provides as follows:

- i. When damage is found to have been incurred in litigation involving infringement of a copyright, print rights, or neighboring rights, if, due to the nature of the relevant facts, it is extremely difficult to prove the facts that are necessary for proving the amount of damage, the court may approve a reasonable amount of damage based on the overall gist of oral proceedings and the results of the examination of evidence.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No, there are no legal minimum or maximums to damages.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Court may order to seize and/or dispose the infringing articles.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

There is Intellectual Property High Court that exclusively hears intellectual property cases for cases having jurisdiction of the Tokyo High Court. Also, Tokyo District Court and Osaka District Court has a Intellectual Property division.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Within 3 years of the infringement and infringer becoming known, or within 20 years of the infringement.

17. Key Challenges of Civil Action

There are no punitive damages so the damages against any copyright infringement is relatively small. This is one of the reasons why copyright holders are sometimes hesitant to file a civil case.

Also, since there is no discovery system in Japan, it is sometimes difficult to obtain evidences that is in possession of the other party.

18. Key Benefits of Civil Action

Cost wise, Japanese civil case is probably less expensive to proceed compared to other countries.

Macau

Contributor: Carlos Duque Simões and Paulo Rowett, *DSL Lawyers*

1. What "works" are subject to copyright (List in alphabetical order)?

The Copyright and Related Rights Law (herein after “**Copyright Law**”, or “**CL**”), pursuant Section 2, (1), states that the following works, provided that they are original, shall be protected:

- a) cinematographic, television, video and other audiovisual works;
- b) databases and other compilations (need to be original in the arrangement of their subject matter or the selection of their contents);
- c) dramatic and dramatico-musical works and the direction thereof;
- d) illustrations and maps;
- e) lectures, speeches, statements and sermons;
- f) musical compositions (with or without words);
- g) parodies and other literary or musical compositions (even if inspired by the theme or subject of another work);
- h) photographic works and others produced by analogous processes of photography;
- i) plans, sketches and three-dimensional works relating to architecture, geography or other sciences;
- j) slogans or mottoes, even for advertising purposes;
- k) texts of literary, journalistic, scientific or any other nature, including computer programs;
- l) works of applied art, industrial designs or models and designer works that constitute artistic creations;
- m) works of choreography or mime that are expressed in written or any other form;
- n) works of drawing, tapestry, painting, sculpture, ceramics, glazing, engraving, lithography and architecture;

2. Is there an exhaustive list of copyrightable works?

No. Section 2, (1) of the CL provides a non-exhaustive list of works that are eligible for protection, provided that they are originals, as per the list stated above.

Additionally, Section 5, (1) of CL further states that copyright protection does not apply to the following works:

- (a) daily news and reports of miscellaneous informative events, however disclosed;
- (b) petitions, allegations, complaints and other texts submitted in writing or orally to public authorities or services;
- (c) texts presented and speeches given to assemblies or other collegiate, political and administrative bodies, or in public debates, on topics of common interest;

(d) political speeches.

3. (If no exhaustive list) List requirements for obtaining copyright protection.

Pursuant to Section 1, (1) of the CL, intellectual creations in the literary, scientific and artistic fields, whatever their type, form of expression, merit, form of communication or purpose, shall be subject to copyright protection, further stating no. 2 of the same section that ideas – as in processes, systems, operational methods, concepts, principles or discoveries - shall not be protected by copyright.

Additionally, the CL further provides legal protection to “related rights of copyright” such as books and periodicals designed by the publisher, performances, audio and video products of the producer or programs from radio and TV stations.

4. Is copyright registration required to initiate a civil case?

No. The right of the author will automatically be subject to protection from the moment the work is created, regardless of any registration or formality. After finishing the work (notwithstanding its disclosure, publication, use or economic exploitation), the author is entitled to seek legal protection.

Copyright protection is automatic (Section 10 of CL) and imprescriptible in Macau. Whilst no registration formalities are required to obtain protection for works, the same will expire 50 years after the death of the creator of said works, according to Section 21 of CL. This applies to posthumous disclosures or publications.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No.

6. What types of infringement can be used to initiate a civil case?

Pursuant Section 56, (3) of CL, it is considered "copyright infringement", the following acts without the express authorization of the author:

- (a) publication of the work;
- (b) performance, recitation, execution, display or presentation in public;
- (c) cinematographic reproduction (including adaptation, performance, distribution and presentation);
- (d) adaptation to any device using mechanical, electric, electronic or chemical reproduction and public performance, including transmission or retransmission by such means;
- (e) dissemination by photography, broadcast or by any other process of reproduction of signs, sounds or images;
- (f) communication to the public, by wired or wireless means;
- (g) distribution of the original or copies of the work to the public, by sale or any other form of ownership transfer;
- (h) translation, adaptation, arrangement, setting to music or any other transformation of the work;
- (i) any use in another work;
- (j) reproduction of the work;

- (k) construction of an architectural work according to the relevant plans;
- (l) rental of the original or of copies of the work, with commercial purposes.

Notwithstanding, private use of protected works is allowed and free of charge, considering **i)** the reproduction of the work is done exclusively for individual private purposes (i. e., the person who executes the reproduction) or **ii)** without gainful intent and in a place open to the public for public use, considering said work (in any form of communication) was already disclosed or made available to the public (Section 60, (2), b) of CL).

7. Who has standing to initiate a civil case?

The owner of the copyright is entitled to initiate a civil case and after the author's death, as long as the work does not fall into the public domain, the rights shall accrue to the successors (Section 43 of CL).

8. Do multiple authors all have to join the lawsuit?

No. Any of the co-authors of a work of joint authorship may exercise, individually, the rights in his personal contribution (Section 15 of CL).

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. According to Section Section 53, (3) of CL the use (including adaptation or transfer to any device) by mechanical, electric or electronic means – namely, digital content via social media – is deemed copyright violation capable of protection from its author.

However, it is possible to use the works without being deemed copyright infringement, on the assumption the user makes a fair use of protected works in private basis, by not economically exploiting protected work and without harming the author's legitimate interests, namely, by misleading the public regarding the authorship of the work. In the event the user shares the work previously made available to the public by the author, without profitable intentions and keeping the accurate authorship of said work, no copyright infringement occurs.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Authors residing in Macau, as well as non-resident authors with works located in Macau, benefit from copyright protection, under Section 50 of CL.

Regarding online copyright infringement, although the counterfeiter may be deemed punishable by copyright infringement, the copyright provisions will not be enforceable outside of Macau.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Infringement of copyright is punishable by imprisonment up to 2 years (or 3 years if the work is unprecedented), capable of conversion into fine up to 240 days, under Section 209 of CL.

Additionally, under Section 203 of CL, the following accessory penalties may apply (individually or combined):

- a) Deposit of good conduct (up to 3 Million Patacas, aprox. USD 371,000);
- b) temporary prohibition from practicing certain activities and professions;
- c) temporary closure of establishments;
- d) permanent closure of establishments;
- e) publication of the infringement decision.

We further note that criminal proceedings regarding appropriation of work (Section 209 of CL), violation of rights of unpublished work (Section 210 of CL) and release in a computer network without authorization (Section 213 of CL) are subject to complaint by the offended, under Section 214 of CL.

12. Damages/Profits: If available, how do the courts measure damages?

In determining the amount of compensation for material damages, the court shall take into consideration the number of unlawful copies that have been released, the economic benefit obtained by the perpetrator/counterfeiter and the damage caused to the author, under Section 201 of CL.

The court shall also take into consideration the non-material damage (“moral damage”) caused by the perpetrator, the circumstances of the infraction, the gravity of the injury sustained and the degree of infringement.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Under a producing or editing contract, in the event material goods are produced above the agreed amount, the author may claim compensation or seek legal seizure of the copies and take possession of them, thus forfeiting to any additional compensation, pursuant Section 80, no. 2 of CL.

Considering other situations where goods are apprehended, after the res judicata of the infringement decision, the Court orders the apprehended goods to be lost in favor of the state, and may opt to destroy them, under Section 171 of the Criminal Code.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

No.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Copyrights protection will lapse 50 years after the death of its creator (Section 21 of CL), while the author's personal rights are imprescriptible, and may be exercised after his death by its successors, pursuant Sections 41 and 43 of CL.

17. Key Challenges of Civil Action

When establishing the compensation, the Court shall take into consideration the number of unlawful copies that have been released, the economic benefit obtained by the counterfeiter and the damage caused to the author. Generally, it becomes a challenge for the author to gather enough evidence to properly quantify the economic losses suffered. In addition, these procedures are generally expensive and time-consuming.

Copyright enforcement in Macau still faces some challenges, due to **i)** lack of practice in pursuing copyrights enforcement and royalties collection by the authors entitled thereon and **ii)** lack of representability from the existing collective management agencies towards the pool of authors. In other words, the most widely recognized collective management agencies are not yet represented in Macau and for that reason do not collect royalties of their authors in the Macau jurisdiction.

18. Key Benefits of Civil Action

Civil action of copyrights may lead to the protection of the author's and other copyright holder's interests, whilst assuring the fair broad communication and distribution of information, further discouraging the economical exploration of protected work and disturbance the breach of author's legitimate interests.

Malaysia

Contributor: Indran Shanmuganathan, *Shearn Delamore & Co.*

1. What "works" are subject to copyright (List in alphabetical order)?

Under Sections 7 and 8 of the Copyright Act 1987, works that are subject to copyright include:

- a) Artistic works including:
 - i. a graphic work, photograph, sculpture or collage, irrespective of artistic quality;
 - ii. a work of architecture being a building or a model for a building; or
 - iii. a work of artistic craftsmanship.
- b) Broadcasts by wire or wireless means, of visual images, sounds, or other information capable of being lawfully received by members of the public or transmitted for presentation to members of the public.
- c) Films, including the sounds of any soundtrack associated with a film, being a fixation of a sequence of visual images on material of any description, whether translucent or

not, so as to be capable by use of that material with or without any assistance of any contrivance:

- i. of being shown as a moving picture; or
 - ii. of being recorded on other material, whether translucent or not by the use of which it can be so shown.
- d) Literary works including:
- i. Novels, stories, books, pamphlets, manuscripts, poetical works, and other writings;
 - ii. Plays, dramas, stage directions, film scenarios, broadcasting scripts, choreographic works, and pantomimes;
 - iii. Treatises, histories, biographies, essays, and articles;
 - iv. Encyclopaedias, dictionaries, and other works of reference;
 - v. Letters, reports, and memoranda;
 - vi. Lectures, addresses, sermons, and other works of the same nature;
 - vii. Tables or compilations, whether or not expressed in words, figures or symbols and whether or not in a visible form; and
 - viii. Computer programs.
- e) Musical works including works composed for musical accompaniment.
- f) Published editions of any literary, artistic, or musical works in Malaysia.
- g) Sound recordings being any sequence of sounds or of a representation of sounds capable of being perceived aurally and of being reproduced by any means, but does not include a soundtrack associated with a film.
- h) Any derivatives of the above.

2. Is there an exhaustive list of copyrightable works?

Yes, insofar as the types of “works” under the Copyright Act 1987 are concerned. However, the definition of each type of “work” is not exhaustive and is not limited to those as set out in the Act.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

The requirements that need to be fulfilled to obtain copyright protection are as follows:

- a) Originality; sufficient skill and effort has been expended in the creation of the work. This is a *de minimis* threshold.
- b) Qualification [i.e. the author is a qualified person within the definition of the Copyright Act 1987 (either a Malaysian citizen or permanent resident or a national of a Berne Convention member country) or the work is first published in Malaysia or any other Berne Convention member country];
- c) Eligibility (i.e. the work falls within one of the categories of work listed in the Copyright Act 1987 which are eligible for copyright protection); and
- d) The work is reduced to material form.

4. Is copyright registration required to initiate a civil case?

At the outset, we wish to highlight that there is no registration system for copyright in Malaysia. Copyright subsists in a work as soon as the said work is reduced to material form (provided that

the requirements of copyright protection i.e. originality, eligibility, qualification and subsistence are met). However, section 26A of the Copyright Act 1987 provides for the possibility of a voluntary notification of the existence of copyright in a work to be made to the Controller of Copyright. The said notification may be made by or on behalf of the author of the work, the owner of the copyright in the work, an assignee of the copyright, or a person to whom an interest in the copyright has been granted by license. The said voluntary notification shall constitute *prima facie* evidence of the ownership of the copyright subsisting in the work. This is also a less costly alternative which has the same effect as a voluntary notification (i.e. *prima facie* evidence of ownership of copyright subsisting in the work), where the owner of the copyright may execute a statutory declaration pursuant to section 42 of the Act (“**the section 42 SD**”). In the context of a civil action, it may be advantageous to have either a voluntary notification or the section 42 SD as it constitutes *prima facie* evidence of ownership of copyright subsisting in the work. The presence of either the voluntary notification or the section 42 SD would result in a shift of the evidential burden to a defendant in a copyright infringement action to disprove the *prima facie* presumption of ownership.

5. Are there any exceptions to the registration requirement to initiate a civil case?

Not applicable.

6. What types of infringement can be used to initiate a civil case?

There are two types of infringement:

- a) Direct infringement – where a person, without the consent of the copyright owner, does or causes another to do any act falling within the exclusive right of the copyright owner; and
- b) Indirect infringement – where a person imports an article into Malaysia for commercial purposes knowing or reasonably knowing that it is an infringing article.

7. Who has standing to initiate a civil case?

- a) Copyright owner(s);
- b) Exclusive licensee, by virtue of Section 38(2) of the Copyright act 1987, which provides that the exclusive licensee shall have the same rights of action and be entitled to the same remedies as if the licence was an assignment;
- c) Non-exclusive licensee, subject to joining the copyright owner as co-claimants.

8. Do multiple authors all have to join the lawsuit?

Insofar as co-ownership in the context of multiple authors is concerned, the general position is that the copyright is held by the said multiple authors as tenants in common in equal shares. As such, a co-owner, may sue for any infringement independent of the co-owners.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet is available under the Copyright Act 1987.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

It is possible that Court will allow an action to be commenced against a person outside of the jurisdiction if it can be shown that: -

- a) The cause of action arose in Malaysia;
- b) The defendant has its place of business in Malaysia; or
- c) The facts on which the proceedings are based exist or alleged to have occurred in Malaysia.

If however the act of infringement does not relate to an act committed in Malaysia, the Copyright Act would not be applicable

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The types of remedies that the court may grant include:

- a) An order for injunction;
- b) Damages;
- c) An account of profits;
- d) Statutory damages of not more than RM25,000 for each infringed work, up to an aggregate maximum of RM500,000;
- e) Additional damages;
- f) Delivery up of infringing articles;
- g) Restrictions on importation of infringing copies; or
- h) A public apology.

12. Damages/Profits: If available, how do the courts measure damages?

The remedy of damages or account of profits is available to a successful plaintiff in a copyright infringement case. Pursuant to section 37(1) of the Copyright Act 1987, an account of profits and damages are mutually exclusive so that one is granted to the exclusion of the other. However an exception to this rule would be section 37(3) of the Copyright Act 1987 which provides that the court may also make an order for an account of any profits attributable to the infringement or prohibited act that have not been taken into account in computing damages. The overriding principle would be the avoidance of double compensation.

Damages

Damages would be calculated and awarded based on the losses, pecuniary or otherwise, suffered by the plaintiff as a result of the infringement, to compensate the plaintiff.

The Court may either award damages based on what it deems fit based on the above principle, or take the 'license fee' approach, which is the fee that the plaintiff would have received from the defendant if a license had been granted to the latter.

Other factors which affect the quantum would include:

- a) The depreciation in the value of the copyright as caused by the infringement;
- b) The injury to or loss of reputation of the copyright owner;
- c) The loss of sales as a result of the infringement;
- d) The nature and purpose of the infringement, whether in relation to commercial matters or otherwise;
- e) Whether there was bad faith;
- f) The conduct of the parties before and during proceedings; and
- g) Whether there is a need for deterrence.

In some cases where the extent of losses cannot be ascertained, the copyright owner may seek statutory damages (as opposed to damages or an account of profits) under section 37(1)(d) of the Copyright Act 1987. Under section 37(8) of the Copyright Act 1987, in awarding statutory damages, the Court shall have regard to: -

- a) the nature and purpose of the infringing act or prohibited act, including whether the infringing act or prohibited act was of a commercial nature or otherwise;
- b) the flagrancy of the infringement or prohibited act;
- c) whether the defendant acted in bad faith;
- d) any loss that the plaintiff has suffered or is likely to suffer by reason of the infringement or prohibited act;
- e) any benefit shown to have accrued to the defendant by reason of the infringement or prohibited act;
- f) the conduct of the parties before and during the proceedings;
- g) the need to deter other similar infringement or prohibited act; and
- h) all other relevant matters.

Further, under section 37(7) of the Copyright Act 1987, the Court is empowered to award additional damages as it may consider appropriate in the circumstances if it is satisfied that it is proper to do so having regard to the following factors: -

- a) The flagrancy of the infringement or prohibited act;
- b) Any benefit shown to have accrued to the defendant by reason of the infringement or prohibited act;
- c) All other relevant matters.

Account of Profits

The basis for ordering an account of profits is that the defendant should be prevented from being unjustly enriched at the expense of the plaintiff and should therefore be deprived of any profit made by the defendant which is attributable to the infringement. This is usually calculated based on the actual profit (after deducting the relevant costs and expenses) derived by the defendant, which is attributable to the infringement.

