

'What's in a name'... John Doe arrives in India

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Intellectual property, (IP) though intangible, is probably the most important form of property today. The definition of IP has widened with the growth of international trade and globalization of economy, giving the whole business a new paradigm.¹ IP having developed into a powerful commercial asset with the ever-evolving digital technology, its theft has also become rampant. As we all know, there are two sides to a coin—development of technology with its positives has also facilitated IP infringement by unknown and unidentified entities constituting class of infringers. This necessitates the need for evolution in IP protection, which considering its nature, is no easy task.

This led to the introduction of *Anton Piller Orders*, permitting the plaintiff's counsel to enter the infringer's premises and seize evidence of infringement, prior to the institution of an action.² The Anton Piller order is a form of discovery preservation granted on an ex-parte application.³ The Indian Courts adopting the trend have granted several interim injunctions and Anton Piller orders for search and seizure in order to stop an infringer or a class of infringers from continuing unlawful activities. However, this did not address the issue of unknown infringers. This led to the adoption of 'John Doe' orders, whose origin can be traced way back to the reign of England's King Edward III, when such orders were used to refer to unidentifiable defendants⁴. Thereafter, John Doe orders were granted mainly by U.S and Canadian Courts. Recently, India has started using this unique concept under the alias "John Doe/Ashok Kumar" orders to punish class of unknown infringers.

This paper analyzes the origins of John Doe orders and their evolution and global recognition. We also look at how different jurisdictions utilize this potent weapon.

Tracing the Origins

Anton Piller injunction originated in the 1976 decision of the English Court of Appeal in *Anton Piller KG v. Manufacturing Processes Ltd.*⁵ in the form of an extraordinary equitable remedy permitting the plaintiff to search and seize the premises of the infringer with the intention of preserving the evidence that may be

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¹ IIPRD Presents One-Day Symposium on Intellectual Property Profile in Business Growth with focus on "Creation, Protection, Promotion, and Commercialization of Intellectual Property for Business Growth" available at http://iiprd.com/schedule_educational_program.html, last visited on February 9, 2012

² Daniel S. Drapeau and Michel W. Drapeau, The Taming of John Doe by Federal Courts of Canada, 17 C.I.P.R 545, [1976] 1 All E.R. 55 (C.A.)

³ Souvik Bhadra and Arka Majumdar, Anton Piller Order in UK and its possible implications in India, Journal of Intellectual Property Rights, Vol 12, September 2007, pp 488-496

⁴ What's In A Name? Merriam-Webster. 1996. ISBN 978-0877796138. available at http://en.wikipedia.org/wiki/John_Doe#cite_note-Webster1996-4 as last visited on September 22, 2011.

⁵ Supra at fn 2

destroyed.⁶ Such orders are required to be passed with extreme caution thereby necessitating full and complete disclosure by the plaintiff of all the details in the matter. However, these orders were restricted to investigating premises of known persons and did not address the wrongs committed by unknown and unidentified infringers. Across all jurisdictions, practitioners and intellectual property right holders have been faced with the daunting task of not letting the infringer go scot free. As a result to prevent infringement of intellectual property rights against unidentified (or "John Doe") defendants similar orders were passed, often referred to as "**rolling**" Anton Piller orders. The name 'John Doe' is used to identify unknown/nameless defendants/infringers, who have allegedly committed some wrong, but whose identity is unknown to the plaintiff. To avoid delay and render justice, the court names the defendant as 'John Doe', until such time the defendant is identified. The orders passed by court in such cases are thus popularly known as 'John Doe orders'. Once the defendant(s) are identified, 'John Doe' is replaced with the name of the concerned defendant, who defends the matter as in any other intellectual property infringement case. If the anonymous defendant is a female, the name 'Jane Doe' has known to be used.⁷ However, it has been a common practice in the Indian legal system, wherein such orders have been passed in the past in criminal proceedings for protection against infringement requesting initiation of search and seizure proceedings against known and unknown persons.⁸

Introduction of John Doe is merely enforcing similar reliefs in civil proceedings. Such orders reflect the positive outlook of the court to provide reliefs to the right-holders in new and different situations.⁹ Most often such orders are mistaken for being treated as search warrants but in actuality are orders enforceable against a defendant personally to allow the plaintiff to enter the premises, or face music in the form of contempt proceedings.¹⁰ John Doe orders are made when no other alternative way is left to ensure justice and means to provide immediate and effective course of action to the plaintiff.¹¹ It is interesting to note that the effectiveness, impact and implementation of such orders are yet to be seen in the Indian scenario.

