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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 803/2017, IA No.13724/2017 (under Order XXXIX
Rules 1&2 of the CPC) and IA No.13728/2017 (under Section 151
CPC for hearing in camera).

MATTEL, INC. & ANR Plaintiffs
Through: Mr. Pravin Anand, Ms. Tush
Malhotra & Ms. Rashi Punia, Advs.
Versus
MS. AMAN BIJAL MEHTA & ORS Defendants
Through: None.

CORAM:
HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW
ORDER
% **22.11.2017**

1. The parties are advised to chill. In spite of this unusual advice *inter alia* to the plaintiff no.1 Mattel, Inc., given by the United States Court of Appeals, Ninth Circuit in a judgment (reported as 296 F.3d 894, in an appeal preferred by the plaintiff no.1 Mattel, Inc. in a *lis inter alia* with MCA Records, Inc.), the plaintiff no.1 Mattel, Inc. has now raised the same heat, as raised in that *lis* before the United States Court of Appeals, Ninth Circuit, in this Court, in this suit filed in conjunction with its Indian subsidiary Mattel Toys (India) Pvt. Ltd., plaintiff no.2 herein, against the producers of a Hindi film titled *Tera Intezaar* due to be released on 24th November, 2017.

2. The suit along with the application for interim relief and the application under Section 151 of the Code of Civil Procedure, 1908 (CPC) for holding the hearing on the *ex parte* injunction prayers in camera came up first before this Court today morning for admission. It was enquired from

the counsel for the plaintiffs, whether he desired the hearing of the application for ‘in camera hearing’ also to be in camera. On the counsel for the plaintiffs answering in the affirmative, the matter was ordered to be taken up in Chamber at 1415 hours.

3. The counsel for the plaintiffs has at the outset been heard on the need for holding in camera hearing.

4. The counsel for the plaintiffs has contended that this suit pertains to a highly confidential subject matter which may invoke media attention leading to distorting/misrepresenting of facts and the proceedings before this Court and in the absence of media reporting the parties may also be more receptive to a settlement.

5. The plaintiffs claim to be the owner of the “BARBIE” trademark used in relation to toy dolls and other merchandise related to or connected to the toy doll named “BARBIE”.

6. It is pleaded (i) that the plaintiffs have produced or licensed the product to numerous motion pictures based on plaintiffs’ world famous “BARBIE” brand; (ii) the plaintiffs have worked with various public figures to create Barbie Dolls in their likeness; examples are given of Diana Ross, Audrey Hepburn, Princess Kate Middleton, J.K. Rowling, Grace Kelly, Jenifer Lopez, Marilyn Monroe, Shakira and the popular Indian actress Katrina Kaif; (iii) that the plaintiffs, around 15th November, 2017, came across a music video on YouTube of a song titled “Barbie Girl” from the movie *Tera Intezaar* scheduled to be released on 24th November, 2017; (iv) that the title and lyrics of the song used the registered and well known trademark “BARBIE” without an authorisation of the plaintiffs and in a

manner antagonistic to the values and interests of the customers target base, the plaintiffs cater to; (v) that the Encyclopedia Britannica lists Barbie as an 11-inch tall plastic doll with figure of an adult woman that was introduced in 1959 by Mattle Inc.; (vi) the sales in India of Barbie products over the last five years have exceeded 2000 million Indian rupees; (vii) “BARBIE” reflects an aspirational figure on which the consumers project to their dreams and aspirations; girls across the globe identify the Barbie as a role model; Barbie connotes a friend and confidante to an entire generation of girls; (viii) the Barbie doll has multiple careers including of a doctor, surgeon, firefighter, tennis player, astronaut etc.; (ix) Barbie has been identified as a well known trademark in various jurisdictions; (x) the actress / female dancer in the impugned song / video is also seen to be inspired from the plaintiffs Barbie as she is dressed in a baby pink dress and is found to be performing some dance steps portraying to be the plaintiffs’ Barbie mannequin doll; (xi) the defendants have adopted the mark “BARBIE” as a catchy word in the title and lyrics of their impugned song / music video solely to generate publicity and attract unwanted attention for commercial exploitation and gain; (xii) with this intention the promotions and teasers of the impugned song used the script similar to that as plaintiffs’ trademark; (xiii) use of the defendants of the trademark “BARBIE” in their song amounts to infringement and dilution of the plaintiffs’ trademark; (xiv) the lyrics of the impugned song “I’m a sexy Barbie girl.....hip matke chaal.....milky milky gaal.....Barbie beauty ko sambhaal.....” etc. are suggestive of an adult woman who is sexually attractive and enticing; (xv) that the Barbie girl in the impugned song has been impersonated by an

actress who is a prominent figure from the adult entertainment industry; and, (xvi) that the contents of the impugned song / its video are not suitable for children and are provocative and inappropriate for younger girls and children, tarnishing and degrading the distinctive quality of the mark “BARBIE”.

7. The counsel for the plaintiffs has justified ‘in camera hearing’ contending that any kind of publicity would prejudicially affect the plaintiffs. It is contended that an *ex parte* ad interim injunction, as sought by the plaintiffs, would also serve the purpose of the defendants by bringing undue publicity to their film and the song. Orders in cases, where ‘in camera hearing’ was sought and granted are cited and on enquiry it is informed that they all relate to trademark / patent / infringement cases.

