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Delivering (Up) a Copyright-Based Remedy for Revenge Porn

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This article

Despite recent progress that has been made in the legal response to the problem of what is colloquially termed ‘revenge porn’, victims continue to face difficulties when seeking the removal of their private sexual images from third-party websites.

While victims who are able to assert authorship and hence copyright ownership of these images can rely on the notice and takedown provisions found in the copyright laws of many jurisdictions to compel their removal, victims who are unable to make such a claim are left without a similar remedy. However, current proposals for victims to be recognized as the joint authors of such images, or to be granted a new exclusive right to prevent their distribution, would disrupt fundamental copyright principles in a manner disproportionate to their underlying aims.

This article puts forward an alternative solution, drawing inspiration from the recent settlement in *Chambers v DCR*: where a claimant has succeeded in obtaining injunctive relief

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against a defendant on the basis of the non-consensual distribution of the claimant's private sexual images, the court may make a further order directing the defendant to assign any copyright they may have in the images to the claimant. This would function in a manner akin to the well-established remedy of delivery up.

1. Introduction: the problem of revenge porn¹

The non-consensual distribution of private sexual images,² known colloquially as ‘revenge porn’, causes serious and immediate harms to its victims.³ Victims of revenge porn experience sustained levels of mental and emotional trauma, resulting in adverse effects on their mental health.⁴ They are also exposed to a much higher risk of harassment both online and – in cases where their contact details or other identifying information have been

¹ The term ‘revenge porn’ is used throughout this article due to its familiarity and its resonance with the public, and should be understood as denoting all instances of the non-consensual distribution of an individual’s private sexual images, regardless of the identity of the person engaging in such distribution or the motives underlying such distribution. However, it is acknowledged that this formulation is potentially misleading, as it appears to confine the scope of the objectionable behaviour specifically to the non-consensual distribution of an individual’s private sexual images by a former romantic or sexual partner in order to punish them for the breakdown of the relationship: see Justice Committee, Stage 1 Report on the Abusive Behaviour and Sexual Harm (Scotland) Bill (Scottish Parliamentary Corporate Body, 2016), [41], [65] – [71]; Legal and Constitutional Affairs References Committee, Phenomenon Colloquially Referred to as ‘*Revenge Porn*’ (Commonwealth of Australia, 2016), [2.3] – [2.9], [5.4] – [5.5]. Because of this, the term ‘image-based sexual abuse’ has been preferred by some commentators as being more accurate: see C McGlynn and E Rackley, ‘Image-Based Sexual Abuse’ (2017) 37 *Oxford Journal of Legal Studies* 534, 535 – 537.

² On the characterisation of such images as ‘private and sexual’ rather than ‘intimate’ or ‘sexually explicit’, see McGlynn and Rackley (n 1) 540 – 543.

³ A number of commentators have located this phenomenon on the spectrum of sexual violence: see N Henry and A Powell, ‘Sexual Violence in the Digital Age: The Scope and Limits of Criminal Law’ (2016) 25 *Social & Legal Studies* 397; C McGlynn, E Rackley and R Houghton, ‘Beyond “Revenge Porn”: The Continuum of Image-Based Sexual Abuse’ (2017) 25 *Feminist Legal Studies* 25.

⁴ HL Deb 21 July 2014, vol 755, col 969; HC Deb 1 December 2014, vol 589, col 122; D Citron and M Franks, ‘Criminalizing Revenge Porn’ (2014) 49 *Wake Forest Law Review* 345, 347, 351; McGlynn and Rackley (n 1) 545.

published alongside their images – in the physical world.⁵ In many cases, the association of their online profile with private sexual images is also likely to lead to the loss of professional and educational opportunities: it is not uncommon for victims of revenge porn to face dismissal from their current employment, or to encounter difficulties in securing future employment.⁶

These harms are exacerbated by the ease with which information can be transmitted through the internet.⁷ As theorists such as Scott Lash and Manuel Castells have pointed out, information has become increasingly ‘liquid’ within the current technological environment: it is now capable of being communicated almost instantaneously across vast distances, without regard to national borders, and to a large and indeterminate audience.⁸ Once an image has been uploaded for the first time, it is readily accessible through a simple internet search, and can be easily viewed, forwarded and reposted by thousands or even millions of internet users. Because of this, a key priority for most victims of revenge porn is the removal of their images from the websites or social media channels to which they have been uploaded, in order to prevent further distribution.⁹ However, the difficulty of regulating online information flows

⁵ Citron and Franks (n 4) 350 – 351; McGlynn and Rackley (n 1) 545.

⁶ HL Deb 21 July 2014, vol 755, col 971; HC Deb 1 December 2014, vol 589, col 122; Citron and Franks (n 4) 352 – 353; McGlynn and Rackley (n 1) 545.

⁷ HL Deb 21 July 2014, vol 755, col 969; HL Deb 21 July 2014, vol 755, col 972; Citron and Franks (n 4) 350; McGlynn and Rackley (n 1) 534 – 535; N Suzor, B Seignior and J Singleton, ‘Non-Consensual Porn and the Responsibilities of Online Intermediaries’ (2017) 40 Melbourne University Law Review 1057, 1058.

⁸ S Lash, *Critique of Information* (Sage Publications, 2002); M Castells, *The Rise of the Network Society* (Wiley-Blackwell, 2010). See also Joined Cases C-509/09 and C-161/10 *eDate Advertising GmbH v X* EU:C:2011:685, [43] (CJEU citing Castells in discussing the globalization of information dissemination).

⁹ Citron and Franks (n 4) 358 – 359; A Levendowski, ‘Using Copyright to Combat Revenge Porn’ (2014) 3 NYU Journal of Intellectual Property & Entertainment Law 422, 425; M Chon, ‘Copyright’s Other Functions’ (2016) 15 Chicago-Kent Journal of Intellectual Property 364, 371.

also means that the law faces significant challenges in providing victims of revenge porn with an effective remedy.

1.1 Criminal law

In the past, critiques of the law's shortcomings in addressing the problem of revenge porn had focused primarily on the lack of a criminal offence targeted specifically at such behaviour, leaving prosecutors to rely on an unsatisfactory patchwork of laws relating to malicious or offensive communications, harassment and stalking, computer misuse, and blackmail.¹⁰ Since then, Parliament has introduced into the law of England and Wales a new statutory offence of 'disclosing private sexual photographs and films with intent to cause distress', in the form of section 33 of the Criminal Justice and Courts Act 2015 ('CJCA').¹¹ While this is generally viewed as a step in the right direction, commentators have also criticized the provision as being unduly narrow in a number of key respects.¹² Among other things, the offence requires the images to have been disclosed 'with the intention of causing ... distress' to the individual appearing in them.¹³ In practice, however, the distribution of such images might well be motivated by factors other than intent to cause distress to the victim, such as financial reward,

¹⁰ See respectively Communications Act 2003, s 127; Malicious Communications Act 1988, s 1; Protection from Harassment Act 1997, ss 2, 2A, 4 and 4A; Computer Misuse Act 1990, s 1. See also Protection of Children Act 1978, s 1.

¹¹ This is also the case in Scotland: see the Abusive Behaviour and Sexual Harm (Scotland) Act 2016. Similar offences have been introduced in Canada, Israel, Japan, New Zealand, the Philippines, and a number of states in Australia and the US.

¹² See e.g. A Gillespie, "'Trust Me, It's Only for Me": "Revenge Porn" and the Criminal Law' [2015] 11 Criminal Law Review 866, 866 – 870.

¹³ See also CJCA, s 33(8). For critique, see Gillespie (n 12) 872 – 873.

notoriety, or even just ‘for a laugh’.¹⁴ This is especially the case with the thousands of internet users who spread the image further by forwarding or reposting it once it has been uploaded for the first time, but who have no direct connection with the victim.

