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India's First Dynamic Injunction Against 'Rogue Websites'- An Analysis of The UTV Software Communications Ltd. Case

"Neutrality helps the oppressor, never the victim. Silence encourages the tormentor, never the tormented. Sometimes we must interfere." – Elie Wiesel, Nobel Laureate

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In an infrequent occurrence, the High Court at Delhi ("Court") on April 10th, 2019 has decreed the astute remedy of Dynamic Injunctions'

and blocked over 30 infringing websites, to restrain the mounting perils of unauthorized online content distribution, or 'online privacy' by Rogue Websites or Flagrantly Infringing Online Locations ("FIOL"). Online privacy has unfolded and progressed from physical carriers via downloads, to streaming, along with, and often even ahead of authorized content distribution, to the level that they now coexist to succor the preferences of varied consumers.

The remedy of Dynamic Injunction permits the owner of a copyright to approach the Joint Registrar of the jurisdictional court to extend an order of injunction already granted against a website to other mirror/redirect/alphanumeric websites with the same content.

This judgment comes in decision to eight suits filed by UTV Software Communications

Limited and Twentieth Century Fox Film Corporation (collectively referred to as "Plaintiffs") that are companies engaged in creating content, producing and distributing cinematographic films around the world, including in India; seeking injunction against the defendants for infringement of copyright by promulgating to the public, the Plaintiffs' original content/cinematographic works without authorization.

The following four classes of defendants were impleaded in the matter:

(i) 30 (thirty) identifiable websites;

(ii) John Doe Defendants, i.e. hitherto unknown parties engaged in the unauthorized communication of the Plaintiffs' copyrighted works and include the registrants of the defendant-websites, uploaders, creators of the redirect/mirror/alphanumeric websites, etc.;

(iii) Internet Service Providers ("ISPs"), that provide internet access, enabling users to visit any website online, including the defendant-websites;



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(iv) Government Department/Agency, namely Department of Telecommunication (“DoT”) and Ministry of Electronics & Information Technology (“MEITY”) (collectively referred to as “Defendants”).

The Plaintiffs contended that the defendant-websites were hosting and providing access to their copyrighted works, without their permission or authority; which amounts to infringement of their rights under the Copyright Act, 1957 (“Copyright Act”).

Blocking of one website is followed by the creation of several other mirror websites which contain the infringing content. Quite often, the names of these websites are very similar to the blocked websites, enabling and encouraging easy identification and access. The details of registrants/operators of these websites are unknown and therefore the Plaintiffs arrayed them as John Doe defendants. The ISPs and the Government Agencies, though not involved in any infringement activity, were impleaded for evolving a reasonable relief that effectively redresses the Plaintiffs’ concerns and also guards the public interest, and for implementing the orders passed by the Court.

The Plaintiffs submitted the affidavit of an investigator stating the activities undertaken by the defendant-websites, and also analyzed in detail, the law relating to website blocking prevalent in foreign jurisdictions. Neither the Government Agencies nor the ISPs advanced any arguments before the Court and stated that they would abide by any



order that the Court passes.

ISSUES AND ANALYSIS

The Court dealt with the following seven issues in this case, as provided below:-

Whether an infringer of copyright on the internet is to be treated differently from an infringer in the physical world?

As regards this issue, the Court recognized that the majority of piracy websites are in it for making money, and not for any ideological reason. Modern digital piracy is a multibillion-dollar international business, and such business model is supported by revenue generated through advertisements, which are displayed on piracy websites. Only a small fraction of sites are supported by ideologies which believe that piracy is a social good.

In consideration of the above, the

Court was of the view that there is no logical reason why a crime in the physical world is not a crime in the digital world especially when the Copyright Act does not make any such distinction.

Whether seeking blocking of a website dedicated to piracy makes one an opponent of a free and open internet?

The Court opined that advocating limits on accessing illegal content online does not violate open internet principles, and if the views of internet exceptionalists were to be accepted, then a boon like cyberspace would turn into a disaster. The Court further opined that the key issue about internet freedom is not whether the internet is and should be completely free or whether Governments should have unlimited censorship authority, but rather where the appropriate lines should be drawn, how they are drawn and how they are implemented.

What is a 'Rogue Website'?