John Doe is an internationally accepted practice to enforce intellectual property rights of parties and is prevalent in several foreign jurisdictions including Canada, America, Australia and UK. The order has been formalized in the United Kingdom (Civil Procedure Act of 1997), Australia (Federal Court of

⁶ John H Simpson, "Rolling" Anton Piller Order Set Aside: "John Doe" Action Dismissed, available at <http://www.slaw.ca/2010/04/26/rolling-anton-piller-order-set-aside-john-doe-action-dismissed/>, last visited on February 3, 2012

⁷ John Doe Orders, A Boon for IP protection available at <http://www.legalera.in/Front-Page/john-doe-orders-a-boon-for-ip-protection.html>, last visited on February 4, 2012

⁸ Section 93 and 94 of the Code of Criminal Procedure, 1973; Pramod Kumar Bhandari vs. State 1997CriLJ1015; Rajesh Garg vs. Tata Tea Limited & Anr. 2011(3)JCC1892

⁹ Rank Film Distributors Limited & Ors. vs. Video Information Centre & Ors. [1981] 2 W.L.R 668, per Lord Wilberforce at p 672

¹⁰ *Anton Piller KG v. Manufacturing Processes Ltd* [1976] 1 All E.R. 55 (C.A.)

¹¹ Daniel S. Drapeau and Michel W Drapeau, The taming of John Doe Orders by the Federal Court of Canada, 17 C.I.P.R , 2001 at pg 545

Australia, Practice Notes), (New Zealand Rules Committee)¹², and also in the Canadian regime. The other jurisdictions have not restricted its scope only to intellectual property but have travelled beyond it and used it in other fields of law. The next part of the paper will give a bird's eye view of the development of the concept in other jurisdictions before discussing at length about the Indian context.

- **United Kingdom**

The trend started in UK in 1975 for inspection and removal of documents with regard to alleged violation of copyright.¹³ John Doe orders are enforceable against anyone in the group constituting the class of infringers to whom the order is addressed. It is an extra-ordinary remedy passed ex-parte covering both inspection and removal of documents but with the consent of the defendant.¹⁴ The John Doe order presents the advantage of allowing a trade-mark or copyright owner to preserve evidence to be used in proceedings against infringers who can often only be identified at the time that they are seen to have counterfeit goods and who might otherwise attempt to conceal or destroy the evidence.¹⁵ The John Doe order also affords the trade-mark or copyright owner the possibility of curtailing the infringer's future activity by means of an injunction, while depriving the proposed infringer of his stock of counterfeit goods by means of a seizure of those goods. The Court of Appeals while determining the jurisdictional framework for application of such orders held that the same fell within the inherent jurisdiction of the Court.¹⁶ Further, interlocutory orders in the nature of John Doe orders were also passed in 1985 on the basis that named defendant represented class of copyright and trade-mark infringers having sufficient common interest but instead of ordering search and seizure ordered the defendants to discontinue distribution of pirated materials.¹⁷ The product being pursued in that action was counterfeit, dressed up to look like the original material of the plaintiff and knowledge of the identity of one individual defendant enabled the Court of Appeal to fashion an order which could be effective against others and, in practice, effective against others comprising the class of infringers who had very little if any connection with the plaintiff.¹⁸ The Court of Justice Chancery Division, following the same principle passed an order in *Bloomsbury Publishing Plc, JK Rowling v. Newsgroup Newspapers Limited*¹⁹ wherein an injunction was passed to enjoin the person or persons who had offered the publishers of the Sun, the Daily Mail, and Daily Mirror newspapers a copy of the book 'Harry Potter' or any part thereof and the person or persons

¹² Judicature Act 1908 No 89 (as at 01 February 2009), Public Act, Act by section, Schedule 2 High Court Rules, Part 33 Search orders, New Zealand Legislation: Acts, Consulted on May 7, 2009.

