

Star India Private Limited vs Leo Burnett (India) Private Limited on 24 September, 2002

Equivalent citations: 2003(2)BOMCR655, 2003(27)PTC81(BOM)

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Bench: F.I. Rebello

JUDGMENT

F.I. Rebello, J.

1. Plaintiffs carry on business of acquiring copyrights in cinematographic films television serials, programmes etc., and also produce and commission production of television programmes for various television channels. The programmes so acquired or produced or commissioned, according to the plaintiffs, enjoy tremendous popularity amongst television viewers in India as also abroad. The plaintiffs entered into an Agreement dated 9th April, 2000 with Balaji Telefilms Pvt. Ltd., (Balaji) in order to create, compose and produce 262 episodes of a television serial entitled "KYUN KI SAAS BHI KABHI BAHU THI".

The terms and conditions of that serial are as set out in the Agreement. Reliance is placed on Class 6 of the Agreement, based on which it is contended that the plaintiffs are now the owners of the copyright of the episodes in the serial so far filmed. Since 9th April, 2000, Balaji has produced episodes of the serial "KYUN KI SAAS BHI KABHI BAHU THI". Full consideration has been paid and, thus, the plaintiffs are the exclusive owners of the copyright in this serial. Balaji's services were engaged by way of contract of service and as such the plaintiffs are the first copyright owners under Section 17 of the Copyright Act.

The theme of the serial involves a renowned business house known as Virani Group, headed by Dhirubhai Virani. Dhirubhai has three sons, Mansukh, Himmat and Jamnadas and a married daughter Pradnya. The family resides in palace like bungalow "Shantiniketan" at Juhu. The story involves around Amba Virani, wife of Dhirubhai Virani, her three daughters-in-law Savita, Daksha and Gayatri and grand-daughter-in-law Tulsi. Savita's eldest son Mihir marries Tulsi, a simple girl from an ordinary middle class family, against the wish of his mother, who wanted him to marry Payal, daughter of a big businessman. The other members of the family excluding Savita, Daksha and Gayatri are happy with the marriage. They attempted, after marriage, all possible tactics to create a barrier between Mihir and Tulsi to break the marriage. Their plans fail. Soon after marriage Mihir meets with an accident on a business tour. A dead body resembling Mihir is found at the accident spot. The Virani family believes Mihir to be dead. At the time of Mihir's death, Tulsi gives birth to a son, who is named Gautam. Mihir's death brings drastic changes between Savita and Tulsi.

Savita realizes that she should treat her widowed daughter-in-law as her daughter and help to bring happiness back into her life. The family decided to get Tulsi remarried. Anupam Kapadia a business partner of Mihir from England decides to complete the project which was started with late Mihir. In the course of time Anupam develops liking for Tulsi. The Virani family thinks that Anupam Kapadia will be a suitable match and, accordingly, the said marriage is fixed. The other part of the story which results in a happy ending need not be reiterated. Suffice to say that Mihir is alive. He had lost his memory which comes back and the family is reunited.

