

*Roadshow Films Pty Limited v Telstra Corporation Limited (Extension of Orders)* [2023] FCA 1167

**FEDERAL COURT OF AUSTRALIA**

BURLEY J

**BURLEY J:**

**1. INTRODUCTION**

1 This judgment is given in two proceedings (the **Foxtel Case** and the **Roadshow Case**), both concerning the operation of s 115A of the *Copyright Act 1968* (Cth), which makes provision for the grant of injunctive relief restraining access via carriage service providers and online search engines to online locations outside Australia that are engaged in infringing, or facilitating the infringement of, copyright.

2 In both proceedings, I delivered judgment granting **site blocking orders** pursuant to s 115A. The first was *Foxtel Management Pty Limited v TPG Internet Pty Ltd* [2017] FCA 1041; 349 ALR 154 and the second *Roadshow Films Pty Limited v Telstra Corporation Limited* [2020] FCA 507; 151 IPR 449 (**Roadshow No 1**). In the Roadshow Case I made an adjustment to the final orders as explained in *Roadshow Films Pty Limited v Telstra Corporation Limited (No 2)* [2020] FCA 769; 153 IPR 317 (**Roadshow No 2**).

3 Section 115A was introduced into the Copyright Act by the *Copyright Amendment (Online Infringement) Act 2015* (Cth) (the **Amendment Act**) with effect from 27 June 2015. Section 115A has since been amended by the *Copyright Amendment (Online Infringement) Act 2018* (Cth) (**2018 Amendment Act**).

4 The site blocking orders were expressed to run for three years with provision being made for them to be extended upon application by the applicants. The applicants have made such applications and a question arises as to the matters of which the Court should be satisfied before granting an extension.

5 At my request, Ms J M Beaumont SC and Ms F St John, who appeared respectively for the applicants in the Foxtel Case and the Roadshow Case, prepared a joint written submission identifying the considerations that they submitted ought to be taken into account in granting the extension orders. In recognition of the fact that there was no contradictor to their

applications, the submissions identified different approaches that may be taken to the question. I am grateful to them for their assistance.

6 My research indicates that some 20 decisions have been made under the Act, each granting site blocking orders in respect of identified online locations that, the Court has found, infringe or facilitate the infringement of copyright or has the primary purpose of doing so.

## 2. THE RELEVANT LEGISLATION

7 Section 115A in its current form provides as follows:

### **Application for an injunction**

- (1) The owner of a copyright may apply to the Federal Court of Australia to grant an injunction that requires a carriage service provider to take such steps as the Court considers reasonable to disable access to an online location outside Australia that:
  - (a) infringes, or facilitates an infringement, of the copyright; and
  - (b) has the primary purpose or the primary effect of infringing, or facilitating an infringement, of copyright (whether or not in Australia).
- (2) The application under subsection (1) may also request that the injunction require an online search engine provider (other than a provider that is covered by a declaration under subsection (8B)) to take such steps as the Court considers reasonable so as not to provide a search result that refers users to the online location.

### *Granting the injunction*

- (2A) The Court may grant the injunction in the terms, and subject to the conditions, that the Court considers appropriate.

Note 1: For the matters that the Court may take into account when determining whether to grant the injunction, see subsection (5).

Note 2: The terms and conditions of the injunction that apply to a carriage service provider under subsection (1) may be different from those that apply to an online search engine provider under subsection (2).

- (2B) Without limiting subsection (2A), the injunction may:
  - (a) require the carriage service provider to take reasonable steps to do either or both of the following:
    - (i) block domain names, URLs and IP addresses that provide access to the online location and that are specified in the injunction;
    - (ii) block domain names, URLs and IP addresses that the carriage service provider and the owner of the copyright agree, in writing, have started to provide access to the online location after the injunction is made; and

- (b) require the online search engine provider to take reasonable steps to do either or both of the following:
  - (i) not provide search results that include domain names, URLs and IP addresses that provide access to the online location and that are specified in the injunction;
  - (ii) not provide search results that include domain names, URLs and IP addresses that the online search engine provider and the owner of the copyright agree, in writing, have started to provide access to the online location after the injunction is made.

*Parties*

- (3) The parties to an action under subsection (1) are:
  - (a) the owner of the copyright; and
  - (b) the carriage service provider; and
  - (ba) if the application under subsection (1) also sought for the injunction to apply against an online search engine provider—the online search engine provider; and
  - (c) the person who operates the online location if, but only if, that person makes an application to be joined as a party to the proceedings.

