

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2018] SGHC 206

Originating Summons No 95 of 2018

In the matter of section
193DDA of the Copyright Act
(Cap. 63)

Between

- (1) Disney Enterprises, Inc.
- (2) Twentieth Century Fox Film Corporation
- (3) Paramount Pictures Corporation
- (4) Columbia Pictures Industries, Inc.
- (5) Universal City Studios Productions LLLP
- (6) Warner Bros. Entertainment Inc.

... Plaintiffs

And

- (1) M1 Limited
- (2) M1 Net Ltd
- (3) MyRepublic Limited
- (4) Singnet Pte Ltd
- (5) Singtel Mobile Singapore Pte Ltd
- (6) Starhub Internet Pte Ltd
- (7) Starhub Mobile Pte Ltd
- (8) Starhub Online Pte Ltd
- (9) ViewQwest Pte Ltd

... Defendants

GROUNDS OF DECISION

[Copyright] — [Remedies] — [Blocking orders]

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Disney Enterprises, Inc and Others

v

M1 Ltd and others

[2018] SGHC 206

High Court — Originating Summons No 95 of 2018

Lee Siu Kin J

26 April, 12 July 2018

19 September 2018

Lee Siu Kin J:

Introduction

1 The plaintiffs are owners of various copyrights subsisting in numerous cinematograph films. In originating summons no 95 of 2018, the plaintiffs sought blocking orders pursuant to s 193DDA of the Copyright Act (Cap 63, 2006 Rev Ed) (“Copyright Act”), which would require the defendant network service providers to take reasonable steps to block its subscribers’ access to certain websites which infringe or facilitate infringement of copyright. After hearing the submissions of the parties, I granted the blocking orders sought.

Background

2 The plaintiffs are engaged in the creation, distribution, licensing and marketing of theatrical motion pictures, television programming and other related products. The plaintiffs own various copyrights subsisting in numerous

films (“the Subject Films”) including the subtitles of these films.¹

3 The defendants are network service providers engaged in the business of providing telecommunications services. The defendants are the major internet service providers in Singapore.²

4 The plaintiffs’ application concerned 53 online locations which provided public access to a collection of films, including the Subject Films, without the requisite consent or licences from the plaintiffs. The 53 online locations were websites which were in turn accessible via Fully Qualified Domain Names (“FQDNs”).³ An FQDN is a domain name, a uniform resource locator (“URL”) and/or an internet protocol address (“IP address”) which can access an online location, including a website.⁴ Domain name, URL and IP address have the following meanings:⁵

(a) Domain name:

(i) A “domain name” is a name formed by the rules and procedures of the “Domain Name System” (“DNS”), which is the system for naming computer servers and other resources connected to the Internet.

(ii) A “primary domain name” is the domain name a user request resolves to when requesting a website. A “redirect domain name” is a domain name which resolves to the primary

¹ Affidavit of Oliver James Walsh dated 19 January 2018 (“Affidavit of OJW”) at paras 15–16; Plaintiffs’ written submissions dated 26 March 2018 (“PWS”) at paras 21–25.

² Affidavit of OJW at para 17.

³ Affidavit of Michael Kwan Yuk Kwan dated 8 June 2018 (“Affidavit of MKYK”) at para 10.

⁴ Affidavit of MKYK at para 7(l).

⁵ Affidavit of MKYK at paras 7(d)–(k).

domain name when the user requests it. For example, where a user keys in the redirect domain name “xmovies8.es” into a search engine, the user is redirected to “xmovies8.nu” which is the primary domain name for the website “xmovies8”.

(b) URL: A URL is the entire address used to fetch a resource from an online location. An example of a URL is “https://xmovies8.es”.

(c) IP address: An IP address is a unique string of numbers that identifies a computer and enables a computer to communicate with another computer via the Internet. A computer requires an IP address to ensure that data sent over the Internet reaches its intended destination.

5 The plaintiffs sought two types of orders. First, the plaintiffs sought an order for the defendants to take reasonable steps to disable access by its subscribers to a list of FQDNs which were being used to enable or facilitate access to the 53 websites (“the main injunction”). The plaintiffs submitted that the 53 websites were “Flagrantly Infringing Online Locations” (“FIOLs”), in that they were being used to flagrantly commit or facilitate infringement of copyright in materials. The order sought in relation to the main injunction read, in material parts:

1. ... [T]hat the Defendants shall, within 15 working days of the date of the Order of Court to be made herein ("this Order"), take reasonable steps to disable access primarily by its residential subscribers and customers to Fully Qualified Domain Names ("FQDNs") which have been used to enable or facilitate access to the Flagrantly Infringing Online Location(s) ("FIOL"), as referred to in the Schedule to this application. Such reasonable steps shall include utilising technical means such as Domain Name System ("DNS") blocking, Uniform Resource Locator ("URL") filtering, or IP address blocking, as may be determined by the Defendants at their discretion, provided that such technical means shall be no less efficacious than the current steps as at the date of this Order each such Defendant would

have taken in relation to any "online location" under section 20(1) of the Remote Gambling Act 2014 (Act 34 of 2014).