2. The plaintiffs case is that Balaji for publicizing the title of the film has devised the original artistic work depicting inter alia the logo and the title in a peculiar stylized font and containing as its essential features the words "KYUN KI SAAS BHI KABHI BAKU THI". The artistic work was prepared and devised by Balaji under an Agreement and as such the plaintiffs have become owners of the said artistic work. The serial has commenced broadcasting since July, 2000. Before launching the serial, the plaintiffs had carried out publicity campaign in the media by inserting advertisements. The original artistic work and the central characters have been used by the plaintiffs. The serial it is contended has acquired immense goodwill and reputation in the minds of the members of public in India so much so that the members of the public associate the said serial with the plaintiffs and the plaintiffs alone. In view of the tremendous popularity and goodwill enjoyed by the serial, the plaintiffs are actively considering using the serial and the characters therein for the purpose of endorsing products and services for a fee. The plaintiffs were, therefore, surprised when some time in the third week of February, 2002, they came across a television commercial for a consumer product "Tide Detergent". On inquiries the plaintiffs came to know that Tide Detergent is marketed by defendant No. 2 and was produced by defendant No. 1. It was the case of the plaintiffs that the comparison of the plaintiffs serial with the commercial would show that there is substantial copying. Comparisons are set out in paragraph 12 of the plaint. It is then contended that the overall impression of any viewer who sees both the works would be that the subsequent work of the defendants is a copy of the original work of the plaintiffs, authorized by the plaintiffs and/or licensed by the plaintiffs. An average person viewing the defendants commercial would immediately notice the glaring identity similarity between the plaintiffs' serial and the defendants' commercial and such a person would get an impression that the defendants' commercial has been authored by the plaintiffs or has been produced under the permission or licensed by the plaintiffs. Further an ordinary person would get an impression, that the plaintiffs who are the producers and proprietors of the serial "KYUN KISAAS BHI KABHI BAHU THI" are whole heartedly and unreservedly endorsing the product of the defendant No. 2. An average viewer would, thus, have an unmistakable impression that there is connection in the course of business and/or trade between the plaintiffs in the said serial and the defendants' and their commercial. It is also averred that apart from the serial, acquiring tremendous goodwill and reputation amongst the people of India, the characters and the said serial have acquired universal renown. The serial and the characters are identified in the public mind excessively with the plaintiffs. The public associates the plaintiffs, the said serial, its characters and Channel Star Plus with each other. On account of having expended large sums of money in developing the rights in the serial and its characters the plaintiffs are entitled exclusively to encash upon the goodwill generated by the serial and its characters and at all material time have serious intention to encash upon the goodwill and reputation of the serial and its characters commercially and for profits in various ways. The

Defendants by telecasting/broadcasting the commercial with the title "KYUN KI BAHU BHI KABHI SAAS BANEGI" with identical characters. Viz., Tulsi, Savita and J.D. are deliberately and dishonestly seeking to trade upon and misappropriate the reputation and goodwill of the said serial and its characters. The Defendants are not entitled to do so without obtaining the prior consent and/or the permission from the plaintiffs. The Defendants are doing so to attract patronage of those of the plaintiffs' viewers, who assume a connection in the course of trade and/or otherwise between the plaintiffs and the defendants' product and the commercial. The defendants by deliberately and false, representing a connection between the other commercial and the plaintiffs' serial and passing off and/or attempting to pass off the defendants' commercial as being authorized and/or licensed by and/or connected with the course of business with the plaintiffs and the plaintiffs' popular serial. On account of this, plaintiffs contend that considerable loss and/or damage is being occasioned to the plaintiffs due to continuous act of infringement of copyright and passing off of the copy to the defendants. Compensation in money, it is contended, would not be an adequate relief.

It is also then contended that the defendants have misrepresented to the members of the public at large that the defendants have been authorized to make use of the original artistic literary and musical work and also the cinematographic film for merchandising the said product of the defendant No. 2 when the true fact is just contrary. By the defendants telecasting the commercial, and that too, in close proximity to the areas of activity of the plaintiffs, an erroneous impression has been created that the defendants are authorized and entitled to make use of the works in the serial. Creation of such misrepresentation and confusion and probability of apprehension is apparent, given consideration to the repute of the defendants. Various reliefs are prayed for and as the matter involves violation of intellectual property rights and as the Court is the guardian of public interest, injunction must follow and other reliefs as prayed for.

The motion taken out is supported by the affidavit Sheenaz R. Patel which reiterates and places reliance on the averments of the plaint.

3. Defendant No. 2 has filed a reply opposing the grant of relief to the plaintiffs through an authorized signatory Shefali Chaddha. It is the case of the defendant No. 2 that it belongs to the P&G group of companies which carries on business worldwide as a leading multinational group of companies in the world. The products emanating from P&G group of companies are well known for its superior quality and technical excellence. The group incurs million of dollars per year as and by way of advertisement expenditure. The Tide Product of P&G is one of the leading brands in the world and is the number one selling brand. It is widely advertised in different media including T.V. as part of P&G's advertisement campaign. Tide is registered as a trade mark in India since last several years and is also registered in many other countries. Defendant No. 1, it is contended, is a well known advertising agency and defendant No. 2 avails of its services from time to time to create and develop T.V. advertisement commercials in respect of its various consumer products. In the year 2001, defendant No. 2 commissioned defendant No. 1 to develop and create a novel T.V. advertisement commercial in respect of its detergent product Tide. The overall idea, concept and format of the proposed T.V. commercial was jointly discussed and developed amongst the representatives of defendant No. 2 and defendant No. 1. Thereafter Ms. Kumuda Rao, the creative Director of defendant No. 1 by her own independent labour and skill created a story board of the

