Kluwer Copyright Blog

Italy: the take-down notice must contain the specific YouTube URLs

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"A take-down notice which generically refers to the titles of the infringing videos, without specifically indicating their URLs, is not sufficient to determine the "actual knowledge" of the hosting provider."

On May 5, 2014, the Distric Court of Turin has given a preliminary ruling on the proper content of the take-down notices in copyright infringement disputes. Although the decision is not completely surprising (see, in this regard, this ruling of the Distric Court of Rome, 11 July 2011), it sets the standard for copyright holders on how to draft a take-down notice to be notified to a ISP.

Background

The action has been brought by Delta TV, an Italian company which produces and distributes TV programs. Amongst others, it holds the rights of economic exploitation of eighteen south American *telenovelas* for Italy. Delta TV finds out that a number of episodes of these *telenovelas* are available on the popular video sharing website YouTube and sends a take-down notice requiring the ISP to expeditiously remove all infringing videos from its server.

However, it does not analytically identifies the files by referring to their individual URLs, but generically refers to the titles of the videos "infringing its intellectual property rights" stored on YouTube servers. Lacking an immediate action to remove the videos, Delta TV sues YouTube and Google for copyright infringement, seeking for a preliminary injunction ordering the ISP to remove all infringing materials and to refrain from making them available to the public in the future. Only after being notified of the claimant's action and having had access to the complete list of the URLs provided to the judge, YouTube removed all infringing videos.

Ruling

The District Court of Turin recalls in the first place that, according to the domestic legislation

which has implemented Articles 14 and 15 of the E-commerce Directive (i.e. Articles 16 and 17 of the Legislative Decree No. 70/2003), the hosting provider:

(*i*) is not liable for the information stored at the request of a user of the service, on condition that it does not have *actual knowledge* of illegal activity or information and, upon obtaining such knowledge, acts expeditiously to remove or to disable access to the information following a proper order by the competent authorities; and

(*ii*) has no general obligation to monitor the information transmitted or stored, nor a general obligation actively to seek facts or circumstances indicating illegal activity.

In the light of these principles, the court states that YouTube could only be held liable if YouTube, after being specifically informed, did not remove the unlawful content indicated by the copyright holder. However, also considering that, at the particular stage of the proceeding, there was no sufficient evidence to determine if YouTube played the role of an "active" (i.e. not neutral) hosting provider, which – according to the well-established Italian case law (and yet unconvincing: see, in this regard, the opinion of Advocate General Jääskinen in the *L'Oréal* case, C?324/09, paragrahps 138 – 142) – would have prevented the applicability of the Community and domestic rules providing a safe harbor for the ISP, the court holds that a take-down notice which only generically refers to the titles of the infringing videos, without specifically indicating their URLs, is not sufficient to determine the "actual knowledge" of the hosting provider with respect to the unlawful material stored on its server and, therefore, is not sufficient to hold the ISP responsible for not having removed such materials expeditiously.

As for the possibility of future infringements, the court, reaffirming that YouTube has no general obligation to monitor the videos published by its users, states that the copyright holder has the choice between monitoring *ex post* all videos uploaded on YouTube or join *ex ante* its ContentID program.

As explained above, this outcome is not completely new. The Distric Court of Rome in 2011 had already made clear that for a take-down notice to be acceptable it has to specifically indicate all the URLs of the infringing materials.

However, one could question that this requirement is compliant with the recent initiative of the Italian Communication Autorithy (AGCOM) which, in the context of the recently adopted Regulation on online copyright enforcement, has made available an online form through which the copyright holder can inform the Authority that content has been unlawfully made available online and request its removal: in fact, the online form has a field generically labelled "address of the web site *or* [emphasis author] of the web page where the work has been unlawfully made available", which seems to suggest that a generic indication of the home page of the web site hosting the unlawful material is sufficient for the Authority to take action.

Despite this, there is no doubt that courts still have the power to interpret, as they deem appropriate, the legislative provision which links the liability of the hosting provider with its "actual knowledge" of illegal information or activity and, in particular, to establish which information is needed for "actual knowledge".

In this perspective, regardless of the option given by the AGCOM, it is expedient for copyright holders to consider the specific indication of the URLs of the infringing materials as a best practice to follow in drafting their take-down notice in the future.

GS

A full summary of this case will be added to the Kluwer IP Cases Database (http://www.kluweripcases.com/).

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