

JOHN DOE ORDERS: PREVENTION OF COPYRIGHT INFRINGEMENT OF CINEMATOGRAPH FILMS

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Abstract

Section 55 of the Copyright Act, 1957 entitles the owner of a copyright to obtain civil remedies for infringement of their copyright. While interim orders are granted very often under Order 39 Rules 1 and 2 of CPC, 1908, the Indian judiciary has in the past decade or so granted several John Doe/Ashok Kumar orders to protect copyright holders against unidentified or possible future infringers. This paper aims to study the need and legal basis for such orders as well as the jurisprudence that has evolved around them over the years. In light of Bombay High Court’s recent order criticizing the liberal usage of John Doe Orders by Indian courts for cinematograph films¹, the debate between competing goals of preventing piracy on the one hand and protecting Internet freedom on the other has come back to the forefront. This paper will therefore also analyze the several judicially developed safeguards that limit the broad sweep of John Doe orders to prevent arbitrary blocking of legitimate content.

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II Copyright Regime

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I RISING COPYRIGHT PIRACY IN THE FILM INDUSTRY

THE INDIAN film industry is the largest producer of feature films.² Every year, there is a production of more than six hundred movies in the prominently spoken languages including Hindi, Tamil, Kannada *etc.*³In a 2010 study, it was found that the film sector in India was approximately 2 billion USD strong with the entire media and entertainment industry crossing

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¹*Eros International Media Limited v. Bharat Sanchar Nigam Limited*, NMSL 2147 of 2016 in Suit (L) No. 755 of 2016.

²Government of India, Report on Study on Copyright Piracy in India (Ministry of Human Resource and Development, 1999).

³*Ibid.*

even 14 billion USD.⁴The revenues earned by the industry have multiplied furthermore since then.⁵

However, the industry is also one of the worst-hit victims of piracy in cinematograph films in the world. Due to a massive increase in sales of pirated CDs and more importantly, in the portals providing online downloading of films, India has become one of the top-five countries worldwide for piracy, statistically.⁶ The number of users downloading pirated cinematograph films in India is the 4th highest, and is only exceeded by the number of users in United States, United Kingdom and Canada.⁷ Moreover, if these numbers are seen in relation to the number of broadband users, India is on the top in terms of piracy in English-speaking countries.⁸ The diversification and advancement of digital technology and information sharing portals have broken geographical boundaries. This coupled with the internet's USP of anonymity has brought piracy to every household.⁹

Recent times have therefore seen the film industry making the transition from the more traditional social arrangements and informal dispute resolution methods to written agreements and intellectual property rights litigation.¹⁰ This rise was also due to the attribution of 'industry status' to the film sector by the Indian government and the change in its funding sources from the mafia to corporates.¹¹ Besides legal protection, other measures are also being explored by the

⁴ India in Business, Ministry of External Affairs, Economic Diplomacy Mission Website, *available at*: <http://www.indiabusiness.nic.in/industry-infrastructure/service-sectors/media-entertainment.htm> (last visited on May, 10, 2017).

⁵ Binoy Prabhakar, "Bollywood No Longer Talks of Piracy; But Ignoring Dangers of Online Can Be Costly", *Economic Times* (Feb. 3, 2013, 11:03 AM IST), *available at*: http://articles.economictimes.indiatimes.com/2013-02-03/news/36704530_1_piracy-box-office-alliance-against-copyright-theft (Last visited on June 8, 2017).

⁶ PricewaterhouseCoopers, Report on India Entertainment and Media Outlook, July 2011, *available at* https://www.pwc.in/assets/pdfs/publications-2011/india_entertainment_and_media_outlook_2011.pdf at 68 (Last visited on June 15, 2017).

⁷ Motion Picture Association, "Online Piracy a Genuine Threat to the Indian Film & Television Industry", (Dec. 15, 2009), *available at*: http://mpa-i.org/index.php/news/online_piracy_a_genuine_threat_to_the_indian_film_television_industry/%20 (last visited on June 8, 2017).

