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Interview with Lord Justice Arnold

By Riana Harvey and Alexandre Miura

ABSTRACT

Lord Justice Arnold is renowned in the UK and the EU for his judicial contributions to the field of intellectual property (IP), and currently sits as a Justice of Appeal in the England and Wales Court of Appeal. As a judge, he has made 14 referrals to the Court of Justice of the European Union (CJEU) between 2004 and 2019¹. Our Chief-Editors had the pleasure of talking with him and getting his opinion on a broad range of topics, from recent case law developments, to the future of IP policies in the UK and in the EU, to website blocking and, finally, some valuable thoughts for IP students who wish to enter the field in the future.

CAREER

SIPLR: You have had such a varied background, tackling all areas of IP law, and have been involved in a wide variety of judicial boards, from the England and Wales High Court, to the Court of Appeal. What differences have you found, if any, when adjudicating on matters in these different forums?

Arnold LJ: I would say that the key distinction under any system is between sitting in the first instance court and sitting in the Court of Appeal.

As a first instance court, you obviously have to be the first person to take a decision on the case, and you then have to deal with the facts and the law and see what conclusion you arrive at. By contrast, when you are sitting in an appellate court, there's already been one decision. So, the key question for any appellate court is whether there is anything wrong with the first instance decision. So, your task is one of review rather than taking a decision afresh.

Furthermore, under most systems, a court of appeal decision has more precedential value than a first instance decision. And so, appeals courts are naturally more concerned with the state of the law as opposed to the decision in the individual case, although, of course, the decision in the individual case remains important. So, I think all of those considerations are true under any system, and that's

true even if you are operating under a civil law system which doesn't operate strict precedent, because even if you don't operate strict precedent, it's still the case that appellate decisions will influence lower courts subsequently.

But over and above those general considerations, in the system in which I spend most of my time, which is that of England and Wales, there are further factors which highlight the difference between sitting in first instance and sitting in the Court of Appeal. The first one is that in our system, if you're sitting at first instance, generally speaking, you are sitting on your own as a single judge. So, in all of my first instance decisions, that's been my position and so it's been purely down to me to make the decision and to write the judgment.

By contrast, in our courts of appeal, there's always a multiplicity. Usually in the Court of Appeal it's three. Occasionally, it can be two. Very rarely, it can be more than three, although I have personally never had that experience. And obviously, if you go on up to the Supreme Court, then there is at least five, although I've not had the privilege of sitting in that court. There's a big difference between sitting on your own and sitting in a collegiate court for the very obvious reason that, if there's more than one of you, first of all, you need to talk to the others. And secondly, you need to reach a decision. And under most systems, that will involve obviously a majority decision. But in most systems, you will try and arrive at a consensus if you can. So that's quite a big difference.

The other big difference under our system is that the first instance court is responsible for fact-finding, whereas that's not the responsibility of the Court of Appeal, and that makes a big difference to the work of the judge. There's a lot more for the judge to do when sitting at first instance than there is at the Court of Appeal.

Obviously, we have under our system disclosure documents, we have evidence from factual witnesses, we have evidence from expert witnesses, and, as a result, there is a lot of material for a first instance judge to synthesise when writing a judgment. I am well known for writing lengthy judgments at first instance because of those factors, among other reasons. By contrast, the judgments that I have been writing in the Court of Appeal have tended to be much shorter for the very good reason that the facts have already been found by the court below, so I don't need to do that work that I was accustomed to doing when sitting at first instance. That makes a really big difference,



and it means that you can concentrate on the legal issues that are raised on the appeal.

So, I think those, generally speaking, would be the differences that I would highlight.

RECENT CASE LAW DEVELOPMENTS

SIPLR: Under s 1 of the Copyright, Designs and Patents Act 1988 ('CDPA'), the UK has a closed list of works that may be protected by copyright. The CJEU *Cofemel*² decision has clearly opened the door to queries as to whether it is possible to interpret UK copyright law in line with *Cofemel*, which was briefly tackled in the IPEC case of *Response Clothing*³ from last year (Hacon J said UK copyright law was compatible to a point). Do you think that *Cofemel* has upended UK law as we know it? Would you maintain the position that you took in *SAS v WPL* (i.e., that a work can be a work outside of the kinds listed in s1 CDPA, provided that it complies with the Berne Convention⁴)?

