

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION NO.____ OF 2010
IN
SUIT LOD.NO.2498 OF 2010

Genx Entertainment Ltd. & Anr. .. Plaintiffs
Versus
Purple Haze Motion Pictures Pvt.Ltd. & Ors. .. Defendants

Mr.Virag Tulzapurkar, Senior Advocate i/b. G.S.Hegde and V.A.Bhagat
for plaintiffs

Mr.Simil Purohit with Ms.Azmin Irani and Manish Doshi i/b. Vimadalal
& Co. for defendant Nos. 1 and 2

Mr.S.U.Kamdar, Senior Advocate with A.S.Kamat, Sunil Goyal i/b.
Ashok Purohit & Co. for defendant No.7.

CORAM : S.C.DHARMADHIKARI, J.

DATE : 31st August 2010 and
1st September 2010.

P.C.:

1] This is a notice of motion by the plaintiffs seeking an interim injunction against the defendants by themselves, their Directors, their proprietor/ partners, their servants, dealers distributors, agents and all those connected with their business restraining them in any manner undertaking any production, telecast, broadcast or release in theatres or

television or satellite channels through rediffusion or any other means including advertising, promoting or using in any manner whatsoever in relation to its yet to be released cinematographic film, the impugned title, name and mark “the film EMOTIONAL ATAYACHAR” and or any trade mark deceptively similar thereto and containing the words “EMOTIONAL ATAYACHAR” being almost identical with and/or being deceptively similar to the plaintiff’s distinctive and well known registered title, name and trade mark “EMOTIONAL ATYACHAAR”.

2] This interim injunction is claimed in furtherance and in aid of the final relief of permanent injunction in same terms.

3] The case of the plaintiff is that they are a company incorporated and registered under the Indian Companies Act, 1956 and they carry on business of providing content production services, producing movies, television shows, broadcasting, offering interactive gaming and new media. They operate two satellite T.V channels in India known as UTV Bindass and UTV Action.

4] The second plaintiff is a company of UTV group and it is stated to have acquired reputation in Media and Entertainment business so also TV broadcasting, producing and distributing movies etc.

5] The first defendant is engaged in the business of production and presentation of cinematographic films and second defendant is Director of first defendant company. The third and fourth defendants are co-producers whereas defendant Nos. 5 and 6 are executive producers. Defendant No.7 is the sole proprietary concern of one Surendra Kumar Bohra and has registered a title of the film “EMOTIONAL ATYACHAR” (impugned title) with the Indian Motion Pictures Producers Association (IMPPA – Mumbai).

6] The plaint proceeds on the basis that several shows including reality shows of plaintiff have been telecast and are being telecast on UTV Bindass channel and have acquired reputation. The success rate in terms of TRP has been referred to and it is stated that as a member of the Association of Motion Pictures and T.V. Programmes Producers (AMPTPP) the title “EMOTIONAL ATYACHAR” was registered on 19th

May 2008 and a copy of the said registration certificate is annexed as annexure A to the plaint. It is stated that this registration is valid and subsisting. It is stated that the said title has been used in a reality show called EMOTIONAL ATYACHAR which was for the first time launched in November 2009. The telecast continues. It is stated that under the first slot this reality show was telecast from 18th December 2009 to 30th April 2010. Even in August 2010 i.e. its second slot, the title has been used in four (4) shows. It is stated that the plaintiffs are the exclusive users of the title EMOTIONAL ATYACHAR. They are the Originators, adopters and users thereof. They used it for TV serials (reality show) but their proprietorship to the title extends to both TV serials and Cinematographic films.

7] It is stated in the plaint that they have spent an amount approximately of Rs.1.75 Crores on the marketing and publishing activities for the first season and they continue to spend huge sums on publicity, promotion and advertisement of the second season. They have generated through this reality show revenue and the details of the same are set out.

8] The second slot is launched as a sequel and is titled “EMOTIONAL ATYACHAR- II”. It is then stated that the invoices which are annexed to the plaint would demonstrate that the plaintiffs had promoted and publicised their show and the mark EMOTIONAL ATYACHAR prominently.

9] It is alleged that this would evidence that the plaintiffs have earned tremendous goodwill and reputation in the same name and mark which goodwill and reputation extends way beyond the scope of the actual services offered and has clear unique character of trademark and name synonymous with and co-related with the entertainment services offered by the plaintiffs. This goodwill and the reputation earned by it has thus far remained unique and unparallel. It is stated that the name and the mark EMOTIONAL ATYACHAAR has acquired a secondary meaning and name associated with the plaintiffs and the reputation of the said trademark spreads far and wide and much beyond the actual scope of services offered and the merchandise promoted by the plaintiffs.

