

CYBER LAW

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I INTRODUCTION

THE CASES relating to Internet or cyber space gained momentum in the recent years expanding the jurisprudence and testing the legislation and its efficacy and lacunae in various cases in 2012. The much debated section 66A of the Information Technology amendment Act (hereinafter referred to as the IT Act) of 2008 notified in October 2009 took a centre stage with the arrests of an academic for emailing a cartoon on the West Bengal chief minister and a business man arrested for posting a twitter alleging corruption by a Union Minister's son. This trend was followed by the arrest of two girls in Mumbai commenting in 'Facebook' on the death of a political leader in Mumbai.

The reactions to these incidents have put in the centre stage the debate on the balance of freedom of expression versus privacy and dignity of the individuals in guarding against defamation. Further the debate on this section got compounded when a private educational institution managed to get a court order to block around 70 URLs which it considered as defamatory bringing to focus again the sections vulnerability in terms of interpretation, application and impact.

The most important sequence of these developments in the cyber space is the filing of the PIL by a law student in the supreme court on the section 66A pleading that "The phraseology of section 66A of the IT Act, 2000 is so wide and vague and incapable of being judged on objective standards, that it is susceptible to wanton abuse and hence falls foul of Article 14, 19 (1) (a) and Article 21 of the Constitution." It was prayed to "reconcile section 41 and 156 (1) of the Criminal Procedure Code with Article 19 (1) (a) of the Constitution". In other words, she has asked the court to disallow arrest without warrant and police investigation without a magisterial order for offences under the IPC or any other laws that involve the freedom of speech.

II PUBLIC INTEREST LITIGATION

The issues relating to cases filed on content removal on popular search sites were sought in various litigations. One of the litigation in the past year is that of a PIL sought by a petitioner against the Union of India to completely remove and

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block the links of the entire movie, ‘Innocence of Muslims’ and all the clips uploaded on ‘You Tube’ owned and operated by ‘Google India Private Ltd’. The Delhi High Court directed the Union of India and the Delhi police to treat this PIL as a representation to act in accordance with the relevant sections of the Information Technology Act, 2000 in the PIL of *Mohd. Amanullah v. Union of India*¹ The “Innocence of Muslims” is the title attributed to an anti-Islamic movie trailer. The 14-minute video clips were initially uploaded to YouTube in July 2012, under the titles *The Real Life of Muhammad* and *Muhammad Movie Trailer*. Videos dubbed in the Arabic language were uploaded during early September 2012. Anti-Islamic content had been added in post production by dubbing, without the actors’ knowledge.² The petitioners in India sought to block and remove all the links of the movie/trailer from ‘You Tube’ named as respondent no. 2 and Google India Private India Ltd. as respondent no. 3. The Assistant Solicitor General (ASG) appearing for the government submitted that there were various petitions in district courts in various parts of the country and action had been taken. The ASG informed that under the IT Act, 2000 a total of 157 Uniform Resource Locators (URLS) hosting the said content have been blocked under section 69A which provides for seven years of imprisonment and/or fine. In spite of the removal such content is available in various servers, which resort to change the URL addresses in different locations.

The Delhi High Court found that the petitioner has not complained or represented to the Delhi police on this issue and included Delhi police as respondent no 4. The court directed the cyber cell of the Delhi police and the union of India to treat this PIL as a representation and to deal it according to the provisions of the law.

III CYBERSQUATTING

Cybersquatting (also known as domain squatting), is the act of registering, trafficking in, or using a domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else. Those who cybersquat use these names for web traffic to seek advertisements and also sell the name at an inflated price.

The term is derived from “squatting” which is the act of occupying an abandoned or unoccupied space or building that the squatter does not own, rent, or otherwise have permission to use. A landmark case decided by the Delhi High Court was that of the *Arun Jaitley v. Network Solutions Private Ltd.*³

The suite related to the desire of Arun Jaitley, a member of Parliament, a former cabinet minister and prominent leader of the Bharatiya Janata Party to register the domain name *www.arunjaitley.com*. It was found that it had been registered earlier with the defendant Network Solutions Private Ltd. a registrar of domain names. The petitioner found the previous owner has not renewed the name. The defendant no.2 *vide* an email dated 25.07.09 reverted back by stating that the matter was referred to the executive department for review and that someone would be contacting them. Later on an email dated 27.07.09 was received by the counsel for the plaintiff from Jeffrey Visgaitis, Executive Support of the defendant no.2, wherein

1 MANU/DE/5580/2012 (3rd Oct., 2012): Manu (OE 5580/2012 (PTC)).

2 Available at: http://en.wikipedia.org/wiki/Innocence_of_Muslims#cite_note-2.

3 MANU/DE/2483/2011, 181(2011) DLT 716.

the plaintiff was asked to either wait for the domain to be deleted for non-payment or make a certified offer for purchasing the domain.

The domain *www.arunjaitley.com* according to the WHOIS⁴ report had expired on 12.06.09. Further according to the domain deletion policy of the defendants, the domain ought to have been deleted after the expiration of 35 days as per the policy. It is argued that even after the expiration of the said 35 days, the domain continued to be under the 'pending deletion' status and the same was not transferred as referred by the plaintiff. The domain name *www.arunjaitley.com* being a 'global top level domain' name, the defendants is bound by the Uniform Dispute Resolution Policy (UDRP). The validity and binding nature of UDRP has been discussed and affirmed by the Supreme Court in *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*⁵ The court observed that:⁶

The Certified Offer Service' of the defendants is nothing but an auction service wherein the person who bids the maximum amount would be entitled for the domain name. The cost for booking a domain for one year is \$35. However, the minimum bid amount for Certified Offer Service is over \$100. Further there is no guarantee that the domain name would be transferred to the bidder. Further the price assessment to procure the domain name *www.arunjaitley.com* according to the website of the defendants is ranging from \$11,725 to \$14,475.

