

IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTIONNOTICE OF MOTION (L) NO. 1640 OF 2013INSUIT (L) NO. 722 OF 2013

M/s. Narayani Production and another ...Applicants

In the matter between:

M/s. Narayani Production and another ...Plaintiffs

vs.

M/s. Prakash Jha Production and others ...Defendants

Mr. A.K. Singh, instructed by M/s. Lex Remedeum, for the Applicants/Plaintiffs.

Mr. V. Dhond, Senior Advocate, along with Dr. Birendra Saraf and Mr. Ameet Naik instructed by M/s. Naik Naik & Company, for Defendant Nos. 1 and 2.

Mr. Snehal Shah, instructed by Mr. Atul Mankame for Defendant No.3.

Mr. Ravi Kadam, Senior Advocate, along with Mr. Vivek Shetty and Mr. Rishikesh Sony, instructed by M/s. DSK Legal, for Defendant No..4.

CORAM: S.J. KATHAWALLA, J.**DATE: AUGUST 28, 2013.****P.C.**

The above suit is filed by the Plaintiffs seeking a perpetual injunction against the Defendant Nos. 1, 2 and 4 from using, circulating, exhibiting, showing, distributing in any audio-visual format such as cinematic format/DVD,CD, film, movie or internet or any website the

name of the feature film titled "SATYAGRAH" in any manner. In the alternative, the Plaintiffs have sought damages in the sum of Rs. 25,00,000/- from the Defendants. A Notice of Motion is also taken out by the Plaintiffs seeking a temporary order and injunction restraining the Defendant Nos. 2 and 3 from proceeding with the release of the movie "SATYAGRAH".

2. An application for urgent ad-interim relief restraining Defendant Nos. 1, 2 and 4 from releasing the feature film titled "SATYAGRAH" was moved on 22nd August, 2013, when the Advocate for Defendant Nos. 1 and 2 informed the Court that they had transferred all their rights in favour of UTV Software Communications Limited. The Advocates for the Plaintiffs thereafter carried out necessary amendment to the Plaint and joined UTV Software Communications Limited as party Defendant No. 4 and moved an application for urgent reliefs on 27th August, 2013. It was submitted on behalf of the Plaintiffs on 27th August, 2013, that the entire film industry including the Film Associations is controlled by a few bigwigs who because of their money power and high connections oppress and snatch away the legitimate rights of small individuals like the Plaintiffs. It was submitted that Defendant Nos. 1 and 2 being extremely powerful have manipulated the records of the

Association of Motion Pictures & T.V. Programme Producers ("AMPTPP") and have deprived the Plaintiff No.2 of his legitimate right to use the title "SATYAGRAH" for his Hindi feature film, which title he has registered with AMPTPP since the year 2005. It was submitted that Defendant Nos. 1 and 2 have after usurping the title "SATYAGRAH" used the same for their film which is slated to be released on Friday, the 30th August, 2013. In view thereof, by an order dated 27th August, 2013, AMPTPP was directed to appear before this Court today at 11.00 a.m. with all the documents in their possession qua applications filed by the Plaintiffs and/or any other party including Defendant Nos. 1 and 2 for the registration of the title "SATYAGRAH".

3. The Learned Advocate appearing for the Plaintiffs has, at the outset, made it clear that the only issue raised in the present suit by the Plaintiffs is that the Defendants are not entitled to use the name "SATYAGRAH" for their movie which is being released on Friday, 30th August, 2013. He submits that he has otherwise no problem with the movie "SATYAGRAH" on any count whatsoever. He submits that on 18th November, 2004 he for the first time applied to AMPTPP for registration of the name/title "SATYAGRAH" for his proposed feature film. The said registration was thereafter renewed by the Plaintiffs on an annual basis.

The last such renewal was confirmed by the AMPTPP by their letter dated 15th February, 2010. The said letter clearly states that the registration granted in favour of the Plaintiffs as regards the name/title "SATYAGRAH" shall expire on 29th January, 2011. The letter also further clarifies that the Association shall be under no obligation to remind the Plaintiffs to submit its application along with the prescribed renewal fees after its expiry on 29th January, 2011.