Crucially, while the CJCA sets out a range of criminal penalties for persons who have been convicted of this new offence,¹⁵ it does not provide victims with a remedy against the operators of the websites through which the offending images have been distributed.¹⁶ Schedule 8 to the CJCA provides for certain immunities from criminal liability where providers of information services are concerned, including the providers of hosting services. The relevant provision states that a hosting provider is not liable for any offence under section 33 for the storage of any information provided by its users, subject to the following conditions: (i) it had no actual knowledge, at the time it was stored, that the information was unlawful within the meaning of section 33; and (ii) upon obtaining such knowledge, it acts expeditiously to remove the information or to disable access to it.¹⁷ This mirrors the ‘safe harbour’ protections set out in the corresponding provisions of the E-Commerce Directive,¹⁸ which have been implemented in the UK through the Electronic Commerce (EC Directive) Regulations 2002.¹⁹ It is therefore only in very rare cases that a website operator will be

¹⁴ Gillespie (n 12) 871; J Ledward and J Agate, “‘Revenge Porn’ and s 33: The Story So Far’ (2017) 28 Entertainment Law Review 40, 41; McGlynn and Rackley (n 1) 553 – 554. See also Crown Prosecution Service, Guidelines on Prosecuting the Offence of Disclosing Private Sexual Photographs and Films (2015). For critique of a similar requirement under the law of California, see Citron and Franks (n 4) 373 – 374.

¹⁵ CJCA, s 33(9).

¹⁶ See Suzor, Seignior and Singleton (n 7) 1066 (describing these websites as the ‘focal points of the internet’ which present ‘the most efficient means of policing content available’).

¹⁷ CJCA, Schedule 8, para 5.

¹⁸ 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, art 14.

¹⁹ SI 2002/2013.

found guilty of an offence under section 33, particularly as the requisite intent of causing distress to the victim would still have to be made out. This is borne out by the guidelines issued by the Crown Prosecution Service in relation to this new offence. The relevant passage notes that '[t]he offence does not itself force website operators to take action in relation to the uploaded material', and envisions that, in a typical case, the removal of the offending images 'would be the responsibility of the website or social media provider'.²⁰

1.2 Misuse of private information

Victims of revenge porn might stand a better chance of obtaining their desired remedy by making a claim under civil law. English law now recognizes a new tort of misuse of private information,²¹ which has its origins in the action for breach of confidence as well as article 8 of the European Convention on Human Rights ('ECHR'),²² the latter of which provides for the fundamental right to respect for an individual's private and family life.²³ This allows claimants to prevent the disclosure of information in respect of which they have a reasonable expectation of privacy, unless this is outweighed by the defendant's right to freedom of

²⁰ There is some indication that the more reputable websites may voluntarily implement measures to facilitate the removal of revenge porn: *Ledward and Agate* (n 14) 42; *Suzor, Seignior and Singleton* (n 7) 1091 – 1092.

²¹ See *Campbell v Mirror Group Newspapers Ltd* [2004] UKHL 22; *Vidal-Hall v Google Inc* [2015] EWCA Civ 311. It has also been recognized as such in Northern Ireland: see *CG v Facebook Ireland Ltd* [2017] 2 CMLR 29.

²² Convention for the Protection of Human Rights and Fundamental Freedoms 1953.

²³ ECHR, art 8. The English courts began to give effect to this right in the context of private information following the entry into force of the Human Rights Act 1998, which imposes on them an obligation not to act in a way that is incompatible with a right guaranteed by the ECHR.

expression.²⁴ The elements of the action are likely to be satisfied in a typical case of revenge porn,²⁵ and a successful claimant would be able to seek both injunctive relief and damages against the perpetrator.

Perhaps most importantly, the tort of misuse of private information could potentially give victims access to an effective remedy against the operators of websites to which their private sexual images have been uploaded. As noted previously, the E-Commerce Directive confers on the providers of hosting services certain immunities from any liability arising from the storage of unlawful material by their users, provided that the hosting provider had no actual knowledge of such unlawfulness at the point of storage and, upon obtaining such knowledge, acts expeditiously to remove the material or disable access to it. Because of this, where images of a private and sexual nature have been uploaded by the users of a website without the consent of the individuals appearing in those images, the operator of the website will not incur liability for the tort of misuse of private information as long as it has no knowledge of the unlawfulness of the material.²⁶ The most recent case law indicates, however, that once the victim has notified the website operator as to the unlawfulness of the material, the operator will come under an obligation to remove the material or disable to access to it. While the position is not entirely clear, several recent decisions of the Northern Irish courts suggest that a website operator who fails to do so will forfeit the immunity conferred by the

²⁴ See *Campbell v Mirror Group Newspapers Ltd* [2004] UKHL 22; *Von Hannover v Germany (No 1)* (2005) 40 EHRR 1; *McKennitt v Ash* [2006] EWCA Civ 171; *Murray v Express Newspapers plc* [2008] EWCA Civ 446.

²⁵ See *AMP v Persons Unknown* [2011] EWHC 3454 (TCC), [24] – [32]; *Contostavlos v Mendahum* [2012] EWHC 850 (QB), [24] – [25]; *JPH v XYZ* [2015] EWHC 2871 (QB), [8].

²⁶ See J Riordan, *The Liability of Internet Intermediaries* (Oxford University Press, 2016), [12.131] (stating that this calls for knowledge that the material or its use or publication, is actionable rather than merely raising a prima facie case to answer).

E-Commerce Directive, thus exposing itself to liability for misuse of private information.²⁷ In order to take advantage of this procedure, the victim need not have obtained a prior judicial determination as to the unlawfulness of the material, or even have commenced legal proceedings against the perpetrator.

The new tort of misuse of private information, together with the conditions attached to the safe harbour protections mandated by the E-Commerce Directive, thus potentially provides victims of revenge porn with a swift and streamlined procedure for compelling the removal of their private sexual images from the websites to which they have been uploaded. However, this is subject to an important caveat: victims will be able to avail themselves of this procedure only against the operators of websites that are located within the jurisdiction of the English courts. In many cases, these website operators may be located instead in jurisdictions that do not offer equivalent protection against interferences with privacy, or that provide intermediaries with even broader immunities than the E-Commerce Directive's safe harbours. Where this is the case, victims of revenge porn are likely to encounter great difficulty even in fixing website operators with any liability at all.

A case in point is the US, which is home to a large number of technology firms. Section 230 of its Communications Decency Act 1996 states that: 'No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider'.²⁸ This has been given a broad interpretation by the US courts, so as to grant internet intermediaries immunity from liability for any information published or disseminated by their users through their services.²⁹ The only statutory exceptions to the immunity conferred by section 230 relate to the imposition of

²⁷ *J20 v Facebook Ireland Ltd* [2016] NIQB 98; *CG v Facebook Ireland Ltd* [2017] 2 CMLR 29.

²⁸ Title V of the US Telecommunications Act 1996.

²⁹ See *Zeran v American Online, Inc* 129 F 3d 327 (4th Circuit, 1997).

federal criminal liability, the enforcement of intellectual property rights, and most recently, the enforcement of sex trafficking laws at both federal and state level.³⁰ While a number of US state legislatures have taken steps to criminalize revenge porn, it is not at present an offence under federal law. Although US law recognizes a number of privacy torts,³¹ the broad protections conferred upon internet intermediaries by section 230 preclude any claims from being successfully asserted against them on that basis.

2. Copyright: an unlikely weapon

Against this backdrop, copyright has emerged as an unexpectedly effective weapon for victims of revenge porn. Unlike the still-evolving law of privacy, copyright law has long been subject to international and regional harmonization, and the extent of harmonization has only increased with the passage of time.³² Many jurisdictions around the world have followed the lead of the US in implementing a ‘notice and takedown’ procedure to address the problem of

³⁰ US Communications Decency Act 1996, s 230(e). The last exception was enacted pursuant to the Stop Enabling Sex Traffickers Act 2018 (‘SESTA’) and Allow States and Victims to Fight Online Sex Trafficking Act 2018 (‘FOSTA’), which came into force on 11 April 2018.

³¹ These are invasion of privacy, public disclosure of private fact, false light, and misappropriation: see W Prosser, ‘Privacy’ (1960) 48 California Law Review 383.