*Service*

- (4) The owner of the copyright must notify:
  - (a) the carriage service provider; and
  - (aa) if the application under subsection (1) also sought for the injunction to apply against an online search engine provider—the online search engine provider; and
  - (b) the person who operates the online location;

of the making of an application under subsection (1), but the Court may dispense, on such terms as it sees fit, with the notice required to be sent under paragraph (b) if the Court is satisfied that the owner of the copyright is unable, despite reasonable efforts, to determine the identity or address of the person who operates the online location, or to send notices to that person.

*Matters to be taken into account*

- (5) In determining whether to grant the injunction, the Court may take the following matters into account:
  - (a) the flagrancy of the infringement, or the flagrancy of the facilitation of the infringement, as referred to in paragraph (1)(b);
  - (b) whether the online location makes available or contains directories, indexes or categories of the means to infringe, or facilitate an infringement of, copyright;
  - (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 disabling access to the online location is a proportionate response in the circumstances;
- (ea) if the application under subsection (1) also sought for the injunction to apply against an online search engine provider—whether not providing search results that refer users to the online location is a proportionate response in the circumstances;
- (f) the impact on any person, or class of persons, likely to be affected by the grant of the injunction;
- (g) whether it is in the public interest to disable access to the online location;
- (ga) if the application under subsection (1) also sought for the injunction to apply against an online search engine provider—whether it is in the public interest not to provide search results that refer users to the online location;
- (h) whether the owner of the copyright complied with subsection (4);
- (i) any other remedies available under this Act;
- (j) any other matter prescribed by the regulations;
- (k) any other relevant matter.

*Presumption that the online location is outside Australia*

- (5A) For the purposes of the proceedings, the online location is presumed to be outside Australia, unless the contrary is established.

*Affidavit evidence*

- (6) For the purposes of the proceedings, section 134A (affidavit evidence) applies as if the reference in paragraph 134A(f) to a particular act included a reference to a class of acts.

*Rescinding and varying injunctions*

- (7) The Court may:
  - (a) limit the duration of; or
  - (b) upon application, rescind or vary;
 an injunction granted under this section.
- (8) An application under subsection (7) may be made by:
  - (a) any of the persons referred to in subsection (3); or
  - (b) any other person prescribed by the regulations.
- (8A) An application under subsection (7) must not request the Court to vary the injunction so that it applies to an online search engine provider that is covered by a declaration under subsection (8B).

*Declarations excluding online search engine providers*

(8B) The Minister may, by legislative instrument, declare that:

- (a) a particular online search engine provider; or
  - (b) an online search engine provider that is a member of a particular class;
- must not be specified in an application under subsection (1) or (7).

*Costs*

(9) A carriage service provider or, if applicable, an online search engine provider is not liable for any costs in relation to the proceedings unless the provider enters an appearance and takes part in the proceedings.

8 The purpose of s 115A is primarily to reduce the incidence of online copyright infringement. It was established to provide an enhanced, streamlined mechanism that enables infringing material hosted by an online target location outside of Australia to be blocked by a carriage service provider, without the need to establish fault on the part of that provider; Second Reading Speech, Copyright Amendment (Online Infringement) Bill 2015 (Cth), Minister for Communications (Hansard: House of Representatives, 26 March 2015 at 3592).

9 Section 115A contemplates that an injunction may be granted for orders requiring a carriage service provider to disable access to an online location outside Australia where it considers it appropriate to do so, having regard to the matters listed in s 115A(5).

10 The injunction may be granted on such terms that the Court considers appropriate; s 115A(2A), some of which terms are set out in s 115A(2B).

11 Subsection (2B) contemplates that an order may be varied *after* it has been granted to block domain names, URLs and IP addresses where the carriage service provider and the copyright owner agree in writing that those domain names, URLs or IP addresses have, since the initial grant of the injunction, “started to provide access to the online location”. This was explained in the second reading speech to the Copyright Amendment (Online Infringement Bill) 2018 (18 October 2018) where Paul Fletcher MP relevantly said of these amendments:

Australia’s piracy rate still remains higher than in countries with strong copyright enforcement frameworks, such as the United Kingdom and Canada. There is still a proportion of Australian users who seek out infringing sites, and there are still pathways for them to get to these sites, including blocked sites.

In February this year, the government reviewed the existing scheme to determine whether it was operating effectively. In general, this assessment found that the scheme is working well and that blocking arrangements have been implemented by carriage service providers with minimum disruption. However, there are some clear pressure points...new pathways to the blocked sites appear after the initial blocking, and these

new pathways can't be blocked because they are not part of the original court order.

...

...