¹³ E.M.I. Limited vs. Pandit [1975] 1 W.L.R. 302

¹⁴ Supra at fn 3

¹⁵ Cullom Machine Tool & Die Inc. v. Bruce Tile Inc., 1990, and Nintendo of America, Inc. v. Coinex Video Games Inc., 1983

¹⁶ Supra at fn 11

¹⁷ E.M.I. Records Limited vs. Kudhail [1985] F.S.R 36 (C.A.)

¹⁸ ibid

¹⁹ [2003] EWHC 1087 Ch

who had physical possession of a copy of the said book or any part thereof without the consent of the plaintiff.²⁰

- **Canada**

John Doe orders are used in Canada by owners of intellectual property rights to preserve evidence against infringers.²¹ Additionally, the rise of the Internet has also brought an explosion of John Doe lawsuits. The nature of the unique orders has been summarized by *Reed J.* in *Fila Canada Inc. v. Doe*²² as follows:-

“The order, which is sought, is what is known as a “rolling” Anton Piller order. As is obvious from the style of cause, when these orders are obtained from the Court neither the identity nor the address of the persons against whom they will be executed are known. On some occasions one or two persons may be identified as named defendants but they will have no necessary connection to the Jane and John Does against whom the order will be executed. The known defendants are allegedly infringing intellectual property rights belonging to the plaintiff but in different places, at different times and in different circumstances. These “rolling” orders can be distinguished from defendant-specific Anton Piller orders. While defendant-specific Anton Piller orders may also include Jane and John Doe defendants, in general, the latter will be connected to the named defendants....”

The striking aspect in the Canadian jurisdiction is that along with development of the concept, several conditions and guidelines have been established towards its enforcement to facilitate actual implementation of the order, creating a wide sweeping pre-judgment seizure order.²³ Some exceptions have also been carved out for better implementation of John Doe orders.²⁴ It is perceived as a nuclear weapon of civil procedure²⁵ and requires highest level of scrutiny and procedural protections.²⁶ The three basic ingredients to obtain John Doe order consists of the following basic aspects²⁷:-

- the plaintiff has an **extremely strong prima facie** (*emphasis applied*) case on the merits;²⁸
- the potential or actual damage to the plaintiff relating to the defendant’s activities is “**very serious**”;

²⁰ <http://www.5rb.com/case/Bloomsbury-Publishing-Group-Ltd--v-News-Group-Newspapers-Ltd--Others>, last visited on February 6, 2012

²¹ Nike Canada Limited vs. Jane Doe (1999) 1 C.P.R (4th), 289 (F.C.T.D)

²² [1996] 3 F.C. 493 (T.D.)

²³ Prof. Jeff Berryman, Thirty Years After: Anton Piller Orders and the Supreme and Federal Courts of Canada, Vol2. Issue 3, Journal of International Commercial Law and Technology (2007)

²⁴ Nike Canada Limited vs. Jane Doe (2) (1999) 2 C.P.R (4th) 501 (F.C.T.D)

²⁵ Bank Mellat vs. Nikpour [1985] FSR 87 (CA)

²⁶ Supra at fn 7

²⁷ Ormrod L.J. in Anton Piller K.G. vs. Manufacturing process Limited [1976] Ch. 55 (C.A.)

²⁸ Rank Film Distributors Limited vs. Video Information Centre (1980) 2 All ER 273 states need for compelling evidence

- the defendant likely has in its possession incriminating evidence;
- there is a real possibility that the defendant may destroy such evidence before the discovery process

The Canadian Courts while dealing with such cases have held that merely an isolated incident is not sufficient but should provide particulars causing widespread infringement.²⁹ Such orders being extraordinary and extremely intrusive require high amount of disclosure from the applicant to prevent invasion of privacy rights.³⁰ Further, time frame has also been set-up to file such applications to demonstrate urgency in the matter.³¹ The Federal Courts in some cases have also suggested appointment of independent advisors (“*Amicus Curiae*”) to provide independent supervision and facilitate execution of such orders.³² John Doe orders passed are reviewed within 14 days to facilitate proper implementation and opportunity to the applicant to verify the documents and goods to establish infringement.