8. I have enquired from the counsel for the plaintiffs, whether the entire proceedings in the suit can be in camera i.e. not only at the *ex parte* stage but even subsequently and how can the orders to be passed in the suit be prevented from being uploaded on the website of this Court accessible to one and all, as is the norm.

9. The counsel for the plaintiffs states that he will not go as far and is only pressing for *ex parte* hearing of the application to be ‘in camera’ and thereafter the proceedings can be in open Court and which cannot be prevented.

10. I fail to see the purpose in the *ex parte* hearing also being in camera if ultimately the dispute is to come out in the open and reporting in the media thereof cannot be prevented.

11. Thus, IA No.13728/2017 is dismissed.

12. However instead of moving the hearing from Chamber to the Court, merely for convenience, the hearing is not disrupted and the counsel for the plaintiffs has been heard on the application for interim relief also in Chamber only.

13. Having remembered the song “Lets go party”, also with the name “BARBIE” from the earlier days and the lyrics of the same also to be provocative, I have enquired about the same from the counsel for the plaintiffs and have after the hearing checked on the internet the lyrics of the said song. The said song by the band ‘AQUA’ is also found to have contents as “ Hi, Barbie.....Hi, Ken..... Do you wanna go for a ride?..... sure ken! jump in.....I'm a Barbie girl I am a Barbie girl in the Barbie world.....you can brush my hair.....undress me everywhere...I'm a blond bimbo girl in a fantasy world.....dress me up, make it tight, I'm your dolly...feel the glamour in pink.....kiss me here, touch me there, hanky panky.....you can touch, you can play, if you say, "I'm always yours", with uu-oooh-u-u.'s and ah-ah-ah-yeah's interspersed.

14. Though the counsel for the plaintiffs in the plaint has not referred to the said song but immediately on my asking produced the copy of the judgment aforesaid of the United States Court of Appeals, Ninth Circuit and of which I must admit, I was not aware.

15. A perusal of the aforesaid judgment shows the plaintiff no.1 Mattel, Inc. to have brought the action, from which the appeal to the United States Court of Appeal arose, against the music companies marketing the aforesaid “Lets go party” song, on similar grounds as on which the plaintiffs are seeking to restrain the defendants therein.

16. It is found that the United States District Court for the Central District of California denied relief to the plaintiff no.1 Mattel, Inc. and against which denial the plaintiff no.1 Mattel, Inc. appealed to the United States Court of Appeal, Ninth Circuit, which held (i) music companies' use of "BARBIE" mark in song was not an infringement of toy manufacturer's trademark associated with the doll; (ii) song that lampooned toy manufacturer's doll fell under non-commercial use exemption in Federal Trademark Dilution Act; (iii) trademark rights do not entitle the owner to quash an unauthorized use of the trademark by another who is communicating ideas or expressing points of view; (iv) trademark owner does not have the right to control public discourse merely because the public imbues his mark with a meaning beyond its source identifying function; (v) music companies' use of "BARBIE" mark in song was not an infringement of toy manufacturer's trademark associated with doll; (vi) "Dilution" refers to the whittling away of the value of a trademark when it is used to identify different products; injury from trademark dilution usually occurs when consumers aren't confused about the source of the trademark; (vii) trademark law grants relief only against uses that are likely to confuse; (viii) although the boundary between commercial and non-commercial speech has yet to be clearly delineated, the core notion of commercial speech is that it does no more than propose a commercial transaction; and, (ix) if speech is not purely commercial, that is, if it does more than propose a commercial transaction, then it is entitled to full First Amendment protection.

17. It was the contention of the plaintiff no.1 Mattel, Inc. before the US Courts also that the song 'Lets go party' is inappropriate for young girls.

However the advice given *inter alia* to the plaintiff no.1 Mattel, Inc. as aforesaid was “to chill”.

18. Internet research also shows that though the plaintiff no.1 Mattel, Inc. applied to US Supreme Court but the US Supreme Court also denied *certiorari* relief in the matter.

19. Though it is the contention of the counsel for the plaintiffs during the hearing that the ‘sexuality’ angle’ was not in issue in the proceedings in the US Courts but reading of the judgment shows otherwise.

20. I have during the hearing also drawn attention of the counsel for the plaintiffs to the order dated 16th November, 2017 of the Supreme Court in W.P.(C) No.1119/2017 titled ***Nachiketa Walhekar Vs. Central Board of Film Certification*** in a proceeding to issue a writ for staying the nation wide release of a film namely “An Insignificant Man” as it contained a video clip pertaining to the petitioner. It was the contention of the petitioner before the Supreme Court that the said video clip was originally shown by media but after a complaint case was filed, it was not shown and therefore such a film should not be granted certificate by the Central Board of Film Certification (CBFC). It was further contended that the petitioner had a right under Article 14 and 21 of the Constitution of India that he should not be projected in a manner in which the film was going to depict.

