

Delhi High Court

Kanungo Media (P) Ltd. vs Rgv Film Factory And Ors. on 27 February, 2007

Equivalent citations: 138 (2007) DLT 312

Author: A Sikri

Bench: A Sikri

JUDGMENT A.K. Sikri, J.

1. The plaintiff has come to this Court with the present suit for permanent injunction, passing off, compensation and damages etc. [In the prayer clause, though, no relief for compensation and damages is claimed]. To put in nutshell, at the outset, the controversy is in respect of the film produced by the defendant No. 1, M/s. RGV Film Factory, in which the defendant No. 2, M/s. ADLABS also has stakes, with the proposed name 'Nishabd', which is slated for release on 2.3.2007. The plaintiff is aggrieved by the adoption of title 'Nishabd' by the defendants No. 1 and 2 for their feature film. Defendant No. 3, M/s. Super Cassette Industries, is sold the rights in the music and lyrics and for this reason the defendant No. 3 is also roped in, in this suit.

2. The plaintiff claims its right over the said title on the ground that it has already produced a movie with the title 'Nisshabd', which has also won various awards and embracing of the same name by the defendants for their film is nothing but an illegal and mala fide attempt to usurp the plaintiff's right over the said title 'Nisshabd'.

3. FACTUAL NARRATION The factual matrix narrated by the plaintiff, as per the plaint, is that the plaintiff applied for and won the prestigious and highly coveted 'FONDS SUD CINEMA' grant, awarded by the French Government for the projection of its feature film 'Nisshabd', which was titled 'Nistadbd' at that time. With this grant of 'FONDS SUD CINEMA' the plaintiff roped in M/s. Artcam International, France, as co-producer of the feature film to satisfy one of the conditions laid down in the grant for funding of the film and production of this film commenced thereafter. It was re-christened as 'Nisshabd' as it suited the numerological and astrological wishes of those involved in the production of the movie and this name was also apt keeping in view the storyline of the film, which was based on the lead character's obsession with sound. Shooting of the movie began and completed within 40 days where after through the Western India Film Producers Association (WIFPA) the plaintiff applied for Central Board of Film Certification clearance on 8.6.2005. This certification was given on 17.6.2005 and the film produced by the plaintiff, thus, acquired the title 'Nisshabd'. Certification was for 'Unrestricted Public Exhibition' popularly known as 'U' rating, namely, it was fit for viewing by all audiences and age groups. The plaintiff further avers that though with the said certification he was entitled to release the movie for public viewing but it was not screened commercially due to paucity of funds. However, it participated in various film festivals and won many awards, details whereof are as under:

a) OSIAN's CINEFAN Festival of Asian Film (15-24 July 2005)

-Best Feature Film

b) OSIAN's CINEFAN Festival of Asian Film (15-24 July 2005)

-Best Actress Award

c) Vesoul International Festival of Asian Cinema

-COUP DE COEUR GUIMET AWARD

d) Vesoul International Festival of Asian Cinema

-PRIX SPECIAL LANGUES'O AWARD

e) International Film Festival, Bangladesh (1-16 March 2006)

-Second Prize in the International Competition Section In addition, it also participated in the following Film Festivals in the category of "Official Selection-Competition":

a) Pusan International Film Festival, Korea (6-14 October 2005)

-Official Selection - Competition

b) Bangkok International Film Festival (17-27 February 2006)

-Official Selection - Competition

c) Durban International Film Festival, South Africa (14-25 June, 2006)

-Official Selection - Competition

d) 8 Mami's International Film Festival, Mumbai (23-30 March 2006)

-Official Selection - Competition

e) EcoVision Film Festival, Palermo, Italy

-Official Selection - Competition

f) Karachi International Film Festival 2006

-Official Selection - Competition Other festivals where this movie was screened are the following

a) Palm Springs International Film Festival, USA (5-16 January 2006)

b) Golden Orange International Film Festival, Antalya

c) 11th Kolkata Film Festival (10-17 November 2005)

d) Dubai International Film Festival

e) 6th FILCA International Film Festival (23-29 June 2006)