Rogue Websites or FIOs are those websites which primarily and predominantly share infringing/ pirated content or illegal work. Either these websites themselves allow streaming of content or provide a searchable database with links to third-party FIOs.

The Court in this regard provided a list of non-exhaustive indicators for ascertaining whether a website is a 'rogue website', which inter alia include: whether the primary purpose of the website is to commit or facilitate copyright infringement?; the flagrancy of the infringement, or of the facilitation of the infringement; whether the detail of the registrant is masked and no personal or traceable detail is available either of the registrant or of the user?; whether there is silence or inaction by such website after receipt of takedown notices pertaining to copyright infringement?; whether the online location makes it available or contains directories, indexes or categories for the means to infringe, or facilitate an infringement of copyright?; the volume of traffic at or frequency of access to the website; etc.

However, it was clarified by the Court that the aforementioned factors do not apply to intermediaries as they are governed by the Information Technology Act, 2000, having statutory immunity and function in a wholly different manner.

Whether the test for determining a 'Rogue Website' is a qualitative or a quantitative one?

It was recognized that globally, courts

examine whether the primary purpose and effect of the website is to facilitate infringement as opposed to examining purely the quantity of infringing content on the website.

The Court opined that if the test to declare a website as a Rogue Website is that it should contain only illicit or infringing material, then each and every Rogue Website would include a small percentage of legitimate content for not being declared an infringing website. Consequently, the real test for examining whether a website is a Rogue Website is a qualitative approach and not a quantitative one.

Whether the defendant-websites fall in the category of 'Rogue Websites'?

The Court acknowledged the presence of ample evidence on record in the current batch of matters to establish that the main purpose of each of the thirty defendant-websites was to commit or facilitate copyright infringement by providing access to a large library of films, including films of the Plaintiffs without their authorization.

Consequently, in the present cases, the qualitative test was satisfied for inter alia the following reasons- the rogue websites did not provide any legitimate contact details, they hid behind veil of secrecy and rarely complied with requests for takedown; they facilitated infringement by providing features such as indexing, detailed search functions, categorization, etc. which make it very convenient for a user to search and download illegal content; they encouraged a user to

circumvent detection or block orders by providing detailed instructions on how to avoid detection or access a blocked website; the rogue nature of these websites have already been accepted by competent courts in other jurisdictions such as in Australia and the Plaintiffs had duly filed such orders before this Court; the volume of traffic to these websites is also indicative of their rogue nature.

Accordingly, for the foregoing reasons, it was held that the defendant-websites are Rogue Websites.

Whether this Court would be justified to pass directions to block the 'Rogue Websites' in their entirety?

In the opinion of the Court, the extent of website blocking should be proportionate and commensurate with the extent and nature of the infringement, and a court should pass an order to block a website only if it is satisfied that the same is 'necessary' and 'proportionate'. The proportionality principle requires that a 'fair balance' be struck between competing for fundamental rights, i.e., between the right to intellectual property on the one hand, and the right to trade and freedom of expression on the other. In light of this, to ask the Plaintiffs to identify individual infringing URLs would not be proportionate or practicable as it would require the Plaintiffs to expend considerable effort and cost in notifying long lists of URLs to ISPs on a daily basis.

The Court acknowledged that at least forty-five countries, including UK, Australia, Singapore, Portugal, France,

Germany, have either adopted and implemented, or are legally obligated to adopt and implement, measures to ensure that ISPs take steps to disable access to copyright infringing websites. Related studies demonstrate that site-blocking in those countries greatly contributed to:

(1) reduction of usage of infringing websites to which access had been blocked; and

(2) reduction of overall usage of infringing websites; and was likely to yield the same results in India.

While passing a website blocking injunction order, the Court recognized that it would also have to consider whether disabling access to the online location was in the public interest and proportionate response in the circumstances and the impact on any person or class of persons likely to be affected by the grant of an injunction. Such order must be effective, proportionate and dissuasive, but must not create barriers to legitimate trade. Thus, website blocking in the case of Rogue Websites, like the defendant-websites, would strike a balance between preserving the benefits of free and open internet and efforts to stop crimes such as digital piracy. The Court also opined that it has the power to order ISPs and the DoT as well as MEITY to take measures to stop current infringements as well as if justified by the circumstances, prevent future ones.