2. ... [T]hat the owner(s) of the FIOL who claim to be affected by this Order is/are to have liberty to apply to vary or revoke this Order insofar as it affects such applicant(s), any such application to be on notice to all the parties and to be supported by materials setting out and justifying the grounds for the application. Any such application shall clearly indicate with the support of evidence the status of the applicant(s) and that it/they is/are the owner(s) of any FIOL which is the subject of such application, and be made on fourteen (14) days' notice to the Plaintiffs and the Defendants.

...

6 Second, the plaintiffs sought an order that would require the defendants to block new FQDNs not presently listed in the plaintiffs' schedule which are subsequently discovered to provide access to the *same* FIOLs that are the subject of the main injunction, upon receiving notification from the plaintiffs ("the dynamic injunction"). It was proposed that under the dynamic injunction, the plaintiffs would provide notification to the defendants by serving an affidavit on the defendants (and filing it in court) which will identify the additional FQDNs and provide reasons why the FIOLs accessible from the additional FQDNs are the same FIOLs which have been blocked in the main injunction. The order sought in relation to the dynamic injunction read:

3. ... [T]hat the Plaintiffs may from time to time notify the Defendants in writing of FQDNs which include one or more additional Domain Name(s), URL(s), and/or IP Address(es) via which a FIOL which was referred to in the Schedule to this Order is accessible (the "Additional Domain Name(s), URL(s) and/or IP Address(es)"), and provide an affidavit to the Defendants and the Court which identifies the Additional Domain Name(s), URL(s) and/or IP Address(es) and states the reasons the FIOL accessible from the Additional Domain Name(s), URL(s) or IP Address(es) is the same FIOL which is identified in the Schedule to this Order and the subject of these orders. The Defendants shall within 15 working days of the notification take reasonable steps (as set out at paragraph 1 of this Order) to disable access primarily by its residential subscribers and customers to the FIOL through the Additional Domain Name(s), URL(s) and/or IP Address(es).

The dynamic injunction was sought by the plaintiffs in the light of the potential for measures to be taken by owners of the FIOs to circumvent the main injunction, such as by changing the domain name, URL and/or IP address for the FIO.

The parties' submissions

7 The plaintiffs submitted that the procedural and substantive requirements for an order under s 193DDA of the Copyright Act were satisfied.

8 The plaintiffs submitted that they had the standing, being the owners of the copyright in the Subject Films, to bring the application.⁶ They had also fulfilled the notice requirements under s 193DDB(1)(a) read with s 193DDB(3) of the Copyright Act by sending take-down notices to the owners of 41 out of 53 of the FIOs, and in respect of the remaining 12 FIOs, undertaking all reasonable efforts to send take-down notices to the owners.⁷ Likewise, the plaintiffs had also fulfilled the notice requirement under s 193DDB(1)(b) of the Copyright Act by informing the defendants of their intention to apply for an order under s 193DDA.⁸ The notice and service requirements for the application under s 193DDB(2) of the Copyright Act were also fulfilled.⁹

9 The plaintiffs further submitted that it had adduced sufficient evidence to demonstrate that the 53 websites were FIOs, given that, amongst others, the primary purpose of the websites was to commit or facilitate copyright infringement. This was evident from the fact that searches for cinematograph films on the 53 websites disclosed a large number of page results, and a

⁶ PWS at paras 21–25.

⁷ PWS at paras 26–36.

⁸ PWS at paras 37–38.

⁹ PWS at paras 39–46.

significant number of the Subject Films were made accessible through the websites without the consent or authorisation of the respective copyright owners.¹⁰

10 In addition, according to the plaintiffs, the factors set out under s 193DB(3) of the Copyright Act, which the court may have regard to in determining if an order under s 193DDA should be granted, weighed in favour of the granting of the orders. It was submitted that the main injunction was necessary to prevent further harm to the plaintiffs and also would not impose an undue burden on the defendants.¹¹ The dynamic injunction was in turn necessary to ensure the continued effectiveness of the main injunction, given the tendency for owners of FIOLs to take circumventive actions to evade site-blocking orders issued by the courts.¹²

11 In relation to the dynamic injunction sought, the plaintiffs further submitted that the court had the jurisdiction under the Copyright Act to grant the injunction, and that the injunction was consistent with the legislative purpose of s 193DDA of the Copyright Act which is to disable access to the FIOL.¹³ According to the plaintiffs, the dynamic injunction also would not impose an undue burden on the defendants.¹⁴

12 The defendants did not raise any objections to the plaintiffs' application.

My decision

¹⁰ PWS at paras 53–59.