10] In para 13 of the plaint it is alleged that as a result of this honest adoption, registration of the title, prior continuous use of the said name and mark, the plaintiffs have acquired unique reputation and exclusive goodwill.

11] It is alleged thereafter that the plaintiffs came across an advertisement in the film trade magazine titled "Complete Cinema" dated 24th July 2010 wherein it was learnt that the first defendant is likely to present a cinematographic film title "the film EMOTIONAL ATAYACHAR" wherein the words and name EMOTIONAL ATAYACHAR occupy a leading, essential and prominent feature. This film will be released either in the theatres or on TV and other mediums. After setting out the details of the production of the said film, it is stated that the plaintiff's Advocate's letter dated 29th July 2010 was addressed calling upon the first defendant to refrain from undertaking any production, release, presentation, promotion or telecast of the film.

12] It is stated that on receipt of the notice, a reply was given by the first defendant, a copy of which is annexed as Annexure L page 225 of

the plaint paperback. The said reply reads thus:-

“We are in receipt of your 6 page letter dated 29th July 2010.

At the outset we are shocked and surprised for the contents of your letter.

Most of the contents are nothing short of glorifying your clients for which we have no comments to make and to put facts in right perspective we have to state as under.

To reply your contention that by our act we are likely to misrepresent having nexus, sponsorship and/or affiliation with your client, we have to candidly state that we have neither acted as stated by you nor we are in need of such acts as our film in itself is self sufficient to be promoted.

Further the title of the film “The Film Emotional Atyachar” is being decided by M/s.Roopvati Pictures who has been assigned various rights under the agreement entered into with them including the name of the movie.

In view of what is stated above we have to state that

despite this if you persist and start any proceedings the same will be at your cost and consequences.”

13] After receiving the reply from the first defendant, plaintiffs have made enquiries with the Indian Motion Pictures Producers Association as to whether defendant Nos. 1 or 7 had obtained any registration of the said title. They have been informed that the title and name of the film EMOTIONAL ATYACHAR has been registered in the name of defendant No.7 and such registration has been obtained very recently, i.e. On 21st July 2010. Having learnt about this erroneous registration of an identical and/or confusingly similar title after more than two years after the registration by the plaintiffs from Association of Motion Pictures and T.V. Programme Producers (AMTPP), a protest was lodged on 17th August 2010.

14] It is in such circumstances that the title carrying the same words being identical and/or deceptively similar to the first plaintiff's name and mark and second plaintiff's title registration, that the suit has been filed. The usual averments to that effect are to be found in paras 16 to 22 and,

thereafter, the nature of the reliefs claimed and the prayers are appearing in the plaint.

15] It is stated that the film “EMOTIONAL ATYACHAAR” which is produced by defendant No.1/ defendant No.7, is slated for release on 3rd September 2010 and, therefore, an application for urgent ad-interim relief has been made.

16] The application has been duly served with the plaint and affidavits on the defendants. The defendants have not chosen to file any affidavit in reply.

17] Mr.Tulzapurkar, learned Senior Counsel appearing for plaintiffs contended that the reality show EMOTIONAL ATYACHAR is extremely popular going by the high TRP ratings. He invites my attention to the fact that the registration with the AMP TPP has been obtained as early as on 19th May 2008. He contends that the registration certificate states that the title EMOTIONAL ATYACHAR is registered for the exclusive use of the plaintiff’s banner and they have no right whatsoever to either transfer

or allow anyone use of the said title. In case the plaintiffs do not desire to use the said title, they will surrender the registration and, thereafter, the Association will be free to allot the same to the next eligible applicant. There is renewal of the same, according to the plaintiffs and which is in force till 29th January 2011. Mr.Tulzapurkar submits that there is no surrender and in fact the first slot and four shows in the second slot would demonstrate that the plaintiff's programme/ show with the said title is immensely popular. The response from the viewing public and the advertisers has earned the plaintiffs good revenues. Thus, the plaintiffs are the originators, adopters and exclusive users. They are proprietors of the title which considering the nature of plaintiff's business of production and distribution of the films and TV serials is associated with the plaintiffs exclusively. Mr.Tulzapurkar invites my attention to the notice, a copy of which is at page 219 of the paperbook and submits that in the notice all these facts were highlighted and the response to the notice from the first defendant shows that instead of dealing with the contents of the notice an evasive answer was sought to be given. It is not as if the plaintiff's notice did not contain any of the averments and allegations as made in the plaint but the defendants have chosen not to deal with them.

