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Intellectual Property Law and Extra-Contractual Liability

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I. Introduction

Secondary liability for intellectual property (IP) infringement has increasingly become a foundational portion of intellectual property research. This is due to the critical role of intermediary third parties in mediating the speech of primary infringers, especially in the digital environment and platform society. The emergence of the internet and platform society has made secondary liability a predominant issue in the intellectual property enforcement discourse as online intermediaries' role is unprecedented for their capacity to influence the informational environment and users' interactions within it. In particular, most creative expression today takes place over privately owned communication networks. The decentralized, global nature of the internet means that almost anyone can present an idea, make an assertion, post a photograph, or push to the world numerous other types of content, some of which may violate intellectual property rights and be illegal in some jurisdictions. Therefore, genuine issues related to the liability of those enabling primary infringers to violate intellectual property rights have been constantly and increasingly arising.

In secondary liability, intellectual property doctrines—and research—intersect with other legal fields, spanning from tort law to extra-contractual liability depending on the relevant jurisdiction. Secondary liability for intellectual property infringement has been traditionally based on conditions and standards derived from miscellaneous doctrines of tort law,[1] such as the doctrines of joint tortfeasance, authorization, inducement, common design, contributory liability, vicarious liability, or extra-contractual liability. Therefore, secondary and

[1] *See* Graeme Dinwoodie, Rochelle Dreyfuss & Annette Kur, *The Law Applicable to Secondary Liability in Intellectual Property Cases*, 42 N.Y.U. J. Int'l L. & Pol. 202, 202–10 (2009); Patrick Goold, *Unbundling the 'Tort' of Copyright Infringement*, 102 Va. L. Rev. 1833, 1833–99 (2016); Joachim Dietrich, *Using Tort Law Accessory Liability to Protect Intellectual Property Rights*, 23 Torts L.J. 275–89 (2016); Lionel Bently & Brad Sherman, Intellectual Property Law 1074–76 (2014); Matthias Leistner, *Common Principles of Secondary Liability?*, *in* Common Principles of European Intellectual Property Law (Andres Ohly ed., 2012); Kamiel Koelman and Bernt Hugenholtz, *Online Service Provider Liability for Copyright Infringement*, WIPO Doc. OSP/LIA/1 Rev.1, 5–8 (22 November 1999).

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extra-contractual liability for copyright infringement is, as such, an unharmonized patchwork both at the international and regional levels and is being predominantly standardized by national case law.

In this context, this chapter discusses intellectual property and extra-contractual liability by highlighting general comparative analysis issues within civil and common law systems, with some consideration given also to major theoretical clusters that might influence the different legal regimes. The chapter focuses on emerging issues of extra-contractual liability for intellectual property infringement in the platform economy, with special emphasis on copyright and trademark infringement, seeking to co-ordinate miscellaneous approaches from the United States (US), the European Union (EU), and selected European countries' experiences. In doing so, this chapter highlights research and methodological issues related to limited harmonization at a regional level in secondary and extra-contractual liability doctrines when applied to IP. Finally, this chapter describes the World Intermediary Liability Maps (WILMap) as an attempt to provide consistency within a fragmented research framework while also presenting other miscellaneous endeavours seeking the same goal. The WILMap project, in particular, serves as an example of a methodological research approach to cope with the fragmented and inconsistent legal framework dealing with extra-contractual and secondary liability for intellectual property infringement, with special emphasis on copyright and trademark infringement in the digital environment.

II. Extra-Contractual Liability for IP Infringement: Theoretical Background

Bringing pressure to innocent third parties that may enable or encourage violations by others is a well-established strategy to curb infringement. Forcing third parties to act affirmatively to curb infringement would increase the level of compliance to the law. Intermediaries' secondary liability has been based on different theories ranging from moral to utilitarian or welfare approaches. A moral approach would argue that encouraging infringement is widely seen as immoral,[2] while the second approach is associated with the welfare theory and, more broadly, with the utilitarian approach to law in general. The welfare approach was pioneered thirty years ago by Reiner Kraakman's seminal article setting the foundations of the so-called

[2] *See* Richard Spinello, *Intellectual Property: Legal and Moral Challenges of Online File Sharing*, *in* Ethics and Emerging Technologies 300 (Ronald Sandler ed., 2013) (concluding that the behaviour of those that enable P2P sharing by writing and publishing the software that makes it possible is ethically problematic, since it induces and encourages others to act unethically); Mohsen Manesh, *Immorality of Theft, the Amorality of Infringement*, Stan. Tech. L. Rev. 5 (2006); Richard Spinello, *Secondary Liability in the Post Napster Era: Ethical Observations on MGM v. Grokster*, 3 J. of Info., Commc'n and Ethics in Soc'y 121 (2005); Geraldine Szott Moohr, *Crime of Copyright Infringement: An Inquiry Based on Morality, Harm, and Criminal Theory*, 83 Boston U. L. Rev. 731 (2003).