13. Damages/Profits: Are there legal minimums and maximums to damages?

In assessing damages, there is no legal minimums or maximums that a successful plaintiff may claim. So long as the plaintiff is able to discharge its burden in showing that it has suffered

reasonable losses in light of the defendant's infringing activities (with the necessary evidence adduced in court), the plaintiff may be able to claim the said damages.

Insofar as statutory damages is concerned, it is limited to not more than RM25,000 for each infringed work, up to an aggregate maximum of RM500,000.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

The Court may order the defendant to deliver up all infringing copies in its possession, power, custody, or control for the purpose of destruction. The same may also apply to related articles such as packaging, labels, invoices, bills, documents, and so forth.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

Copyright disputes are adjudicated at the specialised Intellectual Property High Court which sits in Kuala Lumpur, the capital city of Malaysia.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

In accordance with Section 6 of the Limitation Act 1953, an action for copyright infringement must be brought within six years from the date on which the cause of action accrued. This is a moving time frame if the infringement is existing and continuous.

17. Key Benefits of Civil Action

The fruits of litigation are such that it provides affirmation of a work's copyright attributable to certain party and an enforceable judgment. Injunctions are available to halt infringing activities while preliminary/interim injunctions may be granted to restrain the acts of the defendant pending the determination of the case after full trial. The range of remedies which the Court has at its disposal is broad enough to compensate for the consequences of infringement.

18. Key Challenges of Civil Action

There may be difficulties in establishing ownership and subsistence of copyright with regard to the work(s) in question. In addition, insofar as infringement which occurs on the Internet is concerned, there may be practical difficulties in determining the identity of the infringer, let alone the ease of reproduction and dissemination of infringing work over the Internet.

New Zealand

Contributor: Sherridan Cook - partner / Chantal Ottow, solicitor / Tessa Adams, solicitor

Buddle Findlay

1. What "works" are subject to copyright (List in alphabetical order)?

- Artistic works, including graphic works, works of architecture, and any other work of artistic craftsmanship.
- Dramatic works: anything capable of performance. including but not limited to dances, plays, mimes, scripts or scenarios of films.
- Communication works: transmission of sounds, visual images, or other information, or a combination of any of those, for reception by members of the public.
- Films.
- Literary works: any work that is written, spoken or sung, other than dramatic or musical works, and including a table, a compilation of works (which can include directories and databases) or a computer program.
- Musical works.
- Sound recordings.
- Typographical arrangements of published editions of literary, dramatic and musical works.

Most notably, these works are subject to copyright even if they or the goods they relate to are industrial in character. Hence copyright protection in New Zealand extends to protect works for goods as diverse as toys, electrical, mechanical and plumbing componentry, commercial and household furniture and equipment, and container cranes.

2. Is there an exhaustive list of copyrightable works?

Technically, yes. Section 14 of New Zealand's Copyright Act 1994 provides that copyright subsists in an original work provided it falls into one of the above broad categories. To some extent, this forms an exhaustive list, but the categories are interpreted very widely so as to make the list almost non-exhaustive, which allows protection for works that do not fall within one of the traditional categories.

3. (If no exhaustive list) List requirements for obtaining copyright protection.

Copyright vests automatically in the above broad categories regardless of artistic merit, as long as:

- (a) the author is citizen of / resident in / incorporated in New Zealand or a prescribed country;
- (b) the work was first published in or made from New Zealand or a prescribed country; and
- (c) the work is original (and there is a low threshold for originality).

4. Is copyright registration required to initiate a civil case?

Copyright registration is not required to obtain copyright protection in New Zealand and is not required to initiate a civil case.

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A.

6. What types of infringement can be used to initiate a civil case?

- Primary infringement of copyright: infringement of copyright by copying, issuing copies to the public, performance or playing or showing in public, communicating to the public or making adaptation or act done in relation to adaptation.
- Second infringement of copyright: infringement of copyright by importation, possessing or dealing with an infringing copy, providing the means for making infringing copies, permitting the use of premises for an infringing performance or the provision of apparatus for an infringing performance.
-

7. Who has standing to initiate a civil case?

The copyright owner or an exclusive licensee of the copyright owner is able to take legal action against a copyright infringer. The general rule is that the author of the work is the owner, with exceptions being works made in the course of employment, certain works made subject to a commission, and all of this is subject to any contrary agreement that is in place.

8. Do multiple authors all have to join the lawsuit?

There is no requirement for any author to join a lawsuit unless the author is also an owner. As a general rule, all owners must join a law suit.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. The broad categories in New Zealand's Copyright Act 1994 include such works (eg a computer program is included in the definition of a "literary work", moving images are protected as "films" and multimedia can be protected as a "compilation", which is included as a "literary work"). Any work that is digitally recorded should be protected, as the Act states that copyright subsists in a literary, dramatic or musical work "*in writing or otherwise*", which extends to electronic code and therefore captures any recording of a work in digital form. A 2008 amendment to the Copyright Act introduced the "communication work" category, allowing copyright to subsist in any form of multimedia broadcast through a digital medium,

as the category encompasses the transmission of sounds, visual images, or other information, or a combination of any of those, for reception by members of the public.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Where online infringement is actionable in New Zealand, a judgment obtained in a New Zealand court may be enforced over a counterfeiter in another jurisdiction pursuant to any laws relating to the enforcement of judgments between New Zealand and that jurisdiction.

Where online infringement occurs outside New Zealand, a New Zealand court will not assume jurisdiction and the ability to enforce copyright will depend on the laws of the jurisdiction concerned.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Remedies include an account of profits, interim or permanent injunctions, the delivery up of infringing articles, the delivery up of any machinery adapted to make the infringing articles, compensatory damages and additional damages. An account of profits cannot be recovered in tandem with general damages, and the plaintiff must make an election.

Costs are recoverable but are entirely at the discretion of the court. Usually, the successful party will receive a costs award for some legal costs and disbursements.

12. Damages/Profits: If available, how do the courts measure damages?

The availability of damages in infringement proceedings is determined under section 121 of New Zealand's Copyright Act 1994 as follows:

- (1) Where, in proceedings for infringement of copyright, it is proved or admitted that at the time of the infringement the defendant did not know, and had no reason to believe, that copyright existed in the work to which the proceedings relate, the plaintiff is not entitled to damages but, without prejudice to the award of any other remedy, is entitled to an account of profits. Damages are thus not available for innocent infringement.
- (2) In proceedings for infringement of copyright, the court may, having regard to all the circumstances and in particular to:
 - (a) the flagrancy of the infringement; and
 - (b) any benefit accruing to the defendant by reason of the infringement, award such additional damages as the justice of the case may require.

An account of profits is intended to be restorative rather than punitive, to prevent unjust enrichment (and is therefore available despite an infringer's innocence).

Damages are intended to be compensatory and so require proof of actual loss, to put the plaintiff in the position they would have been in but for the infringement of rights, and any additional damages will be on top of that if circumstances allow.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

This will be dealt with by order of the court, which may order delivery up and / or destruction of the seized goods.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

No, legal action for infringement can be taken in New Zealand's usual civil courts, the District Court or High Court (depending upon the size of the claim).

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There is no specific limitation for commencement of legal proceedings in copyright. However, New Zealand's Limitation Act 2010 provides that a money claim must be commenced within six years of the cause of action accruing (with limited exceptions), and therefore provides an effective limitation.

In terms of equitable relief, delay is not a factor except in the case of an interlocutory injunction. A plaintiff who waits for a defendant to breach its rights for some time will not be denied relief (unless there is an element of unconscionability).

17. Key Challenges of Civil Action

Except in the case of blatant infringement, such as in counterfeiting, the key challenge is typically in proving infringement (the three main issues in any infringement action typically being subsistence of copyright, ownership of copyright and infringement).

18. Key Benefits of Civil Action

Given copyright in New Zealand protects industrial works and goods, the key benefits of a successful civil action are often economic, together with deterring any further infringement.

Peru

Contributor: Juan Carlos Durhand Grahammer, *Durand Abogados*

1. What "works" are subject to copyright (List in alphabetical order)?

According to article 5 of Legislative Decree 822 – Peruvian Copyright Law (PCL), protected works shall include the following:

- (a) literary works expressed in written form in books, magazines, pamphlets or other writings;
- (b) literary works expressed orally, such as lectures, addresses and sermons or educational presentations;
- (c) musical compositions with or without words;
- (d) dramatic, dramatic-musical, choreographic and mimed works, and stage works in general;
- (e) audiovisual works;
- (f) works of three-dimensional art, whether or not they constitute applied art, including sketches, drawings, paintings, sculptures, engravings and lithographs;
- (g) works of architecture;
- (h) photographic works and works expressed by a process analogous to photography;
- (i) illustrations, maps, outlines, plans, diagrams and three-dimensional works relating to geography, topography, architecture or science;
- (j) slogans and phrases in so far as they have a literary or artistic form of expression and possess original characteristics;
- (k) computer programs;
- (l) anthologies or compilations of various works or expressions of folklore, and data bases, provided that the said collections are original in the selection, coordination or arrangement of their contents;
- (m) newspaper or magazine articles, whether on current events or not, reports, editorials and commentaries;
- (n) in general, any other product of the intellect in the literary or artistic field that has original character and is susceptible of disclosure or reproduction by any method of process that is or may yet become known.

Further, in article 6 of PCL it is stated that, irrespective of the rights subsisting in the original work and the corresponding authorization, the following shall also enjoy protection as derived works, in so far as they have original character:

- (a) translations and adaptations;
- (b) revised, updated and annotated versions;
- (c) summaries and extracts;
- (d) arrangements of music;
- (e) other transformations of literary or artistic works or expressions of folklore.

Moreover article 7 of PCL it is specified that the title of a work, if it is original, shall be protected as an integral part thereof. Article 8 of PCL mentions that protection shall apply exclusively to the form of expression used to describe, explain, illustrate or include the author's ideas in works

2. Is there an exhaustive list of copyrightable works?

No, the list of copyrightable works provided by article 5 of PCL is not exhaustive. Indeed, at the end of said list express reference is made to a general and open concept of protected work, specifying that protection comprises: *“in general, any other product of the intellect in the literary or artistic field that has original character and is susceptible of disclosure or reproduction by any method of process that is or may yet become known.”*

3. If no exhaustive list, outline requirements for obtaining copyright protection.

Works need to have original character and they have to be susceptible of disclosure or reproduction by any method of process that is known or may yet become known.

4. Is copyright registration required to initiate a civil case?

No, in Peru copyrights registration is not required to initiate civil actions. Article 3 of PCL states that: *“The rights provided for in this Law are independent of the ownership of the material object in which the work is embodied, and the enjoyment or exercise thereof shall not be subject to registration or compliance with any other formality.”*

5. Are there any exceptions to the registration requirement to initiate a civil case?

No, there are no exceptions.

6. What types of infringement can be used to initiate a civil case?

Basically two types: (i) infringement of copyrights and (ii) infringement of related rights According to article 196 of PCL the title holder may ask for *“the cease of the illegal activity of the offender and demand compensation corresponding to material and moral damages caused by the violation and to profits obtained by the offender attributable to the offense and that were not taken into account when calculating the amount of damages (to illicit profit), or at the option of the owner of the law, the pre-established compensation, as well as the payment of costs and costs.”*

7. Who has standing to initiate a civil case?

The owner of the copyright and/or related rights, his representative or the collective societies, as well as the exclusive licensees or other duly authorized licensees, who have the powers and authority to enforce such rights, may initiate actions, according to article 196 of PCL

When the infringement refers to audiovisual works, the persons that can initiate actions are the producers, the grantee or the licensee of the involved rights, as per article 67 of PCL.

When the infringement refers to phonograms, the persons that can initiate actions are the owner of the rights over the phonogram, the grantee or the licensee of the rights over the phonogram or the collecting society representing them, in accordance to article 138 of PCL.

8. Do multiple authors all have to join the lawsuit?

No, in Peru there is no such a requirement. According to article 14 of the PCL

" The co-authors of a work created in collaboration will be jointly the original holders of the moral and economic rights over it, and must exercise their rights by mutual agreement.

If the contributions are divisible or the participation of each of the co-authors belongs to different genres, each of them may, unless otherwise agreed, exploit their personal contribution separately, provided that it does not harm the exploitation of the common work. "

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Yes, if the effect reaches to local territory.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Precautionary measures

According to article 176 of PCL, the Peruvian Copyright Office (PCO) is entitled to order quick and effective precautionary measures, (a) to avoid an infringement of any of the rights recognized by PCL, and in particular to prevent the introduction into commercial distribution circuits of suspected infringing goods, which shall include measures to prevent the entry of imported goods, at least immediately after customs clearance; (b) to preserve relevant evidence concerning the presumed infringement.

As per article 177 of PCL, precautionary measures shall include the following:

- (a) immediate suspension or cessation of the unlawful activity;
- (b) attachment or confiscation, and withdrawal from commercial distribution circuits, of any copies produced or used and of the material or equipment used for the infringing activity;
- (c) conducting inspections, seizures or confiscations without prior notice. The precautionary measure regarding the seizure or confiscation may be applied for only in connection with an infringement action proceeding, regardless of any action that may be taken ex officio.

Sanctions

According to article 186 of PCL, the PCO is empowered to impose sanctions in connection with infringements of copyrights and neighboring rights taking into consideration the seriousness of the offense, the conduct of the infringer throughout the proceedings, the economic prejudice caused by the infringement, the unlawful benefits obtained by the infringer and other criteria the Peruvian Copyright Office may set for each individual case.

Article 188 of PCL establishes that the PCO may impose the following sanctions, either jointly or individually:

(a) reprimand; (b) fine not exceeding US\$ 180,000.00; (c) rectification of omissions; (d) temporary closure of premises, not exceeding 30 days; (e) permanent closure of premises; (f) permanent seizure or confiscation; (g) publication of the PCO's decision at the infringer's expense.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Authorities calculate damages based on direct losses as proven by the copyright owner, and this does include the loss in profit, also storage and logistic expenses, if the case and part or some of attorney fees as damages. The damages are granted discretionary by authorities on a case by case basis.

13. Damages/Profits: If available, how do the courts measure damages?

Authorities act discretionary when defining the minimum and maximum.

14. Damages/Profits: Are there legal minimums and maximums to damages?

During proceedings, the goods are seized and then once authorities decide on the case, verifying the infringement, they may order the definite confiscation of the goods and - depending on the goods - the destruction thereof. The equipment involved in the production of the infringing goods may also be confiscated.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

Strictly speaking, there are no specialized courts in matters of intellectual property.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

According to article 175 of PCL, the lapse of the period during which an infringement action can be brought before copyright authorities occurs after 2 years which are to be counted from the date on which the act that constitutes the infringement ceased.

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Among judges there is a major lack of knowledge concerning copyrights, but also there is a clear lack of interest by the Government and courts to enforce copyrights.

18. Key Challenges of Civil Action

The possibility to claim damages and other forms of harm of protected rights.

Philippines

Contributor: John Paul Cabilao, *Betita Cabilao Casuela Sarmiento*

1. What "works" are subject to copyright (List in alphabetical order)?

The “works” subject to copyright are (1) original works; and (2) derivative works.

Original Works are:

- a. Audiovisual works and cinematographic works and works produced by a process analogous to cinematography or any process for making audio-visual recordings;
- b. Books, pamphlets, articles and other writings;
- c. Computer programs;
- d. Dramatic or dramatico-musical compositions; choreographic works or entertainment in dumb shows;
- e. Drawings or plastic works of a scientific or technical character;
- f. Illustrations, maps, plans, sketches, charts and three-dimensional works relative to geography, topography, architecture or science;
- g. Lectures, sermons, addresses, dissertations prepared for oral delivery, whether or not reduced in writing or other material form;
- h. Letters;
- i. Musical compositions, with or without words;
- j. Original ornamental designs or models for articles of manufacture, whether or not registrable as an industrial design, and other works of applied art;
- k. Periodicals and newspapers;
- l. Photographic works including works produced by a process analogous to photography; lantern slides;
- m. Pictorial illustrations and advertisements;
- n. Works of drawing, painting, architecture, sculpture, engraving, lithography or other works of art; models or designs for works of art; and
- o. Other literary, scholarly, scientific and artistic works.

Derivative Works are:

- a. Collections of literary, scholarly or artistic works, and compilations of data and other materials which are original by reason of the selection or coordination or arrangement of their contents; and
- b. Dramatizations, translations, adaptations, abridgments, arrangements, and other alterations of literary or artistic works.

2. Is there an exhaustive list of copyrightable works?

No. The Intellectual Property Code of the Philippines (“IP Code”) protects “[o]ther literary, scholarly, scientific and artistic works”.

3. If no exhaustive list, outline requirements for obtaining copyright protection.

Original intellectual creations in the literary and artistic domain are eligible for copyright protection by the sole fact of their creation, irrespective of their mode or form of expression, as well as of their content, quality and purpose.

4. Is copyright registration required to initiate a civil case?

No.

5. Are there any exceptions to the registration requirement to initiate a civil case?

None.

6. What types of infringement can be used to initiate a civil case?

Copyright infringement, which gives rise to civil liability, can fall under any of the following types:

- a. Direct Infringement – when a person directly commits copyright infringement;
- b. Vicarious Infringement – when a person benefits from the infringing activity of another person who commits an infringement, if the person benefiting has been given notice of the infringing activity and has the right and ability to control the activities of the other person; and
- c. Contributory Infringement – when a person, with knowledge of an infringing activity, induces, causes or materially contributes to the infringing conduct of another.

7. Who has standing to initiate a civil case?

The copyright owner, his/her assigns or heirs have standing to initiate a civil case for copyright infringement.

