

## John Doe Copyright Injunctions in India

Juhi Gupta†

National Law School of India University (NLSIU), Nagarbhavi, Bangalore 560 072, Karnataka, India

*Received 7 March 2013, revised 25 April 2013*

Copyright protection has seen the creation of and resort to a variety of means to protect and preserve one's work from infringement. One such tool is John Doe orders, namely *ex parte* preliminary injunctions obtained against unidentified defendants, used to restrain and mitigate anticipated copyright infringements. Thus, they act as timely shields that are only enforceable by copyright owners upon actual acts of infringement being perpetuated and upon ascertainment of the identities of the respective John Does. However, one observes a dramatic development spearheaded by the High Courts of Delhi and Madras wherein John Doe orders are suddenly being granted with alarming regularity to movie producers in a bid to attack piracy of upcoming releases through different mediums. This paper argues that resorting to John Doe orders in India is coming at an extremely disproportionate social cost. They far exceed their legitimate ambit due to their unscrupulous implementation, the primary victim of which has been the Internet. The extent of 'Internet freedom' has been relegated to the mercy of these sweeping orders, jeopardising perfectly valid consumer interests and provoking serious concerns regarding legitimacy of arbitrary clampdowns for indefinite periods in the guise of countering copyright piracy.

**Keywords:** Copyright protection, John Doe orders, piracy, infringement, injunction, Internet, Internet Service Providers

Copyright protection has occupied much legislative and judicial insight with numerous devices being created to preserve this crucial manifestation of an individual's creation. One would imagine that ordinarily any action to protect a copyright would be directed and pursued against specific violators, identifiable by name, subsequent to having perpetrated infringement. However, fathom a scenario where a copyright owner apprehends with reasonable certainty infringement of his copyright by potential infringers whose identities he does not ascertain in terms of names but describes by virtue of being members of an identifiable class.

This scenario constitutes subject of this paper and makes way for the entry of 'John Doe', the popular characterization of persons unknown to the world at large, against whom *ex parte* preliminary injunctions are sought by copyright owners to immediately restrain anticipated copyright infringements.<sup>1</sup>

The paper analyses: (i) meaning and implications of John Doe orders, (ii) origin and subsequent application of the orders in India, and (iii) issues arising from the manner of their implementation in India.

### What's in a Name?

'John Doe' or 'Rolling Anton Piller'<sup>2</sup> orders evolved to overcome difficulties copyright owners encountered in ascertaining specific defendants, enabling them to institute *ex parte* infringement suits against unknown persons belonging to an identifiable class<sup>3</sup> who upon identification would be impleaded and presented with the opportunity to defend themselves analogous to any civil proceeding.<sup>4</sup>

*Prime facie* John Doe orders can safely be regarded as an ingenious and judicious approach to copyright protection. It balances interests of copyright owners and potential infringers since it acts as a shield providing preventive and expeditious remedy to the former which is only enforceable against the latter upon acts of infringement actually being perpetrated and the owner having ascertained identity of the respective John Does. Importantly, they aid copyright owners in circumventing delays posed by indeterminacy and anonymity of violators and seek timely protection of their right rather than being left at the mercy of the 'wait and watch game'. In this respect, their utility has received a renewed vigour in today's 'virtual' age, where advances in digital technologies have presented unprecedented challenges to copyright protection regimes world over. The impact of the 'Internet' has been such that

†Email: juhigupta91@gmail.com

copyright protection is seemingly being outsmarted consistently by rapid sharing of ‘information’ (to be read in its widest sense as including movies, music, books, etc.) spanning geographical contours. This phenomenon thrives on anonymity, incredible speed and ever expanding reach, thus making a strong case for the application of John Doe orders in contemporary times.<sup>5</sup>

### John Doe Comes to India

Christened as ‘Ashok Kumar Orders’, John Doe orders announced their arrival in *Taj Television v Rajan Mandal*,<sup>6</sup> years after their invocation in UK<sup>7</sup> and USA.<sup>8</sup> Initially, they were primarily used by broadcasters to protect their copyrights from infringement by known and unknown cable operators during sporting events.<sup>9</sup> The orders were enforced through the issuance of blanket search and seizure directives<sup>10</sup> and/or appointment of policemen to ‘assist’ broadcasters.<sup>11</sup> *Taj Television* also entrenched the dubious legal foundation<sup>12</sup> upon which such orders are granted – a legislative manipulation involving a conjoint reading of the provisions prescribing temporary injunctions<sup>13</sup> and inherent powers<sup>14</sup> in the Code of Civil Procedure, 1908 (ref. 15). Thus, broadcasters invoked the traditional three-pronged test<sup>16</sup> governing temporary injunctions – (i) *prima facie* case,<sup>17</sup> (ii) irreparable injury<sup>18</sup> and (iii) balance of convenience<sup>19</sup> – to essentially contend that unlicensed transmissions by cable operators is an accepted practice<sup>20</sup> and the events being time bound, a John Doe order is necessitated to forestall destruction of infringing evidence and consequently huge revenue losses.<sup>21</sup> Drawing inspiration from foreign jurisdictions, the court in *Taj Television* affirmed the ‘litigating finger’<sup>22</sup> principle and was convinced that the situation’s urgency warranted a John Doe order,<sup>23</sup> an attitude subsequently replicated in all sanctioned orders.