³² At the international level, see the Berne Convention for the Protection of Literary and Artistic Works 1886; the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations 1961; the Agreement on Trade-Related Aspects of Intellectual Property Right 1994; the WIPO Copyright Treaty 1996; the WIPO Performances and Phonograms Treaty 1996; the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who are Blind, Visually Impaired or Otherwise Print Disabled 2013.

online copyright infringement.³³ This operates in effectively the same way as the conditions to the safe harbour protection conferred on hosting providers by the E-Commerce Directive; the main distinction is that the notice and takedown procedure is concerned solely with copyright-infringing material, rather than all types of unlawful material. Section 512 of the US Copyright Act 1976, for instance, immunizes hosting providers from any liability they may incur for copyright infringement as the result of material stored on their systems by their users, provided that they had no knowledge of the infringing nature of the material at the point of storage and provided that, upon obtaining such knowledge, they act expeditiously to remove the material or disable access to it.³⁴

The images at the centre of a case of revenge porn typically consist either of photographs or videos, or both. Both photographs and films are protected under the copyright laws of the vast majority of jurisdictions.³⁵ Where an image of this kind has been taken by the victim themselves – as would be the case with a ‘selfie’³⁶ – the victim will be recognized in almost all jurisdictions as the author of the image and, correspondingly, as the owner of the copyright subsisting in it.³⁷ The initial uploading of the image by the perpetrator would

³³ These include Australia, China, India, Japan, Malaysia, Mongolia, Taiwan, Singapore, South Africa, and South Korea.

³⁴ This provision was enacted pursuant to the US Digital Millennium Copyright Act 1998, s 202.

³⁵ See e.g. Copyright, Designs and Patents Act 1988 (‘CDPA’), ss 1, 4 and 5B. There is a question as to whether the kind of photographs and videos under discussion meet the originality threshold that is required for the subsistence of copyright under the laws of most jurisdictions; however, the issue has yet to arise in practice. For critique, see E Rosati, ‘Why Originality in Copyright Is Not and Should Not Be a Meaningless Requirement’ (2018) *Journal of Intellectual Property Law & Practice* <<https://doi.org/10.1093/jiplp/jpy084>> accessed 25 June 2018 (advance online publication)

³⁶ See Levendowski (n 9), 426 (citing a survey which indicates that as many as eighty percent of such images may be ‘selfies’).

³⁷ See e.g. CDPA, s 11(1).

therefore constitute both an infringing reproduction and – depending on the jurisdiction³⁸ – an infringing communication of the image to the public, as would subsequent acts of forwarding and reposting by other internet users.³⁹ The operator of the website to which the image had been uploaded might then – again, depending on the jurisdiction and the circumstances of the case – incur secondary liability for the acts of infringement committed by its users.⁴⁰ It could even be primarily liable for the unauthorized communication of the image to the public,⁴¹ or the public performance or display of the image.⁴² Where the copyright legislation in the website operator’s jurisdiction provides for a notice and takedown procedure, therefore, the victim will be able to compel the removal of the offending images by asserting their ownership of the copyright in them. The effectiveness of the notice and takedown procedure in providing a remedy for victims of revenge porn has not been lost upon commentators;⁴³

³⁸ The copyright laws of some jurisdictions, such as the US, do not at present recognize an exclusive right to communicate the work to the public. The closest equivalent under US law would appear to be the right to perform the work publicly or the right to display the work publicly: US Copyright Act 1976, ss 106(4) and (5).

³⁹ See *EMI Records Ltd v British Sky Broadcasting Ltd* [2013] EWHC 379 (Ch), [45] – [46]; *Paramount Home Entertainment International Ltd v British Sky Broadcasting Ltd* [2013] EWHC 3479, [32] – [37].

⁴⁰ See *A&M Records, Inc v Napster, Inc* 239 F 3d 1004 (9th Circuit, 2001) (vicarious infringement and contributory infringement); *Cooper v Universal Music Australia Pty Ltd* [2006] FCAFC 187 (authorizing copyright infringement) *Twentieth Century Fox Film Corp v Newzbin Ltd* [2010] EWHC 608 (Ch), [95] – [112] (authorizing copyright infringement and joint tortfeasance).

⁴¹ See *Twentieth Century Fox Film Corp v Newzbin Ltd* [2010] EWHC 608 (Ch), [124] – [125]; *EMI Records Ltd v British Sky Broadcasting Ltd* [2013] EWHC 379 (Ch), [45] – [47]; *Paramount Home Entertainment International Ltd v British Sky Broadcasting Ltd* [2013] EWHC 3479, [32] – [37].

⁴² See *Perfect 10, Inc v Amazon.com, Inc* 508 F 3d 1146 (9th Circuit, 2007), 1159 – 1160.

⁴³ J Lipton, ‘Combating Cyber-Victimization’ (2011) 26 *Berkeley Technology Law Journal* 1103, 1143 – 1144; D Bambauer, ‘Exposed’ (2014) 98 *Minnesota Law Review* 2025, 2052 – 2056; Citron and Franks (n 4) 359 – 360; Levendowski (n 9) 439 – 444; Suzor, Seignior and Singleton (n 7) 1081 – 1086.

indeed, it forms the basis for a number of proposals that have been put forward to address the problem of revenge porn.⁴⁴

2.1 The limitations of copyright and attempts at circumvention

As the law currently stands, however, victims of revenge porn will be able to avail themselves of the notice and takedown procedure found in copyright law only if they are able to claim authorship and hence ownership of the copyright in their private sexual images. Where the images in question have been recorded by the perpetrator or by a third party, rather than the victim, there is no obvious ground on which such a claim might be asserted. Copyright law does not typically recognize the subject of a photograph or film as having any claim to authorship, nor does it confer on the subject of such a work the right to control its subsequent distribution.⁴⁵ In such circumstances, therefore, the copyright in the images would vest in the perpetrator or the third party responsible for taking it, and the victim would have no entitlement under copyright law to prevent their further distribution.

Because of this, several commentators have sought to redefine the concept of authorship within copyright law so as to enable victims of revenge porn to be recognized as at least the joint authors of the images in which they appear.⁴⁶ This is on the basis that the

⁴⁴ See A Ronneburger, 'Sex, Privacy, and Webpages: Creating a Legal Remedy for Victims of Porn 2.0' (2009) 21 *Syracuse Science & Technology Law Reporter* 1, 23 – 33; D Otero, 'Confronting Nonconsensual Pornography with Federal Criminalization and a "Notice-and-Takedown" Provision' (2016) 70 *University of Miami Law Review* 585, 609 – 613.

⁴⁵ Some jurisdictions do, however, confer moral rights on the subjects of photographs under certain limited circumstances: see CDPA, s 85.

⁴⁶ D Bambauer, 'Beating Revenge Porn with Copyright' (Info/Law, 25 January 2013)

<<https://blogs.harvard.edu/infolaw/2013/01/25/beating-revenge-porn-with-copyright/>> accessed 21 May 2018; S

interest and value of these images stem almost entirely from their subjects, rather than from any contribution made by the party who recorded them. Another suggestion that has been put forward is the creation under copyright law of a new exclusive right in images of a private and sexual nature.⁴⁷ This right would vest in the subject of such an image, and would entitle the subject to prohibit the distribution, performance or display – including the private distribution, performance and display – of the image in question. A third proposal is that the enforcement of the copyright in such images should be made conditional upon positive proof that they had been recorded with the full consent of their subjects, and with the understanding that they would be widely distributed.⁴⁸

2.2 Shortcomings of attempts at circumvention

While these proposals are well-intentioned, it is submitted that they are also significantly flawed, either because they do not adequately take into account the motivations underlying the distribution of revenge porn, or because they introduce distortions into the existing structure of copyright law that are disproportionate to the aim of providing victims with an effective remedy. The suggestion that victims of revenge porn should be recognized as joint authors of the images in which they appear blurs the distinction that copyright law has

Corbett, 'The Case for Joint Ownership of Copyright in Photographs of Identifiable Persons' (2013) 18 *Media & Arts Law Review* 330.

⁴⁷ Bambauer (n 43) 2056 – 2070, 2071 (describing this as being effectively a 'new right of authorship').

⁴⁸ A Bartow, 'Pornography, Coercion, and Copyright Law 2.0' (2008) 10 *Vanderbilt Journal of Entertainment and Technology Law* 799, 834 – 838; A Bartow, 'Copyright Law and Pornography' (2012) 91 *Oregon Law Review* 1, 44 – 46.

historically drawn between the creator of a work and its subject.⁴⁹ If implemented, it could open the floodgates to a multiplicity of claims – including retrospective claims – by models and performers.⁵⁰ This, in turn, could potentially disrupt already settled transactions that had been concluded on the basis of the creator of a work its sole author and hence the sole owner of the copyright subsisting in it. Going forward, the implementation of this proposal would result in highly fragmented copyright ownership for a significant proportion of works.⁵¹ As a consequence, the transfer and management of rights would become exponentially more complex – not to mention more expensive – particularly where large-scale works involving thousands of performers are concerned.⁵² In short, such a proposal would require a radical change in a fundamental principle of copyright law, solely for the purpose of enabling the subjects of a very small subset of works to prevent the distribution of those works by third parties. While the underlying aim is undoubtedly a laudable one, it does not justify the far-reaching consequences that would flow from such a fundamental reconceptualization of authorship.