The counsel for the plaintiff further submitted that the courts have considered domain name protection as an extension of the trademark. Even if the word domain name is not mentioned in the definition of the mark under the trademarks, the judicial opinion is well settled that the domain names are to be given the protection under the law of passing off under the common law remedy.

This function of giving names to the addresses of the website has undergone magnificent change whereby the companies, firms, eminent individuals have been able to name the web addresses after their own names and/ or trademark. This performs dual functions, firstly, the domain name does not merely remain as an address but rather performs the function of a trade mark as the prospective customers or other known persons visit the webpage and are able to immediately connect with the source and identify the same with the particular company or the individual.

In other words, the popularity or the fame of any individual or the company will be no different on the computer (or internet) than the reality. The court further observed that it becomes incumbent to protect the domain names so that the identified names of companies and individuals which are distinct at the market place may not go at the hands of individuals who are nowhere concerned with those names and have obtained them just because they are better conversant with the computer techniques and usage of the internet. To simplify, in order to prevent the cyber squatting or trafficking or trading in domain names or the marks, the trademark law

4 WHOIS is a protocol used to find information about networks, domains and hosts. The whois records normally include data on the organizations and the contacts

5 AIR 2004 SC 3540; 2004 (3) AWC 2366 SC.

6 Available at: <<http://www.indiankanoon.org/doc/754672>>.

has been stretched to the extent that it may cover the field of Internet and domain names may be protected just like the trademarks.

The interplay between the Trade Mark Act as well as the domain names on the basis of the trade mark includes name and in turn the domain name was for first witnessed by court in the case of *Yahoo Inc. v. Akash Arora*,⁷ wherein this court accorded protection of domain names after going through the objects of the trade mark law as well as the definition of the trade mark. Further, the same proposition was laid down by the Bombay High Court in *Rediff Communication Ltd. v. Cyberbooth*,⁸ wherein the court has held that the domain names are worthy of the protection under the passing off regime.

The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any *malafide* intention on the part of the defendant. It was observed that if there is representation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief, which would be granted to plaintiff. The cases of *Cadbury Scchweppes v. Pub Squash*,⁹ and in *Erven Warnink v. Townend*¹⁰ were relevant in such context. Further what has to be established is the likelihood of confusion in the minds of the public, (the word "public" being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory" in the case of *Aristoc v. Rysta*.¹¹

In deciding the case the court observed that cybersquatting is a crime against the laws and regulations of cyber law. This aims at registering, or using a domain name with mala fide intent to make profit belonging to someone else. The cybersquatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price. Cybersquatters ask for prices far more than that at which they purchased it. Some cyber squatters put up derogatory remarks about the person to buy the domain from them to compel the innocent person without any fault.

The court ordered the defendants and its entities operating at the addresses namely portfolio Brains LLC, M/s Oversee.net are permanently restrained from using, promoting, advertisement or retaining or parting with the said domain name namely, Arunjaitley.com and further restrained from adopting, using the mark, name in any of the extensions of the domain name in cyberspace wherein the name 'ARUN JAITLEY' forms one of the feature. The court further ordered that the and its entities are directed to transfer the said domain name to the plaintiff with immediate effect. The necessary governing body under the ICANN rules was also directed to block

7 1999 PTC (19) 201.

8 Rediff Communication Ltd. v. Cyberbooth, AIR 2000 Bom 27.

9 *Cadburyschweppes v. Pub Squash*, 1981 RPC 429; (1981) AUEF 213.

10 *Erven Warnink v. Townend* (1979) AC 731.

11 *Aristoc v. Rysta*, (1945) 62 RPC, UK 65.

the domain name and immediately transfer the domain name to the plaintiff. The defendants were asked to make serious efforts and co-operate in transforming the impugned domain name in favour of the plaintiff.

IV TRADE MARKS AND CYBERSQUATTING

The domain name registration system operates on a first come first served basis and often there is an attempt to pass off well-known trademarks to gain eyeballs so that one can benefit out of the traffic. The case, which came up, is that of the India's premier media house that is also a leading player in the e-commerce business, which filed a case against the registration, and operation of a domain name 'myindiatimes'. In the case of *Times Internet Ltd. v. Jonathan S.*¹² the court ruled in favour of the petitioner and ordered a compensatory damage and punitive damage to be paid by the defendants.

M/s. Bennett Coleman & Co. Ltd. is the promoter company of M/s. Times Internet Ltd., the plaintiff, publishers of the Times of India Newspaper and a string of other newspapers and magazines entered the field of e-commerce about a decade ago. The petitioners deposed that the e-commerce field was entered into by M/s. Bennett Coleman & Co. Ltd. under the Trade Name/Logo of "Indiatimes" and for this purpose the said company created a portal named "indiatimes.com". The petitioner has also deposed that it developed an internet site "<http://www.indiatimes.com>" and through this site, the said company started offering to the public a large variety of goods and services and internet shopping, online games, internet options, shopping and gifts including inter-alia sale of fresh flowers, numerous gift items, e-cards etc.

The plaintiff stated they receive more than 30,000,000 (Thirty Million) SMSs a month, 1,000,000,000 (one Billion) eyeballs a month, and does a business of Rs. 60,000,000 (Sixty Million) worth of online shopping every month at the said website and has 13,000,000 (Thirteen Million) registered users. It is further deposed that the plaintiff group (The Times of India Group) has also ventured into television and initiated a television channel under the trade name 'Zoom'.