4. The Plaintiffs admittedly failed to renew the said registration after 29th January, 2011. In fact, on 16th February, 2012, the Plaintiffs have filed an application before the Trade Mark Registry seeking registration of the trademark "SATYAGRAH" under class 41 which Application is pending. In the meantime on 15th June, 2011, Defendant No.1 filed an Application seeking registration of the name/title "SATYAGRAH" for its film with another Association viz. Indian Motion Picture Producers' Association ("IMPPA").

5. The Plaintiffs upon realising the lapse on their part i.e. failure to renew the registration after 29th January, 2011, made an Application to the AMPTPP on 25th August, 2011 seeking registration of the said title "SATYAGRAH". Admittedly a receipt dated 25th August, 2011,

acknowledging payment of Rs. 1,500/- is issued by the Association to the Plaintiffs. However, the said receipt again admittedly bears an endorsement "subject to approval of TRC" (Title Registration Committee).

6. The AMPTPP and IMPPA are two Associations with whom its Members are allowed to file Applications seeking registration of the title proposed to be used by the members for their proposed Hindi feature films. The parent body of the said two Associations is "Film Makers Combine".

7. On 31st August, 2011, AMPTPP wrote a letter to Film Makers Combine forwarding to them a list of titles applied for registration with them by their members between 25th August, 2011 and 31st August, 2011 and requesting the parent body to forward their objections to the registration of any titles mentioned in the list.

8. On 21st October, 2011, the Film Makers combine addressed a letter to the Secretary, AMPTPP, inter alia, informing them that the name/title "SATYAGRAH" is awaiting registration in the name of Prakash Jha Productions. This is because Shri Prakash Jha had already applied to IMPPA for registration on 15th June, 2011 when admittedly the

registration of the Plaintiffs had lapsed.

9. On 14th November, 2011, IMPPA wrote a letter to Shri Prakash Jha stating that the TRC in its meeting held on 9th August, 2011 regretted its inability to register the title "SATYAGRAH" in his favour since the said title was registered with the Plaintiffs. On 22nd November, 2011, Prakash Jha Productions wrote a letter to IMPPA and after referring to the letter received from IMPPA dated 14th November, 2011, it was pointed out that an enquiry was made with the said Association as well as AMPTPP at the time of making of the application i.e. in June, 2011 and it was found that there was no pending Application seeking registration of the title "SATYAGRAH". IMPPA was therefore requested to reconsider the application and register the said title in favour of Defendant No.1.

10. Thereafter in the meeting of IMPPA held on 30th November, 2011, since the Application of Defendant No. 1 was prior in time, it was decided to register the name "SATYAGRAH" in the name of the Defendant No.1. AMPTPP by its letter dated 5th December, 2011, addressed to the Plaintiffs informed the Plaintiffs that its application for registration of the title "SATYAGRAH" was placed before the meeting of the TRC held on 30th November, 2011 and the same cannot be granted

since the title "SATYAGRAH" was registered in the name of Prakash Jha Productions.

6. The Plaintiff No.2 on 12th February, 2013 wrote a letter to AMPTPP recording that he is the registered holder of the title "SATYAGRAH" since October, 2005, which was last renewed on 25th August, 2011 by payment of the stipulated fee of Rs. 1500/- and that he has come to know through media reports that the Defendant No.1 has announced a project with the same title. Three months thereafter the Plaintiffs have written a letter dated 13th May, 2013 to Mr. Prakash Jha calling upon him to refrain from using the name "SATYAGRAH" for his film. Again, three months thereafter the Plaintiffs have filed the present suit on 19th August, 2011 and moved this Court for urgent ad-interim reliefs.

7. The Learned Advocate for the Plaintiffs has submitted that the Defendant Nos. 1 and 2 being very powerful in the Film Industry have manipulated the records of the Associations and have usurped the legitimate right of the Plaintiffs to use the title "SATYAGRAH" for his feature film in Hindi. The Defendants have violated the statutory as well as common law rights of the Plaintiffs and the Defendants are guilty of

violating their contractual obligations for which the Defendants should be asked to deposit Rs. 25 lacs in this Court, before release of their film "SATYAGRAH" on 30th August, 2013.