How should the Court deal with the 'hydra-headed' 'Rogue Websites' who on

being blocked, actually multiply and resurface as redirect or mirror or alphanumeric websites?

The Court observed that internationally, the recent development in dealing with online piracy is by way of 'Dynamic Injunctions' limited to mirror websites. It referred to the case of Disney Enterprises Inc and Ors. V. Ml Ltd. and Ors. wherein the High Court of Singapore held that an applicant was not obligated to return to court for an order with respect to every single IP address of the infringing URLs already determined by the court. Dynamic Injunction was issued by the Singapore High Court in this case, under the provisions of Section 193 DDA of the Singapore Copyright Act, 1987. Although no similar procedure exists in India, yet in order to meet the ends of justice and to address the menace of piracy, the Court in exercise of its inherent power under Section 151 of the Code of Civil Procedure, 1908 ("CPC") permitted the Plaintiffs to implead the mirror/redirect/alphanumeric websites under Order I Rule 10 of the CPC as these websites merely provide access to the same websites which are the subject of the main injunction.

It is desirable that the Court is freed from constantly monitoring and adjudicating the issue of mirror/redirect/alphanumeric websites and also that the Plaintiffs are not burdened with filing fresh suits. However, the Court also observed that it is not disputed that given the wide ramifications of site-wide blocking orders, there has to be judicial scrutiny of such

directions and that ISPs ought not to be tasked with the role of arbiters, contrary to their strictly passive and neutral role as intermediaries.

Consequently, along with the Order, I Rule 10 application for impleadment, the Plaintiffs was asked to file an affidavit confirming that the newly impleaded website is a mirror/redirect/alphanumeric website with sufficient supporting evidence. On being satisfied that the impugned website is indeed a mirror/redirect/alphanumeric website of injuncted Rogue Website(s) and merely provides new means of accessing the same primary infringing website, the Joint Registrar shall issue directions to ISPs to disable access in India to such mirror/redirect/alphanumeric websites in terms of the orders passed. It is pertinent to mention that the Court has delegated its power to the learned Joint Registrar for passing such orders under Section 7 of the Delhi High Court Act, 1966 read with Chapter II, Rule 3(61) and Rule 6 of the Delhi High Court (Original Side) Rules 2018.

JUDGMENT

The Court recognized that the Copyright Act bestows an array of rights on the owner of a work and also endows with remedies in case the copyright is infringed. Section 51(a)(i) of the Copyright Act provides that copyright is infringed when any person, without authorization of the copyright owners, does anything of which the exclusive right lies with the owner of the copyright. Thus, the defendants-websites, which are communicating the films to the

public by making them available for being seen or heard or enjoyed through their websites, are infringing the Plaintiffs' copyrights in the films. The Court opined that it had ample powers to mould the relief available, to ensure that the Plaintiffs' rights were adequately protected.

RELIEF GRANTED

- The Court passed a decree of permanent injunction restraining the defendant-websites, their owners, partners, proprietors, officers, servants, employees, and all others in capacity of principal or agent acting for and on their behalf, or anyone claiming through, by or under it, from, in any manner hosting, streaming, reproducing, distributing, making available to the public and/or communicating to the public, or facilitating the same, on their websites, through the internet in any manner whatsoever, any cinematograph work/content/programme/show in relation to which Plaintiffs have copyright.

- A decree was also passed directing the ISPs to block access to the said defendant-websites.

- DoT and MEITY were directed to issue a notification calling upon the various internet and telecom service providers registered under it to block access to the said defendant-websites.

- The Plaintiffs were permitted to implead the mirror/redirect/alphanumeric websites under Order I Rule 10 of the CPC in the event they merely provide new means of accessing the same

primary infringing websites that have been injuncted.

- The Plaintiffs were also held entitled to actual costs of litigation, which amongst others include the lawyer's fees as well as the amount spent on Court-fees.

- The Plaintiffs were given liberty to file on record the exact cost incurred by them in the adjudication of the present suits.

