
JAGRAN PRAKASHAN LTD. V. TELEGRAM FZ LLC & ORS., CS(COMM) 146/2020 & I.A. 4073/2020

Shelly, Bennett University

1. BACKGROUND OF THE CASE

Right to Internet as enriched under Article 21 of the Indian Constitution, provides us with information with the click of a button but along with it, it brings various rights and threats in the business media. Soon after government of India declared nation-wide lockdown, various sectors all around the globe suffered massively. The trademark and copyright infringement were one such sector that became a vexing activity which started to affect the commercial rights of various publication houses. In fact, it is an instinct in social media users to share viral information as soon as they come across any astounding fact, without even getting into finding the reality. Similar happened in the recent news that sparked among the media because of the very reason that the conflicting parties are one of the leading heads in their respective fields of information commission. While one being a prominent newspaper publishing house named 'Dainik Jagran', popular for its Hindi newspaper, other being an emerging messaging and voice over IP service named 'Telegram'.

At the most challenging time, when no industry was left that were not facing the consequences were spared, newspaper companies too lost their users. As soon as the world shifted from offline to online mode, there emerged a need to strike a balance between safety of persons with that of flow of information. The publishing houses shifted towards use of softcopy availability of their services so that they do not lose their market credibility and goodwill in such challenging times. In the present case, the plaintiff reported that the defendants were sharing their material in PDF forms on their social media through unidentified users and therefore they alleged defendants to have infringed their trademark and copyright along with financial losses. Hence, the plaintiff seeks to claim injunctive relief from the Delhi High Court against the defendants.

2. FACTS OF THE CASE

The popular Hindi newspaper named “Dainik Jagran” is one of the leading newspapers in India that is well-known for its dual service of providing both softcopies as well as hardcopies of its newspaper throughout the country. Its domain i.e., www.jagran.com is the place accessible to its users for free of cost, however to access the digital format of the newspaper and get it downloaded in a digital format, it requires certain subscription as per the terms and conditions set forth. However, due to pandemic, the readers are not charged with any subscription from the plaintiff, though a sum of dollar 1 is charged from users residing in other countries. This is done to ensure that the users of Dainik Jagran are barred from downloading any content freely available on the website. To sum up, plaintiff holds ownership over the “Dainik Jagran” as its trademark and its several other variants.

On the other hand, the Dubai based IP company named, Telegram FZ LLC, is the defendant number one that basically provides the facility of instant messaging and exchange of voice over IP service. Defendant number one is alleged to have granted access to its users over the e-newspapers of plaintiff, through unidentified users over creation of various channels. While the defendant number two, who are the users of defendant number one, is alleged to have created the following channels IDs:

t.me/D_Jagran, t.me/dainik_jagran_jnm, t.me/dainik_jagranhindi, t.me/dainik_jagran, t.me/Fainik_Jagran_News, t.me/dainikja, t.me/DainikJagran_pdf.

The plaintiff claims that the above-mentioned channels are places where its e-papers are supplied to its users daily. In addition, the users can not only access these newspapers from these channels but can also download all the current as well as previous editions. Since the plaintiff as subscription requirement, and the facility of download is available only to the paid subscribers of the plaintiff, the defendant’s action has caused huge financial loss to the plaintiff. Apart from financial loss, the plaintiff places contention that the defendants with the help of each other are involved in adopting, reproducing, disseminating, and transmitting the e-newspapers, that has resulted in infringement of copyright and trademark of the plaintiff along with the financial ramifications. Subsequently, the plaintiff served notice to the defendants for the same and also served several reminders, to which no response came, therefore, the plaintiff moved the court of law for seeking justice.