The defendant in this case has illegally and unlawfully, got registered the domain name '<http://www.myindiatimes.com>' in their own name and operating with an administrative, technical and billing contact of defendant no. 1. It is further deposed that the defendants being Indian residents and knowing the far reach and credibility of the Times group in the market has, with *mala fide* intentions blocked and squatted over the domain trade name "myindiatimes" by registering it in the name of the defendants.

The petitioners contended that the defendants registered the site and operated it with the sole intention of deceiving and defrauding the public at large and making big money, besides diluting the mark of the plaintiff. It is also deposed that on visiting the impugned website, it was found that it only says "site is under construction".

12 Available at: <http://www.indiankanoon.org/doc/28431473/> (17 April, 2012 – All: 2012 (51) PTC/MANU/DE/5314/2012 195 (Del) Delhi H.C.).

The petitioners submitted that exclusively on account of its user, reputation, goodwill, product services and marketing and mere mentioning of *indiatimes* immediately signifies the services and products marketed by the plaintiff through its e-commerce website *www.indiatimes.com* and accordingly, none else has the right to use the said name/mark *indiatimes* which is completely identified with the plaintiff. Even otherwise the name/mark *indiatimes* has no dictionary meaning, it is a coined word, created invented and developed by M/s. Bennett Coleman & Co. Ltd. and, thus, it is entitled to the highest level of protection. It seems that the registration of domain name by defendant no.1 is without any authorization, permission or license from the plaintiff and the registration is illegal without ulterior motives with a view to encash upon the reputation of the plaintiff.

Plaintiff also claimed damages for loss of reputation, business and cost of proceedings. It is trite to say that the defendant has deliberately stayed away from the present proceedings with the result that an enquiry into the accounts of the defendant for determination of damages cannot take place. The infringement of the trademark of the plaintiff is not in dispute. Counsel for the plaintiff in support of his case has drawn attention of court to a number of judgments *M/s L.T. Overseas Ltd. v. M/s Guruji Trading Co.*¹³ and *Relaxo Rubber Limited v. Selection Footwear*¹⁴ the petitioners also drew the attention of the judgment of *Time Incorporated v. Lokesh Srivastava* and:¹⁵

where the court awarded where apart from compensatory damages of Rs.5 lakhs, punitive damages have also been awarded. The court ordered that the plaintiff would be entitled to damages of Rs 5 lakhs.

V COPYRIGHT INFRINGEMENT AND CYBERSQUATTING

In another case involving a high profile Direct to Home (DTH) service provider *Tata Sky Ltd. v. Sachin Cody*,¹⁶ the issue involved the registration of a site *www.tataksyplus.hd.com*, which the petitioner contended infringed the trademark and copyright apart from cybersquatting. The court ordered the surrender of the domain name to the plaintiff.

The petitioner *Tata Sky Ltd.* is joint venture company between *Tata Sons Limited* and *Sky Broadcasting Group plc*. The plaintiff provides services in India through a satellite television service. This service is provided in High Definition (HD) or, as the case may be, DVD quality picture since the commencement of business in 2005. The defendants included the first defendant who registered the domain name *www.tataskyplushd.com* and the second defendant the domain name registrar and a third defendant a web-hosting agency. It was contended that the plaintiff launched services in India in or about 2005 using the trademark “Tata Sky” to provide to a television audience in India a wide range of viewing options comprising of

13 1999 PTC 578.

14 1999 PTC 578.

15 2005 (30) PTC 3 (Del).

16 2011 (46) PTC 422 (Bom).

entertainment, sports and news in a High Definition/DVD format with CD quality sound. The plaintiff has an extensive customer service network with a work force of 3000 engineers together with call centres manned by multi-lingual customer service representatives. The plaintiff commenced business under the combined mark of Tata Sky of which the mark Tata is used under licence from Tata Sons while the mark Sky is used under licence from Sky Broadcasting Group plc. The plaintiff has used brand extensions of Tata Sky combined with a distinctive logo. Sometime after 2008 the plaintiff launched a new line of activity in a range, which has been labeled as Tata Sky Plus. The plaintiff has also launched a range of products under the mark Tata Sky HD; the letters HD denoting High Definition. The plaintiff is the proprietor of several domain names including *tatasky.com* and *tataskyplus.com* which were registered on 01.07.05 and 04.08.08. The plaintiff uses these domain names in relation to its websites which are utilized for the purpose of the business. The plaintiff is the owner of the copyright subsisting in the content appearing on its websites which is *inter alia* in the nature of literary, artistic and photographic work.

The plaintiff stated that the sales under the Tata Sky marks was Rs. 31 crores for 2006-07, Rs. 259 crores for 2007-08, Rs. 601 crores for 2008-09 and Rs. 980 crores for 2009-10. The Tata Sky marks have been promoted and advertised in the print and electronic media. The plaintiff therefore claims to have acquired reputation and goodwill in the marks which are associated with the plaintiff in the trade and the public at large. The first defendant launched a website using the domain name *tataskyplushd.com*. This domain name according to the plaintiff is identical with and similar to the Tata Sky marks and the prior domain names of the plaintiff. The website of the first defendant was registered with the second defendant as registrar while the third defendant facilitated the registration and hosting of the website. The plaintiff addressed a cease and desist notice to the first defendant. The first defendant declined to accede to the request of the plaintiff to transfer or surrender the domain name.

According to the plaintiff the registration of the domain name by the first defendant is a dishonest act for the reason that:

- (i) the domain name of the first defendant is deceptively close to the plaintiff's domain name and websites;
- (ii) the first defendant has purloined the copyright in the artistic works on the plaintiff's website which has been substantially reproduced on the website of the first defendant;
- (iii) the first defendant has used the Tata Sky mark as part of its domain name; and
- (iv) the first defendant has not merely used the Plaintiff's house mark Tata Sky but has also used the brand extensions of the plaintiff, namely, Plus and HD.