Arnold LJ: Well, two initial points need to be made. Firstly, I have got to be careful what I say, because this is a question that could be coming before me in a future case. In particular, I don't know if there's going to be an appeal in the *Response Clothing* case, but there might well be an appeal in that case. And if so, it's quite likely that I would be sitting on that panel and therefore I must be careful not to prejudice any of the arguments that might arise in that case. The second observation I would make is that I didn't actually decide this point in *SAS v WPL*. I merely recognised that, on the state of the jurisprudence of the

Court of Justice of the European Union as it then stood, it would be arguable that a closed list of works such as that we have under the UK Copyright Act was not compatible with the EU Directive.

Now, I think it's pretty plain that that argument receives more support from subsequent case law and in particular from the *Cofemel* decision. But there are still arguments available to the contrary. In particular, I think one thing that can be said, which is relatively uncontroversial in view of what His Honour Judge Hacon said in the *Response Clothing* case, is that there are two alternative possibilities, at least, that are open to the UK even before one gets to Brexit.

The first is the 'nuclear' option of saying that the 1988 Act is incompatible with EU law. But the second one is a more fine-tuned response, which is to say that the Act is not incompatible with the Directive, because what you can do instead is to interpret the Act in a way that makes it compatible with EU law. And this would be an application of the *Marleasing*⁵ principle of interpretation, according to which national courts are required to interpret their national law insofar as possible in a way in which is compatible with EU law.

Now, as I'm sure you'll appreciate, that's exactly the line that Judge Hacon took in the *Response Clothing* case because he was faced with the question of what is a work of artistic craftsmanship. That is, even as a matter of purely domestic law, not an easy question to answer, and there is some room for manoeuvre for any court in answering that question. But if you overlay on that the *Marleasing* obligation, then it's not too difficult to arrive at the conclusion

¹ Lord Justice Arnold discusses his experiences and conclusions on these references in Arnold, R. 'References to the Court of Justice of the European Union: Experiences of a National Judge 2004-2019' (2020) *International Review of Intellectual Property and Competition Law* 51, 1086-1106, available at <<https://doi.org/10.1007/s40319-020-00973-4>>.

² Judgment of 12 September 2019, *Cofemel - Sociedade de Vestuário SA v G-Star Raw CV*, C-683/17, EU:C:2019:721.

³ *Response Clothing Limited v The Edinburgh Woollen Mill Limited* [2020] EWHC 148 (IPEC).

⁴ Berne Convention for the Protection of Literary and Artistic Works.

⁵ Judgment of 13 November 1990, *Marleasing SA v La Comercial Internacional de Alimentacion SA*, C-106/89, EU:C:1990:395.



that he did, that what you've got to do is to adopt a broad and flexible interpretation of that term in the Act. If you do that, then you can arrive at a position where there's relatively little room for argument that you need to say that the Act is completely incompatible with the Directive, because if you interpret broadly all the categories that are available under the Act, you then struggle to find anything that would not be protected under the Act, but would be protected if you had an open-ended system. So, it's possible to say that, even if it is correct to say that you need to interpret the categories broadly, it doesn't follow that the Act is incompatible with the Directive.

Furthermore, you are still left with the question of how broadly you really need to interpret any particular category and what really does need to be protected on the facts of any individual case. Don't forget that the Court of Justice has, by no means, indicated that everything under the sun must be protected regardless of any requirement. On the contrary, the message one gets from the jurisprudence of the Court of Justice is that there are criteria that need to be satisfied, and that satisfying those criteria is by no means to be taken as a given in any particular case. So, in addition to what was said in *Cofemel* itself, we also have decisions like, for example, *Funke Medien*⁶, where the Court has made it pretty clear that the requirement of an intellectual creation is a very real and meaningful requirement, and therefore it's not going to be the case that every potential work is necessarily protected by copyright.

