

## THE HIGH COURT

[2014 No. 207 P]

BETWEEN

PLAYBOY ENTERPRISES INTERNATIONAL INCORPORATED

PLAINTIFF

AND

ENTERTAINMENT MEDIA NETWORKS LIMITED

DEFENDANTS

**JUDGMENT of Ms. Justice Baker delivered on the 19th day of February, 2015**

1. This is a motion by the defendant for an order pursuant to O.19 r.7 of the Rules of the Superior Courts compelling the plaintiff to furnish replies to particulars. The motion also seeks an order pursuant to O.31 r.15 compelling the production by the plaintiff of certain documentation.

2. The proceedings concern the alleged provision by the defendant on its website of a link to photographs of a model, Kate Moss, in various stages of undress which the plaintiff claims were prepared for publication in a promotional 60th anniversary edition of "Playboy" magazine. The plaintiff claims to have the exclusive licence to all rights relating to the photographs and asserts that the use by the defendant of the photographs and the putting of a link to the photographs on its website was an unauthorised and unlawful act.

3. The plenary summons sought injunctive relief and damages as well as an account of profits pursuant to s. 127 of the Copyright and Related Rights Act, 2000 (the Act of 2000), damages pursuant to s.18 of the Trade Marks Act, 1996, damages for passing off, for breach of confidence, for tortious and intentional interference with the economic and business relationships between the plaintiff and its business partners, and damages for defamation and for tarnishment of the plaintiff's brand.

4. The statement of claim runs to 26 numbered paragraphs. A notice for particulars was raised on the 2nd April, 2014 and a reply was furnished by the plaintiff on the 12th May, 2014. Correspondence then took place between the solicitors for each party and has given rise to this motion. The motion was issued one day short of a month after a motion of the plaintiff against the defendant seeking judgment in default of defence. This motion for particulars and for the production of documentation was agreed to be heard first, although the plaintiff asserts that the service of this motion was to a large extent tactical. The defendant asserted in the course of argument before me that it was unable to serve the defence owing to what it asserts is a lack of particularisation and precision in the claim it is required to meet.

**The claim in copyright**

5. The statement of claim itemises in paragraphs 12 to 24 under the heading "Particulars" various restricted acts in copyright alleged to have been carried out by the defendant, including use and reproduction of copyright material, and having a link on its site to a website or portal through which web users could access the copyright material. Paragraphs 8, 9, 10, 12, 13 and 14 of the statement of claim uses language akin to, or in some cases identical with, that in the Copyright and Related Rights Act, 2000 and detail the various acts restricted to copyright which were alleged to constitute breach.

6. The defendant raised particulars and replies and further replies were furnished in response to a general request by the defendant that the "copyright rights" in and to the works of which the plaintiff is alleged to be the exclusive licensee be identified. Without wanting to repeat the entire of those replies in this judgment, I note the plaintiff's replies essentially identify the cover photograph of Ms Moss which appeared on the anniversary issue of the magazine, and 29 additional photographs of Ms Moss contained within the body of the magazine, as being the copyright works in respect of which the claim is brought and goes on to say that the rights referred to which are alleged to have been breached are the "standard suite" of rights which attach to all copyright works. The plaintiff explains the relief sought as being "reliefs pursuant to copyright law", as well as "the appropriate reliefs" under the European Communities (Enforcement of Intellectual Property Rights) Regulations, 2006 from Council Directive 2004/48/EC.

7. The plaintiff says that it has adequately identified the rights in respect of which a breach is claimed, and the legal basis on which the claim is brought.

8. Following the extensive replies to particulars furnished by the plaintiff's solicitors on the 12th May, 2014 the solicitors for the defendant identified what they assert to be an inadequacy in the replies and it is worthwhile to repeat here their complaint:-

*"The statement of claim asserts breach of copyright but does not plead which restricted act afforded by copyright is alleged to have been breached and by which particular act of our client; there are numerous and differing restricted acts encompassed in copyright and depending on which one is asserted, there are implications for the defence, for proofs and potentially, in a case involving on-line activity such as this one, expert evidence at trial".*

9. This is the nub of the complaint by the defendant, namely that the particulars furnished are not adequate and that the response to this letter of the 24th July, 2014 is equally inadequate. That response in particular asserts that "the language used in paragraph 10 of the Statement of Claim directly uses the language of Section 37 [of the Copyright and Related Rights Act, 2000 (as amended)]" and that by using the language of the legislation the plaintiff has adequately identified the nature of the legal right asserted.

