

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Order delivered on: June 07, 2013*

+ **CS(OS) No.1225/2013**

HAMDARD NATIONAL FOUNDATION & ANR Plaintiffs

Through Mr.N.K.Anand, Advocate ,
Mr.Pravin Anand, Mr.Dhruv Anand
& Mr.Achuthan Sreekumar, Advs.

Versus

HUSSAIN DALAL & ORS Defendants

Through None

CORAM:

HON'BLE MR. JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J. (Oral)

1. **I.A.No.9923/2013 (exemption)**

Exemption allowed, subject to just exceptions.

The applications are disposed of.

2. **I.A.No.9924/2013 (U/s 149 r/w Section 151 CPC)**

By this application, the learned counsel for the plaintiffs craves leave to extend the time to make good deficient court fee. Mr. Anand submits that the same would be deposited within two weeks as the steps have already been taken. In view of statement made by learned counsel for the plaintiffs, the prayer is allowed. The application is disposed of.

3. **CS(OS) No.1225/2013**

Issue summons to the defendants, on filing of process fee and Regd. A.D. Covers within a week, returnable on 15th July, 2013 before the roster Bench.

I.A.No.9922/2013 (u/o XXXIX, R.1 & 2 CPC)

4. Issue notice to the defendants, returnable on 15th July, 2013.

5. The plaintiffs have filed the instant suit for infringement of trade mark, passing off, commercial disparagement and tarnishment of goodwill and damages. Along with the suit, the plaintiffs have filed the interim application seeking prayers as contained in the application.

6. It is stated by plaintiffs that the plaintiff is a well known laboratory in the field of ayurvedic preparations and is carrying on business for more than 100 years from now. It is stated that the plaintiffs have given several useful products to the public at large which are not merely famous in India but world over. The said products include the celebrated ones like ROOH AFZA, Rogan Badaam Shrin etc.

7. The plaintiffs state that the trade mark ROOHAFZA is one of the most popular trade mark in respect of sharbats which gives cooling effect to the human body. The said trade mark has been put to extensive use since the year 1907 and the trade mark ROOHAFZA is registered since the year 1945 prior to independence of this country.

8. The plaintiffs have stated that the usage, reach and consumption of the product ROOHAFZA is such that the said product is a household name across India and the globe. It is stated that no one could imagine his or her upbringing atleast in India and neighboring countries without hearing about the sharbat called ROOHAFZA which has a tremendous and stupendous mass approach.

9. In the light of the same, it is the grievance of the plaintiffs that the defendants have recently released the movie with the name YEH JAWAANI HAIN DEEWANI which has hit the cinema halls and the said movie contains some dialogues which somehow show the well known product ROOHAFZA in the manner which is detrimental to the interests of the plaintiffs as a proprietor. The plaintiffs in order to fortify its stand has reproduced the offending dialogues in the film which are reproduced as under:

a) Son: “Yeh Roohafza Bahut Bekaar Hai!”

b) Mom : “Sab Thik Ho Jayega!”

Son: “Siwaye Is Roohafza Ke.... Bahut Bura Hai”

10. The plaintiffs contend that the said conversation between the mother and son in the film depicts a kind of household wherein mom tries to console his son that everything will be alright no matter what difficulties he is facing and in response to the same, the son responds that everything can change but this ROOHAFZA will remain the same and continue to bad. It is submitted by the plaintiffs that the ground reality about the popularity of the product of the plaintiffs is directly opposite as the same is a house hold name and is liked by the segment of every level of consumer be a villager to a person residing in metropolitan city be it rich or poor. Therefore, the plaintiffs contend that such a representation about the celebrated product which has gained such reputation in the Hindi Film which would be watched by almost all the viewers in India is detrimental to the interest of the proprietor and would in all certainty damage or injure the goodwill and reputation of the plaintiffs.