Mr. Tulzapurkar submits that the letter from the AMPTPP is now available and it is clear that on the strength of the registration with the Indian Motion Pictures Producers Association that the defendants are claiming right to use the title for their feature film. That by itself will not be conclusive and in any event, the plaintiff's rights cannot be defeated. It is clear that the registration by the defendants is of 21st July 2010. They have not claimed that they have used the mark and title any time prior hereto. It is in such circumstances that Mr. Tulzapurkar submits that the plaintiffs have made out a prima facie case and the balance of convenience is in their favour. If there is a proof of a distinctive title and actual user for continuously more than a year, then according to Mr. Tulzapurkar, irreparable loss harm and injury would be caused if a film with the same title is permitted to be released. More so, when the film and TV serial business of the parties have everything in common. The film is going to be telecast on TV as well. The viewers are likely to think that it comes from the same banner as that of the plaintiffs. In this case, there is no question of any copyright. The reliefs that the plaintiffs are claiming are on the basis of passing off. There is restriction flowing as far as rival user by the defendants in the same title so as to harm

plaintiff's rights and, therefore, the contents of the work are immaterial in this case. For all these reasons, Mr.Tulzapurkar submits that the ad-interim injunction as prayed be granted.

18] In support of his contentions Mr.Tulzapurkar relies upon a judgement of the learned Single Judge of Delhi High Court in the case of Kanungo Media (P) Ltd. Vs. RGV Film Factory & Ors., reported in 2007 34 (Patent and Trademark Cases) 591 (Delhi).

19] On the other hand, Mr.Kamdar, learned Senior Counsel appearing for defendant No.7 submits that there is enormous delay in approaching this Court. Inviting my attention to paras 8 and 14 of the plaint, Mr.Kamdar submits that both plaintiffs and defendants are in same business. According to plaintiffs, they became aware of the registration of the defendants as early as on 24th July 2010. Yet, they came to this Court on the eve of the release of the film and, therefore, the application be dismissed, purely on the ground of delay and laches. Such a party is not entitled to any discretionary and equitable reliefs and, therefore, the notice of motion be dismissed. Mr. Kamdar has relied upon several

orders of this Court wherein in somewhat identical circumstances, according to him, relief of the present nature has been denied.

20] On merits, Mr.Kamdar submits that no prima facie case is made out by the plaintiffs. Mr.Kamdar submits that the case purportedly made out by the plaintiffs, on their own showing, is of passing off. However, there cannot be any question of passing off inasmuch as what the plaintiffs have done is that they have telecast in the past a reality shown in the name EMOTIONAL ATYACHAR. All that they have done is to telecast the show with this title. They are filing this suit on the basis of the registration of this title with the AMPTPP. This is an internal arrangement with the Association which has no statutory recognition. This registration does not confer any statutory right. On the strength of registration of a title, the plaintiffs cannot sue for passing off. There is no trademark registration admittedly in the said name or title. It is already clarified that there is no question of copyright. Therefore, the plea of passing off merely on the basis of a title of a reality show is not relatable to distribution of any goods or services which could be said to be recognised by law. Admittedly, there are no goods involved in this

case. There is a distinct work inasmuch as what the plaintiffs have done is to start a reality show containing several episodes. According to them, the show involves real life characters whereas what the defendants are intending to do is to distribute a feature film. When nothing is stated about the contents, then, merely on the basis of the similarity of the title, the defendants cannot be restrained from releasing the film. Mr.Kamdar submitted that there are several instances of similarity in titles of films and television shows. For example there is a film “Andaz” and with the same title new films were made so also TV shows and serials. In such circumstances, mere similarity of title, without anything more, is not enough to claim injunctive relief of the present nature. According to Mr.Kamdar, there cannot be any prima facie case made out because the title is not a product in the sense understood in law. Further, the balance of convenience is also not in favour of plaintiffs because the film is slated to be released on 3rd September 2010. Almost 300 prints are already handed over and forwarded to the distributors and exhibitors. In such circumstances, if an injunction is issued that would cause tremendous loss so also set back to the reputation and goodwill of the defendants in the market.

21] Without prejudice to these submissions and merely to allay any fear and apprehension of copying the title the learned Senior Counsel states, on instructions, that defendants would issue a clarification/ disclaimer clarifying that the film of the defendants has nothing to do with the reality show of the plaintiffs and there is no attempt to copy the contents or cause any confusion or deception in the minds of the viewing public.

