

IN THE HIGH COURT OF JUDICATURE AT BOMBAY**ORDINARY ORIGINAL CIVIL JURISDICTION****APPEAL (LODGING) NO. 598 OF 2010
IN
NOTICE OF MOTION NO. _____ OF 2010
IN
SUIT (LODGING) NO. 2498 OF 2010**

Genx Entertainment Ltd. and another).. Appellants

Versus

Purple Haze Motion Pictures Pvt. Ltd. and others).. Respondents

Dr. Virendra Tulzapurkar, Senior Advocate, with Mr. Virag Tulzapurkar, Senior Advocate, Mr. Vinod Bhagat, Mr. Puni Jain and Mr. Dhiren Karania i/b G.S. Hegde & V.A. Bhagat for the Appellants.

Mr. Simit Purohit with Ms. Azmira Irani and Mr. Manish Doshi i/b M/s. Vimadalal & Co. for Respondent Nos.1 and 2.

Mr. S.U. Kamdar, Senior Advocate, with Mr. Ashok Kamat, Ms.Pooja Mehta i/b RMG Law for Respondent No.7.

**CORAM : MOHIT S. SHAH, C.J. AND
DR. D.Y. CHANDRACHUD, J.**

Thursday, September 2, 2010

P. C. :

This appeal is directed against the order dated 1 September 2010 declining to grant ad-interim relief in favour of the appellants-plaintiffs on the appellants-plaintiffs' Notice of Motion in Suit (Lodging) No.2498 of 2010. The judgment of the learned Single Judge is not yet

made available to us and we have been called upon to decide the Notice of Motion in the Appeal on the ground that the appellants-plaintiffs are seeking injunction against the release of the movie “*the film Emotional Atayachar*” tomorrow i.e. 3 September 2010.

2. The case of the appellants-plaintiffs is that it is part of the UTV Group of Companies which is engaged in the business of producing movies, television shows, broadcasting, offering interactive gaming and new media. It operates two satellite television channels known as *UTV Bindaas* and *UTV Action* which show youth centric entertainment programmes and movies respectively and has been in operation since 2007. The appellants-plaintiffs claim that in 2008 appellant No.2 registered the title “EMOTIONAL ATYACHAAR” with the Association of Motion Pictures & TV Program Producers (AMPTPP) which is parent body of TV Program Producers’ undertaking title registrations. The appellants’ reality show “EMOTIONAL ATYACHAAR” was first telecast on air on the appellants’ UTV Bindaas television channel from 18th December 2009 till 30th April 2010. The appellants’ show was stated to be an instant hit with the audiences who have come to identify the said name and programme titled EMOTIONAL ATYACHAAR with the appellants on television. The words and name EMOTIONAL ATYACHAAR also became immensely popular and have become synonymous with the appellants and none else. The appellants-plaintiffs’ further case is that on 7 August 2010 the appellants came out with the second sequel of their reality show titled EMOTIONAL ATYACHAAR 2 and the same is presently running on its said television channel UTV BINDAAS and completed four episodes at the time of filing the present appeal.

3. The appellants further case is that on 24 July 2010, the appellants came to learn from the journal "COMPLETE CINEMA" that respondent Nos.1 to 6 had made a film "EMOTIONAL ATYACHAR". However, the date of release of the movie was not indicated in the said journal but on 29 July 2010 the appellants-plaintiffs served a cease and desist notice upon the respondents informing them that the plaintiffs had already registered the title "EMOTIONAL ATYACHAAR" with the Association of Motion Pictures and TV Programme Producers (AMPTPP) on 19th May 2008. The only response which the appellants-plaintiffs received from the respondents to the above notice was reply dated 13 August 2010 informing the plaintiffs that the title of the film was decided by respondent No.7 through an assignment. The respondents replied that "Further the title of the film "The Film Emotional Atyachar" is being decided by M/s. Roopvati Pictures (Respondent No.7) who has been assigned various rights under the agreement entered in to with them including the name of the movie". The plaintiffs thereafter addressed notice dated 17 August 2010 to the Association of Motion Pictures & T.V. Programme Producers stating that it came to the plaintiffs' knowledge that IMPAA had registered the title "the film Emotional Atayachar" in favour of its member M/s.Roopvati Pictures. The plaintiffs protested that such registration could not have been done, without checking with AMPTPP whether a similar or deceptively similar title as already been registered by an AMPTPP member. The plaintiffs further stated that they were initiating civil proceedings in this Court against the respondents for producing a film with the title "the film Emotional Atyachar" which is similar to their title "Emotional Atyachaar". Thereafter the plaintiffs filed the present Suit on 21 August 2010 and prayed for ad-interim injunction by restraining the respondents from releasing the film.