The creation of a new exclusive right for victims of revenge porn in their images, meanwhile, would result in even more wide-ranging disruptions to established principles of copyright law.⁵³ For one thing, the proposal calls for the vesting of an exclusive right in a

⁴⁹ See S Frankel, 'The Copyright and Privacy Nexus' (2005) 36 Victoria University of Wellington Law Review 507, 520.

⁵⁰ This would be the logical consequence of the declaratory theory of judicial decision-making, which has been accepted by the House of Lords: see *Kleinwort Benson Ltd v Lincoln City Council* [1999] 2 AC 349, 378 – 379.

⁵¹ See *Garcia v Google, Inc* 786 F 3d 733 (9th Circuit, 2015), 737.

⁵² See *Garcia v Google, Inc* 786 F 3d 733 (9th Circuit, 2015), 742 – 743. See also Suzor, Seignior and Singleton (n 7) 1083 – 1084. cf *Garcia v Google, Inc* 766 F 3d 929 (9th Circuit, 2014).

⁵³ For further critique, see R Tushnet, 'How Many Wrongs Make a Copyright?' (2014) 98 Minnesota Law Review 2346, 2349 – 2361.

party who is neither the author of the work nor the owner of the copyright subsisting in it; for another, it defines this exclusive right in a way that includes private acts of distribution, performance and display, even though copyright law has historically restricted the scope of the copyright owner's exclusive control to such of these acts as are carried out in public.⁵⁴ Again, such a wholesale destabilization of copyright law is disproportionate to the remedial advantages that would be gained by the subjects of what is ultimately a very small proportion of works.

The proposal that the enforcement of copyright in images of a private and sexual nature should be made conditional upon the full and informed consent of their subjects, meanwhile, might well reduce the economic incentives for the commercial exploitation of such images. There is some basis for this argument in English law: in the past, courts had indicated that they would refuse to enforce the copyright in works that were 'grossly immoral'⁵⁵ or that had been created in 'disgraceful circumstances'.⁵⁶ However, this is likely to have a minimal impact on victims and perpetrators of revenge porn. A typical perpetrator is unlikely to be motivated by financial incentives; instead, broad distribution of the images will usually be their goal.⁵⁷ Such a proposal, if implemented, might even have the perverse

⁵⁴ UK and European copyright law do not recognize an exclusive right of public display, and the closest equivalent would appear to be the right to communicate the work to the public: see CDPA, ss 16 and 20; 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 3.

⁵⁵ *Glyn v Weston Feature Film Co* [1916] 1 Ch 261, 269 – 270. For an overview, see A Sims, 'The Denial of Copyright Protection on Public Policy Grounds' (2008) 30 *European Intellectual Property Review* 189.

⁵⁶ *Attorney-General v Guardian Newspapers Ltd (No 2)* [1990] 1 AC 109, 275 – 276. On the uncertainties inherent in exclusions of this kind, see generally L Bently and B Sherman, *Intellectual Property Law* (4th edn, Oxford University Press, 2014), 122 – 123.

⁵⁷ *Bartow* (n 48) 45 – 46. See also *Ronneburger* (n 44) 17 – 19.

effect of increasing the further distribution of these images by third parties, emboldened by the knowledge that no action could be taken against them by the copyright owner.⁵⁸

3.0 The case of Chambers v DCR

Having highlighted the shortcomings of the previous proposals, this article now seeks to put forward a remedy that would enable victims of revenge porn to take advantage of the notice and takedown procedure developed in the copyright context, while causing minimal or even no disruption to the fundamental principles of copyright law. It draws inspiration in part from the terms of the settlement arrived at in the case of *Chambers v DCR*.⁵⁹ Here, the YouTube personality Chrissy Chambers brought an action for breach of confidence, misuse of private information and harassment against the defendant, with whom she had previously been romantically involved. Chambers' contention was that the defendant had, towards the end of their relationship and without her knowledge or consent, recorded several films of himself engaging in sexual activity with her. A few years after their relationship came to an end, he had uploaded the films in question to a pornographic website, again without her knowledge or consent.⁶⁰ One of Chambers' main priorities in bringing the action was to compel the removal of the films from the websites to which they had been uploaded, both initially by the

⁵⁸ *Bartow* (n 48) 48 – 49. See also *Fraserside Holdings v Venus Adult Shops* [2005] FMCA 997, [42].

⁵⁹ See the Statement in Open Court dated 17 January 2018.

⁶⁰ As these acts were carried out prior to the entry into force of the CJCA, no criminal charges could be brought against the defendant on that basis.

defendant and subsequently by third parties. To this end, both she and her legal advisors considered it vital for her to secure ownership of the copyright in those films.⁶¹

Ultimately, Chambers was able to reach a settlement with the defendant. Under the terms of the settlement, the defendant admitted that the uploading of the films constituted a breach of confidence and a misuse of Chambers' private information. He agreed to delete or destroy all images containing her likeness that remained in his possession, and to pay substantial damages as well as legal costs. Crucially, the defendant also agreed to assign his copyright in the films to Chambers.

The outcome in *Chambers v DCR* has been hailed in some quarters as setting a landmark precedent for future victims of revenge porn.⁶² Strictly speaking, of course, it does nothing of the kind: an out-of-court settlement establishes no legal precedent upon which

⁶¹ See J Kleeman, 'The YouTube Star Who Fought Back Against Revenge Porn – And Won' (The Guardian, 18 January 2018) <<https://www.theguardian.com/news/2018/jan/18/chrissy-chambers-youtube-revenge-porn-legal-victory>> accessed 21 May 2018; J Wakefield, 'Chrissy Chambers: Revenge Porn Almost Killed Me' (BBC, 18 January 2018) <<http://www.bbc.co.uk/news/technology-42733034>> accessed 21 May 2018.

⁶² See J Kleeman, 'YouTube Star Wins Damages in Landmark UK "Revenge Porn" Case' (The Guardian, 17 January 2018) <<https://www.theguardian.com/technology/2018/jan/17/youtube-star-chrissy-chambers-wins-damages-in-landmark-uk-revenge-porn-case>> accessed 21 May 2018; R Spillett, 'Lesbian YouTube Star Wins Damages in Landmark UK "Revenge Porn" Case Against Her Ex-Boyfriend for Sharing Videos of Them Having Sex (Then She Proposes to Her New Partner Outside the High Court)' (Mail Online, 17 January 2018) <<http://www.dailymail.co.uk/news/article-5279927/Lesbian-blogger-wins-damages-revenge-porn-case.html>> accessed 21 May 2018; K Corcoran, 'A YouTuber Successfully Sued Her Ex-Boyfriend in a Landmark Revenge Porn Ruling – And Then Proposed to Her Co-Star on the Court Steps' (Business Insider, 18 January 2018) <<http://uk.businessinsider.com/chrissy-chambers-youtuber-wins-legal-case-against-ex-for-revenge-porn-2018-1>> accessed 21 May 2018; J Kleeman, 'The YouTube Star Who Fought Back Against Revenge Porn – And Won' (The Guardian, 18 January 2018) <<https://www.theguardian.com/news/2018/jan/18/chrissy-chambers-youtube-revenge-porn-legal-victory>> accessed 21 May 2018.

future claimants may rely. Nevertheless, the terms of the settlement do point the way towards a remedy that courts might, in future, be able to award to successful claimants in cases of this type.

4.0 The proposal: ‘delivery up’ of the copyright in the images concerned

The proposed remedy is this: where a claimant has succeeded in obtaining injunctive relief against a defendant for misuse of private information, and the claim is founded upon the non-consensual distribution of the claimant’s private sexual images by the defendant, the court may, in a suitable case, make a further order directing the defendant to assign any copyright they may have in the images to the claimant, for the purpose of enabling the claimant to compel the removal of those images from third-party websites.⁶³ This would, in effect, be akin to an order for delivery up ‘in aid of’ the injunction granted against the defendant.