Tide T.V. commercial of defendant No. 2, the duration of which was/is to be of about 30 seconds. The story board was made in or around November/December, 2001. Reliance is placed on the story board created. The whole theme or concept of the commercial is set out in paragraph 9 of the reply. One Opticus Films were engaged to produce the film. The engaged the service of the models Muni Jha, Smriti Malhotra and Aparna Mehta. The Tide T.V. commercial with specially created and recorded background music was shot/filmed at Concorde Studios on or about 7th December, 2001. The post production quality editing was done in Singapore. It is, therefore, submitted that the Tide T.V. commercial is an independent creation made at the instance of and for and behalf of defendant No. 2 for valuable consideration and independent copyrights therein vest in defendant No. 2. Independent labour, skill and effort have been expended in the creation of the Tide T.V. commercial. The duration of the Tide T.V. commercial is of about 30 seconds. The commercial is not a reproduction or imitation of the plaintiffs' serial at all and does not infringe any copyright in the serial or any of the plaintiffs' work. The T.V. commercial, it is contended, is extensively aired on T.V. channels since January, 2002 and defendant No. 2 has incurred a huge expenditure. The commercial was submitted for the purpose of airing it on Star T.V. it was accepted and as such the plaintiffs/its sister concern has acknowledged that the Tide T.V. commercial was not objectionable. It is further submitted that there is no copyright in an idea, concept or theme. The defendants have put the plaintiffs to a strict proof insofar as its contention that the programme enjoys tremendous popularity. It is further denied that the alleged artistic work constitutes an original artistic work. The defendants deny and do not admit that, the work was commissioned by the plaintiffs and made by Balaji pursuant to the Agreement. The title "KYUN KI SAAS BHI KABHI BAHU THI" is a commonly known saying/proverb/creation which has not been devised by the plaintiffs or by Balaji. The manner in which it is written does not constitute an artistic work and the same is not copyrightable. The depiction of overlapping bonds in the logo is the age old expression of the 'saas' handing over the keys to the 'bahu'. This portrayal is in the public domain and does not constitute an original artistic work. The defendants contended that the burden of proof as to advertisement, expenses incurred and the TRP ratings it is contended is on the plaintiffs which has not been discharged.

It is also contended that the plaintiffs are guilty of laches, and delay and of making false allegations. It is, therefore, contended that on this count alone the plaintiffs would be disentitled to any relief. It is then specifically denied that the Tide T.V. commercial has been copied, much less substantially copied, from plaintiffs' T.V. serial as alleged. Defendant No. 2 has denied that the title as depicted at Exhibit "C" of the plaint constitutes an artistic work or an original artistic work and that the manner in which the defendants' commercial is depicted in the Tide T.V. is a copy of the plaintiffs' title or alleged copyright. It is specifically denied that there is no copyright in the title and, at any rate, it is denied that the plaintiffs have a copyright. The depiction of overlapping hands in an age-old custom representing the 'saas' handing over the keys (and thus the responsibility of the house) to the 'bahu'. This portrayal is in the public domain and does not constitute an original artistic work. It is specifically pleaded that the commercial of defendant No. 2 has been independently created by Ms. K. Rao by her own skill and labour. It is not a copy of the plaintiffs' serial logo at all. It is specifically denied that the placement and selection of jewellery or that the title music has been copied as alleged. The models in the Tide. T.V. commercial were engaged on behalf of defendant No. 2. It is denied that these models play the same role in the Tide T.V. commercial as in the plaintiffs' serial. It