10. The defendant says it is entitled to specificity as to which acts are alleged to infringe the restricted acts that are mentioned. The defendant says that without clarity as to this matter it cannot plead the precise exceptions to copyright infringement which would give it a defence under the legislation.

**The Law**

11. Hogan J. in *Armstrong v. Moffatt & Ors* [2013] IEHC 148 described the "*misplaced enthusiasm*" which he identified in the litigation practice of serving long and detailed notices for particulars on plaintiffs in personal injuries actions. He, rather generously perhaps, described such exploration of a plaintiff's pleadings as a "*glorious new art form*". His judgment was a call for a return to first principles in the light, *inter alia*, of the purpose or object of a notice for particulars as long identified in the case law to which he referred. I will not repeat that case law here, save to say that the purpose of pleadings and, *ipso facto*, the purpose of raising a notice for particulars on pleadings, is to identify in broad outline the case which the opposite party will have to meet at trial. Imprecise or general pleadings are of no benefit to the party receiving these pleadings, and will not sufficiently inform his or her preparation of replying pleadings, request for discovery or the preparation of evidence and case law for trial.

12. Hogan J. was of course dealing with a claim for personal injuries and in the context of the significant changes made to pleadings in personal injuries cases which have been effected by the enactment of the Civil Liability and Courts Act, 2004. He noted, *obiter*, that a particular had been raised with regard to the bare plea in the personal injury summons alleging a breach of statutory duty, and that there might be "*less straightforward personal injury claims*" which might call for a different treatment, and for more extensive and detailed particulars.

13. I adopt the judgment of Hogan J. as a statement of first principles with regard to the true purpose of pleadings and of the extent to which the court should direct the furnishing of further and better particulars of a claim. His *obiter* comment with regard to the treatment that might apply to less straightforward claims of breach of statutory duty points me to an area of difficulty relevant to the instant case, as he correctly said the test that a court must apply in deciding whether to order further and better particulars *inter alia* includes an inquiry as to whether the particular "*arises from*" the pleadings and whether in general the furnishing of further and better particulars is necessary to ensure fairness between the parties.

14. Counsel for the plaintiff has relied strongly on the judgment of Hogan J. but it offers little assistance to me save as identified above, primarily because the claim of the plaintiff to a large extent is one founded in a statutory tort, to which in my view different, and perhaps very different, considerations apply with regard to the detail that must be contained in pleadings and the way by which the nature of the claim is properly identified. Further, certain other factors must be taken into account, and litigation surrounding alleged breach of contract or infringement of confidentiality is litigation which is complex both in law and in fact, in the legal issues and in the factual nexus that can give rise to either a claim under such statutory headings or a defence to such claims. It is in the interests of the parties, as well as appropriate in the interest of justice generally, and the efficient use of court time and resources, that the issues in complex litigation be identified, and if necessary be reduced prior to trial, or indeed prior to the making by the parties of discovery, especially when one considers in the modern age of computers, discovery can be so voluminous as to require an army of lawyers and advisors to analyse.

15. The plaintiff argued in the course of the hearing before me that the particulars sought by the defendant will have the effect of "straight jacketing" or constraining the case that the plaintiff makes, and that the plaintiff is entitled to and has pleaded the case in the alternative. Such form of pleadings is and has been the norm probably for as long as the courts have operated on the basis of claims being fully pleaded. More fulsome and lengthy pleadings have however become more common, and again this is probably as a result of the ease by which certain forms of pleadings may be reproduced with the benefit of word processing packages. I accept that a plaintiff is in general entitled to plead in the alternative, but not that pleas may be so general as to leave the other side with little or no specificity in understanding the claim. A claim made in a statutory context, or arising from alleged breach of statutorily created rights, cannot be pleaded so generally or in the alternative to the extent that the pleadings obscure or confuse the claim and fail to point sufficiently to the source of the rights.

### **The statutory claims**

16. Section 37 of the Act of 2000 identifies certain restricted acts. Infringement of copyright is defined expressly by s.37 (2) of the Act as the undertaking, or authorising of another to undertake, any of the acts restricted to the owner of the exclusive rights. The plaintiff argues that paragraph 10 of the statement of claim adequately identifies the nature of the breach as the unlawful reproduction, public display, distribution and transmission of the photographs of Ms Moss. It is said that the language "directly uses the language in section 37".