Under English law, an order for delivery up is a well-established remedy for the action in breach of confidence,⁶⁴ and has since been recognized as a remedy that is available for the tort of misuse of private information.⁶⁵ It is also routinely awarded in cases involving

⁶³ Many jurisdictions prescribe certain formalities that must be complied with for an assignment of copyright to be valid: see CDPA, s 90(3).

⁶⁴ On the historical origins of the remedy, see G Forrai, ‘Confidential Information – A General Survey’ [1971] *Sydney Law Review* 382, 391 – 392; J Stuckey, ‘The Equitable Action for Breach of Confidence: Is Information Ever Property?’ (1981) 9 *Sydney Law Review* 402, 427 – 430.

⁶⁵ *Mosley v United Kingdom* (2011) 53 EHRR 30, [41]. The remedy is routinely sought in cases involving the misuse of private information: see *Price v Powell* [2012] EWHC 3527 (QB), [41]; *Khan v Khan* [2014] EWCA Civ 913, [4]; *Bains v Moore* [2017] EWHC 242 (QB), [2] – [7]; *Candy v Holyoake* [2017] EWHC 2943 (QB), [2].

the infringement of intellectual property rights.⁶⁶ In such cases, an order for delivery up is typically granted in conjunction with an injunction to restrain the defendant from engaging either in further unauthorized use of confidential or private information or in further acts of intellectual property infringement, depending on the cause of action. In breach of confidence cases, the remedy usually takes the form of an order directing the defendant to deliver to the claimant for destruction any documents in their possession that contain confidential information belonging to the claimant.⁶⁷ In cases involving the infringement of intellectual property rights, meanwhile, the defendant will generally be required to deliver up for destruction any infringing goods that are in their possession.

The courts have made it clear that the aim of such an order is not to punish the defendant; rather, it is intended to augment the effectiveness of the injunction already granted against the defendant by removing the very means of making further unauthorized use of the information – or of committing further infringements – from the defendant’s possession.⁶⁸

⁶⁶ See *Mergenthaler Linotype Co v Intertype Ltd* (1926) 43 RPC 381.

⁶⁷ On occasion, the defendant may even be required to deliver up products or machinery created through the unauthorized use of such information: see *Ormonoid Roofing and Asphalts Ltd v Bitumenoids Ltd* (1930) 31 SR (NSW) 347; *Peter Pan Manufacturing Corp v Corsets Silhouette Ltd* [1964] 1 WLR 96; *Ansell Rubber Co Pty Ltd v Allied Rubber Industries Pty Ltd* [1972] RPC 811.

⁶⁸ See *Mergenthaler Linotype Co v Intertype Ltd* (1926) 43 RPC 381, 382 (Russell J noting that, as long as infringing goods remain in the possession of the defendant, ‘he may be subject to too serious and grave a temptation and may thereby be tempted to commit a breach of the injunction which he would not otherwise commit’). See also D Vaver, ‘Civil Liability for Taking or Using Trade Secrets in Canada’ (1981) 5 *Canadian Business Law Journal* 253, 300 – 301; F Gurry, *Breach of Confidence* (Clarendon Press, 1984), 411 – 413; M Burrows, *Remedies for Torts and Breach of Contract* (Oxford University Press, 2004), 583 – 586, 632; M Conaglen, ‘Thinking About Proprietary Remedies for Breach of Confidence’ [2008] 1 *Intellectual Property Quarterly* 82, 87 – 88.

The remedy proposed here is thus consistent with the overall aim of the order in its more conventional form, as it seeks to prevent – or at least reduce – further unauthorized dissemination of the claimant’s private information, although it does so by equipping the claimant with the means of halting such dissemination, rather than removing from the defendant the means of doing so. In this way, it seeks to ensure the effectiveness of the injunctive relief granted against the defendant.

4.1 Possible objections to the proposal

Two main objections can be made against the extension of the order for delivery up in the manner proposed here. The first is that the order has traditionally been directed at the delivery up of physical rather than intangible property. The second is that the order in its conventional form is one that directs the delivery up of the offending items to the claimant specifically for destruction. There is clear case law to the effect that a claimant who has received documents or other items from a defendant pursuant to such an order is obliged to destroy them; the claimant is not entitled to retain those items for their own use or benefit, as the property in the items remains in the defendant.⁶⁹ In this context, the nature of the order under discussion must be distinguished from an order that directs a defendant to deliver up to the claimant items that are the physical property of the claimant.⁷⁰ In a case involving breach of

⁶⁹ See *Delfe v Delamotte* (1857) 3 Kay & J 581, 584; *Hole v Bradbury* (1879) 12 Ch D 886, 903 – 904; *Ormonoid Roofing and Asphalts Ltd v Bitumenoids Ltd* (1930) 31 SR (NSW) 347, 361 – 361; *Ansell Rubber Co Pty Ltd v Allied Rubber Industries Pty Ltd* [1972] RPC 811, 828.

⁷⁰ The latter type of order is most frequently awarded in successful actions for the tort of conversion. On the distinction between the two in practice, see *Prince Albert v Strange* (1849) 2 De G & Sm 652, 713 – 718. See also *Vavasasseur v Krupp* (1878) 9 Ch D 351, 360 – 361; *Gurry* (n 68) 411 – 413; *Burrows* (n 68) 585. cf *Industrial Furnaces Ltd v Reaves* [1970] RPC 605, 627 – 628.

confidence, the latter type of order would be appropriate where the defendant had physically purloined a confidential document belonging to the claimant.⁷¹ In these circumstances, the basis of the order would lie in the claimant's property right in the item, rather than the prevention of future breaches by the defendant, though it might have much the same practical effect where confidential or private information is concerned.

4.2 Extension of the remedy in domain name cases

It has to be acknowledged that the form of the remedy proposed here does deviate in certain respects from the order for delivery up as it is conventionally understood. It also needs to be emphasized, however, that such an extension is not entirely without precedent. There is at least one category of case in which the courts have seen fit to order a form of delivery up amounting to the transfer of something very close to – though not precisely – an intangible property right.⁷² This has occurred in disputes surrounding domain names, particularly those involving so-called 'cybersquatting', where an unauthorized third party registers domain names that are identical or similar to well-known trade marks or trade names with the intention of offering them for sale – typically at extortionate rates – to the owners of those trade marks or the goodwill in those trade names. The leading case on this issue remains *British Telecommunications plc v One in a Million Ltd.*⁷³ The defendants here dealt in internet domain names, and had registered a large number of domain names comprising the trade marks or trade names of well-known commercial enterprises. The defendants offered

⁷¹ See *Evitt v Price* (1827) 1 Sim 483; *Alperton Rubber Co v Manning* (1917) 86 LJ Ch 377.

⁷² At present, domain names are not regarded as property under English law, though there is some authority to the contrary under US law. For an overview, see S Burshtein, 'Is a Domain Name Property?' (2005) 1 *Journal of Intellectual Property Law & Practice* 59.

⁷³ [1998] FSR 265; [1999] 1 WLR 903.

these domain names for sale to the relevant companies, and the companies commenced legal proceedings against them for passing off and trade mark infringement.

At first instance, Jonathan Sumption QC (as he then was), sitting as a deputy judge of the High Court, granted summary judgment in favour of the claimants. He held that the defendants were liable in passing off for having created ‘instruments of deception’ through the registration of the domain names,⁷⁴ and were also liable for trade mark infringement in having used in the course of trade domain names that were very similar to the claimants’ well-known marks, to the detriment of those marks.⁷⁵ For the purposes of the present discussion, what is of particular importance is the form of relief Sumption QC saw fit to grant to the claimants. Not only were the claimants awarded a prohibitory injunction to restrain the defendants from using the domain names in question, they were also granted a mandatory injunction directing the defendants to take steps to assign the disputed domain names to them. In his judgment, Sumption QC drew a direct analogy between this latter remedy and the order for delivery up in its conventional form, stating that:

I accept that [such] an order ... goes rather further than the negative form of injunctions normally appropriate quia timet. But it seems to me to be the most completely effective remedy, and one which does no injustice to the defendants, for these names are of no value to them otherwise than as a means

⁷⁴ [1998] FSR 265, 270 – 272. The doctrine of instruments of deception makes it passing off for a trader to put into circulation goods that are inherently likely to deceive the ultimate purchasers, even though the immediate purchasers might be retailers or middlemen who are unlikely to be deceived: see C Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (5th edn, Sweet & Maxwell, 2016), [5-137] – [5-184].