The usage and application of the orders have also been extended to certain Internet Service Providers (“ISP”) to prevent unknown customers from illegally downloading music from the internet and discussed at length in the landmark judgment of *BMG Canada Inc. vs. John Doe*.³³ The plaintiff contended that more than 1000 songs were downloaded by installing peer-to-peer applications, copying files to shared directories and using ISP services to connect home computers to the internet, leading to copyright infringement by reproduction, authorization of reproduction and distribution of unauthorized copies of sound recording. The applicant sought disclosure of names and addresses of their account holders who illegally downloaded. The Trial Court dismissed the motion and held that due to unreliability of evidence produced, the public interests in favour of disclosure did not outweigh privacy interests. This led to an appeal wherein the Federal Court acknowledged the legitimate copyright of the plaintiff and held “*that where there exists evidence of copyright infringement, privacy concerns may be met if the Court orders that the user only be identified by initials or makes a confidentiality order.*”³⁴ The Court of Appeal tilted in favour of the copyright owners³⁵ and prescribed a low threshold requirement of proving a *bonafide claim and not a prima facie case*.³⁶ *This landmark judgment has paved the way for copyright holder to identify the true identities of the internet infringers and prevents them for hiding behind pseudonyms.*³⁷

²⁹ Club Monaco Inc. vs. Woody World Discounts (1999) 2 C.P.R (4th) 435 (F.C.T.D)

³⁰ Supra at fn 22

³¹ ibid

³² India Manufacturing Limited et al. vs. Lo et al (1996) 110, F.T.R 201

³³ [2004] F.C.J. No. 525 (QL)

³⁴ Linda Wright, An overview of the BMG Case, Volume 6, No. 5, Internet and E-Commerce Law in Canada, 2005.

³⁵ Copyright Act, R.S.C, 1985.

³⁶ Canadian Private Copying Collective vs. Canadian Storage [2004] F.C.J No. 2115 FCA 424 at para 147

³⁷ Supra at fn 34

John Doe subpoenas are the primary means to enforce the rights of the intellectual property holders for litigation in the internet arena; as a result an effective standard governing them is the need of the hour.

A standard that is too weak decimates the protection of anonymity, allowing plaintiffs to “pursue . . . extra-judicial self-help remedies”³⁸ by unmasking defendants who have said nothing actionable and “simply seek revenge or retribution.”³⁹ However, anonymity should not be used by infringers as a shield of protection leaving the plaintiff without a potential defendant.⁴⁰ The Courts need to be careful while passing such orders and distinguishing between false and genuine cases and piercing the veil to unravel the truth.

- **United States**

In the United States, these orders are useful in combating bootlegging operations because the public face of the operation often changes from venue to venue.⁴¹ Applicability of such orders is not merely restricted to intellectual property regime but has been expanded to include within its realm different kinds of situations and offences. The Internal Revenue Services has also filed application seeking records from HSBC Bank, U.S.A to see accounts of persons alleged to be involved in tax evasion. The said case has been filed to ascertain that taxpayers pay taxes on foreign bank accounts.⁴² Further, with regard to ISPs, a Pennsylvania District Court held that due process should be followed and customers should be given prior notice to deal with such cases. Several amendments have been suggested to the Copyright Act thereby imposing obligations on ISPs to maintain records that would permit determining the identity of the infringer.⁴³

Suits have been instituted for bank frauds, usage of malicious software and unauthorized interception of electronic communications wherein John Doe orders have been passed and assistance is taken from Federal Bureau of Investigation (“FBI”) for execution and enforcement of orders.⁴⁴ John Doe orders have

³⁸ Doe No. 1 v. Cahill, 884 A.2d 451, 457 (Del. 2005). For a classic example of plaintiff “selfhelp,” see Kaitlin Quistgaard, Raytheon Triumphs over Yahoo Posters’ Anonymity, SALON.COM, May 24, 1999, <http://www.salon.com/tech/log/1999/05/24/raytheon/index.html>. As cited in Nathaniel Gleicher, John Doe Subpoenas: Toward a Consistent Legal Standard available at: <http://ssrn.com/abstract=1378742>, last visited on February 4, 2012.