22] Mr.Kamdar's submissions have been adopted by Mr.Purohit appearing for defendant Nos. 1 and 2.

23] In rejoinder, Mr.Tulzapurkar would urge that the question of delay does not arise because the plaintiffs have moved with necessary expediency and only after the registration was brought to their notice, could they have filed the instant suit. That was noticed in July 2010. If the registration is recent one i.e. 21st July 2010, then it cannot be said that the plaintiffs have approached this Court after unexplained and enormous delay, particularly when the plaint has been lodged and declared on 21st August 2010. Therefore, there is no substance in the contention of

Mr.Kamdar with regard to the application being belated.

24] As far as reliance placed by Mr.Kamdar on the Division Bench decision of this Court reported in A.I.R. 1942 Bom. 241 (K.M.Multani Vs. Paramount Talkies of India Ltd.), Mr.Tulzapurkar would urge that the report reproduces the observations of the learned Single Judge (His Lordship Justice Wadia) from whose judgement and order an appeal was preferred before the Division Bench. As far as the Division Bench goes, the same does not approve the reasoning but clarifies that the Courts frequently have to adapt old established principles to new conditions of life, and it is quite possible that in relation to the film industry some developments may take place in the law relating to passing off. Further, the Division Bench has clarified that the advent of the film under a particular title had been very extensively advertised and arrangements made for the booking of the film and in which some other person produced a film under the same title shortly before the advertised film arrived. In such situation the nature of passing off action would succeed, although generally the plaintiff must establish the reputation of his property by actual results. Thus the contents are something which is not

relevant at this stage. It is not necessary for the plaintiffs to aver and allege that the contents of the work in question are identical. Therefore, and when such an aspect has been recognised now by Trademark Act, 1999 and more particularly section 29(4) thereof, then all the more this Court should proceed on the basis that the claim for passing off is wholly maintainable. Mr. Tulzapurkar, therefore, submits that the injunction as prayed be granted.

25] With the assistance of the learned Senior Counsel appearing for parties, I have perused the plaint and relevant annexures so also the judgements brought to my notice. Since, extensive arguments have been canvassed at the ad-interim stage, I proceed to dispose of this motion finally.

26] The plaint proceeds on the basis that the plaintiffs have been incorporated as companies (two distinct companies). The first plaintiff is part of UTV Group of Companies which is engaged inter alia in the business of providing content production services, producing movies, television shows, broadcasting, offering interactive gaming and new

media. The plaintiffs operate two satellite TV channels in India known as UTV Bindass and UTV Action, which was formerly known as UTV Bindass Movies which show youth centric entertainment programmes and movies respectively since 2007. Plaintiff No.2 is the flagship company of UTV group and is a reputed and established media and entertainment company, engaged inter alia, in the business of television broadcasting, producing and distributing movies, providing animation and gaming interactive services, producing television content and related activities and services.

27] It is undisputed that the plaintiffs have on their TV channel been telecasting reality shows. The details of such reality shows are set out in para 4 of the plaint. It is further undisputed that the present show on which the claim in the plaint is based is another reality show. UTV Bindass is the satellite TV channel and one of the reality shows thereon is EMOTIONAL ATYACHAR, that is produced by plaintiff No.2. Further, the claim is that the title of this reality show is deceptively similar to the title of “the film EMOTIONAL ATYACHAR”, which is produced and distributed by the defendants. Beyond this, there is no claim of passing

off based on either the contents of the show or that of the film. It has been clarified that for making such a claim, the plaintiffs need not allege and prove that the contents of the film are identical to that of a reality show. Therefore, on the strength of registration of title with the Association of Motion Pictures and TV Programme Producers, which is the parent body of TV programme producers undertaking title registration so also on the basis of the Registration dated 19th June 2008 evidenced by the certificate at Annexure A to the plaint, that the suit claim has been laid.

28] In somewhat identical circumstances and when one of the reality show of the plaintiffs titled DADAGIRI was sought to be copied by another TV channel Zee TV, Bangala with title “DADAGIRI unlimited”, that I had an occasion to deal with similar arguments. In my order dated 25th September 2009, in Notice of Motion No.2945 of 2009 in Suit No. 2083 of 2009 (Genex Entertainment Ltd. Vs. Zee News Ltd.) this is what is observed by me:-