⁷⁵ [1998] FSR 265, 272 – 273. See Trade Marks Act 1994, s 10(3) (making it infringement for an unauthorized third party to use in the course of trade a sign that is identical or similar to a registered trade mark that has a reputation in the UK, where the use of the sign takes unfair advantage of or is detrimental to the distinctive character or the repute of the trade mark).

of threatening unlawful acts. It is the equivalent, in this rather arcane context, of the delivery up of infringing goods.⁷⁶

The decision of Sumption QC was affirmed on appeal.⁷⁷ At the Court of Appeal, Aldous LJ commented favourably on the form of remedy granted at first instance, noting that there was ‘ample evidence to justify the injunctive relief granted ... to prevent [the domain names] being used for a fraudulent purpose and to prevent them being transferred to others’.⁷⁸

Since then, orders directing defendants in a case of this type to assign or transfer the disputed domain names to successful claimants are routinely sought and awarded.⁷⁹ What is also significant is that, while the judicial analysis of the passing off and trade mark claims in *One in a Million* has often been criticized as taking an unduly expansive view of the elements of each action,⁸⁰ virtually none of this criticism has been directed at the form of relief

⁷⁶ [1998] FSR 265, 274.

⁷⁷ See also [1999] 1 WLR 903, 924 (Aldous LJ holding, additionally, that the fact that the defendants would be identified as the registrants of the relevant domain names through a ‘Whois’ search conducted by members of the public constituted a false representation of an association between the defendants and the claimants, which amounted to passing off).

⁷⁸ [1999] 1 WLR 903, 925.

⁷⁹ See in particular *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 19, [4] (expressly seeking ‘an order for delivery up of’ the disputed domain name to the claimant). See also *WH Smith Ltd v Colman* [2001] FSR 9, [3]; *Easyjet Airline Co Ltd v Dainty (t/a EasyRealestate)* [2002] FSR 6, [23] – [27]; *Phones 4u Ltd v Phone4.u.co.uk Internet Ltd* [2005] EWHC 334 (Ch), [72]; *Tesco Stores Ltd v Elogicom* [2006] EWHC 403 (Ch), [27], [42]; *Yell Ltd v Giboin* [2011] EWPC 009, [185]; *Vertical Leisure Ltd v Poleplus Ltd* [2014] EWHC 2077 (IPEC), [12], [25].

⁸⁰ See M Elmslie, ‘The One in a Million Case’ (1998) 9 *Entertainment Law Review* 283; R Meyer-Rochow, ‘The Application of Passing Off as a Remedy Against Domain Name Piracy’ (1998) 20 *European Intellectual Property Review* 405; C Colston, ‘Passing Off: The Right Solution to Domain Name Disputes?’ [2000] *Lloyd’s*

awarded in that case⁸¹ – even though, as Sumption QC himself acknowledged, it did go beyond what might be expected in a more conventional case. Thus, while the extension of the order for delivery up in this way might, at first blush, appear to be at odds with the remedy in its more conventional form, this development has attracted virtually no controversy so far, nor has it been said to produce any unintended negative consequences in practice.

4.3 Justifying the extension of the remedy in cases involving revenge porn

It is submitted that the reasons accepted in cases such as *One in a Million* as justifying an order for the delivery up – in a manner of speaking – of the disputed domain names apply with at least equal force to successful claims of misuse of private information that are founded upon the non-consensual distribution of the claimant’s private sexual images, so as to justify an order for the ‘delivery up’ of the copyright in those images in cases where such copyright vests in the defendant. Like the transfer of disputed domain names to a successful claimant in a cybersquatting case, the assignment of the copyright in the offending images would provide the claimant with ‘the most completely effective remedy’, as it would put the claimant in the best position to prevent the further distribution of those images and, by extension, further invasions of their privacy. It would therefore enhance the effectiveness of the injunctive relief awarded against the defendant: while a typical prohibitory injunction would restrain the defendant themselves from engaging in further unauthorized distribution of the images in question, this in itself would not be adequate to safeguard the claimant’s privacy, given the nature of information flows on the internet. As with the cybersquatting

Maritime and Commercial Law Quarterly 523; H Carty, ‘Passing Off and Instruments of Deception: The Need for Clarity’ (2003) 25 *European Intellectual Property Review* 188; Wadlow (n 74) [5-161] – [5-167].

⁸¹ cf A Sims, ‘Rethinking *One in a Million*’ (2004) 26 *European Intellectual Property Review* 442, 444.

cases, such an order is unlikely to result in injustice to the defendant in a typical case since, like the disputed domain names in *One in a Million*, there is no legitimate means by which the copyright in such images might be exploited commercially.⁸²

Admittedly, this modified version of the order for delivery up is something of a departure from what might be expected in a more typical case of breach of confidence or misuse of private information, in that it is intended to prevent the future dissemination of the claimant's private information not so much by the defendant themselves as by third parties. However, it is submitted that this modification to the conventional form of the order is justified by the nature of revenge porn itself, the harms caused by it, the ease and speed with which information can be transmitted online, and the extraordinary difficulty of obtaining any other effective remedy against third-party website operators, particularly where they are located outside the jurisdiction of the English courts. In this context, regard should also be had to article 13 of the ECHR, which imposes on signatories an obligation to provide for effective remedies under national law for any breach of the fundamental rights guaranteed by it, as well as article 6 of the Human Rights Act 1998, which imposes a statutory duty on the courts to act compatibly with these fundamental rights, including the right of privacy protected under article 8.⁸³ Indeed, even in more conventional cases of breach of confidence, the courts appear increasingly willing to adapt the order for delivery up so as to take account of the realities of information storage and transmission in the digital environment. In *Arthur J Gallagher Services (UK) Ltd v Skriptchenko*,⁸⁴ for instance, the High Court had no difficulty

⁸² cf *Renault UK Ltd v Derivatives Risks Evaluation Management Ltd* (Unreported, 22 October 2001), [21] (counsel for the claimant conceding that the transfer of the disputed domain name to the claimant could not be sought, as the domain name could legitimately be used for a range of purposes).

⁸³ On the interpretation of this requirement, see *Klass v Federal Republic of Germany* (1979 – 80) 2 EHRR 214, [65] – [69]; *Ilhan v Turkey* (2002) 34 EHRR 36, [97]; *Kudla v Poland* (2002) 35 EHRR 11, [157].

⁸⁴ [2016] EWHC 603 (QB).

in making an order which directed the delivery up of the defendant's electronic devices to the claimant for imaging and inspection, followed by the deletion of any confidential information present on those devices and their subsequent return to the defendant.⁸⁵

In addition, in at least some of the domain name cases, the courts have taken into account the possibility that the disputed domain names might be misused should they fall into the hands of third parties in deciding whether or not to order them to be transferred to the claimants. A case in point is *Easyjet Airline Co Ltd v Dainty (t/a EasyRealestate)*,⁸⁶ where the claimant airline and associated companies within the same group succeeded in their action for passing off against the defendant, who had registered a domain name – *easyRealestate.co.uk* – that bore a close resemblance to the claimants' trade marks.⁸⁷ Bernard Livesey QC (sitting as a deputy judge of the High Court) had initially considered it sufficient to confine the remedy to an injunction restraining the defendant from passing off any business as the claimants' through the use of the domain name.⁸⁸ At the conclusion of the hearing, however, he decided to grant an additional order directing the defendant to take the steps necessary for transferring the domain name to the claimants. This was due in part to the real possibility that the defendant might sell the domain name to a third party, who might in turn use it in such a way as to cause damage to the claimants.⁸⁹

A key advantage of the present proposal is that any intervention would take place only at the remedy stage of the legal proceedings. Because of this, it causes no disruption to the

⁸⁵ [2016] EWHC 603 (QB), [37] – [40], [63]. See also *Imerman v Tchenguiz* [2010] EWCA Civ 908, [73]; *Warm Zones v Thurley* [2014] EWHC 988 (QB), [3], [35].

⁸⁶ [2002] FSR 6.

⁸⁷ The defendant had used the domain name to host a website whose design resembled the claimants' distinctive get-up.

⁸⁸ [2002] FSR 6, [23].