'gatekeeper theory' that will be influential in shaping early online intermediaries' policies.[3] The law would enlist third parties to frustrate or penalize recalcitrant primary infringers, such as bartenders/drunks, accountants/fraudulent clients, employers/illegal immigrants.[4] According to Kraakman:

> [s]uccessful gatekeeping is likely to require (1) serious misconduct that practicable penalties cannot deter; (2) missing or inadequate private gatekeeping incentives; (3) gatekeepers who can and will prevent misconduct reliably, regardless of the preferences and market alternatives of wrongdoers; and (4) gatekeepers whom legal rules can induce to detect misconduct at reasonable cost.[5]

Transposing Kraakman's framework from security regulations—for which it was initially developed—to intellectual property infringement, penalties should be imposed on intermediaries in hopes of suppressing infringing behaviours by users only if: otherwise, the incidence of infringement would be unacceptably high because direct infringers cannot be controlled by socially acceptable sanctions; the intermediaries on their own would not intervene to curb infringement—and instead might foster it; the intermediaries can effectively suppress infringement with minimal capacity for direct infringers to circumvent them; or the social and economic cost of penalizing intermediaries are not unacceptably high.[6] This last cost benefit analysis would be especially relevant in the case of so-called dual-use technologies—technologies that can be used to infringe others' rights as well as facilitate socially beneficial uses.

Although moral or fairness approaches have encountered some success in civil law systems, while common law systems have been traditionally more akin to welfare approaches, welfare theory approaches have been generally dominant in secondary liability policy until recently. These theories have been based on the notion that liability should be imposed only as a result of a cost-benefit analysis, which is especially relevant in the case of dual-use technologies that can be deployed both to infringe others' rights and facilitate social beneficial uses.[7] Apparently, however, there is an ongoing revival of moral approaches to intermediary liability where the justification for policy intervention would be based on responsibility for users' actions as opposed to efficiency or balance innovation versus harm. As I have argued elsewhere, the policy discourse is increasingly shifting from liability to enhanced

[3] Reiner Kraakman, *Gatekeepers: the Anatomy of a Third-Party Enforcement Strategy*, 2 J. L. Econ. & Org. 53 (1986); *see also* C. Metoyer-Duran, *Information Gatekeepers*, 28 Ann. Rev. Info. Sci. & Tech. (ARIST) 111 (1993).

[4] *See* Kraakman, *supra* note 3, at 53.

[5] *Id.* at 61.

[6] *See* William Fisher, *CopyrightX: Lecture 11.1, Supplements to Copyright: Secondary Liability, 7:50* (18 February 2014), https://www.youtube.com/watch?v=7YGg-VfwK_Y (applying Kraakman's framework to copyright infringement).

[7] *Id.* at 7:50.

'responsibilities' for online intermediaries under the assumption that their role is unprecedented for their capacity to influence the informational environment and users' interactions within it.[8]

III. Liability Doctrines and Exemptions: A Comparative Analysis

Against this doctrinal framework, miscellaneous doctrines have been developed both in common and civil law countries to impose liability on third parties aiding, abetting, enabling, or merely facilitating primary infringers' behaviour. As mentioned, these doctrines have drawn from established principles in tort and extra-contractual liability, traditionally applied to non-contractual liability, and repurposed to the case of intellectual property infringement. Recently, secondary liability has become a privileged tool to curb IP infringement online under the assumption that primary liability is 'a teaspoon solution to an ocean problem'.[9]

In both civil and common law countries, some intra-IP law solutions, such as the doctrine of authorization in the UK, have been coexisting with miscellaneous doctrines based on general principles of private law, such as tort law or extra-contractual liability, ranging from strict liability to negligence or a breach of a duty of care and, at times, depicting a very confused international panorama. No comprehensive review would be possible given the scope of this chapter. However, some anecdotal reference to the interaction between intellectual property and extra-contractual/tort liability provisions in some major jurisdictions might provide a broad-brush idea of the research and methodological challenges at stake in this field.

Judge-made doctrines of secondary liability—including contributory, vicarious, and inducement liability—have been developed for some time in the US. Contributory infringement would find its origin in tort law principles—according to which, whoever directly contributes to a tort should be held liable along with the tortfeasor herself—whereas vicarious infringement would be a qualification of the doctrine of *respondiat superior*—a branch of the law of agency that governs

[8] *See Why Keep a Dog and Bark Yourself? From Intermediary Liability to Responsibility*, 25 Oxford J. Int'l L. & Inf. Tech. 1–33 (2017); *see also* Communication from the Commission to the European Parliament, the Council, and the Economic and Social Committee, and the Committee of the Regions, Tackling Illegal Content Online. Towards an Enhanced Responsibility of Online Platforms, COM (2017) 555 final (28 September 2017); Martin Husovec, Injunctions Against Intermediaries in the European Union Accountable But Not Liable? (2017); Emily Laidlaw, Regulating Speech in Cyberspace: Gatekeepers, Human Rights and Corporate Responsibility (2015); Mariarosaria Taddeo and Luciano Floridi, *The Debate on the Moral Responsibility of Online Service Providers*, Sci. Eng. Ethics 1, 1 (published online 27 November 2015), http://link.springer.com/article/10.1007%2Fs11948-015-9734-1.