The bill will make clear that the Federal Court has the power to issue responsive and adaptive injunctions, without the need for the copyright owner to go back to the court. This will give the court the power to grant injunctions on terms that allow the copyright owner and carriage service provider, by agreement, to apply the injunction to block other pathways that start to provide access to an infringing site.

12 Subsection (7) contemplates that the terms of a site blocking injunction may be limited in duration or varied. As I have noted, the Orders in both of the present cases were limited in duration to three years. The applicants submit, and I accept, that this was not as a result of any determination by the Court, but rather as a consequence of negotiations between the copyright owners and the carriage service providers in the first of the cases to consider the operation of s 115A, being *Roadshow Films Pty Ltd v Telstra Corporation Ltd* [2016] FCA 1503; 248 FCR 178.

### 3. RELEVANT CONSIDERATIONS IN MAKING ORDERS UNDER S 115A(7)

13 The Orders made in each of the present cases (as well as, I understand, in other similar cases) provide a mechanism whereby an applicant can apply to extend the duration of the site blocking orders. The question then arises as to the matters that might be relevant to take into consideration in determining whether or not to extend or vary the term of the site blocking orders beyond the initial three years duration. In my view the following points may be made.

14 First, it will not generally be necessary for the Court to revisit the initial basis for granting the Orders. Section 115A contemplates a distinction between the grant of such orders and their variation; see s 115A(7). Unless the Court has reason to believe that the circumstances warranting the initial grant have changed, there will generally be no reason why the status quo should be altered.

15 In this regard, I note that the evidence in the present application demonstrates that the process of establishing that target online locations have the primary purpose or primary effect of infringing, or facilitating the infringement of copyright, as required by s 115A(1) is a lengthy and costly exercise. It is antithetical to the legislative purposes of s 115A to require such steps to be repeated.

16 Secondly, in granting an extension of the Orders, the Court should be satisfied that the applicants or their solicitors have visited each of the Target Online Locations the subject of the

application and, based on the results of that access, formed a good faith belief that those locations have not permanently ceased to have the primary purpose or primary effect of infringing or facilitating the infringement of copyright and that each Target Domain Name, Target URL or Target IP address that is the subject of the application has not permanently ceased to enable or facilitate access to the Target Online Location.

17 This approach aligns with that taken in *Roadshow No 1*, which explains the basis upon which orders were made to vary existing orders within the three year duration of the initial orders; see at [2], [72]-[80]. The scheme put in place in those orders enabled variations to be made to ensure that, where additional domain names, URLs or IP addresses were used to provide access to the target online location, the applicants may, by their solicitor, provide a certification of the matters to which I have referred to the respondents. The respondents would then have a short period (seven business days in that case) to indicate if they opposed the variation. If those orders are not opposed, and the Court does not require the matter to be relisted, then the respondents must take steps to disable the identified domain names, URLs or IP addresses; see *Roadshow No 1* at [79] and *Roadshow No 2* at [4]-[7].

18 In the present application the evidence reveals that a website at several of the Target Domain Names displays a message indicating that the website has become temporarily unavailable. Whilst this may be taken into consideration in the exercise of discretion as to whether to grant the extension, it is apparent that such a website, having earlier been shown to have been the site of infringing activity or facilitating infringing activity but been temporarily inaccessible is still capable of resuming its misconduct. In such circumstances I consider that it is appropriate to grant such orders. In this regard, see, for example, *Roadshow Films Pty Ltd v Telstra Corporation Ltd* [2016] FCA 1503; 248 FCR 178 at [76] (Nicholas J).

19 Thirdly, it will not generally be necessary for the applicants to make yet further “reasonable efforts” to notify the operator of the target online location of the application to vary the Orders. Evidence adduced by the applicants in the present application demonstrates that attempting to satisfy this statutory requirement is an expensive exercise, costing in the order of \$30,000.

20 Rather, in my view the applicants should be required only to provide notice of the application by sending the relevant materials to any email address that the target online location indicates may be used to contact its operators. If no such email address is provided, then there is no further obligation on the part of the copyright owner.

21 In this context, it may be noted that section 115A(3) provides that the person who operates the online location is only a party to the proceedings if that person makes an application to be joined. Section 115A(4) provides that the copyright owner must notify the person who operates the online location of the making of the application for the initial Order, but that the Court may dispense with notice if it is satisfied that the owner, despite reasonable efforts, is unable to determine the identity or address of the person who operates the online location.