¹¹ PWS at paras 73–77.

¹² PWS at paras 79–81.

¹³ Plaintiffs' supplemental written submissions dated 22 June 2018 ("PSWS") at paras 23–30; PWS at paras 82–84.

¹⁴ PSWS at paras 31–33; PWS at paras 85–87.

13 After hearing the submissions of the parties at the hearing on 26 April 2018, I granted the main injunction. In relation to the dynamic injunction, I requested further submissions to be filed by the plaintiffs.

14 Upon hearing further submissions on 12 July 2018, I granted the dynamic injunction but on modified terms, in particular, to include a proviso in the order sought by the plaintiffs.

15 That the various legal requirements for the main injunction were met was relatively uncontroversial and straightforward in the light of the evidence. The main issue in this case was therefore whether the dynamic injunction sought by the plaintiffs could be granted under the framework of the existing legislation and if so, if the dynamic injunction ought to be granted. The ensuing analysis will therefore consider the following issues, with an emphasis on (d):

- (a) *locus standi* and procedural requirements;
- (b) whether the online locations were FIOs;
- (c) whether the defendants' services were being used to access the FIOs; and
- (d) whether the orders sought were reasonable steps to disable access to the FIOs.

Analysis

16 The central legislative provision in this application was s 193DDA of the Copyright Act. Section 193DDA empowers the High Court to order network service providers to take reasonable steps to disable access to a FIO. The provision reads:

Order to disable access to flagrantly infringing online location

193DDA.—(1) Where the High Court is satisfied, on an application made by the owner or exclusive licensee of copyright in a material against a network service provider, that —

(a) the services of the network service provider have been or are being used to access an online location, which is the subject of the application, to commit or facilitate infringement of copyright in that material; and

(b) the online location is a flagrantly infringing online location,

the High Court may, after having regard to the factors referred to in section 193DB(3), make an order requiring the network service provider to take reasonable steps to disable access to the flagrantly infringing online location.

...

Locus standi and procedural requirements

17 Pursuant to s 193DDA(1) of the Copyright Act, an application for a site-blocking order may only be brought by “the owner or exclusive licensee of copyright in a material”. Under s 130 of the Copyright Act, copyright is presumed to subsist in the work in question and the plaintiff is presumed to be the owner of such copyright where subsistence and ownership of the copyright are not challenged by the defendant:

Presumptions as to subsistence and ownership of copyright

130.—(1) In an action brought by virtue of this Part —

(a) copyright shall be presumed to subsist in the work or other subject-matter to which the action relates if the defendant does not put in issue the question whether copyright subsists in the work or other subject-matter; and

(b) where the subsistence of the copyright is established—the plaintiff shall be presumed to be the owner of the copyright if he claims to be the owner of the copyright and the defendant does not put in issue the question of his ownership.

As neither subsistence nor ownership of the copyright in the Subject Films were put in question by the defendants, the plaintiffs were presumed to be the owners of the copyright in respect of the Subject Films. I was therefore satisfied that the plaintiffs had the requisite *locus standi* to bring the application.

18 The notice and service requirements for an order under s 193DDA of the Copyright Act are set out under s 193DDB. In brief, this provision requires the plaintiff to inform the owner of the online location of its intention to apply for an order under s 193DDA if the owner fails to comply with its take-down notice within a prescribed period. Following the end of the prescribed period, the plaintiff must also send a notice to the defendant network service provider stating its intention to apply for the order. I was satisfied based on the evidence adduced by the plaintiffs that the notice requirements were satisfied in the present case as there were reasonable efforts to identify the owners of the 53 online locations and to notify them as well as the defendants of these proceedings. The service requirements were also met.