11. The matter came up for hearing when Mr. N.K Anand and Mr. Pravin Anand appeared and argued on behalf of the plaintiffs. Mr. Anand argued

that the existence of the dialogues in the movie would definitely damage the good will and reputation of the plaintiffs and is an actionable wrong in common law as well as in statute. Mr. Anand has relied upon the tests of commercial disparagement which are prevalent in field of the commercial speech and advertisement that no merchant or trader is entitled to say that the product of the competitor is bad or of inferior quality. Mr. Anand argued that there is no reason that the said tests should not be extended to the film dialogues as the film is also a commercial venture and attracts the large segment of the public. Mr. Anand also submitted that the same Hero (actor of the film) on one hand is promoting the PEPSI drink and in the present movie he is speaking dialogues which are detrimental to the product i.e. ROOHAFZA drink against the interest of his client.

12. I have gone through the plaint, interim application and documents filed therewith. I find that the provisions of the Trade Mark Act, 1999 explicitly provide for the infringement of the trade mark by way of spoken use if the representation is made to the public. This is evident from the following provisions of the Trade Mark Act 1999:

“Section 2 (2) - In this Act, unless the context otherwise requires, any reference--

(a) to "trade mark" shall include reference to "collective mark" or "certification trade mark";

(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;

(c) to the use of a mark,--

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

Section 29 (9) - Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”

13. From the conjoint reading of the aforementioned Sections of the Trade Marks Act, 1999, it is manifest that though the definition clause under the provision of Section 2 (2) provides that the unless the context provides, the use of the mark in relation to the goods shall be construed in the manner indicated under the provisions of Section 2 (2) (c) but the reading of Section 29 (9) of the Act further clarifies that in the said section, the legislature has expressly departed from the ordinary construction of the expression “use” under the Trade Marks Act. This is evident from the reading of Section 29 (9) of the Act wherein it is expressly stated that reference in this Section to the use of the mark shall be construed in accordance with what has been mentioned in the said section. Thus, the provision of Section 29 (9) provides that the expression “use” under the said sub section has to be construed in the light of the what has been contained therein which is an infringement by way of the spoken words.

14. A further reading of Section 29 (9) would make it clear that the said section provides that it is an infringement of the trade mark by way of the spoken use of the words which are contained in the trade mark and their visual representation thereof. What is an infringement is not merely visual representation of the product in the bad light under the provision of Section 29 (9) of the Act but it is the infringement of the trade mark if the same is caused by way of spoken use of the words and the visual representation of the said words. This is evident from the grammatical reading of the section which in the continuation and completion of the sentence reads “by their

visual representation”, all this would mean that visual representation of the spoken words is an infringement of trade mark.

15. Now, the cinematograph film is a visual representation of the motion picture containing sound recordings, dialogues which are presented in the audio and video format before the public at large. The said cinematograph film is definitely covered within the ambit of the visual representation which is larger genus under the provisions of Section 29 (9) of the Act. Thus, the provision of the Section 29 (9) further makes a statutory infringement of the registered trade mark if the same is caused by the spoken words.

16. The tests for the adjudging the said infringement would remain the same which are prevalent in the field of the trade mark. Either the said spoken words should cause the infringement by making a mis-statement or causing confusion and deception which is the gist of the passing off action or in the alternative, the said spoken words should cause infringement by way of diluting the distinctive character and repute of the trade mark which may either intention or unintentional.

17. It is well settled that the intention to defraud is not essential ingredient of the passing off action, thus, the infringement or passing off which has been caused innocently or fraudulently would not make a difference if the same falls within the ambit of the infringement as a matter of law and fact.

18. It is true that in a similar case complaining derogatory lyrics in the film namely “Chakravyuh”, the Division Bench of this court in the case of Prakash Jha Productions v. Bata India Limited and Another which was FAO(OS) 505/2012 decided on October 17, 2012 proceeded to observe that the said lyrics are mere expression of thoughts of the producer and writer of the movie and the way they think and intend to project the same in the movie

by writing the lyrics and representing the public. However, the said decision was taken to Supreme Court of India in Appeal (Civil) No(s).32998/2012 in case of *Bata India Limited v. Prakash Jha Productions and Others* wherein the Supreme Court cautioned that the said lyrics in the movie are in a bad light and ought to contain a disclaimer that there is no intention to damage the goodwill of the person. The order of the Supreme Court reads as under:

“Having heard learned counsel for the petitioner as well as learned counsel for the Respondent Nos.1-3 and having looked into the lyrics and the song in question, **we are of the view that the same is in poor taste and the wordings indicating the names of certain Business Houses could have been avoided.** However, we are also of the view that there does not appear to be any intention in the song to besmirch the reputation of any particular Business House or commercial enterprise and that the entire song has been written in a manner which attempts to depict the producer's view of the state of society today.” (Emphasis Supplied)

19. In a similar petition, which had been filed before the Calcutta High Court by the Birla Group, the learned Single Judge of the High Court had directed that the song, when played, was to be run with the following disclaimer:

“Use of the names of the song are merely as example. No injury or disrespect is intended to any particular person or brand.

We repeat that the song appears to have been written in the context of the theme of the film and ought not to be taken as any kind of aspersion against the persons named in the said song. **We may also indicate that the Division Bench of the Calcutta High Court has maintained the Order of the learned Single Judge.** We, however, add that such disclaimer should also be included in the audio version and that the same should be aired before the song is played. We also endorse the views expressed by the Division

Bench of the High Court that the wordings of the song are not likely to be taken literally by the viewers.” (**Emphasis Supplied**)

20. In view of the order passed by the Supreme Court which has put the restrictions in the form of disclaimer while viewing the said song puts an imprimatur of the court that the derogatory lyrics in the movie can be put to restrictions and conditions on case to case basis. Thus, the order of the appellate court merges into the order of Division Bench of this court which in effect means that this court can proceed to evaluate the said proposition on case to case basis.

21. Further, the case of *Bata* (supra) is strictly not applicable to instant case as in the said case, the lyrics which were written in the song were aimed to target a class of the industrialists like Tata and Birla and Bata in generality which was a kind of the perception of the presenter and author as rightly observed by the Division Bench and upheld in part by the Supreme Court. However, in sharp contrast to the same, in the instant case, the objectionable content or dialogue targets only a singular commercial product which enjoys impeccable reputation of a household drink in India. The said visual representation attempting to target a singular product may likely to affect the popularity of the product before the public as one cannot make out as how the public would take the said representation of the product as against the case of *Bata* (supra) where the general lyrics did not really affect any product specific of the said manufacturers. Thus, the present case slightly stands on a different footing than the case of *Bata* (supra).

22. It is equally true that every citizen has a fundamental right to speech and expression as enshrined in the Indian constitution in the form Article 19 (1) (a), however the said fundamental right to speech and expression is not

unbridled or uncontrolled as the same is subject to the provisions of Article 19 (2) of the Constitution. The said article reads as under:

Protection of certain rights regarding freedom of speech, etc.-

(1) All citizens shall have the right-

(a) to freedom of speech and expression;

(b) to assemble peaceably and without arms;

(c) to form associations or unions;

(d) to move freely throughout the territory of India;

(e) to reside and settle in any part of the territory of India;

(g) to practise any profession, or to carry on any occupation, trade or business.

[(2) Nothing in sub-clause (a) of clause (1) shall affect the operation of any existing law, or prevent the State from making any law, in so far as such law imposes reasonable restrictions on the exercise of the right conferred by the said sub-clause in the interests of the sovereignty and integrity of India,] the security of the State, friendly relations with foreign States, public order, decency or morality, or in relation to contempt of court, defamation or incitement to an offence.

23. A conjoint reading of the Article 19 (1)(a) and Article 19 (2) of the Act, would make it clear that the state is within its power to make any law in so far as it imposes the reasonable restrictions on the exercise of the right conferred by the said sub-clause in the in relation to defamation etc. the law preventing the infringement of trade mark by way of spoken words is a commercial law preventing unfair or untrue commercial speech which may cause injury to the proprietor which is included within the ambit of the infringement in order to prevent disparagement. The said law prevent disparagement is one of the facet of the tort of the defamation and is thus an

excepted matter under Article 19 (2) and the state is within its power to make such law.