22 In both of the present cases, orders dispensing with notice were made after the receipt of extensive evidence as to the steps taken by the solicitors representing the copyright owners to give notice of the proceedings to the operators of the target online location; *Foxtel* at [56], [62], [67], [78], [85], [100], [119], [126], [131], [140]; *Roadshow 1* at [24], [25]. Other examples of the steps taken to give notice of such proceedings may be seen in *Universal Music Australia Pty Limited v TPG Internet Pty Ltd* [2017] FCA 435; 348 ALR 493 at [36]-[44] (Burley J) and *Roadshow Films Pty Limited v Telstra Corporation Limited* [2020] FCA 1468 at [19]-[20] (Rares J).

23 In all of the cases mentioned above, and indeed from my survey of the decisions made to date, although the target online locations often ostensibly made available addresses for contact with the operators, none provide any substantive responses to the communications sent notifying them of the proceedings. These cases suggest that it is typical for the operators of such sites to take steps to give the illusion that they wish to be contacted and will be responsive to requests for information when indeed the reverse is true.

24 In this regard, it may be noted that in each case, there is an order permitting owners or operators of any Target Online Location to apply to the Court to vary or discharge the orders. The evidence discloses that no such applications have been made in either of the present proceedings.

25 Fourthly, if the applicants become aware that any Target URL, Target IP Address or Target Domain Name that is a subject of the blocking order has permanently ceased to enable or facilitate access to any target online location, or any target online location has permanently ceased to have the primary purpose of infringing or facilitating the infringement of copyright, the applicants must notify the carriage service providers so that the block can be lifted.

26 Finally, given that the Target Online Locations have not permanently ceased their infringing activities after several years of the blocking orders being made, the Court may infer that these



are long-term infringing operations and that, by the time of the extension application, some degree of association is likely to have formed in the minds of their users between the name or brand under which the online locations operate (in these cases, names such as ‘Project Free TV’, ‘Torlock’, ‘LosMovies’, ‘unblockproject’ and ‘kickass’) and the infringing content which they provide or to which they facilitate access. This leads to a further inference that the domain names which contain those names or brands (or very similar names) are unlikely to have a legitimate primary purpose but are likely to continue to be associated with the relevant Target Online Locations. This kind of reasoning has been applied in recent site blocking cases in the United Kingdom (albeit in the context of adding new domain names or websites): *Columbia Pictures v British Telecommunications* [2021] EWHC 2799 (Ch) at [7] (Mrs Justice Falk J) and *Columbia Pictures v British Telecommunications* [2022] EWHC 2403 (Ch) at [7]-[9] (Mr Justice Meade J).

#### **4. A PROPOSED APPROACH**

27 Having regard to the matters identified in section 3 above, in my view the following orders might be made in an initial site blocking application which accommodate a balance between the interests of the copyright owners in seeking such orders, and serve to provide some protection to carriage service providers and the operators of target online locations.

28 If an Applicant makes an application to extend and/or vary the period of operation of these orders:

- (a) the application must be made at least 28 days prior to the expiry of the operation of the orders by filing a minute of the orders sought together with a solicitor’s certification in accordance with (b) below;
- (b) a solicitor on behalf of the Applicant must certify that:
  - (i) within the 6 weeks prior to the application, the solicitor or another representative of the Applicant has attempted to access each Target Online Location via each Target Domain Name;
  - (ii) following the exercise in (b)(i) above, the solicitor has a good faith belief that each Target Online Location that is the subject of the application has not permanently ceased to have the primary purpose or effect of infringing or facilitating the infringement of copyright, and that each Target Domain Name, Target URL or Target IP address that is the subject of the application has not

permanently ceased to enable or facilitate access to a Target Online Location;  
and

- (iii) the Applicant has given the Respondents at least 7 days' notice of the application;
- (c) the accompanying minute of order may specify any Target Domain Names, Target URLs or Target IP addresses that are excluded from the application;
- (d) within 7 days of receiving notice of the application, any Respondent objecting to the extension of these orders must notify the Applicant and the Court in writing of the objection and the reasons therefor;
- (e) if any Respondent objects in accordance with (d) above, the proceeding will be relisted for directions, unless the Court otherwise orders;
- (f) if no Respondent gives notice of any objection, then the Court may make orders in terms of the Applicant's minute without any further hearing;
- (g) the Applicant must serve on the Respondents any such orders made; and
- (h) the Applicant must attempt to give each relevant Target Online Location notice of the Orders made by sending an email to one email address identified by such Location as providing a means to contact its operator or administrator (if any is identified), further notifying it that it may seek to vary or set aside such Orders upon the filing of a notice of appearance with the Court and an appropriate application, supported by affidavit evidence.

## **5. GRANT OF ORDERS IN THE CURRENT APPLICATIONS**

29 In each of the present applications the applicants have provided certification consistent with that which is set out above. I will accordingly make the Orders substantially as sought in the Roadshow and Foxtel Cases.