Whether the online locations were FIOLs

19 The term “online location” is not expressly defined in the Copyright Act. That said, a “flagrantly infringing online location”, *ie*, a FIOL, is defined under s 193A of the Copyright Act as:

an online location which is determined by the High Court under section 193DDA to have been or is being used to *flagrantly commit or facilitate infringement of copyright in materials*;

[emphasis added]

In addition, pursuant to s 83 read with s 103(1) of the Copyright Act, infringement of copyright in a cinematograph film takes place where a person who, not being the copyright owner, and without the licence of the copyright owner, makes a copy of the film or communicates the film to the public. Further,

under s 26(1) read with s 31(1) of the Copyright Act, the copyright in subtitles would be infringed where a person who, not being the copyright owner, and without the licence of the copyright owner, reproduces in material form the said subtitles.

20 The definition of a FIOL is intended to be, to some extent, imprecise and amorphous in order to accommodate advancements in technology. At the second reading of the Copyright (Amendment) Bill (No 16 of 2014), the then Senior Minister of State for Law, Ms Indranee Rajah, SC stated in relation to the definition of a FIOL that:¹⁵

The Bill keeps the definition of ‘flagrantly infringing online location’ technically neutral. This is to accommodate rapid technological advances over time.

A similar position is taken in the Explanatory Memorandum to the Australian Copyright Amendment (Online Infringement) Bill 2015:¹⁶

The term ‘online location’ is intentionally broad and includes, but is not limited to, a website, and would also accommodate future technologies.

21 As alluded to earlier at [4] above, in relation to the plaintiffs’ application, the alleged 53 FIOLs were websites.¹⁷ These websites were in turn accessible via FQDNs which the plaintiffs sought to block in the orders applied for.

¹⁵ Plaintiffs’ supplemental bundle of authorities dated 22 June 2018 (“PSBOA”) at Tab 7, p 54.

¹⁶ PSBOA at Tab 6, p 44.

¹⁷ Affidavit of MKYK at para 10.

22 Pursuant to s 193DDA(2) of the Copyright Act, in determining if an online location is a “flagrantly infringing” online location, the court must consider all of the following matters:

- (a) whether the primary purpose of the online location is to commit or facilitate copyright infringement;
- (b) whether the online location makes available or contains directories, indexes or categories of the means to commit or facilitate copyright infringement;
- (c) whether the owner or operator of the online location demonstrates a disregard for copyright generally;
- (d) whether access to the online location has been disabled by orders from any court of another country or territory on the ground of or related to copyright infringement;
- (e) whether the online location contains guides or instructions to circumvent measures, or any order of any court, that disables access to the online location on the ground of or related to copyright infringement; and
- (f) the volume of traffic at or frequency of access to the online location.

23 I was satisfied based on a consideration of all of the factors listed under s 193DDA(2) that the 53 websites were FIOs. Hence, the requirement under s 193DDA(1)(b) was met.

24 All of the 53 websites were one of the following:¹⁸

(a) A linking target website: a website that contains an index of hyperlinks to copyrighted films which redirects the end-user to the hyperlinked site, *ie*, the host site in order to stream the content. A linking target online location facilitates the user's making of a copy (via downloading) and the host site's making available of the film (via streaming) and thereby facilitates the user's and host site's infringement of the copyright in the films.

(b) A streaming target website: a website which allows end-users to directly stream copyrighted content. These sites directly make available the films to the public and thereby both infringe and facilitate infringement of copyright.

(c) A Peer-to-Peer target website: an internet network which allows a group of computer users with the same networking programme to connect with each other and directly access files from each other's hard drive without connecting through a central server. These websites therefore enable users to download films from other users of the networks and correspondingly facilitate infringement of copyright.

(d) A subtitle target website: a website which provides links for users to download copyrighted subtitles. Such websites facilitate the user's reproduction in material form of the subtitles and thereby facilitate the user's infringement of the copyright in the subtitles.

25 The plaintiffs adduced sufficient evidence that the main purpose of all
53 websites was to commit or facilitate copyright infringement by showing, *inter alia*, that the websites provided access to a large library of films, including the Subject Films, without the authorisation of the owners of the copyright.

¹⁸ Affidavit of OJW at paras 4–13.

Screenshots were adduced by the plaintiffs showing successful attempts to search for and view the relevant subtitles and/or cinematograph films via the 53 websites.¹⁹ In addition, the websites were designed to facilitate easy access to cinematograph films, including the Subject Films, in breach of the copyright in those films. They contained indexes of the films, which were categorised including by quality, genre, viewership and ratings.²⁰

26 I was also satisfied that the operators of the websites demonstrated a disregard for copyright generally by virtue of the extent of the copyright infringement, and non-compliance with the take-down notices issued by the plaintiffs.²¹ Instructions to circumvent measures taken to disable access were also found on a number of these websites, as evidenced by screenshots of posts on these websites, which show the owner or operator of the websites informing users of a change of domain name for the websites.²²

27 There was also evidence that a number of the websites had been blocked in other jurisdictions.²³

28 Evidence was also adduced from a company which provides traffic data to show that the volume of traffic at the websites in question was significant.²⁴

29 I was thus satisfied that the 53 online locations were FIOs and correspondingly that the requirement under s 193DDA(1)(b) of the Copyright Act was met.