f) Thrissur International Film Festival 2006

4. It is further claimed THAT Mr. Jahar Kanungo and his wife Mrs. Lima Kanungo, who are also the directors of the plaintiff company, invested all their lives savings into the production of this movie. In addition, many well wishers of Mr. Kanungo also pooled in money and contributed to ensure that his dreams are realized in producing this movie. It is claimed that because of various prestigious awards having been won by the plaintiff's movie, which is also critically acclaimed internationally, the plaintiff's feature film under the name and title 'Nisshabd' has come to be associated by the film enthusiasts and members of the public exclusively with the plaintiff company and its director Mr. Jahar Kanungo. This title 'Nisshabd' has, therefore, acquired such distinctiveness that any use by any person or company of the word 'Nisshabd' or any word deceptively similar thereto is bound to cause confusion among the film enthusiasts and members of the public, who would get the impression that the person/company using the word 'Nishabd' for its movie, is the production of that of the plaintiff company herein. It is also alleged that if both the films 'Nisshabd' and 'Nishabd' are screened together, it is bound to create total confusion causing huge losses to the plaintiff herein, more so when the theme of the two films are totally different. The word 'Nisshabd' which in literal translation in English signifies 'Wordless', the movie of the plaintiff has artistically connected it to its foundational theme - Silence. Silence occasioned by unspoken words, Silence occasioned by wordlessness and Silence caused by the absence of sound. The whole story of the film surrounds the story of a man who escapes the evil clutches of the noisy city to go back to the village only to be let down by his obsession with silence. He then returns to the city and compromises with its unforgiving sounds. Hence the whole artistic theme and title in 'Nisshabd', produced by the plaintiff, relates to the foundational artistic theme of the said feature film and, therefore, the plaintiff company has enjoyed and continues to enjoy full copyright in naming its film 'Nisshabd', as far as the theme relates to any film produced. Therefore, the defendants cannot be allowed to give the title 'Nishabd' to their film, which is phonetically similar to the word 'Nisshabd' with which name the plaintiff has produced the film. It is the case of the plaintiff that since it has acquired prior rights in respect of the name and title of this film 'Nisshabd' and there is certification by the CBFC on 17.2.2005 as well, the defendants could not give the same title to their film despite having knowledge of the pre-existing right of the plaintiff. It is done by the defendants to exploit the rare accolades that the plaintiff's film has received internationally.

5. On the aforesaid averments, following prayer is made in the suit:

(a) to pass a decree of permanent injunction injuncting the Defendants, their agents, employees etc. from using the brand name and title "NISHABD" which is deceptively similar to the film of the Plaintiff herein, "NISSHABD";

(b) Restrain the Defendants by themselves, their servants, and/or agents by an order of permanent injunction from in any manner using in relation to any of its films the brand name and title

"NISHABD", "NISSHABD" or any other deceptively similar marks/name/words/abbreviated letters so as to pass off or enable others to pass off the Defendant's film as that of the Plaintiff and/or in some way connected with the Plaintiff.

(d) direct the Defendants to pay for costs of this Petition.

6. Along with the suit, present IA is filed seeking ad interim injunction to restrain the defendants from using the name and title 'NISHABD' for their film and/or releasing the said movie and/or its sound track with the name 'Nishabd'. It is also prayed that the defendants be restrained from promoting their film 'Nishabd' and its audio/video soundtrack and other advertisement in audio/video/print media.

7. Suit and this application came up for preliminary hearing on 21.2.2007. Defendant Nos. 1 and 2 appeared on caveat and accepted notice and waived the service of summons. Both the parties requested that matter be taken up on urgent basis and injunction application be decided as the movie produced by the defendants is scheduled to be released on 2.3.2007. It was accordingly directed that the matter would be listed for hearing on 23.2.2007. Defendants No. 1 and 2 have filed reply to the application opposing the prayer of injunction. We shall traverse that reply while stating the arguments of the parties and discussing those arguments.