SIPLR: With Brexit, do you think that political influences, for example, legislative intervention after the end of the Brexit transition period would play a role in influencing this decision any further beyond the judiciary and their decisions?

Arnold LJ: Well, it is obviously the case that if there is legislative intervention in the UK, then the position may change. But - as is well known - I've been calling for a new Copyright Act for five years⁷, and so far, there has been deafening silence from the government. Moreover, for reasons with which we are all familiar, and I don't just mean COVID-19, the likelihood of any legislation in the field of copyright from the UK government emanating

any time soon is low, post-Brexit. There are going to be higher legislative priorities. That is inevitable.

So, while it's theoretically possible that there will be new legislation in the field of copyright, and I for one would welcome new legislation, as I have made clear, it seems to me that in the short to medium term, it simply isn't going to happen. As for judicial evolution, I think that question is probably best answered in the context of your next question.

POLICY AND THE FUTURE OF IP

SIPLR: It is well known that you have referred many cases to the CJEU, and Brexit will be putting an end to the possibility to do so. How do you think IP law in the UK and the EU will be impacted in this regard post-Brexit?

Arnold LJ: The first and most obvious effect is that we won't be able to refer questions to the Court of Justice anymore - that jurisdiction will cease on the 31st of December (2020). Secondly, obviously, we will no longer be subject to the supremacy of EU law. As we were just discussing in theory, that will make it possible for legislation to depart from the *acquis*. And moreover, we won't be subject to future EU Directives. Indeed, assuming that the current timetable is adhered to, we won't be required to implement the recent Directive on Copyright in the Digital Single Market Directive (DSM Directive)⁸.

So, there is the possibility of legislative divergence, firstly, in terms of not implementing future EU Directives and secondly the possibility of UK legislation that will alter past EU Directives which have been implemented in the UK. The other element in the equation is the one that we were touching on before, which is the question of judicial interpretation. As to that, it very much remains to be seen how matters are going to play out in the future. There is obviously the potentiality for judicial interpretation to diverge, but I suspect that's going to be a rather long-term process. In the EU Withdrawal Act 2018⁹ that was passed by the UK Parliament, it was provided that all Court of Justice jurisprudence that was in place as at the date of departure from the EU [31st January 2020] or, in effect, the end of the transitional period, that's to say 31st December 2020, would be binding on all UK courts below the Supreme Court, and the Supreme Court would only be able to depart from such decisions to the extent that it could depart from its own previous decisions. Now, the government has recently announced that they are going to amend that legislation so as to provide that the Court of Appeal will be able to depart from Court of Justice precedents, which will make things a little bit easier¹⁰.

But even so, even if you say to the UK courts at Court of Appeal level and above that they can depart from Court of Justice precedents, the question is: why should they do so if there's no change in the underlying legislation? You've got to be convinced that the Court of Justice has got it wrong.

Moreover, you've got to be convinced in circumstances where the system of references represents an ongoing dialogue between national courts and the Court of Justice. So, take the example of communication to the public -

we've got, in round terms, about 20 decisions so far, maybe a little more, and what we have is a process of evolution and refinement of the Court of Justice's case law. So, in circumstances where the underlying legislation in the UK hasn't changed because there has been no legislative intervention by the UK Parliament and because there's no relevant change in the EU *acquis*, why should a court in the UK suddenly decide that it is going to strike out on its own in terms of interpreting legislation? Even if you think that maybe some of the past decisions are not quite right, maybe in a future decision of the Court of Justice they will refine it in a way that makes it more acceptable. So, the question of judicial interpretation is going to present the UK courts with a real headache as to what the right approach is going to be. While there is plainly potential for divergence in the medium to long term, I don't think it's going to be a quick process.

WEBSITE BLOCKING

SIPLR: Website blocking is obviously not available throughout the world, and whilst the UK has led the way for such developments, some countries have only just accepted basic website blocking as a means of tackling online IP infringement (Canada in November 2019¹¹), with others not accepting it as a possibility as of yet. Do you think that website blocking orders as a tool is still more effective than other remedies?