17. The breach of copyright is asserted to arise under the Act of 2000 and under EU law, and not otherwise. If so, the defendant has specific defences available to it also under the statutory and EU schemes. Section 40 of the Act defines what is meant by "making available to the public of a work" and identifies in seven lettered subparagraphs various ways that this might be done including broadcasting, renting, lending copies of the works, broadcast copies of the works etc. The statement of claim pleads other language namely that "the defendant reproduced, publicly displayed, distributed and transmitted" the works. While the language is broadly speaking similar to, and in some cases the same as, the language of the Act of 2000 it does not in my view sufficiently mirror that of the Act, and as the claim is made under the legislative and EU schemes, and certain different defences will be available in the light of these schemes it seems to me incumbent upon the plaintiff to identify the sections and subsections of the Act either by number or by using the language in the Act for that purpose. The defendant is entitled to know within which part of the Act the claim is made and in particular whether any or all of the forms of making available a work as defined in s. 40 are alleged to have occurred.

18. A plea of a statutory tort or breach of a statutory duty is one which can, and does in the case of breach of copyright, afford a defendant a defence of a particular type and range, and within the statutory scheme. The purpose of particulars is to identify the basis of the claim, and if the claim is made under statute it should not be required that a defendant engage in a hermeneutical analysis of the pleadings to ascertain whether the plea relates to one or other or all of the sections of a particular Act, or whether the claim is made other than under the statute. If a claim is made under statute then it should be clear that it is so made. Without such clarity a defendant might well find itself pleading in the alternative, for example by pleading that if the plea is a plea of breach of a particular statutory right by an identified statutory means then the defendant denies the breach or asserts that his actions do not amount to a breach, or that the actions were justified in certain circumstances, and then pleading in the alternative that if the claim is not under the statute that different matters of defence arise. This is unnecessary from the point of view of pleading generally, unhelpful both to the parties and to the court in understanding the issues in a case, and will result in unnecessarily verbose and cumbersome pleadings. More importantly it seems to me that this form of pleading, where a plea is made in the alternative in the most general way, is not a desirable form of pleading in the context of an identified or identifiable statutory legal right and a claim for breach of such rights.

19. It cannot be the case that every claim of specific statutory tort or other class of legal wrong is required as a matter of law to be pleaded with such specificity that only the language of the legislation is used. Pleadings are a matter of style, and no one style of pleadings is mandated even in a claim of a breach of the statutory right. However, if the legislation is specific in the class of acts which are wrongful then a defendant ought to know without difficulty where in the legislative scheme the rights asserted and the breaches alleged are stated to arise. The language of the plea ought to identify with a sufficient degree of particularity and singularity either by way of a reference to a particular section and subsection of an Act, or by the use of the exact language of an

Act, together with other words as chosen by the draughtsperson to further explain or elaborate on a plea.

20. For example, no reference is found in the legislation to the "transmission" of works, the word used in the statement of claim, and the defendant is entitled to know whether it is alleged that this is a form of making available, an alleged form of copying or some other alleged breach of the rights of the plaintiff.

21. Equally the plea that the defendant "reproduced" the works, while it might be a plea that the defendant made available to the public copies of the works, is not an express plea of the statute. Equally a plea that the defendant "exploited" the photographic works is one that does not fall easily within the language of the Act.

22. Accordingly, I direct the plaintiff to reply to questions 4, 5, 6 and 8.

#### **The claim in breach of trademark**

23. The plaintiff also claims that the defendant breached trademarks of the plaintiff. The defendant sought particulars of the registered trademarks of the plaintiff and full particulars of the precise acts restricted to the owner or exclusive licensee of copyright under the Trade Marks Act, 1996 and/or Council Regulation 207/2009. The plaintiff in replies gave a long list of trademarks identified as being "the most relevant trademarks" identified to date, and these comprise different categories of marks including word, device and design marks. The trademarks are identified as being those detailed in the Trade Marks Act, 1996 and there was also in replies claimed that the rights of the plaintiff were protected by the Paris Convention for the Protection of Industrial Property Article 6bis as a well-known trademark.