The plaintiff has sought an order of permanent injunction restraining the first defendant from using the domain name *tataskyplushd.com* or any other mark resembling the marks of the plaintiff. A mandatory direction is sought against the first defendant to transfer or surrender or to cancel the domain name which has been registered. Relief was sought against the second and third defendants as well. A motion for interim relief was taken out.

The court observed that the material which has been placed on record *prima facie* indicates that the plaintiff has a registration in regard to the domain name *tataskyplus.com* as well as in respect of the name *tatasky.com*. The plaintiff has continuously used the mark *Tata Sky* which is representative of a joint venture between the *Tata and Star Group of Companies*. The plaintiff has other domain names registered using *Tata Sky* as a constituent part of the name.¹⁷

The first defendant obtained registration of the domain name *Tata Sky plus HD*. The website of the first defendant is not merely deceptively similar to the website of the plaintiff but almost identical in all material respects. The get up, film actor and the overall design bear a striking similarity with the website of the plaintiff. In these circumstances, there is justification in the grievance of the plaintiff that the adoption of the domain name *Tata Sky plus HD* is an undisguised attempt to tread on the reputation of the plaintiff which must be enjoined.

It was observed that the courts when they deal with matters relating to the infringement or violation of proprietary interests in intellectual property must be conscious of the grave consequences of the use of deceptively similar domain names in cyberspace. The arms of the law must reach out to such cases of wrongdoing. Wrong doers are in a sense a step ahead of regulatory enforcement. This only emphasizes the need to strike at such violations which have no justification other than to trade on the established reputation of an existing mark. The court cited an author and noted that¹⁸ notes with the emergence of the Internet as an advertising forum, recruiting mechanism and market place for products and services, companies doing business online have a strong desire to acquire domain names that are easy to remember and find an association with their products. It further observed that the author notes that those who have registered the trademarks of others as domain names and then try to sell those domain names back to the trademark owners or third parties at a high profit have exploited the natural connection between trademarks and domain names. The domain name registrant evidently acts in bad faith only with a view to ultimately transfer back the domain name to the owner of the mark. The facts of this case provide no justification whatsoever for the first defendant to have used a mark which is deceptively similar to that of the plaintiff, incorporating it as a part of the domain name and utilizing in the process the artistic works of the plaintiff and the copyright embodied therein.

Further citing the *Satyam Info way Ltd.* case,¹⁹ where the Supreme Court emphasized the importance of domain names and the danger that is exposed by unlawful infraction in the following observations:²⁰

The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere

17 *Supra* note 16 at para 18.

18 Rodney Ryder, *Guide to Cyber Law* 150 (2001).

19 *Supra* note 4.

20 *Ibid.*

means of communication to a mode of parrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain name owner provides information/services which are associated with such domain name. Thus, a domain name may pertain to provision of services within the meaning of Section 2(z).

A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location.²¹ Consequently a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical. As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. Whereas a large number of trademarks containing the same name can comfortably co-exist because they are associated with different products, belong to business in different jurisdictions etc., the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value.²²

The court further cited the judgment of the Delhi High Court in *Pfizer Products Inc. v. Altamash Khan*,²³ where a judge issued interim mandatory orders to the Defendant to transfer the domain name to the plaintiff at the ad interim stage. The Delhi High Court in *Either Limited v. Web Link India*²⁴ a similar view of the law was adopted.

An interim mandatory direction requiring the first defendant to transfer the domain name to the plaintiff is warranted. For one thing, a wrongful violation of the proprietary interest of the plaintiffs has to be dealt with swiftly and effectively. Moreover, the second defendant is one amongst many registrars accredited with the registration of domain names. Merely directing the cancellation of domain name will not serve the ends of justice. The hiatus between the cancellation of a domain name and a fresh registration of a domain name by the plaintiff would be sufficient to allow other violations to take place in the meantime anywhere and at any point of time in cyberspace. The essential nature of cyberspace mandates flexible and efficient judicial remedies. The seamless nature of cyberspace and the ease and flexibility with which a violation can take place should suggest a course of action where other infringers are not left with an opportunity to tread upon and violate the

21 Rodney D Ryder, *Intellectual Property and the Internet* 96-97 (2002).

22 Diane Rowland and Elizabeth Macdonald, *Information Technology Law* 521(2nd edn.).

23 2006 (32) PTC 208 (Del.)

24 2002 (25) PTC 322 (Del)

proprietary interest of the plaintiff in the mark. In the circumstances, the motion would have to be made absolute. Hence, for the reasons already indicated the motion is made absolute in terms of prayer clauses (a) to (f). As regards prayers (c) and (d), it would be necessary to clarify that the Court has granted the principal relief that has been sought of a direction to transfer to the Plaintiff the registration of the domain name *tataskyplushd.com*. Hence, an alternative relief of the surrender and cancellation of the domain name is not required to be granted.