4. The Notice of Motion was taken up for hearing on 23 August 2010 and by the order dated 1 September 2010, the learned Single Judge has declined to grant ad-interim relief and dismissed the Notice of Motion.

5. Dr. Tulzapurkar, learned counsel for the appellants-plaintiffs, has submitted that since the respondents did not file any reply to the Notice of Motion and the plaintiffs had shown that the title of their television show was already registered with the AMPTPP in May 2008 and the defendants had used the same title in their movie and had only merely added the words “the film” before the title “Emotional Atyachar”, clear case of passing off was made out and therefore the learned Single Judge ought to have granted the interim injunction. Strong reliance is placed upon the decision of the Delhi High Court in *Kanungo Media (P) Ltd. vs RGV Film Factory and others*¹ and also on **McCarthy on Trademarks and Unfair Competition**, Volume 2, Fourth Edition, in support of the contention that an injunction against a literary title used in another type of literary work can be granted. The learned Counsel further submits that under the modern law of trademarks, marks will be protected as between non-competitors if the products are so related that there is a likelihood of confusion. The learned Counsel further relied on the observations made by a Division Bench of this Court in *K.M. Multani vs Paramount Talkies of India, Ltd., and others*² and particularly the observations on page 248 in which the Court held that it is possible that a passing-off action would succeed where the advent of a film under a particular title has been very extensively advertised and the arrangements were made for release of the film and in which some other person produced a film of the same title shortly before the advertised

¹ 2007 (34)PTC 591 (Del)

² AIR (29) 1942 Bombay 241

film was ready. It is submitted that the facts in the instant case are similar. The plaintiffs had already launched television serial called “Emotional Atyachaar” and eight months thereafter the defendants have come out with the movie titled “the film Emotional Atyachar”.

6. On the other hand, Mr.Kamdar, learned Counsel for the respondents-defendants, has opposed the appeal and submitted that while the plaintiffs have made a reality show being broadcast on a television channel, the contents of the said show have nothing in common with the contents of the movie being released tomorrow. It is submitted that the theme of the plaintiffs’ show focusses around one of the partners in a relationship suspecting fidelity of the other partner. On the other hand, the theme of the defendants’ film is three persons chasing a money bag on a highway and the subject matter of the plaintiffs’ television show and the defendants movie are completely different. Reliance is placed on the decision of a Division Bench of this Court in *K.M. Multani* (supra) and also on the decision of the learned Single Judge of this Court rendered on 25 September 2009 in *Genx Entertainment Ltd. vs Zee News Ltd.*¹ and also on the judgment dated 4th November 2009 in *Sushila Sharma vs Madhur Bhandarkar and others*². Reliance is also placed on the judgment of the learned Single Judge of the Delhi High Court in *Warner Bros. Entertainment Inc. and another vs Harinder Kohli and others*³ in support of the submission that even where the title of the defendants film “HARI PUTTAR” was similar to the mark “HARRY POTTER” being marketed by the plaintiffs, and the High Court refused to grant an injunction.

1 Notice of Motion No.2945 of 2009 in Suit No.2083 of 2009

2 Notice of Motion No.3391 of 2009 in Suit No.2417 of 2009

3 2008 (38) PTC 185 (Del.)