⁸*Ibid.*

⁹ Tanushree Sehgal, "Piracy in the Media & Entertainment Industry in India: Stemming the Menace", 20 *ELR* 82-83 (2009).

¹⁰ Nishith Desai Associates, Report on Indian Film Industry: Tackling Litigations (Sep., 2014), *available at*: http://www.nishithdesai.com/fileadmin/user_upload/pdfs/Research%20Papers/Indian_Film_Industry.pdf (last visited on May 11, 2017).

¹¹*Ibid.*

industry such as the creation of Alliance Against Copyright Theft (AACT), which conducts several raids as a response by a conglomerate of the big studio names in the industry including Reliance Big, UTV, Moser Baer, along with the Movie Producers & Distributors Association.¹²

II COPYRIGHT REGIME

India's copyright regime is considered both progressive and robust and provides a host of remedies against piracy.¹³ Section 13 of the Copyright Act 1957 (the governing law for copyright and related rights in India) provides the scope of the subject matter of copyright protection in India and includes cinematograph films.¹⁴ Under section 2(f) of the Act, 'cinematograph film' is defined as any work of visual recording and considered inclusive of works that are produced by other analogous processes.¹⁵ The copyright for the cinematograph film subsists for 60 years after being published.¹⁶ A bundle of rights is given to the copyright owner or the 'author', which for a cinematograph film is the producer of such film under the Act.¹⁷

The Act provides both civil remedies and criminal penalties for infringement of a copyright. The meaning of infringement is provided under section 51 of the Act as, when any person, without a license granted by the owner of the copyright or the registrar of the copyright, does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright.¹⁸ It is also considered infringement if a person, unauthorised to do so, allows a place to be used for public infringing communication of a work.¹⁹ Infringing acts include unauthorized reproductions, performances, a creation of derivative works, issue of copies of a work not in circulation, distribution or import of infringing work and what is really required to be seen is whether a person viewing such work would have an unmistakable impression that the later work is copying the first.²⁰ Section 14(d) of the Act entitles the owner of the copyright to the exclusive right of communication of the film.

¹²*Ibid.*

¹³ Alka Chawla, *Law of Copyright- Comparative Perspectives* 238 (Lexis Nexis, Delhi, 2013).

¹⁴ The Copyright Act, 2012 (Act 27 of 2012), s. 13(1)(b).

¹⁵ The Copyright Act, 2012 (Act 27 of 2012), s. 2(f).

¹⁶ The Copyright Act, 2012 (Act 27 of 2012), s. 26.

¹⁷ The Copyright Act, 2012 (Act 27 of 2012), s. 2(d)(v).

¹⁸ The Copyright Act, 2012 (Act 27 of 2012), s. 51(a)(i).

¹⁹ The Copyright Act, 2012 (Act 27 of 2012), s. 51(a)(ii).

²⁰ Nida Zainab Naqvi and Syed Ahtisham Raza Naqvi, "Remedies Against Breach of Copyright" in Priya Rai, R.K. Sharma *et al* (eds.) *Transforming Dimensions of IPR: Challenges for New Age Libraries* 139 (2015), available at :

Section 55 of the Copyright Act gives owners (including exclusive licensees²¹), whose copyright has been infringed, the right to obtain all civil remedies, through injunctions, damages and disgorgement, that are otherwise available for the infringement of any right.²² Sections 63 to 70 of the Act prescribe criminal penalties by way of imprisonment and fines. The Act also provides for administrative remedies in the form of applying to the Registrar for a ban on importing infringing copies into the country as well as then delivering the copies that are confiscated to the copyright owner.²³

