

## French Supreme Court invalidates “Take down and stay down” rule

In a significant series of three decisions handed down on 12 July 2012, the French Supreme Court ruled that a hosting platform has no obligation to ensure that hosted content that has been previously notified is not later re-posted online by its users.<sup>1</sup> At first sight, the solution adopted by the French Supreme Court seems straight forward, simply applying Article 6-I of Law no. 2004-575 of 21 June 2004 on Confidence in the Digital Economy (“LCEN”). To rule otherwise would lead to imposing on website operators a general obligation to monitor that is prohibited by the LCEN and by Directive no. 2000/31/EC of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (“e-commerce Directive”) that the LCEN transposed into French law.

Yet, the message of the French Supreme Court becomes all the more relevant and significant when it is placed in context. The re-posting of content that is identical or similar to content having previously been notified and deleted was, indeed, one of the topics giving rise to most of the uncertainties before the decisions of 12 July 2012.

### Situation before 12 July 2012

First, one ought to recall that the LCEN did not identically transpose the e-commerce Directive. Pursuant to Article 14 of the Directive, “*the provider, upon obtaining [...] knowledge or awareness [of the illicit content], [must act] expeditiously to remove or to disable access to the information.*” Yet, the e-commerce Directive does not specify how the provider becomes aware of the illicit nature of content.

This gap was filled in by the LCEN which established a presumption according to which the operator is aware of the illicit nature of the content when such content is notified to it. Going even further, Article 6-I 5° of the LCEN has very precisely set the conditions to be met by such a notice. These obligations imposed on rights owners wishing to have videos or images removed from a website counterbalance the obligation imposed on the hosting providers to promptly remove content.

In this respect, it is important to provide hosting providers with the means to meet their obligations to act promptly,<sup>2</sup> which is sometimes strictly punished when content is removed after more than a few days.<sup>3</sup> One of the requirements for a complete notice under Article 6-I 5° of the LCEN relates to the precise

location of the notified content because, without this information, the hosting provider cannot in most cases identify and remove the litigious content.

But what is the exact effect of a notice complying with the legal requirements? Is the obligation to promptly remove content met as soon as the provider removes the notified content or must the provider also ensure that the same content is not later re-posted? On websites hosting videos in particular, some Internet users did not hesitate to re-upload videos deemed to be infringing on the website from which they had just been removed.

### Equivocal case law on “take down and stay down” until 12 July 2012

Various decisions held hosting providers liable for letting users re-post online content identical to the content that had previously been notified and that allegedly infringed the same intellectual property rights without requesting a new notice.<sup>4</sup> Some courts even blamed hosting providers for not having implemented sufficient measures that would have prevented the re-posting of the litigious content on the ground that, without such measures, access to the litigious content was not really blocked.<sup>5</sup>



Courts blamed hosting providers for not preventing re-posting of the litigious content



- 1 French Supreme Court, 1st Civil Chamber, 12 July 2012, no. 11-13.669 (Google Inc. and others v. Bac Films and others), no. 11-13.666 (Google Inc. and others v. Bac Films and others) and no. 11-15.165 and 11-15.188 (consolidated appeals, Google Inc. and Aufeminin.com and others v. André Rau, H & K)
- 2 The French courts frequently recall the importance of this provision and the necessity to include specific indications in the notice; see, in particular, French Supreme Court, 1st Civil Chamber, 17 February 2011, no. 09-67.896, Nord-Ouest Production and others v. Dailymotion
- 3 For a recent example, see Paris Civil Court, 29 May 2012, TF1 and others v. YouTube
- 4 Paris Court of Appeal, 9 April 2010, Google v. Flach Films and others; Paris Court of Appeal, 3 December 2010, Dailymotion v. Zadig Production; Paris Court of Appeal, 14 January 2011, Google Inc. v. Bac Films and others; Paris Civil Court, 11 June 2010, La Chauve Souris and 120 Films v. Dailymotion; Paris Civil Court, 13 January 2011, Calt Production v. Dailymotion; Créteil Civil Court, 14 December 2010, INA v. YouTube
- 5 Paris Court of Appeal, 4 February 2011, Google Inc. and Aufeminin.com and others v. André Rau, H & K

However, this position was discussed on the ground that it conflicted with Article 15 of the e-commerce Directive, which prohibits Member States of the European Union from imposing on hosting providers a general obligation to monitor the content of their website.<sup>6</sup> Furthermore, these decisions may result in “*disproportionate burdens on intermediaries*”,<sup>7</sup> which would also be unrealistic in light of the volume of information to be filtered and what is technically feasible.

French case law was, in fact, not unanimous on this point as other courts, observing differences between the re-posted content and the similar content that had initially been notified, refused to hold the hosting provider liable for not having prevented the re-posting.<sup>8</sup> These were notably cases where the videos were not entirely identical (for instance, complete videos instead of trailers or extracts).

#### **Contribution of the decisions of 12 July 2012**

The French Supreme Court quashed the appellate decisions holding technical intermediaries liable for letting notified content be re-posted online. These cases

involved either films that could be viewed or downloaded through links available on the Google Videos service, or reproductions of photographs on the website *aufeminin.com* and used by Google Images, in both cases without the consent of the rights owners concerned.

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Intermediaries do not have any obligation to actively seek illicit content (even though a lot of them do so anyway)

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Pursuant to the decisions of 12 July 2012, the obligation imposed on hosting providers to promptly remove or block access to re-posted content can only result from a new notice meeting the requirements of Article 6-I 5° of the LCEN. Indeed, the French Supreme Court recalls that such a notice is required for the hosting provider to have actual knowledge of the illicit nature and location of the content in question, without which no action can effectively be implemented.



