

“John Doe” arrives in alliance with the principle of *Quia Timet*

Introduction

A John Doe order is a type of injunction granted by courts in cases where an anonymous person (“**John Doe**” or “**Ashok Kumar**” as used in India) has committed or is likely to commit a breach of the rights of the plaintiff but cannot be identified at the time of filing of the suit. The principles applicable for obtaining a John Doe order are similar to those applicable for grant of interim relief, *viz.*, existence of a *prima facie* case, balance of convenience in favour of plaintiff and irreparable loss caused (may be) due to the illegal activities of the defendant. In India, the first ever “John Doe” order was issued by the Delhi High Court (“**DHC**”) in *Taj Television & Anr v Rajan Mandal & Ors*¹ in a copyright matter and the Economic Times on June 21, 2002 reported that “Justice Dalveer Bhandari has restrained even unidentified cable operators from stealing the signal.” This order marked the beginning of a new era of intellectual property protection in the form of John Doe orders.

Since the *Taj Television case*, the Indian courts have passed several John Doe orders in trade mark and copyright infringement, personal privacy and confidential information to provide necessary relief to the parties. However, the media and the film industry have only recently started to invoke the concept of John Doe orders to prevent piracy over internet in the form of unauthorized uploading of cinematographic films and to restrain the wrongdoers from indulging into infringement of their copyrights. The orders are being issued in alliance with the principle of *quia timet*, discussed later. This newsletter will discuss adoption of the concept of John Doe orders in India in light of the orders issued by the DHC and the latest one by the Madras High Court (“**MHC**”).

1. Media Industry and John Doe orders

The chances of foreseeable damages to the proprietors are higher in case of copyright infringement in media related works. Once a film or a media production or a live show is telecast in public without the approval of the proprietor the loss cannot be recovered and, therefore, John Doe orders that have the potential to check even the unknown infringers, have gained popularity in media industry. They provide quick action against the unknown offenders rather than a reaction after the actual infringement. While filing an application for issue of such an order, mere apprehension of infringement is sufficient to convince the court to issue such restrictive order to protect the commercial interest of the proprietors.

In India, this unique concept was introduced in the *Taj Television case* wherein the DHC recognized for the first time the exigency in which no other remedies could provide effective relief to a TV channel to protect its investment in a valuable live broadcast from its unauthorized transmission by unlicensed cable operators. Therefore, the DHC, exercising its inherent powers under section 151 of the Code of Civil Procedure, 1908 (“**CPC**”), granted an injunction in the form of John Doe order against unidentified cable operators who were illegally

¹ (2003) F.S.R 24

transmitting Ten Sports channel which had the exclusive rights² to cover the Football World Cup 2002 in Japan and Korea.

This trend was followed in several cases and the DHC has been most pro active in issuing such orders to protect the rights of the media industry, more specifically the rights of the producers of un-released movies. In *Satellite Singapore PTE Ltd v. Star Cable Network & Ors*,³ the DHC passed an order prohibiting the respondents from broadcasting unauthorized signals of the appellant for downloading/telecasting purposes during the Indian Premier League (“IPL”) cricket tournament. This was done to safeguard the interest of the appellant who had purchased the exclusive rights for broadcasting IPL matches in India.

Similar orders were issued by the DHC to protect the copyrights in recent Bollywood films. The producers of these films were apprehensive of the fact that pirated copies of the movies would be distributed in the form of DVDs/CDs in the market and shown on the television by cable operators, which would result in a huge financial loss to them. Realizing the imminent necessity of restraining the unknown assailants, the DHC, relying on the principle of *quia timet* passed a John Doe order against the defendants and unnamed parties to restrain them from distributing, displaying, duplicating, uploading, downloading or exhibiting the movie in any manner or infringing the copyright of the plaintiff *via* any other means.

2. Principle of *quia timet*

The principle of *quia timet* is applicable to any tortious liability wherever there is an apprehension of infringement. The DHC in *Super Cassettes Industries Ltd. v. Myspace Inc. and Anr*⁴ held that the principle of *quia timet* has evolved to assist the party who is under fear of some future probable injury to his rights or interests. The relief in the form of injunction is granted not because an injury has already occurred, which requires any compensation or other relief, but on the premise that an injury or loss might occur in the future. In most cases, where the aforesaid principle has been applied, there was an imminent necessity to restraint the commission of a future act, absence of which would defeat the very purpose of the relief sought. In the case of *Fletcher v. Bealey*⁵ often cited by the Indian courts, Justice Pearson laid down the following ingredients necessary for a *quia timet* action:

- a. there must be a proof of imminent danger;
- b. the proof that the apprehended damage will, if it comes, be very substantial; and
- c. the impossibility to protect plaintiff's interests in the event of injurious circumstances.

Basically, the party claiming relief must be able to portray that if the damage occurs at any time, it will be impossible for a plaintiff to protect himself against it in case the relief is denied to him in a *quia timet* action. This principle is the essential premise on which a John Doe order is issued, particularly in the potential infringement cases of media industry. Recently, in

² The rights are statutorily recognized under section 37 of the Copyright Act, 1957 and order 39 rules 1& 2 of the CPC.

³ F.A.O. (OS) 211/2010

⁴ 2011(48)PTC49(Del)

⁵ 1885 28. Ch.D. 688

Singham's case,⁶ though no actual infringement had taken place, the plaintiff was able to prove the likelihood of pirated copies of the movie being made and distributed by unauthorized persons, which would under all circumstances incur heavy losses for the plaintiff. The DHC, therefore, applied the principle of *quia timet* and issued a John Doe order to protect the future interest of the plaintiff.