³⁹ Cahill, 884 A.2d at 457.

⁴⁰ Scot Wilson, Comment, Corporate Criticism on the Internet: The Fine Line Between Anonymous Speech and Cybersmear, 29 PEPP. L. REV. 533, 537 (2002).

⁴¹ Civil Remedies for Copyright Infringement, available at <http://www.aph.gov.au/house/committee/laca/copyrightenforcement/chap5.pdf>, last visited on February 3, 2012

⁴² Department of Justice-Office of Public Affairs, Justice Department Asks Court to Allow IRS to Seek HSBC India Bank Account Records. April 7, 2011 available at <http://www.justice.gov/opa/pr/2011/April/11-at-439.html> last visited on February 4, 2012

⁴³ Bill C-60. An Act to amend the Copyright Act, 1st Session, 38th Parliament, 2005 as cited in Amy Min-Chee Fong, Unmasking the John Does of Cyberspace: Surveillance by Private Copyright Owners, Canadian Journal of Law and Technology, 2005.

⁴⁴ United States of America vs. John Doe (1-13) United States District Court, District of Connecticut, No. 3:11 CV 561 (VLB), April 2011

also been passed for computer intrusions, conspiracy and money laundering matters to prevent being infected from malicious software and appointment of Internet Systems Consortium as receiver to install, monitor and administer domain name servers to facilitate identifying victims of malicious software.⁴⁵ Blogging on the internet space has led to several John Doe lawsuits and comments being posted by third parties have led to legal consequences.⁴⁶

- **Australia-New Zealand**

John Doe orders have been sought in ex parte applications to the Court, but are granted only if strict requirements are met.⁴⁷ Copyright Agency Limited (“CAL”) set up in Australia are of the opinion that courts are reluctant to grant Anton Piller orders, as they turn out to be a very expensive affair.⁴⁸ The Courts grant such orders to restrain sale of pirated copyright materials as well as permitting plaintiff to seize infringing materials.⁴⁹

Justice Anderson in the case of *Tony Blair*⁵⁰ held that “*relief sought in injunction applications and in terms of Anton Piller orders are similar. ...Each involves an intrusion on privacy but is an intrusion which has been justified on the basis of the court's equitable jurisdiction can properly be extended to meet the realities of modern commercial situations. It is an ancient maxim of the law that where there is a right there is a remedy: Ubi jus ibi remedium. In circumstances were it is plain that persons are infringing proprietary interests which the law recognizes, or deceiving the public by way of trade in a manner which may indirectly affect the commercial interests of others, the law should, if it reasonably can, provide a remedy.*” Further, differentiating John and Jane Doe orders he stated that “*The fact that persons cannot be identified at this stage of the proceedings is no bar to relief against persons who may be identified at a relevant time. It is not the name but the identity and identification of the infringing persons which is relevant. The identity may not be immediately established, but persons infringing will be identified by their act of infringements. Jane Doe and John Doe will be known by their works.*”

The process of granting such orders in Australia involves surveillance and investigative and forensic activities.⁵¹ In both the jurisdictions, rolling Anton Piller orders are passed restricting the same to a specified boundary to clarify its extent whereas the Canadian Courts have granted such order combining

⁴⁵ United States of America vs. John Doe, 18 U.S.C 1956 (b) (4)

⁴⁶ Corilyn Shropshire, Blogs vs. the Law: Showdown Looms over Bloggers and Their Rights, PITT. POST-GAZETTE, Oct. 4, 2005, at D1, available at 2005 WLNR 16543937.

⁴⁷ House of Representatives Standing Committee on Legal and Constitutional Affairs, Cracking down on copycats: Enforcement of copyright in Australia, Commonwealth of Australia 2000.

