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IN THE HIGH COURT OF DELHI AT NEW DELHI

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CS (COMM) 223/2016

TATA SKY LTD.

..... Petitioner

Through: Mr. Rajiv Nayar, Senior Advocate with
Mr. Rishi Agrawala, Ms. Niyati Kohli,
Mr. Aavishkar Singhvi and Ms. Nadia Rafiq,
Advocates.

versus

YOUTUBE LLC & ORS.

..... Respondents

Through: Mr. Arvind Nigam, Senior Advocate
with Mr. Neel Mason, Mr. Ankit Relan and
Ms. Karnika Bansal, Advocates for Defendant
No.1.

Ms. Mamta R. Jha, Advocate for Defendant No.2.

CORAM: JUSTICE S. MURALIDHAR

ORDER

10.08.2016

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IA No. 48/2016 (seeking deletion of Defendant No. 2 from array of parties)

1. This is an application by Defendant No. 2 Google India Pvt. Ltd. ('GIPL') seeking its deletion from the array of parties. The only reason why GIPL appears to have been made a party in the suit is that Defendant No. 1 YouTube LLC itself does not have an office in India.

2. Considering that Defendant No. 1 has participated in these proceedings, and is not disputing the jurisdiction of this Court, and with Defendant No. 1

having already complied with the interim injunction issued on 27th August 2015, the Court sees no reason why Defendant No. 2 should continue to be arrayed as a party to the suit.

3. The application is accordingly allowed and Defendant No. 2 is deleted from the array of parties.

IA No. 353/2016 (under Order XXXIX Rule 4 CPC)

4. In view of the above order in I. A. No. 48 of 2016, this application does not survive and is disposed of as such.

IA Nos. 17808/2015 (under Order XXXIX Rules 1 and 2 CPC) & 26085/2015 (under Order XXXIX Rule 4 CPC)

5. The interim injunction granted by this Court on 27th August 2015 in IA No. 17808 of 2015 filed by the Plaintiff Tata Sky Ltd. ("Tata Sky") restrained the Defendants (which included YouTube LLC Defendant No. 1) "from using the trade mark 'TATA SKY' in any manner directly or indirectly in any of their websites including posts, messages, discussions, forums, blogs or any other form of electronic media, without written authorization of the plaintiff, and to remove any material whereby it is sought to prove any methodology or trick to hack into the system of the plaintiff or to access the plaintiffs services". The Defendants were further directed to remove the video clips "how to watch HD channels free in TATA SKY Trick" or "Hack tata sky for free exclusive" from their websites.

6. Since then YouTube LLC has taken down from its websites the URLs of the offending video against which the Plaintiff's complaint was directed.

7. It is pointed out by Mr. Arvind Nigam, learned Senior Advocate appearing for YouTube LLC, that there was no question of YouTube LLC itself violating the trademark 'Tata Sky' since it is not the author of any of those offensive videos which have been uploaded on its websites. He points out that in any event YouTube LLC has removed the offending URLs from its website. He affirms to the Court that those URLs will not hereafter be permitted to continue on the website of YouTube LLC. He also assures the Court that if there is any further complaint of a similar nature by the Plaintiff, YouTube LLC will not be found wanting in responding immediately to take down any such similar offensive material consistent with the interim injunction issued by the Court on 27th August 2015. In the circumstances, YouTube LLC is in IA No. 26085 of 2015 seeking variation of the order dated 27th August 2015 to vacate the injunction as far as YouTube LLC is concerned while allowing it to continue as a 'John Doe' order *qua* unknown offenders.

8. Mr Nigam added that it was Tata Sky which led YouTube LLC to believe that Tata Sky owned the copyright over the encryption in the STBs, which it obviously did not, and YouTube LLC cannot be faulted for suggesting that a complaint for copyright violation ought to be filed by Tata Sky. He pointed out that Tata Sky in its complaint dated 1st July 2015 alleged circumvention of technological measures which was an offence under Section 65A of the Copyright Act, 1957. The suit was ultimately framed as one for a trademark violation and had Tata Sky not been unclear about the kind of violation that had taken place, YouTube LLC may have acted even more promptly than it did to take down the offending material from its website.