[9] Randal Picker, *Copyright as Entry Policy: The Case of Digital Distribution*, 47 Antitrust Bull. 423 (2002).

the responsibility of employers for the misconduct of their employees.[10] Since the so-called 'dance hall cases', a long line of US cases applied these doctrines to third parties involved with primary intellectual property infringement. In *Sony*, the US Supreme Court found that secondary liability doctrines, including contributory and vicarious liability, earlier applied to patent infringement could be extended to copyright infringement but manufacturing and marketing a device capable of substantial non-infringing uses—such as the Sony VHS player—does not trigger secondary liability.[11] Later, *Fonovisa* found that third parties managing and selling out spaces in a swap market might be vicariously liable for the intellectual property infringement occurring within the market's premises.[12] Recently, abundant case law dealt with secondary liability for copyright infringement occurring in peer-to-peer ('p2p') networks by applying similar tort-based doctrines. *Napster* found the p2p platform by the same name vicariously liable as it has actual knowledge of infringement and supervisory control.[13] *Aimster* qualified previous decisions by noting that 'willful blindness'—such as cryptography of all data exchanged on the platform so as not to have knowledge of infringing files being shared—constituted knowledge and triggered infringement.[14] Finally, *Grokster* introduced a new ground for liability beyond contributory and vicarious liability by stating that inducement to infringement—proved by evidence of 'purposeful, culpable expression and conduct'—triggers liability.[15]

Other countries came up with mixed approaches where secondary liability is alternatively based on intellectual property provisions or general tort principles. Under UK law, third parties would generally be held liable for the infringements of primary wrongdoers if they have either authorized those infringements, procured or induced them, or acted pursuant to a common design with its users to achieve them. On one side, according to s. 16 of the UK copyright law, '[c]opyright in a work is infringed by a person who without the licence of the copyright owner does, or *authorises another to do*, any of the acts restricted by the copyright'.[16] In this context, UK Courts have distinguished between 'authorization' and 'mere facilitation', which would not trigger secondary liability.[17] Also, claimants bringing

[10] *See* Reiner Kraakman, *Vicarious and Corporate Civil Liability*, *in* Tort Law and Economics 134–47 (Michael Faure ed., 2009); Sverker Högberg, *The Search for Intent-Based Doctrines of Secondary Liability in Copyright Law*, 107 Col. L. Rev. 909, 915 (2006); Alfred Yen, *Third Party Copyright Liability after Grokster*, 91 Minn. L. Rev. 184 (2006); Mark Lemley and Anthony Reese, *Reducing Digital Copyright Infringement without Restricting Innovation*, 56 Stan. L. Rev. 1345, 1366 (2004); Charles Wright, *Actual Versus Legal Control: Reading Vicarious Liability for Copyright Infringement into the Digital Millennium Copyright Act of 1998*, 75 Wash. L. Rev. 1005, 1013 (2000).

[11] *See* Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417 (1984).

[12] *See* Fonovisa v. Cherry Auction, 76 F.3d 259 (9th Cir 1996).

[13] *See* A&M Records v. Napster, 239 F.3d 1004 (9th Cir. 2001).

[14] *See* In re Aimster Copyright Litig., 334 F.3d 643 (7th Cir. 2003).

[15] *See* Metro-Goldwyn-Mayer Studios Inc. v Grokster, Ltd., 545 U.S. 913 (2005).

[16] *See* CDPA 1988, § 16 (emphasis added). *See also* Falcon v. Famous Players Film Co. Ltd. [1926] 2 KB 474.

[17] *See* CBS v. Ames Records [1981] RPC 407, § 106; Amstrad [1988] RPC 567, 603 [HL]; Newzbin (No. 1) [2010] FSR 21, § 90; Dramatico [2012] RPC 27, § 81.

suits against secondary infringers have to prove an additional mental element, i.e. that the defendant knew or had reason to believe that he was dealing with infringing copies, providing the means for making infringing copies or that the performances for which he had permitted the use of premises or had provided necessary apparatus was infringing.[18] On the other side, UK courts have also applied common law tort doctrines such as joint tortfeasance, which requires an 'identifiable procurement of a particular infringement' or inducement and a 'common design'.[19] It is according to this doctrine that liability was found, for example, in the case of the operators of the *ThePirateBay* platform, but not the manufactures of the Amstrad cassette player and duplicator.[20] Finally, under seminal *Norwich Pharmacal* jurisprudence, if, albeit innocently, 'a person gets mixed up in the tortious acts of others' so as to facilitate the tort, he comes under a duty to assist the person who has been wronged and help to put an end to the tort.[21] In close connection to UK doctrines, Australian jurisprudence construed a 'separate common law tort' realized by the authorization to the infringement of intellectual property rights.[22]

In France, general tort law principles have been relied upon to expand liability to additional actors other than the material infringer.[23] Extra-contractual liability obliges to repair damages caused by fault or negligence (*responsabilité délictuelle*

[18] *See* Dramatico Entertainment Ltd. v. British Sky Broadcasting Ltd. (No. 1) [2012] EWHC 268 (Ch) (UK); Sophie Stalla-Bourdillon, *Liability Exemptions Wanted! Internet Intermediaries' Liability under UK Law*, 7 J. Int'l Comm. L. & Tech. 289, 293–99 (2012); Christina Angelopoulos, *On Online Platforms and the Commission's New Proposal for a Directive on Copyright in the Digital Single Market*, Centre For Intell. Prop. & Info. L. 19–33 (January 2017), available at https://juliareda.eu/wp-content/uploads/2017/03/angelopoulos_platforms_copyright_study.pdf; Paul S. Davis, *Accessory Liability: Protecting Intellectual Property Rights*, 4 Intell. Prop. Q. 390 (2011).