VI INTERNET SERVICE PROVIDER (ISP) LIABILITY

In landmark case involving film production houses and ISPs the Madras High Court ordered for the blocking of specific URLs and not the entire website. This case *Vodafone India Limited v. M/s. R.K. Productions Pvt. Ltd.*²⁵ brought out the liability of ISPs and also the issue of blocking entire website. The fact of the case is as follows: Case was filed in 2012 by M/s. R.K. Productions Private Limited. And case no. 294 of was filed by Creative Commercials Media and Entertainment Ltd. Both suits were filed as John Doe suits. But the label “John Doe” was replaced by Ashok Kumar, an unknown person of India. The first suit relates to a Tamil Film named as “3”. It is for a permanent injunction restraining the defendants and other unknown persons infringing the plaintiff’s copyright in the cinematograph film “3” by copying, recording, reproducing or allowing, camcording or communicating or allowing others to communicate or making available or distributing or duplicating or displaying or releasing or showing or uploading or downloading or exhibiting or playing and in any manner communicating the plaintiff’s movie “3” without a proper license from the plaintiff or in any other manner which would violate or infringe the plaintiff’s copyright in the said cinematograph film “3” through different mediums including CD, DVD, Blu-ray, VCD, Cable TV, direct to home services, internet services, multimedia messaging services, pen drives, hard drives, tapes, conditional access systems or in any other like manner whatsoever and also for a direction to the defendants, allowing appropriate authorities, to block all unauthorized websites /web pages including the schedule mentioned websites, web pages by way of data source network (DSN) blocking and/ or data packet interruption (DPI) based Universal Resource Locator (URL) blocking and/or internet protocol (IP) address blocking through routers thereby blocking all or any of the contents that relate to plaintiff’s copyright protected cinematographic film /motion picture “3” unauthorisedly copied, communicated or made available or displayed or released or showed or uploaded or downloaded or exhibited or played and /or in any manner communicated in and through their respective websites and web pages of the defendants. The second suit in case no. 294 of 2012 was filed by Creative Commercials Media & Entertainment Limited in respect of the very same relief in respect of the movie “Dhammu”. The suits were admitted. Pending the suit in case no. 208 of 2012, this court had granted an interim injunction *vide* order dated 29.03.2012 holding that if an injunction is not granted, the plaintiff’s right in relation to the motion picture “3” will be affected. Similarly, in the second suit in case no.

25 MANU/TN/1548/2012 (Oct. 30, 2012 – Madras High Court IPR).

294 of 2012, by an order dated 25. 4.2012, an interim injunction was granted in respect of the film “Dhammu”. However, by a common order dated 22.6.2012, this court had clarified the interim injunction in the following terms:²⁶

hereby clarified that the interim injunction is granted only in respect of a particular URL where the infringing movie is kept and not in respect of the entire website. Further, the applicant is directed to inform the respondents/defendants about the particulars of URL where the infringing movie is kept and on such receipt of particulars of URL from the plaintiff/applicant, the defendants shall take necessary steps to block such URLs within 48 hours. Notwithstanding the clarification, some of the respondents / defendants filed vacate injunction applications to vacate the order.

In respect of one film which was illegally recorded and communicated through the internet medium, an average of more than 3500 links are created which is disbursed across the world.

Such links garner approximately 2, 40,000 views per month as well as 45,000 downloads per day. Each hit causes an average loss of Rs. 20 and by one month, the total loss to the producer comes to Rs. 3.88 crores.²⁷

Such illegal and unauthorized communication of a cinematographic film or motion picture results in enormous loss to the tune of hundreds of crores of rupees to the production companies. The applicant company itself has been a victim of such illegal and unauthorized piracy. An inclusive list of the websites which provide for illegal and unauthorized communication of motion pictures is set out in schedule ‘A’. The web pages and websites which provide such links are also multifarious and are disbursed all over the world. As the applicant did not know the exact composition of unknown persons, the unknown persons are represented under the name, Ashok Kumar. The respondents are responsible for the contents provided in the websites and webpages and have administrative control over the said websites and web pages of such unknown persons. However the Internet Service Providers (ISPs) such as the respondents and the unknown persons who maintain the websites and webpages have continually turned a deaf ear over the pleas of the production houses. The application has no other option to file a suit against the respondents.

Under the provisions of the Copyright Act, 1957, no person other than the applicant can deal with various rights in relation to the motion picture 3 without the express authority of the applicant. The respondents did not have any right over the copyright protected property of the applicant. Therefore, reproducing, copying, distributing, displaying through cable or online medium of the applicant’s copyright protected film 3 either by the respondents or any person accessing the websites hosted or allowed by the respondents in the territory of India would be in clear

26 *Id.*, para 4.

27 *Ibid*

violation of the statutory and common law rights. It was therefore imperative before the said motion picture is released, the respondents should be restrained from in any manner infringing the applicant's copyright protected cinematographic work through a suitable injunction. The suit was filed by them as a *quia timet* action on account of reasonable apprehension on the act of infringement.

In the counter affidavit filed by the BSNL, the first defendant in both suits, it was stated that the first defendant is the State owned organization licensed by Telecom Regulatory Authority of India (TRAI) to provide services in Telecom such as Basic telephony, mobile services and broadband network in all over India. The applicant has given a list of web sites in Schedule 'A', who he claims that they have committed copyright infringement and are potential infringers. But they have not been made as parties to the suit or to the applications. Hence the suit is liable to be dismissed for non-joinder of parties. The first respondent is a telecom operator and an internet service provider (ISP) and that he has to provide a medium to access World Wide Web (www) and telecommunication services through wired and wireless telephony to his customers. The suit has been filed against them as ISP in India. An ISP only offers a medium for the users to get access to the 'www' and exchange or retrieve information. Section 79 of the Information Technology Act specifically absolves the ISPs from any liability under any law including under the Copy Right Act in respect of their activities and that the present suit is liable to be rejected *in limine*.