is also denied that a viewer viewing the serial of the plaintiffs and the Tide TV. commercial of defendant No. 2 would gather an overall impression that the Tide T.V. commercial of defendant No. 2 has been copied from the plaintiffs serial or has been authorized/licensed by the plaintiffs. It is further denied that an average person would father an impression that the commercial of defendant No. 2 has been authorized by the plaintiffs or has been produced under the permission of the plaintiffs or that an impression would be created that the plaintiffs are endorsing the product of defendant No. 2. There are other denials. The defendants do not admit that the serial has acquired by goodwill and/or reputation in India as is alleged or its popularity on its character. It is the case of the defendants that the plaintiffs are not entitled to exclusively encash upon the alleged goodwill of the serial and its characters. It is specifically denied that airing of Tide T.V. commercial would require any authorization from the plaintiffs for merchandising purposes.

It is also averred that even assuming that there are some features of defendant No. 2's Tide T.V. commercial found in the serial, of the plaintiffs, even then the alleged copying does not amount to a reproduction or substantial reproduction of the plaintiffs' serial, that is, alleged copying, if any, is of an unsubstantial part of the serial and, hence does not amount to infringement. The alleged logo at Exhibit 'C' does not constitute a separate work or original artistic work. Without prejudice to the aforesaid copyright, it does not vest in the plaintiffs under Section 17 of the Copyright Act, 1957 or under Clause 8 of the Agreement. At any event, there is no copying, much less substantial copying by the defendants in view of the independent creation of the Tide T.V. commercial. The serial is not identified by the public with the plaintiffs in the trademark sense, that is, to indicate source or origin of any goods. The plaintiffs have not established any goodwill in the serial in itself. For all the reasons contended and considering the annexures to the reply, the motion should be dismissed.

A rejoinder as been filed by Sheenaz R. Patel dealing with the contentions as raised in the reply. Insofar as viewing on Star T.V. Channel it is pointed out that the Tide T.V. commercial was never accepted for viewing on Star T.V. Channel as set out in paragraph 15 of the rejoinder. I need not advert to the other averments which are denials of the averments in the affidavit in reply. Some questions are of course posed in paragraph 45 of the rejoinder. Some additional affidavits have been filed by defendants placing on record the T.V. commercials similarly produced and of Sanjay Shet-ty, of Opticus Films who hot the commercial and of Ms. Kumuda Rao herself. It may be set out that from the judgments cited, those necessary to be referred to only, have been referred.

4. From the above pleadings in considering the grant of reliefs as prayed for by the plaintiffs it will be necessary, to answer the following questions which have arisen :

(1) Have the defendants by making the commercial film, violated and/or infringed the plaintiffs' copyright in the T.V. serial "KYUN KI SAAS BHI KABHI BAHU THI"?

(2) Have the plaintiffs' proved the defendants have infringed the plaintiffs' artistic work at Exhibit 'C, to the plaint? and (3) Have the plaintiff's proved that the defendants are guilty of passing off their reputation and goodwill in the T.V., serial, by misrepresenting the connection between the plaintiffs and the defendants arid thereby causing damage to the plaintiffs; and thereby defeating the plaintiffs'

character/merchandising rights, etc.?

5. The first question, therefore, that requires consideration is whether the defendants' commercial is a copy of the plaintiffs' T.V. serial? The case of the plaintiffs has been that as owners of the copyright in the film and considering Section 14(d)(1) of the Copyright Act, the plaintiffs, as the owners of the copyright in the film, have an exclusive right to make a copy of the film including a photograph of any image forming part thereof. It is contended that unlike the U.K. and Australia Copyright Acts, the word 'copy' is not defined in the Indian Copyright Act and, therefore, recourse must be had to the technical meaning of the word 'copy'. Reference is placed on the Oxford English Dictionary and Random House Dictionary of the English Language as to the meaning of the word 'copy'. It is then contended that the definition of 'infringing copy' is contained in Section 2(m)(ii) of the Act. Hence, imitating the film or making another film which bears likeness or striking resemblance to a copyrighted film would amount to making a copy of the film and, therefore infringement of the copyright in the film. Assuming that to establish infringement, copying should be of a substantial part of the plaintiffs' film, the test of substantiality must be from the point of view of the infringing work. It is, therefore, the duty of the Court to ascertain whether a substantial part of the defendants' work consists of a copy of the plaintiffs work. Reliance is placed on the judgment of the Apex Court in R.G. Anand v. Delux Films and Ors., . It is then contended that substantiality is not the question of quantity but of quality. The opening sequence common to each episode and also the peculiar and dramatic high point of the plaintiffs film is copied and the defendants have saved themselves time, labour and expense in developing something original. Reliance has been placed on paragraph 8.26 of Copinger and Skone James on Copyright, Thirteenth Edition, Reliance is placed on judgments.