8. Do multiple authors all have to join the lawsuit?

No, there is no such requirement. A coauthor may, individually, without the consent of the other coauthors, enforce his/her rights.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. The Cybercrime Prevention Act of 2012 or Republic Act No. 10175 (“Cybercrime Prevention Act”) allows prosecution of criminal actions for copyright infringement if committed by, through and with the use of information and communications technologies.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Yes. Jurisdiction shall lie:

- a. If any of the elements of the crime was committed within the Philippines;

- b. If committed with the use of any computer system that is wholly or partly situated in the Philippines; or
- c. When by such commission, any damage is caused to a natural or juridical person who, at the time the offense was committed, was in the Philippines.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The plaintiff is entitled to the following remedies:

- 1. Temporary and permanent injunction restraining such infringement, including preventing the entry into the Philippine channels of commerce of imported infringing goods;
- 2. Damages (economic and noneconomic damages);
- 3. Attorney's fees and costs; and/or
- 4. Seizure and/or destruction of infringing goods and documents evidencing commercial dealings of such goods

12. Damages/Profits: If available, how do the courts measure damages?

The plaintiff may recover actual damages, legal costs, and other expenses incurred due to the infringement. He/She is also entitled to the profits that the infringer may have made due to such infringement. Pursuant to Section 216.1(b) of the IP Code:

[I]n proving profits, the plaintiff shall be required to prove sales only and the defendant shall be required to prove every element of cost which he/she claims, or, in lieu of actual damages and profits, such damages which to the court shall appear to be just and shall not be regarded as penalty; Provided, That the amount of damages to be awarded shall be doubled against any person who:

- (i) Circumvents effective technological measures; or
- (ii) Having reasonable grounds to know that it will induce, enable, facilitate or conceal the infringement, remove or alter any electronic rights management information from a copy of a work, sound recording, or fixation of a performance, or distribute, import for distribution, broadcast, or communicate to the public works or copies of works without authority, knowing that electronic rights management information has been removed or altered without authority.

...

Section 216.1(e) of the IP Code continues:

The copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in an action a sum equivalent to the filing fee of the infringement action but not less than Fifty thousand pesos (PHP 50,000.00; around USD 1,000.00). In awarding statutory damages, the court may consider the following factors:

- (1) The nature and purpose of the infringing act;

- (2) The flagrancy of the infringement;
- (3) Whether the defendant acted in bad faith;
- (4) The need for deterrence;
- (5) Any loss that the plaintiff has suffered or is likely to suffer by reason of the infringement; and
- (6) Any benefit shown to have accrued to the defendant by reason of the infringement.

In case the infringer was not aware and had no reason to believe that his acts constitute copyright infringement, the court in its discretion may reduce the award of statutory damages to a sum of not more than ten thousand pesos (PHP 10,000.00 [note: around USD 200.00]), *Provided*, That the amount of damages to be awarded shall be doubled [in the foregoing circumstances].

13. Damages/Profits: Are there legal minimums and maximums to damages?

Please refer to the response in #12 above.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Upon order of the court, all infringing copies or devices, as well as all plates, molds, or other means for making such infringing copies, may be destroyed without compensation to the infringer.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases?

No.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Philippine provides for a prescriptive period of four (4) years from the time the cause of action arose.

17. Key Challenges of Civil Action

Filing a civil action for copyright infringement can be costly and time-consuming. In addition, Philippine courts are notorious in awarding low amounts of damages, if at all.

18. Key Benefits of Civil Action

The plaintiff can obtain a preliminary injunction in order to immediately put a stop to the infringing activity pending the civil action.

Poland

Contributor: Tomasz Koryzma, CMS

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) artistic works;
- 2) audiovisual works (including motion pictures);
- 3) dramatic works, dramatic works with music, choreographic works, and pantomimes;
- 4) musical works and textual and musical works;
- 5) photographic works;
- 6) works expressed in words, mathematical symbols or graphic (literary, journalistic, scientific, cartographic and computer programs);
- 7) works of architecture, urban architecture, and urban planning;
- 8) works of industrial design;
- 9) works of string instrument craftsmanship.

2. Is there an exhaustive list of copyrightable works?

No, under Polish law this list is not exhaustive. The subject matter of copyright is each individual creative work, embodied in any form, regardless of its value, designation, or medium of expression regardless of whether it belongs to any of the listed categories in section B.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

To obtain copyright protection the work must be an individual creative work, embodied in any form, regardless of its value, designation, or medium of expression. The work is subject to copyright from the moment it is established, even if it is unfinished.

4. Is copyright registration required to initiate a civil case?

No registration is required. Copyright protection is automatic and independent of any formalities. There is no official public register of works protected by copyright and no certificates are issued to prove copyright protection.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No exceptions. However, there are registers of works kept by various organizations like e.g. ZAIKS (Polish Society of Authors and Composers). Such organizations may issue registration certificates confirming the authorship of the work and date of creation of the work. Such certificates can be used as evidence in a possible trial.

6. What types of infringement can be used to initiate a civil case?

Any unauthorized breach of the scope of someone else's copyright will be an infringement of copyright.

This breach can be:

- a) direct
- b) indirect

7. Who has standing to initiate a civil case?

- 1) copyright owner, author, co-author or their legal successor
- 2) exclusive licensee
- 3) organizations of collective management of copyright and related rights

8. Do multiple authors all have to join the lawsuit?

No, each co-author may pursue claims for infringement of copyright to the entire work.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, it is also supplemented by Act of 18 July 2002 on Electronically Supplied Services.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court. ?

Due to the principle of territoriality, the local court has jurisdiction only with respect to the copyrights infringements which effects reach the local territory.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Author's personal rights protection:

- a) request regarding cessation of further infringements;
- b) remove the effects of the infringement in particular make a public statement of the appropriate content and form;
- c) if the infringement was intentional - the court may award to the author an appropriate amount of money to compensate the damage suffered by him or, at the author's request, oblige the violator to pay an appropriate amount of money for the social benefit identified by the author

Author's economic rights protection:

- a) request regarding cessation of further infringements;

- b) remove the effects of the infringement;
 - c) redress the damage caused:
 - in accordance with general rules, or
 - by paying an amount of money equal to double value of relevant remuneration which, at the time of its enforcement, would be due on account of the right holder's consent to use a work;
 - d) release of obtained benefits
 - e) request the publication of one or more than one press statements having the appropriate content and form or the public announcement of the whole or part of a ruling issued by the court
 - f) at the request of that person who infringed economic copyrights and subject to the right holder's consent, if the infringement was not intentional - payment of appropriate amount of money to the right holder, if stopping the infringement or removing its effects would be disproportionately severe to that person;
 - g) the court, when ruling on the infringement of economic rights, may rule, at the right holder's request, on illegally produced objects and means and materials used to produce them, in particular the court may rule that they be removed from the market, awarded to the right holder on account of the compensation due to him, or destroyed.
- Also, it is possible to apply for: (i) the return of attorneys' fees and costs of the court proceedings, (ii) temporary injunction of the claims and (iii) seizure of the infringing products.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

General rules:

The court determines damages on the basis of proving the guilt, the amount of the damage and the cause and effect relationship. It is possible to claim the loss suffered (damnum emergens) and the benefits that the party could have achieved if the damage had not been done (lucrum cessans).

Amount of money equal to double of the value of relevant remuneration:

The court determines the amount on the basis of proving the fact of infringement and the amount of the appropriate remuneration. It is common that the court appoints an expert in order to determine the amount of the appropriate remuneration.

13. Damages/Profits: If available, how do the courts measure damages?

In case the court orders the infringer to redress the damage caused by paying an amount of money equal to the value of relevant remuneration which, at the time of its enforcement, would be due on account of the right holder's consent to use a work - the maximum amount of such remuneration may be equal to double of relevant remuneration. The court has discretion to define the amount of the appropriate remuneration based on the evidence presented by the parties or/and the expert's opinion.

14. Damages/Profits: Are there legal minimums and maximums to damages?

The court, when ruling on the infringement of economic rights, may rule, at the right holder's request, on illegally produced objects and materials used to produce them, in particular the court may rule that they are removed from the market, awarded the entitled person as compensation or destroyed.

The court takes into account the gravity of the infringement and third person interests.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

In July 2020 specialized IP courts were established in Poland, settling e.g. copyright infringement cases.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

Limitation period amounts to three years from the day when the injured party found out about the damage and about the person liable to redress it or, with due diligence, might have found out about it. However, such a limit may not be longer than ten years from the day when the event causing the damage occurred.

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

As there is not any public official register of copyrights it is difficult to evidence before the court that specific work meets all statutory requirements of copyrightable work protected by relevant copyright provisions. Therefore, it is always up to the court to decide whether specific work meets such requirements. This is particularly important in border line cases when it is not crystal clear whether the work at issue enjoys copyright protection.

18. Key Challenges of Civil Action

It helps copyright owners of unregistered rights to prove their rights and obtain a judgment confirming the ownership of particular work. Such judgments may be used by copyright owners against future infringements.

The establishment in July 2020 of the specified IP courts may speed up the proceedings and make the court judgements more predictable and consistent in similar cases.

Portugal

Contributor: Rita Milhões e Ana Sampaio - *J. E. Dias Costa*

1. What "works" are subject to copyright (List in alphabetical order)?

- Intellectual creations in the literary, scientific and artistic domain, whatever their genre, form of expression, merit, mode of communication and purpose, include

- (a) Books, pamphlets, magazines, newspapers and other writings;
- b) Lectures, lessons, speeches and sermons
- c) Dramatic and dramatic-musical works and their staging
- d) Choreographic works and pantomimes, the expression of which is fixed in writing or in any other form;
- (e) musical compositions, with or without words
- f) Cinematographic, television, phonographic, videographic and radio works
- g) Works of drawing, tapestry, painting, sculpture, ceramics, tiles, engraving, lithography and architecture
- h) Photographic works or produced by any processes analogous to photography
- i) Works of applied arts, industrial designs or models and design works that constitute artistic creation, irrespective of the protection of industrial property
- j) Illustrations and geographic maps
- l) Projects, sketches and plastic works related to architecture, urbanism, geography or other sciences
- m) Mottoes or slogans, even if of an advertising nature, if they are original;
- n) Parodies and other literary or musical compositions, even if inspired by a theme or motive from another work.

2. Is there an exhaustive list of copyrightable works?

No, article 2º of the Portuguese Code on Copyright and Related Rights provides a non-exhaustive list of works that are eligible for protection.

3. (If no exhaustive list) Outline requirements for obtaining copyright protection.

Copyright law in Portugal protects all works of intellectual creation provided that the work is original – personal and individual creative work - and, by any means, exteriorized.

4. Is copyright registration required to initiate a civil case?

No. A work enjoys copyright protection from the moment it is created, regardless of any registration or formality. However, although optional, registration may facilitate, for example, the resolution of disputes over ownership or authorship, financial transactions, assignments, licenses and transfers of rights.

In Portugal, registration of copyright may be done at the IGAC (General Inspection of Cultural Activities).

5. Are there any exceptions to the registration requirement to initiate a civil case?

No.

6. What types of infringement can be used to initiate a civil case?

It is considered "copyright infringement" the following without the express permission of the copyright holder:

- using the work
- distribute or publish the work not distributed or published yet
- to gather or compile published or unpublished works
- who, being authorized to use a work, exceeds the limits of the authorization granted
- to use, as his own creation or performance, a work that is a mere total or partial reproduction of another's work or performance, disclosed or not disclosed, or is so similar as to be without its own individuality
- claiming paternity of a work or performance which one knows does not belong to him
- Attempting against the genuineness or integrity of the work or performance, by practicing an act that distorts it and may affect the honor or reputation of the author or artist.

7. Who has standing to initiate a civil case?

- The owner of the right; owner of moral rights
- natural or legal entity that has organized and directed the creation of a collective work and on whose behalf it has been disclosed or published
- After the death of the author and until the work is on the public domain, the successors

8. Do multiple authors all have to join the lawsuit?

No, each author may be entitled to assert claims arising from violations of the joint copyright.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

The Portuguese courts may have jurisdiction over nonresident counterfeiter but only if the infringement is directed, or at least available, to the Portuguese consumers.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

- Preliminary injunctions

- Damages (economic and noneconomic damages)
- Seizure/Destruction of the infringing works
- Attorney's fees and costs (with limitation established in the law in connection with the court fees paid when filing the action)

12. Damages/Profits: If available, how do the courts measure damages?

In determining the amount of compensation for patrimonial and non-pecuniary losses and damages, the court shall take into consideration the profit obtained by the infringer, the loss of profit and damage suffered by the injured party and the costs incurred by the latter with the protection of copyright or related rights as well as with the investigation and termination of the conduct harmful to his or her right.

In calculating the compensation due to the prejudiced party, the importance of the revenue resulting from the illicit conduct of the infringer shall be taken into account (for example the show or shows illicitly staged).

The court shall also take into consideration the non-material damage caused by the conduct of the infringer, as well as the circumstances of the infraction, the gravity of the injury suffered and the degree of illicit diffusion of the work or performance.

Where it is impossible to fix, under the above, the amount of the prejudice effectively suffered by the injured party, and provided that he or she does not oppose, the court may, as an alternative, establish a fixed amount through recourse to equity, which is based, at least, on the remunerations that would have been received if the infringer had requested authorization to use the rights in question and the expenses borne by that party with the protection of the copyright, as well as with the investigation and termination of the conduct harmful to his or her right.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

If it is concluded for the liability of the infringer and the goods are deemed as counterfeit/fake, the Court orders them to be lost in favor of the state and may decide to destroy them or offer them to charitable institutions if the owner rights agree and in case it is possible to remove the infringing marks.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Yes, the Intellectual Property Court located in Lisbon.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The law does not provide specific limit for commencement of legal proceedings and therefore it will depend on the concrete case.

17. Key Challenges of Civil Action

- The proof of the right namely the date of creation may be a challenge if there are no specific records or registration;
- The proof of the damages by the plaintiff;
- Civil proceedings may be expensive namely if there is appeal to appeal court.

18. Key Benefits of Civil Action

- Acknowledgment of the copyright by a court decision
- Possibility of enforcement of the decision
- The plaintiff may offer all the evidence to support the proceedings and is aware of and notified of all developments.

Russia

Contributor: Anastasia Kuznetsova, *CLAIMS LLM*,

1. What "works" are subject to copyright (List in alphabetical order)?

1. Works of art, literature, and science regardless of the value and purpose of the work:
 - audiovisual works;
 - choreographic works and pantomimes;
 - computer programs (protected as literary works);
 - dramatic and musical-dramatic works, screenplay works;
 - geographic, geological, and other maps, plans, sketches, and plastic works related to geography, topography, and other sciences;literary works;
 - musical works with or without text;
 - photographic works and works obtained by means analogous to photography;
 - works of architecture, city planning, and park and garden art, including in the form of plans, depiction, and models;
 - works of decorative-applied and stage-set art;
 - works of painting, sculpture, graphics, design, graphic stories, comics, and other works of figurative art;

Other works.

2. Also included:

compiled works, i.e., works that constitute by selection or placement of the materials the result of creative labor (e.g., anthology, encyclopedia, database, atlas, or similar works);

derivative works, i.e., works that are a reworking of another work.

3. Part of a work:

For example, its name, a character in the work if by their nature, they can be recognized as an independent result of the creative work of the author.

2. Is there an exhaustive list of copyrightable works?

No, Russian law gives an open list of copyrightable works and provides requirements allowing to define whether a work is copyrightable or not.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

A work should be made by creative labor and expressed in any way that allows other people to perceive it (i.e., in any objective form, including in written or oral form (in the form of a public speech, public performance, and in any other form), in the form of a depiction, a sound or video recording, or a three-dimensional form).

Generally, results of intellectual activity are presumed to be made by creative labor; lack of novelty, uniqueness, or originality does not automatically classify the work as non-creative.

4. Is copyright registration required to initiate a civil case?

No registration or other formalities are required for copyright protection and initiating a civil case.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No exceptions. However, in some cases, obtaining registration could make it easier to prove the fact of creation/existence of copyrighted work and corresponding rights. In Russia, the state official registration system exists only for computer programs and databases (registration is not mandatory). For other works, there exists a deposit system with registers held by various private organizations. These organizations issue certificates confirming authorship of the work, establish the fact and date of creation of the work; these certificates may be used as evidence in a possible trial but the authorship could be challenged during the trial according to the latest decisions of the Russian Supreme Court.

6. What types of infringement can be used to initiate a civil case?

Infringement of an exclusive right, infringement of personal non-property rights, or infringement of other rights (infringement of the right to demand remuneration for the use of the work made for hire, infringement of the right of the person who has organized the creation of a complex object to indicate his name or designation or to demand such indication, infringement of the right of the publisher of encyclopedias, encyclopedic reference works, periodical and continuing collections of scholarly works, newspapers, magazines, and other periodical works to use such publications, to indicate its designation or to demand such indication, infringement of the right of the producer of an audiovisual work, e.g., the right to indicate his name or designation, or to demand such indication).

7. Who has standing to initiate a civil case?

1. rightsholder
2. exclusive licensee
3. organizations of collective management of copyrights and related rights
4. a special person acting on behalf of the owner based on an agreement with the owner concluded in accordance with Art. 1012 of the Civil Code of the Russian Federation

8. Do multiple authors all have to join the lawsuit?

No, all authors don't need to join a lawsuit to enforce collective work. Each of the co-authors has the right to protect their rights independently, including in cases when a work created by co-authors forms an inseparable whole.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. In general, there is no special regulation of prosecution for copyright infringement in the digital (electronic) medium or mobile network (Internet).