Thus, the French courts will now no longer be able to impose on hosting providers obligations meant to prevent the re-posting of allegedly illicit and previously notified content. The Supreme Court confirms that “take down and stay down” injunctions fall under the scope of the prohibition of general obligations to monitor laid down in Article 6-I 7° of the LCEN, which transposed into French law Article 15 of the e-commerce Directive. Even though this is merely a reminder of the law, the French Supreme Court mentions that intermediaries do not have any obligation to actively seek illicit content (even though a lot of them do so anyway).

This being said, there is no doubt that rights owners will continue to request the broadest possible injunctions against website operators by relying on the possibility that the French Supreme Court let the lower courts “order a measure of such a kind as to prevent or end the damage related to the current content of the website in question”. Nevertheless, the decisions of 12 July 2012 should encourage lower courts to limit the scope of the injunctions which they may possibly order. The concept of “current content” that has been introduced has a restrictive purpose and should impede preventive measures that would not only concern the content displayed on the day the injunction is imposed, but also future content.

### Courts should order more targeted injunctions

The French Supreme Court seems to seek an acceptable and feasible compromise for both rights owners and website operators, which can only be approved. Thus, the lower courts will have to implement a proportionality criterion when ordering a blocking measure. Such a measure, which will necessarily be temporary, must remain proportionate to its purpose.

The French Supreme Court thus follows the indications of the Court of Justice of the European Union, which refers to Directive no. 2004/48/EC of 29 April 2004

6 Pursuant to Article 15(1) of the e-commerce Directive, “Member States shall not impose a general obligation on providers, when providing the services covered by Articles 12, 13 and 14, to monitor the information which they transmit or store, nor a general obligation actively to seek facts or circumstances indicating illegal activity”

7 Report of the European Commission of 21 November 2003 on the application of the e-commerce Directive, COM(2003) 702 final, p. 15

8 See, notably, Paris Commercial Court, 27 April 2009, Davis Film v. Dailymotion; Paris Civil Court, 3 June 2011, SACEM v. Dailymotion; Paris Civil Court, 22 September 2009, ADAMI and others v. YouTube

9 CJEU, 24 November 2011, Scarlet Extended SA v. SABAM, no. C-70/10; CJEU, 26 February 2012, SABAM v. Netlog NV, no. C-360/10

concerning the measures and procedures aiming at ensuring compliance with intellectual property rights, to rule that the injunctions that would aim at preventing infringements of intellectual property rights must be effective, proportionate and dissuasive. The European Court held that the European regulations do not allow national courts to enjoin an Internet access provider or social media platform to implement a preventive filtering system of all the electronic communications passing through its services that would indistinctly apply to all its customers, at its exclusive expenses and without any limitation in time. National authorities are thus prohibited from adopting measures that would force an operator to actively monitor all the data of all its users to prevent any future infringement of intellectual property rights.<sup>9</sup>

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### What's next?

As Margaret Thatcher said, one may have to fight a battle more than once to win it. This seems the case here, whether from the standpoint of the rights owners (who have to send a notice each time content infringing their rights is posted online) or of the website operators (who must remove the content upon obtaining actual knowledge of its existence on the website). In this respect, the fight against infringements of intellectual property rights is a never-ending process as it is very difficult to prevent Internet users from infringing intellectual property rights by re-posting content that was previously removed by operators.

A significant number of hosting providers already implement proactive measures to fight against the illicit activities of the users of their websites. It is generally possible to easily and quickly report online the existence of content that may infringe intellectual property rights and request such content to be removed. The main online video platforms also offer the possibility for rights owners to provide fingerprints of the videos concerned for the operator to attempt to prevent the re-uploading of content it may identify as illicit by comparing it to the print.

The decisions of 12 July 2012 confirm the fact that hosting providers do not have the obligation to implement such measures as it is the rights owners' duty to send the necessary notices. Nevertheless, these measures are welcome when they are technically possible and show the good faith of the operators of websites, which do not seek to benefit from counterfeiting. These decisions should thus not be interpreted as an encouragement towards website operators to stop applying such measures. They are, indeed, frequently mentioned by courts as being positive and lead courts to refuse to order against responsible and diligent operators unnecessary injunctions insofar as such injunctions would be redundant with existing measures, or less efficient.<sup>10</sup>

Furthermore, European authorities are seeking to reduce, if not definitively end, the practices of intellectual property rights infringement. The European Commission launched, on 4 June 2012, a public consultation on procedures for notifying and acting on illegal content hosted by online intermediaries, the purpose of which was to gather the opinion of the different parties concerned on the best practices in this field.<sup>11</sup> The way rights owners should inform hosting providers of illicit content and the reaction that these intermediaries should adopt are part of the addressed issues. This consultation is now closed since 11 September 2012 but its results are not yet known. A legislative development on this point, in particular a revision of the e-commerce Directive, should not be excluded.

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<sup>10</sup> See Paris Civil Court, 13 September 2012, TF1 and others v. Dailymotion, which acknowledges the reliability of the solutions implemented by the website; see also, Paris Civil Court, 29 May 2012, mentioned above

<sup>11</sup> See [http://ec.europa.eu/internal\\_market/e-commerce/notice-and-action/index\\_fr.htm](http://ec.europa.eu/internal_market/e-commerce/notice-and-action/index_fr.htm) and <http://ec.europa.eu/yourvoice/ipm/forms/dispatch>