8. THE ARGUMENTS Learned Counsel for the plaintiff, with all zeal and earnestness coupled with emotional pitch of his arguments, submitted that the attempt on the part of the defendants in adopting the title 'Nishabd' for their movie was utterly malicious. He pointed out that the plaintiff's film had participated in 8th Mami's International Film Festival, Mumbai held between 23-30 March 2006. This event was organized by ZEE Cinema in association with M/s. ADLABS (the defendant No. 2). In this Film Festival the plaintiff's movie was screened. The brochure, which was brought on the occasion of the said Film Festival, gave the description of the plaintiff's film wherein it was also mentioned that this film had won the Best Film Award and Best Actress Award at OSIAN's Cinefan Festival of Asian Film. Thus, the defendants came to know about the plaintiff's movie, even if it was not commercially released, in March 2006. Within six days thereafter, the defendants filed the application with WIFPA for production of their proposed film with the name 'Nishabd', which was a rampant act of cheating and theft. He further submitted that prior user of the title 'NISSABD' by the plaintiff was not in dispute and there was no explanation forthcoming as to why the defendants had decided to copy this title. He further submitted that same title was bound to create confusion in the minds of public and for this purpose he emphasized the averments, which have already been taken note of above. Learned Counsel for the plaintiff also sought to explain the reason why the plaintiff could not approach for such a relief earlier. He submitted that the plaintiff is a person of ordinary means. Even the film which he produced was financed by M/s. Artcam International, France, as co-producer as well as contribution from his friends. It was because of the financial constraints that the plaintiff could not even launch the film commercially, though the film had been "released" by exhibiting the same in various film festivals. He further submitted that keeping in view the provisions of the Cinematograph (Certification) Rules, 1983 as amended, he bona fide believed that after CBFC had given certification to its film it would not grant certification to the defendants of the film with same name and title. However, when he came to know in the month of January 2007 that

CBFC had certified the defendants' film as well with the same name, he approached the Court immediately thereafter. He also submitted that before approaching the Court, the plaintiff, even to protect its right, had applied to the Trade Mark Registry on 2.2.2007 to get both 'Nisshabd' and 'Nishabd' registered as marks over which he has already been enjoying rights as well as copyright. He also submitted that in any case, certification by the CBFC is contrary to the Rules and, therefore, the defendants cannot be allowed to take any mileage out of that.

9. Learned Counsel for the defendants, on the other hand, countered the aforesaid arguments and submissions made by him can be paraphrased as follows:

(a) The plaintiff had approached the Court much belatedly when the defendants' film was completely shot and is already for release. He submitted that a sum of Rs. 8 crores was spent on the production of this film by the defendants. The defendants had also spent substantial amount on advertisement in promotion of this film and there was a budget of Rs. 1.5 crores for this purpose and at this juncture filing of the suit by the plaintiff was only a gimmick to get publicity and in turn cause harm to the defendants.

(b) Not only there was delay simplicitor, such a delay was fatal as the plaintiff did not approach this Court earlier even when as per his own showing, he had come to know in May 2006 itself about the plans of the defendants No. 1 and 2 to produce the film with title 'Nishabd'. However, for all this period he maintained stoic silence tacitly allowing the defendants to go ahead with their project spending huge amount. This, according to the learned Counsel, amounts to waiver of the plaintiff's right, if any, by acquiescence. He tried to demonstrate this by giving the following events:

3.4.2006-The defendant made an application to the Association of Motion Pictures and TV Programme Producers for registration of the three titles including 'Nishabd' for a Hindi feature film.

April 2006-It was announced in the media that the defendant is producing a film by the name 'Nishabd' with Mr. Amitabh Bachchan, Ms. Jiah Khan and Ms. Rewati.

May 2006-The defendant started shooting of the film and at one stretch the entire movie was shot at a chosen location, i.e. Munnar in Kerala. The movie has been produced at a total cost of approximately Rs. 8 crores.

17.7.2006-The Association of Motion Pictures granted a certificate to the defendant for registering the feature film titled 'Nishabd' in Hindi.

18.7.2006-The Association of Motion Pictures, in the usual course as a practice issued a circular, which was sent to all producer members. In that circular at page 8 serial No. 28248 name of the defendant's movie 'Nishabd' appeared.

July-December 2006-The post production work of the movie was done and during this time there were several articles etc. in the media with regard to the movie of the defendant.

December 2006-The defendant with an advertisement budget of Rs. 1.5 crores started promotional work of the movie and a large part of it has already been spent because the movie is due for release on 2.3.2007.

The website of the movie with the web link "www. nishabd the film. com" has been launched.

January 2007-One song of the movie was shown on CNN IBN along with the name of the movie 'Nishabd'.

M/s. Super Cassette Industries have the music rights of the film. From January 2007 they have started producing and distributing compact discs (CDs) and cassettes in the market which are available at all music stores all over the world and also from the internet.

Trailors of the defendant's movie have been running since December 2006 and posters and publicity material of the film have already been distributed and put up at Cinema Halls and other publicity places from January 2007.

There were articles in the press that the defendant's movie 'Nishabd' is being released soon.