[19] *See* SABAF v MFI Furniture [2003] RPC 264, § 59 (Peter Gibson LJ) (noting '[t]he underlying concept for joint tortfeasance must be that the joint tortfeasor has been so involved in the commission of the tort as to make himself liable for the tort. *Unless he has made the infringing act his own*, he has not himself committed the tort') (emphasis added); *see also* L'Oréal v. eBay Int'l AG [2009] EWHC 1094 (Ch), § 350.

[20] *See* Amstrad [1988] RPC 567 [HL], § 609; Dramatico [2012] RPC 27, § 83.

[21] Norwich Pharmacal Co. v. Customs and Excise Comrs [1974] AC 133, § 175 B–C.

[22] *See* Univ. of New S. Wales v. Moorhouse [1975] HCA 26 (Austl.) (finding the University of New South Wales liable for authorizing the infringements of those who used the photocopiers it provided in its library); CBS Songs Ltd. v. Amstrad Consumer Elecs. Plc [1988] UKHL 15 (finding manufacturer and seller of hi-fi equipment not liable when applying authorization liability of intermediaries facilitating the copyright-infringing actions of their users); Universal Music Australia Pty Ltd. v. Sharman License Holdings Ltd. [2005] FCA 1242 (Austl.) (finding Sharman, who operated the Kazaa filesharing platform, liable for authorizing the infringements of its users); Roadshow Films Pty Ltd. v. iiNet Ltd. [2012] HCA 16 (Austl.) (holding that iiNet, Australia's second largest ISP, was not liable for authorizing its customers' infringement of copyright films downloaded over BitTorrent); *see also* Jane Ginsburg and Sam Ricketson, *Inducers and Authorisers: A Comparison of the US Supreme Court's Grokster Decision and the Australian Federal Court's KaZaa Ruling* (Columbia Public Law and Legal Theory, Working Paper No. 0698, 2006).

[23] Of course, here as well, in addition to intra-intellectual property solutions, such as by expanding primary liability for copyright infringement to the right of communication to the public or reproduction not just to the material acts of infringement, but also to the provision of means for their commission. *See* Code de la propriété intellectuelle (Intellectual Property Code), art. L.122-4 (Fr.).

and *quasi-délictuelle*).[24] Similarly, crafted provisions are available in most civil law legislations and have been customarily deployed to find secondary liability for intellectual property infringement. Traditionally, in France, third parties were placed under a duty to take all necessary measures to prevent infringement of others' rights to avoid liability. Courts developed the principle of '*diligences appropriées*' from a general duty of care based on the standards of the '*bon père de famille*' and the '*prestataire diligent et avisé*'. These standards would impose three main obligations on third parties, including bringing the need to respect the rights of others to the attention of users (*obligation d'information*), remaining vigilant against infringement along with a standard of professional care (*obligation de vigilance*), and acting against verified infractions by—in the case of copyright infringement—removing the unlawful material and impeding its future re-posting (*obligation de réaction*).[25] Later, the *Cour de Cassation* found this general duty—that derailed into a judicially made notice and stay-down system—non-compliant with the prohibition of general monitoring under EU law; therefore, copyright holders must now monitor the content of websites themselves and notify intermediaries for each new infringement of protected content.[26]

In Germany, secondary liability in intellectual property infringement is almost invariably handled through the doctrine of *Störerhaftung*—as an alternative to joint tortfeasance for which the liability threshold is often set to high.[27] This doctrine—embedded in BGB, § 1004—grants a permanent injunctive relief to the proprietor against anybody who has caused an interference—*störer* means interferer—with the property, unless it would be unreasonable to burden the interferer with a duty to examine whether his behaviour could interfere with the (intellectual) property of a third person.[28] Of course, also common liability in damages—similar to French *responsabilité délictuelle* and *quasi-délictuelle*—can ground secondary liability for IP infringement according to the principle that '[a] person who, intentionally or negligently, unlawfully injures the life, body, health, freedom, property or another right of another person is liable to make compensation to the other party for the damage arising from this'.[29]

[24] *See* Code Civil, art. 1382 ('Every act whatever of man that causes damage to another, obliges him by whose fault it occurred to repair it') and art. 1383 ('We are responsible not only for the damage occasioned by our own act, but also by our own negligence or imprudence.').

[25] *See* Lacoste (TGI de Nanterre, 8 December 1999).

[26] *See* Cour de cassation [Cass.][supreme court for judicial matters] 1e civ., 12 July 2012, Bull. civ., No. 831 (Fr.); Cour de cassation [Cass.][supreme court for judicial matters] 1e civ., 12 July 2012, Bull. civ., No. 828 (Fr.); André Lucas, Henri Jacques Lucas and Agnès Lucas-Schloetter, Traité de la Propriété Littéraire et Artistique 901 (LexisNexis 4th ed., 2012); Angelopoulos, *supra* note 18, at § 2.

