

\$~2

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of decision: 31st August, 2018.
+ **CS (COMM) 1322/2016**
PRISM MOTION PICTURES PRIVATE LIMITED Plaintiff
Through: Mohd. Fuzail Khan and Ms. Shafali
Jain, Advocates. (M:9818331923)
versus

MUKTA ARTS LIMITED & ANR. Defendants
Through: Mr. Rahul Chitnis and Mr. Angad
Singh Narula, Advocate for D-1.
(M:9899884710)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The Plaintiff in the present case has '*doubled its troubles*' by registering the title '*DOUBLE TROUBLE*' for a Punjabi film. It has neither been able to produce and release its movie and on the other hand, Defendant no.1 adopted the title '*DOUBLE DI TROUBLE*' and released its Punjabi film in the said name.

2. The present suit for passing off and infringement of copyright has been filed by the Plaintiff against the Defendant No.1- Mukta Arts Limited. The grievance of the Plaintiff is that the Plaintiff coined the film title '*DOUBLE TROUBLE*' (Punjabi) and registered the same with the Defendant No.2 – Indian Motion Pictures Producers' Association ('*IMPPA*'). The said body i.e. Defendant No.2 is a voluntary organization, which works in the film industry and permits producers, directors etc. to register film titles, in order to show priority of adoption of movie titles.

3. The Plaintiff applied for the said title in March, 2013, which was

granted by IMPPA on 30th July, 2014. While the Plaintiff was working on the script and production for the said film, it came to the plaintiff's knowledge that Defendant No. 1 had adopted the title '*DOUBLE DI TROUBLE*' (Punjabi). '*DOUBLE DI TROUBLE*' was released in August, 2014. The Plaintiff filed the present suit seeking an injunction to the effect that Defendant No. 1 should not be allowed to use the title '*DOUBLE DI TROUBLE*', which is almost identical to the Plaintiff's title.

4. The Defendant No. 1's stand is that it registered its title with the Indian Film and TV Producers Council ('*IFTPC*') on 30th August, 2013. Defendant No.1 does not dispute that the Plaintiff's application for registration is prior in time to that of the Defendant, which was made on 11th July, 2013 and subsequently granted on 30th August, 2013. The Defendant, though a member of Defendant No.2, sought to obtain registration from IFTPC and not IMPPA. IFTPC is also a similar voluntary body, like Defendant No.2, which operates in the film industry.

5. In this background, the question is whether the Plaintiff has any copyright in the said title or goodwill in the same. The Plaintiff does not dispute that till date, it has not used the name '*DOUBLE TROUBLE*' for any film or programme. It merely holds a registration with IMPPA. Defendant No.1, however, released the movie in August, 2014. The grievance of the Plaintiff is that a voluntary body like IMPPA ought to be respected by large firms like Defendant No.1 who should not be allowed to overpower a smaller player in the industry like the Plaintiff and ignore such a player's priority of adoption in this manner.

6. Insofar as the cause of action for copyright and passing off is concerned, the Plaintiff has no goodwill, at this stage, as the Plaintiff's title

has not been used in public domain. Also, as held in *Krishna Lulla and others Vs. Shyam Vithalrao Devkatta and Anr. (2016) 2 SCC 521*, there cannot be copyright over titles. The Supreme Court while dealing with the title 'Desi Boys' observed as under:

“7. The main issue that arises for determination is whether the Respondent No.1-Devkatta has copyright in the title “Desi Boys” which he has given to the synopsis of a story. Further, if at all a complaint under Section 63 of the Copyright Act is tenable against all the appellants for giving the title “Desi Boyz” to the film released by them?

8. Section 13 of the Copyright Act lays down works in which copyright subsists. Section 13(1) reads as follows:-

“13. Works in which copyright subsists. – (1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works, this is to say-

(a) original literary, dramatic, musical and artistic works;

(b) cinematograph films; and

(c) sound recording

9. It is obvious that what is claimed by Respondent No.1 Devkatta is only copyright in the title “Desi Boys”. It is, therefore, not necessary to examine if a mere synopsis or a note of a story amounts to a literary work. Admittedly, Devkatta has not made any film by the name “Desi Boys” and his only grievance is about the infringement of copyright in the title which according to him is the soul of his story and copying it takes away everything from his story.”