(c) He further submitted that because of delay, laches and acquiescence the plaintiff should not be granted any interim injunction and in support he relied upon the judgment of the Supreme Court in the case of Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel and Ors. and also the judgment of Single Judge rendered by Hon'ble Mr. Justice Vikramajit Sen in the case of Biswaroop Roy Choudhary v. Karan Johar 2006 VIII AD (Delhi) 351.

(d) His additional submission was that even otherwise, the plaintiff has no case on merits. His argument was that admittedly the case set up by the plaintiff was of passing off and not of infringement of any registered trade mark, but there could not have been any confusion between the two films inasmuch as:

(i) the concept of the two films was entirely different. As against the plaintiff's film where the emphasis was 'Nisshabd' - Reaching Silence with the theme where his hero has obsession with silence, the subject of the film produced by the defendants centered around the storyline portraying the relationship between a 60 years old with an 18 years old girl, who also happens to be his daughter's friend. 'Nishabd' was the only title which could aptly describe such a theme with unusual relationship between the two which often leave the listens or views unspeakable (Nishabd), i.e. when they find it hard to speak about this relationship. The tag line is that some love stories are never meant to be understood or spoken

(ii) The plaintiff's film was a documentary whereas the defendants' film was a feature film with commercial overtones.

(iii) The plaintiff's film was in Bengali and the CBFC certification was also to this effect whereas the defendants' film was in Hindi. The plaintiff's film therefore, had limited audience who could speak

and understand Bengali, which would rule out confusion.

(iv) The plaintiff's film was not commercially released and, therefore, the movie watchers would not even know the existence of the plaintiff's film and thus, there could not be any confusion, namely, it could not be said that the defendants' film would be taken as that of the plaintiff. Such a confusion was ruled out in all probabilities, as the sale promotions of the defendant's film were with central characters, namely, Amitabh Bachchan and Jiah Khan.

(e) His last submission was that in case injunction is granted, the defendants would suffer irreparable injury, which could not be compensated in terms of money in the event the defendants succeed ultimately. On the other hand, if the injunction is refused, the plaintiff could always be compensated by way of damages if the plaintiff succeeds in the end.

LAW ON THE SUBJECT:

10. The case relates to the alleged appropriation of a title. It is not a case where there is any allegation of usurpation of the work of the plaintiff by the defendants. In fact, as seen above, the plot and storyline of the two films is altogether different and there is not even a semblance of similarity between the two.

11. It is common, rather imperative, to give title to literary or entertainment works. Like human beings, literary work produced by the author or the work of entertainment produced by a producer needs a name. It is only then such work would be identified. The term 'literary title' is used to encompass titles of books, periodicals, newspapers, plays, motion pictures, television series, sings, phonograph records, cartoon features and the like [McCarthy on Trademarks and Unfair Competition, Third Edition (1995) Vol. I].

12. American Courts have taken uniform view that title alone of a literary work cannot be protected by Copyright Law. Copying of a title alone, and not the plot, characterization, dialogue, song etc. is not the subject of Copyright Law. Thus, a copyright on a literary work would not include exclusive right to use the title on any other work. What, therefore, follows is that if a junior user uses the senior user's literary title as the title of a work that by itself does not infringe the copyright of a senior user's work since there is no copyright infringement merely from the identity or similarity of the titles alone. Same is the position under Copyright Law in India.

13. However, legal protection for literary titles lies in the field of trademark and unfair competition. In general, such titles are protected according to the fundamental tenets of trademark and unfair competition law. McCarthy has described this and even provided the test which has to be applied while determining the infringement in the realm of trademark as under:

In general, such titles are protected according to fundamental tenets of trademark and unfair competition law. That is, such titles cannot be used by a junior user in such a way as to create a likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers. For these purposes, titles of literary and entertainment creations and works are treated in

much the same way as the trademarks of other commercial commodities.

