

The development of john doe law equity essay

Law



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-Aditya Pratap Singh & Niket Anand[1]Introduction" Copyright is the Cinderella of the law. Her rich old sisters, Franchises and Patents, long crowded her into the chimney-corner. Suddenly the fairy grandmother, Invention, endowed her with mechanical and electrical devices as magical as the pumpkins coach and the mice footmen. Now she whirls through the mad mazes of a glamorous ball".[2]Intellectual Property (IP) is designed to create incentives for research and development (R&D) investments by granting inventors exclusive rights to their innovations for a fixed period of time. [3]Intellectual Property are the sparkling assets, they are the spark plugs that give thunderous start and bring the investments in monetary, fixed and intangible assets to profitable life, which otherwise could well remain sleepy. [4]Intellectual Property can mean the difference between success and failure in business today.[5]Companies need to be aware of the legal implications at each stage of the Intellectual Property life cycle.[6]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.[7]The evolution of the Internet has placed burden on outmoded intellectual property defences such as copyright and patent. [8]Some forms of information, when made available on the Internet,[9]are easily copied. Because the costs of copying are low and because copying is often anonymous, publishers have often responded with more aggressive enforcement of existing intellectual property rights and with calls for extensions of those rights to cover additional content, new media and new forms of access.[10]In the present picture rampant piracy and unlawful use of intellectual property has led to the evolvment of John Doe /Ashok Kumar orders[11]. A John Doe order defines a court injunction that is issued against <https://assignbuster.com/the-development-of-john-doe-law-equity-essay/>

unknown offenders i. e. an injunction granted by courts when a breach of the rights of the Plaintiff is committed or is likely to be committed,[12]by a person who cannot be identified by the Plaintiff at the time of filing of suit.

[13]The name " John Doe" is used to pinpoint anonymous/unidentified defendants/infringers, who have allegedly committed some wrong, but whose identity is unidentified to the plaintiff. A John Doe order can be passed against unknown unauthorized persons enabling the plaintiff to serve the order upon such persons when their identity is disclosed. Different countries use different fictional names,[14]which is generally the most common name in that country, to describe the anonymous person to be named as the defendant. In India, such orders are known as Ashok Kumar orders.[15]To curb the calculated, conscious, and predetermined infringement of

intellectual property, courts of different Jurisdictions have come out with John Doe orders providing immediate relief to Intellectual Property Right (IPR) holders. Origin & Development of John DoeThe adoption of John Doe orders, whose origin can be traced way back to the reign of England's King Edward III[16], when such orders were used to refer to unidentifiable defendants 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 destroyed.[17]However, these orders were restricted to inspecting properties of identified persons and did not address the wrongs committed by anonymous and unidentified infringers.

[18]Once the defendant(s) are identified, " John Doe" is substituted with the name of the identified defendant, who defends the matter as in any other intellectual property infringement case. If the unidentified defendant is a female, the name " Jane Doe" has known to be used[19]. The John Doe order

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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.

[20]Essentially, a John Doe/Anton Piller order is an order from a court ordering an infringer[21]to let the plaintiff's solicitor search his premises and deliver up to him evidence of infringement of the rights of the plaintiff.

[22]This device has been judicially described as " the nuclear weapons of civil litigator".[23]The order has also been characterized as potentially draconian in effect[24]. The central purpose is protection & preservation of the subject matter of the cause of action e. g. pirated tapes and

documentary evidence such as client lists (in cases of restraint of trade clause breaches), customers supplied (in video piracy) etc.[25]United Kingdom- A Brief History/ Development of John DoeIn 1975 Hugh Laddie, (later to become Justice before his death in 2008), argued before the Court of Queen's Bench in the United Kingdom for an ex parte order for inspection and removal of documents which allegedly violated the plaintiff's copyright.

[26]Without much observance or elaboration the Anton Piller order was launched. Dockray and Thomas report points out that on average 500 orders per year were made between the years 1975-80. However, this frequency dropped in the 90's to about 50 orders per year, although that frequency may have increased in recent years.[27]It was only in the landmark case of Anton Pillar KG v Manufacturing Process[28], that it gained recognition and popularity. In Anton Pillar KG v Manufacturing Process[29], Lord Denning and Lord Ormord laid down both substantive standards for granting the order and service requirements accompanying the order and thus laid the foundations,
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over which subsequent cases have developed the law. After differentiating the order from search order, Lord Denning took shelter in *United Company of Merchants of England, Trading to East Indies v Kynaston*[30], where Lord Redesdale said that the impugned order in that case 'is an order operating on the person requiring defendants to permit inspection, not giving authority of force, or to break down the doors of their warehouse' and held that there is justification to make an order compelling defendant to permit plaintiff to inspect, if justice so demands. After this case, there have been a number of instances where Anton Piller order was sought and granted. In fact, in *Systematica Ltd v London Computer Center Ltd and Idnani*[31], Whitford J warned against 'rather too free a use of being made of Anton Piller order by the plaintiffs'. Canada Unfolding 'Rolling Anton Pillar' OrderSpeed is of the essence of Anton Piller order.[32]If there is a delay, or if advance warning is given, the assets may well be removed before the injunction can bite.