[27] *See* Burgerliches Gesetzbuch [BGB] [German Civil Code], art. 830 ('[i]f more than one person has caused damage by a jointly committed tort, then each of them is responsible for the damage') [hereinafter BGB].

[28] *See* Rolex v. Ebay/Ricardo (Internet Auction I), I ZR 304/01, JurPC Web-Dok, 31 (BGH, 11 March 2004) (Ger.).

[29] *See* BGB, *supra* note 27, at art. 823.

Cross-pollination between different legal regimes makes the research framework increasingly complex. For example, a recent Spanish copyright reform expanded third parties' liability for copyright infringement by introducing, inter alia, US doctrines of secondary liability—inducement, contributory and vicarious liability—in the Spanish legal system. The reform imposed liability—unless the intermediary is sheltered by the Directive 2001/29/EC's exemptions—on anyone who either knowingly induces the infringement or, knowing or having reason to know about the infringement, co-operates to it, or having a direct economic interest in the results of the infringement has the ability to control the infringer's conduct.[30]

Of course, tort and extra-contractual liability doctrines developed by courts in multiple jurisdictions must also be co-ordinated with the liability exemptions enjoyed by online service providers for wrongful activities committed by users through their services. These exemptions—or safe harbours—considerably complicate the research field because regional or super-national legislations must co-ordinate with national legislation and judicially made doctrines. The United States introduced these safe harbours first. In 1996, the Communications Decency Act exempted intermediaries from liability for the speech they carry.[31] In 1998, the Digital Millennium Copyright Act introduced specific intermediary liability safe harbours for copyright infringement under more stringent requirements.[32] Shortly thereafter, the eCommerce Directive imposed on Member States the obligation of enacting similar legal arrangements to protect a range of online intermediaries from liability.[33] Other jurisdictions followed suit in more recent times.[34] In most cases, safe harbour legislations provide mere conduit, caching, and hosting exemptions for intermediaries, together with the exclusion of a general obligation on online providers to monitor the information which they transmit, store, or actively seek facts or circumstances indicating illegal activity.[35] In particular, hosting providers are not liable for the information

[30] Real Decreto Legislativo (RDL) 1/1996, de 12 de abril, por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia, BOE-A-1996-8930, art. 138, as amended by Ley 21/2014, de 4 de noviembre, BOE-A-2014-11404 (Spain).

[31] *See* Communications Decency Act of 1996, 47 U.S.C. § 230.

[32] *See* Digital Millennium Copyright Act of 1998, 17 U.S.C. § 512 [hereinafter DMCA].

[33] *See* Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market, 2000 O.J. (L 178) 1–16 [hereinafter eCommerce Directive].

[34] *See, e.g.*, Copyright Legislation Amendment Act 2004 (Cth), No. 154, Sch. 1 (Austl.); Copyright Modernization Act, SC 2012, c.20, § 31.1 (Can.); Judicial Interpretation No. 20 [2012] of the Supreme People's Court on Several Issues concerning the Application of Law in Hearing Civil Dispute Cases Involving Infringement of the Right of Dissemination on Information Networks, 17 December 2012 (China); Federal Law No. 149-FZ, on Information, Information Technologies and Protection of Information, 27 July 2006 (Russ.) and Federal Law No. 187-FZ of 2 July 2013, amending Russian Civil Code, § 1253.1.

[35] *See, e.g.*, eCommerce Directive, *supra* note 33, at arts. 12-15; DMCA, *supra* note 32, at § 512(c)(1)(A–C).

stored, provided that: (1) the provider does not have actual knowledge of illegal activity or is not aware of facts or circumstances from which the illegal activity is apparent; or (2) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or disable access to the information.[36] In this context, the DMCA enacted notice-and-takedown procedures for removing alleged copyright-infringing content.[37] European law, then, imposes a higher standard on online intermediaries by providing rightsholders with injunctions against intermediaries whose services are used by a third party to infringe a copyright or other intellectual property right.[38]

In this context, it is worth mentioning that there is no case law and harmonized regulation on secondary liability for IP infringement at the EU level.[39] As seen, each Member State has deployed differing and miscellaneous standards, also depending on the relevant subject matter.[40] This means the EU liability exemption legal framework must co-ordinate—and often clash—with multiple unharmonized doctrines based on national tort and extra-contractual liability principles. However, in recent times, the Court of Justice of the European Union (CJEU) has tried to introduce some harmonization by expanding primary liability for infringement of the right to communication to the public where traditionally only secondary extra-contractual or tort liability doctrines were applied. In particular, the CJEU found that some online service providers under specific circumstances might be primarily liable for copyright—and possibly trademark—infringement, rather than secondarily, in cases of linking to infringing content.[41]

[36] *See, e.g.*, eCommerce Directive, *supra* note 33, at art. 14; DMCA, *supra* note 32, at § 512(c)(1)(A–C).

[37] *See* DMCA, *supra* note 32, at § 512(c)(3), (g)(2–3).

[38] *See* Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, art. 8(3), 2001 O.J. (L 167) 10–19; Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2000 on the Enforcement of Intellectual Property Rights, art. 11, 2004 O.J. (L 195) 16.