14. Titles may relate to two types of works, i.e. titles of single literary works and titles of series of literary works. Titles of series of books, periodicals or newspapers do function as a trademark to indicate that each edition comes from the same source as the others and, therefore, such titles are even registrable as trademark. Such 'series titles' enjoy the same protection as usual trademark. The title of a newspaper serves a trademark function to the reader who is shopping among competing newspapers, just as when he or she is shopping among competing household products. Or, for example, where a term has been used in the title of a series of books, it may come to identify and distinguish a source to buyers. If so, it is a trademark for a series of books and is registrable as such. This trend is picked up even in television plays and motion pictures. We have television serials which run into hundreds of episodes. We have the examples of particular motion pictures made in series. The trend which started in Hollywood with 'The Godfather', 'Rocky', 'Die Hard', 'Mission Impossible', 'The Matrix', 'Jurassic Park' etc. has percolated in Indian film industry as well with the movies 'Hera Pheri - Phir Hera Pheri', 'Dhoom - Dhoom II' and 'Munna Bhai MBBS - Lage Raho Munna Bhai'. It is easy to give trademark protection to such titles of series of literary work etc.

15. That is not to say that titles of single literary work do not enjoy trademark protection, but in order to become entitled to this protection, it is necessary to prove that such a title has acquired secondary meaning. To quote McCarthy one again:

The law of literary titles is unique in one important respect. That is, the courts have given trademark protection to literary titles of one-shot, single works only upon a showing of secondary meaning, even though the title is not descriptive of the contents of the work. Regardless of the arbitrary or fanciful nature of the title as compared with the contents of the single book, play, movie, record, etc., secondary meaning is required. Thus, unlike ordinary marks, literary titles of single works which are inherently distinctive are not accorded immediate protection, absent proof of secondary meaning and consumer recognition.

16. Underlying assumption behind this rule is that only if such title has acquired the secondary meaning and is capable of associating itself with the particular work or source, the question of likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers/users would arise. This aspect shall be considered in some detail later in the discussion.

17. Title of a literary work may be descriptive of the literary work itself or the title may be such which has no relationship with the nature of work to which it is attached.

18. Whether titles of single literary works can be registered as trade mark or not has itself become debatable in the US, though in the case of titles of series of literary work, judicial opinion is that they are registrable. However, it is not necessary to go into this debate inasmuch as the plaintiff's title 'Nisshabd' for its film is not registered as a trademark. The case at hand is, therefore, while applying the legal protection given to such titles under the Trade Marks Act is to be considered on the principle applicable in the cases of passing off of such trademarks. In passing off, necessary ingredient to be established is the likelihood of confusion and for establishing this ingredient it

becomes necessary to prove that the title has acquired secondary meaning. Thus, in case of unregistered title following ingredients are to be proved in order to triumph in an injunction suit:

i) Title has acquired the secondary meaning;

ii) There is likelihood of confusion of source, affiliation, sponsorship or connection of potential buyers/audience/viewers.

19. The test of secondary meaning in respect of literary titles is explained in the following manner by McCarthy (supra):

The test of secondary meaning for literary titles is essentially one of determining whether, in the minds of a significant number of people, the title in question is associated with a single source of the literary work. That is, are people likely to assume that defendant's work is connected in some way with the producers of plaintiff's literary effort? The association need be only with a single, anonymous source. That is, the consumer need not know the trade name of the source, but is entitled to assume that all works or goods under that title are controlled by some single source.

20. In *International Film Service Co. Ltd. v. Associated Producers Inc.* 273 F. 585 (D.C.N.Y. 1921), the Judge Learned Hand observed as under:

A title is, if not strictly descriptive, at least suggestive and not an arbitrary sign... [t]he question is said to be of secondary meaning, following the long line of decisions in the Webster Dictionary cases. The plaintiff succeeds as soon as he shows an audience educated to understand that the title means his play...the title is the proper name of a specific thing, not the differential of a species, as in the case of fungibles.

21. Each literary work is a specific, separate and unique commercial item and not as one product among many competing products. The reason is simple. Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Therefore, each literary title is regarded as a term used to describe the product itself, rather than a mark used to designate a single source among many sources of literary works.

22. What is the evidence needed to establish secondary meaning for a literary work? In *International Film Service Co. Ltd. v. Associated Producers Inc.* (supra) following simple, but at the same time most eloquent parameter is laid down by the Court:

The plaintiff succeeds as soon as he shows as audience educated to understand that the title means his play.

23. Even if the work has not been released, a sufficient amount of pre-release publicity of the title may cause a title to acquire recognition sufficient for protection. Relevant evidence from which secondary meaning for a literary title may be inferred as a question of fact include: (1) the length and continuity of use; (2) the extent of advertising and promotion and the amount of money spent;

(3) the sales figures on purchases or admissions and the number of people who bought or viewed plaintiff's work; and (4) the closeness of the geographical and product markets of plaintiff and defendant.