The procedural approach is problematic for two reasons:<sup>24</sup> *Firstly*, it overrides Order VII, an issue left unaddressed in *Taj Television*, which mandates identification of every defendant’s name and address<sup>25</sup> together with details of the cause of action,<sup>25</sup> failure to do which is a ground for rejecting the plaint.<sup>25</sup> *Secondly*, it disregards the purpose of inherent powers which the Supreme Court has articulated so as to only supplement or regulate the procedure adopted by courts, without any bearing on litigants’ substantive rights for which courts have to be specifically empowered.<sup>26</sup>

While this procedural manipulation continues to remain unchecked, one observes a dramatic development spearheaded by the High Courts of Delhi and Madras wherein John Doe orders are suddenly being granted with alarming regularity to movie producers in a bid to attack piracy of upcoming releases through different mediums. The recent spate of orders has far exceeded their legitimate ambit due to their unscrupulous implementation, the primary victim of which has been the Internet. The extent of ‘Internet freedom’ has been relegated to the mercy of these sweeping orders, jeopardising perfectly valid consumer interests and provoking serious concerns regarding legitimacy of arbitrary clampdowns for indefinite periods in the guise of countering copyright piracy.

### John Doe Orders and Popular Culture

John Doe orders and their impact warrant attention in the realm of pop culture. Why so? Well, simply put, they restrict or may even completely deny public access to cultural commodities. Article 27 of the Universal Declaration of Human Rights contemplates a level-playing field for both creators and consumers. It states that everyone has the right to participate in the cultural life of the community and enjoy the arts. At the same time it also says that every author of a literary or artistic work is entitled to protection of his material and moral interests stemming from it.

Maintaining a delicate balance between copyright protection and public consumption of cultural goods – both equally legitimate interests – is a difficult task and at a certain level, idealistic also. John Doe orders and particularly their manner of implementation in India, which are discussed in the following section, are unjustifiably and heavily tilting the balance towards copyright owners.

Some scholars go to the extent of arguing that piracy (the evil John Doe orders seek to mitigate) not only makes cultural goods, which everyone is entitled to, affordable for the masses but also ensures greater access and larger reception of the goods.<sup>27</sup> Scholars like Coombe endorse piracy as it symbolizes a direct-action to appropriate popular cultures. This is considered legitimate because popular culture rooted in the public domain is a free space and human beings as heirs of culture are rightfully entitled to it.<sup>28</sup>

At the risk of citing an example that has been discussed ad nauseum, the song ‘Kolaveri Di’ ought to attribute its phenomenal success largely to the fact that the makers of the film ‘3’ released the song and its video online in the days running up to the movie’s

release, thereby facilitating its downloading, distribution and sharing *en masse*. Subsequently, when the date of release approached, the very same makers procured a John Doe order to prohibit availability of the film on a variety of mediums among which the Internet was the biggest sufferer, the very same medium which made their song an overnight rage.<sup>29</sup> In this context, Lawrence Liang has questioned the double standards of filmmakers and the argument of a movie being the private property of the filmmaker and urges the need for a 'political language of passion and enthusiasm which can supplement the existing languages of denial and access'.<sup>30</sup>

### The Shields Become Swords

The case of movie producers owning an exclusive copyright is premised on the aforementioned three-pronged test, highlighting that established rampancy of copyright piracy and the brief lifespan of movies at the box office mandate John Doe orders as opposed to playing the 'wait and watch game' to apply for injunctions only after identifying specific infringers by which time revenue losses potentially running into crores could have been incurred.<sup>31</sup>

Notwithstanding that most orders are obtained a day prior to the movie's release by which time substantial piracy may already have been perpetrated, one can sympathize with the producers' apprehensions. The sympathy, however, dissipates soon enough once the sheer ambiguity plaguing the orders comes to light. They lack guidance on the manner of implementation, seldom prescribe a time period of application and contain broadly worded terms. Starting with the order granted to the producers of *7 Khoon Maaf* and *Thank You*,<sup>32</sup> where reminiscent of the broadcasting cases, the court required policemen to 'assist' in enforcing the order against the John Doe cable operators without further elaborating the nature of assistance.<sup>33</sup>

The ambiguity and consequently sweeping nature of the orders were only compounded when the Delhi High Court included the deceptively innocuous term 'Internet' for the first time while granting a John Doe order to the producers of *Singham*<sup>34</sup> without any further qualification. Since then, the 'Internet' has repeatedly featured in subsequent orders with absolutely no definition being supplied by courts.

Injunctions ought to be specific, an aspect emphasized by the Delhi High Court itself in a verdict<sup>35</sup> it delivered not long before its flurry of John Doe orders, articulating the perils of vague

injunctions to defendants. However, the pioneer of John Doe orders seems to have forgotten its own elucidation and the vagueness perpetuating the orders has bestowed producers with untrammelled powers, transforming the orders into swords from shields.

Since the *Singham* order, the 'Internet' has emboldened producers of *Bodyguard*,<sup>36</sup> *Speedy Singhs*,<sup>37</sup> *Don 2* (ref. 36), *3* (ref. 38) and *Dammu* (ref. 39) to orchestrate the arbitrary shut down of websites even prior to any infringing content being uploaded. Initially by persuading Internet service providers (ISPs) indirectly and then by impleading them as primary parties to the litigation,<sup>40</sup> entire video/file sharing sites, leading torrent websites, streaming services and peer-to-peer networks have been indiscriminately blocked as opposed to specific pages or uniform resource locators (URLs) containing piratical content.<sup>41</sup>

The Internet is a free paradigm and banning whole websites in today's day and age is archaic, only tempting violators to find other means to perpetrate piracy and suppressing a growing market for entertainment supported by file sharing websites to the extent they use non-infringing content.<sup>42</sup> This manner of implementation of the orders is problematic at multiple levels:

- (i) It grossly misinterprets the rationale of John Doe injunctions which are only enforceable upon occurrence of the infringement and identification of the infringer. Further, it only pertains to the specific act of violation (in this case a specific URL or page) and not the entire website, especially given that most of the targeted websites do contain a sizeable proportion of perfectly legitimate content.<sup>43</sup> Although a distinction ought to be made between websites intended to perpetrate copyright infringement and websites incidentally guilty of the same, the point to be noted is that even with respect to the former category, the injunctions cannot be enforced until an actual act of infringement is perpetrated.
- (ii) It reflects extreme levels of arbitrariness insofar as the orders do not specify the websites to be blocked and therefore, brings into question the basis upon which ISPs exercise their discretion in determining which websites to block and the duration of the same.
- (iii) While sanction of the Department of Information Technology (DIT) is required for website blocking, ISPs are doing so in the

absence of any directive to this effect in the orders and are justifying the action under an inapplicable legal provision.<sup>44</sup>

- (iv) In granting such a *carte blanche* to producers, courts have miserably failed to balance the interests of all constituencies involved. Any decline in copyright piracy, even if significant, has disproportionately impacted public interest and trapped ISPs in a precarious position.

The direct impact on consumers has been severe censorship of their Internet freedom. Just as the lack of safeguards in the broadcasting orders enabled seizure of licensed equipment,<sup>24</sup> so also the width of movie orders has affected innocent Internet usage having absolutely no connection to the movie in question as well as consumers' fair use rights under Section 52 of the Copyright Act, 1957. Condemning the commercial motivation behind John Doe orders, Lawrence Liang points out that while producers hope that lack of digital mobility will translate into a greater number of people flocking to the theatres to 'legitimately' watch their movie, 'netizens' are deprived of their right to access and use file sharing and user-generated-content websites which allow free dissemination of cultural texts in digital form. Further, the blanket ban not only denies them access to cultural texts but also to completely disassociated content that is openly licensed and that has been uploaded for the very purpose of sharing.<sup>29</sup>

Further, consistent procurement of such orders and indefinite time period of implementation has made a mockery of free Internet accessibility for weeks on end. More so, in this clamp down, no distinction is made between websites which are almost wholly dedicated to perpetrating such infringement and websites which may incidentally contain such material. Lack of adequate publication of the orders and misrepresentation by the ISPs regarding reasons for shutting websites has left consumers with a lot of uncertainty,<sup>45</sup> which only gets exacerbated when one reads reports of blanket John Doe orders being granted.<sup>46</sup>

In the standoff between copyright owners and consumers, it is the ISPs who have been caught in a catch-22 situation. While it is justified to criticize implementation of the orders for which in fact liability has been attracted,<sup>47</sup> it is also vital to appreciate that producers have unjustifiably shifted the burden of implementation to the ISPs. Unlike cable operators, ISPs are mere conduits who are neither responsible nor competent to monitor

individual websites. However, having been forced into implementing the orders,<sup>48</sup> they have chosen to sacrifice consumers' interests and block entire websites to overcome impossibility of monitoring individual sites and potential liability for contempt of court. One should not forget that this is not an attractive proposition for them either as they risk losing a lot of business as well as frustrated subscribers.<sup>49</sup>

The inadequate legal provisions on intermediaries' liability currently occupying the field do not supplement their case, an issue intrinsically connected to John Doe orders, more so since ISPs are conveniently being made responsible for their implementation. The ruling in *Super Cassettes Industries Ltd v MySpace Inc*<sup>50</sup> has rendered the applicability of the safe harbour provision in the Information Technology Act, 2000 (ref. 51) to intermediaries uncertain for copyright infringement. This in turn casts doubts on the applicability of the Information Technology (Intermediaries Guidelines) Rules, 2011, to intermediaries in respect of copyright infringement which stipulate a takedown procedure, albeit half-hearted in nature.<sup>52</sup> However, the Copyright (Amendment) Act, 2012 introduces a safe harbour provision, though not described in as many words, supplying protection to intermediaries against claims of secondary copyright infringement.<sup>53</sup>

Nevertheless, ISPs do not seem to have lost all teeth. In pursuance of a clarification sought by a consortium of ISPs regarding the extent of the John Doe injunction granted in *3* and *Dammu*, the court crucially clarified that the injunction only applied to specific URLs hosting infringing content and not entire websites. A welcome precedent, the court also rightly shifted the onus to the producers to inform the ISPs about the particulars of the infringing URL within forty eight hours.<sup>54</sup> Subsequent to this clarification, the John Doe order granted for *Mirattal*<sup>55</sup> specifically mentioned URLs containing the movie, without applying to its trailers and soundtrack. Undoubtedly a positive development, further refinement on its modalities is required, primarily on the aspects of binding nature of the takedown requests and the undesirable possibility of ISPs becoming censors which could once again materialize in the form of over-compliance resulting in the removal of non-infringing content.

## Conclusion

The question to be asked is that notwithstanding the merits of John Doe orders and the sound considerations compelling movie producers to procure

them week after week, are they being churned out and implemented at an extremely disproportionate social cost? Based on the above analysis, it can be concluded in the affirmative and, as argued in the paper, it is strongly believed that converting them into swords to ludicrously deny the public legitimate freedoms, without legislative or executive sanction, is worthy of unlimited condemnation. *Ex parte* orders are passed without even hearing the contesting side and therefore, regardless of the context in which they are given, the absolute necessity for their judicious implementation cannot be underscored enough. Yet the consolidation of a truly disturbing trend is not only arbitrary but also illogical, having larger implications on the future course of the country's copyright protection regime, particularly with respect to the virtual world.

It is also ironical that although John Doe orders have been enthusiastically sanctioned to producers, barring their proud claims of reduced levels of piracy, no information is available in the public domain at least to ascertain the real success of the orders as well as their enforcement in mediums other than the Internet. Had they been employed as originally conceived, i.e., as shields, they would not have occupied the fancy of the producers to such an extent. In this context, the clarification of the Madras High Court assumes significance because it is a step towards restoring the true nature and ambit of the orders as well as avoiding *en masse* website blocking and ISPs being rendered scapegoats, a reform that is urgently needed.