⁸⁹ [2002] FSR 6, [23] – [28].

existing framework of copyright law. Unlike the solutions put forward by other commentators, the present proposal does not call for any reconceptualization of established copyright principles, and therefore poses no risk of unsettling concluded transactions or fragmenting copyright ownership in undesirable ways. Furthermore, because the remedy of delivery up is one that falls within the equitable jurisdiction of the court, judges would retain the discretion to determine whether such an order should be granted or refused on the particular facts of each case.⁹⁰ This functions as an additional safeguard against abuse.

4.4 Comparison with the proposed remedy of a constructive trust

A final objection to the new form of remedy proposed here is that it goes further than the domain name cases in terms of its effect. At present, domain names are not recognized as a species of property under English law. Because of this, an order for the transfer of a domain name, like an order for delivery up in its conventional form, does not result in the reallocation of any property rights as between the parties. In contrast, the remedy proposed here would require the defendant to effect an assignment of what is undoubtedly an intangible property right in favour of the claimant.

In response to this, it has to be pointed out that the notion of a claimant acquiring property rights over an asset – whether tangible or intangible – that has been obtained by a defendant through the misuse of the claimant’s confidential information is not unheard of. Such a possibility was contemplated by no less a body than the House of Lords itself, in the well-known case of *Attorney-General v Guardian Newspapers Ltd (No 2)*.⁹¹ This concerned

⁹⁰ See *Mergenthaler Linotype Co v Intertype Ltd* (1926) 43 RPC 381, 382. See *Saltman Engineering Co Ltd v Campbell Engineering Co Ltd* [1948] 56 RPC 203, 219.

⁹¹ [1990] 1 AC 109.

the book *Spycatcher*, which had been written by Peter Wright, a former officer of the British Security Service. The book purported to be an account of his twenty years of service, and contained allegations of irregularities and unlawful activities that had been carried out by members of the Security Service during that time. The Attorney-General, on behalf of the Crown, brought an action in breach of confidence and sought an injunction to restrain the defendant newspapers from publishing extracts from the book.⁹² What is significant for the purposes of the present discussion is that, although the Crown had not sought to rely on any claim founded on copyright,⁹³ judges at every stage of the proceedings nevertheless felt compelled to make some comment as to the possible outcome had it chosen to do so.⁹⁴ At first instance, Scott J observed that, had such a claim been advanced, the argument that the Crown should be treated as the owner of the copyright in the book ‘would seem to have some merit’, as the book was the product of Wright’s breach of his duty of confidence to the Crown.⁹⁵ A similar view was expressed by Dillon LJ in the Court of Appeal, who remarked that ‘there could have been strong arguments’ for saying that the copyright in the book belonged in equity to the Crown and was held on a constructive trust for it.⁹⁶ This view was also shared by several members of the House of Lords. Lord Keith noted that, had the Crown sought to advance the claim that it was in equity the owner of the copyright in the book, such

⁹² The House of Lords held that the Attorney-General was not entitled to an injunction to restrain the *Observer* and *Guardian* newspapers from further publication of information derived from the book, nor to an injunction to restrain the *Sunday Times* from continued serialization of the book. However, the Attorney-General was held to be entitled to an account of the profits accruing to the *Sunday Times* as a result of the serialization.

⁹³ [1990] 1 AC 109, 194.

⁹⁴ For a summary, see SK Ng, ‘The *Spycatcher* Saga: Its Implications and Effect on the Law of Confidence’ (1990) 32 *Malaya Law Review* 1, 82 – 86.

⁹⁵ [1990] 1 AC 109, 140 – 141.

⁹⁶ [1990] 1 AC 109, 211.

an argument ‘might well succeed’,⁹⁷ while Lord Griffiths expressed agreement with the view of Scott J and Dillon LJ that ‘the copyright in *Spycatcher* is probably vested in the Crown’.⁹⁸ Lord Goff, meanwhile, remarked that ‘there is some ground’ for the argument that the copyright in the book was held by Wright on constructive trust for the Crown.⁹⁹

As the Crown in that case chose not to pursue a claim in copyright, these remarks are of course merely obiter dicta. There is as yet no English case in which a defendant has been held to be a constructive trustee of property acquired by them through the misuse of the claimant’s confidential or private information.¹⁰⁰ Nevertheless, the fact that this view found favour with so many members of the bench at each level of the proceedings remains significant. In this context, it should be noted courts elsewhere in the common law world have been known to make use of the constructive trust as a remedy for successful claims in breach of confidence. An example is the Canadian case of *Lac Minerals Ltd v International Corona Resources Ltd*,¹⁰¹ where the defendant had obtained a valuable piece of land through the misuse of the claimant’s confidential information. The Supreme Court of Canada decided,

⁹⁷ [1990] 1 AC 109, 262 – 263.

⁹⁸ [1990] 1 AC 109, 276.

⁹⁹ [1990] 1 AC 109, 288.

¹⁰⁰ Though there are cases that have come close to doing so: see *British Syphon Co Ltd v Homewood* [1956] 1 WLR 1190; *Missing Link Software v Magee* [1989] 1 FSR 361; *Attorney-General for Hong Kong v Reid* [1994] 1 AC 324; *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289; *Service Corporation International plc v Channel Four Television Corporation* [1999] EMLR 83; *United Pan-Europe Communications NV v Deutsche Bank AG* [2000] EWCA Civ 166; *Markem Corp v Zipher Ltd* [2005] RPC 31. See also *Attorney-General v Blake* [1997] Ch 84, 96. cf *Satnam Investments Ltd v Dunlop Heywood & Co Ltd* [1999] FSR 722, 743 – 744; *University of Southampton’s Applications* [2006] RPC 21, [42]; *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2008] RPC 1, [62].

¹⁰¹ [1989] 2 SCR 574.

by a majority, that the land was held by the defendant on a constructive trust for the claimant.¹⁰²

The appropriateness of a constructive trust as a remedy for breach of confidence has been questioned by commentators, many of whom regard the idea with a high degree of scepticism.¹⁰³ The most prominent criticisms relate to the lack of established principles under English law for determining when such a constructive trust might be imposed, as well as its potential for disrupting concluded transactions and settled property rights. Still, the cases outlined above show that the idea of a claimant gaining property rights in an asset obtained through the unauthorized use of their confidential information is not as unprecedented as it might appear.

The new form of remedy proposed in this article does not go anywhere as far as the imposition of a constructive trust. In particular, it does not entail the creation of an equitable proprietary right in favour of the claimant at the instance of the court, nor does it involve the judicial redistribution of the defendant's property rights, potentially with retrospective effect. Instead, it merely subjects the defendant in a successful claim for misuse of private information founded upon the non-consensual distribution of private sexual images to a

¹⁰² See also *Pre-Cam Exploration & Development Ltd v McTavish* [1966] SCR 551. For decisions to a similar effect in other jurisdictions, see *Shellmar Products Co v Allen-Qualley Co* 36 F 2d 623; *Ohio Oil Co v Sharp* 135 F 2d 303; *Saco-Lowell Shops v Reynolds* 141 F 2d 587; *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* [2001] HCA 63, [102].

¹⁰³ See HW Tang, 'Confidence and the Constructive Trust' (2003) 23 *Legal Studies* 135, 139 – 152; D Sheehan, 'Information, Tracing Remedies and the Remedial Constructive Trust' (2005) 13 *Restitution Law Review* 82, 89 – 90; G Wei, 'Breach of Confidence, Downstream Losses, Gains and Remedies' [2005] *Singapore Journal of Legal Studies* 20, 44 – 48; Conaglen (n 68) 100 – 109.

personal obligation to assign any copyright they may have in those images to the claimant.¹⁰⁴ The nature of the proposed remedy also obviates the need for the courts to grapple with unresolved questions concerning the place of the ‘remedial’ – as opposed to the ‘institutional’ – constructive trust within English law,¹⁰⁵ as well as the nature of confidential or private information itself and the extent to which it constitutes a ‘proprietary base’ justifying the imposition of a constructive trust.¹⁰⁶ Given that the radical remedy of a constructive trust was well within the contemplation of the courts in cases such as *Attorney-General v Guardian*, it is submitted that the much more moderate remedy proposed here merits at least the same degree of consideration.