¹⁹ Affidavit of OJW at paras 21–24 and OW-4.

²⁰ Affidavit of OJW at para 28 and OW-7.

²¹ Affidavit of OJW at paras 31–33.

²² Affidavit of OJW at para 52 and OW-15.

²³ Affidavit of OJW at para 50 and OW-14.

²⁴ Affidavit of OJW at paras 53–55, OW-16 and OW-17.

Whether the defendants’ services were being used to access the FIOs

30 There was also evidence adduced, which the defendants did not dispute, that the defendants’ services were being used to access the 53 FIOs.²⁵ This was to be expected since the defendants were internet service providers and the FIOs were correspondingly accessible by the defendants’ subscribers through the defendants’ services. Hence the requirement under s 193DDA(1)(a) of the Copyright Act was also met.

Whether the orders sought were reasonable steps to disable access to the FIOs

31 The High Court’s power to grant site-blocking orders stems from s 193DDA of the Copyright Act (see above at [16]). This provision allows the court to make an order requiring the network service provider to “take reasonable steps to disable access to the flagrantly infringing online location”.

32 In addition, the court is to take into account the factors referred to under s 193DB(3) in making an order under s 193DDA of the Copyright Act. Section 193DB(3) reads:

When making an order under subsection (1) or (2) or section 193DDA(1), the court shall have regard to —

- (a) the harm that has been or may foreseeably be caused to the plaintiff;
- (b) the burden that the making of the order will place on the network service provider;
- (c) the technical feasibility of complying with the order;
- (d) the effectiveness of the order;
- (e) any possible adverse effect on the business or operations of the network service provider;

²⁵ Affidavit of OJW at para 18 and OW-3.

(f) whether some other comparatively effective order would be less burdensome; and

(g) all other matters which it considers relevant.

The main injunction

33 The main injunction required the defendants to take reasonable steps to block the scheduled FQDNs (*ie*, domain names, URLs and/or IP addresses) which the plaintiffs had identified as providing access to the 53 websites which I have found are FIOs. I was satisfied that the factors under s 193DB(3) of the Copyright Act supported the granting of the main injunction. The main injunction was necessary to mitigate further harm caused to the plaintiffs. I was also satisfied that the methods proposed to block access to the FQDNs, which were left largely within the discretion of the defendants, including DNS blocking, URL filtering or IP address blocking were technically feasible and did not place an excessive burden on the defendants.

The dynamic injunction

34 The dynamic injunction required the defendants to block additional FQDNs not presently listed in the plaintiffs' schedule which provide access to the same 53 FIOs, upon receiving notification of such additional FQDNs from the plaintiffs.

35 The dynamic injunction anticipates and seeks to counteract circumventive measures that may be taken by owners or operators of the FIOs. This would include measures taken to change the domain name, URL and/or IP address providing access to the FIO. Owners or operators of FIOs are able to take measures which circumvent existing blocking orders since it is possible for a single FIO to be accessed via multiple domain names, URLs and/or IP addresses.²⁶ As an illustration, s/n 52 of the schedule to the plaintiffs' application

sought to block the FQDNs which provide access to the FIOL known as “series9”. Multiple domain names, URLs and IP addresses were associated with the “series9” FIOL:

FIOL	Target Domain Names	Target URLs	Target IP Addresses
series9	series9.co	https://series9.co	104.25.155.110
			104.25.156.110
	theseriesonline.net	http://theseriesonline.net	192.162.138.21
	series9.io	http://series9.io	104.25.155.110
			104.25.156.110
	theseriesonline.com	http://theseriesonline.com	104.24.118.246
			104.24.119.246
	seriesonline.io	https://seriesonline.io	104.27.168.74
			104.27.169.74

36 In this connection, the means of accessing FIOLs are dynamic rather than static. In fact, since the filing of the application by the plaintiffs, the means of accessing some of the FIOLs have already changed.²⁷ For example, the primary domain name for the FIOL “xmovies8” has since been changed from “xmovies8.es” to “xmovies8.nu”.²⁸ As the domain name “xmovies8.nu” did not exist at the time of the application and was not listed under the plaintiffs’ schedule, should the dynamic injunction not be granted, the plaintiffs would need to apply to the court to amend the main injunction in order to add the new

²⁶ PSWS at paras 10–14.