III LEGAL BASIS FOR JOHN DOE ORDERS

One of the prominent civil remedies utilized by film producers to tackle piracy is John Doe Orders, also known as Rolling Anton Pillar Orders²⁴ or more familiarly as Ashok Kumar orders in India.²⁵ They are *ex parte* temporary injunctions, which copyright owners seek, to refrain those infringers whose identity is not known.²⁶ John Doe orders are helpful tools in the hands of copyright owners of cinematograph films, where large-scale anonymous piracy on the Internet is a massive concern. It acts as a 'shield', by aiding the owner to obtain a timely remedy and sidestepping any postponement caused by the anonymity of the infringer.²⁷ John Doe Orders arise out of *quia timet* actions, which are actions by a party seeking the help of the Court to prevent a possible future injury to the party's interests or rights.²⁸

John Doe Orders are granted under order 39 rule 1, 2 read with section 151 of CPC. Thus, the same principles that come into the picture on the grant of an interim injunction under order 39, CPC apply to John Doe Orders too. The three-pronged test to determine whether the order should be granted is applied *i.e.*; .²⁹

- i) an existing prima facie case
- 2) balance of convenience in the favour of the plaintiff and

<http://www.nludelhi.ac.in/download/publication/2015/transforming%20dimension%20of%20ipr%20-%20challenges%20for%20new%20age%20libraries.pdf> (last visited on July 30, 2017).

²¹ The Copyright Act, 2012 (Act 27 of 2012), s. 54.

²² The Copyright Act, 2012 (Act 27 of 2012), s. 55.

²³ *Supra* note 20 at 145.

²⁴ David Barron, "Roving Anton Pillar Orders: Yet to be Born, Dead or Alive", 18 *EIPR* 183, (1996).

²⁵ *ESPN Software India Pvt. Ltd. v. Tudu Enterprise, C.S.(OS)No.384 of 2011* (18 February 2011).

²⁶ Quenten Cregan, "Roving Injunctions and John Doe Orders against unidentifiable Defendants in IP Infringement Proceedings", 6 *Journal of IP Law and Practice* 623-631 (2011).

²⁷ Juhi Gupta, "John Doe Copyright Injunctions in India", 18 *Journal of Intellectual Property Rights* 351-359, (2013).

²⁸ *Ibid.*

²⁹ *J.K. Rowling and Bloomsbury Publication v. Newspapers Newsgroup Limited*, 2003 F.S.R. 45.

3) irreparable loss being caused to the plaintiff because of the infringement of his/her copyright by the (in this case unidentified) defendant

The order is considered anticipatory and 'shield'-like because once it has been obtained, the owner of the copyright can simply serve the order to those who are found to be infringing and they then must comply with the order, as failure to do so would constitute contempt.

IV INDIAN JURISPRUDENCE

While the John Doe jurisprudence is imported from American case law and is widely used in Australia, Canada, and Britain as well,³⁰ the first time it was used by the Indian courts was in the case of *Taj Television v. Rajan Mandal*.³¹ In this case, the plaintiff being the exclusive owner of broadcast reproduction rights for FIFA World Cup 2002, sought an injunction against six known and fourteen unknown cable-operators, some of whom were transmitting the tournament without authorization from the plaintiff and thereby infringing the plaintiff's copyright under section 37 of the Act.³² The plaintiff contended that since the finals of the tournament, which were at the most risk of infringement, were approaching, and since the cable industry is unstructured and makes it easy to erase any evidence of infringement, it was impossible to identify the infringers in a timely manner without causing irreparable loss to the plaintiff.³³ Owing to the contingencies of the case and in order to prevent heavy revenue losses to the plaintiff, the court by relying on the Supreme Court's decision in *Manohar Lal*³⁴ case invoked its inherent powers to meet the ends of justice³⁵ and authorized a commissioner to enter premises where infringement may be taking place and record evidence of unauthorized transmission by the operators.³⁶ The Court clarified that Indian courts do have the power to give John Doe orders.³⁷

Post *Taj Television*, Indian courts were far more liberal in pronouncing John Doe orders and several orders were given out in subsequent cases. In *ESPN Software*³⁸, the Court held that since judicial systems in countries where John Doe orders are prevalent such as UK, Australia,

³⁰*UTV Software Communications v. Home Cable Network Ltd.*, I.A. No. 5383/2011 in CS(OS) No. 821 of 2011.