The Court was also of the view that since website blocking is an unwieldy exercise and majority of the viewers/subscribers who access, view and download infringing content are youngsters who do not have knowledge that the said content is infringing and/or pirated; it directed the MEITY/DoT to consider framing a policy under which a warning is issued to the viewers of the infringing content, if technologically feasible in the form of e-mails, or pop-ups or such other modes, cautioning the viewers to cease viewing/downloading the infringing material. In the event, the warning is not heeded to and the viewers/subscribers continue to view, access or download the infringing or pirated content, then a fine could be levied on the viewers/subscribers. This measure, in the opinion of this Court, would go a long way in curbing the pirated content and the dark-net as well as in promoting the legal content and accelerating the pace of 'Digital India'.

CONCLUSION

Online piracy is widely incessant,

unrelenting, pervasive and expensive, and the inertness with which copyrighted content can be copied and disseminated across borders not only impairs the creators, artists, distributors and makes it challenging for right holders to protect their work, but also has inimical ramifications on the economy owing to diminution of jobs, exports and overall competitiveness. Bringing cases of online piracy against foreign websites can prove to be a herculean task, and the outlook of governments of hoodlum nations is no help.

In light of the above rhetoric factors, the Court's decision seems to be a welcoming change, more particularly for the following reasons:

(i) As a first instance, the Court has done away with impleadment of all rogue websites at once and exercised its inherent powers to allow the plaintiffs to update the list as and when a blocked website creates its illegal twin website, thereby curbing multiplicity of suits and saving time and cost of litigants. This is in clear diversion from the earlier requirement wherein any new website which did not form part of an existing order would constitute a new and separate act of infringement soliciting a new suit or a new judicial finding before it could be blocked;

(ii) The Court took a cue from the years of experience of various jurisdictions that have successfully adopted website blocking regimes primarily by directing the ISPs to permanently block the identified websites. Also, in addition to

protracting the relief available to ensure that the Plaintiff's rights are adequately protected, the Court directed the Government Agencies to issue a notification urging the various internet and telecom service providers registered under it to block access to the defendant-websites;

(iii) The delegation of power by the Court to the learned Joint Registrar for issuing directions to disable access to mirror/redirect/alphanumeric websites, which qualifies as a judicial order as it in effect blocks a new website, is also not commonplace.

However, notwithstanding the above, the remedy of Dynamic Injunctions comes with its share of fallibility, particularly in the manner of its implementation. There can be heavy conjecture in that the procedure for grant of Dynamic Injunction compromises with the principles of natural justice, as the whole premise of such grant does away with the requirement of notifying the Rogue Websites whose content is sought to be blocked. As such, the Rogue Websites are precluded from the opportunity to present their case, which in effect runs contrary to the legal maxim of Audi Alterum Partem. Moreover, although the judgment envisages circumvention of a multiplicity of proceedings, there might be instances of abuse of such remedy, posing questions on its efficacy.

It is pertinent to acknowledge that inasmuch as it remains the fastest and most facile mode to exact entertainment, online piracy will prevail. As such, the glaring question is how to combat it. It is evidently in the best interest of the right-holders and well as in the general public interest to take cantankerous measures to fight against online piracy, considering that the scales weigh heavier in favor of reasonable legal enforcement as compared to the vast extent of online piracy. Various countries across the globe are resorting to the tool of website blocking to restrain Rogue Websites and encourage consumption of legal content. This, however, involves drawing equilibrium between the advantages of and expenses involved in implementation; which entails analysis of whether the implementation is prompt, transparent, accountable and foreseeable. It may be argued that the implementation may not be effective, or there might be ways to outwit or thwart the blocking orders; however, it has to be borne in mind that the standard to ascertain effectiveness should not be complete obliteration of piracy, but, as a first step, its reduction. Thus, as rightly observed by the Court, website blocking is no 'no silver bullet' in the fight against digital piracy, but it should at least be one of the lead bullets, alongside other measures such as partnering with Internet ad companies, domain seizures, and other efforts to prosecute owners of pirate sites.^{iv}



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i *UTV Software Communication Ltd. v. 1337x.to and Ors.*, CS(COMM) 724/2017.,

ii *Ibid.*,

iii 2Para 2 of Order dated 29.07.2016 in *DEITY Vs. Star India Pvt. Ltd.*, FAO (OS) 57/2015.

iv (2018) SGHC 206.