“10] Mr.Tulzapurkar, learned Senior Counsel appearing for

plaintiffs contended that the plaintiffs are entitled to temporary injunction as prayed. He submits that a perusal of the Annexures to the plaint would indicate that the attempt is to copy the mark. Mr. Tulzapurkar has invited my attention to Annexure A to the plaint. He has also invited my attention to Annexure B and more particularly page 27. He has then invited my attention to page 30 of the plaint and contended that the word "Dadagiri" has been used as a registered trade mark in relation to services relating to distribution and advertisement of cinematographic films, DVDs, VCDs, CDs, Audio and Video CDs, audio and video cassettes and other electronic disc formats, organisation of exhibition of various forms of films for commercial or advertising purposes being services included in class 35. He has then contended that broadcasting and telecasting of Cinematographic films in theaters, studios, multiplexes as also TV and Video Advertisement and documentary films and serials, production of cinematographic films being services included in class 41 are also covered by the Registration Certificate issued in

favour of the plaintiffs by Trademark Registry. He submits that on the strength of this so also on the basis of the certificate issued by the Association of Motion Pictures and TV programme Producers dated 2nd September 2008, it is clear that the TV serial bearing name Dadagiri with the typical way of lettering is associated with none else than the plaintiffs. He submits that plaintiffs exclusive right to use the said word mark in relation to the services is absolute. That the reputation and popularity is immense is substantiated by the revenue generated. Further the investment in the project/ TV show on Bindass Channel is enormous as is evident by the publicity and other materials. In these circumstances and cashing on to the popularity of the name of the plaintiffs' game show which has already completed its first part and now is into second part, the defendants have deliberately started a quiz show on their Bengali channel with the same title. Had it not been for the plaintiffs' title and mark, it would not have been the title for the defendants' quiz show. It may be that the quiz show is in

Bengali language and is to be aired on Zee Bangla channel but it is evident from the fact that even in West Bengal, the plaintiff's show Dadagiri is immensely popular and enjoys wide viewership therein together with other parts of India. Therefore, it being telecast on the Bangla channel is not of much significance. On the other hand, it shows that even for the Bangla channel programme which is targeted at the Bengali speaking audience, the defendants deliberately chose the name "Dadagiri" and have advertised their programme in such a manner as would confuse the viewer public. The font and the manner in which the word has been written indicates that the attempt is to copy plaintiffs' mark. Mr. Tulzapurkar has invited my attention to pages 266 to 288 of the plaint paperbook and has contended that a prima facie case has been made out and, therefore, this Court should grant interim injunction as prayed."

"12] He submits that a closer look at the plaint averments would demonstrate that there is no basis for plaintiffs claim

in law. Mr.Dwarkadas has contended that the Trademark Act, 1999 is not intended to apply in such cases at all. Mr.Dwarkadas submits that the mark has to be registered in relation to goods and services. In the present case, the plaintiff has been carrying on business in the name and style of Genx Entertainment Ltd. He submits that the plaintiffs themselves have set out in the plaint that they are part of UTV Group of Companies which is engaged, inter alia, in the business of providing content production services, producing movies, TV broadcasting, offering interactive gaming and news media. Plaintiffs operate its two satellite channels in India known as UTV Bindass and UTV Bindass movies, which show youth centric entertainment programmes and movies respectively. Mr.Dwarkadas submits that there cannot be any statutory or common law right in the title of a quiz show”.

“...He submits that the said show on the TV channel is not an independent service. It is not “goods” either. The service that is provided is by UTV Group of Companies of which

plaintiff is a part. The service is of production of movies, TV broadcasting and related services. The word “Dadagiri” is just a title of a TV show/ serial. He submits that its registration allegedly cannot be seen as something exclusive to the plaintiffs. He submits that the word “Dadagiri” is a common word. It means bullying and ‘throwing ones weight around’. There is nothing special in this word and it is of common usage. Even if it is a title of a film or TV show, does not mean that it is an exclusive trademark in relation to the goods and services. Therefore, such word which is commonly used and several films and programmes with that name having been aired till date would go to show that the plaintiffs cannot claim any rights therein. When they cannot claim any rights therein in law, then, there is no question of the certificates produced enabling them to protect the word “Dadagiri”. He submits that the provisions relating to infringement and passing off would, therefore, be completely inapplicable. The whole foundation or basis of the suit being untenable in law, the application for interim relief/ injunction

must be dismissed”.

13] “... In such circumstances, registration of the mark Dadagiri in relation to the services contemplated by class 35 cannot be of any assistance to the plaintiffs. They have admittedly not produced any movie by the name “Dadagiri”. Further, their channel is also not known as Dadagiri.

“... They may be dealing in cinematographic films and TV channels and airing TV programmes on their TV channel but as pointed out none of these services can be registered in the name and style “Dadagiri”.”