21. The Supreme Court held that:-

“It is worthy to mention that freedom of speech and expression is sacrosanct and the said right should not be ordinarily interfered with. That apart, when the respondent No.1, CBFC, has granted the certificate and only something

with regard to the petitioner, which was shown in the media, is being reflected in the film, this Court should restrain itself in not entertaining the writ petition or granting injunction.

Be it noted, a film or a drama or a novel or a book is a creation of art. An artist has his own freedom to express himself in a manner which is not prohibited in law and such prohibitions are not read by implication to crucify the rights of expressive mind. The human history records that there are many authors who express their thoughts according to the choice of their words, phrases, expressions and also create characters who may look absolutely different than an ordinary man would conceive of. A thought provoking film should never mean that it has to be didactic or in any way puritanical. It can be expressive and provoking the conscious or the sub-conscious thoughts of the viewer. If there has to be any limitation, that has to be as per the prescription in law.

The Courts are to be extremely slow to pass any kind of restraint order in such a situation and should allow the respect that a creative man enjoys in writing a drama, a play, a playlet, a book on philosophy, or any kind of thought that is expressed on the celluloid or theater, etc.”

22. Though the counsel for the plaintiffs vaguely suggested that laws of India are different from that applied by US Courts but it cannot be forgotten that India has the benefit of one of the most modern and liberal Constitutions, one of the most cherished rights wherein is to speak one's mind and write what one thinks, no doubt, that is subject to reasonable restrictions, but then the ambit of what one can do is wide (reference Justice Sanjay Kishan Kaul speaking for the Division Bench of the High Court of Madras in *S. Tamilselvan Vs. The Government of Tamilnadu* 2016-3-L.W.

577).

23. The law has constituted CBFC to adjudge the need if any for imposing ‘prior restraints’ which otherwise are at serious odds with the fundamental right enshrined in the Constitution of speech and expression. Thus, once a film has been cleared by CBFC for viewing, there is a presumption in its favour including of the same being not defamatory of any one. If after a film has been so cleared by CBFC, the Courts were to act as super Censor Board at the mere asking, it will have the potential of imposing arbitrary and at times irrational prior restraints causing severe damage to the right of freedom and expression.

24. Internet research also shows the United States Court of Appeals, Ninth Circuit to have in *Mattel Inc. Vs. Walking Mountain Products* 353 F.3d 792 (2003) also not accepted the argument of the ‘market harm by impairing the value of Barbie’, reasoning the infringement therein to be perceived as a ‘parody of Barbie’.

25. Barbie is seeking in India what has been denied to it in the Court of its origin.

26. I am also reminded of another famous toymaker “Toys – R – Us”. The toys are asserting rights as humans were known to assert till now.

27. Two reasons aforesaid are in my view enough to disentitle the plaintiffs to any *ex parte* relief.

28. I may however add that the judgment aforesaid of the US Court also states that ““Barbie was born Germany in 1950s as an adult collector’s item. Over the years, Mattel transformed her from a doll that resembles a “German street walker”, as she originally appeared, into a glamorous, long

legged blonde. Barbie has been labelled both the ideal American woman and bimbo. She has survived attacks both psychic (from feminists critical of her fictitious figure) and physical (more than 500 professional makeovers). She remains a symbol of American girlhood, a public figure who graces aisles of toy stores throughout the country and beyond. With Barbie , Mattel created not just a toy but a cultural icon”.

29. Mention may also be mentioned of the fact that Barbie is a nic name for Barbara a common name in the Western world. The use of the name Barbie in a song has to be viewed in the said light also.

30. There is another reason for which I am of the opinion that no case for grant of *ex parte* order sought, restraining the defendants from releasing the film *Tera Intezaar* with the impugned song, ought not to be granted. The newspapers and the stories on the electronic news media in the country are today widely broadcasting the demand by one section of the society for a ban to another film. The petitions filed in the Supreme Court in this regard have not met with any success and have been disposed of as premature owing to the CBFC having not granted certificate to the film as yet. I am of the opinion that grant of any order as sought is likely to send a wrong signal to the public at large.

31. Though traditionally grant of orders under Order XXXIX Rules 1&2 of the CPC was governed by the elements of *prima facie* case, irreparable injury and balance of convenience only but it is settled law that an interim order can also be refused if the same is not found to be in public interest.

32. I will be unfair to the counsel for the plaintiffs if I do not record that he has during the hearing handed over a compilation of judgments on the

subjects of (i) Bloomberg, deletion and removal; (ii) infringement through objectionable content; and, (iii) trademark dilution; and, on (iv) in camera proceedings and has contended that there is no case of pornographic association, in which injunction has been refused. However, it is deemed appropriate by me to consider and deal with all the aforesaid pleas at the after notice stage.

33. Issue notice / summons of the suit to the defendants by all modes including *dasti* and electronic, returnable on 30th November, 2017.

34. It will be open to the counsel for the plaintiffs to, with or without a copy of this Order, call upon the defendants to delete the word “BARBIE” from the impugned song and to notify the defendants that on their failure to do so, the plaintiffs would be entitled to damages from the defendants.

RAJIV SAHAI ENDLAW, J

NOVEMBER 22, 2017

‘pp’ ..