

Client Alert

October 2018

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Singapore High Court grants "dynamic" site-blocking injunction in largest ever site-blocking action - *Disney Enterprises, Inc. & Others v M1 Ltd & Others* [2018] SGHC 206

Facts

The Plaintiffs are owners of various copyrights subsisting in movies and TV shows (the "**Copyrighted Subject-Matter**"). The Plaintiffs applied for a site-blocking order under Section 193DDA(1) of the Singapore *Copyright Act* (Cap. 63) (the "**Act**"), for the Defendant network service providers to take reasonable steps to disable access to Flagrantly Infringing Online Locations ("**FIOLs**") consisting of 53 piracy websites.

The Plaintiffs sought two types of orders:

- (i) for the Defendants to take reasonable steps to disable access by its subscribers to a list of Uniform Resource Locators ("**URLs**"), IP addresses and domain names (the "**Fully Qualified Domain Names**" ("**FQDNs**")) which were being used to enable or facilitate access to the FIOLs (the "**Main Injunction**"); and
- (ii) an order requiring the Defendants to block new FQDNs discovered subsequent to the granting of the Main Injunction, which provided access to the same FIOLs that were the subject of the Main Injunction (the "**Dynamic Injunction**").

Decision

The High Court granted the blocking orders sought.

(a) Locus standi and procedural requirements

Under Section 193DDA of the Act, an application for a site-blocking order may only be brought by the owner or exclusive licensee of copyright in a material.

The High Court held that pursuant to section 130 of the Act, the Plaintiffs were presumed to be the owners of the copyright in respect of the Copyrighted Subject-Matter, given that the Defendants had not put in question the subsistence or ownership of the copyright therein. The Plaintiffs therefore had the requisite standing to bring the application.

In addition, the Plaintiffs satisfied the notice and service requirements under section 193DDB of the Act.

(b) Whether the 53 websites were FIOLs

The High Court observed that the term "*online location*" is not expressly defined in the Act, and is intended to be amorphous in order to accommodate advancements in technology.

In holding that the 53 websites were "*flagrantly infringing*" online locations, the High Court considered the following factors, in accordance with section 193DDA(2) of the Act:





- (i) the primary purpose of the websites was to commit or facilitate copyright infringement by providing access to a large library of films without the authorisation of the copyright owners;
- (ii) the websites facilitated easy access to the films by containing indexes of the films;
- (iii) the owners of the websites demonstrated a disregard for copyright generally, given the extent of infringement and the owners' failure to comply with the take-down notices issued by the Plaintiffs;
- (iv) a number of the websites had been blocked in other jurisdictions;
- (v) some of the websites contained instructions on circumventing measures to disable access; and
- (vi) the volume of traffic at the websites was significant.

(c) *Whether the orders sought were reasonable steps to disable access to the FIOs*

In making an order under section 193DDA of the Act, the High Court is to consider the following factors under section 193DB(3):

- (i) the harm that has been or may foreseeably be caused to the plaintiff;
- (ii) the burden that the making of the order will place on the network service provider;
- (iii) the technical feasibility of complying with the order;
- (iv) the effectiveness of the order;
- (v) any possible adverse effect on the business or operations of the network service provider;
- (vi) whether some other comparatively effective order would be less burdensome; and
- (vii) all other matters which it considers relevant.

(d) *The Main Injunction*

The High Court was satisfied that the factors under section 193DB(3) of the Act supported the granting of the Main Injunction, which was necessary to mitigate further harm caused to the Plaintiffs and provided for technically feasible blocking methods that would not be excessively burdensome on the Defendants.

(e) *The Dynamic Injunction*

The High Court first considered if it had the jurisdiction to issue the Dynamic Injunction. In this regard, the High Court observed that section 193DDA of the Act was worded broadly and did not expressly preclude the order issued from taking the form of the Dynamic Injunction.

In this regard, the High Court highlighted that the Dynamic Injunction would merely require the Defendants to block new means of accessing the same infringing websites, rather than blocking new infringing websites that had not been included in the Main Injunction.



Notably, the High Court clarified that section 193DDC of the Act - which provides for the variation or revocation of an order under section 193DDA - did not preclude the court from issuing a Dynamic Injunction.

The High Court found that the factors under section 193DB(3) of the Act supported the granting of the Dynamic Injunction:

- (i) the Dynamic Injunction was necessary to ensure that the Main Injunction operated effectively to reduce further harm to the Plaintiffs, in light of the ease and speed at which the FIOLO owners may take measures to evade the Main Injunction;
- (ii) the Dynamic Injunction could potentially reduce the burden on the Defendants, by obviating the need for them to return to court to respond to the Plaintiffs' application for variation of the Main Injunction each time a new FQDN resolving to the same FIOLOs arises; and
- (iii) the Plaintiffs would need to notify the Defendants of the new FQDNs and show in their affidavit that the new FQDNs provide access to the same FIOLOs which are the subject of the Main Injunction, before the Defendants would be required to block the new FQDNs. The Defendants would not be required to do so if they are of the view that the grounds for disabling access provided by the Plaintiffs are insufficient.

In arriving at its decision, the High Court endorsed the position of the UK Courts (where Dynamic Injunctions have likewise been permitted) and declined to follow the approach of the Federal Court of Australia, which has required parties to apply to court to vary the original site-blocking order in response to any circumventive measures taken by the FIOLO owners.

Comments

This case is significant as it represents the largest ever site-blocking action in Singapore, in respect of the number of FIOLOs subjected to the blocking orders, and marks the first time that a Dynamic Injunction has been granted in Singapore.

The High Court's decision embodies a timely victory for rights holders in their battle against online piracy, as they may now seek an injunction to combat and keep pace with the increasingly frequent circumventive measures taken by infringers.

At the same time, the decision strikes an important balance by ensuring that network service providers and site-owners have recourse in the event of a dispute as to whether the new FQDNs resolve to the same FIOLOs already ordered blocked.

In addition, the judgment usefully clarifies that the variation provision under section 193DDC of the Act does not preclude the High Court from granting a Dynamic Injunction.

Ultimately, the High Court's ruling should encourage more rights holders to utilise the statutory site-blocking framework to protect their interests. It remains to be seen if the decision will in fact give rise to an increase in site-blocking applications in this jurisdiction.

Baker & McKenzie.Wong & Leow acted for the Plaintiffs in this matter.

A copy of the High Court's judgment may be accessed [here](#).

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