4.5 Drawbacks of the proposal

The new form of remedy put forward in this article is, of course, not without its drawbacks. First of all, it is something of a makeshift solution, as it relies on a procedure developed to tackle the problem of online copyright infringement to safeguard an entirely unrelated set of interests. Because of this, it runs the risk of mischaracterizing the harm at issue as the simple

¹⁰⁴ See P Birks, ‘The Remedies for Abuse of Confidential Information’ [1990] *Lloyd’s Maritime and Commercial Law Quarterly* 460, 463; J Davies, ‘Duties of Confidence and Loyalty’ [1990] *Lloyd’s Maritime and Commercial Law Quarterly* 4, 5 – 6.

¹⁰⁵ For an overview, see B Collins, ‘The Remedial Constructive Trust ‘Between a Trust and a Catch-Phrase’ (2014) 20 *Trust & Trustees* 1055.

¹⁰⁶ On the disputed nature of confidential information as property, see T Aplin, ‘Confidential Information as Property?’ (2013) 24 *King’s Law Journal* 172; L Bently, ‘Trade Secrets: “Intellectual Property” but Not “Property”?’ in H Howe (ed), *Concepts of Property in Intellectual Property* (Cambridge University Press, 2013). On questions surrounding the need for a proprietary base, see C Rotherham, ‘Restitution and Property Rites: Reason and Ritual in the Law of Proprietary Remedies’ (2000) 1 *Theoretical Inquiries in Law* 205, 227 – 229.

breach of a property right.¹⁰⁷ Furthermore, it cannot be denied that the proposed remedy is dependent on the capacity of copyright to function as a tool for the suppression of information. While the present proposal seeks to harness that capacity for ends that are entirely benign, it should not be forgotten that this has also been deployed for purposes that are far from praiseworthy. Assertions of copyright infringement have been made in order to prevent the disclosure of information relating to a controversial religious movement,¹⁰⁸ to restrain potentially negative commentary on well-known public figures,¹⁰⁹ and even to suppress third-party criticism.¹¹⁰ It should also be remembered that the notice and takedown procedure itself is open to abuse. Researchers in the US have found examples of notifications being issued to prevent lawful uses of copyright-protected material, notifications being issued by parties who are not the copyright owners of the material in question, and notifications being used to remove material that is not protected by copyright in the first place.¹¹¹ From a

¹⁰⁷ Citron and Franks (n 4) 360; McGlynn and Rackley (n 1) 558 – 559; Suzor, Seignior and Singleton (n 7) 1084 – 1058. On the mismatch between copyright law and the protection of other interests more generally, see J Fromer, ‘Should the Law Care Why Intellectual Property Rights Have Been Asserted?’ (2015) 53 *Houston Law Review* 549, 587 – 592. cf Chon (n 9) 372 – 377 (arguing that privacy harms fall well within the historical and therefore current functions of copyright law).

¹⁰⁸ *Hubbard v Vosper* [1972] 2 QB 84.

¹⁰⁹ *Rosemont Enterprises, Inc v Random House, Inc* 261 F Supp 691 (SDNY, 1966); *Meeropol v Nizer* 560 F 2d 1061 (2nd Circuit, 1977); *Salinger v Random House, Inc* 811 F 2d 90 (2nd Circuit, 1987).

¹¹⁰ *Katz v Chevaldina* 127 F Supp 3d 1285 (SD Fla, 2015). See also *Lion Laboratories Ltd v Evans* [1985] QB 526; *Online Policy Group v Diebold, Inc* 337 F Supp 2d 1195 (ND Cal, 2004).

¹¹¹ See J Urban and L Quilter, ‘Efficient Process or Chilling Effects – Takedown Notices under Section 512 of the Digital Millennium Copyright Act’ (2006) 22 *Santa Clara Computer & High Technology Law Journal* 621; W Seltzer, ‘Free Speech Unmoored in Copyright’s Safe Harbor: Chilling Effects of the DMCA on the First Amendment’ (2010) 24 *Harvard Journal of Law & Technology* 171. See also Suzor, Seignior and Singleton (n 7) 1081.

broader perspective, there is also something disquieting about the fact that intellectual property rights are accorded much stronger protections compared to privacy rights in almost all jurisdictions, such that recourse to property-based reasoning remains the most effective way of safeguarding an individual's privacy rights.¹¹²

At a more practical level, the nature of proposed remedy means that it can only be obtained at the conclusion of a successful action in the tort of misuse of private information. Victims of revenge porn who do not have the resources to initiate and maintain a civil suit might therefore struggle to avail themselves of it.¹¹³ In addition, the nature of the notice and takedown procedure means that claimants must issue a fresh notification to the relevant website operator each time a new instance of the offending image is uploaded or reposted;¹¹⁴ most copyright legislation does not impose on hosting providers a further obligation to ensure that material that has been removed pursuant to such a notification does not resurface, or to engage in the pre-emptive monitoring and filtering of material uploaded by their users.¹¹⁵ Still, until such time as higher international standards of protection for privacy rights are implemented and suitable remedies are put in place for enforcing them, the proposal outlined here will at least provide victims of revenge porn with an urgently-needed remedy against the

¹¹² See J Cohen, 'Examined Lives: Informational Privacy and the Subject as Object' (2000) 52 *Stanford Law Review* 1373, 1390 (commenting that '[a] world with ongoing usage restrictions for intellectual property, but not for personally-identified data, is a world in which the liberty claims of individuals count for less than those of publishers and data processors').

¹¹³ cf *Bambauer* (n 43) 2052 – 2053 (noting that an action in civil law would not be subject to the same prosecutorial constraints on resources); *McGlynn v Rackley* (n 1) 557 (suggesting that an action in civil law puts the victim of revenge porn 'back in control').

¹¹⁴ See *Levendowski* (n 9) 443 – 444 (drawing an analogy with the arcade game of 'whack-a-mole').

¹¹⁵ Indeed, there are jurisdictions where such an obligation cannot be imposed: see E-Commerce Directive, art 15; *Case C-70/10 Scarlet Extended SA v Société belge des auteurs, compositeurs et éditeurs SCRL (SABAM)* [2011] ECR I-11959, [37] – [40]; *CG v Facebook Ireland Ltd* [2017] 2 CMLR 29, [52] – [73].

operators of websites through which their private sexual images are distributed, notwithstanding its shortcomings.

5.0 Conclusion

Despite the progress that has been made by the law in terms of criminalizing revenge porn and providing redress for its harms, victims of revenge porn still face significant challenges in obtaining the remedy they most urgently require, namely the removal of their images from the websites through which they have been distributed. In these circumstances, copyright has emerged as a somewhat unlikely weapon for victims of revenge porn. Where the copyright in the offending images is vested in the victim, they will be able to compel the removal of those images through the use of the notice and takedown procedure found in the copyright laws of many jurisdictions. Where the copyright in the images is vested in the perpetrator or a third party, however, the victim is unable to have recourse to the notice and takedown procedure. Because of this, some commentators have suggested that the subjects of such images should be recognized as their joint authors, or that they should be given a new exclusive right to prevent the distribution and display of the images in question. While these proposals are well-intentioned, they would have the effect of disrupting fundamental principles of copyright law in ways that are disproportionate to the aim of providing victims of revenge porn with an effective remedy.

The present article puts forward an alternative solution, drawing inspiration from the terms of the settlement in the case of *Chambers v DCR*. It argues that, where a claimant has succeeded in obtaining injunctive relief against a defendant in the tort of misuse of private information, and where the claim is based on the defendant's non-consensual distribution of

the claimant's private sexual images, the court may in a suitable case make a further order directing the defendant to assign any copyright they may have in the images to the claimant, for the purpose of enabling the claimant to compel the removal of those images from third-party websites. This would be akin to the well-established remedy of delivery up 'in aid of' an injunction. This new form of remedy is not without precedent. In cases involving cybersquatting, the English courts have had little difficulty adapting the order for delivery up so as to compel the transfer of disputed domain names from one party to another, while in more recent cases of breach of confidence, they have seen fit to modify the conventional form of the order so as to give due recognition to the realities of information storage and retrieval in the digital environment. The English courts have even gone so far as to contemplate the imposition of a constructive trust on assets acquired in breach of confidence – a radical form of remedy that goes well beyond the solution presented here. The proposed remedy requires no reconceptualization of fundamental copyright principles, and therefore poses no risk of unsettling concluded transactions or disrupting the careful balance struck by copyright. Despite its shortcomings, therefore, it fills a vital gap in the array of remedies available to victims of revenge porn, pending the development of a more comprehensive set of measures.