[33]The reason of existence of the Anton Piller order has been the safeguarding of evidence rather than the seizure of infringing property, despite the dominance of cases of the latter type predominating before most Commonwealth courts. Of the latter type, the Federal Court of Canada has developed an exclusive and very effective order known as a "Rolling Anton Piller Order". An applicant, alleging in one part of the country that it is facing pervasive violation of its intellectual properties by anonymous persons, has been efficacious in gaining an Anton Piller order that can be validly executed throughout the land. The nature of the order has been summarized by Reed J. in *Fila Canada Inc. v. Doe*[34]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

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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, for example, by being an employee of the defendant or a supplier of the alleged counterfeit goods of the defendant. The "rolling" orders are executed against street vendors and transient flea markets vendors although they are framed in broad enough terms to encompass the search of retail premises, office premises, vehicles, warehouses, as well as residences. They are usually expressed to last a year subject to being renewed. Procedural Requirements of John doe/Anton Piller Once the order has been issued by Court followed with search and seizure, aggrieved party is mandated to submit its report to the court at a date stated in the order, and generally within 14 days of execution. It is required that plaintiff should add the known defendant to the pleading and request the court for an interlocutory order effective until trial. In a case when defendant did not allow the plaintiff to search and seize the evidence in his /her premise than a show cause hearing should be moved by the plaintiff. Also, realizing the misuse of Anton Piller order Federal Court has laid down the specific protection on its granting. Brightman J. in Anton Piller KG observed: "Otherwise," he said, "it seems to me that an order on the lines sought might

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become an instrument of oppression, particularly in a case where a plaintiff of big standing and deep pocket is ranged against a small man who is alleged on the evidence of one side only to have infringed the plaintiffs' rights." [35] Additional procedural protections mentioned by Federal court while issuing the Anton Piller are as follows: The court should be given adequate time to review the motion and supporting documentation. In an action that is being brought against unknown parties and that has been continuing for some time there is no particular reason for the plaintiff to claim urgency. [36] The plaintiff should provide evidence of numerous and widespread infringement. The supporting affidavit evidence should show the geographical extent of the infringement so that the order can be drawn to cover a particular area or the entire country. [37] A rolling order should not authorize execution against an unnamed party occupying residential premises. [38] Before granting a rolling order it is desirable that the plaintiff provides specific instances of infringement against a named defendant. In this way it is hoped that the validity of the plaintiff's substantive legal claim to hold intellectual property rights will be tested. [39] This factor is also a concern to the fact that the granting of an Anton Piller order is made in less than ideal conditions, although Canadian courts have accepted that the plaintiff must demonstrate at an extremely strong prima facie level that the plaintiff has a legal right and that it is being infringed. [40] These procedures are more or less followed in every jurisdiction. Substantive requirements for John Doe order In Anton Piller KG v. Manufacturing Process [41], Lord Ormond and Lord Denning enumerated four prerequisites for the making of an Anton Piller order. These are A strong prima facie case against the defendant. The court in Rank Film Distributors Ltd v. Video Information Centre [42], referred <https://assignbuster.com/the-development-of-john-doe-law-equity-essay/>

to clear and compelling evidence and a very strong prima facie case. However, in *Yousuf v. Salama*[43], the court required only to prove that there is a prima facie case[44]. That the potential or actual damage done to the plaintiff by the defendant is serious, however, since only the plaintiff's evidence is taken and the defendant is not given a chance to contest the appeal, there remains serious doubts over the viability of this requirement. In fact, Scott J in *Columbia Picture Industries v. Robinson*[45] emphatically remarked that the plaintiff solicitor cannot be expected to present the available evidence from the respondent's point of view. Clear evidence that the defendant has relevant and incriminating documents or item in his possession, and that there is a real possibility that the defendant would destroy such material before any inter parties application can be made. This can be achieved by "full and frank disclosure" by the plaintiffs. Scot J in *Columbia Picture Industries v. Robinson*, quoted with approval the observation of Whitford J, in the *Jeffrey Rogers Knitwear Productions Ltd v. Vinola Knitwear Manufacturing Co*[46], that any plaintiff seeking an Anton Piller order, must place before the court all the relevant information that points to the probability that in the absence of such an order material would be destroyed. However in *Brink's MAT Ltd v. Elcombe*[47] and others, it was held that the decision to set the order for non-disclosure is discretionary and will not always be exercised. However, In *Digital Equipment Corp v. Darkcrest Ltd*[48], it was held that the plaintiffs do not owe any duty for full and frank disclosure to the defendants, but to the court. Should an order be made, it would do no real harm to the defendant or his case. However the chief proponent of this requirement, Lord Denning, was himself not ready to give it much weightage, as was evident from his statement in *Yousuf v.*