However, the clarification in its current form does not preclude over-compliance by ISPs and hence the author proposes its enhancement on the following lines – firstly, any takedown request should be subjected to the penalty of perjury to discourage frivolous requests from producers; secondly, to maintain intermediaries as only conduits, requests should be directed to the respective websites; and thirdly, even though the identified infringer can contest the suit in court, in the interests of efficacy, the websites should be given a restricted window period to ascertain the *bona fides* of the request reserving the right to the aggrieved party to contest the finding in court.

## References

- 1 Quentin Cregan, Roving injunctions and John Doe Orders against unidentifiable defendants in IP infringement proceedings, *Journal of Intellectual Property Law & Practice*, 6(9) (2011) 623-631.
- 2 A 'Rolling Anton Piller' order is inspired from the traditional 'Anton Piller' order, the latter empowering a plaintiff to enter the premises of a known defendant for search and seizure without prior notice to preserve critical evidence which could otherwise be easily destroyed by the defendant. Orders of the same nature granted against unknown defendants have been labelled as 'Rolling Anton Piller' orders, although they are not confined to the purposes of inspection; Barron David R, Roving Anton Piller Orders: Yet to be born, dead, or alive, *European Intellectual Property Review*, 18(4) (1996) 183.
- 3 Hayhurst Gordon W, *Ex parte* Anton Piller Orders with John Doe defendants, *European Intellectual Property Review*, 9(9) (1987) 257.
- 4 Seymour Jillaine, Injunctions enjoining non-parties: Distinction without difference?, *Cambridge Law Journal*, 66(3) (2007) 605, 607-608.
- 5 Sehgal Tanushree, Piracy in the media and entertainment industry in India: Stemming the menace, *Entertainment Law Review*, 20(3) (2009) 82-83.
- 6 *Taj Television v Rajan Mandal*, [2003] F.S.R. 22, decided on 14 June 2002 (Hereinafter '*Taj Television*'). The plaintiff owned the Ten Sports channel and the broadcasting rights to some of the major global sporting events, including the matches of the football World Cup. The plaintiff had entered into agreements with various cable operators in the country to transmit the channel but there were a large number of unlicensed cable operators who were wrongfully transmitting the channel, some of who had been identified. Accordingly, at the time of the World Cup, the plaintiff instituted a suit to obtain *ex parte* relief against named and unnamed cable operators to restrain them from infringing the plaintiff's broadcasting rights under Section 37 of the Copyright Act, 1957.
- 7 The first case in which a John Doe copyright injunction was granted in the UK was *EMI Records Ltd v Kudhail*, [1985] F.S.R. 36, decided on 15 June 1983. The plaintiff alleged the copyright infringement of certain cassette tapes by street traders, very few of whose names could be found, and thus sought a John Doe order against all members of an identifiable class (defined as traders selling goods bearing the pirate brand name 'Oak Records') to restrain them from engaging in the counterfeiting. The court held that the plaintiffs have been able to establish the existence of a group sharing a common interest, although the individual members are unidentifiable due to the group's secrecy, justifying the grant of an *ex parte* relief.
- 8 The first case in which a John Doe copyright injunction was granted in the USA was *Billy Joel et al. v Various John Does, Jane Does and ABC Company*, 499 F. Supp. 791 (1980), decided on 18 July 1980. In this case a John Doe order was granted to prevent the unauthorised sales of merchandise bearing Billy Joel's name outside the venues where he was to conduct his concerts which were negatively impacting revenue generation from sales by authorised vendors inside the concert venues. The court held that notwithstanding the general inability to grant an injunction against unknown persons, the plaintiff had satisfied the court that such an injunction is needed in the given facts and circumstances. In order to ascertain the identities of the unauthorised vendors, the court directed that copies of the restraining order were to be served on all those whose