However, there is a special regulation of infringement of copyright (except photographic works) on the Internet that allows getting effective preliminary injunctions — blocking access to the website where the disputed object is posted. The relevant claim must be brought within a period determined by the court, which cannot exceed 15 days from the date of the court decision applying interim measures. The only court that provides it is the Moscow City Court, and such preliminary injunctions are provided under the Civil Procedural Code, but not the Arbitration Procedural Code that provides more professional court proceedings. Arbitration courts* can also provide preliminary injunctions, but such measures are not as effective.

** Arbitration courts in Russia are specialized state courts hearing commercial disputes.*

In addition, the information protection legislation provides for a mechanism for out-of-court settlement of disputes on infringement of rights to copyrighted objects on the Internet. The copyright holder has a right to send a copyright infringement statement to the website owner, who is obligated to fulfill the copyright holder's request within 24 hours by stopping access to content that violates copyright or providing evidence of the legality of posting this content. If counterfeit content is removed on time, the site owner, who acts as an information intermediary, is released from liability, provided he did not know and should not have known about the infringement.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court. ?

A copyright action is usually brought to a court with jurisdiction at the location of the counterfeiter (defendant).

If the defendant is located in a foreign state, a claim may be brought at the location of his property in the Russian Federation. Cases relating to copyright infringement (except for rights to photographs) on the Internet are submitted and considered only by the Moscow City Court if the plaintiff has previously applied for interim measures (formally, regardless of whether the defendant is located in the Russian Federation)

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

In case of infringement of personal non-property rights, their enforcement shall be exercised, in particular, by the recognition of a right, restoration of the situation existing before the infringement of the right, prevention of activities infringing on the right or creating a threat of

its infringement, remuneration for moral damages, publication of the decision of a court on the infringement committed.

In case of infringement of exclusive rights, their enforcement shall be exercised by:

1. the recognition of the right;
2. preventing the actions infringing the right or creating a threat of its infringement;
3. reimbursement of damages;
4. seizure of the physical carrier;
5. the publication of the judicial decision on the infringement committed with an indication of the actual rightsholder.

Instead of reimbursement of damages, the rightsholder has a right to demand the infringer to pay compensation for the infringement of their right.

If a legal entity repeatedly or severely infringes on exclusive rights to results of intellectual activity, the court may decide to liquidate such a legal entity at the request of the public prosecutor.

If a natural person makes such infringements, their activity as an individual entrepreneur may be terminated by the court, as provided by the laws.

The winning party is entitled to reimbursement by the other party for legal costs, including attorney fees. In the event of a decrease in compensation, the defendant may also receive compensation for legal expenses in proportion to the reduction of the awarded compensation.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

The court calculates damages based on direct losses and lost profits, as proven by the copyright owner. However, it is generally challenging to prove, so the rightsholder has a right to demand (instead of damages) remuneration payment (compensation).

The Claimant can choose between three methods of calculating compensation:

1. An amount from ten thousand rubles to five million rubles determined at the discretion of the court.
2. Double the value of the counterfeit copies of the work.
3. Two times the value of the right to use the work, considering prices usually set for the work's lawful use in comparable circumstances.

13. Damages/Profits: If available, how do the courts measure damages?

For claims demanding payment of remuneration (compensation) of ten thousand to five million rubles, the Court determines the amount of compensation based on the parties' evidence. The compensation is not set higher than the claim stated by the plaintiff. In exceptional cases, the Court may set the amount lower than the legal minimum.

When determining the amount of compensation, the Court takes into account, in particular, circumstances regarding the object of infringement of rights, the nature of the infringement committed, the period of illegal use of results of intellectual activity, existence and degree of guilt of the infringer, probable property losses of the rights holder, whether the use of the results of intellectual activity, the rights to which belong to other persons, are an essential part of the economic activity of the infringer, and makes a decision based on the principles of rationality and justice, as well as the principle of proportionality of compensation to the consequences of the infringement.

14. Damages/Profits: Are there legal minimums and maximums to damages?

In cases when production, distribution, or other use, as well as importation, transportation, or storage of material carriers that embody a result of intellectual activity or means of individualization lead to infringement of an exclusive right to such result or such means, these material carriers are considered counterfeit and, upon a decision of the court are removed from the market circulation and destroyed without any compensation whatsoever.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

Yes, there is a specialized Intellectual Property Court. However, this Court hears cases related to copyright protection only at the cassation stage.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

There is no limitation period for commencement of legal proceedings for infringement of personal non-property rights.

For infringement of exclusive rights, the limitation period is three years from the day the injured party found out about the damage and about the person liable to redress it or, with due diligence, may have found out about it. This limit may not be longer than ten years from the day when the event causing the damage occurred.

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

- need to engage an expert witness in court to establish a violation of exclusive rights to copyrighted objects; dependence of the court's decision on the expert's conclusions — often, expert findings depend on whether the court approved an expert proposed by a plaintiff or by a defendant

- difficulty proving damages for copyright infringement; the tendency of judicial practice to reduce the amount of compensation for copyright infringement, and an establishment of practice when the amount of compensation is set below the minimum legal limit (such possibility is recognized by the Constitutional Court of the Russian Federation)

- lack of criteria for reducing the amount of compensation, a high degree of discretion of the court when deciding on reducing compensation and setting the final amount of awarded

compensation; the defendant's ability to demand that the plaintiff reimburses the defendant for legal costs in proportion to the decrease in the awarded compensation

- lack of extensive practice regarding interim measures in cases of copyright infringement; difficulty obtaining a court decision to prohibit infringement on copyright in the future

18. Key Challenges of Civil Action

The satisfaction of a civil claim allows the rights holder to obtain recognition by the court of the existence of copyright and the status of an object of copyright, which is not required by law but will make it possible to protect their rights in the future more effectively. The effectiveness of actions to protect copyright contributes to establishing a system of licensing and legal use of copyrighted objects.

Saudi Arabia

Contributor: Munir Suboh, *BSA Ahmad Bin Hezeem & Associates LLP*

1. What "works" are subject to copyright (List in alphabetical order)?

- (1) Written materials like books, booklets and others.
- (2) Works which are verbally delivered like lectures, speeches, poetry, songs and the like.
- (3) Dramatic works, plays, shows and similar presentations which involve motion, sound or both.
- (4) Works which are especially prepared for broadcasting or are presented through broadcasting
- (5) Drawings, works of plastic arts, architecture, decorative art and artistic embroidery and the like.
- (6) Sound and audio-visual works.
- (7) Applied art works, whether handcrafted or manufactured.
- (8) Photographic works and the like.
- (9) Illustrations, geographical maps, designs, plans, sketches and sculptural works related to geography, topography, architecture and science.
- (10) Three dimensional works of geography, topography, architecture or science.
- (11) Computer programs.
- (12) Protection shall include the title of a work, if it is of creative nature, and not a common expression indicating the subject matter of the work.
- (13) Derivative works.

2. Is there an exhaustive list of copyrightable works?

YES to some extent and law refers to groups or types of works with flexible definition to allow all copyrightable works to be included.

3. (If no exhaustive list) Outline requirements for obtaining copyright protection.

Works need to be original and expressed in a tangible medium of expression.

4. Is copyright registration required to initiate a civil case?

No but advisable

5. Are there any exceptions to the registration requirement to initiate a civil case?

Not required for all types of copyrights.

6. What types of infringement can be used to initiate a civil case?

- 1) Direct copyright infringement

2) Contributory infringement can be arguably pursued for some limited remedies if there is clear supportive evidence. It is still difficult to pursue under local laws as the system requires direct losses and direct wrongdoing.

7. Who has standing to initiate a civil case?

- 1) Copyright owner, including author, co-author, holder of financial and/or moral rights
- 2) Exclusive, non-exclusive and/or sole Licensee if authorized to pursue such action
- 3) Commercial agent if it is authorized to initiate such action

8. Do multiple authors all have to join the lawsuit?

No

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court ?

Yes - this is exercised carefully as the enforceability of the judgment can be a question. Generally speaking, if the effect of counterfeit reaches to local territory in KSA it will fall within the remit. Also if the copyright owner has a presence in KSA territory.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

Injunction (administrative attachment orders)

Damages for direct damages and generally difficult to pursue and proof.

No loss in profits are granted. No statutory damages. No punitive damages.

Permanent seizure and disposition of infringing articles by court or administrative authorities.

Publication of judgment in local newspapers.

Minimal attorneys' fees granted

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

The court is not generally willing to provide damages except for direct and actual losses that can be proven. Difficult to prove or pursue and hence copyright owners opt to minimize their expectations from damages. Normally granted on discretionary basis in the range of 5,000 USD up to 20,000 USD maximum, in an exceptional situation.

13. Damages/Profits: If available, how do the courts measure damages?

No

14. Damages/Profits: Are there legal minimums and maximums to damages?

Seizure normally occurs with the administrative authority and products remain seized according to their order. Once decision is issued, destruction occurs and a report is issued to document completion of destruction.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

No court but there is the Saudi Intellectual Property Authority which has its own copyright disputes committee and it rules on copyright disputes and cases.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

One of a few jurisdictions in the world that does not recognize the status of limitation or time bar in KSA as it conflicts with Islamic Sharia's rules and principles.

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

- Still need more precedents for copyright cases.
- Relatively slow in process to rule on disputes.
- Copyright owners may require more trained specialists and IP experts that rule on their cases.
- No statutory damages or punitive damages especially in bad faith cases.
- No clear mechanism in imposing attachment orders and accessibility to law enforcement agencies is still improving.
- No major damages are granted for a relatively high cost process.

18. Key Challenges of Civil Action

It grants a judgment that is enforceable immediately for similar products or incidents.

It gives an official route and gateway to protect IP rights and copyrights from various breaches, such as infringement by manufacturing, importation, or exportation.

It helps copyright owners for unregistered ones to prove their rights and get a judgment, similar to a declaratory order, to affirm their ownership.

It establishes an acceptable legal ground to pursue criminal proceedings against counterfeiters especially in complex cases where copyright owners do not have clear proof of their ownership by way of registration or presentable documents.

Singapore

Contributors: **Dr. Stanley Tze Chang and David Lim Yong Sheng, *Allen & Gledhill LLP***

1. What "works" are subject to copyright (List in alphabetical order)?

Artistic works, including paintings, sculptures, drawings, engravings, photographs, buildings and structures, and other works of artistic craftsmanship.

Cable programmes i.e. a programme which is included in a cable programme service, that is to say, a service which consists wholly or mainly in the sending by means of a telecommunication system of sounds or visual images or both

Cinematographic films i.e. the aggregate of visual images embodied in an article or thing so as to be capable by the use of that article or thing of being shown as a moving picture, or of being embodied in another article or thing by the use of which it can be so shown, and includes the aggregate of the sounds embodied in a sound-track associated with such visual images

Dramatic works, including choreographic shows or other dumb shows if described in writing, or a scenario or script for a cinematograph film

Literary works, including written works, lyrics in songs, articles in journals or newspapers, compilations and computer programmes

Musical works

Published editions of works

Sound broadcasts i.e. sounds broadcast otherwise than as part of a television broadcast

Sound recordings i.e. the aggregate of the sounds embodied in a record

Television broadcasts i.e. visual images broadcast by way of television, together with any sounds broadcast for reception along with those images

2. Is there an exhaustive list of copyrightable works?

Yes, insofar as the categories are prescribed by the Copyright Act. However, the definitions of each "work" are not exhaustive.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

Works must be an authorial creation that is causally connected with the engagement of the human intellect. Copyright protects the expression of original works (as compared to ideas). For the most part, it is a test that applies to originality, except for s 7A. Ng Loy Wee Loon - not-copied test, except for s 7A, which applies the XXX test

4. Is copyright registration required to initiate a civil case?

No. Singapore does not have a system of copyright registration.

5. Are there any exceptions to the registration requirement to initiate a civil case?

Not applicable.

6. What types of infringement can be used to initiate a civil case?

The Singapore Copyright Act provides for direct copyright infringement in the form of doing any of the acts provided for in the copyright, and authorising the doing (s 31), as well as secondary infringement (s 32 / 33)

7. Who has standing to initiate a civil case?

1. The owner of the copyright; and
2. By virtue of section 123 of the Copyright Act, the exclusive licensee of the copyright, as defined in section 7 of the Copyright Act i.e. the holder of a licence in writing, signed by or on behalf of the owner or prospective owner of copyright, authorising the licensee, to the exclusion of all other persons, to do an act that, by virtue of this Act, the owner of the copyright would, but for the licence, have the exclusive right to do.

8. Do multiple authors all have to join the lawsuit?

As highlighted in the response to Question 7 above, the right to enforce copyright belongs exclusively to (i) the owner of the copyright, or (ii) the exclusive licensee of the copyright. However, assuming that joint authors are also joint owners of copyright, they do not have to enforce the jointly-owned work collectively.

Under section 7 of the Copyright Act, a “work of joint authorship” is defined as “a work that has been produced by the collaboration of 2 or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of other authors”.

However, generally, the author of a literary, dramatic, musical or artistic work shall be entitled to any copyright subsisting in the work: section 30(2) of the Copyright Act. Similarly, the copyright in subject matter other than works vests in the maker, publisher, or provider of the work: sections 97 – 101 of the Copyright Act.

Joint owners of copyright may be joint tenants or tenants in common. However, there is no general requirement that joint authors must collectively enforce a jointly-owned work. Joint owners may bring an action for infringement individually. However, the position between joint owners may be subject to contractual stipulations to the contrary, such that one joint owner may require the other joint owners to support the enforcement of the copyright or otherwise render assistance.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, the offences in the Copyright Act do not distinguish between physical copyright infringement and other digital or electronic forms of copyright infringement. Copyright infringement may occur in digital or electronic form, or on mobile networks/on the Internet. In particular, section 136(3A) of the Copyright Act has been considered in the context of end-user

piracy of compact discs (CD) and other digital media, in addition to section 136(3) of the Copyright Act.

Additionally, the wilful removal or alteration of rights management information as well as the circumvention of technological measures applied in connection with the exercise of copyright for the purposes of commercial advantage or financial gain constitute offences which primarily impact copyright in the digital or electronic mediums.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court. ?

The Copyright Act provides that, for infringement to occur, the act of infringement must be committed in Singapore. However, assuming this is satisfied, it is possible to bring a claim against a counterfeiter based overseas.

The jurisdiction of the Singapore courts in civil proceedings is founded upon service of the relevant originating process upon the putative defendant. As such, the courts will exercise long-arm jurisdiction over a counterfeiter if it can be shown that one of the limbs under Order 11 Rule 1 of the Rules of Court is satisfied, including:

- (i) a claim founded on a tort, wherever committed, which is constituted, at least in part, by an act or omission occurring in Singapore; or
- (ii) a claim wholly or partly founded on, or is for the recovery of damages in respect of, damage suffered in Singapore caused by a tortious act or omission wherever occurring.

As copyright infringement is considered a statutory tort, it is potentially possible to bring an action against a perpetrator overseas.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Section 119 of the Copyright Act provides that, in an action for an infringement of copyright, the types of relief that the court may grant include:

- (a) an injunction (subject to such terms, if any, as the court thinks fit);
- (b) damages;
- (c) an account of profits;
- (d) where the plaintiff has elected for an award of statutory damages in lieu of damages or an account of profits, statutory damages of —
 - (i) not more than \$10,000 for each work or subject-matter in respect of which the copyright has been infringed; but
 - (ii) not more than \$200,000 in the aggregate, unless the plaintiff proves that his actual loss from such infringement exceeds \$200,000.

The court may also order any infringing copy, or any article which has been used for making infringing copies, in the possession of the defendant or before the court to be delivered up or forfeited to the plaintiff, or destroyed or otherwise dealt with as the court thinks fit.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Damages are generally compensatory in nature, and are intended to put the injured party back in the position he would have been in had the infringement not occurred. The copyright owner must therefore prove that he has suffered loss as a result of the copyright infringement, and that the loss suffered is not too remote.

Additionally, where the plaintiff seeks an award of statutory damages under section 119(2)(d) of the Copyright Act, the court shall have regard to —

- (a) the nature and purpose of the infringing act, including whether the infringing act was of a commercial nature or otherwise;
- (b) the flagrancy of the infringement;
- (c) whether the defendant acted in bad faith;
- (d) any loss that the plaintiff has suffered or is likely to suffer by reason of the infringement;
- (e) any benefit shown to have accrued to the defendant by reason of the infringement;
- (f) the conduct of the parties before and during the proceedings;
- (g) the need to deter other similar infringements; and
- (h) all other relevant matters.

The courts also have the power to award additional damages, in situations where:

- (a) an infringement of copyright is established; and
- (b) the court is satisfied that it is proper to do so, having regard to —
 - (i) the flagrancy of the infringement;
 - (ii) any benefit shown to have accrued to the defendant by reason of the infringement; and
 - (iii) all other relevant matters.

However, if, at the time of the infringement, the defendant was not aware, and had no reasonable grounds for suspecting, that the act constituting the infringement was an infringement of the copyright, the court will not award damages.

The Copyright Act also provides that a claim for damages as well as a claim for an account of profits are not inconsistent, subject to a general prohibition against double recovery. In particular, under section 119(2A) of the Copyright Act, the court may award damages, as well as an account of profits in respect of profits attributable to the infringement that have not been taken into account in computing the damages.

13. Damages/Profits: If available, how do the courts measure damages?

There are no legal minimums and maximums to general damages, as long as the damage suffered can be proved.