24. The defendant avers that it is unclear whether it is alleged that the claim is one for passing off or one for trade liable or malicious falsehood. More significantly for the purpose of this application the defendant alleges that it is entitled to particulars of which registration and which marks are asserted and by reference to which acts of the defendant there is alleged to have been a breach. The defendant in essence asks the plaintiff to link the individual identified registered trademark or marks with the manner in which it is alleged to have been used by the defendant, and the manner in which it is alleged that that use was detrimental to the reputation of the trademark. In my view there is an adequate identification by the plaintiff of the trademarks alleged to have been infringed, and the particular acts of the defendant have in my view been sufficiently particularised in paragraphs 16 and 17 of the statement of claim and adequately dealt with in the letter of the 24th July, 2014. The plaintiff in particular has made it clear that the claim is not merely one in passing off and that the claim for breach of trademark is a separate claim. That is sufficient in my view to enable the defendant to plead to this claim and in particular also I note the express reference to s. 14 (3) of the Trade Marks Act, 1996.

#### **Claim in breach of contract**

25. There is no narrative in the statement of claim which identifies a contract or particulars of a breach of a contract between the plaintiff and the defendant but there is a general prayer for damages for breach of contract and breach of confidence "as regards the use and exploitation of the works". The defendant has sought particulars of the contract alleged to have been breached and the plea in paragraph 16 merely pleads that the defendant has been in breach of contract.

26. The plaintiff identifies a contract between Playboy Enterprises and Mert Alas and Marcus Piggott made on the 26th February, 2013 as the contract which it is alleged was breached. Further particulars were raised of this and the defendant's solicitor suggests that it was "difficult to see" how there could be a breach of a contract between the plaintiff and the photographers. The response to this question, if it be a question, was that the defendant wrongfully interfered with economic relations and induced a breach of contract, which is quite a different plea from the one of breach of contract as such. The answer given to this question by the letter of the 24th July, 2014 at paragraph (vi) is in my view adequate to deal with the breach of contract in that it has identified the claim as one of inducing a breach of a contract between the plaintiff and the third party. In his letter of the 21st October, 2014 the solicitor for the defendant makes the point that the plea is a particularisation of a contract to which the defendant was not a party and that in my view is more than sufficient to enable the defendant to plead to the claim of breach of contract as ultimately clarified and narrowed by the plaintiff. The defendant's solicitor has already expressed his own view of the legal merits of this claim, and does not need any further particulars to plead accordingly.

#### **The assertion of breach of moral rights**

27. The notice for particulars sought details of the alleged breach of moral rights, pleaded in paragraph 12 of the statement of claim as being the "moral rights of the photographers who created the exclusive works". Correspondence seeking further particulars of the claim to breach of moral rights resulted in an assertion by the solicitor for the defendant in the letter of the 26th June, 2014 that "no such breach is any way justiciable at the suit of your client". The reply by the solicitors for the plaintiff on the 24th July, 2014 identifies the plea as being a failure by the defendant to "acknowledge the true authorship and ownership of these copyright works" and was "prejudicial to the reputation of the authors of this work". The plea is explained as a breach of the paternity and integrity rights of the authors of the photographs, and the distortion and use of their works in a manner of which they did not sanction or approve. The final letter in this thread of the 21st October, 2014 from the solicitor for the defendant merely says that the claim in moral rights is "made by a plaintiff with no possible right to make".

28. As with the claim of breach of contract the defendant's solicitor has himself identified the nature of the defence and the nature of the legal argument which the defendant will make with regard to this plea. No further particulars are required to enable the defendant to plead accordingly.

#### **The claim in breach of confidence**

29. It is alleged by the defendants that the claim in breach of confidence is pleaded with "no indication of the confidential information intended to be referred to or the act which is alleged to constitute the asserted breach". The defendants complain that the claim lacks specificity and that it cannot understand from the pleadings what quality of confidence can inhere in photographs which were on the internet, or the circumstances that import an obligation of confidence on the defendant. This part of the claim is adequately particularised in my view and questions and observations of the solicitor for the defendant have already identified a class of defence. I also conclude that there is sufficient information in the pleadings in general to enable the defendant to understand the class or quality of confidence in the photographs and any obligation that might arise with respect to that has been made clear.

#### **Interference with economic relations**

30. There is a general plea that the defendant has interfered with the economic relations of the plaintiff with no further specificity, and the defendant has raised a query with regard to what economic relations are referred to, the state of knowledge alleged to be attributable to the defendant in respect of such, and the specific act which it is asserted amounted to a breach. The plaintiff replies by identifying its trademarks including the figurative and design marks including the "Playboy Bunny" logo captured in the photographic works and the "Bunny" costume, a registered trademark, which appears in the photographic works. No further correspondence occurred with regard to this plea save that it is fair to say that the balance of the statement of claim and the further particulars

furnished by the plaintiff do identify the class of claim and the nature of the works in respect of which the claim is made. I do not believe the defendant needs any further particulars to plead to this claim.