[39] Actually, there is no direct relation between liability and exemptions, which function as an extra-layer of protection intended to harmonize at the EU level conditions to limit third party liability. *See, e.g.*, Angelopoulos, *supra* note 18.

[40] *See* Christina Angelopoulos, European Intermediary Liability in Copyright. A Tort-Based Analysis (2016); Tatiana-Eleni Synodinou, *Intermediaries' Liability for Online Copyright Infringement in the EU: Evolutions and Confusions*, 31 Comp. L. & Sec. Rev. 57, 57–67 (2015); Tatiana-Eleni Synodinou, *Intermediaries' Liability for Online Copyright Infringement in the EU: Evolutions and Confusions*, 31 Comp. L. & Sec. Rev. 57–67 (2015); Christina Angelopoulos, *Beyond the Safe Harbors: Harmonizing Substantive Intermediary Liability for Copyright Infringement in Europe*, 3 Intell. Prop. Q. 254 (2013); Mari Männiko, *Intermediary Service Providers' Liability Exemptions: Where Can We Draw the Line?*, *in* Regulating eTechnologies in the European Union: Normative Realities and Trends (Tanel Kerikmäe ed., 2014) (noting that comparative analysis show that the present legislation is too general and gives too much room for interpretation); Patrick Van Eecke, *Online Service Providers and Liability: A Plea for a Balanced Approach*, 48 Common Mkt. L. Rev. 1455–61 (2011); Broder Kleinschmidt, *An International Comparison of ISP's Liabilities for Unlawful Third Party Content*, 18 Int'l J.L. & Info. Tech. 345, 345–53 (2010).

[41] *See* Case C-279/13, C More Entm't AB v. Linus Sandberg (ECJ, 26 March 2015); Case C-466/12, Nils Svensson et al. v Retriever Sverige AB (ECJ, 13 February 2014).

IV. The World Intermediary Liability Map (WILMap): A Methodological Approach Mapping a Fragmented Legal Framework

Unsurprisingly, online intermediaries' obligations, liabilities, and responsibilities increasingly take the center stage of internet policy. However, inconsistencies across different regimes generate legal uncertainties that undermine both users' rights and business opportunities. To better understand the heterogeneity of the international online intermediary liability regime—and in search of consistency—I have developed and launched the World Intermediary Liability Map (WILMap), a detailed English-language resource hosted at Stanford CIS and comprised of case law, statutes, and proposed laws related to intermediary liability worldwide.[42]

The WILMap is a graphic interface for legislation and case law enabling the public to learn about intermediary liability regimes worldwide and evolving internet regulation. This resource allows visitors to select information on countries of interest, including case law, statutes, and proposed laws. The WILMap features legislation, pending bills, and proposals imposing obligations on intermediaries, both access and hosting providers or other online intermediaries, such as payment processors. If available, the WILMap includes relevant case law for each jurisdiction. The WILMap would like to feature any case law discussing obligations and liability of online intermediaries due to (infringing) activities undertaken by their users. The WILMap also features sections for administrative enforcement of intermediary liability online, if there are administrative agencies charged with implementing website blocking orders or content removal in a certain jurisdiction. Each country page includes links to original sources and English translations, if available.

Mapping online intermediary liability worldwide entails the review of wide-ranging topics, stretching into many different areas of law and domain-specific solutions. The WILMap covers numerous topics, including online intermediaries' safe harbours, e-commerce, copyright and trademark protection, defamation, hate/dangerous speech (including anti-terrorism provisions), privacy protection, and child protection online.

The WILMap has become a privileged venue to observe emerging trends in internet jurisdiction, innovation regulation, and enforcement strategies dealing with intermediate liability for copyright, trademark, and privacy (right to be

[42] World Intermediary Liability Map (WILMap) (a project designed and developed by Giancarlo Frosio and hosted at Stanford CIS), https://wilmap.law.stanford.edu [hereinafter WILMap]. The Stanford Intermediary Liability Lab (SILLab), another project I launched at Stanford Law School in 2013, functioned as an incubator for developing the WILMap and study international approaches to intermediary obligations concerning users' copyright infringement, defamation, hate speech or other vicarious liabilities, immunities, or safe harbors. *See* Stanford Intermediary Liability Lab, https://www.facebook.com/groups/ILLab; *see also* CIS, Intermediary Liability, https://cyberlaw.stanford.edu/focus-areas/intermediary-liability.

forgotten) infringement and the role of internet platforms in moderating the speech they carry for users, including obligations and liabilities for defamation and hate and dangerous speech. Mapping online intermediary liability worldwide should help magnify policy gaps in existing legal frameworks regulating OSPs and possible strategies to overcome them.