However, where the plaintiff has elected for an award of statutory damages in lieu of damages or an account of profits, the Copyright Act limits the quantum of statutory damages to not more than \$10,000 for each work or subject-matter in respect of which the copyright has been infringed, and not more than \$200,000 in the aggregate, unless the plaintiff proves that his actual loss from such infringement exceeds \$200,000.

14. Damages/Profits: Are there legal minimums and maximums to damages?

Under section 120 of the Copyright Act, the court may make an order that any infringing copy, or any article which has been used for making infringing copies, in the possession of the defendant or before the court to be delivered up to the plaintiff.

An application may also be made to the court for an order that an infringing copy or other object delivered up pursuant to an order made under section 120 be —

- (a) forfeited to the plaintiff; or
- (b) destroyed or otherwise dealt with as the court thinks fit.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

There are no specialist intellectual property courts in Singapore. However, at first instance, civil proceedings for copyright infringement are heard in the High Court by a specialised list of Judges with an expertise in intellectual property disputes.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

As copyright infringement is a statutory tort, infringement proceedings must be brought within the limitation period of six (6) years from the date on which the cause of action occurred. However, it should be noted that the limitation period only applies to the filing of the writ to commence the action. Following the filing of the writ, a plaintiff has six (6) months to serve the writ on the defendant (or 12 months if the writ is to be served out of jurisdiction): Order 6 Rule 4(1) of the Singapore Rules of Court (“ROC”). The Court may also extend the validity of the writ for 6 months from time to time: Order 6 Rule 4(2) of the ROC.

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There are various considerations that copyright owners and/or exclusive licensees should have regard to prior to instituting a civil action against a putative infringer. Even prior to commencing an action, in many cases, it may be a challenge to establish the necessary locus standi (i.e. subsistence of copyright, authorship and/or ownership). This is especially the case for copyright works which were not authored by the current owners or exclusive licensees. If ownership cannot be proved, the action for infringement may be struck out for want of locus standi.

Potential plaintiffs may also wish to consider potential evidential challenges, such as the ability to obtain evidence of infringement and consequential loss, and the availability of remedies which would achieve the plaintiff’s purposes. For example, the unavailability of injunctive

remedies may well be of concern to a plaintiff which wishes to ensure that the infringing party ceases its infringing acts.

Additionally, there are practical difficulties in bringing infringement proceedings in certain cases. For example, where infringement occurs online, it may be difficult to identify and locate the infringer.

The protection of artistic works in Singapore is also limited by the operation of sections 70 and 74 of the Copyright Act, which carve out artistic works which are properly suited for protection under the Registered Designs Act (Cap. 266) from being protected as artistic copyright works.

Copyright infringement proceedings may also be relatively lengthy and costly.

18. Key Challenges of Civil Action

Singapore has instituted fairly wide-reaching and thorough protections for copyright works. This includes providing for civil proceedings between private individuals, as well as criminal offences in respect of certain acts of infringement.

In light of the potential evidential difficulties of establishing locus standi, the Copyright Act provides for various presumptions that may be called to aid in a civil suit. For example, copyright is presumed to subsist in the work or other subject-matter, and where the subsistence of the copyright is established, the plaintiff shall be presumed to be the owner of the copyright if he claims to be the owner of the copyright, if the defendant does not put those questions in issue: section 130(1) of the Copyright Act. Even if the defendant does in good faith put those questions into issue, an affidavit in which the plaintiff makes assertions that copyright subsists in the work or other subject-matter; and that he is the owner of the copyright, constitutes prima facie proof of the matters stated therein until the contrary is proved. Pre-action discovery processes such as Norwich Pharmacal orders are also available to potential litigants.

The range of remedies under the Copyright Act also provides a broad spectrum of redress for the owner or exclusive licensee of the copyright work, including statutory damages, additional damages, and the availability of an account of profits in addition to damages. Furthermore, civil procedure in Singapore allows for the successful litigant to claim a proportion of party-and-party costs arising from the civil suit. The Copyright Act also provides for other forms of remedies at the right owner's disposal which can be applied for judiciously in a civil action, including injunctions, as well as the delivery up and forfeiture or destruction of infringing articles: sections 120 and 120A of the Copyright Act.

Singapore has also recently introduced enhancements to its border control measures to further restrict the import and export of infringing goods via the Intellectual Property (Border Enforcement) Act 2018, such as by granting further powers to Customs officials to inspect, seize, and dispose of goods or articles which infringe copyright.

In the realm of online piracy, Singapore has instituted statutory provisions which enable owners of copyright to apply to court for orders to disable access to flagrantly infringing online locations. In 2018, Singapore became one of the first jurisdictions to grant a dynamic site-

blocking order. This site-blocking order allows a copyright owner to submit a request that further domain names be blocked to the relevant Internet Service Providers, obviating the need to make a fresh application to court. Under a dynamic site-blocking order, internet service providers are required to prevent access to online locations which are found to be infringing. Additionally, providers would have to block any additional domain names which lead to the same infringing online locations upon receiving notification of additional domain names.

Finally, it should be noted that in Singapore, civil and criminal remedies function alongside each other to provide a holistic backdrop of copyright enforcement. It is possible for the owner or exclusive licensee of the copyright work to bring a civil action against a putative infringer in conjunction with action taken by public authorities. For example, Singapore's border control measures in respect of infringing products or articles operate on both an ex-officio basis (where the authorities have the power to seize and inspect goods which they reasonably suspect to be infringing copies of copyright material) and pursuant to a private request (where the copyright owner or licensee may give written notice to the authorities requesting that infringing copies of the copyright material be seized).

In the same vein, there is no restriction against criminal proceedings being brought at the same time as civil proceedings. Evidence that is proved in civil proceedings may be used in criminal proceedings. A conviction or acquittal in the course of criminal proceedings may also be adduced as evidence for the purpose of proving, where relevant to any issue in the proceedings, that the defendant committed (or, as the case may be, did not commit) that offence, whether or not he is a party to the proceedings; and where he was convicted: section 45A of the Evidence Act (Cap 97).

Spain

Contributor: *Dr. Cristina Hernández-Martí Pérez, HERNANDEZ MARTI ABOGADOS*

The Spanish Copyright Law is: Royal Legislative Decree 1/1996, of 12 April 1996, approving the Revised text of the Intellectual Property Law, which regularizes, clarifies, and harmonises the legal provisions in force on the matter. Hereinafter, **LPI**.

1. What "works" are subject to copyright (List in alphabetical order)?

- books, pamphlets, printed matter, correspondence, writings, speeches and addresses, conferences, forensic reports, lectures and any other works of the same nature.
- musical compositions, with or without words
- dramatic and dramatic-musical works, choreographies, pantomimes and, in general, theatrical works
- cinematographic works and any other audiovisual works
- sculptures and works of painting, drawing, engraving, lithography and graphic cartoons, comic strips or comics, as well as their essays or sketches and other plastic works, whether applied or not.
- projects, plans, models and designs of architectural and engineering works.
- graphs, maps and designs relating to topography, geography and, in general, to science.
- photographic works and works expressed by a process analogous to photography.
- computer programs.

Art. 10.1 LPI

2. Is there an exhaustive list of copyrightable works?

No, it is not an exhaustive list.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

It can be protected by copyright provided the work is an original creation. Art. 10.1 LPI states it will be protected "all original literary, artistic or scientific creations expressed by any means or in any medium, tangible or intangible, now known or to be invented in the future"

4. Is copyright registration required to initiate a civil case?

No. Registration is not required. All original work expressed by any means or any medium, tangible or intangible is automatically protected. Nevertheless, it is advisable that in order to submit evidence to the Court in a copyright infringement case to have enough proof. Some means of evidence on when was the "work" created, e.g.: a notarial act; a Burofax (so a letter which certifies the content of it) ... Therefore, registration is not a requirement but the copyright owner needs to prove when was the work created.

5. Are there any exceptions to the registration requirement to initiate a civil case?

There is no exception as there is no requirement.

6. What types of infringement can be used to initiate a civil case?

It is considered infringement to reproduce, distribute, transform or communicate to the public the work protected by copyright. (Art. 17 to 21 LPI)

In 2014 the LPI was amended to include second liability for those who indirectly infringe copyright. Art 196 LPI state that the copyright owners may bring the actions against those who, knowingly or with reasonable grounds to know, circumvent any effective technological measure. the same actions may be brought against those who manufacture, import, distribute, sell, rent, advertise for sale or rent or possess for commercial purposes any device, product or component, as well as against those who provide any service which, in respect of any effective technological measure:

- (a) is promoted, advertised, or marketed for the purpose of circumventing protection; or
- (b) has only a limited commercial purpose or use outside the circumvention of protection; or
- (c) is primarily designed, produced, adapted, or realized for the purpose of enabling or facilitating the circumvention of protection.

7. Who has standing to initiate a civil case?

The author of the copyrighted work (Art. 17 LPI); those who have acquired exclusive transfer of the rights (Art. 48 LPI) *“It also gives it standing, independently of that of the owner, to pursue infringements affecting the powers granted to it.”* and copyright collecting societies (Art. 150 LPI)

8. Do multiple authors all have to join the lawsuit?

Three cases of join authorship:

collaborative works: a collaborative work is the result of the joint participation of several authors in the production of an original creation. It includes both works in which it is possible to distinguish the contribution made by each author and those in which this delimitation is not possible. Art. 7 LPI.

The intellectual property rights in a collaborative work shall belong to all the authors in the proportion determined by them. As far as not provided for in this Law, the rules established in the Civil Code for community of property shall apply to these works. The protection of these economic rights may be requested by one of the co-authors acting on interest of the others. Consequently, any of the authors may, on an individual basis, apply for the protection of the work as a whole.

collective works: Collective works are characterized by the intervention of a person who takes the initiative to elaborate the work, performs the coordination functions and is responsible for publishing and disseminating it under his or her name. Consequently, unless otherwise agreed,

this person becomes the exclusive owner of all exploitation rights over the collective work. The authors who have contributed to it retain their rights over the work of their authorship (over their contribution); they will never hold any rights over the collective work obtained as a result. Art. 8 LPI

composed works: A new work shall be considered a composed work if it incorporates a pre-existing work without the collaboration of the author of the latter, without prejudice to the author's rights and the necessary authorization of the latter. In order to determine the legal standing for the protection of these works, it is necessary to establish to whom the ownership of the exploitation rights over the result of the creative activity is attributed. The author of the new original creation will be the owner of the rights over the composite work, without the creator of the pre-existing work having any rights over it. Without prejudice to the need to obtain the consent of the latter in order to carry out any act of exploitation of the work obtained as a result. Art. 9 and Art. 21.2. LPI

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. According to Art. 270.2 and 270.3 of the Spanish Criminal Code

“2. The same penalty shall be imposed on anyone who, in the provision of information society services, with the intention of obtaining a direct or indirect financial benefit, and to the detriment of a third party, actively and non-neutrally facilitates, without limiting himself to purely technical processing, access to or the location on the Internet of works or services that are the object of intellectual property without the authorization of the owners of the corresponding rights or their assignees, in particular by offering ordered and classified lists of links to the works and content referred to above, even if these links were initially provided by the recipients of his services.

3. In such cases, the judge or court shall order the removal of the infringing works or services. When, through an Internet access portal or information society service, the content that is the object of the intellectual property referred to in the previous paragraphs is disseminated exclusively or predominantly, the interruption of the provision thereof shall be ordered, and the judge may order any precautionary measure aimed at protecting intellectual property rights.

Exceptionally, when there is a repetition of the conduct and when it is a proportionate, efficient, and effective measure, the blocking of the corresponding access may be ordered.”

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court.?

When the harmful event has occurred in Spanish territory, the Spanish courts shall have jurisdiction (Art. 22 quinquies b) Organic Law No. 6/1985 of July 1, 1985, on the Judicial Power) or when the offence has been committed within Spanish territory (Art. 23.1 Organic Law No. 6/1985 of July 1, 1985, on the Judicial Power)

If the infringer is not in Spain, it will be necessary to refer to Law 29/2015, of 30 July, on international legal cooperation in civil matters. Title I of the Law regulates the general regime of international legal cooperation and applies to requests for legal cooperation on the service of judicial and extrajudicial documents and the taking of evidence.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

The specific remedies for copyright cases (Art. 138 LPI):

- Action for cessation of the infringer's unlawful activity
- compensation for material and moral damages caused
- request the publication or dissemination of all or part of the court decision in the media at the infringer's expense.

Art. 139 LPI refers to what the cessation of the unlawful activity may include:

- (a) suspension of the infringing exploitation or activity,
- (b) prohibiting the infringer from resuming the infringing operation or activity.
- c) The withdrawal from trade of the infringing copies and their destruction, including those in which the information for electronic rights management has been removed or altered without authorisation or whose technological protection has been circumvented.
- d) The withdrawal from commercial channels, the disabling and, if necessary, the destruction of moulds, plates, matrices, negatives and other material elements, equipment or instruments intended principally for the reproduction, creation, or manufacture of infringing copies.
- e) the removal or sealing of equipment used in the unauthorized communication to the public of works or performances, as well as of those in which information for the electronic management of rights has been removed or altered without authorization,
- f) confiscation, disablement and, if necessary, destruction of the instruments, at the infringer's expense, whose sole use is to facilitate the unauthorized removal or neutralization of any technical device used to protect a computer program. The same measures may be taken in relation to devices, products, or components for circumvention of technological measures and for removing or altering information for the electronic management of rights
- (g) the removal or sealing of instruments used to facilitate the unauthorized removal or neutralization of any technical device used to protect works or other subject-matter, even if that is not its only use
- h) the suspension of services provided by intermediaries to third parties who use them to infringe intellectual property rights, without prejudice to the provisions of Law 34/2002 of 11 July 2002 on information society services and electronic commerce.

In declaratory proceedings, the costs of the proceedings at first instance shall be borne by the party who has been unsuccessful in all his claims, unless the court finds, and gives reasons for finding, that there were serious doubts as to the law or fact of the case (Art.394 Law 1/2000, of 7 January, on Civil Proceedings). The costs in the proceedings (Art. 241 Law 1/2000) may include:

1. *Fees for the defence and technical representation when these are mandatory.*
2. *Insertion of notices or edicts that must be published in the course of the proceedings.*
3. *Necessary deposits for the filing of appeals.*
4. *Expert's fees and other payments to be made to persons who have taken part in the process.*
5. *Copies, certifications, notes, testimonies and similar documents which must be requested in accordance with the law, except those which are requested by the court from public registers and records, which shall be free of charge.*
6. *fees payable as a result of actions necessary for the development of the process.*
7. *The fee for the exercise of jurisdictional powers, when mandatory.*

Costs charged to a litigant that are not subject to an official scale, cannot exceed one-third of the amount of the claim, unless the court considers a party to have been reckless as to costs (Art. 394 Law 1/2000). Attorneys' fees are not totally recoverable because costs only include fees stipulated by local law societies.

12. Damages/Profits: If available, how do the courts measure damages?

Damages are regulated under Art. 140 LPI. The damages due to the owner of the infringed right shall include not only the value of the loss he has suffered, but also the value of the profit he has lost as a result of the infringement of his right. The amount of damages may include, where appropriate, the costs of investigation incurred in obtaining reasonable evidence of the commission of the infringement which is the subject of the legal proceedings.

Art. 140.2 LPI regulates how are the damages measured. The damages shall be fixed, at the option of the injured party, according to one of the following criteria:

(a) the negative economic consequences, including the loss of profits suffered by the injured party and the profits which the infringer has derived from the unlawful use.

In the case of non-pecuniary damage, compensation shall be payable, even if the existence of economic loss is not proven. The assessment shall be based on the circumstances of the infringement, the seriousness of the injury and the degree of unlawful dissemination of the work.

b) the amount that the injured party would have received as remuneration, if the infringer had requested authorisation to use the intellectual property right in question.

The amount of compensation may include, where appropriate, the costs of investigation incurred in obtaining reasonable evidence of the commission of the infringement which is the subject of the legal proceedings. (Art. 140 LPI)

13. Damages/Profits: Are there legal minimums and maximums to damages?

No. It must be taken into consideration in Spain they are no punitive damages, since compensation is always connected to the actual harm suffered.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

The infringing products and/or the means used to carry out the infringement are destroyed (Art. 139 LPI).

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

The commercial courts will know of the copyright cases (Art. 86bis Organic Law 6/1985 of 1 July 1985 on the Judiciary).

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The damaged party has a period of five years to bring an action to claim damages. It is a limitation period and the counting is from the time when the injured party was able to exercise the action. (Art. 140.3 LPI)

17. Key Challenges of Civil Action

- To proof the originality of the work, meaning original that it reflects the personality of its author, as an expression of his free and creative choices
- Verification that it is copying and not a derivative work. Whether substantial or incidental copying has taken place.
- proof of the ownership of the work and the date of its creation
- criteria for calculating damages

18. Key Benefits of Civil Action

- Spanish decisions are enforceable in Spain and in EU territory (Regulation 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)

Sweden

Contributor: Tobias Kempas, *Advokatfirman Vinge KB, Sweden*

1. What "works" are subject to copyright (List in alphabetical order)?

Any literary or artistic work may be subject to copyright protection (provided that the protection requirements are met) regardless of whether it is

- i. an architectural work or applied art;
- ii. a computer program;
- iii. cinematographic work;
- iv. a fictional or descriptive written or oral expression;
- v. a musical or dramatic work;
- vi. a photographic work or any other work of fine art;
- vii. a work expressed in some other manner.