The first respondent also stated that it is a public sector undertaking under the Ministry of Communication and Information Technology and works under the directions and orders issued by the Department of Telecommunications and TRAI. It gives as an ISP the medium through which the users access internet as stipulated by DOT and TRAI guidelines. One of the conditions of the ISP licence is that the service provided shall be unrestricted and shall not invade the privacy of the contents /usage by the consumers unless and until directed by CERT-In, DIT, DOT and TRAI. No ISP in the country is authorized or licensed to track or note or monitor the date usage of its customers without the direction of these authorities. It abides by the ministerial order dated 7.7.2003 issued by the Department of Information Technology. It gives procedure for monitoring and blocking of the web sites and web links. The respondent is following the guidelines issued by those authorities and has no control or powers of supervision over the contents on 'www' and has no power to block the websites and web links on its own. It complies as and when the CERT-In issues an order in blocking web sites and web links. The applicant had not approached the proper forum. The applicant has made false allegations against the respondents. The service provided by the ISP does not in any manner include any processing of data or reproduction of data and does not involve any of the acts alleged to be an infringement of copyright under the Act. The respondents have no control or knowledge about the information which the consumers retrieve or share on the 'www'. The applicant has not disclosed any specific act of violation committed by the respondents.

Another respondent Bharti Airtel Limited has filed a counter affidavit in support of their application stating that one of the conditions of the ISP licence is that the service provided shall be unrestricted and shall not invade the privacy of the contents

/usage by the consumers unless and until directed by the TRAI. Hence the ISP is not authorized or licensed to track or note or monitor the data usage of its customers. For issuance of 'John Doe' order under the Indian law, there should be an actionable wrong already committed or done and only the identity of the wrong doer would be undetermined. Under the provisions of the CPC, the suit can be instituted against the identified and named defendants and that the present suit is *ex-facie* not maintainable. Every website is known by a domain name and has an IP address, *i.e.*, Internet Protocol address, which is a numeric address. Since the consumers cannot remember numerical address of domain names /websites, the DNS servers are used to decode the IP address. The function of the ISP is to provide access to the customers to every website which the customer wishes to browse or visit. The respondents cannot have any manner of control or exercise due diligence on the content of any of these websites.

They further stated that for every website, there is a specific link to each of the content in the websites and these can be located through Unique Resource Locators or URLs. Every website could consist of millions of URLs. Such URLs can contain large amount of data and contend which may or may not be objectionable. It is not the function of the ISP to check each and every URL being accessed by every customer and each and every website is accessed by every customer. The function of the ISP does not include the exercise of any editorial control over any of the websites. The ISP has no concern or control with the content of any website. In the array of parties as defendants, not even one person, who is actually infringed the plaintiff's copyright, has been made as party. The general allegation of video piracy cannot be used as a grant to file the present suit. Even in the notice issued to the respondents, they have only mentioned to block the access to URLs. There are no allegations against any of the ISPs which were infringed the copyright of the applicant. The suit for copyright infringement is a civil suit which has to comply with pre-requisites of CPC. Under the garb of playing illegal content, it cannot be said that the ISPs are under the obligation to block all websites, which violates the constitutional right of ISPs whose obligation arise only under the Information Technology Act, 2000. Though the plaintiff impleaded 38 ISPs, they have not impleaded a single website which has infringed their copyright.

Further in the affidavits filed in support of those applications, it was stated that the suit is barred by law. Section 79 of the IT Act specifically absolves an ISP from any liability under any law under the Copy Right Act in respect of any of their activities and that the suit is liable to be rejected in view of the immunity afforded by the IT Act. Though the respondents were not residing within the jurisdiction of this court, the suit has been filed against them. No leave has been obtained under clause 12 of the Letters Patent. There was no cause of action against the defendants in filing the suit. There was no specific overt act has been attributed to the respondents. The suit is also liable to be rejected for non-joinder of parties since none of the persons who have allegedly infringed the rights of the plaintiffs have been made as parties. Under section 14(d) of the Copyright Act, the copyright infringement in respect of a cinematographic film, the person who has actually infringed and communicated the film to the public has to be made as a defendant and such communication should be of the entire film or part of the film. The

defendants have not communicated any film to the public in any manner whatsoever. If the communication of the pirated content is done by the website owner, which is providing the pirated content and not the respondents. The respondents merely allow the consumers to access the internet and that the internet may consist of millions or billions of websites which may have a large amount of illegal content as well. The respondents were not relating to any pirated content of any film and in such case, the liability is of the website owner and no one else. Further it was pleaded that under section 2(ff), the communication to the public means making any work available for being seen or heard. Such act of making available is not being performed by the ISPs, but the owners of the various websites. The constitutional right of ISPs cannot be violated and their obligation arises only under the IT Act, 2000. Under section 79, if an ISP is specifically informed of the link within a website which is violative of the plaintiff's copyright, then the said ISP, as per the policy, is obliged to block the access to the specific URL. This obligation does not mean that the ISPs can be made as defendants in a suit for infringement and can be burdened with the obligation of defending the civil litigation of this nature. The ISPs did not have any connection in terms of revenues which are earned by the website owners as well as by providing downloads. Inasmuch as the plaint does not disclose any cause of action, the plaint is liable to be rejected.

In the counter affidavit filed by the plaintiff it was stated that the instant action was taken prior to the release of the cinematographic film. The actual persons who might be involved in acts of piracy cannot be ascertained at this juncture. It is for this reason; an unknown person was included under the name of Ashok Kumar, which has been widely accepted by the courts in India. The ISPs, who are defendants, have in the past-allowed access to various websites and web pages to illegally copy, upload and download cinematographic films. The ISPs are functioning as vessels for others to use their services to infringe third party works. Hence the ISPs were arraigned as parties. The ISPs contribute for the infringement to take place through their services and also gain monetarily through such actions. Therefore the liability of ISPs is identical to the actual persons involved in the acts of infringement. The practice and procedures related to the report of such illegal information, which has already been generated, transmitted, received, stored or hosted in any computer resource. But in the instant case, it is a preventive relief against the defendants. Since the civil court is the competent authority to grant the preventive injunctive relief against unknown persons, the applicants /plaintiffs are entitled to maintain the suit.