The WILMap project has been made possible by an amazing team of contributors from around the world, both individual researchers and institutions, providing the necessary information to create and update each country page.[43] The creation of a global network of WILMap contributors also allows for the promotion of synergies with global platforms and free expression groups to advocate for policies protecting innovation and other user rights.[44]

Since its launch in July 2014, the WILMap has been steadily and rapidly growing. Today, the WILMap covers almost one hundred jurisdictions in Africa, Asia, the Caribbean, Europe, Latin America, North America, and Oceania. The WILMap is an ongoing project. In collaboration with a network of experts worldwide, CIS continues to update and expand the map with the goal of covering all jurisdictions. To make the WILMap a more valuable resource for activists, industry players, researchers, and the general public, the WILMap website has been updated with enhanced usability and data aggregation features.[45]

WILMap's attempt to study secondary liability to come at terms with a fragmented legal framework is not isolated. Mapping and comparative analysis exercises have been undertaken by the Network of Centers—which produced a case study series exploring online intermediary liability frameworks and issues in Brazil, the EU, India, South Korea, the US, Thailand, Turkey, and Vietnam[46]—WIPO,[47] and other academic initiatives.[48]

Institutional efforts at the international level are on the rise. Recently, the Global Multistakeholder Meeting on the Future of Internet Governance (NETmundial) worked towards the establishment of global provisions on intermediary liability

[43] *See* WILMap, *supra* note 42, Contributors, https://wilmap.law.stanford.edu/contributors.

[44] *See* OSJI-CIS Workshop on Intermediary Liability, Fostering Greater Collaboration between Service Providers and Internet Freedom Groups in the Public Interest, Stanford University, Stanford, CA, 15 December 2014.

[45] Stanford Law School's Center for Internet and Society Launch the World Intermediary Liability Map 2.0, CIS Blog (16 May 2018) https://cyberlaw.stanford.edu/blog/2018/05/stanford-law-schools-center-internet-and-society-launch-world-intermediary-liability.

[46] *See* Berkman Center for Internet and Society, *Liability of Online Intermediaries: New Study by the Global Network of Internet and Society Centers* (18 February 2015), https://cyber.law.harvard.edu/node/98684; Urs Gasser and Wolfgang Schulz, *Governance of Online Intermediaries: Observations from a Series of National Case Studies* (Berkman Center Research Publication No. 2015-5, 2015).

[47] *See* Daniel Sang, *Comparative Analysis of National Approaches of the Liability of the Internet Intermediaries—VII: Japan* (WIPO Study); Ignacio Garrote Fernández-Díez, *Comparative Analysis on National Approaches to the Liability of Internet Intermediaries for Infringement of Copyright and Related Rights* (WIPO Study).

[48] *See, e.g.*, for other mapping and comparative exercises, Intellectual Property Liability of Consumers, Facilitators, and Intermediaries (Christopher Heath & Anselm Kamperman Sanders eds., 2012).

within a charter of Internet governance principles.[49] A few months earlier, the Organization for Economic Co-operation and Development (OECD) issued recommendations on Principles for Internet Policy Making stating that, in developing or revising their policies for the Internet Economy, the State members should consider the limitation of intermediary liability as a high-level principle.[50] Also, the 2011 Joint Declaration of the three Special Rapporteurs for Freedom of Expression apparently contains statements suggesting an ongoing search for a global regime for intermediary liability.[51] The Representative on Freedom of the Media of the Organization for Security and Co-operation in Europe (OCSE) issued a *Communiqué on Open Journalism*, which hopes to advise the organization's fifty-seven member states on best practices with regards to digital rights and intermediaries.[52]

Efforts to produce guidelines and general principles for intermediaries emerged also in the civil society. In particular, the Manila Principles on Intermediary Liability sets out safeguards for content restriction on the internet with the goal of protecting users' rights, including 'freedom of expression, freedom of association and the right to privacy'.[53] A set of general principles is accompanied by sub-principles and a background paper qualifying some of the terminology and statements included in the principles.[54]

Other projects developed best practices that might be implemented by intermediaries in their terms of service with special emphasis on protecting fundamental rights.[55] For example, under the aegis of the Internet Governance Forum, the Dynamic Coalition for Platform Responsibility aims to delineate a set of

[49] *See* NETmundial Multistakeholder Statement, São Paulo, Brazil, 24 April 2014, available at http://netmundial.br/wp-content/uploads/2014/04/NETmundial-Multistakeholder-Document.pdf.

[50] *See* Organization for Economic Co-operation and Development (OECD), Recommendation of the Council on Principles for Internet Policy Making, C(2011)154 (13 December 2011), available at http://acts.oecd.org/Instruments/ShowInstrumentView.aspx?InstrumentID=270.

[51] *See* The United Nations (UN) Special Rapporteur on Freedom of Opinion and Expression, the Organization for Security and Co-operation in Europe (OSCE) Representative on Freedom of the Media, the Organization of American States (OAS) Special Rapporteur on Freedom of Expression and the African Commission on Human and Peoples' Rights (ACHPR) Special Rapporteur on Freedom of Expression and Access to Information, International Mechanism for Promoting Freedom of Expression, Joint Declaration on Freedom of Expression and the Internet (2011), available at http://www.osce.org/fom/78309?download =true.

[52] Organization for Security and Co-operation in Europe (OCSE) Representative on Freedom of the Media, Dunja Mijatović, 3rd Communiqué on Open Journalism, Vienna, 29 January 2016, available at http://www.osce.org/fom/219391?download=true [hereinafter OCSE, Communiqué on Open Journalism].

[53] See Manila Principles on Intermediary Liability, Intro, available at https://www.manilaprinciples.org.