Arnold LJ: First of all, I think we need to define our terms, so in answering this question I am going to take website blocking as including not just blocking of static websites, but also blocking of streaming servers, because, as a matter of practical reality, static websites are history. Nobody is interested in static websites anymore; the name of the game is streaming. But, if we take website blocking to include streaming server blocking, then I think the answer I would give to the question is that I have an open mind on the subject, but as of yet, I have not seen anything that looks to be more effective. If people do come up with more effective solutions, then that is fine.

Obviously, there is the potential going forward for two other more radical solutions, the first of which is licensing - some form of collective licensing solution - but I do not anticipate that happening anytime soon. The other is increased use of filtering by platforms, and we see moves in that direction as a result of the DSM Directive. But, if we leave those two possibilities out of account and purely look at it from the right holder perspective, it seems to me that really website blocking is probably the most effective solution that is available, and I certainly have not seen any good evidence to suggest there is anything more effective.

SIPLR: In the *FAPL*¹² cases, dynamic website blocking was possible apparently because of a technology implemented by the FAPL to trace the origin of the infringing server. Do you think that this technology or type of website blocking can also apply to other platforms (e.g. Facebook, Instagram), in which communication to the public of copyright-protected works can occur? As a follow-up to this question, do you think that dynamic website blocking would be a possibility also in the trade mark field, for instance, to prevent websites from selling counterfeit goods (especially in light of the *Cartier*¹³ case?)

Arnold LJ: The *FAPL* cases that I had did depend upon the availability of the technology, and the technology which had evolved by that point in time was really quite remarkable, even viewed from the perspective of late 2020 because, by that point in time, it had become possible for the streaming servers to be identified and moreover for them to be blocked in real time. So, if you had a streaming server that was streaming illegal streams of a Premier League football match, you could turn on the block when the football match started and turn off the block when the football match stopped. That was really a quite remarkable piece of technology, and that was what made that whole area of the case law so interesting. What it meant was that you could have blocking which was highly targeted and therefore highly proportionate, and that is why I made the orders that I did. I think the interesting thing is

⁶ Judgment of 29 July 2019, *Funke Medien NRW GmbH v Bundesrepublik Deutschland*, C-469/17, EU:C:2019:623.

⁷ Lord Justice Arnold published an article in 2015 which explores this further: Arnold, R. 'The need for a new Copyright Act: a case study in law reform' as part of the Herchel Smith Intellectual Property Lecture 2014. Available at <<https://doi.org/10.4337/qmjip.2015.02.01>>.

⁸ Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC.

⁹ European Union (Withdrawal) Act 2018, available at <<https://www.legislation.gov.uk/ukpga/2018/16/contents/enacted>>.

¹⁰ Amendment available here: <<https://www.legislation.gov.uk/ukdsi/2020/9780348213683/contents>>.

¹¹ See decision of the Federal Court in Ontario, Canada, in *Bell Media Inc. and others v GoldTV.biz and others* [2019] FC 1432.

¹² *FAPL v BT* [2017] EWHC 480 (Ch).

¹³ *Cartier International AG and others v British Sky Broadcasting Limited and others* [2016] EWCA Civ 658.

that so far, the only cases in which rights holders have applied for those sorts of orders have been cases involving live sporting events - so we have had football and we have had boxing in this country.

It might have been expected that there would be more rights holders who were interested in obtaining streaming server blocking orders in cases involving other sorts of content, particularly given, as I have observed previously, that content is consumed nowadays by most consumers through streaming. It doesn't involve downloads from static websites. That is very old-fashioned technology nowadays, so one would have thought there would have been interest from rights holders in other areas of copy-right content in going down that road. But, so far, there doesn't seem to have been that much interest in it in this country, and I'm not quite sure whether there has been more interest in other countries.

So far as the other aspect of your question is concerned, which is extending outside copyright towards trade marks, of course there you are much more in the realm of static websites than streaming servers and therefore you are less dependent upon the technology. The problem with it is one which was manifest in the *Cartier* case, the whack-a-mole problem (blocking one source and then another popping up). But the evidence suggests that it is just about worthwhile from the right holder's point of view, certainly in the context of the live sporting events, it is apparent that rights holders like FAPL do think it is worthwhile.