15] The Trademark Act, 1999 is an Act to amend and consolidate the law relating to trademarks to provide for registration and better protection of trademark for goods and services and for prevention of the use of fraudulent marks. The Trademark Act was earlier known as Trade and Merchandise Marks Act, 1958. The competent Legislature amended it bearing in mind the developments in trading and

commercial practice, increasing globalisation of trade and industry, the need to encourage investment flows and transfer of Technology, need for simplification and harmonisation of trade mark management system. In addition to registration of trademark for goods, the Act now provides for registration of trademark for services”.

“16] In the definitions, the word “deceptively similar” is defined in section 2(h). It means that the mark is deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion. The word “goods” is defined to mean anything which is the subject of trade or manufacture. The word “mark” is defined thus:-

“2(m): “Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.”

“It is the inclusive definition and includes device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods etc. However, what is material for our

purpose is the concept of registration. The term “Registration” is defined in Section 2(t) to mean Register of Trademarks and Registered is defined in section 2(u) to mean Registration under this Act. The Registered Proprietor is defined in section 2(v) to mean a person for the time being entered in the register as proprietor of the trademark. The word “service” is defined in section 2(z) and reads thus:-

“2(z): “Service” means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising”

16] The word Trade mark is defined in section 2(a)(b) and reads thus:-

“2(z)(b): “Trademark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and -

(i) *In relation to Chapter XII (other than section 107), a registered trademark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and*

(ii) *in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.”*

“18] Ultimately, the Act is for registration of Trademark and for the purpose of registration, classification of goods and services is provided for. The term mark includes a label, name, word. However, one must make a distinction between the term “mark” and “trademark”. The trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours and when used in relation to service, it should indicate a connection in the

course of trade between the service and some person having the right either as proprietor or by way of permitted user, to use the mark without any indication of the identity of that person and includes a certification trade mark or collective mark”.

“19] In the judgement reported in 138 (2007) Delhi Law Times 312, a learned Single Judge of Delhi High Court was considering the question as to whether a film with the name “Nisshabdh” can be released by the first defendant as the plaintiff has exclusive right over the said title. He had already produced a movie with title “Nishabdh”. Thus, the case was of a film of the plaintiff which had already won critical and popular acclaim and the allegation was that its name is being copied by the first defendant malafide. This is the attempt to usurp plaintiffs’ rights over the title Nishabdh. After factual narration in para 3 and while referring to the prayers and the arguments of both sides, the learned Single Judge then discussed the law on the subject. In para 10, he

refers to the fact that the case is relating to alleged misappropriation of a title. The case is not of any usurpation of the work of plaintiff by the defendants. The plot and storyline of two films is altogether different and there is no semblance of similarity between the two. It is the title given to the Literary or Entertainment work which alone was subject matter of consideration. Referring to the American courts views, it has been held by the learned Judge in para 12 that title alone of a literary work cannot be protected by copyright law. Copying of the title alone and not the plot, characterisation, dialogue, song etc. is not the subject of copyright law.”

“20] Legal protection for literary titles lies in the field of trademark and unfair competition and the learned Judge, thereafter, refers to the types of titles. He has then observed that TV serials which run into hundreds of episodes and made in series. He has given several illustrations in para 14. The learned Judge says that titles of single literary work had

enjoyed trademark protection, but in order to be entitled to protection, it is necessary to prove that such a title has acquired secondary meaning. With regard to titles or series of books, periodicals or newspapers, they are registrable as trademarks and series titles enjoy the said protection as usual trademark. But with regard to single literary work, the assumption is that it must have acquired the secondary meaning and is capable of associating itself with a particular work or source, the question of likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers/ users would arise and this aspect has been considered by the learned Single Judge in details in the latter part of the judgement”.

“22] In the case before me, an attempt is to show that the word “Dadagiri” is the word mark of plaintiffs exclusively associated with them. Upon careful perusal of the plaint, it is clear that what is emphasised is the presence of UTV Software and Communications Ltd., UTV Group of

Companies. What is emphasised is two satellite TV Channels, UTV Bindass and UTV Bindass Movies. The plaintiff is telecasting programmes, Games and Reality show which aim to target ordinary Indian youth through these two satellite TV channels. They are owned by the plaintiff which is a UTV Group of companies. It is not the case of plaintiffs that the word UTV Bindass and UTV Bindass Movies, is copied. What they are projecting is that for the last two years, the UTV Bindass TV channel aired numerous shows and one successful reality show broadcasted is titled "Dadagiri". Now, the title Dadagiri is stated to be the mark, registered as a trademark. The word mark registration is in relation to goods in class 18. The registration of the wordmark Dadagiri in relation to these goods is admittedly of no assistance and not even pressed before me".