On the other hand, on behalf of the defendants, it is contended that the plaint discloses no cause of action and/or in any event no cause of action has accrued to the plaintiffs to allege any infringement of the copyright in the plaintiffs' cinematographic film. Section 14(d) of the Act, it is contended, specifies only three categories of acts of which the owner of the copyright in a cinematographic film has exclusive right. Comparison is sought to be made within Section 14(e) where only three categories of exclusive right are given to an owner of the copyright in a sound recording. Reliance is placed on Section 2(f) which defines a cinematographic film. It is then contended that in contrast to Section 14(d) and (e) are Section 14(a), (b) and (c), which speak of exclusive rights to the owner of copyright in a literary, dramatic or musical work. These Sections, it is contended, give an exclusive right to the owner to reproduce the work in any material form. This is specifically and significantly absent in relation to a cinematographic film and sound recording and the exclusive right conferred by the latter sections is to copy the recording of that particular film/sound. The position becomes clear, it is contended; if the definition of infringing copy in relation to literary, dramatic or artistic work is contrasted with the definition of infringing copy in relation to cinematographic film and sound recording. Contrasting the two, in the former an infringing copy is the reproduction of the original copyrighted literary, dramatic, musical or artistic work. In the latter case, infringing copy is a copy of the film made from the copyrighted film or recording embodying the same sound recording from the copyrighted sound recording. The subsequent film/sound recording is not an infringing copy if it is not copied or made from the same, earlier recording. The expression 'to make a copy of the film', it is submitted, is to make a physical copy from the copyrighted film itself and not a reproduction of the copyrighted film, that is another film which merely resembles the copyrighted

film. From the affidavits of Kumuda Rao and Shetty it is clear that the defendants have not copied the film but have "made a new film. The only contention of the plaintiffs is that the film made/shot by the defendants resembles the plaintiffs' film and, therefore, constitutes reproduction. Reliance is placed on various judgments. The defendants, alternatively, contend that the plaintiffs' film and the defendants' film are different. There is no copying or substantial copying of plaintiffs' work, hence, no question of any copyright infringement can arise. It is also once again alternatively submitted that what is to be compared is the 'whole' of the respective works and 'not part' and if so compared, there is no copying or substantial copying.

6. It is, therefore, necessary to deal with the submissions as to whether the commercial film made by the defendants is a copy of the plaintiffs' film. Firstly, let me refer to the meaning of the word 'copy' as set out in the Oxford English Dictionary which defines the word 'copy' as under :

"Copy-1, a thing made to imitate or be identical to another, 2. a single specimen of a publication or issue (ordered twenty copies), 3a. matter to be printed, b. material for a newspaper or magazine article (sandals make good copy), c. the text of an advertisement, 4a. a model to be copied, b. a page written after a model (of penmanship) 1 to make a copy of b (often foil, by out) transcribe, 2. Into make a copy rather than produce something original, esp. clandestinely 3. to (foll. by to) send a copy of (a letter) to a third party, 4. to do the same as; imitate copy-edit edit (copy) for printing."

Similar Random House Dictionary of the English Language defines the word 'copy' as follows:

"Copy-1, an imitation, reproduction, or transcript of an original. 2. written matter or artwork to be reproduced in printed form 3. text to be read or heard, as distinguished from pictures to be seen in newspapers, magazines, television commercials, etc., 4. one of the various examples or specimens of the same book, engraving, or the like,. 5. Brit, informal (in schools) a, composition, a written assignment, 6. A archaic something that is to be reproduced, an example or pattern-7. to make a copy of, transcribe; reproduce, 8. to follows as a patter or model, 9. to make a copy or copies, 10. to make or do something in imitation of something else."