But when it comes to sources of counterfeits and grey market goods, then I think it is quite telling that no rights holders have followed *Cartier's* example. If you ask yourself, well, why have no trade mark proprietors followed *Cartier's* example, I think the answer is obvious: you need to block potentially hundreds, if not thousands, of websites if you are going to be effective, and that is a very tall order from the perspective of gathering all the necessary evidence and then getting court orders and then getting them implemented, particularly given the decision of the Supreme Court that the rights holders have got to pay all the costs of implementation¹⁴. And, of course, the more sites you are blocking, the higher the implementation costs. So, I suspect, based on the lack of activity on the part of trade mark proprietors since *Cartier*, that we are not going to be seeing much more in that field, and instead they will be looking for alternative ways forward. But who knows! I may be proven wrong.

CONCLUDING REMARKS

SIPLR: What would you say is the most valuable thing that you have learnt in your career in IP? What advice would you feel like giving to junior professionals wanting to practise IP?

Arnold LJ: That is a very difficult question because I have been in the field of intellectual property now for quite a long time - I'm not going to say exactly how long, but it is more than three decades - so I have learnt quite a lot in that time. I think I would offer three pieces of advice: the first is one that may sound unexpected but is actually quite important, and it is this: to be a good IP lawyer, you have to be good at other areas of law. And I'll explain what I mean by that.

Intellectual property law does not exist in a vacuum - on the contrary, it interfaces with a lot of other areas of law. So, to give some obvious examples, most intellectual property is dealt with by way of contracts; therefore, you need to be a good contract lawyer. An awful lot of the intellectual property disputes that I have dealt with over my career, both as a barrister and as a judge, have really been contract disputes. They involve intellectual property, but the real dispute has been about contracts. Secondly, infringement of intellectual property is a form of tort, so you need to be a good tort lawyer. Thirdly, in our system, in order to really deal with intellectual property properly, you have to be a good equity lawyer, and the reason for that is that a lot of the judge-made law that fills the gaps between the legislative provisions comes out of equity - some of it comes out of the common law, so for example, accessory liability, that is a common law doctrine coming out of ordinary tort law, but a lot of the law comes from equity. So, take an obvious example, the remedy of an injunction - that is an equitable remedy, and so equitable principles are applicable when deciding whether or not to grant an injunction and that has always been the case. Likewise, the remedy of an account of profits, that is an equitable remedy. So, to be a good IP lawyer, you have to have a sound grasp of equity. And so it goes on.

Just to reinforce the point and to give me a bridge to my second piece of advice, I remember when the Human Rights Act 1998¹⁵ was coming into force in the year 2000, some intelligent and perspicacious person organised a seminar with the title 'Intellectual property and human rights', and I remember very well my reaction to that at the time - this is over 20 years ago, don't forget - was to say: what on earth are they on about? They are two different subjects, this is oil and water, they don't mix, they have nothing to do with each other. Well, how wrong could you be! What I now know, having learnt better in the intervening 20 years, is that to be a good IP lawyer you have to be a good human rights lawyer, as what we now appreciate is that there is a massive interface between intellectual property law and human rights law. And in fact, it goes further than that, which is that increasingly we see the phenomenon of constitutionalisation of intellectual property. So, you have not only got to be a human rights lawyer, you have to be a constitutional lawyer as well. So, as I have been saying, to be a good IP lawyer you have got to be abreast of other

¹⁴ *Cartier International AG and others v British Sky Broadcasting Telecommunications Plc and another* [2018] UKSC 28.

