

THE CURIOUS CASE OF 'JOHN DOE'

Simultaneous to a Friday movie release, several file sharing sites are overloaded with the users illegally sharing the movie. Also, cable operators throughout the country telecast the movie without a license inter alia for unlawful gains. A single pirated copy DVD being sold by peddlers becomes a palate for an uncontrolled and unscalable domino effect of piracy. The potential damage through piracy is colossal to say the least. ***Therefore, preventive actions in the nature of 'John Doe' orders have become significant in the global context especially for production houses to prevent infringement of their intellectual property rights.***

A. MEANING AND ORIGIN

'John Doe' has its origin in the reign of England's King Edward III when the orders were used to refer to unidentifiable defendant. Oxford Dictionary defines John Doe as an "*Anonymous Party*".

In Canada, John Doe order were resorted to by owners of IPR in order to preserve evidence against unknown infringers by allowing the representatives of the Plaintiff to search and seize infringed products. Once identified the term John Doe is replaced with the name of the Defendant^[1]. It is an established concept in America, Australia and UK.

In the matter of ***Billy Joel v. Various John Does***^[2], a popular order which has been consistently relied upon by parties it has been *inter-alia* held:

"Were the Injunction to be denied, Plaintiffs would be without any legal means to prevent what is clearly a blatant infringement of their valid property rights. While the proposed remedy is novel, that in itself should not weigh against its adoption by this Court. A court of equity is free to fashion whatever remedies will adequately protect the rights for the parties before it."

B. THE INDIAN PICTURE

1. Applicable Legal Provisions

The Order is granted under **Order 39 rule 1 and 2** of the Civil Procedure Code, 1908 ("**CPC**"), which refers to court's power to grant a **Temporary Injunction** read with **Section 151** of CPC and Part III Chapter VII of the Specific Relief Act 1963 pertaining to permanent

injunction.

2. Conditions

The courts in India have laid down various restrictions and conditions which the plaintiff needs to comply with before obtaining a John Doe Order.

1. Frank and full disclosure:

Plaintiff has an obligation to make full and frank disclosure to the Court inter alia of the existence of his right, instances of previous breach and of an anticipated large scale and sporadic infringement by known and unknown persons.

2. Prima-facie case:

Plaintiff is required to establish a prima facie case before any pre-emptive relief can be granted to the plaintiffs. The Indian Courts while passing John Doe orders have also relied on cases/judgement passed by foreign courts where it has been inter-alia held that *"in cases where **plaintiffs show that they have a bona fide claim** that unknown persons are infringing their copyright, they have a right to have the identity revealed for the purpose of bringing action."*

3. Actual/ Potential Damage or Irreparable Losses:

Plaintiff must establish that, in the absence of the requested John Doe order, defendant's actions will cause harm that will potentially or actually result in financial or irreparable losses. In **UTV Software Communications Limited v. Home Cable Network Ltd. and ors.**^[3] while granting a John Doe order against the cable operators, who illegally telecast pirated version of the films, the Court relied on the fact that a single telecast by the defendant would simultaneously reach several hundred thousand homes resulting in loss which are irreparable and cannot be computed in terms of money.

Once these conditions are satisfied, several Courts in India have proceeded to issue John Doe orders against cable operators, internet service providers etc.

In the case of **Satellite Singapore PTE Ltd. v. Star Cable Network & Ors**^[4], the Delhi High Court in order to check piracy and unauthorised transmission passed orders prohibiting the respondents from broadcasting/using unauthorized signals of the appellant for downloading/ telecasting purposes during the Indian Premier League (IPL) cricket tournament. A similar order was passed by the Delhi High Court in the case of **ESPN Software India Pvt. Ltd. v. Tudu Enterprise and Ors**^[5]. The Plaintiffs in this case had the sole right to telecast the ICC Cricket World Cup 2011.

3. Indian Production Houses

The remedy of John Doe has been invoked several times by production houses to prevent the movies from being illegally downloaded from the net or being telecasted by the cable operators without a license. In **UTV Software Communications Limited v. Home Cable Network Ltd. and Ors.**^[6] an order was obtained against the cable operators who illegally telecasted pirated version of the films '7 KhoonMaaf' and 'Thank You'. A few cable operators who cause infringement could be identified however there were many unidentified cable operators. Such persons were collectively termed as defendant nos.19 to 50 named as "Mr. Ashok Kumar". In this regard, reliance was placed on the internationally adopted "John Doe" practice as well as India's obligation under the TRIPPS agreement to effectively enforce IPR rights of parties. The court held that balance of convenience was in favour of the plaintiff and against the defendants. This case was followed by **Speedy Singhs** case^[7] in which the Defendants, including the unknown defendants referred to as 'Ashok Kumar' were restrained from in any way communicating without license or displaying, releasing, showing uploading, downloading, exhibiting, playing defraying the movie "Speedy Singhs" through different mediums like CD, DVD, Blue-ray, VCD, Cable TV, DTH, Internet Services, MMS, Tapes, Conditional Access System or in any other like manner. The Reliance Big Pictures obtained a similar order from the Delhi High Court to prevent the illegal broadcast or streaming of the Film, '**Bodyguard**' and '**Singham**',^[8] Reliance Entertainment claimed that this brought down the piracy of the movie by 30%.