9. Mr. Rajiv Nayar, learned Senior Advocate appearing for Tata Sky pointed out that there was an unacceptable delay in YouTube LLC responding to Tata Sky's complaint to it about the offending video which virtually sought to teach the public how to hack Tata Sky's set top boxes (STBs) which were encrypted, thereby enabling free viewership of TV channels/contents which were otherwise available only to subscribers. He referred to Rule 3 (2) (d) and (e) and Rule 3 (4) of the Information Technology (Intermediaries Guidelines) Rules 2011 ('ITIG Rules') and submitted that YouTube LLC was obliged to act with promptitude once it was clear that the offending videos were illegal inasmuch as that Tata Sky's STBs could be hacked into through simple steps. He referred to the order of the Supreme Court in ***Sabu Mathew George v. Union of India 2016 SCC OnLine SC 681*** in which it was observed that the intermediaries there "cannot put anything that violates the laws of this country."

10. Mr Nayar urged that the policy developed by YouTube LLC was inadequate to deal with the type of difficulty faced by Tata Sky. He submitted that in the categories of complaints provided on You Tube LLC's website, Tata Sky had checked the box which said: "Other legal issue". Although in the e-mail sent on 1st July 2015 Tata Sky stated that the videos "provide a way to circumvent technological measures adopted by Tata Sky in their STBs to their subscribers" the offending videos were clearly described as seeking "to suggest false and illegal methods to access television content for free by breaking the encryption" on the STBs of Tata Sky. According to Mr Nayar it was You Tube LLC which characterised this as a copyright violation in the first place, and then failed to act promptly, thus

compelling Tata Sky to approach this Court for relief.

11. The above submissions have been considered. To recapitulate the background facts, this suit brought forth by Tata Sky was occasioned by a video uploaded on the website of YouTube LLC which sought to impart to the general public the method of hacking into Tata Sky's STBs. Basically, the video was attempting to show how the encryption code on the STBs could be broken into and the television channel contents viewed for free without subscribing to Tata Sky.

12. Tata Sky on coming across the said video made a complaint to YouTube LLC on 31st December 2014. The relevant extract of the said complaint are as under:

"2. We bring to your notice that there is a video on the Youtube website at 'https://www.youtube.com/watch?v=VC2zhLavDQk' giving step by step instructions on possible hacking of Tata Sky HD Set Top Box to receive High Definition ('HD') content, free of cost. This is illegal and violative of Tata Sky rights and the rights of the broadcasters who own the HD content broadcast through Tata Sky Platform, whose rights Tata Sky is bound to protect. Please be advised that this is an offence under Section 66 of the Information Technology Act, 2000 read with Section 107 and 109 of the Indian Penal Code.

9. Therefore, you are required to immediately remove the illegal from your servers/website with all due speed, no later than 36 hours of receipt of this notice in terms of sub-section 4 of Section 3 of the Information Technology (Intermediaries Guidelines) Rules 2011."

13. On 8th January 2015, YouTube LLC replied to Tata Sky as under:

"Hello,

Thank you for your message.

We have reviewed your request and have determined that a takedown notice under Section 512(c) of the DMCA is not appropriate for this type of complaint.

Instead, please consider submitting a complaint for other legal issues (including alleged circumvention of technological measures).” (emphasis in original)

14. Thereafter, Tata Sky through its counsel lodged the following complaint on 1st July 2015 on YouTube LLC's website:

"Law info: THEVIDEOS PROVIDE AWAY TO CIRCUMVENT TECHNOLOGICAL MEASURES ADOPTED BY TATASKY IN THEIR SET TOP BOXES TO THEIR SUBSCRIBERS

Violation detail: TATASKY is in the business of providing Direct to Home (hereinafter referred to as "DTH") services to its subscribers within the territory of India through its DTH platform "Tata Sky". The above videos seek to suggest false and illegal methods to access television content for free by breaking the encryption on settop boxes of TATASKY. The Delhi High Court in Suit No Cs (OS) 1225 of 2015 has restrained this kind of activity by Passing an Order against forumfuns.com on 1st May 2015."