While approaching to the court of law, the plaintiff puts reliance on the Section 79 of the Information Technology Act read along with Rule 3 sub-rule 4 of the Information Technology

(Intermediaries Guidelines Rule 2011 to put forward that the defendants despite due reminders, failed to exercise with due diligence and therefore, they cannot escape from the liability mentioned in the intermediary guidelines. In addition, they also asked the defendants to pull down all its channels within a period of 36 hours, but the defendants failed to do that as well. Thus, in lieu of the loss and infringement caused to plaintiff's ownership over copyright and trademark, the plaintiff seeks to get an interim injunction from the Delhi High Court against the defendants under Order 39 Rule 1 and Rule 2 of the Code of Civil Procedures, 1908 to restrain the other party from further infringement of intellectual property rights.

3. ISSUE

Whether defendant's act of sharing e-newspaper of plaintiff in PDF format, through unidentified users, amounts to infringement of copyright and trademark?

4. JUDGEMENT

The judgment of the present case notes the plaintiff to have a prima facie case in its favour as the balance of convenience lies in the favour of the plaintiff. The decision of the court therefore is the grant of interim injunction as per Order 39 Rule and Rule 2 of the Code of Civil Procedure, 1908 against the defendants. In addition, the court also directs the defendant to block its channels within a period of 36 hours as ascribed under Section 79 read with Rule 3(3) of the Information Technology Act because despite several reminders the defendant is said to have obtained knowledge from the plaintiff and therefore defendants are obliged to disable its channels and information within 36 hours of receiving the information.

5. ANALYSIS

We all must have anticipated commencement of end number of challenges be it whatever sector running in the world as soon as the nation-wide lockdown was announced. The dual loss of revenue along with terms of work to the industries has resulted in loss of large number of users of their services. The supply of physical newspapers created a fear of spread of the virus, because of which physical suppliers resorted towards e-newspaper accessibility for its users. Recently, it was held by one of the publications running in our country, that the sharing of e-content through pdfs on social media applications is an illegal practice and the admins along with sharers can be held for the unauthorized circulation of such content. The newspaper companies therefore have the right to impose penalties on such individuals and if necessary,

resort to legal actions as well for such illegality. This debatable issue emerged when the country was facing mass sharing of e-newspaper through social messaging applications that lead to violations of intellectual property rights and huge financial loss to publication houses because of the subscription requirements.

Almost every publication provides for “Terms of Use” policies on their official websites which is literally is contractual obligation that makes it legally binding on its users or subscribers, and every other stakeholder. In fact, whenever anyone opens such official website, such person is bound to accept the “I Accept” option that makes them bound of terms of its usage. Usually, this practice is common with a little variance and puts an obligation on the person accepting to not resort to circulation of e-copies of the material available for personal use. For example, one of the terms of an English newspaper states “Any individual accepting terms & conditions mentioned is not authorized to copy, republish, reproduce, post, download, broadcast for make generally available to the public: or alter, adapt, deviate any of the material without the prior written permission.” Thus, agreeing to such terms automatically puts a contractual obligation on e-newspapers circulation and becomes a matter of unfair dealing.

In the case of *Bennett Coleman & Others v. Ajay Kumar & Others*¹, where the plaintiff filed a suit against the defendant who were downloading e-newspaper copies of the Times of India & Economic Times and therefore claimed an interim injunction against them. The court passed an interim order against the defendants to prevent a website (www.sscias.com) from downloading such e-copies as defendants were the owners of the mentioned website which is an educational site for the students. The judgment of this landmark case of *Bennett Coleman* enjoins the defendants from unauthorized copying of the e-newspapers by stating that it amounts to an unlawful gain that might result into huge financial loss along with severe harms to a leading holder.

As per Section 52 of the Copyright Act, which is in consensus with Article 13 of the TRIPS Agreement, claims members to confine certain limitations to its exclusive rights that do not conflict with legitimate interest of the right holders. As Indian courts in various instances found that although such circulation of e-newspapers results in loss in number of visitors on news sites but at the same time large number of visitors to publication’s websites might result in more market potential & subscribers for the future. Talking about the infringement, section 52(a) of the Copyright Act lays down certain exceptions to the infringement of copyright which

¹ CS COMM 21 of 2019, Jan. 16, 2019

is also termed as fair dealing. The act does not define the term “fair dealing” however, it has been a matter of court’s interpretation in various cases, for instance, in the case of *Hubbard v. Vosper*², Lord denning states “fair dealing” to be a term that is not possible to define and therefore it must be a question of degree whether firstly, one needs to take into account the extent and number of the extracts & quotations, thereafter, one must consider the use that is made of them and lastly consider the proportions.

