

Shephali

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION (L) NO. 1076 OF 2017
IN
SUIT (L) NO. 319 OF 2017

Anil Kapoor Film Co Pvt Ltd ...Petitioners
Versus
Make My Day Entertainment & Anr ...Respondents

Mr Ravi Kadam, Senior Advocate, with Mr Rashmin Khandekar, Mr Ameet Naik, Mr Prasad Shenoy & Ms Madhu Gadodia, i/b Naik Naik & Co, for the Petitioners.

Dr Abhinav Chandrachud, a/w Mr Manish Bohra, i/b M/s. AS Khan & Associates, for Defendant No. 1.

CORAM: G.S. PATEL, J

DATED: 4th May 2017

PC:-

1. Leave under Clause XII of the Letters Patent was granted by a separate order passed today.

2. This application for ad-interim reliefs comes to be made in circumstances that are, to put it mildly, most irregular. I had specifically declined circulation for ad-interim reliefs. The papers were therefore not circulated. I did permit the matter to be listed for the limited purposes of a Clause XII leave application. It is in fact

listed under that caption. At the time of the application for Clause XII leave, the Motion is pressed for ad-interim reliefs. When Dr Chandrachud for the 1st Defendant protests (quite rightly), he and I are both told he was given notice that the Plaintiff would be so moving. Once I had declined to grant circulation, the Plaintiff ought not to have made this application today at all. This is unfair to the other side and it is unfair to the Court. I have allowed Mr Kadam for the Plaintiffs to proceed only because he insists there is great urgency.

3. I find, in fact, there is not. This is yet another instance where despite at least two months' prior knowledge, possibly more, a party chooses — in this case, I suspect on legal advice — to wait until the very last minute to approach the Court; this time, on the penultimate day of the term, just before the court closes for the summer vacation. Typically, this is a time when the court's dockets are more pressed than usual, and today's docket is especially crowded with a fixed matter listed for completion and a separate list notified to *start* at 5:00 pm. The Plaintiff could have moved at any time earlier.

4. The application is for an injunction in passing off. It is in respect of a title of a film. This needs to be re-emphasized. The only right claimed is in the title of the Plaintiff's forthcoming, under-production film, one that does not yet exist. The Plaintiff says that it has rights to the title *Veere Di Wedding*. According to the Plaintiff itself, this means "my best friend's wedding". This is to star Ms Sonam Kapoor, among others. The 1st Defendant has made a film

with the title *Veere Ki Wedding*, scheduled for release in May or June 2017. It stars Mr Jimmy Shergill.

5. Mr Kadam concedes there is no question of copyright in a title. The suit is not framed on that basis. His claim is, he says, and can only be in passing off. He says this has been accepted as a possible cause of action by Courts including *inter alia* by the Supreme Court in *Krishika Lulla & Ors v Shyam Vithalrao Devkatta & Anr.*¹ In paragraph 19, the Supreme Court said:

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 trade mark 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* [*Dicks v. Yates*, (1881) LR 18 Ch D 76 (CA)] 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).

(*Emphasis added*)

6. However, this is not the same as saying that in every single case where a Plaintiff has or claims to have acquired some sort of registration of a script or screenplay, he is entitled automatically to an injunction in passing off.

7. The plaint says that in April 2013 the Plaintiff entered into a script writing service for two scripts. One of the scripts was
1(2016) 2 SCC 521.

finalized in March 2015. This was registered with the Film Writer's Association ("FWA") under the name *Veere Di Wedding*. The Plaintiff claims this is exclusive. The title was registered with the Indian Film and Television Producers Council ("IFTPC"). Then the Plaintiff claims that on 29th April 2015 the Plaintiff sought registration of the title with the IFTPC, which it secured around 20th June 2015. This was valid initially for a period of one year. It was renewed thereafter, and this renewal was confirmed.

8. According to the Plaintiff, a shooting schedule from August 2016 was finalized. Mr Kadam relies on several newspapers articles in publications such as the *Times of India*, *India Today*, *Indian Express*, *Financial Express*, *Deccan Chronicle*, *Business Standard*, *The Hindu*, *Hindustan Times* and *First Post* etc., to say that these news reports show the Plaintiff to have 'acquired considerable reputation and goodwill' in the *title* of its film, *Veere di Wedding*. This title, he says, is now firmly ensconced in the public imagination with the Plaintiff's forthcoming cinematic work.

9. An Additional Affidavit is tendered. This is supposed to show the expenses incurred to show that the Plaintiff has spent 'vast amounts' on this production. There is a statement annexed to this affidavit. It does not bear out the assertion. I notice there are amounts of Rs. 50 lakhs, Rs. 65 lakhs, Rs. 45 lakhs and Rs. 25 lakhs paid to artists and directors. Some amounts are paid to some producers. Quite extraordinary amounts are said to have been spent on office and administrative expenses, Internet dongles, house keeping, telephones and so on. As evidence of expenses on film production, this is singularly underwhelming.