8. I have today perused the file produced by Defendant No.3 and have set out hereinabove, the chronology of events that has transpired right since the year 2005 when the Plaintiffs first applied for registration of the title "SATYAGRAH". I am prima facie satisfied that there is a lapse on the part of the Plaintiffs in not renewing the registration of the title "SATYAGRAH" on and after 29th January, 2011. In the meantime, Prakash Jha Productions have applied for registration of the title "SATYAGRAH" on 15th June, 2011. On 25th August, 2011, the Plaintiffs once again applied for registration of the title "SATYAGRAH" for the Hindi feature film, which as can be seen from the receipt that was accepted subject to approval of TRC. As set out hereinabove, by its letter dated 31st August, 2011, AMPTPP forwarded to its parent body – Film Makers Combine, a list of applications received by it from its members between 25th August, 2011 and 31st August, 2011 for registration of various titles for feature film in Hindi and also sought objections from the said Film Makers Combine. At Item No. 30 of the list, the particulars of the Application filed by the Plaintiff on 25th August, 2011 are shown. It

appears that for lack of clarification and certain misunderstanding, IMPPA without realizing that the Application of Prakash Jha Productions is prior to the application of the Plaintiffs first wrote to Prakash Jha Productions that they are unable to register the film "SATYAGRAH" in favour of Prakash Jha Productions as the same is registered in the name of the Plaintiffs. In response Prakash Jha Productions pointed out that Defendant No. 1 had applied on 15th June, 2011 for registration of the title "SATYAGRAH" and was informed upon making enquiries that no application was pending on that day for registration of the title "SATYAGRAH" and therefore their application was wrongly rejected on the ground that the registration in respect of the title "SATYAGRAH" already stood in the name of the Plaintiffs. Therefore, in the meeting of the Associations held on 30th November, 2011, the matter was looked into and the application of Prakash Jha Productions dated 15th June, 2011 being prior in time was granted registration and the application of the Plaintiffs dated 25th August, 2011 stood rejected. I therefore do not accept the contention advanced on behalf of the Plaintiffs that due to manipulations on the part of Defendant Nos. 1 and 2 and the Defendant No.3 Association, their application was rejected or the registration of the title "SATYAGRAH" in favour of the Plaintiffs was allowed to be snatched away by Prakash Jha Productions. In my prima facie view, if at all anyone

is to be blamed for the Plaintiffs having lost its registration to the title "SATYAGRAH", it is the Plaintiffs themselves, who have been negligent in not getting the said title registered after 29th January, 2011. I also do not accept the submission advanced on behalf of the Plaintiffs that there is a violation of the contractual obligations on the part of the Defendants. Admittedly, no copyright can be claimed in the title of the film "SATYAGRAH". Since the trademark "SATYAGRAH" is not registered till date in favour of the Plaintiffs, the Plaintiffs cannot claim any statutory rights in that regard. The Plaintiffs also cannot claim any common law rights in the admitted absence of any plea of existence of any reputation and goodwill in the mark. The Plaintiffs have therefore failed to make out any prima facie case in their favour.

9. The Plaintiffs have in February, 2013, written a letter to AMPTPP making a grievance against the use of the title "SATYAGRAH" by Defendant Nos. 1 and 2. The Plaintiffs have thereafter not taken any steps and have written a letter only in May, 2013, to Shri Prakash Jha making a grievance of using the name "SATYAGRAH" for his proposed film. It is only on 19th August, 2013, that the Plaintiffs filed the present Suit and moved this Court for urgent ad-interim reliefs, despite being well aware that the feature film "SATYAGRAH" is scheduled to be released on

30th August, 2013. In view thereof, the balance of convenience is completely in favour of the Defendants and against the Plaintiffs.

10. The Application of the Plaintiffs for grant of urgent ad-interim relief is therefore rejected. Notice of Motion is placed for hearing and final disposal on 25th September, 2013. Needless to add that the Notice of Motion shall be finally decided by this Court without being influenced by the observations made in this order.

(S.J. KATHAWALLA, J.)