24. In so far as test of likelihood of confusion of literary titles is concerned, it is the same as applied to trade marks in general. In considering the likelihood of confusion similar literary titles, the Courts often takes into consideration the total visual impression of the whole item reaching consumers. It is held by Courts that little assistance can be taken from a meticulous comparison to words letter by letter, syllable by syllable pronounced with clarity to be expected from a teacher of elocution. The two marks are to be compared in totality and stress is to be laid on common features rather than on distinctive features.

25. Therefore, what follows is that while considering the application for temporary injunction and pendente lite relief, the plaintiff has the burden of proving probable existence of secondary meaning in the title leading to likelihood of confusion and a likelihood of success at trial. Where the plaintiff cannot make a strong case of secondary meaning or likelihood of confusion, a preliminary injunction has to be denied. However, in a case where plaintiff introduces sufficient evidence on secondary meaning and likelihood of confusion, defendant's use of literary title need to be preliminarily enjoined. Where a dramatic work alleged to be infringement is about to be widely disseminated among the public, the need for preliminary injunctive relief may be great. In *Chappell & Co. v. Fields* 210 F. 864 (2nd Cir. 1914) as far back as in 1914 the US Court had observed that "preliminary injunctions are granted more readily in dramatic than in other cases because the delay involved in waiting a final decree would generally amount to a denial of justice."

26. I may state here that in discussing the aforesaid legal position I have extensively quoted the legal position in US as applicable to the cases of "titles in literary or entertain works." Reason is simple. Law in India on the subject is not much developed and the only case cited at the bar was the judgment of a learned Single Judge (per Hon'ble Mr. Justice Vikramajit Sen) of this Court in the case of *Biswaroop Roy Choudhary v. Karan Johar* (supra). However, it may be added that the principles on which law in US on the subject has developed are the same as applicable in the Indian law of passing off. The only difference is that where as there is a paucity of case law in India, in America, over a period of time law has sufficiently been evolved.

THE CASE AT HAND:

27. We may apply the afore-stated principle of law to the case at hand. It is not in dispute that the plaintiff is the prior user who produced the film way back in the year 2005 with the title 'Nisshabd'. It is also not in dispute that this film has not been commercially exploited. At the same time, indubitably, it has been shown in various Film Festivals and in many such events it has won prizes, some of which are treated as prestigious and highly coveted. The question is whether on this basis it can be said that the title of the plaintiff's film has acquired secondary meaning, i.e. whether the audience would associate the title 'Nisshabd' to mean that it refers to the plaintiff's movie. Another question is as to whether there is likelihood of confusion in the mind of public, namely, with the defendants' movie 'Nishabd' people would perceive that it is the same movie which the plaintiff

produced. Third question is what would be the effect of delay in bringing the cause to the Court? I have posed all those three questions together because of the reason that answer to the same has become inextricable, specially in view of the facts of this case.

28. There is a candid admission in the plaint itself that the plaintiff had come to know about the defendants' intention to choose the title 'Nishabd' for its forthcoming venture. During the course of arguments, learned Counsel for the plaintiff has produced the copy of an e-mail sent by the director of the plaintiff company (who is the director of the film as well) to WIFPA. This letter contains complaint against the defendant No. 1 regarding its proposed film to be named as 'Nishabd' and states that since he has already produced the film with the same title, no other film with this title could be registered. I reproduce below the said letter verbatim:

Dear Mr. Prabhat Pande, We find in the newspapers report of a feature film to be made by Mr. Ramgopal Varma, and the proposed film will be named as NISHABD.

As you may be aware, our film titled NISSHABD (in Bengali) has already been registered (Registration No. 8238 vide your letter No. WIFPA/6-05/516 dated 8th June 05. The film has already been made and got its censor certificate from Delhi. The film has already been shown at about 11 International festivals so far, no other film with the same title NISHABD or NISSHABD can be registered.

With regards Jahar Kanungo Director Kanungo Media Pvt. Ltd.

29. On the same date reply was received by the plaintiff from WIFPA taking the stand that there was no impediment in registering the title 'Nisshabd' for Hindi film as the plaintiff's title 'Nisshabd' was for Bengali film. The text of this letter is manifestation of the defendants' intention and the view of WIFPA:

From: sangram shirke Date: Mon, 8 May 2006 11:16:34+0100 (BST) Subject: Title Nisshabd To:

jaharkanungo@gmail.com Dear Sir, In reference to your email dated 8th May 2006 please note you have registered the Title "Nisshabd" for Bengali Film, therefore, the said title is free for registration for other languages, T.V. serial or Music Album.