The High Court of Bombay in the case of **Red Chillies Entertainments Private Limited v. Hathway Cable & Datacom Limited & ors**^[9] granted an order restraining any person from inter alia telecasting/broadcasting/distributing/ putting on the cable TV network/disseminating/reproducing or otherwise making available to the public, the film '**Happy New Year**' or dealing in any manner whatsoever which would violate/infringe the Plaintiff's copyright.

4. JOHN DOE FOR TRADEMARKS

The Court recognized the application of John Doe order for protecting Trademark wherein John Doe orders are the only remedy for a Plaintiff faced with large volumes of anonymous counterfeiters. In **Ardath Tobacco Company Ltd. v. Mr. Munna Bhai and Ors.**^[10] an order was passed inter alia against unidentified Defendants No. 7 to 23 named as "Ashok Kumar", who were restrained from manufacturing, selling, stocking or dealing in cigarettes under a label, carton or packaging material deceptively similar to the label, carton and packaging material and artistic work as of the STATE EXPRESS 555 of the plaintiff.

In the case of **M/s Sandisk Corporation vs. John Doe**^[11], the Plaintiff had submitted that certain unknown persons were selling counterfeit products with identical name and packaging and logo and it was impossible to identify the sellers. The Court issued an order "the

unnamed and undisclosed persons arrayed as 'John Does' are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly, dealing in counterfeit products, which are identical to the products bearing the plaintiff's Trade mark SanDisk and logo marks and the 'Red Frame' logo, with identical product packaging, product get-up colour scheme, layout, overall look and feel as that being used by the plaintiff."

5. COMPLEXITIES

Since the concept of granting John Doe order has evolved from judicial proactiveness it is tough to determine its precise limits. The procedure that needs to be followed in granting and executing these orders vary with regard to the cases in which it has been granted. The John Doe orders may thus lead to many complexities which may include the following.

1. Improper implementation of orders:

John Doe orders may be improperly implemented and may harm the rights of the legitimate third parties. In the **Singham case**^[12], after obtaining the order the Plaintiff sent a list of file sharing sites to ISPs, asking them to stop them from pirating the movie. The ISPs, unable to prevent piracy, blocked entire file sharing websites. Consequently, many users who use these sites for legitimate purposes were unable to access the sites. It is pertinent to note that in the case of **IPRS v. Mr. Badal Dhar Chowdhry**^[13], the Court held that vague/ indefinite injunctions should not be issued.

2. Jurisdiction of the defendants:

When 100 John Does are named in a single case based solely on numerical internet protocol addresses. Many of them are outside the jurisdiction of the Courts. Thus, a question may arise whether the cause of action has arisen within the jurisdiction of the Courts.

3. Joining different defendants in one suit:

Another question to be considered in such cases is whether the defendants residing in different jurisdictions can be joined as defendants in the same suit.

John Doe is still in its nascent stage in India and the concept will eventually evolve when more cases are brought before the Court. John Doe orders are always passed subject to the legitimate rights of the parties and do not affect the rights of legitimate license holders in any manner. **However, the Bombay High Court, in the recent past has taken a view that such blanket orders cannot be passed unless the Plaintiff can show actual incidents of breach or acts which are likely to result in such a breach**^[14]. Moreover the actual implementation of the orders is in itself a challenge for the Plaintiff. It is important for the judiciary to lay down the precise nature and limit of such

orders so that they are effectively implemented and/or would aid in effective enforcement of the Orders.

- By Dinesh Pednekar (Associate Partner)/ Lavin Hirani (Associate)/ Rajni Singh (Associate)

[1] Nike Canada Ltd. v. John Doe, 2 C.P.R. (4th) 501, at 503-4 (F.C.T.D.).

[2] 1980 U.S. Dist LEXIS 12841.

[3] CS(OS) No. 821/2011

[4] Order in FAO(OS) 211/2010.

[5] MANU/DE/1061/2011

[6] Order in CS(OS) No. 821/2011

[7] Order in CS(OS) No. 2352/2011 dated 21.09.2011.

[8] Order in CS(OS) No. 1724/2011 available on

http://delhihighcourt.nic.in/dhcgrydisp_o.asp?pn=135357&yr=2011

[9] Suit (L) No 993 of 2014.

[10] 2009 (39)PTC 208 (Del.).

[11] CS(OS) 3205/2014

[12] Supra.

[13] Order in CS(OS)1014/2004

[14] Notice Of Motion (L) No. 2407 Of 2014 In Suit (L) No. 1016 Of 2014

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