[54] *See* Manila Principles on Intermediary Liability Background Paper (30 May 2015), available at https://www.eff.org/files/2015/07/08/manila_principles_background_paper.pdf.

[55] *See, e.g.*, Jamila Venturini et al., Terms of Service and Human Rights: Analysing Contracts of Online Platforms (2016).

model contractual-provisions.[56] These provisions should be compliant with the UN 'Protect, Respect and Remedy' Framework as endorsed by the UN Human Rights Council together with the UN Guiding Principles on Business and Human Rights.[57] Appropriate digital labels should signal the inclusion of these model contractual provisions in the Terms of Service of selected platform providers.[58] Again, the Global Network Initiative (GNI) put together a multistakeholder group of companies, civil society organizations, investors, and academics to create a global framework to protect and advance freedom of expression and privacy in information and communications technologies. The GNI's participants—such as Facebook, Google, LinkedIn, Microsoft, and Yahoo—committed to a set of core documents, including the GNI Principles, Implementations Guidelines and Accountability, Policy, and Learning Framework.[59]

Ranking Digital Rights is an additional initiative promoting best practices and transparency among online intermediaries.[60] This project ranks internet and telecommunications companies according to their virtuous behaviour in respecting users' rights, including privacy and freedom of speech. In November 2015, the first project's report ranked sixteen companies in different countries on thirty different measures.[61] Companies scored between 13 per cent and 65 per cent.[62] Most companies received a failing grade for their public commitments and disclosed policies affecting users' freedom of expression and privacy.[63]

Several initiatives have been looking into notice and takedown procedures to highlight possible chilling effects and propose solutions. Lumen—formerly Chilling Effects—archives takedown notices to promote transparency and facilitate research about the takedown ecology.[64] The Takedown Project is a collaborative effort housed at UC-Berkeley School of Law and the American Assembly to study notice and takedown procedures.[65] The Takedown Project launched the

[56] *See Dynamic Coalition on Platform Responsibility: A Structural Element of the United Nations Internet Governance Forum*, available at http://platformresponsibility.info [hereinafter Dynamic Coalition].

[57] *See* United Nations, Human Rights, Office of the High Commissioner, *Guiding Principles on Business Human Rights: Implementing the United Nations 'Protect, Respect, and Remedy' Framework* (2011), available at http://www.ohchr.org/Documents/Publications/GuidingPrinciplesBusinessHR_EN.pdf.

[58] *See* Dynamic Coalition, *supra* note 56.

[59] *See* Global Network Initiatives, available at http://globalnetworkinitiative.org.

[60] *See* Ranking Digital Rights, available at https://rankingdigitalrights.org; *see also* Rebecca MacKinnon, Consent of the Networked: The Worldwide Struggle for Internet Freedom (2012).

[61] *See* Ranking Digital Rights, Corporate Accountability Index, available at https://rankingdigitalrights.org/index2015.

[62] *Id.*

[63] *Id.*

[64] *See* Lumen, available at www.lumendatabase.org; *see also* Online Censorship, available at https://onlinecensorship.org (allowing users to document their experience with terms of service based removals of content).

[65] *See* The Takedown Project, available at http://takedownproject.org.

Notice Coding Engine looking at the impact of automated both sending and receiving process of notice and takedown.[66] Again, the Internet and Jurisdiction project has been developing a due process framework to deal more efficiently with transnational notice and takedown requests, seizures, MLAT, and law enforcement co-operation requests.[67] The framework will be based on the creation of a legal reference database to support the assessment of takedown requests.[68] Finally, apart from establishing good practice standards for notices, the Manila Principles initiatives made available a template notice of content restriction as a mock-up web form that can be adopted by intermediaries.[69]

V. Conclusions

Interaction between IP law and tort law/extra-contractual liability doctrines is constantly on the rise. Extra-contractual liability doctrines serve as a privileged legal tool to address secondary liability, which often does not find specific redress in intellectual property legislation and lacks harmonization in regional or international intellectual property legal instruments. Of course, secondary liability for intellectual property infringement—with special emphasis on copyright and trademark infringement—becomes critical in the platform economy given the role of online service providers in mediating content distribution. Tort law and extra-contractual liability, therefore, have been largely deployed to force third parties, such as online intermediaries, to help in curbing infringement primarily carried out by end-users. The inherently fragmented, national, and unharmonized nature of tort and extra-contractual liability provisions and doctrines has been obviously a challenge for legal research, reflecting a larger market conundrum where both users and industry players find themselves at a disadvantage in understanding how different regimes might regulate the global services offered to the public. The WILMap—and other miscellaneous projects—has been developed to provide a methodological solution to this fragmentation, mapping out a very inconsistent legal framework and giving intellectual property researchers some co-ordinates to carry out follow up research.

[66] *Id.* at Projects, Notice Coding Engine.

[67] *See* Bertrand de La Chapelle and Paul Fehlinger, *'Towards a Multi-Stakeholder Framework for Transnational Due Process'* (Internet & Jurisdiction White Paper, 2014), available at http://www.internetjurisdiction.net/wp-content/uploads/2014/08/Internet-Jurisdiction-Project-White-Paper-3.pdf.

[68] *Id.*

[69] Template Notice Pre-Zero Draft Revised, available at https://goo.gl/NlVXEF.