It has become a norm to be aware of one’s rights along with one’s liabilities. There is no doubt about the genuineness of copyright and trademark ownership of Dainik Jagran’s as the terms & conditions clearly stipulates it. The bar on users is only with respect to downloading the content directly or indirectly and not with respect to downloading or printing of extracts of such content for non-commercial use. Hence, there is a possibility that dissemination of information by Telegram via its variants of channels is done with malicious intent because such practice is done through unidentified users and as a creator, it can create various channels with only a telegram link along with username.³ . In addition, a complaint of infringement of intellectual property rights on a public channel is dealt & entertained only in situation where such a request is made by the owner of an authorized agent of such copyright and accessed individually before any necessary action.⁴ However, such is not a mandatory in the Information Technology (Intermediaries Guidelines) Rules, 2011. As per these guidelines, one can take a suo-moto cognizance of such copyright infringement matters.⁵

Thus, although there is no copyright over a information, fact or news, but an e-paper is a subscription based service which is not directly or generally available in the public domain which means that such have been granted protection under copyright and trademark laws. In fact, the president of Indian Newspaper Society, Mr. Shailesh Gupta said that the circulation of pdfs of e-newspapers which are subscription-based results in digital piracy and financial loss. In addition, it also results in misuse of such information and hence, there is no bar imposition by any media houses on circulation of pdfs of e-newspapers with are available at free of cost.

² 1972 2 Q.B. 84

³ Telegram - Channels FAQ https://telegram.org/faq_channels; accessed on June 4, 2020.

⁴ Telegram FAQ; <https://telegram.org/faq#q-there-39s-illegal-content-on-telegram-how-do-i-take-it-down>; accessed on June 04, 2020.

⁵ Rule 3(4) of the Information Technology (Intermediaries Guidelines) Rules, 2011
; <https://www.wipo.int/edocs/lexdocs/laws/en/in/in099en.pdf>; accessed on June 04, 2020

6. CONCLUSION

The diversity in the era of social media calls for stringent checks on its content posted to ensure strict measures with respect to the liability of administrators. The present situation of Covid, calls for e-supply of content which also includes fake sources from which these emerge. The reliability over e-content is therefore one of the most debatable issue at present in not just our country but in the mainstream world as well. The decision in the present case as announced by Justice Mukta Gupta is a wonderful decision that aims to curb the social media challenges and protects the intellectual property rights. The decision places a critical time for the Media Houses and social media handlers to be extremely careful before entering into such unauthorized practices.

As per Article 11 of the WIPO Copyright Treaty (1996), the state's member is obliged to adopt technological measures to protect the owners of copyright. Such measures or tools are designed in such an innovative way that protects from unauthorized access or use of digital work. The technological protection measures include passwords, cryptographic locks, digital signatures, and other security locks which gives imperative solutions to enhance protection of content with the use of advanced programs. In the end, there is a need for awareness of intellectual property rights among the users so that they do not end up involved in any kind of illegal activity without permission, that would invite legal action against them. Also, the six litmus principles as set forth in the landmark case on copyright infringement i.e., *R.G. Anand v. Delux Films*⁶, must be adhere thereto.

Overall, the case provides for some interesting understanding of the substantial as well as procedural provision of the intellectual property rights available to an owner of copyright & trademark. The challenge extends to the government, media houses and even entities that sometimes puts into question the fundamental right to speech and expression as envisioned under Article 19(1)(a) of the Indian Constitution. Today, piracy is favoured by many creators as it brings a sense of curiosity in its users, however, digital piracy remains to threaten the exclusive rights of creators. Thus, the decision of the present case, is a commendable initiative taken to protect the intangible rights along with pecuniary interests.

⁶ AIR 1978 SC 1613