Section 2(m)(ii) defines 'infringing copy' as follows:

"2(m) infringing copy' means-

(ii) in relation to a cinematographic film, a copy of the film made on any medium by any means."

Section 14 of the Copyright Act, 1957 for the purpose of the Act defines 'copyright' to mean the exclusive right subject to the provisions of the Act, to do or authorize the doing of any of the following acts in respect of a work or any substantial part thereof, namely:

(d) in the case of a cinematograph film:

(i) to make a copy of the film, including a photograph of any image informing part thereof-;

(ii) to sell or give on hire, or offer for sale or hire, any copy of the film, regardless of whether which copy has been sold or given on hire on earlier occasions;

(iii) to communicate the film to the public.

It will, therefore, be essential to find out as to the meaning of the word 'copy' in the absence of it being defined in the Act. Reference can be made to Copinger and Skone James on copyright, Thirteenth Edition, at paragraph 3.29, some portions of which may be reproduced:

".....it has been stated that skill labour and judgment merely in the process of copying cannot, confer originality and the mere copyist cannot have protection of his copy. Particularly, therefore, where the reproduction is in the same medium as the original, there must be more than an exact reproduction to secure copyright; there must be some element of material alteration or embellishment which suffices to make the totality of the work an original work. If the original, in the case of a painting, is used merely as a model to give the idea of the new work or, in the case of a photograph, merely as a basis to be worked up by photographic process to something different, then the new work may be entitled to protection; but, if the result is simply a slavish copy, it will not be protected."

The same Authors in the Fourteenth Edition in paragraph 7.98 have dealt with "Films". The learned Authors have stated as under:

"It is an infringement of the copyright in a film to make a copy of it, or a substantial part of it, whether directly or indirectly and whether transiently or incidentally to some other use. This includes making a photograph of the whole or any substantial part of any image forming part of the film. As with a sound recording, it is not expressly stated that copying of a film includes storing it by electronic means but again it is suggested that it does. Again, the copyright in a film is infringed if the recorded moving images are directly or indirectly copied but not if the same or similar images are recorded independently, for example by reshooting the subject matter of the film. Again, however, underlying works such as the screenplay may be infringed by such means."

As pointed out earlier contrasting Section 14(d) and (e) on the one hand and Section 14(a), (b) and (c) on the other, in the latter case the owner of the copyright has exclusive right to reproduce the work in 'any material form'. This is absent and excluded insofar as the former case (cinematograph film/sound recording). The exclusive right in the former is to copy the recording of a particular film/sound recording. It is, therefore, clear that production by another person of even the same

cinematographic film does not constitute infringement of a copyright in a cinematograph film. It is only when actual copy is made of a film by a process of duplication i.e., by using mechanical contrivance that it falls under Section 14(d)(i). The expression 'to make a copy of the film' would mean to make a physical copy of the film itself and not another film which merely resembles the film.

The making of another film is not included under Section 14(d)(i) and such other film, even though it resembles completely the copyrighted film, does not fall within the expression 'to make a copy of the film'. Therefore, if the film has been filmed or shot separately by a person and it resembles the earlier film, the subsequent film is not a copy of the first film and, therefore, does not amount to infringement of whole of the copyright of the first film. The position in the case of literary, dramatic or artistic work seems to be different. A narrow copyright protection is accorded to a film/sound recordings than for literary, dramatic or artistic work. The reason perhaps could be that they have to be original to satisfy the test of copyrightability, whereas the requirement of originality is absent for claiming copyright in cinematograph films/sound recordings.

In *Telmak Teleproducts (Aust.) Pty. Limited v. Bond International*, 1985 (5) IPR 203, the defendants made, an advertisement film for the same products as were contained in the plaintiffs' advertising film and the Court found that the products of the rivals (which were advertised) and the films were also similar. As the defendants, however, had made their own film, though it was similar to the plaintiffs' film, the Court held that the making of the defendants' film was not an act within the categories of exclusive rights conferred on the copyright owner of the plaintiffs' film. The defendants' film had been shot and sound recorded by the defendants own agents. The defendants' film was not copied from the recorded medium of the plaintiffs' film. It was, therefore, held that the defendants had not made a copy of the plaintiffs' film. The defendants had not copied the visuals, images and sounds which together made up the plaintiffs' cinematographic film. The defendants had not caused the plaintiffs' film to be seen in the public, therefore, there was no act of the defendants which fell within the categories of exclusive rights conferred on the plaintiffs by the Act.