15. On the same day YouTube LLC responded as under:

"Hi there,

It appears you are concerned about the circumvention of measures that control access to your copyright protected work. In order to take action, we require a more detailed description of the alleged violation.

Please answer some or all of the following questions:

1. What is the copyright protected work at issue?

2. Please describe the software or other technical measure that you believe protects your copyrighted material and how it works.
3. What is depicted at this URL that you believe circumvents the protection you described above? How does that circumvention work?
4. Where does the violation you're Reporting Appear at the URL (S) at issue? Please give timestamps in the video, if applicable.

Please understand that the video (s) in question will remain live on YouTube until you have provided us with this information. Thank you for your cooperation."

16. Thus YouTube LLC viewed the said complaint as one of copyright violation since it was about 'circumvention of measures'. The Plaintiff replied to the above questions by an email of 7th July 2015. On 8th July 2015, YouTube wrote to the Plaintiff suggesting that it should file a copyright complaint if it believed that it had copyright of the content in question. Thereafter present suit was filed with the specific prayer of injunction Youtube LLC from allowing unauthorised use of trademark 'Tata Sky 'and also from posting, screening or providing any audio or video material which seeks to provide or inform any methodology to hack into the Tata Sky system.

17. An order of granting an interim injunction was passed by this Court on 27th August 2015. YouTube has complied with the said order and has removed the offending URLs.

18. The 'Community Guidelines' put out by YouTube regarding content that ought not to be uploaded on its website read as under:

“Nudity or sexual content

YouTube is not for pornography or sexually explicit content. If this describes your video, even if it's a video of yourself, don't post it on YouTube. Also, be advised that we work closely with law enforcement and we report child exploitation.

Violent or graphic content

It's not okay to post violent or gory content that's primarily intended to be shocking, sensational, or disrespectful. If posting graphic content in a news or documentary context, please be mindful to provide enough information to help people understand what's going on in the video. Don't encourage others to commit specific acts of violence.

Hateful content

Our products are platforms for free expression. But we don't support content that promotes or condones violence against individuals or groups based on race or ethnic origin, religion, disability, gender, age, nationality, veteran status, or sexual orientation/gender identity, or whose primary purpose is inciting hatred on the basis of these core characteristics. This can be a delicate balancing act, but if the primary purpose is to attack a protected group, the content crosses the line.

Spam, misleading metadata, and scams

Everyone hates spam. Don't create misleading descriptions, tags, titles, or thumbnails in order to increase views. It's not okay to post large amounts of untargeted, unwanted or repetitive content, including comments and private messages.

Harmful or dangerous content

Don't post Videos that encourage others to do things that might cause them to get badly hurt, especially kids. Videos showing such harmful or dangerous acts may get age-restricted or removed depending on their severity.

Copyright

Respect copyright. Only upload videos that you made or that you're authorized to use. This means don't upload videos you didn't make, or use content in your videos that someone else owns the copyright to, such as music tracks, snippets of copyrighted programs, or videos made by other users, without necessary authorizations. Visit our Copyright Center for more information.

Threats

Things like predatory behaviour, stalking, threats, harassment, intimidation, Invading privacy, revealing other people's personal information, and inciting others to commit violent acts or to violate the Terms of Use are taken very seriously. Anyone caught doing these things may be permanently banned from YouTube.”

19. The procedure for lodging a complaint has been explained by YouTube in its written statement as under:

- (i) YouTube provides viewers with an option to report any video by simply clicking on the "Report" option, which is provided below every video available on YouTube.
- (ii) By clicking the said "Report" link, a viewer is presented with a list of likely issues he may have against the video, out of which the user can simply check and report his specific grievance against the video. This list includes issues such as spam, copyright infringement, trade mark infringement, misleading content etc. and also gives an option of reporting 'other legal issues' which includes issues such as circumvention of technological measures etc.

(iii) In addition to the aforesaid "Report" video option, a user can also report any issue by filling a simple 'complaint form' on YouTube, which is available on its website.

(iv) Upon clicking the relevant category to which the complaint may relate to, the complainant is directed to specific grievance forms relevant to each category.