⁴⁸ *ibid*

⁴⁹ *Tony Blair Pty Ltd. Vs. Splain* [1993] 3 N.Z.L.R 185 (High Ct.) and *Tony Blair Pty. Ltd. Vs. Jamison* (1993) 41 F.C.R 414 (F.C.T.D)

⁵⁰ *ibid*

⁵¹ *Supra* at fn 47

the same with Anton Piller Orders and applicable throughout the jurisdiction as part of inherent jurisdiction of the Court.⁵²

John Doe in India

The Indian Courts have not been far behind in passing such orders and initiatives have been taken in cases involving trademark, copyright infringement, personal privacy and confidential information. The Indian judiciary has taken positive steps towards development of this trend and recognizing the need for such orders to provide relief to victims/parties. The Indian Courts have since long granted interim order under Order 39 Rules 1 & 2 of the Code of Civil Procedure, 1908 (“CPC”), to protect the rights of the plaintiff and prevent possible injury. The statutes including Trademarks Act, 1999 and Geographical Indication of Goods Act, 1999 also provide for such interim orders. But under certain situations, often by the time interim orders are granted enough damage has already been caused, to address such specific situations, the common law concept of ‘John Doe/Jane Doe’ orders, recognized as ‘Ashok Kumar’ orders in India, may come to the rescue.

Anton Piller order have been passed by the Indian courts as well highlighting the significance of full and frank disclosure of the plaintiff, as well as appointment of Special Officers by Court within 14 days to provide report on the alleged illegal sale/marketing/distribution of the drawings/design and get-up similar to that of the plaintiff.⁵³ The basic principles for passing such orders have been adopted from the foreign jurisdictions however Justice Ganguly held that Anton Piller Order is primarily used for preservation of evidence.⁵⁴

The Delhi High Court (“Delhi HC”) considering the above mentioned factors and the need of the hour passed its very first John Doe order in the year 2002, in *Tej Television Limited vs. Rajan Mandal*.⁵⁵ The matter dealt with unauthorized transmission of channel (“Ten Sports”) by unlicensed cable operators without entering into agreements with marketing partners of the plaintiff. Around 1377 cable operators had taken licenses but several prominent cable operators had not signed up and broadcasted the same without any approvals. The plaintiff was the owner of the registered broadcasting rights⁵⁶ of the channel for the Soccer World Cup, 2002. The unauthorized broadcasting caused losses to the plaintiff and also strained their relationship with the other licensees.

⁵² Jeff Berryman, The Anton Piller Order-A Civil Search Warrant available at <http://www2.americanbar.org/calendar/section-of-international-law-2011-spring-meeting/Documents/Thursday/Searching%20for%20the%20Truth%20and%20Seizing%20the%20Deceitful/The%20Anton%20Piller%20Order%20%E2%80%93%20A%20Civil%20Search%20Warrant.pdf>, last visited on February 4, 2012

⁵³ *Bucyrus Europe Limited And Anr. vs Vulcan Industries Engineering* 2005 (30) PTC 279

⁵⁴ *Supra* at fn 3

⁵⁵ [2003] F.S.R 24

⁵⁶ Rights are statutorily recognized as per the provisions of Section 37 of the Copyright Act, 1957

The Court recognized the unique nature of cable piracy and it being virtually impossible to enforce such rights. Having to wait and find the specific cable operators would have led to huge losses of revenue to the plaintiff. In light of the said situation the Court exercising its inherent power under Section 151 of the CPC and in tandem with internationally recognized principles of John Doe in the other foreign jurisdictions passed a John Doe order and appointed Court Commissioner to search premises of other unnamed cable operators and seize evidence by taking photographs and video films. This judgment discussed in detail the applicability of 'John Doe' orders in various foreign jurisdictions including Canada, America, England and Australia. The action was an immediate success in curbing what might have been a total destruction of the plaintiff's IP rights.⁵⁷ The principle rests on the basic premise that as long as the litigating finger is pointed at particular person then the misnomer is not fatal.⁵⁸

The same trend has been followed in *ESPN Software vs. Tudu Enterprises*⁵⁹ wherein it was held that subscription to channels without license will be impermissible. The Plaintiff herein also claimed to be the sole and exclusive distributor of three pay channels, namely, ESPN, STAR Sports and STAR cricket Channels in India having obtained the exclusive right from ESPN STAR Sports televise in India till the year 2015 for all ICC events. Rampant piracy was indulged by the Defendants at the time of practice matches so fearing losses, the plaintiff filed for a John Doe order apprehending unauthorized cable transmission of the Plaintiff's channel leading to irreparable loss and damage including subscription loss as well as advertisement revenues. Such practices would also encourage other cable operators who have currently procured licenses from the Plaintiff and possessed valid licenses to also transmit unauthorized signals without making necessary payments thereby defeating public interest.