10. At this stage, this is the only material the Plaintiff shows of 'reputation' and 'goodwill', even assuming the two can be conflated and treated as synonymous, which I very seriously doubt.

11. I turn now, briefly, to the correspondence with IFTPC. It seems that in its communication of 11th June 2016 to Defendant No. 2, the IFTPC said that the Plaintiff's film was registered only for the Punjabi language. There is further correspondence from August 2016, with IFTPC then backtracking to say this information was an inadvertent error. On 11th August 2016, IFTPC wrote to the 2nd Defendant saying that the film *Veere Di Wedding* without any language restriction was registered to the Plaintiff. In March 2017 there was further correspondence between IFTPC and the Defendants regarding the registration of the title *Veere Ki Wedding* used by the Defendants. The Defendants claim that the error was on the part of IFTPC. The Plaintiff claims this was when it first learned of the Defendants' film with the title *Veere Ki Wedding*.

12. That was at least two months ago.

13. According to Mr Kadam, it is well-settled that if the ingredients of a passing off action are satisfied, an injunction should follow. That is true. But the question always is whether those ingredients are satisfied at all. As in the case of a trade mark, an action in passing off is a common law action in deception. A plaintiff must show reputation (and I will again allow Mr Kadam the latitude of including in this the concept of 'goodwill'), misrepresentation and damage. Of course, actual damage is not required to be proved

and fraud is not a necessary ingredient. But as the expression itself suggests, the attempt must be deceive, a calculated deception by the defendant to pass off his product or service as that of the plaintiff (or vice versa). It is not necessarily a deception as to goods or services themselves, but as to their source or provenance. In order to gain an order on a cause of action in passing off, therefore, the first order of business must be to establish reputation.

14. On the question of reputation generally, I believe it would be difficult to assert that without their being product or service to begin with. The Plaintiff's film is yet to be completed. It may never be completed. Many things in life are uncertain. Film completion is one — the history of cinema is littered with unfinished films. The reputation urged in this case is in anticipation of the creation of the thing to which it supposedly attaches, viz., the Plaintiff's film. The reliance on newspapers and news reports saying that the Plaintiff proposes to make such a film is scant evidence of the kind of reputation one must establish to succeed in passing off.

15. Dr Chandrachud for the Defendant No. 1 relies on the decision of the Privy Council *Francis Day & Hunter Ltd v Twentieth Century Fox Corporation Ltd & Ors.*² This is of course a well-known and celebrated decision that held there was no possibility of deception of the public by producing a film under with the title of a popular song. The Privy Council found that while it cannot be said that there can never be passing off in such a case, these cases are not only rare, but must be approached with caution and circumspection.

2AIR 1940 PC 55 : 1939 SCC Online PC 50.

A court must not lightly assume that the public is so gullible, so infantile, and quite so easily deceived that it does not know what it wants to see, hear or read. Not to put too fine a point on things, it seems to me hardly likely that any avid movie goer headed for a film starring Ms Sonam Kapoor will dive headlong into a darkened auditorium showing a film with Mr Shergill; or will mistake Mr Shergill's film for Ms Kapoor's (let alone he for she). There are such things as movie posters and marquees, after all. And, as the commercial fate of so many films tells us, our movie goers are not to be underestimated. The entire edifice of this argument on deception seems to me to be built on some archaic imagining of movie going from the 1950's or 1960's. It does not account for the Internet, the proliferation of online material, that all of this is available on common mobile phones, and that persons going to movies know exactly what they are about. This information overload has made deception far more difficult. It has, therefore, raised the bar when it comes to establishing passing off in situations like this.

16. The case in a passing off action is always that others, i.e., persons other than the plaintiff himself, and usually the anonymous public, have been deceived or are likely to be deceived; and that the defendant's actions are calculated to deceive. To succeed, the plaintiff must show that he has a proprietary right transgressed by some action by the defendant. Reputation is the primary factor. The plaintiff must show that name, description or get up that the defendant puts about are associated in the public mind and imagination with the goods or services of the plaintiff. The defendant must be shown to be acting in a way likely, or calculated, to deceive the unsuspecting public into believing that it are buying

or using (or in this case, seeing) that which is the plaintiff's, although in fact it is buying, using or seeing something put out by the defendant. No person may represent his or her goods or services as those of another.

