

Roadshow Films Pty Limited v Telstra Corporation Limited (No 2) [2020]
FCA 769

FEDERAL COURT OF AUSTRALIA

BURLEY J

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- 1 On 20 April 2020 I delivered reasons for judgment where I found that the respondents, each a carriage service provider (**CSP**), should be required to take reasonable steps to disable access to 86 target online locations that infringe or facilitate the infringement of copyright: ***Roadshow Films Pty Limited v Telstra Corporation Limited*** [2020] FCA 507. These reasons adopt the same definitions as in *Roadshow*.
- 2 The orders that I proposed to make in *Roadshow* were set out in Annexure A of the reasons, and were in a slightly different form to those made in a number of previous applications under s 115A of the *Copyright Act 1968* (Cth). In particular, in Order 12 they provide a new process whereby additional URLs, domain names and IP Addresses that provide access to target online locations which are the subject of existing orders (**additional avenues**) can be added to the operation of those orders without further order of the Court. Having regard to the novelty of this form, I invited further submissions from the parties, which have now been received from the applicants and from one of the five respondent groups, Telstra.
- 3 Having regard to those submissions, the revised form of Order 12 that I will now make is set out below, with amendments to the form proposed in *Roadshow* marked up:

If a website the subject of any of the Target Online Locations is at any time during the operation of these Orders provided from a different Domain Name, IP Address or URL, the Applicants may, by their solicitor:

- (a) Provide a notice in writing to the Respondents and the Court that:
 - (i) Identifies the different Domain Name, IP Address or URL; and
 - (ii) Certifies that, in the good faith belief of the Applicants, the website operated from the different Domain Name, IP Address or URL is a new location for the Target Online Locations the subject of these Orders and brief reasons therefore;
- (b) Within 447 business days of the notice given pursuant to Order 12(a), the Respondents must notify the Applicants and the Court in writing if they ~~agree~~ object to taking steps pursuant to Order 1 [being the initial site blocking Order] to disable access to the Domain Name, IP Address

or URL notified in accordance with Order 12(a);

- (c) If any Respondent ~~does not agree~~ objects to disabling a Domain Name, IP Address or URL notified in accordance with Order 12(a), or the Court otherwise considers it appropriate to do so, the proceeding will be relisted for further directions; and
- (d) If, within the time period specified in Order 12(b), no ~~any~~ Respondent objects ~~agrees~~ to disabling access to any Domain Name, IP Address or URL notified in accordance with Order 12(a), and the Court does not otherwise require the proceeding to be relisted, then upon receipt of a notification from the Applicants that the Court does not require the matter to be relisted, that Respondent must take steps pursuant to Order 1 to disable access to the Domain Name, IP Address or URL notified in accordance with Order 12(a) ~~the subject of the agreement~~.

4 The procedure envisaged in the initially proposed orders required the respondents to consent to the inclusion of additional avenues, failing which the proceedings would be re-listed. The applicants submit that this procedure would be complicated by the problem that frequently, as in the present case, some of the CSPs joined as respondents elect not to participate in the proceedings. They either enter submitting appearances (as Telstra, Optus and Vodafone did in the present case) or enter no appearance at all, despite being ordered to do so (as TPG and Vocus did). In the present proceedings, only Telstra entered an appearance and also supplied submissions in relation to the form of orders.

5 This leads to two difficulties. The first is that more frequently than not it may be expected, as here, that there will be no participation in the proceedings at all by the CSPs. This appears to be routine in such cases: see *Roadshow Films Pty Limited v Telstra Corporation Limited* [2019] FCA 1328 at [10] – [11]; *Roadshow Films Pty Limited v Telstra Corporation Limited* [2019] FCA 885 at [2]; *Foxtel Management Pty Limited v TPG Internet Pty Ltd* [2019] FCA 1450 at [2]; *Australasian Performing Right Association Ltd v Telstra Corporation Limited* [2019] FCA 751 at [7]. The norm is likely to be that at least some of the CSPs will not consent to the inclusion of the additional avenues, which will occasion the relisting of the proceedings and additional delay and expense, which is antithetical to the purpose for the broader regime envisaged under the recent amendments to s 115A: see *Roadshow* at [76] – [78].

6 Secondly, if one CSP does consent, but others do not, the consenting CSP may in effect be penalised, because only it will be the subject of a broader site blocking order. This could over time provide the other CSPs with a competitive advantage.

7 The applicants contend that the preferable approach is for the additional avenues to be included within site blocking orders if, upon the provision of notice to the respondents, the respondents

fail to notify the Court and the applicants whether they agree to the inclusion within a specified period. Telstra agrees broadly with this approach, but submits that it should be refined slightly so that the obligation upon the CSPs is to indicate “if they object” to the inclusion of the additional avenues. Telstra submits that it is not well placed to determine which online locations are to be blocked, or what additional avenues should be blocked, and does not wish for the additional cost burden of ascertaining the answer to that question to fall upon it. Accordingly, a more appropriate wording is for a CSP to have the opportunity to object to blocking any additional avenue, should a matter come to its attention that should be raised, but otherwise the question of what should be blocked be left to the applicants and the Court.

- 8 Having regard to the arguments of the parties, I am satisfied that the approach proposed by the applicants, as refined by the Telstra proposal, is appropriate. It meets the objective of the legislation to facilitate, in appropriate cases, a more expeditious and less expensive means by which orders may be amended.