- merchandise was seized, such persons reveal their names in order to be added as parties to the suit and appear in court to contest the action.
- 9 In *MSM Satellite Singapore Pvt Ltd v Star Cable Networks and Others*, FAO(OS) No. 211 of 2010, the court applied *Taj Television* to prevent infringement of the plaintiff's broadcast rights over the Indian Premier League matches by forty one named defendants and an indeterminate number of unknown defendants, majority of who were cable operators. In *ESPN Software India Pvt Ltd v Tudu Enterprise*, CS(OS) No. 384 of 2011 (Hereinafter '*ESPN Software*'), a John Doe order granted against over 175 named defendants (who the plaintiff had identified during the course of the tournament) and an indeterminate number of unnamed defendants to preserve the plaintiff's exclusive right to broadcast the 2011 ICC Cricket World Cup.
  - 10 A Commissioner is appointed by the court to search the premises of the known and unknown defendants, make an inventory and take into custody all broadcasting equipment which is being used or could be used to broadcast the channel. He is also required to prepare a report of all unnamed violators to enable the court to issue notice to the violators to proceed with civil or criminal action as the case may be.
  - 11 In cases where the court has appointed a Commissioner to conduct search and seizure, he is allowed to take the 'assistance' of technical experts and police officials in carrying out the orders of the court as was the case in *Taj Television*. In *MSM Satellite*, the Commissioner was ordered to visit the premises of the known and unknown cable operators during the period in which matches were being telecast live and seize the equipment found if the operator was found to be unauthorised. However, in *ESPN Software*, the Delhi High Court prohibited the seizure of the defendant's broadcast equipment and did not appoint any Commissioners for this purpose. It directed the concerned police stations to 'assist' in enforcing the court's orders.
  - 12 Iyengar Prashant, *Copyright Enforcement and Privacy in India* (2011), [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1864572](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1864572) (12 February 2012).
  - 13 Order XXXIX, Rule 1, Code of Civil Procedure, 1908 stipulates the cases in which a temporary injunction may be granted, the cases relevant for John Doe injunctions being when any suit property is in danger of being wasted, damaged or alienated by any party to the suit, or wrongfully sold in execution of a decree or when the defendant threatens to dispossess, the plaintiff or otherwise cause injury to the plaintiff in relation to any property in dispute in the suit. The court may grant the injunction to restrain such act or make such other order for the purpose of staying and preventing the wasting, damaging, alienation, sale, removal or disposition of the property or dispossession of the plaintiff, or otherwise causing injury to the plaintiff in relation to any property in dispute in the suit as the Court thinks fit, until the disposal of the suit or until further orders. Order XXXIX, Rule 3, Code of Civil Procedure, 1908 provides for *ex parte* injunctions subject to the court being satisfied that any delay would defeat the object of granting the injunction. The court needs to record the reasons for its opinion and require the plaintiff to deliver to the defendant a copy of the application of the injunction immediately after the *ex parte* order is granted together with the copy of the affidavit in support of the application, a copy of the plaint, and copies of the documents on which the plaintiff relies. Further, the plaintiff needs to submit an affidavit indicating compliance with the above on the day on or immediately the day after such injunction is granted.
  - 14 Section 151, Code of Civil Procedure, 1908 provides that nothing in the Act shall be deemed to limit or otherwise affect the inherent power of the Court to make such orders as may be necessary for the ends of justice or to prevent abuse of the process of the Court. The plaintiff in *Taj Television* relied upon the Supreme Court decision in *Manohar Lal Chopra v Rai Bahadur Rao Raja Seth Hiralal*, AIR 1962 SC 527, decided on 16 November 1961 [Hereinafter '*Manohar Lal*'] to justify the use of the court's inherent powers in the interest of justice as powers which are complementary to those provided for in the Code and which can be used as long as they not detract from the Code's provisions and the legislative intention, *Taj Television*, 14.
  - 15 Section 55(1) of the Copyright Act, 1957 which provides for injunctions as a civil remedy for copyright infringement cannot apply to John Doe injunctions as the provision requires for the infringement to have occurred.
  - 16 The test in UK to grant John Doe injunctions as laid down in *Bloomsbury Publishing Plc v Newsgroup Newspapers Ltd* [2003] EWHC 1087 Ch, decided on 7 May 2003 is as follows:
    - (i) The plaintiff must show a good, arguable case;
    - (ii) The order must clearly indicate what the defendant/s can and/or cannot do;
    - (iii) The order must identify the defendant/s against whom it is made with respect to their works or an identifiable class;
    - (iv) The injunction will only be enforceable against a person who once made aware of the order, understands that it applies to him.
  - 17 *Prima facie* case refers to a *bona fide* triable case for which the court is satisfied, needs to be investigated and disposed on merits; *Dalpat Kumar v Prahlad Singh*, AIR 1993 SC 276, decided on 16 December 1991 (Hereinafter '*Dalpat*'), 5.
  - 18 Irreparable injury refers to a material injury which cannot be adequately compensated for by damages. The court has to be satisfied that there is no other remedy available to the plaintiff except the injunction sought and that he needs to be protected from the consequences of the apprehended injury, *Dalpat*, 5.
  - 19 Balance of convenience refers to weighing the amount of substantial mischief or injury which is likely to be caused to the parties if the injunction is granted or not granted. If the court finds that greater inconvenience would be caused to the plaintiff if the injunction is not granted than to the defendant if the injunction is granted, it means that the balance of convenience is in favour of the injunction being granted. *Dalpat*, 5.
  - 20 In the plaintiff's words in *Taj Television* 'it is an accepted practice that many cable channels choose to supply/communicate to the paying subscribers the best television channels without the appropriate authorisations/licences from the owners/rights holders of copyright in the channels. This unauthorised and illegal practice has continued to cost the television industry in terms of millions of rupees in loss of revenue in terms of the initial and eventual exploitation of the channel.' *Taj Television*, 8.