17. This is the essence of what a Division Bench of this Court said in *KM Multani v Paramount Talkies of India Ltd & Ors*,³ relied on by Dr Chandrachud. There, the question was also of passing off in relation to a movie title, *Virginia*. Wadia J declined an injunction. Dismissing the appeal, the Division Bench said:

6. The film industry is comparatively modern, and apparently the only case of a passing-off action relating in any way to a film is the recent decision of the Privy Council in *Francis Day and Hunter, Ltd. v. Twentieth Century Fox Corporation, Ltd.* [1940] A.C. 112 where the complaint was that a film was being produced by the defendants under the same name as a song the copyright in which belonged to the plaintiffs. The Privy Council held that there could be no possibility of deception of the public by producing a film under the name of a well-known song. **Courts frequently have to adapt old established principles to new conditions of life**, and it is quite possible that in relation to the film industry some developments may take place in the law relating to passing-off. The evidence in this case is that the title of a film is very important; and another peculiarity of a film is that its life is comparatively short. It is not like a book which may be in circulation for years. **It might be very difficult to establish the reputation of a film under a particular title, and its association in the public mind with the plaintiff, by evidence of the actual production of the film. I can imagine a case in which the advent of a**

3AIR 1942 Bom 241.

film under a particular title had been very extensively advertised, and arrangements made for the booking of the film, and in which some other person produced a film under the same title shortly before the advertised film arrived. It is quite possible that in a case of that nature a passing-off action would succeed, *although generally the plaintiff must establish the reputation of his property by actual results*. See the case of *Licensed Victuallers Newspaper Company v. Bingham* (1888) 38 Ch. D. 139 in which the plaintiffs sued to restrain the defendants from publishing a newspaper under the same title as the plaintiffs' newspaper and failed on the ground that the plaintiffs' newspaper had only been published for three days before the date of action, and the Court held that sufficient reputation could not be acquired in that time to found a passing-off action.

7. In this case I am clearly of opinion that the plaintiff fails to prove either of the matters necessary to his success. **On the first point, he has not established that the title "Virginia" is associated in the minds of the public interested in films, with his film. I do not think he has established that fact even in relation to the limited public of Bombay, and he has not attempted to establish it in relation to the public in any other part of the world, though he has claimed an injunction in general terms. There is no evidence of extensive advertisement, though, no doubt, he did advertise on the wall of the cremation ground at Queen's Road, which is a prominent place. But there is no evidence that he spent large sums of money in advertisement.** His film has been shown only for a fortnight in Bombay, though, no doubt, it may be shown hereafter elsewhere. His production in India is practically no more than the production of the defendants' picture, which has been shown for a week in Calcutta. *In my opinion, it is essential for the plaintiff to*

go much further than he has gone to establish that when the public go to a film called "Virginia", they expect to see the plaintiff's film, and none other.

8. On the second matter which the plaintiff has to prove, the also fails. **He has entirely failed to prove that the use by the defendants of the title "Virginia" in connection with their film is in any way calculated to deceive.** The plaintiff's film is an Indian film in black and white; written in Urdu, depicting an imaginary story, as we are told, of the meeting of Greeks and Romans in the year 4,000 BC. The story does not purport to be historical. On the other hand, the defendants' film is a film in technicolour, and it depicts modern life in America. The plaintiff took the title; Virginia as being the name of the heroine of his picture, whereas the defendants took the title because the setting of their picture is in Virginia, which is a state in America.

9. In my opinion, there can be no possibility of deception between two things so essentially different. **It is, no doubt, unfortunate that two films should have exactly the same title, and the fact may lead to some confusion and inconvenience in the booking and production of the films. But the inconvenience to the plaintiff is no greater than the inconvenience to the defendants.** Both parties have without any intention to deceive taken the same title for their films, **and the plaintiff has no right to restrain the defendants from using the title, unless he can show that it has become associated in the minds of the public with his film and nobody else's.** He has called virtually no evidence at all. **His only witnesses were himself and a gentleman concerned with newspapers relating to the film industry. There was no attempt to prove any actual deception, or any likelihood of deception by reason of the identity of**

these two titles. In my opinion, the learned Judge was quite right in dismissing the plaintiff's suit.

(Emphasis added)

18. All these observations are of particular interest, even if our film industry is no longer in its infancy. It is true that in the case before the Division Bench the films were in two different languages. But both films existed and were in distribution. In the present case there is no evidence of the Plaintiff's film even being in existence yet. The mere fact that there is another film in the making with the same title but a completely different star cast is not necessarily evidence of it being 'calculated to deceive', or of the Defendants 'passing off' their film as having been made by the Plaintiff. There is a tiered structure to passing off actions, and a plaintiff and the court he approaches, must proceed down that well-worn path: first, reputation; then, misrepresentation; and then all the rest. It will not do for any plaintiff to allege misrepresentation and on that basis to try and establish reputation. As I have noted, other than third party news reports (which must be proved), and a desultory statement of expenses that is far from compelling, there is nothing to show reputation. No one has seen the film. There is no film to see. It is wholly wrong to describe this as a *quia timet* action. That expression relates to an action brought before misrepresentation can be made, not before reputation is established.