²⁷ PWS at para 80.

²⁸ Affidavit of MKYK at para 28.

domain name for it to be blocked. On the other hand, the dynamic injunction would remove the need for the plaintiffs to return to court to apply for an amendment of the main injunction or for a new order.

(1) Whether the court has jurisdiction to issue a dynamic injunction

37 Section 193DDA of the Copyright Act is worded broadly and in this regard does not expressly preclude the order issued pursuant to the provision from taking the form of a dynamic injunction. This is so long as the actions required pursuant to the dynamic injunction constitute “reasonable steps to disable access to the flagrantly infringing online location”. There is no other provision in the Copyright Act which stipulates the types of orders or the scope of the orders that may be granted by the court under s 193DDA. Therefore, in relation to the dynamic injunction, the question was whether the blocking of additional FQDNs by the defendants, as and when informed by the plaintiffs of such sites, were “reasonable steps to disable access to the flagrantly infringing online location” such that the court had the jurisdiction under s 193DDA of the Copyright Act to issue the injunction.

38 I found that the court has the jurisdiction to issue a dynamic injunction given that such an injunction constitutes “reasonable steps to disable access to the flagrantly infringing online location”. This is because the dynamic injunction does not require the defendants to block additional FIOs which have not been included in the main injunction. It only requires the defendants to block additional domain names, URLs and/or IP addresses that provide access to the *same* websites which are the subject of the main injunction and which I have found constitute FIOs (see [19] – [29] above). Therefore, the dynamic injunction merely blocks new means of accessing the same infringing websites,

rather than blocking new infringing websites that have not been included in the main injunction.

39 In fact, under the dynamic injunction applied for in the present case, the plaintiffs would be required to show in its affidavit that the new FQDNs provide access to the same FIOs which are the subject of the main injunction before the defendants would be required to block the new FQDNs (see [6] above). There are technical means of showing that the new FQDNs link to the same blocked FIOs. One way to show that a new FQDN links to the same FIO is to demonstrate that the primary domain name for the FIO has changed, which is known technically as a “DNS CHANGENAME”. The plaintiffs may also show that there has been a redirect from a new FQDN to the primary domain name of the FIO, or that a primary domain name already blocked now redirects to a new primary domain name for the same FIO through a mechanism known as “HTTP 3xx redirect”.²⁹

40 Further, while s 193DDC of the Copyright Act provides a mechanism for the variation of the main injunction, I agreed with the Plaintiffs’ submission³⁰ that this did not preclude the court from issuing a dynamic injunction in the original order. Section 193DDC reads:

Variation or revocation of order

193DDC.—(1) The High Court may, on the application of a party to an order made under section 193DDA(1), vary the order as it thinks just if the High Court is satisfied that there has been a material change in the circumstances or that it is otherwise appropriate in the circumstances to do so.

(2) The High Court may, on the application of a party to an order made under section 193DDA(1), revoke the order if the High Court is satisfied —

²⁹ Affidavit of MKYK at para 28–31.

³⁰ PWS at paras 94–98.

- (a) upon further evidence, that the order ought not to have been made;
- (b) that the online location has ceased to be a flagrantly infringing online location; or
- (c) that it is otherwise appropriate in the circumstances to do so.

(3) In this section, a reference to a party to an order made under section 193DDA(1) includes a reference to the owner of the online location that is the subject of the order.

Section 193DDC of the Copyright Act appears to me to be a general provision for variation of orders made under s 193DDA(1) and does not preclude the making of a dynamic injunction.

(2) Whether the dynamic injunction ought to be granted

41 As with the main injunction, whether or not the dynamic injunction should be granted required a consideration of the factors stipulated under s 193DB(3) of the Copyright Act. I found that these factors supported the granting of the dynamic injunction.

42 In relation to s 193DB(3)(d) of the Copyright Act, *ie*, the effectiveness of the proposed order, the dynamic injunction was necessary to ensure that the main injunction operated effectively to reduce further harm to the plaintiffs. This is due to the ease and speed at which circumventive measures may be taken by owners and operators of FIOLs to evade the main injunction, through for instance changing the primary domain name of the FIOL. Without a continuing obligation to block additional domain names, URLs and/or IP addresses upon being informed of such sites, it is unlikely that there would be effective disabling of access to the 53 FIOLs.