³¹*Taj Television v. Rajan Mandal*, I.A NO. 5628/2002 in CS (OS) 1072 of 2002.

³²*Supra* note 31 at 3.

³³*Supra* note 31 at 4.

³⁴*Manohar Lal Chopra v Rai Bahadur Rao Raja Seth Hiralal*, AIR 1962 SC 527.

³⁵The Civil Procedure Code 1908, s. 151.

³⁶*Supra* note 31.

³⁷*Ibid.*

³⁸*Supra* note 25.

Canada, US share a basic similarity with the Indian system, it is reasonable to imply that the latter has the power to pass such orders as well.³⁹ The orders were/are considered particularly fitting for piracy in cinematograph films especially because of the shift of piracy in these films from physical sales to online downloading portals. Thus, studios and film producers file anticipatory suits against ISPs and cable operators who provide access to Internet asking them to block access to specific websites and URLs, where the infringing copy is accessible.⁴⁰

The first case to grant protection by way of John Doe orders in case of online piracy was *Reliance Entertainment* case for the cinematograph film *Singham* (2011).⁴¹ Further, in *RK Production v BSNL*⁴² the High Court of Madras gave an order preventing anyone from illegal download or sale of DVDs of the movie '3'.⁴³ The order also puts a burden on the Internet Service Providers (ISPs) to block access to the websites, on which infringing copies are uploaded.⁴⁴ In an article published in June 2016, it was noted that within a month, 4 John Doe orders had been granted to producers of *Azhar* (2016), *Housefull 3* (2016), *Waiting* (2016) and *Veerappan* (2016) to block websites which were hosting dormant or dead links to pirated copies of the films, which could be activated later when the film would be released.⁴⁵ It was found that in all these cases, one of the defendants was an ISP.⁴⁶

V A SHIFT WITHIN COMPETING POLICY GOALS

Rampant John Doe orders being meted out by courts resulted in 2,162 URLs being blocked by courts, most of which were for copyright piracy cases, between January and early December of 2014.⁴⁷ Increasingly academicians and researchers were criticizing the liberal practice of courts in giving blanket orders to address potential infringement of copyright by ignoring the plight of the internet service providers, whose content was being over blocked, despite being legitimate.

³⁹*Ibid.*

⁴⁰ Kian Ganz, "The Messy Battle Against Online Piracy", *Livemint*, (Aug 2, 2017. 02 12 AM IST), available at: <http://www.livemint.com/Consumer/YtbRN9fv6ZgZCZOexcWMI/The-messy-battle-against-online-piracy.html> (last visited on Feb. 12, 2017).

⁴¹*Reliance Big Entertainments v. Multivision Networks.*, CS(OS) 3207/2011 (Delhi HC).

⁴²*R.K. Productions v. BSNL Ltd.*, O.A.No.230 of 2012 (Mad HC).

⁴³*Ibid.*

⁴⁴*Ibid.*

⁴⁵ Nikhil Pahwa, "Four John Doe Orders for Blocking Websites in the Last Month Alone", *Medianama*, (June 13, 2016), available at: <http://www.medianama.com/2016/06/223-john-doe-orders-india/> (last visited on May 10, 2017).

⁴⁶*Ibid.*

⁴⁷*Supra* note 40.