- 21 In *Taj Television*, the plaintiff contended 'owing to the unique nature of cable piracy and the unstructured nature of the cable industry, enforcement of rights against cable operators is a virtual nightmare. It hardly takes a few minutes for cable operators who unauthorisedly transmit signals to destroy evidence of such unauthorised transmission. The final phase of the World Cup which ends on 30 June 2002 is perhaps the most critical as it is the stage that would command the highest viewership and consequently the highest risk of rampant infringement by all parties who have not till date obtained licenses from the plaintiffs. The plaintiffs apprehend that if they were to wait and identify specific parties and collect evidence of infringement by such specific parties, they would lose a great amount of time and the world cup matches may come to an end. This loss of time in enforcing their rights would lead to immediate and irreparable injury/loss/damage...unauthorised transmission will prompt other cable operators, including the ones who have currently signed up under a valid license to steal the cable signal and unauthorisedly transmit without making the necessary payments. The illegal distribution may result in poor programme quality, thereby impacting on the plaintiffs' reputation.' *Taj Television*, 7, 9. This concern was also appreciated in *ESPN Software* where the court agreed with the plaintiff that unauthorised cable transmission culminates in irreparable loss and damage including subscription and advertisement losses. It could also encourage other operators including licensed operators to engage in such a practice. This would harm the plaintiff's reputation as well as the public interest due to poor programming quality, *ESPN Software*, p. 30.
- 22 The plaintiff in *Taj Television* relied upon the grant of John Doe orders in trademark matters in Canada where courts have held that such orders can be enforced against persons whose identities are unknown at the time of instituting the action, but whose activities fall within the scope of action. So long as the 'litigating finger' is directed to the unknown defendant/s, the inability to identify him by name is considered as a mere misnomer.
- 23 'Undoubtedly the cable operators in India have a long history of violating copyrights. A very large number of court orders are testimony to this. The cable operators are encouraged owing to the unique nature of cable piracy and the unstructured nature of the cable industry, the speed with which any trace of infringement can be erased by the cable operators, enforcement of rights in conservative nature is unlikely to effectively redress the plaintiffs' grievance. At the same time, I am of the opinion that though the court is not powerless to pass John Doe orders in India but in the facts and circumstances of this case the directions given in succeeding paragraphs may protect the interests of the plaintiffs and meet the ends of justice.' *Taj Television*, 17. Similarly, in *ESPN Software*, the court adverted to the real likelihood of copyright infringement by cable operators which results in irreparable loss to broadcasters. Thus, a prima facie case exists wherein the balance of convenience and the interest of justice are in favour of the plaintiff. *ESPN Software*, at 30-35.
- 24 Reddy Prashant T, A critical analysis of the Delhi High Court's approach to *ex parte* orders in copyright and trademark cases, *Manupatra Intellectual Property Reports*, 3 (2011) 171, 195-196, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1969777](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1969777) (15 February 2013).
- 25 Order VII, Rule 1(a), (c), (e), Code of Civil Procedure, 1908.
- 26 *Padam Sen v State of Uttar Pradesh*, AIR 1961 SC 218, decided on 27 September 1960, 10. Interestingly, although *Manohar Lal* refers to this case, the plaintiff in *Taj Television* as well as the Delhi High Court seems to have overlooked the Court's constriction of inherent powers to procedural and not substantive matters.
- 27 Labato Ramon, Communication Networks, Cities, and Informal Economies, 1, 15 (April 2011), <https://www.google.co.in/search?sourceid=chrome&ie=UTF-8&q=ramon+labato+Communication+Networks%2C+Cities%2C+and+Informal+Economies> (17 February 2013).
- 28 Thomas Pradip, Copyright and emerging knowledge economy in India, *Economic and Political Weekly*, 36(4) (2011) 2147, 2149.
- 29 Prabhala Achal and Liang Lawrence, A ludicrous ban in *The Open Magazine* (2 June 2012), <http://www.openthemagazine.com/article/nation/a-ludicrous-ban> (11 February 2013).
- 30 Liang Lawrence, Meet Ashok Kumar the John Doe of India; or the Pirate Autobiography of an Unknown Indian (May 2012), <http://kafila.org/2012/05/18/meet-ashok-kumar-the-john-doe-of-india-or-the-pirate-autobiography-of-an-unknown-indian/> (10 February 2013).
- 31 Want to combat piracy? Go for John Doe order in *The Deccan Herald* (25 May 2012), <http://www.deccanherald.com/content/252129/want-combat-piracy-go-john.html> (21 February 2013). Film producers have alleged that online piracy causes losses in the range of three to five crores on every big budget movie; Venugopal Vasudha, Internet users enraged over blocking of file-sharing sites in *The Hindu* (18 May 2012), <http://www.thehindu.com/news/cities/chennai/article3429836.ece> (17 February 2013).
- 32 *UTV Software Communications Ltd v Home Cable Network Ltd & Ors*, CS(OS) No. 821 of 2011, decided on 4 April 2011 [Hereinafter '*UTV order*']. The Delhi High Court passed a John Doe order against eighteen named and twenty one unnamed cable operators who violated the exclusive copyright vested in the plaintiff in *7 Khoon Maaf* and who could potentially do so again in the plaintiff's forthcoming *Thank You*.
- 33 The relevant part of the order reads as follows: '*The SHO/Superintendent of the concerned police station(s) are directed to render assistance to the plaintiff should any be required for purposes of enforcement of the present order as it is the obligation of the police authorities and the State to enforce judicial orders passed.*' *UTV order*, 32(iv) [Emphasis supplied].
- 34 *Reliance Big Entertainment Pvt Ltd v Jyoti Cable Network & Ors*, CS(OS) No. 1724 of 2011, decided on 20 July 2011 (Hereinafter '*Singham order*'). A landmark verdict for bringing the 'Internet' into the sphere of John Doe orders, the Delhi High Court passed an injunction against five named defendants and twenty five unnamed defendants. It would be pertinent to cite the order passed by the court as this has been copied verbatim in the subsequent John Doe orders granted by courts to producers: 'For the forgoing reasons, defendants and other unnamed and undisclosed persons, are restrained from communicating or making available or distributing, or duplicating, or displaying, or releasing, or showing, or uploading, or downloading, or exhibiting, or playing, and/or defraying the movie '*Singham*' in any manner without proper license from the plaintiff or in any other manner which