Mr. Ramgopal Varma has registered the title "Nisshabd" for Hindi and as the rules of Title Registration the said title is free for registration for other languages.

Also kindly note the titles have to be renewed every year if required by paying the requisite fees.

Kindly take note of the same.

Thanking you, Prabhat Pandey Hony. Gen. Secretary Western India Film Producers' Association

30. At this stage, we are not concerned as to whether the position taken by WIFPA was legally valid or not. What is stressed is that on 8.5.2006 the plaintiff was made aware that the title 'Nisshabd' was free for registration in languages other than Bengali and even for TV serial or music album and as the defendants' proposed film was in Hindi language, it could be registered with WIFPA. Notwithstanding the same, the plaintiff remained silent and did not take an action. He eschewed and gave in. The reason given by the plaintiff that because of financial difficulties he could not file the case earlier, would not be convincing and this plea does not inspire confidence. In any case, fact remains that the plaintiff did not even lodge a protest with WIFP, the defendants or any other authority, including CBFC. At least the plaintiff cannot argue that so called financial difficulties prevented him from writing a protest letter even.

31. Such a silence on the part of the plaintiff may amount to giving up rights, if any, he had. What is more important is that consciously he allowed the defendants to go ahead with the production of the movie 'Nishabd'. Since the storyline of the defendants' movie is totally different, even if it was being shot with the said story, it was not of any concern to the plaintiff. However, what would be of relevance to us is the actions and steps taken by the defendants in the adoption of the title 'Nishabd' for their movie. In April 2006, the defendants had announced that they were producing the film by the name 'Nishabd.' In July 2006, the Association of Motion Pictures granted a certificate to the defendants for registering the feature film with this title in India. On 18.7.2006 the said Association had even issued a circular, which was sent to all producer members. Various articles in the media appeared regarding this movie. The producer and the director wanted to project the bold theme, which this movie had and the articles focused this theme of the movie. After the completion of the movie and before its release, as it has become a necessary marketing strategy, the defendants also started promotional work of the movie. It is stated that a sum of Rs. 1.5 crores is the advertisement budget for this movie and large part of it has already been spent. The defendants even launched website of this movie. Music rights have already been sold to the defendant No. 3. They have started producing and distributing compact discs and cassettes in the market, which are available at all music stores all over the world and also from the internet. Since December 2006, trailers of the defendants' movie have been running in various cinema halls. Posters and publicity material of the film have also been distributed. The lead cast in the movie is Amitabh Bachchan and Jiah Khan. Amitabh Bachchan is indubitably an established and accomplished actor of prominence, who many perceive to be a living legend. What is emphasised by the defendants is the impact of publicity of the defendants' film with title 'Nishabd' by keeping him in the forefront of such promos. Jiah Khan is a debutant and the producers have tried to launch her as a new face aptly suited for such a role. With this kind of promotion given by the defendants to their forthcoming film, it is claimed that general public today associate title 'Nishabd' more with the defendants' film and not the plaintiff's.

32. When the matter is examined in the aforesaid backdrop, the plaintiff has lost the chance in getting temporary injunction by not approaching the Court earlier. By his inaction and allowing the things to happen in the aforesaid manner, it has slipped an opportunity. Things would have been different had we considered this case when the film was being shot by the defendants or even completed but before the promotional work of the film started by the producers. The plaintiff could have argued that he is the senior user of the title and it is his film alone which has not only been produced much earlier but has been shown in various Film Festivals and has won awards and,

therefore, has acquired secondary meaning, namely, title 'Nishabd' is associated with his film. I consider that favorable critical reaction to the work may be treated as evidence of secondary meaning for the title, as a highly praised work is more likely to be known to the public by name. In fact, "any publicity is good publicity" and, therefore, it is not necessary that to acquire secondary meaning, work has to be popular, for even bad reviews and advertisements, public comments may bring about widespread identification of the literary work by its title. May be, consideration of the plaintiff's claim say even in July/August 2006 could have yielded positive results for it. In presenti, because of the publicity of extravagant nature of the defendants' film in the form of articles published in the journals and newspapers, posters, website, release of film's music, the forthcoming film of the defendants is known more than that of the plaintiffs. The plaintiff has allowed it to happen. It is because of this that the plaintiff even cannot claim that the title 'Nishabd' is associated only with its movie or the public does not know about the defendants' movie.