2. Is there an exhaustive list of copyrightable works?

No. Any literary or artistic object can be subject to copyright protection (can be a "work"), if it fulfils the protection requirements.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

Copyright protection applies to the *expression* in any form as long as it is *original* in the sense that it is the author's own intellectual creation. Accordingly, under Swedish copyright law, two conditions must be satisfied for a work to be considered protectible by copyright: (a) The expression in the work must be sufficiently precise for identification, and (b) it must be original to the author. As in other European legal systems, a creative work is the author's own if it reflects the personality of the author—in the nature of a personal right rather than merely as a property right.

4. Is copyright registration required to initiate a civil case?

No.

5. Are there any exceptions to the registration requirement to initiate a civil case?

n/a

6. What types of infringement can be used to initiate a civil case?

Subject to certain limitations, copyright protection includes an exclusive right to exploit a work by *making copies of the work* and *making the work available to the public*, in either the original or an altered form, via a translation or adaptation, in another literary or artistic form, or in another technical manner.

Any direct or indirect, temporary or permanent preparation of copies of the work, regardless of the form or through which method this is carried out and regardless of whether it concerns the work in whole or in part, is considered as “*making copies*”.

The work is being “*made available to the public*” (i) when the work is being communicated to the public, (ii) when the work is publicly performed, (iii) when copies of the work are publicly exhibited and/or (iv) when copies of the work are placed on sale, leased, lent, or otherwise distributed to the public.

Any such (unauthorized) use of a work constitutes an infringement and may be subject to civil proceedings, provided that no limitations apply.

In addition, aiding or abetting an act that constitutes an infringement constitutes *secondary* infringement and may be subject to civil proceedings.

7. Who has standing to initiate a civil case?

The author, his successor in title, or any party who has the right to exploit the work as a duly appointed licensee, can commence civil proceedings. In addition, a collecting society can sue for copyright infringement if the member (copyright holder) has empowered the society to legally represent it in court proceedings.

8. Do multiple authors all have to join the lawsuit?

No. If multiple authors have contributed to the work, each author is entitled to bring an action before the court if an infringement has occurred.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Any infringement may be subject to court proceedings. Infringement in the digital medium is regulated in the same way as any other infringement.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

There is no case law which provides a conclusive and general answer to this question. The answer must thus be based on an analysis of what a Swedish court could and is likely to do in view of applicable general rules on international jurisdiction (such as the Brussels I Regulation) and the specific aspects that arise in connection with intellectual property disputes. In general, a Swedish court will have jurisdiction if the harmful event occurred in Sweden, i.e. if the damage occurred in Sweden or if Sweden is the place of the event giving rise to the damage. However, if the infringer is not domiciled in a Member State of the Brussels I Convention, the situation becomes more difficult to assess. The position among most Swedish legal scholars appears to be that a Swedish court is competent, under national procedural law, to try a dispute

concerning compensation for damage caused in Sweden by a counterfeiter domiciled outside the Brussels I Convention area.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs)?

11.1 Injunctions

Generally, injunctions will be granted under two circumstances: (a) to prevent an attempted infringement or one in preparation, or (b) to cease a the continuation of an ongoing infringement or the aiding or abetting of such an infringement.

Preliminary injunctions are also available under Swedish law. Not only will the potentially be granted in cases of “imminent” infringement but also for attempted infringement or an infringement then in preparation to occur. However, the claimant must show probable cause for two essential facts: (a) that an act constituting an infringement or a contribution to it is occurring or is being prepared or attempted, and (b) that it can reasonably be expected that the infringing act will thereby diminish the value of the copyright. A preliminary injunction is issued subject to a default fine. It will remain in place pending the final adjudication of the case or until further order of the court. A security deposit will be required of the defendant to apply toward any damage found to have been caused by the infringement.

11.2 Reasonable compensation and damages

Copyright holders are entitled to reasonable compensation. For that reason, if an infringing act should be found to have been committed either willfully or due to negligence, additional damages will be awarded to the rights holder. The test for determining the extent of any such damages are as follows:

- i. lost profits to the rights holder;
- ii. profits made by the infringer;
- iii. damage to the reputation of the work;
- iv. moral rights damages; and
- v. the interest of the rights holder in avoiding infringement of the work.

11.3 Forfeiture

Unless clearly unreasonable, property and profits in connection with the infringement may be declared forfeited. In lieu of property, the value of the property may be declared forfeited

11.4 Infringement investigation

If it can be reasonably assumed that someone has committed, aided or abetted an infringement, for the purpose of preserving evidence, the court may order an infringement investigation to

search for objects or documents that can be assumed to be of importance for the inquiry into the infringement.

11.5 Other measures

The court can decide that property involved in an infringement should be recalled from the market, altered or destroyed or that some other measures should be taken. The same applies to means of assistance that have been, or are intended to be, used in connection with an infringement.

At the petition of the plaintiff, the court may also order the party that has committed, or contributed to, the infringement to pay a pecuniary compensation for appropriate measures to disseminate information about the judgement in the case.

11.6 Compensation for litigation costs

The general rule in the Swedish Code of Judicial Procedure is that costs follow the event. That is, the loser pays the winner's litigation costs.

12. Damages/Profits: If available, how do the courts measure damages?

See the answer under Section 11.2 above.

Financial awards fall into two categories:

Reasonable compensation: That is the standard award. The primary basis is the established market price for the use in question. If there should be no such market price, the court may calculate reasonable compensation based on its assessment of submitted evidence. Reasonable compensation is not pegged to actual damages and can be either higher or lower than actual damage or loss.

Damages:

The core premise is that damages are awarded for actual damages suffered by the rights holder due to an infringement. Punitive damages are not available under Swedish law. The amount to be awarded as damages is resolved by examination of the evidence. Damages are not awarded to the extent the financial harm has been addressed by the award of reasonable compensation.

13. Damages/Profits: Are there legal minimums and maximums to damages?

In principle, there are no legal minimums or maximums. Calculation of reasonable compensation and potential damages will be based on the evidence presented.

14. Post Seizure: How are goods dealt with at the end of a civil lawsuit?

The court may, at the request of the rights holder, decide that property involved in a civil lawsuit regarding copyright infringement shall be recalled from the market, altered or destroyed or that some other measure shall be taken. These provisions apply to all copyright protected works,

except for the construction of an architectural work and, shall be paid for by the defendant, unless specific reasons dictate otherwise.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Copyright is enforced in the Patent and Market Court (at first instance) and the Patent and Market Court of Appeal. These are specialized intellectual property courts created on 1 September 2016.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The Swedish Copyright Act has no limitation period regarding the initiation of civil infringement action. As a consequence, the general 10-year statute of limitations from the accrual of the claim applies.

17. Key Challenges of Civil Action

One of the plaintiff's main challenges is to present sufficient evidence in respect of reasonable compensation and, if applicable, additional damages.

For certain types of subject matter, it is also quite difficult to convince the court that the originality requirement is met, i.e. that the plaintiff actually owns exclusive rights to a copyrighted work. Typically, works of fine art (e.g. industrial designs) will present the greatest challenge in this respect. Sports broadcasts is another example.

In complex cases, litigation costs may be high.

18. Key Benefits of Civil Action

There is a wide range of remedies available to the plaintiff (cf. above).

Judges with specialist legal expertise are required for civil copyright cases in the Patent and Market Courts. In main hearings in criminal cases, the general rule is that a district court panel consists of one qualified judge and three lay judges (and, in principle, any adult can become a lay judge).

In general, Swedish court proceedings are quick, compared to many other European countries. Swedish court judgments are also recognized and enforceable in all EU Member States.

Switzerland

Contributor: *Chantal Bolzern, BKS Attorneys Ltd.*

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) Literary, scientific and other linguistic works;
- 2) Musical works and other acoustic works;
- 3) Works of art, in particular paintings, sculptures and graphic works;
- 4) Works with scientific or technical content such as drawings, plans, maps or three-dimensional representations;
- 5) Works of architecture;
- 6) Works of applied art;
- 7) Photographic, cinematographic and other visual or audiovisual works;
- 8) Choreographic works and works of mime;
- 9) Computer programs.

The list is not exhaustive, the law is designed to be open-ended (see Article 2 of the Swiss Copyright Act (Urheberrechtsgesetz - URG): Works are all literary and artistic intellectual creations with individual character, irrespective of their value or purpose).

2. Is there an exhaustive list of copyrightable works?

No. There can be other types of works, that are not included in the list. Any type of "work result" of a human being is copyrightable if it is an intellectual creation with individual character (see above).

3. If no exhaustive list: List requirements for obtaining copyright protection.

See section 2 above: A work needs to be an own intellectual creation of the author who has to be a human being (s. Article 2 Section 1 URG). It requires personal and intellectual activity in the sense of intellectual content and design. The work has to be individual, but the purpose is irrelevant. Therefore, also photographs for advertisements or an industrial design can be copyrightable.

4. Is copyright registration required to initiate a civil case?

No. Switzerland doesn't have a public register where an author can document or register their work. Through its creation, a work is automatically protected by copyright.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No, as there is no registration requirement. In court, the rights holder must state and prove that they hold the relevant rights, either directly as the author or via contract.

6. What types of infringement can be used to initiate a civil case?

The infringer violates or threatens to violate:

- 1) an exclusive right of the author or rights holder
- 2) an author's moral right
- 3) an exclusive neighboring right protected under the Swiss Copyright Act.

7. Who has standing to initiate a civil case?

- 1) Author or performer (neighboring rights) can sue for infringement of their rights unless these rights have been exclusively licensed to someone else.
- 2) Exclusive licensee: within the scope of the exclusive license, the licensee has standing to sue unless expressly excluded in the licensing contract.
- 3) Non-exclusive licensee: not generally entitled to enforce, but may be authorized by the licensor to do so.
- 4) Collecting societies: have standing to sue under general principles, e.g. if they have been granted an exclusive license.

8. Do multiple authors all have to join the lawsuit?

No, each joint author shall be entitled to assert claims arising from violations of the joint copyright; they can, however, demand performance only to all of the joint authors.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, since the same rules apply to the online world as to the offline world. The Swiss Copyright Act is neutral in questions of technology.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Swiss law does not recognize a long arm jurisdiction.

If the infringer offers their services (physical or digital goods) on the internet also to potential customers in Switzerland, jurisdiction by virtue of tort can be established. As there are no specific remedies for online infringement, the question of jurisdiction is answered by the general rules of the Swiss Code of Civil Procedure. Swiss courts may exercise a long-arm jurisdiction, if the infringement takes or took place in Switzerland and the injured party (rights holder) has their residence in Switzerland. The place of residence of the infringer is irrelevant.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

The rights holder is mainly entitled to the following reliefs against a copyright infringer:

- 1) Injunction to cease and desist the infringing action.
- 2) Compensation for damages (if defendant acted with intent or negligence) if not, restitution under general principles of unjust enrichment is possible:
 - 2.a) Actual lost profits or
 - 2.b) Compensation, usually based on a market royalty rate or
 - 2.c) Accounting of infringer's profits resulting from use of the infringed work and
 - 2.d) Court and lawyer's fees.
- 3) Delivery-up or destruction of infringing goods in the possession or ownership of the infringer.
- 4) Publication of the court decision.
- 5) Removal of infringing goods from the distribution chain, including a recall of products.
- 6) Pronunciation of a declaratory judgment.
- 7) Rendering of necessary information.
- 8) Claims against third parties possessing infringing reproductions of the work, using infringing services or providing services for infringing actions or being involved in the production, distribution or provision of such goods and services.

12. Damages/Profits: If available, how do the courts measure damages?

The entitled party is free to choose between three different methods. The level of loss can either be determined using

- a) what is referred to as the licensing analogy (see below) or
- b) the entitled party can demand surrender of the profit they have lost themselves or
- c) the profit that the infringer has made.

In case of choosing the “licensing analogy”, the court assesses the damages on the basis of the amount the infringer would have had to pay in remuneration if the infringer had requested authorization to use the rights infringed.

There is no basis for punitive damages in Swiss law.

13. Damages/Profits: Are there legal minimums and maximums to damages?

No.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Swiss law provides for a destruction order against those liable as parties at least inducing infringement. For obvious reasons, this does not apply to works of architecture, i.e. buildings.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

Yes, by law every Canton has to have one specialized court, although in reality these courts regularly judge copyright cases alongside trademark or general commercial law matters.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

The statutory limitation period for legal action against copyright infringements is 3 years from the day on which the rights holder became aware of the infringing acts and the identity of the infringer.

If the rights holder does not learn about the infringing acts, the statutory limitation period will be 10 years starting from the date on which the infringer committed the infringing acts or - if those acts occur during a time period - on the day the infringer stopped their infringing acts.

17. Key Challenges of Civil Action

Often, rights holders struggle to prove that they actually are rights holders if they are not the original author since their licensing contracts especially in film and music are not specific enough in mentioning the relevant works or recordings etc.

Civil proceedings in Switzerland need to be held in the official regional language (German, French or Italian) which makes it often necessary to have all relevant documents which should be used as evidence to be translated.

18. Key Benefits of Civil Action

Civil proceedings guarantee the rights holder to enforce the decision. Decisions of the civil courts are recognized and enforceable in Switzerland and via bilateral agreements with many countries that guarantee the mutual recognition and enforceability of court decisions.

Civil proceedings can be relatively inexpensive regarding court costs.

Court costs depend on the amount in dispute and are determined according to legal cost tables. The court costs are lower if there is no oral hearing or an amicable agreement between the parties.

Civil proceedings offer efficient legal protection.

Civil proceedings offer efficient legal protection through the granting of interim injunctions and summary proceedings.

Taiwan

Contributor: Crystal J Chen, Tsai, Lee & Chen

1. What "works" are subject to copyright (List in alphabetical order)?

The Copyright Act provides a non-exhaustive list of works subject to copyright protection (Art. 5), as rearranged in alphabetical order:

1. Architectural works.
2. Artistic works.
3. Audiovisual works
4. Computer programs.
5. Dramatic and choreographic works.
6. Musical works.
7. Oral and literary works.
8. Photographic works.
9. Pictorial and graphical works.
10. Sound recordings.

2. Is there an exhaustive list of copyrightable works?

No.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

In a broad definition, a creation that is within a literary, scientific, artistic, or other intellectual domain can be a copyrightable work (Art. 3.1.1). A work is copyright protected if it suffices the following requirements, namely, a work has to (1) have originality; (2) be completed; and (3) be objectively presentable in an external form of expression perceivable by humans.

Furthermore, a work must not be any of the following matters that are excluded from being copyrightable (Art. 9):

1. The constitution, statutory law, regulations, or official documents from the governmental authorities.
2. Translations or compilations by central or local government agencies of works referred to in the preceding subparagraph.

3. Slogans and common symbols, terms, formulas, numerical charts, forms, notebooks, or almanacs.

4. Oral and literary works for news reports that are intended strictly to communicate facts.

5. Test questions and alternative test questions from all kinds of examinations held pursuant to acts or regulations.

4. Is copyright registration required to initiate a civil case?

No, registration is not a pre-requisite to initiate a civil action based on copyright,

5. Are there any exceptions to the registration requirement to initiate a civil case?

N/A

6. What types of infringement can be used to initiate a civil case?

(1) Direct infringement on economic rights of copyright, such as reproduction, distribution, public transmission and display. Direct infringement on the moral rights of an author, such as public release, identity, bar against distortion and mutilation.

(2) Contributory infringement can be arguably pursued if a direct infringement is found.

7. Who has standing to initiate a civil case?

Only the Copyright holder or the plate rights holder has standing to sue. (Art. 84) The exclusive licensee within the scope of the license also has independent standing to litigate in its own name; while the economic right holder cannot exercise rights within the scope of exclusive license. (Art.37.4)

For moral right infringement, only the author has standing to sue and such a right cannot be transferred or succeeded. However, after the death of the author, unless specified by a will, the following persons in order shall be entitled to request remedies (Art. 18 and 86):

1. Spouses
- 2.Children
- 3.Parents
- 4.Grandchildren
- 5.Brothers and sisters
- 6.Grandparents

8. Do multiple authors all have to join the lawsuit?

For moral right infringements, all joint authors' consents are required to initiate a lawsuit; whereas joint authors may designate one or several delegates in the proceedings. A joint author shall not refuse consent without a legitimate reason. (Art. 19) Therefore, multiple authors all have to join the lawsuit.

For copyright infringement on economic rights, each joint owner has independent standing to sue, but the proceeds from an action shall be distributed among all joint owners in proportion to every one's own share in the copyright.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. There is criminal liability for copyright infringement occurred in the digital medium, electronic medium, mobile network and Internet. According to Article 100 of the Copyright Act, criminal prosecution for any kind of copyright infringement is not actionable without a copyright owner's complaint. However, for online infringement or infringement in digital form, the prosecution is actionable *ex officio* without a complaint in the event that:

- (i) there is digital reproduction of work with the intent to sell or rent, or
- (ii) distribution of copies of work reproduced in digital form, knowing that it infringes on economic rights of others,
- (iii) and the aforementioned copyright infringement causes more than one million NT dollars injury.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

Yes. In determining if a Taiwanese court has jurisdiction over an infringement activity that is cross-border in nature, several factors may put into consideration, such as:

1. The infringement result firstly occurs in the territory of Taiwan;
2. A part of the infringing acts or a part of the infringing results occur in Taiwan.