In *Norowzian v. Arks Limited and Ors.*, 1996 FSR 394, the English Copyright Acts of 1956 and 1988 were considered. In this case. It was the plaintiffs contention that the defendants had made a film purposely resembling the plaintiffs' film and that the defendants' film reproduced the essential features of the plaintiffs' film. On this basis, the plaintiffs alleged that the copyright in their film had been infringed because, according to the plaintiffs, the making of the defendants' film constituted copying of the plaintiffs' film. The defence of the defendants was that they had made their own film and, therefore, there was no copying. The Court after referring to *Modern Law of Copyright and Designs* by Laddie Presscott and Victoria, and *Copinger and Skone James on Copyright* held that, for the second film to infringe the copyright in the first film, it had to be an actual copy of the first film, itself, that in respect of a cinematographic film it is the recording that is protected from copying and nothing else, that even if the defendants' film exactly resembles the plaintiffs' film, but if the defendants' film is a re-shoot of the plaintiffs' film, which reproduces the essential features of the plaintiffs' film but does not copy the plaintiffs' film, that is, it is not reproduced from the recorded medium of the plaintiffs' film, the defendants' film does not and cannot infringe the plaintiffs' copyright in the plaintiffs film. This decision follows the decisions of the Australian Courts

in Telemak Teleproducts (supra) and CBS Australia Limited and Ors. v. Telmak Teleproducts (Aust.) Pty. Ltd., 1987 (9) IPR 440. It was thus held that unless there has been a copying of the whole or part of the plaintiffs' film itself, in the sense of a copying of the particular recording of that film, there cannot be any infringement of the copyright. The re-shoot of the film cannot be said to be the copy of the film for the purposes of infringement.

In Spelling Goldberg Production v. BBC Publishing Limited, 1981 RPC 283. The defendants had acquired possession of the plaintiffs' film and had made a physical copy of the plaintiffs' film. It was on these facts that the Court had held that it was a copy of the plaintiffs' film.

Therefore, considering the terminology used in the Act the facts on record and the cases discussed it is clear that the defendants made their own film independently. The film of the defendants, therefore is not a copy and, therefore, would not amount to an infringement of the plaintiffs' copyright in its film considering the language of Section 14(d) of the Copyright Act.

7. Then the issue to be addressed is whether there is substantial copying which would give rise to a cause of action to the plaintiffs. At this prima facie stage once the view is taken that the defendants' film is not a copy of the plaintiffs' film, it really would not require that this second submission be considered. However, as it has been advanced, it may be dealt with briefly. It was contended on behalf of the plaintiffs that the test of substantiality must be from the point infringing the work. Hence, the Court must ascertain whether a substantial part of the defendants' work consists of a copy of the plaintiff's work. See. R.G. Anand v. Delux Films (supra). Relying on Copinger paragraph 8.26 it is also submitted that substantiality is not a question of quantity but of quality. In the present case the opening sequence is common each episode and the peculiar and dramatic high point of the plaintiffs' film is copied and the defendants have saved themselves time, labour and expense in developing something original. It is further contended that it is immaterial if the serial runs into 262 episodes and whether it constitutes a single work. What is material is that the defendants have stolen a substantial part of the plaintiffs' work. Therefore, whether the plaintiffs' work consists of each episode as a film or whether all 262 episodes constitute a film is really to beg the question in the present case. It is then contended that the submission by the defendants that the copyright of the film is infringed only when each copy is made of the original is based on the decisions of the Australia and English Courts referred to earlier. Those authorities, it is contended, cannot be considered considering Section 14(d)(i) of our Act. It is contended that under Section 14 of the Act the exclusive right to make a copy of the film includes the right to make a photograph of any image forming part thereof. If, therefore, a copy of even a single image or frame is made, it amounts to violation of the plaintiffs' copyright in the film. Copying means and would include making something which bears a substantial degree of resemblance to the original. Therefore, even if exact words, scenes or events are not reproduced, if the plaintiffs show a substantial degree of resemblance or imitation of the original, copying would be established. What is material is that skill, labour and judgment in the process of copying cannot confer copyright and a mere copyist cannot have protection for his copy.