19. Dr Chandrachud is also at some pains to point out that not only is the material relied on by the Plaintiffs not in the form of any advertisement that it has itself carried out, but some third party comments. All of this is *after* the 1st Defendant sought registration

of its title. That, in his submission, and I think quite correctly, is enough to put at rest any question of Defendants having acted in deceit. Other than the newspaper reports annexed — all from June 2016 — there is nothing at all to indicate that the Plaintiff has given its film the kind of publicity or has acquired the sort of indelible reputation that could possibly lead me to a *prima facie* conclusion that the Defendants' adoption of their title was deceitful.

20. Finally, there is the title itself. It is a common place phrase in one or more of our many vernacular tongues. It means “my best friend’s wedding”. There are, I imagine, titles of some books and movies (and songs or melodies) that by themselves are sufficiently unique: *Gravity’s Rainbow*, perhaps, or *The Catcher in the Rye*, *To Kill A Mockingbird*, and so on. In cinema, too, this may be so: *Citizen Kane*, *Blade Runner*, many of the Bond movies (*Goldfinger*, *Thunderball*, *The Quantum of Solace*), *Aguirre the Wrath of God*, *Fitzcarraldo*, etc. But the fact that the title is unique is not in itself sufficient to establish reputation, nor is the fact that there has been a previous book or a film with the same name. There is absolutely no shortage of films that have exactly the same title but are very different otherwise and share nothing else in common.⁴ These instances put us squarely within the frame of the ration in *KM Multani*: in that case, too, there were two competing films with the same name but nothing else. There exist many films with exactly the same title but different contents. It is not shown, or even urged, that for these films an action in passing off succeeded, was ever filed, or

4 *The Accused* (1998 and 1949); *Betrayed* (1988 and 1954); *Heat* (1995 and 1972); *Gladiator* (1992 and 2000); *Invincible* (2006 and 2001); *Crash* (2004 and 1996); *Proof* (2005 and 1991); *The Aviator* (2004 and 1985); *Heaven Can Wait* (1978 and 1943); *Notorious* (1946 and 2009).

even could have been filed merely because the two titles were the same. George Tillman Jr's 2009 *Notorious* is about as far as it is possible to be from Alfred Hitchcock's 1946 work of the same name; and this is true too of several others. There is not a suggestion in the plaint that, apart from the title, there is any commonality between the Plaintiff's forthcoming film and that of the 1st Defendant. When therefore the Plaintiff argues that an action in passing off lies in respect of a title of a film, though not in copyright infringement, this is inaccurate. A work may gain reputation on publication or release. In showing reputation, a plaintiff must show that his work with that name is associated in the public mind only with that film or book, one that exists. When the title is unusual or unique, it might make the task of a plaintiff somewhat easier, but I think it is difficult to conceive of a reputation attaching to a non-existent thing — a film not made or a book not written — no matter how unique the title. Where the title is more commonplace, the burden of establishing a reputation might lie heavier; but that burden is never discharged by saying only, as the present Plaintiff does, that it has plans to make a movie with a particular title and others have spoken of it. Films with names *Gaslight*, *Birth of a Nation*, *Casablanca*, *Bicycle Thieves*, or hundreds of others; and, closer home, of films with commonplace titles like *Zanjeer*, *Deewar*, *Anand*, *Pyaasa* or *Sholay* — the list is endless — are all instances of film that, with possibly ordinary titles, acquired a reputation in those titles upon their release. The 'reputation' of these films has, over time, been so established that the titles uniquely connote these films and no other. I do not think that is even remotely true of the Plaintiff's yet-to-be-made film. Thus, when a plaintiff claims passing off in a title *simpliciter*, independently of any content similarity, he reaches well beyond the

considerations of *KM Multani* (where, incidentally, there was, in relation to reputation, an overview of the content). It is, I think, *prima facie* exceedingly difficult to conceive of reputation attaching to a title alone, of a thing not in existence, divorced entirely from content. This burden is not, *prima facie*, sufficiently discharged to warrant an ad-interim injunction.

21. At this stage, Mr Kadam seeks to withdraw his application and asks that the Motion only be made returnable. That is unacceptable, especially given the circumstances in which the application has come to be made, and the fact that this application has eaten considerably into time that was specifically allotted to other matters.

22. There is no *prima facie* case in passing off. Hence, no ad-interim reliefs. The Notice of Motion to come up in usual course. These are, of course, *prima facie* observations and the Motion will be decided on its merits unaffected by these findings.

(G. S. PATEL, J.)