Other factors to be often considered are frequency of transportation and Internet communication, the accused infringer's major marketplace, closeness of languages and cultures. Relevant parties' convenient accessibilities to a court, territorial relevance, impartialities, procedural fairness and efficiency may have also been put into consideration.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

1. Injunctions (temporary and permanent)
2. Damages claim if the infringer has willfulness or negligence
3. Statutory damages and punitive damages are available
4. Destruction of or other necessary disposals against infringing tools or products
5. Recovery of identity
6. Reputation recovery by publishing judgment on news media

12. Damages/Profits: If available, how do the courts measure damages?

Damages can be claimed based on actual loss of copyright holder, if it is hard to prove, then it may be based on copyright holder's profit difference before and after the infringement activity.

Damages may also be claimed based on profits of the infringer. If the infringer cannot prove its necessary costs and spent, the revenue from the infringing activity will be deemed as the infringer's profit.

If none of the above can be proved, the court may also exercise its discretion to award statutory damages between TWD 10,000 – 1,000,000. If the damaging activity is intentional and the matter is serious, the compensation may be increased to TWD 5,000,000.

13. Damages/Profits: Are there legal minimums and maximums to damages?

For statutory damages, the min. is TWD 10,000 and the max. is TWD 1,000,000 or even 5,000,000 for malicious willfulness to cause great injury.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

Infringement tools or products are subject to destruction or other necessary disposals such as deletion, removal, dismantle, take-down, etc.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

Yes. The Intellectual Property and Commercial Court is the specialized court to adjudicate intellectual property related disputes, including copyright infringement cases. However, the specialized court does not have exclusive jurisdiction over the matter in the first instance. Many copyright owners choose a district court to file criminal complaints against the infringers for convenience.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Damages for infringement on economic rights and moral right shall be claimed within 2 years from knowing the injury and infringer, or 10 years from the fact of infringement occurs.

17. Key benefits in Civil Action

A successful action will result in award of damages and injunction. It would discourage potential future infringement activities.

18. Key Challenges of Civil Action

Copyright is obtained when a work is completed, suggesting that registration is not required to create a right. But in that sense, the creation of copyright is not manifest to the public. The need to present evidence proving the ownership of right becomes critical. The proofs of identity as an author, the time of completion, independent creation are all important to successfully establish the copyright. It is advisable to keep records of materials of creation activities such as notes, drafts, work schedule, and so on. Musical works can be docketed in any of the music copyright collective management organizations for record.

In practice, frequent challenges in a civil action are:

- Whether the creator is the true author,
 - Whether there is originality in a work,
 - Whether the accused work is an unauthorized copy, including is there substantial similarity in expression, and
 - Whether the use of work is exempted under a fair use.
- Preliminary injunctions have been criticized to be quite inefficient to acquire. The court would often review the entirety of the merit of a case before granting one, meaning that it takes a much longer time period than anticipated.

UAE

Contributor: Munir Suboh, BSA Ahmad Bin Hezeem & Associates LLP

1. What "works" are subject to copyright (List in alphabetical order)?

- 1) Books, pamphlets, articles, and other written works.
- 2) Computer programs and applications, databases, and similar works as determined by a ministerial decision.
- 3) Lectures, speeches, sermons, and any other works of similar nature.
- 4) Theatrical works, musical shows and pantomime.
- 5) Musical compositions with or without words.
- 6) Audio, visual or audiovisual works.
- 7) Architectural works, and engineering drawings and layouts.
- 8) Works of drawing in lines or colours, sculpture, engravings, lithography, printing on textiles, wood and metals, and any similar works of fine arts.
- 9) Photographic and analogous works.
- 10) Works of applied arts and plastic arts.
- 11) Illustrations, geographical maps, sketches, and three - dimensional works relative to geography, topography or architecture and others.
- 12) Derivative works, without prejudice to the protection prescribed for the works from which it has been derived.

Protection shall include the title of the work, if innovative, as well as the written innovative broadcast program.

2. Is there an exhaustive list of copyrightable works?

YES to some extent and law refers to groups or types of works with flexible definition to allow all copyrightable works to be included.

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

Works need to be original and expressed in a tangible medium of expression

4. Is copyright registration required to initiate a civil case?

No, however, it is significantly easier to evidence copyright infringement if you do hold a copyright registration. A registration takes away some of the burden to prove infringement and provides a clear scope and duration of rights in a work.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No exception. However, in the event that the author of the work was from, domiciled in and created the work in a territory which was not signatory to the Berne Convention and its related agreements, the courts of the UAE would not be able to enforce their rights in the UAE based on Berne Convention and would not benefit from automatic protection mentioned in the agreement accordingly. The question then will be whether the work is eligible for

protection under UAE Copyright Law..

6. What types of infringement can be used to initiate a civil case?

- 1) Direct copyright infringement
- 2) Contributory infringement can be arguably pursued for some limited remedies if there are clear supportive evidence. It is still difficult to pursue .

7. Who has standing to initiate a civil case?

- 1) Copyright owner, including author, co-author, holder of financial and/or moral rights
- 2) Exclusive, non-exclusive and/or sole Licensee if authorized to pursue such action
- 3) Commercial agent if it is authorized to initiate such action

8. Do multiple authors all have to join the lawsuit?

No - There is no requirement that all authors must join a lawsuit in order to enforce a collective work. Whilst collectively the parties own the work, each author has an independent right of enforcement against third parties.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes and this is further supplemented by the Cyber Crime Law, Federal Law No. 5 of 2012

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court. ?

Yes if the effect reaches to local territory. Also, if the copyright owner is based in UAE, it can arguably pursue this rights against unknown counterfeiter for more investigation and prosecution.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Intermediate measures

- prevention of publication, exhibition or production of the infringing work
- order to obtain evidence related to the infringement
- provisional attachment of all infringing content/works and any goods and/or equipment used to create the infringing works
- provisional attachments on the concerned party
- analysis of income made from infringing works and seizure of related income

Formal Court Measures

- confiscation and destruction of infringing works
- confiscation of associated equipment
- closing down the establishment where the offence occurred for a maximum of 6 months
- publication of summary court judgment defaming the infringing party
- fines ranging from AED 10,000 to AED 500,000
- imprisonment terms for a minimum of two months
- court costs and expenses.
- deportation (if the infringing party is not from the UAE)

Only nominal legal fees are recoverable in the UAE, which are generally no more than AED 3,000. There are no statutory damages or punitive damages.

For cybercrimes involving copyright infringement, the jail term increases to a minimum of one year and/or a fine ranging between AED 250,000 and AED 1,000,000.

12. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

The court calculates damages based on direct losses as proven by the copyright owner, this is inclusive of the loss in profit, storage and logistic expenses and part or some of attorney fees as damages. The damages are granted discretionary by the court and there is no clear guidance or statutory grounds to follow for copyright infringement cases.

Loss of profits is a recognised concept in the UAE yet in practice they are difficult to prove or obtain.

13. Damages/Profits: If available, how do the courts measure damages?

The court has discretion to define the minimum and maximum.

14. Damages/Profits: Are there legal minimums and maximums to damages?

During court proceedings, the goods are seized then once the court grants a destruction order, the goods are confiscated and destroyed. The equipment involved in their production may also be confiscated.

15. Post Seizure: How are goods dealt with at end of civil lawsuit

No, there are no specialist intellectual property courts in the UAE and any intellectual property cases would be heard by the civil court.

The judiciary often refers cases to court appointed experts for further investigation and to provide their assessment on the case. The expert assessment is an important stage of litigation as often the judge will follow the opinion of the independent expert.

16. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

The general rule for time bar/status of limitation for civil claims in UAE is 15 years in UAE (civil transactions law) and 10 years for commercial claims. However, there are some exceptions as the law says that no claim for compensation arising out of a harmful act shall be heard after the

expiration of three years from the day on which the defendant became aware of the occurrence of the harm and of the identity of the person responsible for it .Also, the law says that provided that if such claim arises out of a crime and the criminal proceedings are still current after the expiry of the time limit referred to in the foregoing paragraph, the claim for compensation shall not be barred. This should be relevant for copyright infringement claims.

In any event, no claim for compensation shall be heard in any case upon the expiration of fifteen (15) years from the day on which the harmful act took place. No specific time bar or status of limitation is in place for copyright cases within copyrights law and hence reference should be made to the above provisions

17. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There are many challenges parties could face in copyright disputes, such as the lack of a specialized IP court or authority to hear such disputes . The creation of such courts could help to expedite and improve the outcomes for the benefits of copyright owners.

There is no Central or Federal court that can take sole jurisdiction on all copyright cases within the UAE.

This area is being developed significantly in the UAE in the last decade. However, there is generally a lack of court precedents to show high court awards or damages for owner of copyrights especially when defendants are traders or entities that generate profits. This could be for many reasons but mainly because copyright owners have not made efforts to increase their expectations in monetary damages claims, nor pursued their cases aggressively and substantively evidenced their claims. This may be due to the lack of a specialized IP court.

Delegation to untrained, unqualified accounting experts in IP cases could be painful process to parties and the outcomes of their dispute.

Relatively expensive jurisdiction to pursue copyright claims properly, with specialized copyright counsels.

Courts are unlikely to impose fines against defendants for lack of cooperation in discovery and the expert investigation process.

There are no statutory damages or punitive damages awarded, even in cases of bad faith cases.

Post undertaking by plaintiff to cover damages prior be able to pursue attachment orders against counterfeiters/counterfeit products.

18. Key Challenges of Civil Action

It grants a judgment that is enforceable immediately for similar products or incidents.

It gives an official route and gateway to protect IP rights and copyrights from various breaches, such as infringement by manufacturing, importation, or exportation.

It helps copyright owners of unregistered rights to prove its rights and obtain a judgment, similar to declaratory order, to affirm their ownership.

It assists copyright owners to go through discovery process via experts and tries to have specialized IP and copyright experts to hear their cases and claims. IP experts are generally qualified in UAE and are in a good position to understand and advise on complex copyright matters.

It establishes acceptable legal grounds to pursue criminal proceedings against counterfeiters especially in complex cases where copyright owners do not have clear proof of its ownership by way of registration or other documents.

Ukraine

Contributor: *Ganna Prokhorova (Partner), Nataliia Badora (Associate) Mamunya IP*

1. What "works" are subject to copyright (List in alphabetical order)?

The list of works protected by copyright includes works of science, literature and art in particular:

- audiovisual works;
- collections of works, collections of works of folklore, encyclopedias and anthologies;
- computer programs;
- databases;
- derivative works;
- dramatic, musical works, pantomimes, choreographic and other works created for stage performance and their productions;
- illustrations, maps, plans, drawings, sketches, plastic works related to geography, geology, topography, engineering, architecture and other fields of activity;
- literary works of a fictional, journalistic, scientific, technical or other nature (books, brochures, articles, etc.);
- musical works with and without text;
- performances, lectures, speeches, sermons and other oral works;
- photographic works;
- translated texts, dubbing, subtitling of audiovisual works in other languages;

- works of artistic design (including stage design and fonts);
- works of applied art, including works of decorative weaving, ceramics, carving, foundry, art glass, jewelry, etc.;
- works of architecture, urban planning, garden and park art;
- works of fine art;
- other works.

Copyright covers both published and not published, completed and unfinished works regardless of their purpose, genre or manner of expression.

2. Is there an exhaustive list of copyrightable works?

No, the list is non-exhaustive.

3. (If no exhaustive list List requirements for obtaining copyright protection?)

A work should be made by creative effort and expressed in any objective form. Generally, results of intellectual activity are presumed to be made by creative effort, unless it is proved otherwise.

According to the Art. 7 of the Law of Ukraine “On Copyright and Related Rights” the legal protection applies only to the form of expression of a work and shall not apply to any ideas, theories, principles, methods, processes, systems, concepts, discoveries, even if they are expressed, described, explained, illustrated in the work.

4. Is copyright registration required to initiate a civil case?

No. Copyright registration or other formalities are not required for copyright protection and initiating a civil case. Registration of copyright is voluntary in Ukraine.

5. Are there any exceptions to the registration requirement to initiate a civil case?

Not required for all types of copyrights.

6. What types of infringement can be used to initiate a civil case?

The following acts are considered copyright infringement and can be used to initiate a civil case:

- 1) infringement of moral rights;
- 2) infringement of the exclusive right to use work, right to authorize or prohibit the use of the work by others;
- 3) any unauthorized use of a copyrighted work, namely:
 - piracy (ie, illegal publishing, reproduction or dissemination of a copyrighted work);
 - plagiarism (ie, misappropriation of work by claiming the authorship of a work created by another author);

- importing copies of works (including computer programs and databases), phonograms, videograms, broadcasting programs into the customs territory of Ukraine without the permission of copyright holder and (or) related rights;
- committing actions that create a threat of infringement of copyright and (or) related rights;
- intentional bypassing of technical protection features intended to protect copyright;
- falsifying or making alterations to information about the management of copyright or related rights;
- distribution, import into the customs territory of Ukraine, public announcement of objects of copyright and (or) related rights, from which information on rights management was falsified or altered;
- camcording, cardsharing;
- management of a website that, by indexing the metadata of a work or object of related rights and providing a search engine, allows users of this website to find and distribute a work or object of related rights within a peer-to-peer network without violating the property rights of copyright and/or related rightsholders;
- abuse of official position by officials of a collective management organization, which resulted in non-payment or improper distribution and payment of remuneration to a copyright or related rights holder.

7. Who has standing to initiate a civil case?

- a. author or another rightsholder;
- b. inheritor and legatee of the copyright if the copyright is still during the protection period;
- c. licensee authorized to protect copyright;
- d. organizations of collective management of copyrights and related rights.

8. Do multiple authors all have to join the lawsuit?

No, it is not necessary for all authors to join a lawsuit. In case of violation of joint copyright, each co-author can protect his right in court.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. The general copyright legal provisions apply to infringement in the digital medium/electronic medium/mobile network/Internet.

Ukrainian legislation contains a specific out-of-court procedure of protection of copyright for online infringement. The rightsholders or their representatives (certified Ukrainian attorney or patent attorney) may address the owner of a website with a demand to delete the infringing content and provide information about the infringer. Within 48 hours the owner of the website is obliged to undertake measures to remove the infringing content. Otherwise, the website owner will be deemed responsible for copyright infringement.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court.?

A copyright action is usually brought to a court with jurisdiction at the location of the counterfeiter (defendant). If the defendant's registered place of residence or stay is unknown, a claim may be brought at the location of his property Ukraine.

Exercising a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction is very unlikely in civil enforcement.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

The following remedies are available in Ukraine:

- 1) recovery for the infringed rights and/or termination of infringing actions;
- 2) moral damages recovery (a monetary payment for moral suffering caused by the actions of the infringer);
- 3) recovery material damages, including lost profit, or recovery of income received by the infringer;
- 4) statutory damages either in the fixed range from approx. USD 145 – USD 14 510 or double of the price a rights holder would charge for a license to the copied work; or triple if infringement is intentional;
- 5) to request the infringer to provide information about third parties involved in the infringing activities;
- 6) to prohibit the publication of the works or demand confiscation of such works;
- 7) to demand the termination of preparatory actions to the infringement, including the suspension of customs procedures;
- 8) seizure or confiscation of all counterfeit copies of works, phonograms, videograms or broadcasting programs;
- 9) publication in the mass media of information about copyright infringement and court decision concerning such infringement.

The list is non-exhaustive.

Additionally, the court may oblige the infringer to pay a fine amounting to 10% from the sum ordered in favour of the copyright holder with the entire sum to be transferred to the state budget.

12. Damages/Profits: If available, how do the courts measure damages?

When determining the amount of monetary damages and moral damage, the court is obliged to consider the type of the infringement, the monetary and moral damage caused to the copyright holder, as well as the possible income that infringer could receive. The amount of damages may additionally include incurred court costs, as well as attorneys' fees and costs.

During statutory damages assessment the court must take into account the scope of the infringement and (or) the intentions of the infringer, the duration and systematic nature of the infringement, as well as other objective circumstances. The amount of compensation must be effective, proportionate, dissuasive and aimed at restoring the infringed rights.

13. Damages/Profits: Are there legal minimums and maximums to damages?

Authorities act discretionary when defining the minimum and maximum. However, the court will make a decision taking into account the amount of damages proven by the claimant.

The amount of statutory damages is limited – (1) fixed range from approx. USD 145 – USD 14 510; (2) double the price a rights holder would charge for a license to the copied work; (3) or triple if infringement is intentional.

14. Post Seizure: How are goods dealt with at the end of civil lawsuit?

Upon a claimant`s request the court may decide to hand over the counterfeit items to copyright holder. If claimant does not request such a transfer, the counterfeit goods shall be destroyed, and the materials and equipment used to reproduce the counterfeit copies shall be sold. The proceeds from the sale shall be transferred to the State Budget of Ukraine.

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.?

No, copyright infringement cases are considered by civil or economic courts. However, in the course of judicial reform it was decided on the creation of the Higher Court on Intellectual Property. A competition was held for selection of judges to the court, but so far, the court is not yet functioning.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

There is no limitation period for commencement of legal proceedings for infringement of moral rights.

The standard three-year period of limitation of action applies to copyright infringement. Limitation period is calculated as of the day when the injured party found out about the infringement or might have found out about it.

17. Key Challenges of Civil Action

Copyright ownership

Although a registration is not required to claim copyright protection, the copyright owner is encouraged to maintain sufficient written record of the authorship in order to avoid any dispute on the copyright ownership.

Expertise

The expert's opinion is often necessary to successfully prove the copyright infringement. The involvement of an expert causes additional costs.

Damages enforcement

It is essential to consider injunctive measures at the very beginning of a case. Otherwise, the defendant may ensure that all of the funds will be withdrawn from his accounts.