According to the counsel of the plaintiff section 14(d) of the Copyright Act confers upon the copyright owner an exclusive right to communicate the film to the public. Section 2(m) defines infringing copy in relation to a cinematographic film as a copy of film made on any medium by any means. Section 51(a) (ii) defines that copyright is infringed if any person permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work. Section 62 of the Act provides that a suit for infringement of copyright can be filed where the plaintiff resides or carries on business. Section 55 provides for the grant of an injunction whenever copyright infringement takes place in addition to damages and accounts. The term "*quia*

timet action” has been defined as an action instituted by a party who seeks the aid of the Court in fear of some future probable injury to his rights or interest, which is an action brought to prevent a wrong that is apprehended. The unnamed defendants are persons who are apprehended by the plaintiff to involve in uploading, downloading or in any way communicating the plaintiff’s feature film. It is valid and maintainable under the principles laid down by this court in *Tube Investments of India Ltd. v. BSA-Regal Group Ltd*²⁸. Further the *quia timet* action is an equitable relief sought under dire circumstances with a view to prevent any infringement from taking place, lest the owner of the copyright be left with no relief upon such infringement. The apprehension of the plaintiffs forms a cause of action. Upon a successful demonstration of the apprehension, an injunction should be granted as set out by the judgment of the division bench of Calcutta High Court in *Radio Today Broadcasting Ltd. v. Indian Performing Rights Society Ltd.*²⁹

The Plaintiff argued that he ISPs allows subscribers to access to the internet. The ISPs bridge the end users to the persons uploading the illegal pirated contents through various web links. Without the ISPs, no person would be in a position to access the pirated contents nor would the unknown persons be in a position to upload the pirated version of the film. Therefore, the ISPs are necessary parties to the suit. The ISPs are not handicapped in the system of blocking such specific content, web links, URLs, since the IT Act has given power to ISPs to block any given content from the internet and that they should ensure that there are no illegal or immoral contents made available for access to general public. The only remedy available is to have access to such websites blocked by the ISPs. Since floods cannot be controlled, they are attempting to seek control over the floodgates.

The cases cited in reference included the judgment of the Delhi High Court in *Super Cassettes Industries Ltd. v. Myspace Inc.*³⁰ and also a judgment of the Delhi High Court in *Indian Performing Right Society Ltd. v. Badal Dhar Chowdhry*.³¹ It is stated that section 51(a) (ii) of the Copyright Act would include the place at the web space, internet. Therefore, the ISPs, by providing service for access of various unknown persons to commit acts of infringement of copyright, are liable for infringement under the said Act. The ISPs are not only necessary party, but also proper parties. Further arguing on the issue of section 79 of the IT Act, it is not applicable in the instant case in view of section 81 of the IT Act. The Delhi High Court in *Super Cassette Industries Ltd.* case has held that section 81 overrides the provision of section 79 of the IT Act. The IT Act does not oust the inherent power of this court while directing blocking of any content by the ISPs. The ISPs are business driven by volume of customers and downloading. Therefore, they are gaining when multiple persons are illegally downloading such materials. The CPC provides that under order 7 rule 1, the plaint shall contain the name, description and place of residence of the defendants so far as they can be ascertained. In this case, the violators are many in number, the plaintiffs could not identify each and every one. Therefore, the Ashok Kumar suit is maintainable.

28 2010 (42) PTC 493 (Mad).

29 2009 (39) PTC 431 (Cal).

30 2011 (47) PTC 49 (Del.)

31 2012 (50) PTC 376 (Del).

Quoting the Judgment of the Delhi High Court *vide* its judgment in *ESPN Software India Private Ltd. v. Tudu Enterprise*³² has held that the Indian courts have jurisdiction to pass an order against unknown persons arrayed as Ashok Kumars. The present case is not merely a suit against unknown persons as the ISPs are functioning as vessels for others to use their services to infringe third party works. The suit is filed under section 62 of the Copyright Act as the suit can be filed where the plaintiff has its office and carries on business. There is no necessity to get leave under clause 12 of the Letters Patent. The cause of action had taken place within the jurisdiction of this court. A reference was made to a judgment of a division bench of this court in *Wipro Limited v. Oushadha Chandrika Ayurvedic India (P) Ltd.*³³ Therefore, they prayed for the dismissal of the vacate injunction applications as well as the dismissal of order 7 rule 11 applications.

The defendants argued citing the judgment of the Superior Court of New Jersey, Appellate Division in *Dendrite International, Inc., New Jersey Corporation v. John Doe*,³⁴ wherein the U.S. Court held that for entertaining the *John Doe* suit, the plaintiff should identify the missing party with sufficient specificity such that the court can determine that the defendant is a real person or entity who could be sued in federal court. The defendants counsel clarified the judgment of the Delhi High Court in *ESPN Software India Private Ltd. case*,³⁵ Though in that case the maintainability of *John Doe* suit was upheld, but it was based upon peculiar facts of the case where the ICC World Cup 2011 to be held in India, Srilanka and Bangladesh was to last till April, 2011 only and therefore, the events would be over if injunction is not granted and the plaintiff would be severely impacted. But, in the present case, the question of such issue did not arise.

Dealing on the 'quia timet action' the defendant cited the judgment of the Supreme Court in *Kuldip Singh v. Subhash Chander Jain*³⁶ it was observed as follows:³⁷

A quia timet action is a bill in equity. It is an action preventive in nature and a specie of precautionary justice intended to prevent apprehended wrong or anticipated mischief and not to undo a wrong or mischief when it has already been done. In such an action the court, if convinced, may interfere by appointment of receiver or by directing security to be furnished or by issuing an injunction or any other remedial process.