24. In the case of *Tata Press Ltd. v. Mahanagar Telephone Nigam Ltd. & Ors.* (1995) 5 SCC 139 the Supreme Court speaking through Hon'ble Kuldeep Singh, J. (as his Lordship then was) also approved that the commercial speech which is unfair, untruthful and deceptive can be prevented under Article 19 (2) and the same cannot be protected under Article 19 (1) although the Supreme Court then proceeded to evaluate the permissible extent of the commercial speech in the later part of the judgment. In the words of Supreme Court, it was observed thus:

“our Constitution itself lays down in Article 19(2) the restrictions which can be imposed on the fundamental right guaranteed under Article 19(1) (a) of the Constitution. **The "Commercial speech" which is deceptive, unfair, misleading and untruthful would be hit by Article 19(2) of the Constitution and can be regulated/prohibited by the State.**” (Emphasis Supplied)

25. Freedom of speech includes the right to freely express one's opinions by words of mouth, writing, printing and all other means is a freedom guaranteed to citizens of India under Article 19(1)(a) of the Constitution of India. Right to view is at the core of freedom of speech and expression and any restraint would have a chilling effect in a free democratic society. Faith in democracy is rested on the dictum : ‘Let people have the truth and freedom to discuss it and all will go well.’ Suppression of freedom of speech on the ground that it will promote justice. It is also recognized that freedom of speech is not an absolute unlimited right. Article 19(2) provides reasonable restrictions on what is guaranteed by Article 19(1)(a) of the Constitution as law provides some safeguards against abuse if it causes likelihood of prejudice to a person or party without his fault.

26. The crucial question is where to draw a line between the 'right to tell' and 'no right to tell' because blanket rights and powers sometime become dangerous if checks and balances are not checked. The same must be resulted in some type of cases where the fundamental rights of other parties who has otherwise clean and good reputation of the person or institution against whom something adverse is said without any fault by a public figure whose versions are taken as truth.

27. As discussed earlier, in the present case, this Court is totally agreed with the observations of the Supreme Court. The said offending dialogues in the film are uncalled for, the same are in poor taste and these could have been avoided. The same are likely to tarnish the reputation of the plaintiffs.

28. In view of the above discussion and explicit provisions of the Trade Marks Act, I am satisfied that the infringement of trade mark can be caused by the spoken words and visual depiction of the same in the form of presentation in the movie. Therefore, the prima facie case is made out by the plaintiffs for infringement of trade mark and also of passing off which may injure the reputation of the plaintiffs before the public. However, it has been informed that the film has already been put to release in the theaters across India and other places and thus I am of the view that the protection which can be accorded to the plaintiffs is to prevent the future commission of the said acts by omitting the objectionable dialogues in other formats of the movie in which the same shall be made available to the public at the home and no injunction order can be passed at the this stage directing the defendants to make alterations in the released movie. The balance of convenience and irreparable loss is not in favour of the plaintiffs as the movie is already put to release and thus the same would be beyond the control of the defendants to put any kind of disclaimer in the already

released movie. However, certainly, the defendants can be prevented to release the home video version of the movie or any version of the movie on television which should not contain the objectionable dialogues as contained in para 19 of the plaint and discussed above which can be done by the defendants by editing the film. I find that for future the balance of convenience is in favour of the plaintiffs to such an extent of limited protection and irreparable loss shall ensue to the plaintiffs if the said protection is not granted to the plaintiffs.

29. Accordingly, the defendants, their agents, representatives, assignes or any other persons acting on their behalf are restrained from releasing the home video version of the movie Yeh Jawaani Hain Deewani or any other version of the movie on cable television or television which contains the objectionable dialogues as complained of the in the suit provided in para 19 of the plaint. However, it is made clear that this order is not applicable to the theater version of the movie which has already been put to release and the defendants are at liberty to omit the objectionable contents from the film and proceed to release the home video version or any television version of the movie.

30. Compliance of Order XXXIX, Rule 3 CPC be made within one week.

31. *Dasti*, under the signatures of the Court Master.

**MANMOHAN SINGH
(VACATION JUDGE)**

JUNE 07, 2013/ka