- would violate/infringe the plaintiff's copyright in the said cinematograph film 'Singham' through different mediums like CD, DVD, Blue-ray, VCD, Cable TV, DTH, Internet, MMS, Tapes, Conditional Access System or in any other like manner.' Shah Kunal M, Singham on piracy alert, *The Times of India* (24 July 2011), [http://articles.timesofindia.indiatimes.com/2011-07-24/news-interviews/29807206\\_1\\_singham-unidentified-prospective-infringers-reliance-entertainment](http://articles.timesofindia.indiatimes.com/2011-07-24/news-interviews/29807206_1_singham-unidentified-prospective-infringers-reliance-entertainment) (13 February 2013).
- 35 *The Indian Performing Right Society Ltd v Mr Badal Dhar Chowdhry*, CS(OS)1014/2011, decided on 5 April 2010. The plaintiff sought a permanent injunction against the defendant, an organiser of live shows, to restrain him from playing songs in which the plaintiff had a copyright without taking the permission of and making a payment to the plaintiff. In the context of injunctions, the court opined: 'The court ought not issue an injunction which is vague or indefinite. Breach of injunction has serious consequences for the violator. However, before the Defendant can be so enjoined, the Defendant ought to be made aware of the precise act which he is prohibited from doing. A vague injunction can be an abuse of the process of the court and such a vague and general injunction of anticipatory nature can never be granted...The Division Bench of this court also, in *Time Warner Entertainment Co LP vs RPG Netcom* AIR 2007 Delhi 226 has held that a vague order of injunction which is uncertain in its application and likely to cause confusion should not be passed; it will be impossible for the courts to ensure implementation and compliance without the Defendant or the court knowing as to which works the injunction applies.' *The Indian Performing Right Society Ltd v Mr Badal Dhar Chowdhry*, CS(OS)1014/2011, decided on 5 April 2010.
- 36 *Reliance Big Entertainment v Multivision Network & Ors*, CS(OS) No. 2066 of 2011, decided on 19 December 2011 ; Bodyguard Salman Khan movie: Reliance Entertainment gets court protection against its piracy , *The Economic Times* (28 August 2011), [http://articles.economictimes.indiatimes.com/2011-08-28/news/29938388\\_1\\_piracy-levels-fight-piracy-cable-operators](http://articles.economictimes.indiatimes.com/2011-08-28/news/29938388_1_piracy-levels-fight-piracy-cable-operators) (18 February 2013).
- 37 *Viacom 18 Motion Pictures v Jyoti Cable Network & Ors*, CS(OS) No. 2352 of 2011, decided on 14 May 2012.
- 38 *M/s R K Productions Pvt Ltd v BSNL & Ors*, CS(OS) No. 208 of 2012, decided on 29 March 2012.
- 39 Karunya Keshav, Taking copyright law a step too far? *The Hindu* (20 May 2012), <http://www.thehindu.com/news/states/karnataka/article3436679.ece> (9 February 2013).
- 40 This was first done in *M/s R K Productions Pvt Ltd v BSNL & Ors*, CS(OS) No. 208 of 2012, decided on 30 October 2012.
- 41 Blocking website in India: Reliance Communications shows it is very easy in *The Times of India* (24 December 2011), [http://articles.timesofindia.indiatimes.com/2011-12-24/Internet/30554592\\_1\\_block-websites-reliance-communications-reliance-entertainment](http://articles.timesofindia.indiatimes.com/2011-12-24/Internet/30554592_1_block-websites-reliance-communications-reliance-entertainment) (9 February 2013); Nikhil Pahwa, Block & Lock Brigade in *The Sunday Guardian* (27 May 2012), <http://www.sunday-guardian.com/artbeat/block-a-lock-brigade> (15 February 2013).
- 42 Reddy Prashant, Should the government ban file-sharing websites? *The Business Standard* (30 May 2012), <http://www.business-standard.com/india/news/shouldgovernment-ban-file-sharing-websites/475701/> (16 February 2013).
- 43 Liang Lawrence and Prabhala Achal, Copyright madness, *The Indian Express* (22 May 2012), <http://m.indianexpress.com/news/%22copyright-madness%22/952088/> (20 February 2013).
- 44 Section 69A of the Copyright Act, 1957 provides for the power of the executive to issue directions for blocking public access to any information through any computer resource, but does not cover copyright infringement. Website blocking in specific has been contemplated in the Information Technology (Procedure and Safeguards for Blocking for Access of Information by Public) Rules, 2009 which have been made under s.69A. Under the Rules, requests to block websites or specific content have to be made to the Department of Information Technology (DIT) through designated nodal officers. This assumes a lot of significance because ISPs like Reliance have wrongly stated in their press releases that the website blocking undertaken in pursuance of the court orders is under s.79 of the Copyright Act, 1957 which in fact only provides for a safe harbour to ISPs. Blocking website in India: Reliance Communications shows it is very easy in *The Times of India* (24 December 2011), [http://articles.timesofindia.indiatimes.com/2011-12-24/Internet/30554592\\_1\\_block-websites-reliance-communications-reliance-entertainment](http://articles.timesofindia.indiatimes.com/2011-12-24/Internet/30554592_1_block-websites-reliance-communications-reliance-entertainment) (9 February 2013).
- 45 Pahwa Nikhil, Block & lock brigade, *The Sunday Guardian* (27 May 2012), <http://www.sunday-guardian.com/artbeat/block-a-lock-brigade> (15 February 2013).
- 46 Reliance Big Entertainment has reportedly procured a John Doe order from the Delhi High Court covering several upcoming big-budget releases ; Pahwa Nikhil, Block & lock brigade, *The Sunday Guardian* (27 May 2012), <http://www.sunday-guardian.com/artbeat/block-a-lock-brigade> (15 February 2013).
- 47 In *Vinay B v Airtel Authorised Representative*, C.C. No. 226/2012, decided on 3 August 2012, Airtel was directed to pay Rs 20,000 by the District Consumer Disputes Redressal Forum at Shimoga, Karnataka for deficiency in providing internet services, the deficiency being the illegal blocking of a large number of torrent and video sharing websites pursuant to the John Doe order given for 3 and Dammu, thereby causing mental agony to the complainant. See also Anuj Srivas, Airtel penalised for 'torrent site' block, legality questioned in *The Hindu* (7 August 2012), <http://www.thehindu.com/sci-tech/Internet/article3738269.ece> (17 February 2013).
- 48 Producers have conveniently passed the buck on to the ISPs, claiming that they have misinterpreted the John Doe orders which only authorise blocking of specific URLs. However, it has been frequently reported that it is the producers who persuade the ISPs into blocking websites. For instance, a Right to Information petition revealed that Copyright labs, the law firm representing the plaintiffs in the John Doe orders given in 3 and Dammu, actually asked ISPs to arbitrarily block whole websites.
- 49 *SABAM v Scarlet*, Case-C70/10, decided on 24 November 2011 where the court affirmed the importance of striking a balance between protecting intellectual property and the ISPs' right to freedom of business. The court also pointed out that requiring ISPs to monitor individual websites and links is too onerous a burden and not contemplated by the law.
- 50 *Super Cassettes Industries Ltd v MySpace Inc*, CS(OS) No. 2682 of 2008, decided on 29 July 2011. The Delhi High Court ruled that in the light of the proviso to Section 81 of the