18. Key Benefits of Civil Action

Civil proceedings offer efficient legal protection. Non-exhaustive list of remedies in civil proceedings allows the injured party to choose the most effective remedy for particular infringement. Successful litigation can provide affirmation of rights, compensation for damage sustained and to discourage future potential.

USA

Contributor: *Alan Behr, Phillips Nizer LLP*

1. What "works" are subject to copyright (List in alphabetical order)?

The U.S. Copyright Act (17 U.S.C. §102) notes that copyrightable “works of authorship” include the following categories:

1. architectural works;
2. dramatic works, including any accompanying music;
3. literary works;
4. motion pictures and other audiovisual works;
5. musical works, including any accompanying words;
6. pantomimes and choreographic works;
7. pictorial, graphic, and sculptural works; and
8. sound recordings.

Copyright protection does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” See 17 U.S.C. §102.

2. Is there an exhaustive list of copyrightable works?

There is no exhaustive list of copyrightable works or media; a work must be an original work of authorship fixed in a tangible medium of expression in compliance with 17 U.S.C. §102(a).

3. (If no exhaustive list, outline requirements for obtaining copyright protection.

To qualify for copyright protection, a work must be a work of authorship that is original and fixed in a tangible medium of expression. It must have at least a modicum” of creativity, a standard that is often the “low bar” for copyrightability.

17 U.S.C. §102(a) specifically states: “Copyright protection subsists...in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”

4. Is copyright registration required to initiate a civil case?

Yes. 17 U.S.C. §411(a) states: “[N]o civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” See also *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019). Please note this only applies to “United States works” because, under the Berne Convention, registration cannot be a barrier to the enforcement of works from Berne countries. 17 U.S.C. §101 defines what is a “United States work.”

5. Are there any exceptions to the registration requirement to initiate a civil case?

Yes. Congress enacted specific exceptions to the registration requirement for actions initiated under the Visual Rights Act (17 USC 106(a)) and actions for the benefit of works that are especially vulnerable to pre-registration infringement, such as a live broadcast, which must be registered within three months following the infringement. See 17 U.S.C. §411(c).

6. What types of infringement can be used to initiate a civil case?

The two main types of copyright infringement are primary and secondary infringement. Secondary liability is further outlined below:

1. Direct copyright infringement and

2. There are presently two forms of liability uniformly categorized as secondary liability and a third that is sometimes placed under the same general heading:

a. Contributory Infringement arises if someone (i) who has knowledge of infringing acts (ii) materially contributes to the infringement.

b. Vicarious infringement arises if the defendant (i) had the right and power to control the infringing activity and (ii) received a direct financial benefit from it.

c. Inducement of copyright infringement attaches when it can be shown that one (i) distributed a device or technology with (ii) the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement.

7. Who has standing to initiate a civil case?

Only the legal or beneficial owner of an exclusive right conferred by the Copyright Act has standing to sue. Please note that the holder of an exclusive license qualifies as a legal owner. See 17 U.S.C. § 501(b). See also *DRK Photo v. McGraw-Hill Global Education Holdings, LLC, et al.*, Case No. 15-15106 (9th Cir., Sept. 12, 2017). The beneficial owner is typically the author of the work, who is entitled to royalties from the exploitation of the work by the legal owner.

8. Do multiple authors all have to join the lawsuit?

A joint author has a common undivided interest in the whole and so may sue any third party for copyright infringement without asking other co-owners to join the litigation.

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes. However, the Digital Millennium Copyright Act (DMCA) affords certain exemptions to liability (“safe harbors”) for Internet service providers if they take down infringing activities by third parties upon notice. See 17 U.S.C. §512. Criminal penalties could apply for attempting to circumvent digital rights management technology or encryption. See 17 U.S.C. §§1201-1204.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court. ?

Yes. However, courts will only accept jurisdiction if there is a “substantial connection’ between the defendant and the forum state necessary for a finding of minimum contacts...by an action of the defendant purposefully directed toward the forum State.” *Asahi Metal Indus. Co. v. Superior Court of California*, 480 U.S. 102, 112, 107 S.Ct. 1026 (1987).

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys’ fees and costs).?

1. Injunctions (temporary and final). See 17 U.S.C. §502;
2. Impounding and disposition of infringing articles. See 17 U.S.C. §503;
3. Damages (actual damages; infringer’s profits; and statutory damages). See 17 U.S.C. §504;
4. Litigation costs and reasonable attorneys’ fees may be awarded to the prevailing party at the court’s discretion in civil actions.

A plaintiff can recover fees and costs only if the work was registered before the infringement commenced. See 17 U.S.C. §505

Damages in copyright infringement generally fit into one of three categories: actual damages, the infringer’s profits, and statutory damages. See 17 U.S.C. §504. Actual damages account for the losses that a copyright owner directly suffered because of the infringement. To the extent that lost profits are not included in the calculation of damages, they could be awarded in addition to actual damages. Plaintiffs can choose between actual damages and profits or the statutory damages provided as an alternative.

The minimum and maximums for statutory damages are outlined in the Copyright Act, but courts have broad discretion within the statutory parameters. See 17 U.S.C. §504(c). Those are

between US \$750 to US \$30,000 per work infringed for non-willful infringement (“as the court considers just”), with the maximum increasing to US \$150,000 in cases of willful infringement. See 17 U.S.C. §504(c) Statutory damages can be reduced at the discretion of the court, down to a statutory minimum of \$200, in cases of innocent infringement.

12. Damages/Profits: If available, how do the courts measure damages?

Please see the previous response.

13. Damages/Profits: Are there legal minimums and maximums to damages?

Please see the response to Question 11.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

Goods may be destroyed post seizure. “As part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or used in violation of the copyright owner’s exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.” See 17 U.S.C. §503(b).

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

No, there are no specialized copyright courts. However, all copyright cases must be heard in federal court because copyright is the subject of federal law, which preempts the laws of the individual states.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Copyright infringement has a three-year statute of limitations. See 17 U.S.C. §507(b) which states: “No civil action shall be maintained under the [Act] unless it is commenced within three years after the claim accrued.” The statute of limitations is rolling, and each sale of an infringing product is considered a new infringement which restarts the clock. That is why, for example, cases of infringement of a musical composition can be filed decades after the infringing act; each time the infringing recording is sold, the starting point of the statute of limitations is effectively reset.

17. Key Challenges of Civil Action

Key challenges in copyright disputes include:

· Copyright cases can be expensive. Attorneys’ fees are not always awarded and damages may be relatively small, even if statutory damages are selected by the copyright owner.

- Access to the infringing material by the defendant has to be shown as a predicate to an analysis of whether infringement has occurred.

- The “low bar” for creativity has to be surmounted.

- Substantial similarity in expression protected by copyright between the works at issue has to be shown.

- Preliminary relief, such as injunctions, are not always obtainable. In general terms, there is a judicial preference not to stifle publication before the facts are fully known. ·

There could also be difficulty posed by certain copyright defenses such as fair use and a demonstration of independent creation.

18. Key Benefits of Civil Action

The key benefits to filing a civil action include:

- Primarily, it should halt the infringement and potentially provide for an award of damages and legal fees.

- Litigation can deter potential future infringers from attempting to copy without authorization.

Vietnam

Contributor: *Nguyen Tran Tuyen, ELITE LAW FIRM (Vietnam)*

1. What "works" are subject to copyright (List in alphabetical order)?

We would like to advise that under Article 14 of Vietnam IP Law these following works are subject to copyright protection:

1. Architectural works;
2. Cinematographic works and works created by a process analogous to cinematography (below collectively referred to as cinematographic works);
3. Computer programs and data compilations.
4. Dramatic works;
5. Folklore and folk-art works of folk culture;
6. Lectures, addresses and other sermons;
7. Literary and scientific works, textbooks, teaching courses and other works
8. Musical works;
9. Photographic works;

10. Press works;
11. Sketches, plans, maps, and drawings related to topography, architecture, or scientific works;
12. Works of art, works of applied art.

2. Is there an exhaustive list of copyrightable works?

No.

3. (If no exhaustive list, outline) requirements for obtaining copyright protection.

We note that under IP Law of Vietnam, requirement for obtaining copyright protection include:

- (i) A work is created directly by a natural person (Art. 12(a) and Art.14.3)
- (ii) A work must be fixed in a certain material form (Point 2, Art. 6)
- (ii) A work must be completed (Point 4, Art. 19)
- (iii) A work has to have originality (Point 3, Art. 14)

We note that the following objects are **not protected as copyrighted works** (not covered by copyright protection) under Art. 15 of IP Law of Vietnam:

- a) News of the day as mere items of press information.
- b) Legal documents, administrative documents and other documents in the judicial domain and their official translations of these documents.
- c) Processes, systems, operation methods, concepts, principles, and data.

4. Is copyright registration required to initiate a civil case?

No. In principle, a copyright registration certificate is not required to initiate a civil case under IP Law, Civil Code and other regulations of Vietnam. However, in this case, a copyright holder and a plaintiff need to provide evidence proving he or she has created the original work and is the true owner of the work before the court.

5. Are there any exceptions to the registration requirement to initiate a civil case?

No.

6. What types of infringement can be used to initiate a civil case?

The following types of copyright infringement can be used to initiate a civil case (under Art. 28 of IP Law of Vietnam)

1. Appropriating copyright to literary, artistic, or scientific works.
2. Impersonating authors.
3. Publishing or distributing works without permission of authors.
4. Publishing or distributing works under joint-authorship without permission of co-authors.
5. Modifying, mutilating or distorting works in such a way as prejudicial to the honor and reputation of authors.
6. Reproducing works without permission of authors or copyright holders, except: Duplication of works for personal scientific research or teaching purpose and Performance of dramatic works or other performing-art works in mass cultural, communication or mobilization activities without collecting any charges in any form.
7. Making derivative works without permission of authors or holders of copyright to works used for the making of derivative works, except Transcription of works into Braille or characters of other languages for the blind
8. Using works without permission of copyright holders, without paying royalties, remunerations, or other material benefits according to the provisions of law, except for the cases specified in Clause 1, Article 25 of Vietnam IP Law.
9. Leasing works without paying royalties, remunerations or other material benefits to authors or copyright holders.
10. Duplicating, reproducing, distributing, displaying, or communicating works to the public via communication networks and by digital means without permission of copyright holders.
11. Publishing works without permission of copyright holders.
12. Willingly canceling or deactivating technical solutions applied by copyright holders to protect copyright to their works.
13. Willingly deleting or modifying right management information in electronic form in works.
14. Manufacturing, assembling, transforming, distributing, importing, exporting, selling, or leasing equipment when knowing or having grounds to know that such equipment may deactivate technical solutions applied by copyright holders to protect copyright to their works.
15. Making and selling works with forged signatures of authors of original works.
16. Exporting, importing, or distributing copies of works without permission of copyright holders.

7. Who has standing to initiate a civil case?

A Copyright holder has the right to initiate a civil case to protect their intellectual property rights (under Art. 198 of IP Law of Vietnam).

8. Do multiple authors all have to join the lawsuit?

Yes. Multiple authors all have to join the lawsuit if the work has joint authors (multiple authors).

9. Is there prosecution for copyright infringement in the digital medium/electronic medium/mobile network/Internet?

Yes, copyright infringement in the digital medium/electronic medium/mobile network/Internet shall be prosecuted under Art. 28 of IP Law and Art. 225 of Criminal Code of Vietnam.

According to Art.28.10 of IP Law, acts of duplicating, reproducing, distributing, displaying, or communicating works to the public via communication networks and by digital means without permission of copyright holders shall be considered as copyright infringement.

Also, under Art.225.1 of Criminal Code of Vietnam, *any person who, without permission of the copyright or related right holder, intentionally commits one of the following acts, infringing upon copyright or related rights being protected in Vietnam on a commercial scale trade or gain illicit profits from VND 50,000,000 (about 2,000USD) to under VND 300,000,000 (about 12,000USD) or cause damage to the copyright or related right holders from VND 100,000,000 (about 4,000USD) to under VND 500,000,000 (about 20,000USD) or the infringing goods are valued at between VND 100,000,000 (about 4,000USD) and under VND 500,000,000 (about 20,000USD). From 100,000,000 VND to under 500,000,000 VND, the offenders shall be subject to a fine of from 50,000,000 VND (about 2,000USD) to 300,000,000 VND (about 12,000USD) or a non-custodial reform for up to 03 years:*

a) Copying works, phonograms, or video recordings;

b) Distributing to the public copies of works, copies of phonograms, copies of video recordings.

10. If online copyright infringement is actionable will courts exercise a long-arm jurisdiction over a counterfeiter that is outside the territorial jurisdiction of the local court?

No.

11. List the remedies provided for infringement in the jurisdiction (injunction/damages and profits/statutory damages/seizure and disposition of infringing articles/attorneys' fees and costs).?

Under Art. 202 of IP law of Vietnam, the remedies provided for IP/copyright infringement in Vietnam include:

1. Compelling the termination of infringing acts;
2. Compelling the public apology and rectification;
3. Compelling the performance of civil obligations;
4. Compelling the payment of damages;

5. Compelling destruction, distribution or use for non-commercial purposes of goods, raw materials, materials and means used for the production or trading of intellectual property right-infringing goods, provided that such destruction, distribution, or use does not affect the exploitation of rights by intellectual property right holders.

12. Damages/Profits: If available, how do the courts measure damages?

According to Art. 204 of IP Law of Vietnam, principles for determining damage caused by infringement of intellectual property rights are as follows:

1. Damages caused by acts of infringing upon intellectual property rights/copyrights include:

a) Material damage, including loss of property, decrease in income, profit, loss of business opportunities, and reasonable costs to prevent and remedy the damage;

b) Mental damage includes loss of honor, dignity, prestige, reputation, and other mental losses caused to authors of literary, artistic, or scientific works; Performers; Authors of inventions, industrial designs, layout designs, plant varieties.

2. The degree of damage is determined on the basis of actual losses suffered by the intellectual property right holder due to acts of infringement of intellectual property rights.

13. Damages/Profits: Are there legal minimums and maximums to damages?

Yes. There are legal minimums and maximums to damages in some cases. Under Art. 205 of IP Law, *basis for determining the level of compensation for damage caused by infringement of intellectual property rights/copyrights are as follows:*

1. In cases where the plaintiff can prove that the act of infringing upon intellectual property rights has caused material damage to him/her, he/she has the right to request the Court to decide on the level of compensation according to one of the following grounds:

a) Total material damage in monetary terms plus profits earned by the respondent from committing acts of infringing upon intellectual property rights, if the plaintiff's reduced profits have not been included in the total material damage;

b) The price for licensing the right to use an intellectual property object, assuming that the defendant is assigned the right to use that object by the plaintiff under the contract to use the intellectual property object, within the scope corresponding to the act of infringement; offenses committed;

c) Physical/material damage by other calculation methods proposed by the intellectual property right holder in accordance with the provisions of law;

*d) In case it is not possible to determine the compensation level for material damage according to the grounds specified at Points a, b and c of this Clause, **the compensation level for material damage shall be fixed by the Court, depending on the level of damage, but not exceeding VND 500,000,000 (about 20,000USD).***

2. In cases where plaintiffs can prove that acts of infringing upon intellectual property rights have caused **mental damage** to them, they have the right to request the Court to decide on **the compensation level between VND 5,000,000 (about 250USD) and VND 50,000,000 (about 2,500USD)**, depending on the level of the (mental) damage.

3. In addition to the compensation for damage specified in Clauses 1 and 2 of this Article, the intellectual property right holder has the right to request the court to force an organization or individual that commits acts of infringing upon intellectual property rights to pay reasonable costs to hire a lawyer/lawyers.

14. Post Seizure: How are goods dealt with at end of civil lawsuit

Under Art. 202 of IP Law of Vietnam, at end of civil lawsuit, the plaintiffs may request or the court may order to *compel destruction, distribution or use for non-commercial purposes of goods, raw materials, materials and means used for the production or trading of intellectual property right-infringing goods, provided that such destruction, distribution, or use does not affect the exploitation of rights by intellectual property right holders.*

15. Court: Is there a specialized court(s) to adjudicate copyright infringement cases.

No. At present, there is not any specialized court(s) to settle copyright infringement cases in Vietnam. All copyright infringement cases shall be handled by economic Court belonging to People's Civil Court at provincial court level.

16. Limitation: If applicable, what is the time limit for commencement of legal proceedings?

Damages for infringement on economic rights of copyrighted works must be claimed within 03 years, from the date that the copyright holder knows (material) damages (under Art. 588 Civil Code).

There is not any regulation relating to the time limit (status of limitation) for commencement of legal proceedings for claim for mental damages of copyright infringement. Accordingly, the copyright holder can claim for mental damages of copyright infringement as to the copyright infringer at any time as soon as he/she finds out a mental copyright infringement.

17. Key benefits in Civil Action

We opine that key benefits in civil action shall include (but not limited to):

- (i) judgments have high legal value, forcing the infringing party to execute;
- (ii) The copyright holder is partially reimbursed for damages when the work is infringed;
- (iii) Forcing an apology to the infringing party must make a public apology;
- (iv) Restore the reputation of the right holder;
- (v) Actively protect your intellectual property assets.

18. Key Challenges of Civil Action

We think that key challenges of civil action shall include (but not limited to):

- (i) Difficult to enforce judgment;
- (ii) Time consuming;
- (iii) Compensation level still is not high enough for preventing copyright infringement;
- (iv) it is difficult to gather evidences proving actual damages for the plaintiff/copyright holder;
- (v) Cost for settling a copyright infringement case in court is high.