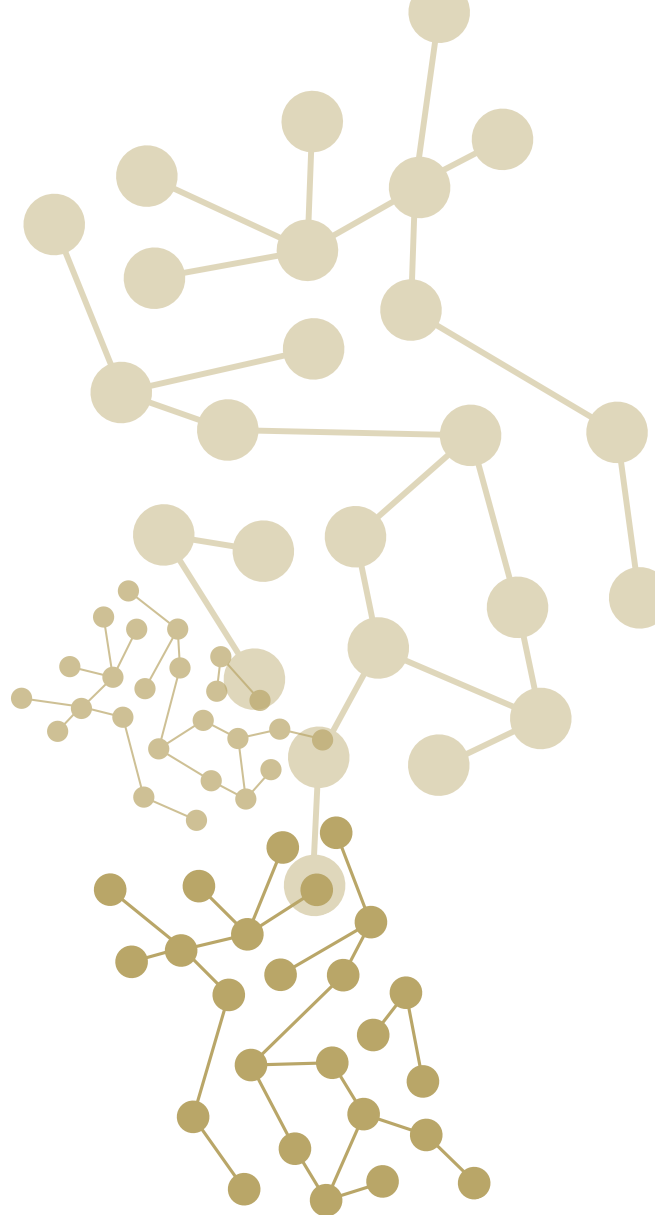
¹⁵ Human Rights Act 1998, available at <<https://www.legislation.gov.uk/ukpga/1998/42/contents>>.

areas of law, and you can't be stuck in the silo of intellectual property law.

That takes me to my second piece of advice, which I think I have already hinted at, which is to keep an open mind. You can form a view on something but subsequently learn that you are completely wrong, and as I say, my reaction to the idea that intellectual property law and human rights law had something to do with each other is a good example of that. I thought they had nothing to do with it, and I am happy to admit I was completely and utterly wrong. So, keep an open mind, and be prepared to revise your opinions because you may well find as time moves along that things emerge which falsify your original opinion. The third piece of advice is one which I think flows from a lot of what we have talked about this afternoon, which is: don't be parochial, don't be insular. What I mean by that is that we can all learn from each other.

When I started learning the law in England a long time ago, you could still see vestiges of an attitude which amongst former generations of English lawyers was very common indeed, which was to say that English law is best, we have nothing to learn from anybody else. And that is an attitude which you can still find manifested in some other jurisdictions and some other courts. A well-known example is the US Supreme Court, where they take it as axiomatic that they have nothing to learn from the jurisprudence of other courts, a view which of course was very force-fully articulated on numerous occasions by the late Justice Scalia. But I am happy to say in England, over the course of my professional career, we have learnt better. We know now that we do not have a monopoly of wisdom - on the contrary, we know full well now that we can learn from others, just as we hope that others can learn from us, and by a collaborative approach to legal problems, hopefully we can all learn and do better in the future. So, as I say, my advice is don't be parochial, don't be insular, don't think that your own system is always right - on the contrary, look and see what other systems of law have to say. We all face common problems, and by looking and seeing how other people have solved the problems, we can all learn to do better.

SIPLR: Thank you for taking the time to speak with us, Lord Justice Arnold!



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