"25] One more thing that is worth noticing is that the plaintiffs are not alleging that the concept of their programme Dadagiri which is aired on their channel is copied. The

contents thereof are not in issue. It is not the case of the plaintiff that the plot, storyline has any similarity with that of the defendants' programme "Dadagiri Unlimited". Admittedly, plaintiffs' programme is consisting of college going youth. It is a game show which gives four contestants a chance to re-live the first day of their college life by surviving quintessential bullies in three rounds. It is in relation to these three bullies and their activities that the word "Dadagiri" has been used as title of this show. The concept is outlined in para 5 of the plaint and what is urged that the programme which is to be aired on the Zee Bangla TV channel is a Bengali quiz show. Thus, conceptually the programmes are not identical. The content is also not identical, although both programmes may be targeted and aimed at youth viewers".

"26] Thus, the registration of the word mark Dadagiri in relation to some of the services of the plaintiffs can be said to be of no assistance inasmuch as there is no dispute that both

plaintiff and defendants are distinct TV channel companies. Their names are not identical. The business activities may be identical but in relation to the defendants the viewer ship also is not claimed to be as wide as that of the plaintiff.

“....It is not the case of plaintiff that their channel name is in any way copied. It is their case that one of the programmes which is aired on their T.V. Channel has a title Dadagiri and it is that title which is copied. I fail to understand as to how these averments can be of any assistance to the plaintiffs for alleging infringement of their trade mark Dadagiri, even if it is assumed to be a word mark capable of being registered under the Trademarks Act, 1999. The word Dadagiri is used in relation to the concept or the contents of TV show title Dadagiri aired on UTV Bindass TV channel of the plaintiffs. The defendants are using the said title because the Anchor of their quiz show Mr.Saurav Ganguly, ex-captain of Indian Cricket Team, is known as Dada/ elder brother in West Bengal. Apart from this fact that

the word “Dadagiri” is registered in relation to goods which are admittedly not the business activities of either of the parties, assuming that it is capable of being registered by the plaintiffs as a word mark in relation to their services, yet, mere usage of that word as title of TV show/programme can by no stretch of imagination be made the subject matter of an action of infringement of the word mark by the plaintiffs”.

“27] It is urged that the title of the plaintiffs’ film before the Delhi High Court “Nishabdh” was not registered as a trade mark and, according to Mr.Tulzapurkar, therefore, this decision is distinguishable and of no assistance to Mr.Dwarkadas. Mr.Tulzapurkar has also invited my attention to the fact that a further affidavit has been filed by the plaintiffs, a copy of which has been duly served on the defendants, wherein the word mark “Dadagiri” is registered in class 41. He submits that class 41 pertains to services relating to entertainment and exhibition of cinematographic films and his special emphasis is on the words “all medias

and motion picture Television”. This also cannot be of any assistance assuming that the defendants have not disputed the contents of the affidavit or the registration certificate. The channel of the plaintiffs is not known as “Dadagiri” channel. The channel has a distinct name and Dadagiri is only title of one of the shows that is aired on the plaintiff’s channel. This word is also undisputedly of common usage. In such circumstances, how the certificates can be of any assistance, when they are in relation to the services of TV, is not clear to me at all. I am not entering into the controversy as to whether the word mark Dadagiri is capable of being registered or not. I am proceeding on the basis that it is so capable but its registration as a word mark must be in relation to services rendered in the aforementioned class. Merely because the title of a particular show or programme on the plaintiff’s channel is Dadagiri, then, these registration certificates cannot be the basis for claiming the interim reliefs”.

29] There, proprietorship of the mark was claimed with a right of exclusive user. That was the registered trademark in relation to certain goods and services the class of which has been indicated. The allegation was that Zee TV Bangla is going to air an identical TV show with Mr.Saurav Ganguly, Ex-India Cricket Captain being the Chief Feature. That was a Bengali Quiz Show featuring him. Therein also reliance was placed by Mr.Tulzapurkar on the judgement of the learned Single Judge of Delhi High Court (supra). I had occasion to peruse that judgement carefully. Further, a careful perusal of the same would indicate that ultimately, the Delhi High Court did not accept the claim of the plaintiffs therein. The Delhi High Court has rejected the injunction application. Therefore, the observations on which reliance is placed by Mr.Tulzapurkar and particularly paras 10 and 13 to 15 of this judgement, together with para 18 must be read in the backdrop of the fact situation. The test of passing off is well settled. It is not as if the statutory recognition of that concept is not there. In the present case, the plaintiffs on their own showing state that they do not have any trademark in the name or title EMOTIONAL ATYACHAR. In fact in their cease and