43 I also took into consideration the burden to the defendant network service providers, the technical feasibility of complying with the dynamic

injunction, any possible adverse effect on the business of the network service providers, and whether some other comparatively effective order would be less burdensome (see ss 193DB(3)(b), 193DB(3)(c) 193DB(3)(e) and 193DB(3)(f) of the Copyright Act respectively). I found that the dynamic injunction would not significantly increase the burden on the defendants from that already imposed under the main injunction. In fact, 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 FIOLs arises.

44 Further, in order to ensure that the interests of the defendant network service providers are not unduly impinged by the dynamic injunction, I included a proviso in the order granted, along with the liberty for parties to apply. Under the proviso, the defendants would not be required to block the additional FQDNs upon the request of the plaintiffs if they are of the view that the grounds for disabling access provided by the plaintiffs are insufficient. Thus, the order that I granted in relation to the dynamic injunction read:

1. The Plaintiffs may from time to time notify the Defendants in writing of Fully Qualified Domain Names ("FQDNs") which include one or more additional Domain Name(s), URL(s), and/or IP Address(es) via which a FIOL which was referred to in the Schedule to [the main injunction] is accessible (the "Additional Domain Name(s), URL(s) and/or IP Address(es)"), and provide an affidavit to the Defendants and the Court which identifies the Additional Domain Name(s), URL(s) and/or IP Address(es) and states the reasons the FIOL accessible from the Additional Domain Name(s), URL(s) or IP Address(es) is the same FIOL which is identified in the Schedule to [the main injunction] and the subject of the orders therein. The Defendants shall within 15 working days of the notification take reasonable steps (as set out at paragraph 1 of [the main injunction]) to disable access primarily by its residential subscribers and customers to the FIOL through the Additional Domain Name(s), URL(s) and/or IP Address(es). *Provided that if the Defendants are of the view that the grounds for disabling access to any of the FQDNs are insufficient, then the Defendants need not disable access to*

these FQDNs and shall notify the Plaintiffs of this, including the reasons therefor, within 15 working days of the receipt of the affidavit.

2. The parties shall have liberty to apply.

[emphasis added]

45 In coming to my decision, I had considered the approaches that have been adopted in the UK and Australia. I noted that the English courts have granted dynamic injunctions in order to combat online piracy. In *Twentieth Century Fox Film Corporation and others v British Telecommunications plc (No 2) Note* [2012] 1 All ER 869, the applicant right-holders brought an application against the respondent internet service provider seeking an injunction pursuant to s 97A of the Copyright, Designs and Patents Act 1988 (c 48) (UK) to block the access by the respondent’s subscribers to a copyright infringing website known as “Newzbin2”. The English High Court granted an order which included a provision for the applicants to notify the respondent of additional IP addresses or URLs whose sole or predominant purpose was to enable or facilitate access to the Newzbin2 website. Arnold J stated at [10]–[12]:

Since the main judgment was delivered, the operators of Newzbin2 have made available client software which is designed to allow a user to access the Newzbin2 website independently from, for example, an installed web browser, and thereby circumvent any block imposed by [the respondent] pursuant to the order. For this and other reasons, it is common ground that the order should permit [the applicants] to notify IP addresses and/or URLs to [the respondent] in future in order for those to be subject to the same blocking measures as www.newzbin.com.

...

... I do not consider that [the applicants] should be obliged to return to court for an order in respect of every single IP address or URL that the operators of Newzbin2 may use. In my view the wording proposed by [the applicants] strikes the appropriate balance. If there is a dispute between the parties as to whether the predominant purpose of an IP address or URL is to enable

or facilitate access to Newzbin2, they will be able to apply to the court for a resolution of the dispute. ...

46 Further, in *Cartier International AG and others v British Sky Broadcasting Ltd and others* [2017] 1 All ER 700, a decision of the English Court of Appeal, Kitchin LJ stated at [18]:

An important feature of all of the orders made pursuant to s 97A has been that they have included a provision for the rightholders to notify additional IP addresses or URLs to the ISPs in respect of the websites which have been ordered to be blocked. This has allowed the rightholders to respond to efforts made by website operators to circumvent the orders by changing their IP addresses or URLs.