With regard to section 79 of the IT Act, it found in paragraphs 68 and 69 of the Delhi High Court's judgment in *Super Cassette Industries Ltd.*'s case, which reads as follows: Firstly that the court should adopt the mode of construction which upholds the provisions of the Act and make them workable and the interpretation which makes any provision of the Act otiose must be eschewed. In *High Court of Gujarat*

32 MANU/DE/1061/2011.

33 MANU/TN/0449/2008 : 2008 (37) PTC 269 (Mad)

34 No. 3 reported in 775 A. 2d 756 (2001) 342 N.J. Super. 134

35 *Supra* note 32.

36 (2000) 4 SCC 50.

37 *Id.*, para 6.

v. *Gujarat Kishan Mazdoor Panchayat*,³⁸ the Supreme Court held as under:³⁹

The Court while interpreting the provision of a statute, although, is not entitled to rewrite the statute itself, is not debarred from “ironing out the creases”. The court should always make an attempt to uphold the rules and interpret the same in such a manner which would make it workable.

If section 79 of the Information Technology Act is allowed to operate as an embargo or restriction upon the exercise of the right of right holder on saving the liability of the copyright infringement, the said interpretation will render proviso to section 81 of Information Technology Act otiose or unworkable. The said interpretation thus leads the purpose of the proviso as redundant. On the contrary, if the gamut of the section 79 is allowed to remain confined and subject to the proviso of section 81 which is intended to be so by the legislature, both the provisions can stand and work in their respective fields.

It was further observed that section 79 is, thus, meant for all other internet wrongs wherein intermediaries may be involved including auctioning, networking servicing, news dissemination, uploading of pornographic content but not certainly relating to the copyright infringement or patent infringement which has been specifically excluded by way of proviso to section 81. This can be only possible harmonious construction between the two Acts which makes both the Acts workable. The adding of proviso is rather not only exclusionary but also clarifying in nature which clarifies that the provisions of IT Act may not restrict the rights under Copyright Act or Patent Act as its tries to create and confer harmony between two laws and enactments so that they can operate in their respective fields. Thus, there is harmony by adopting the proviso rather than negating it.

The court observed that there is no impact of provisions of section 79 of IT Act (as amended on 2009) on the copyright infringements relating to internet wrongs where intermediaries are involved and the said provision cannot curtail the rights of the copyright owner by operation of proviso of section 81 which carves out an exception cases relating to copyright or patent infringement. It would be wrong understanding of the law to state that the infringements can be prohibited only when the torts are perfected. The principle of *quia timet* is not only confined to the trademark infringements as propounded by the learned counsel for the defendants. The said submission is also misplaced and rejected as meritless. The principle of *quia timet* is applicable to any tortuous liability wherever there is an apprehension of infringement likely to happen. This can be seen even in the cases of trespass where the injunctions are sought even when there is threat of invasion in the property of someone. The principle of *quia timet* has been explained by John George Woodroffe in his book “The Law Relating to Injunctions” in the following words:

The court in its relief stated that the submission that this court cannot prevent future wrongs on the basis of *quia timet* injunction is also not correct as it is equally applicable to infringement of copyright like in any other tortuous

38 [2003] 2 SCR 799

39 *Id.*, para 36.

act. Accordingly, the plaintiff is entitled to relief on the basis of *quia timet* action as the defendant's nature of activities is such where the plaintiff's works is liable to infringe and more so when the defendants are notified about the plaintiff's several works. The said danger of infringement is imminent risk of substantial damages with certainty as the defendants have already done several infringements and will continue to do so in the light of the continuous acts of the defendants. The plaintiff's interest is also to be protected against such infractions which are possible by way of injunction and any court jurisdictionally competent can grant the relief prayed for *quia timet* action. The maintainability of *John Doe* suit (Ashok Kumar suit) is concerned; it was rightly upheld by the Delhi High Court in *ESPN Software India Private Ltd.*'s case.

With reference to injunction and vacate injunction applications are concerned, it must be noted that at the ex-parte stage, this court had granted omnibus injunction order, thereby blocking the entire websites of individual concerned. Subsequently, on the matter being pointed out by the respondents, this court made a correction order on 22.06.12 as extracted above. Therefore, it is open to the applicants/ plaintiffs to give the particulars of URL, where the infringing movie is kept and on such receipt of particulars of URL from the plaintiffs /applicants, the respondents / defendants will have to take necessary steps to block such URLs. This amended order is not under challenge and that the said order is making a workable solution without hurting the stand of both sides. The respondents/defendants are undoubtedly internet service providers (ISPs) and therefore, they have an obligation not to allow such infringement to take place by using their services. Though the charges leveled by the applicants/ plaintiffs on the respondents /defendants ISPs that they are making money out of utilizing the space and that they are in connivance for such infringement is uncharitable, yet the obligation to remove such URLs where the infringement has been pointed out, cannot devalue the order made by this court on 22.06.12 and that order will be made absolute. Therefore, all injunction applications are disposed of in terms of the interim orders granted already and applications for vacating the interim injunction will stand dismissed.

VII CONCLUSION

The technological advancement resulting in various social and business models poses new challenges to the legal system and its functioning. As often said that technology and its traction is a by product of few players, whereas the legal response is always a collective contention. Thus it cannot anticipate or move ahead of the technological landscape but can only follow it as and when dispute arises. The contours of freedom of expression, censorship, privacy, and commercial stakes are being redrawn in the virtual world which requires imaginative application of the real world legal principles. The courts have mixed judgments on the issue of freedom of expression and defamation. At times the actions have overlooked the technological nuances as in the case of blocking of entire websites. Nevertheless the case laws in 2012 have enlarged the scope of understanding the legal interface of the emerging space of Internet.