31. Further there is a general sentence at paragraph 7 of the reply by the solicitor for the plaintiff of the 31st October, 2014 that the defendant interfered with the economic and licensing/contractual relations between the plaintiff as exclusive licensee and the licensors of copyrighted works which were alleged were created exclusively for the plaintiff's publication. That letter also further particularises the identified actions of the defendant in diverting what is described as "valuable internet traffic" from the plaintiff's websites to those allegedly accessible through links put on its website by the defendant. This is sufficient in my view to enable the defendant to plead.

### **The production of documents**

32. The defendant also seeks production of documents under O.31 r.15 of the Rules. What are sought are a copy of the photographic works in respect of which the plaintiff claims copyright, and a copy of the "exclusive licence" which the plaintiff alleges it has in the works. The works are identified as the cover photograph, and 29 additional photographs of Ms Moss contained within the 60th anniversary edition of "Playboy" magazine and it is argued that the plaintiff's exclusive licence is a matter either for discovery or evidence, or both. The defendant does not accept this.

33. The plaintiff argues that the jurisprudence of these courts suggests a reluctance on the part of the court to make an order for the production of documents in response to a request for particulars, and that such a request belongs more properly in the realm of discovery. However, there is no case law directly on point, save where what is sought is the production of documents referred to in an affidavit of discovery. The old English case of *Quilter v. Heatly* [1883] 23 ChD 42 is of assistance however, and there Lindley L.J. observes that the provisions of a broadly equivalent rule were intended to give the party the same advantage as if the document in question had been fully set out in pleadings.

34. Most commonly one expects a request to produce documents to be contained in a notice for particulars when the document or documents form the basis of the claim, such as in a claim on foot of a contract for the sale of land. In such a case it would make little sense to await discovery before a party pleading to a claim on foot of such a contract would have sight of the document, the full particulars are most likely to be relevant to how the matter is pleaded in defence.

35. Equally there will be many cases where discovery is not mandated at all, and indeed it could fairly be said that discovery has become a somewhat cumbersome tool in modern commercial litigation and has resulted in the production of voluminous folders of papers many of which offer no assistance in the running of the case.

36. This case is between the most obvious one where the document is at the centre of a claim, and the other end of the spectrum where a document might be necessary to understand any frailty in the factual nexus or background facts, which might offer a full or partial defence or otherwise. What is sought is production of the documents, primarily photographs, which it is alleged were reproduced. These documents it seems to me do form the basis of, or more correctly the starting point for, the plea of breach of the various rights of the plaintiff on foot of which the claim is brought. The defendant is entitled to now know exactly what photographs are alleged to have been reproduced, and for example the defendant needs to know whether all or some of the photographs to which links were allegedly put on its website were the ones in issue or whether some differences can be gleaned in the photographs that were allegedly so reproduced and those in respect of which the plaintiff claims to have rights and which are asserted to have been infringed. My view is that the production of the photographs is properly one that should be ordered at this stage, and that is because the photographs are central to the claim and to how the claim is defended.

37. The other class of documents that is sought is the exclusive licence which the plaintiff pleads it has in the works. That licence is probably contained in or maybe gleaned from a number of documents, but again it is breach of this licence and the rights arising from the exclusive nature of the licence that gives rise to the claim. The document or documents are not sought in order to more properly understand the pleaded factual nexus, or in order to more properly understand an entire context in which the claim is made, including in particular the claim for losses which are alleged to be quantifiable, but is central to the plea, or to some of the pleas, in the statement of claim. Again I consider that production of the documents showing the licence or licences the plaintiff claims to have in the works ought to be ordered at this stage.

38. My view is tempered to a large extent by the general proposition I outlined above, namely that complex commercial litigation ought not to be unduly cumbersome, and the parties ought to be forthright in the production of documents which will in due course be disclosed in the course of the litigation process, whether through discovery or cross examination or other investigations. To withhold the documents at this stage when these documents are not merely relevant but also central, and a foundation stone of the plea, is not in the interests of the parties, the proper conduct of litigation, or in the interest of the cost effective processing of such litigation.

39. Accordingly I order the plaintiff to answer particulars number 4, 5, 6 and 8 and to produce the documents sought at paragraphs 1 and 2 of the notice of particulars of the 4th April, 2014.