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Salama[49], where he remarked ' The Anton Piller order can do no harm to the defendant at all. If he is honest, he will produce the documents in any case. If he is dishonest, that is all more reason why the order should be made'. India- Ashok Kumar orders

Over the past several decades there has been an growing attentiveness globally and within India of the significance of ' knowledge civilisations' which, in disparity to earlier industrial or agrarian societies, influence ' information' as the key raw material and output of a range of prolific action. As one UNESCO Report puts it " Knowledge is today recognized as the object of huge economic, political and cultural stakes"[50].

In this new epitome, investment in Information and Communications Technology (ICT), the execution of robust Intellectual Property laws, and their determined enforcement are recommended as imperative in facilitating the transition away from the older economic modes. The anticipation of the knowledge society is particularly appealing for developing countries, like India, where it is viewed as a vehicle for achieving accelerative growth through which we would be able to transcend our " historical disabilities", and achieve parity with the incumbent masters of the world.[51]

Lord Denning had once said " You may call this " forum shopping" if you please, but if the forum is England, it is a good place to shop in both for the quality of the goods and the speed of service".[52]

Such commendation is seldom, if ever, heard in the framework of the Indian judiciary, particularly from foreign intellectual property (IP) owners who continually quench about the enormous complications and difficulties that they encounter in enforcing their rights before Indian Courts. The boom of IPR coupled with the aspiration to protect these rights have motivated India Courts for passing such orders and initiatives in cases involving trademark, copyright infringement, personal

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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"[53]orders in India, may come to the rescue. Anton Piller orders have been passed by the Indian courts as well highlighting the significance of full and frank disclosure of the plaintiff. [54]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.[55]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 v. Rajan Mandal.[56]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 rights[57]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. The <https://assignbuster.com/the-development-of-john-doe-law-equity-essay/>

Court accepted the unique nature of cable piracy and it being effectively impossible to enforce such rights. Having to wait and find the specific cable operators would have led to enormous loss of revenue to the plaintiff. In light of the said situation the Court exercising its inherent power under Section 151 of the CPC[58]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.[59]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.[60]The same trend has been followed in ESPN Software v. Tudu Enterprises[61]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

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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 v. Ashok Kumar*.^[62] 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.^[63] Precaution 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^[64]. The jurisprudence has advanced over a sequence of verdicts in India concerning to the media industry involving copyright violations and defamation through blogging on the internet space as well as trademark infringements.^[65] 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^[66]. 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 <https://assignbuster.com/the-development-of-john-doe-law-equity-essay/>

other unauthorized persons. The Delhi HC has been the most upbeat in generating consciousness and passing such exclusive orders in case of movies like Singham,[67]Bodyguard[68]and Speedy Singhs, Don 2[69]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. In Singham case[70]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.[71]Thus, John Doe orders are becoming quite communal in the film industry and seem to be an efficacious way to check piracy.[72]The tendency is not limited to only movies but as was introduced in Tej Television[73]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. v. Star Cable Network & Ors[74]John Doe orders have been passed to protect the rights of the applicant who held the exclusive broadcasting rights for IPL matches in India. Search and seizure orders were passed for appointment of Commissioner to <https://assignbuster.com/the-development-of-john-doe-law-equity-essay/>

check premises for ascertaining illegal transmission/downloading of IP match signals, during the hours when IPL matches were telecasted. Software-ISPs domain[75]India has also not been far behind in tracking Internet Service Providers ("ISPs") to prevent undesirable and illegitimate resources from being publicized or written on internet by anonymous bloggers or illegal transferring 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.[76]The said act has caused enough uproar as only Department of Information Technology is entitled to block websites. [77]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[78]. 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. [79]The issue was initially highlighted in the case of IFCI limited[80]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 v. Myspace Inc. & Anr[81]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

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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[82]read with Information Technology (Intermediaries guidelines) Rules, 2011. ConclusionThe Indian Courts are poignant in the accurate path but at the same time need to ensure that the tenacity of such orders is not whitewashed or misused. While exercising its inherent jurisdiction under the provisions of CPC, the Delhi High Court in The Indian Performing Right v. Mr. Badal Dhar Chowdhry[83]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. Convention of John Doe orders in Indian scenario has brought in cognizance 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 anonymous 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 procedure of procuring 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.