47 On the other hand, the Federal Court of Australia has taken a contrary view and has required parties to apply to court to vary the original site-blocking order in response to any circumventive measures taken by operators of FIOs. In *Roadshow Films Pty Limited v Telstra Corporation Ltd* [2016] FCA 1503, the Federal Court of Australia declined to issue an order sought by the applicants which would permit them to extend the scope of the main site-blocking order to include additional domain names, IP addresses and/or URLs without any further order of court. While the Australian courts have acknowledged that an online location already ordered to be blocked may be accessed from a new FQDN subsequent to the order, they have preferred an approach that would require the court to amend the original order to add these new FQDNs, upon application by the applicants. Nicholas J stated in this regard at [137]–[138] of *Roadshow Films Pty Limited v Telstra Corporation Ltd* [2016] FCA 1503 (see also *Roadshow Films Pty Limited v Telstra Corporation Limited* [2018] FCA 582 at pp iv–v, [13]) :

In my view the respondents' proposed order 12 is preferable. Whether the terms of any injunction should be varied to refer to additional Domain Names, IP addresses or URLs is a matter for the Court to determine in light of evidence.

The applicants submitted that notifications of the kind they propose will not amount to variations to the injunction because they will be provided for by the terms of the orders the applicants propose. However, the effect of a notice given by the applicants under their proposed orders will require the respondents to block additional Domain Names, URLs or IP Addresses which might not point to any of the same online locations in relation to which the injunction was originally granted. If the injunction is to apply to new Domain Names, URLs or IP addresses, then these are matters which should be dealt with by way of further order in the manner proposed by the respondents.

48 Nicholas J's reason as gleaned from the above-quoted passage for declining to issue a dynamic injunction appears to be that the court should be the ultimate arbiter and retain the powers to determine if the additional FQDNs should be blocked. This is presumably to prevent "overblocking", *ie*, the blocking of legitimate sites.

49 However, with respect, this may be an overstated concern in my view. Under the dynamic injunction granted in the present case, the plaintiffs would be required to provide evidence to the defendants (and to the court) that the new FQDNs resolve to the same FIOs already blocked under the main injunction. Further, with the proviso included, should there be any dispute as to whether this is indeed the case, the defendant network service providers may decline to block the new FQDNs and parties may apply to court for a determination of the issue. In this regard, the court retains the powers to determine if the new FQDNs indeed resolve to the same FIOs and if they should correspondingly be blocked by the defendant network service providers.

50 Therefore, I respectfully declined to follow the Australian approach and preferred instead an approach based on that adopted in the UK. A dynamic injunction provides a practical means of ensuring the continued effectiveness of the original injunction since it provides an expedited process for the blocking of

additional FQDNs which resolve to the same infringing websites, where this is undisputed and unchallenged by the defendants. The defendants and owners of the online locations remain free to challenge the plaintiffs' attempts to block additional FQDNs under the express terms of the order, and also pursuant to s 193DDC of the Copyright Act. There are sufficient safeguards in my view to prevent an abuse of the dynamic injunction by the plaintiffs. In this regard, I was doubtful that there was anything significantly more to be gained in terms of safeguard which would justify the additional time and cost incurred from requiring the plaintiffs to apply to court to formally vary the main injunction to include additional FQDNs, where these are not subject to any challenge by the defendants.

Conclusion

51 At the second reading of the Copyright (Amendment) Bill (No 16 of 2014), the then Senior Minister of State for Law Ms Indranee Rajah, SC explained that the mechanism under s 193DDA of the Copyright Act seeks to “empower rights owners to more effectively disable access to sites that flagrantly infringe copyright” while at the same time ensuring that the framework does not “unduly impinge upon the rights and interests of other stakeholders, including network service providers and website owners hosting legitimate content”.³¹

52 I was of the view that the orders granted would strike an appropriate balance between the competing interests. In particular, the dynamic injunction ordered would provide right-holders with a means to more effectively deal with circumventive measures while at the same time providing a recourse to network service providers and site-owners should there be a dispute as to whether the

³¹ PSBOA at Tab 7, pp 51 and 53.

new FQDNs indeed resolve to the same FIOLs blocked under the main injunction.

53 Such an approach was, in my view, consonant with the legislative objective of s 193DDA of the Copyright Act which is to provide a means of disabling access to the FIOL, given the nature of online piracy today including the ease with which circumventive measures may be adopted.

Lee Seiu Kin
Judge

Andy Leck, Lim Ren Jun, Yeo Gek Min and Bay Shen Yang Nigel
(Wong & Leow LLC) for the plaintiffs;
Chan Kwok Chuan Jason and Nicholas Ong Wei Lun (Amica Law
LLC) for the first and second defendants;
Chua Yeow Hooi and Sim Guang Hui Emmanuel (Robinson LLC)
for the third defendant;
Koh Chia Ling and Ong Chin Kiat (OC Queen Street LLC) for the
fourth and fifth defendants;
Lim Yee Ming and Kok Zi Hao (Kelvin Chia Partnership) for the
sixth, seventh and eighth defendants;
The ninth defendant unrepresented.