The application of such acts has not been restricted to the media industry alone, but as seen in other jurisdictions such orders are passed to seize counterfeit goods in possession of unknown person infringing trademark and copyright of plaintiffs. Unidentified persons indulging in manufacture and sale of counterfeit opticals under the trademark of "RAY BAN" without any prior authorization faced dire consequences in *Luxottixa Group Limited vs. Ashok Kumar*. A similar John Doe order also came in the form of restraining unidentified persons from infringing labels, packaging materials and artistic work of the plaintiff, who was engaged in sale and manufacture of cigarettes.⁶⁰

⁵⁷ Transnational enforcement of intellectual property rights – Indian judiciary - Indian cases and suggestions for further strengthening the intellectual property rights

⁵⁸ Canadian judgments -Jackson v. Bubels, 28 (1972) D.L.T. 500 (B.C.C.A.) and Dukoff v. Toronto General Hospital (1986) 54 O.R.50 (H.C.) as quoted in Taj Television Ltd. and Ors. v. Rajan Mandal and Ors. in C.S. (O.S) No. 1072/2002 and referred in *ESPN Software India Private Limited vs. Tudu Enterprise CS (OS) 384/2011* .

⁵⁹ CS (OS) 384/2011.

⁶⁰ *Ardath Tobacco Company Limited vs. Mr. Munna Bhai & Ors.*, 2009(39)PTC208(Del).

John Doe -Prevention is better than cure

Indian judiciary has woken up to the situation and realized that in several situations such orders need to be passed even prior to the infringement having taken place to restrain threatened or imminent wrongful acts, in the form of *Quia Timet* injunctions. The jurisprudence has developed through a series of judgments in India pertaining to the media industry involving copyright violations and defamation through blogging on the internet space as well as trademark infringements. The scope and usage of John Doe orders in India has not extended beyond intellectual property violations as till date most people are unaware of its existence though the same was already provided in our criminal legislations for protection of intellectual property infringement.⁶¹ Creating widespread awareness about the positive effects of such orders is essential to maximize its usage and curtail the wrongful acts of the infringers.

Quia Timet injunctions in the recent past have been given prior to release of several new movies to prevent sale of pirate copies and illegal copying/distribution/ broadcast of new films/songs by cable operators and other unauthorized persons. The Delhi HC has been the most pro-active in creating awareness and passing such unique orders in case of movies like *Singham*, *Bodyguard* and *Speedy Singhs*, *Don 2* granting ad-interim ex-parte injunction for production houses like Reliance, Viacom 18 Motion Pictures against a number of cable operators and unknown persons from copyright infringement.

- **Media Industry**

In *Singham* case⁶², though no actual infringement had taken place, apprehending copies of movie being made and sold/distributed in the form of DVDs/CDs in the market and/or shown on TV by cable operators, interim applications were filed for injunction to prevent piracy and loss of revenue to the plaintiff. In this case, the Delhi High Court on plaintiff establishing three basic ingredients of prima facie case, imminent danger, and balance of convenience passed John Doe order restraining all defendants and other unknown persons constituting part of the same class from distributing, displaying, duplicating, uploading, downloading or exhibiting the movie in any manner. Eventually, several Indian ISP's were contacted to block access to several file sharing websites. Thus, John Doe orders are becoming quite common in the film industry and seem to be an effective way to curb piracy.