33. Prima facie, as of today the claim of the plaintiff's movie's title 'Nisshabd' appears to be blurred in comparison with the defendants' movie's title 'Nishabd'. For the same reason, as the defendants' forthcoming movie has acquired much publicity, there is hardly any question of confusion. One cannot, in the process, lose sight of the fact that the plaintiff's film is a documentary and in Bengali language whose viewership would be substantially less than a Hindi movie. Further, no doubt, the plaintiff's movie has achieved critical acclaim but only in the Film Festivals where not only the viewership is limited but of a particular category. Therefore, in today's context in so far as the question of granting temporary injunction is concerned, the plaintiff has not been able to meet the above requirements.

34. In *International Film Service Co. Ltd. v. Associated Producers Inc.* (supra) it was held that "The plaintiff succeeds as soon as he shows an audience educated to understand that the title means his play". I am conscious of the argument of the learned Counsel for the plaintiff that only because the plaintiff is a small time producer and, therefore, could not commercially release the film earlier, though he intends to do it now, title of his film should not be hijacked by those who consider themselves mighty and have reach in the film industry. There is a lot of substance in this argument. However, it is stated at the cost of repetition that such an argument would have been worth its weight had the plaintiff approached the Court earlier and taken action to nip in the bud the attempt of the defendants in choosing this title for their film. In fact, knowing his limitations viz. if he allows the defendants to publicise their film with title 'Nishabd' he would lose out, should have made him more vigilant in promptly approaching the Court. By delay it has allowed the damage to be caused to itself inasmuch as, today overwhelming section of public associate this title with the defendants' film.

35. In this context, it would be apt to quote from the judgment of the Supreme Court in the case of *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel and Ors.* (supra) where it is held as under:

103. Acquiescence is a facet of delay. The principle of acquiescence would apply where: (i) sitting by or allowing another to invade the rights and spending money on it; (ii) it is a course of conduct inconsistent with the claim for exclusive rights for trade mark, trade name, etc.

36. Because of delay, this Court in *Biswaroop Roy Choudhary v. Karan Johar* (supra) also refused to grant injunction observing as under:

12. Delay in approaching the Court, so far as grant of equitable relief is concerned, is always fatal. If the plaintiff is a serious producer of the film he ought not to have ignored gossip within his trade, whether it was in the form of press reports or exchange of communication to the Guild or Association claiming the same title. At this present moment I am unable to find any plausible reason for not filing the present case at least upon the Defendants performing its Mahoorat. The plaintiff has waited for the Defendants to expend large sums of money and energy in the completion of the film with the same title, thereby shifting the balance of convenience in favor of the Defendant. The situation that is arrived at is that the likelihood of passing off is almost wholly eradicated. The subsisting claim may, at the highest, be the use of a title which the Plaintiff has itself failed to use. The right as well as the loss can only be determined after the trial.

37. Learned Counsel for the plaintiff had referred to the judgment of the Supreme Court in the case of *Midas Hygiene Industries (P) Ltd. and Anr. v. Sudhir Bhatia and Ors.* and of this Court in *Glaxo Group Ltd. v. Vipin Gupta* 2006 (7) AD (Delhi) 688 to contend that injunction could not be refused only on the ground of delay and laches. It has to be borne in mind, in the first place, that it would be a principle applicable in the case of registered trade mark. Secondly and more important, is the distinction between the cases of passing off action in goods/trading and passing off action in literary works. In the former case one product is competing with the other and there are two competitors. However, as far as literary work is concerned, as has been pointed out above, it is a specific, separate and unique commercial item and not as one product among many competing products. Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Thus, in fact, this is the genesis for the adoption of the test of secondary meaning for title of a literary work. Therefore, it would be difficult to hold that delay is not fatal in such cases.

38. Consequently, I am, therefore, of the view that injunction of the nature pressed by the plaintiff cannot be granted to the plaintiff at this stage when it approached the Court barely 10 days before the proposed release of the defendants' film with the same title. This injunction application is, therefore, dismissed. It is made clear that entire discussion in the order is on the prima facie view of the matter and observations made in this order are only tentative.

No costs.