7. In the above context, the Supreme Court reviewed the case law on the subject from India and abroad including the judgement of the Privy Council

in *Francis Day & Hunter Ltd*¹ relating to the title ‘*The Man Who Broke the Bank at Monte Carlo*’ which was a song used as a film title and finally held—

“19. We are thus, of the view that no copyright subsists in the title of a literary work and a plaintiff or a complainant is not entitled to relief on such basis except in an action for passing off or in respect of a registered trademark comprising such titles. This does not mean that in no case can a title be a proper subject of protection against being copied as held in *Dicks v Yates* where Jessel M.R said “there might be copyright in a title as for instance a whole page of title or something of that kind requiring invention” or as observed by Copinger (*supra*).

20. In the present case, we find that there is no copyright in the title “*Desi Boys*” and thus, no question of its infringement arises. The prosecution based on allegations of infringement of copyright in such a title is untenable.”

8. Thus, though film titles may be entitled to protection, if substantial reputation and goodwill is established, per se, in the absence of extensive use, they would not be protectable. Christopher Wadlow in ‘*The law of passing off*’ (*Sweet & Maxwell, 5th Edn., 2016*) opines:

“The title of a film can become distinctive, as apparently happened in *Twentieth Century Fox Corp Vs. Gala Film Distributors* where the defendants undertook to change the title of their film from *Anastasia*. It is clear that Roxburgh J would have granted an interlocutory injunction on the merits if necessary.....There are several cases dealing with films having the same title as existing literary or dramatic works, but most have failed on the facts...”

9. Thus, as in the present case, the film was not released and the title had

¹ *Francis Day Hunter Vs. Twentieth Century Fox Co* [1939] All E.R. 192 (PC)
CS (COMM) 1322/2016

not acquired distinctiveness qua the Plaintiff, it is not entitled to protection even under the law of Passing Off. However, insofar as adherence to the guidelines related to such voluntary bodies is concerned, there is no doubt that these are both bodies, which are operating in the Bombay film industry. Defendant No.1 is a member of Defendant No.2 as also IFTPC. It, however, chose to register its title with IFTPC. It is for the said voluntary bodies to bring out guidelines on their own, to ensure that such conflicts do not occur between their members.

10. The whole purpose of registration of titles with voluntary bodies would be defeated if some sanctity is not given to priority in adoption of a title. It is a publicly known fact that the process of film production is a long drawn one, beginning with adoption of title, registering a title, arranging funds, script writing, finalising cast, production of the film, lining up distributors and finally culminating in release of the film. Since the process is long, the period required for a title to acquire goodwill is also equally long. The sanctity to be given to adoption and registration of titles, by persons in the industry, who are members of these bodies, ought to be decided, lest the process of registration becomes meaningless. The Defendant No.1's counsel candidly states that there ought to be coordination between the voluntary organizations such as IMPPA and IFTPC in order to ensure that such conflicts are not created in the future, and if they do arise, the same can be resolved in an amicable manner. The injunction as sought for is not liable to be granted as an injunction has to be passed not on the basis of membership in voluntary bodies and priority of registration in such a body, but on the basis of legal rights.

11. Since the Plaintiff is not using the mark '*DOUBLE TROUBLE*', has

not created goodwill or publicity, and has not shown preparation towards the release of any movie, the injunction as claimed does not deserve to be granted. Defendant No.2 is ex-parte. However, both the bodies ought to consider if any guidelines need to be framed in respect of registration of titles. A copy of this order be sent to Defendant No.2 and be communicated by Defendant no.1 to IFTPC in order for them to consider if any guidelines in regard to competing titles registered with their respective organisations ought to be passed.

12. The suit is disposed of with these observations.

AUGUST 31, 2018/dk

**PRATHIBA M. SINGH
JUDGE**

सत्यमेव जयते