The trend is not restricted to only movies but as was initiated in *Tej Television*⁶³, cases involving broadcasting/using unauthorized signals for downloading/telecasting purposes during the Indian Premier League (IPL) cricket tournament have also come before the Delhi HC in the case of *Satellite Singapore PTE Ltd. vs. Star Cable Network & Ors.*⁶⁴ John Doe orders have been passed to protect the rights of the

⁶¹ Section 93 and 94 of the Code of Criminal Procedure, 1973

⁶² I.A. No. 11242/2011 in CS(OS) No. 1724/2011

⁶³ Supra at fn 55

⁶⁴ [F.A.O. (OS) 211/2010]

applicant who held the exclusive broadcasting rights for IPL matches in India. Search and seizure orders were passed for appointment of Commissioner to check premises for ascertaining illegal transmission/downloading of IP match signals, during the hours when IPL matches were telecasted.

- **Software-ISPs domain**

India has also not been far behind in tracking Internet Service Providers (“ISPs”) to prevent unwanted and unlawful materials from being shown or written on internet by anonymous bloggers or illegal downloading following the path paved by other jurisdictions. Recently, Reliance obtained John Doe order from the Delhi HC to prevent pirated copies of movie Don 2 from being sold/downloaded/distributed. However, the said order seems to have been misused as Reliance resorted to blocking several file-sharing websites though the said websites were accessible on networks of other ISPs. The said act has caused enough uproar as only Department of Information Technology is entitled to block websites. Blocking of websites without sufficient proof that the users were indulging in piracy is similar to shutting down a public library from access to general public.⁶⁵ But the issue remains whether Reliance was the concerned intermediary as it was not the entity hosting the content. This leads to the debatable issue about liability of intermediaries and the ISPs.

The issue was initially highlighted in the case of *IFCI Limited*⁶⁶ which involved posting of derogatory remarks/ write ups on Google, Facebook and Twitter by using blogs/URL and emails. John Doe order was passed directing the unidentified defendants from blocking the sites/blogs and ascertaining the actual users/persons creating URL/IP addresses. Thereafter, the Delhi HC in the recent judgment of *Super Cassettes Industries vs. Myspace Inc. & Anr.*⁶⁷ held that social networking sites (“SNS”) such as YouTube, Myspace etc. may be held liable for copyright infringement caused due to infringing material posted on such websites, provided it may be established that intermediaries had control over the material posted, had the opportunity to exercise due diligence in preventing infringement and derived profits out of such infringing activities in consonance with Section 79 of the Information Technology Act read with Information Technology (Intermediaries guidelines) Rules, 2011.

Conclusion

The Indian Courts are moving in the right direction but at the same time need to ensure that the entire purpose of such orders is not defeated or misused. While exercising its inherent jurisdiction under the

⁶⁵ Blocking website in India: Reliance Communications shows it is very easy, available at http://articles.timesofindia.indiatimes.com/2011-12-24/internet/30554592_1_block-websites-reliance-communications-reliance-entertainment, last visited on January 13, 2012.

⁶⁶ CS(OS) 2696/2011

⁶⁷ [MIPR2011(2)303]

provisions of CPC, the Delhi High Court in *The Indian Performing Right vs. Mr. Badal Dhar Chowdhry*⁶⁸, held that vague injunctions may not be issued and categorically stated that “*vague injunction can be an abuse of the process of the court and such vague and general injunction of anticipatory nature can never be granted*”. Scope and extent of such orders need to be categorically stated to avoid any sort of misuse.

Usage of John Doe orders in Indian scenario has brought in awareness and protection to holders of IP rights but the question remains how such orders will be implemented and enforced. The issue before us is if the unidentified defendants are unaware of such orders or unwilling to abide by the Court order and continue with the said infringement, is any remedy left with the plaintiff or the entire process of obtaining such orders go waste leaving the plaintiff without any benefit and losing its entire impact. Appointment of Commissioners for search and seizure, new guidelines for curbing copyright infringement are all modes of effectuating John Doe orders. But still the notion seems to be at nascent stage with handful of orders being passed and still very few people knowing about its usage and application. An effective mechanism needs to be set into motion to address implementation of such extreme orders, by way of communicating the same to the proposed infringers through a proper mode and their compliance to receive the desired reliefs. John Doe has miles to go in achieving its very purpose.

⁶⁸ CS(OS)1014/2004

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