- Information Technology Act, 2000, Section 79 does not protect intermediaries from liability for copyright infringement because the proviso states that the Copyright Act, 1957 shall prevail over Section 79. Therefore, the court held MySpace liable for secondary infringement under Section 51(a)(ii) of the Copyright Act, 1957.
- 51 With the 2008 amendment of the Information Technology Act, 2000, India joined the bandwagon of countries providing for a 'notice and takedown' mechanism to establish liability of intermediaries. The 'safe harbour' provision under Section 79 provides that an intermediary shall not be liable for any third party information (information dealt with by an intermediary in his capacity as an intermediary), data, or communication link made available or hosted by him if the function of the intermediary is limited to providing access to a communication system over which information made available by third parties is transmitted or temporarily stored or hosted; or the intermediary does not initiate the transmission, select the receiver of the transmission, and select or modify the information contained in the transmission. The intermediary is also required to observe due diligence while discharging his duties under the Act and also observes such other guidelines as the Central Government may prescribe in this behalf. The safe harbour shall not be available if the intermediary has conspired or abetted or aided or induced, whether by threats or promise or otherwise in the commission of the unlawful act, or fails to expeditiously remove or disable access to material on a computer resource controlled by him when he receives actual knowledge or a notification.
- 52 A study conducted by the Centre for Internet & Society on Intermediary liability concludes that the takedown procedure in the Rules will lead to a 'chilling effect' on free speech and expression where the intermediaries will engage in excessive self-censorship to avoid their liability. Thirty six hours is insufficient for them to carry out a proper investigation, the outcome being compliance with the takedown request. Even assuming that intermediaries endeavour to determine the authenticity of the requests, they are not equipped to don the hats of censors and thus, would rather comply with the requests than incur high damages and possible civil or criminal action. The Guidelines do not provide for judicial review and *audi alteram partem* since the third party provider of information is not required to be given an opportunity to defend himself before the intermediary either before or after the take-down. Since an intermediary is given only thirty six hours to effect the takedown, the probability of the intermediary actually investigating the request's authenticity is minimal. This is in contrast to Section 512 of the Digital Millennium Copyright Act, 1998 in the USA where a copyright owner submitting a takedown request can be held liable for perjury. The third party provider of information, if aggrieved by the removal, can submit a counter notification to the ISP and the latter would be obligated to put back the disabled material unless the copyright owner obtains an order from the court to take down the material. Intermediary Liability in India: Chilling effects on free expression on the Internet, <http://cis-india.org/internet-governance/chilling-effects-on-free-expression-on-internet> (20 February 2013).
- 53 In pursuance of the amendment, Section 52(1)(b) does not hold intermediaries liable for copyright infringement for the transient or incidental storage of any work or performance purely in the technical process of electronic transmission or communication to the public. Section 52(1)(c) does not hold intermediaries liable for the transient storage of any work or performance for the purpose of providing electronic links, access or integration where this has not been expressly prohibited by the copyright owner, unless the intermediary is aware or has reasonable grounds for believing that such storage is of an infringing copy. Section 52(1)(c) also provides for a notice and takedown procedure where if the intermediary receives a notice from the copyright owner complaining of infringement, the intermediary shall prohibit access to the alleged infringing material for twenty one days. If within this time period the copyright owner is unable to procure an order from the court to continue the disablement, the intermediary may continue to provide access to the material. As such, the intermediary is not obligated to restore access to the material if the court order for continued takedown is not received by it. However, if the intermediary does not receive such a court order and does restore access to the material, it carries the risk of running foul of the main body of Section 52(1)(c), especially when the copyright owner has provided convincing evidence of infringement, for being 'aware' or having 'reasonable grounds' for believing that the content is infringing. For liability to not be attracted the proviso would have to prevail over the main section and the requirement of a court order would have to be deemed important enough to overlook the possible commission of primary infringement by the intermediary. Another problem is that due to the overlap between 'communication' under Section 52(1)(b) and 'access' under Section 52(1)(c), an intermediary could be held liable under the former which does not stipulate a takedown procedure and does not require the technicality of a court order.
- 54 Web piracy: HC says block links, not websites, *The Times of India* (22 June 2012), [http://articles.timesofindia.indiatimes.com/2012-06-22/internet/32368412\\_1\\_websites-isps-john-doe](http://articles.timesofindia.indiatimes.com/2012-06-22/internet/32368412_1_websites-isps-john-doe) (21 February 2013).
- 55 Film 'Mirattal' gets copyright cover, *The Times of India* (2 August 2012) [http://articles.timesofindia.indiatimes.com/2012-08-02/chennai/33000256\\_1\\_john-doe-order-tamil-film-vinay-rai](http://articles.timesofindia.indiatimes.com/2012-08-02/chennai/33000256_1_john-doe-order-tamil-film-vinay-rai) (21 February 2013).