7. The learned Counsel for the defendants further submitted that there is delay on the part of the appellants of about one month in filing the Suit inasmuch as the fact that the title of the defendants' movie "the Film Emotional Atyachar" was already made known to the world at large including the plaintiffs whose own movie title was also registered.

8. Mr.Kamdar, learned Counsel for the defendants further submitted that the movie has already been released in Gujarat today on account of Janmashtami holiday and that 300 prints of the movie have already been released for being released tomorrow. It is therefore submitted that the balance of convenience is in favour of the defendants and against the plaintiffs. Mr.Kamdar further submitted that, without prejudice to their rights and contentions, defendant No.7 will furnish a Bank Guarantee for a sum of Rupees Fifty lakhs within four weeks from today that in case plaintiffs succeed, the said amount can be paid towards damages, if at all this Court were to hold that the plaintiffs are entitled to recover damages against the defendants.

9. Mr.Kamdar further stated at the Bar, under instructions of the defendants, that the defendants will also display a disclaimer notice right at the commencement of the movie in each cinema hall and also in their promotional material also to be released now. He further states that the defendants will also make it clear that the defendants' movie has nothing to do with the television show "Emotional Atyachaar" of the plaintiffs.

10. Having heard the learned Counsel for the parties and having gone through the decisions cited at the Bar, we are of the view that the appeal is required to be heard finally. We are also of the view that much

water has flown in the trademark regime after the decision of a Division Bench of this Court in *K.M. Multani* (supra). In that case, the Court refused to grant injunction on two grounds. Firstly, the plaintiffs had failed to prove that they had very extensively advertised their film and the arrangements were made for booking of the film and that thereafter the defendants had come out with their film. However, the Division Bench did not stop there and observed that on the facts of that case the plaintiff had failed to prove either of the matters necessary to its success but the Division Bench went further and held that the contents of both the films were quite different. The plaintiffs' film was an Indian film in black and white, written in Urdu, depicting an imaginary story of the meeting of Greeks and Romans in the year 4000 B.C., without purporting to be a historical story. On the other hand, the defendants' film was a film in technicolour and depicts modern life in America. The plaintiff's title "Virginia" was the name of the heroine of the movie, whereas the defendants took the title "Virginia" because the setting of that picture was in Virginia, which is a State in United States of America. The Division Bench then held that there can be no possibility of deception between two things so essentially different and that the fact may lead to some confusion and inconvenience in the booking and production of the films and, therefore, the plaintiff had no right to restrain the defendants from using their title, unless he can show that it has become associated in the minds of the public with his film and nobody else's.

11. Having regard to the subsequent development of law discussed in **McCarthy on Trademarks and Unfair Competition**, Volume 2, Fourth Edition, and the decision of the Delhi High Court in *Kanungo Media (P) Ltd.* (supra), we are of the view that the principles

laid down by the Division Bench of this Court in *K.M. Multani* (supra), need reconsideration and the matter needs to be examined in further detail having regard to the subsequent developments of law. We are, therefore, inclined to refer this Appeal to a larger Bench.

12. Coming to the question of injunction, during the pendency of the Appeal, having regard to the statements being made by Mr.Kamdar, learned Counsel for the defendants, that the defendants will put up a disclaimer notice not only at the commencement of the movie but also in their promotional literature to be published in the newspapers and also in the posters to be released now which shall be displayed in all the cinema halls and other places where the posters have been presently and to be hereafter displayed and also having regard to the undertaking that the defendants will furnish a Bank Guarantee of a Nationalised Bank for a sum of Rupees Fifty lakhs, we decline to grant interim injunction in favour of the appellants-plaintiffs. The Bank Guarantee shall be furnished within a period of four weeks from today and shall abide by the outcome of this Appeal.

13. It is clarified that the observations made in the judgment may not be treated as expression of any final opinion on the controversy between the parties. It is also clarified that this order is passed in the peculiar facts of this case.

CHIEF JUSTICE

DR. D.Y.CHANDRACHUD, J.