desist notice, this is what is stated:-

“... In order to protect their valuable common law right in the name and trade mark EMOTIONAL ATTYACHAR, our clients have filed necessary application thereof under the provisions of the Trademarks Act, 1999 which applications are pending. Nevertheless by virtue of honest adoption, prior use and wide publicity undertaken by our clients for their name and trade mark EMOTIONAL ATTYACHAR when used in relation to their reality show broadcast on television, our clients claim exclusive proprietary rights therein”

“... Our clients state that the reputation of their mark EMOTIONAL ATTYACHAR spreads far and wide and much beyond the scope of the actual services offered by them thereunder and any unauthorised use of the said name and /or of a mark closely similar thereto, in relation to allied and like description of services, is likely to be co-related by the viewers and the trade with our clients. That our clients

attach great value to their name and trademark EMOTIONAL ATYACHAR and cannot allow the same to be misused by anyone in relation to like description of services, least of all by you.”

30] It is on the basis of passing off alone and that too in the title that the instant claim has been led pressed. Mr.Kamdar’s reliance upon the Division Bench decision of this Court in K.M.Multani (supra) is apposite. The learned Single Judge’s observations therein cannot be brushed aside at this prima facie stage. Ultimately, the appeal therefrom is dismissed. Therefore, the observations and findings at pages 244 and 245 certainly have a precedential value. Mr.Tulzapurkar would urge that the Division Bench has not approved part of the reasoning of the learned Single Judge. In fact, some of the observations of Beaumont C.J. on the Test of passing off are also referred by the Hon’ble Supreme Court in Cadilla Health Care Vs. Cadilla Pharmaceuticals Ltd., reported in A.I.R. 2001 S.C. 1952 (See para 35). Thus, the Division Bench ruling also supports my view.

31] The Delhi High Court had referred to the tests and held that the test of secondary meaning in respect of literary title is explained by McCarthy and that part is quoted in para 19. It is essentially one of determining whether, in the minds of a significant number of people, the title in question is associated with a single source of the literary work. That is, are people likely to assume that defendant's work is connected in some way with the producers of plaintiff's literary effort? The association need be only with a single, anonymous source. That is, the consumer need not know the trade name of the source, but is entitled to assume that all works or goods under that title are controlled by some single source. Further, referring to English judgements, the Delhi High Court held that each literary work is a specific, separate and unique commercial item and not as one product among many competing products. The reason is simple. Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Therefore, each literary title is regarded as a term used to describe the product itself, rather than a mark used to designate a single source among many sources of literary works. I fail to understand as to how reliance can be placed on some observations of the Delhi High Court ignoring the principles and

tests that have been followed and applied therein.

32] If these tests are applied, it is evident that the plaintiffs are not alleging that their TV Channel UTV Bindass or UTV Action and any rights pertaining thereto are being affected. They do not dispute that beyond a reality show of this title, they are not making any claim on the contents of the show and the film. All that is alleged is that there is registration of the title which is prior in point of time. It may be that the business is somewhat identical but for the reasons that I have recorded in the case of DADAGIRI (supra) and applying the principles set down by Division Bench of this Court and the the learned Single Judge of Delhi High Court, I am of the view that plaintiffs are not entitled to the interim injunction as prayed. This is not a case where beyond similarity of the title and that too not of a feature film but a reality show, that there is anything alleged which would demonstrate even prima facie that the works are deceptively similar. On the basis of similarity of title plaintiffs cannot succeed in this case. There is some substance in the complaint of Mr.Kamdar that such an action on the basis of registration of title of reality show by itself would not give any right to sue and claim

permanent injunction, much less of the sweeping nature as claimed in the instant case.

33] The film of the defendants is slated for release on 3rd September 2010. Prints are also forwarded to the distributors and exhibitors. It is for this reason as well I do not think that it would be proper to grant any ad-interim injunction and much less in the terms prayed by the defendants.

34] Therefore, for failing to make out a prima facie case and even the balance of convenience not being in favour of the plaintiffs, the injunction application must fail and it is accordingly dismissed. In the view that I have taken, it is not necessary to rule on the objection of delay and laches. Any wider controversy need not be gone into in the facts and circumstances of the case. Motion is dismissed. No costs.

(S.C.DHARMADHIKARI, J)