20. YouTube's defence is on the following lines:

(a) Being an intermediary under the IT Act, is statutorily exempt under Section 79 from liability in respect of any third party video uploaded on the YouTube platform.

(ii) The impugned links were created/uploaded/made available by third party users on YouTube and not by YouTube itself. Under Section 11 of the IT Act, an electronic record sent by an originator or even a person acting on his behalf, is attributed to the originator alone and not the platform provider.

(iii) The reliefs as prayed for, if allowed, would impose an unfair burden on YouTube to sift through and filter millions of videos available on YouTube belonging to third parties and decide whether such videos are infringing the trademark, copyright or other proprietary rights of the Plaintiff. This would be contrary to the letter and spirit of Section 79 of the IT Act which requires an intermediary to be "content neutral" to any video/content uploaded on its

website and simply follow a "notice and takedown" or a "receive and react" mechanism in relation to any complaint.

21. In the present case neither Tata Sky nor YouTube appear to have been clear, in the first instance, whether the complaint pertained to a trademark or a copyright infringement or to some other legal issue. The correspondence exchanged between them reflects this confusion. However, there could be complaints regarding some material on the website of YouTube which by their very nature require it to act immediately without insisting on the Complainant having to clearly demonstrate that the complaint falls within one or the other category that YouTube has identified for the purposes of acting on such complaints.

22. The Community Guidelines are meant to guide a person uploading content on what should not be uploaded. It is understandable that with the huge volume of uploads it is not practical for YouTube to be viewing each upload in order to decide whether it is objectionable from the point of view of its Community Guidelines. However, when a specific instance of possible violation is drawn to its attention, its review team will have to view the content and take a call on whether it requires to be taken down. The response time as well as the response itself are both critical for a complainant. In the present case Tata Sky's specific complaint was that the video was "giving step by step instructions on possible hacking" of its STBs in order to receive to receive High Definition content, free of cost. Tata Sky pointed out that this was violative of its rights and of broadcasters who own the HD content broadcast through Tata Sky Platform and was an offence

under Section 66 of the IT Act. In terms of Rule 3 (1) (e) of the ITIG, YouTube is obliged not to host content that violates any law for the time being in force. In determining it to be a complaint regarding 'circumvention of technological measures' which is defined as an offence under Section 65 A of the Copyright Act, YouTube's review team appears to have got into a bind about correctly 'categorising' it instead of actually taking a call on whether the nature of the content required taking down. If it had focused on the latter aspect the need for Tata Sky to have approached this Court for relief could have been avoided.

23. To be fair to Mr Nigam, he did say that there are certain types of content, and he flagged child pornography as an instance, where YouTube would not get into the exercise of first 'categorising' the complaint before proceeding to take down the content. In other words, the very nature of the content would warrant immediate action even though the Complainant may not have correctly categorised the complaint. He further stated that every Court order is an occasion for YouTube to review its policy and strengthen it further.

24. With the URLs of the offending video in the instant case having been taken down by YouTube, and with its statement that those URLs will not hereafter be permitted to continue on the website of YouTube LLC, the interim injunction granted by the Court has worked itself out as far as YouTube is concerned. It is clarified that the said injunction order was directed at it not because YouTube had violated any trademark of Tata Sky but because its website hosted the offending URLs which required to be taken down. It was for that purpose alone that YouTube was a necessary and

proper party without whose compliance the injunction order would have not been able to be implemented. With YouTube assuring that if there is any further complaint of a similar nature by the Plaintiff, YouTube LLC will not be found wanting in responding immediately to take down any such similar offensive material consistent with the interim injunction issued by the Court on 27th August 2015, the Court does not consider it necessary to dwell on the issue further. The interim injunction is made absolute against all other 'unknown' defendants.

25. Mr. Nayar, learned Senior counsel appearing for the Plaintiff states that the Plaintiff does not wish to seek any further reliefs in the suit and that it can be disposed of in terms of the above order.

26. The suit and the pending applications are accordingly disposed of.

27. The date already fixed before the Joint Registrar for 16th September 2016 stands cancelled.

AUGUST 10, 2016
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S. MURALIDHAR, J