The latest John Doe order issued by the MHC in *R.K. Productions Private Limited v. BSNL & Ors*,⁷ on March 29, 2012 could mark the beginning of the acceptability of John Doe orders in yet another High Court. However, such orders are still to be challenged in the Supreme Court, and as and when they do, the outcome ought to then apply uniformly throughout India.

3. R.K. Productions Private Limited (“plaintiff”) v. BSNL & Ors. (“defendants”)

The plaintiff, a production and distribution company in the film & entertainment business produced the Tamil film “3”. It obtained a copyright over the film as it was apprehensive of its infringement based on past experience. The plaintiff apprehended that by using advance technology, the movie “3” would be copied and distributed in the market on DVDs/CDs, as also exhibited on cable and internet by the defendants and other unknown persons. On account of fear of huge financial loss due to the possible infringements, the plaintiff filed an application for an ad-interim injunction in the form of a John Doe order to restrain the defendants and unknown persons from indulging into any such activities. The MHC, on the basis of the above apprehension and the affidavits submitted by the plaintiff, passed a restraining order against the defendants from infringing the copyright of the plaintiff in the cinematographic film/motion picture “3” in any manner without proper license from the plaintiff.

The John Doe order issued by the MHC and DHC earlier may be an effective instrument in curbing piracy which has plagued the media industry. As courts of equity, Indian courts are free to provide remedies which adequately protect the rights of a proprietor and John Doe orders seem to be an appropriate instrument. The onus to establish infringement is upon the plaintiff and this is quite difficult in several cases particularly pertaining to online or widespread infringement or where parties are not known or untraceable. In such cases John Doe orders have played a crucial role in minimizing this burden of proof of infringement and can be applied for even solely on an apprehension of infringement.

In online infringement where the plaintiff fails to identify the infringer(s), the main purpose gets defeated, as the infringing material remains available over the internet. This raises a concern on the enforceability aspect of these orders and their effectiveness. Further, a review of the existing jurisprudence reveals that the courts do not tend to discuss the legal arguments on which the orders are based nor do they contain any tests to determine violation. They essentially base their orders on the facts and circumstances of the specific case and weigh it on the principles of temporary injunction.⁸ The full judgment of the MHC is still awaited on this

⁶ I.A. No. 11242/2011 in CS(OS) No. 2734/2011, *Singham* is a Bollywood film

⁷ O.A. No. 230 of 2012 in C.S. No. 208 of 2012

⁸ Under order 39 rules 1& 2 of the CPC the courts have the power to grant interim orders pending the disposal of the suit, to protect rights of the litigants.

issue and hopefully it would bring forth the legal aspect and define the limits of John Doe orders.

4. Concerns regarding enforceability and limitations of John Doe orders

John Doe orders are enforced by serving a copy on the party which is likely to act or acts (when identified after infringement comes to the knowledge of the applicant) in violation of the order and seeking adherence to the issued notice. In case a defendant fails to comply with it, contempt proceedings can be initiated under Rule 2A of Order 39 of CPC. The order also enables the copyright holder to compel the internet service providers (“ISPs”) to block file sharing websites which can possibly infringe their rights. Such measures have been taken in the past by Reliance Communications on the basis of the order issued by the DHC in *Reliance Big Entertainment v. Multivision Network and Ors*⁹ on December 19, 2011.¹⁰ Once the ISPs block the file sharing websites, even items which do not infringe the copyright of the plaintiff are restricted from being viewed publicly. This could be viewed as an attack on an individual’s right to freedom of speech and expression under Article 19(1)(a) of the Indian constitution. Only reasonable restrictions as mentioned under Article 19(2) can be imposed on the right granted under Article 19(1)(a) in accordance with the procedure established by law.¹¹ Further, the reasonability of the restriction has to be assessed on the basis of the evidence adduced in a particular case by a court of law.¹² When the ISPs block the file sharing websites based on a John Doe order, there is no evidence of infringement of the copyright of the plaintiff but only contemplation of such an infringement. Further, the ISPs are not a court of law and, hence, not authorized to restrict the websites, unless specifically directed to do so in the John Doe order. Therefore, such restrictions in absence of specific directions could be termed as illegal and in breach of the fundamental right to freedom of speech and expression guaranteed under the Indian constitution.

Sensing the wide misuse of John Doe orders, the DHC in the *Indian Performing Right v. Mr. Badal Dhar Chowdhury*¹³ placed certain restrictions on the powers of the court while issuing such orders. The DHC pointed out the requirement of specificity of the infringement for passing a John Doe order. It held that the court ought not to issue an injunction which is vague or indefinite, as breach of injunction has serious consequences for the violator.

Conclusion

Courts in India have started to accept the inevitability of John Doe orders to prevent the violation of intellectual property rights especially relating to those under immediate threat. However, the concept is presently limited to certain cases relating to violation of broadcasting and distribution rights in the media industry. Further, the issue regarding the violation of the right to freedom of speech and expression is not clear as the same has not been brought before the court. The slow pace of development in this field of law can be attributed to the late

⁹ CS(OS)3207/2011

¹⁰Information retrieved from <http://www.business-standard.com/india/news/rcom-shuts-access-to-file-sharing-sites/459854/> as accessed on April 9, 2012

¹¹ *Narendra Kumar v. Union* (1960) 2 S.C.R. 375, 387

¹² *Mbant Tehal Das v. Shiromani Gurudwara Prabhandak Committee*, (1979) ILR 2 Punjab and Haryana 131

¹³ CS(OS)1014/2004

adoption of this concept in India, which has resulted in unavailability of Indian jurisprudence on this issue. Hence, there is an urgent need to define the legal principles and grounds on which John Doe orders can be issued and enforced, so as to protect the proprietors from the misuse of their intellectual property.

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