A paradigm shift came about recently in July 2016 when in an application for a John Doe order to prevent infringement of the cinematographic film *Dishoom* (2016) was rejected by the High Court of Bombay.⁴⁸ The court dismissed the application and held that blocking of websites was not permitted unless it can be shown that the whole website contained only pirated content.⁴⁹ The judge was very firm in his ruling that although copyright protection for the plaintiffs is important, it cannot be at the cost of other public law rights and thus there must be a balance created to protect the constitutional rights and freedoms of innocent ISPs as well.⁵⁰ Several safeguards were also created into the order, with the judge laying down that when a sweeping request is made for the purpose of blocking potential online infringers of copyright, the courts must in some manner test the authenticity of the information that is provided by the Claimant so that any legitimate content such as trailers of the film does not get blocked.⁵¹ In the order delivered on the 30th of August in the same case, the court further suggested that the ISPs must join hands to institute the position of an ombudsman, who would check the legitimacy of a plaintiff's claim at first—thereby easing the extensive burden of such cases being brought to courts.

VI CONCLUSION

Procedurally, although, John Doe orders override Order VII of the Civil Procedure Code, 1908 which mandates identification of the defendant's name and address, it has repeatedly been held by Indian courts that where such identification is impossible, a John Doe order may be given.⁵² However, John Doe orders are problematic since the invocation of inherent powers of the court is meant to supplement the regular procedure without affecting the parties' substantive rights⁵³, an element which is absent in online piracy cases since they threaten to destroy Internet freedom if they continue to be broad or unscrupulous in their nature. However, John Doe orders as a measure need to be controlled and reserved for extraordinary situations, where the balance of convenience suggests that the loss caused to plaintiff will be far greater than the compromise to the larger public goal of protecting Internet freedom and constitutional rights of the ISPs.

⁴⁸*Supra* note 1.

⁴⁹*Ibid.*

⁵⁰*Ibid.*

⁵¹*Ibid.*

⁵²*Super Cassetes Industries Ltd. v. Myspace Inc.*, 2011 (47) P.T.C. 49 (Del. HC); *Indian Performing Right Society Ltd. v. Badal Dhar Chowdhry.*, 2012 (50) P.T.C. 376 (Del. HC).

⁵³*Padam Sen v State of U.P.*, AIR 1961 SC 218.

A study reveals that when a film is transmitted online without authorization, more than 3500 other links get replicated which are spread all over the globe and these URLs manage to get more than 2 lakh views in a month and about 45000 downloads in a single day.⁵⁴ Thus every time someone opens a link, it results in a loss of about twenty rupees to the producer totaling the month's aggregate to more than 3 crores.⁵⁵ That's a massive revenue loss for film producers, who invest substantial amounts of capital in their films. In such situations, John Doe orders are an effective remedy and must be granted to ensure the industry's trust and faith in the protection granted by the copyright regime to them.

Thus the need of the hour is to balance the protection rights of film producers and copyright owners from widespread piracy as well as resolve the problems of over-blocking of non-infringing content that trouble the ISPs. It is widely known that Internet piracy is reaching new levels every day, causing an uproar in producers of cinematograph films. In this light, it becomes important to review our copyright protection regime and provide other measures as well.

The 2012 amendment of the Copyright Act introduced certain solutions by way of section 55A, which makes circumvention of a technological protection measure i.e. a TPM with the intention to infringe upon the owner's rights, a criminal offence.⁵⁶ This can be of immense value to copyright holders as it would tackle piracy at its nascent stages instead of bringing a claim for a John Doe Order. Section 65B also provides for protection by way of making it a criminal offence to remove the digital rights management information from a work.⁵⁷

Furthermore, it is essential to reduce the burden on courts by creating more number of cyber cells along with separate tribunals or specialized dispute resolution mechanisms for tackling media and entertainment related piracy disputes, as such measures will help in handling online piracy more effectively and in a timely manner.

⁵⁴ Aditya Mishra, "Recent Inclination of Indian Judiciary to Pass "John Doe" Orders – A Critical Analysis on the Perspective of Copyright Infringement of Film Productions", 2 *Law Mantra*, (2015).

⁵⁵ *Ibid.*

⁵⁶ The Copyright Act, 2012 (Act 27 of 2012), s. 55A.

⁵⁷ The Copyright Act, 2012 (Act 27 of 2012), s. 65B.