In the instant case the defendants' contention is that they have produced material to show that the plaintiffs' film and the defendants' commercial is not a substantial copy of the plaintiffs' film. The

plaintiffs' work is a film of 262 episodes and of the duration of 5240 minutes equivalent to over 87 hours. The defendants' work is a commercial/advertisement of its product Tide of about 30 seconds only. The two are entirely different and one can never be considered to be a copy of the other. The question of infringement of any copyright of the plaintiffs' film, therefore, does not arise. It has been factually established from the affidavits on record that the defendants' film has been made independently. The T.V. commercial of the defendant No. 2 promotes the product Tide detergent. The commercial does not purport to be nor can be taken by anyone viewing it to be a cinematographic film/serial at all, much less as the plaintiffs' film. The T.V. commercial has a beginning of about 8 to 10 seconds as prelude to the Tide detergent T.V. commercial but the major and real substantial part consists of the Tide detergent. The over all impact on the viewer which is sought to be impacted is of the Tide detergent. The defendants have placed on record material to show that the number of the characters in the film are different. The young lady whose remarriage is proposed is present in the defendants commercial but is absent in the corresponding part of the plaintiffs' film. The script of the two films is different. No portion of the dialogues or scenes are common. In the defendants' commercial the other family members present are opposed to be proposal of remarriage and the elderly lady raises the hand to strike the person making such proposal. In this segment of the plaintiffs' film, the family members present all support the proposal of remarriage. In the defendants' commercial the young lady, whose marriage is proposed, is already married with a child and whose husband is alive. She is wearing a mangalsutra and has a bindi and sindoor on her forehead, which are well established and recognized symbols and signs that she is not a widow. In the plaintiffs film, on the other hand, she is believed to be a widow and does not wear such symbols/signs, The defendants in their commercial seek to create an impact of the Tide product. The defendants, therefore have expended their own independent skill, labour and effort in making the T.V. commercial. Insofar as models are concerned, they are the same in both the films. These models are professionals and are free to contract. There cannot be, therefore, any act which would amount to infringement by using the same models. Even if the idea is borrowed there, can be no copyright in the idea. The test is to compare the two rival works. Thus seen and compared any applying both the tests quantitatively and qualitatively the two works prima facie are different and there is no work of substantial copying or similarity between the two. See *Jay Music Limited v. Sunday Pictorial Newspapers Limited*, 1960 (1) All E.R. 703. Copinger also sets out that where there is some element of material alteration or embellishment which makes the totality of the work an original work it will not be an infringement.

The issue then is whether if the whole of the respective works is compared and not only parts, factually or materially as it stands, is there copying or substantial copying. I am not at this stage also not considering whether the "work" as an episode or all the episodes which have to be considered in totality. Even for arguments sake if an episode is considered as a 'work', still what is to be compared is the whole work as a single entity. It is not permissible to split or compartmentalize or dissect the plaintiffs' work into parts, then seek to compare, such parts against the alleged infringed work. What is to be seen is the entirety of each work. It may be made clear that I am not considering an issue whether a particular part of the film or a scene in the film which may have a striking resemblance, if copied, would amount to a substantial copying of the film. For this purpose reference may be made to the decisions in *Francis Day and Hunter Limited v. Twentieth Century Fox Corporation Limited* and *Ors.*, 1940 AC 112 (PC); *Ladbroke (Football) Limited v. William Hill (Football) Limited*, 1964 (1)

WLR 273; Merchandising Corporation of America Inc. and Ors. v. Harpbond Limited and Ors., 1983 FSR 32; R.G. Anand v. Delux films and Ors. (supra) and Fritco Lay Limited v. Uncle Chips Private Limited, 2000 PTC 341. Applying the tests on the material as it stands there is no substantial copying on facts.

8. In respect of the contention of the photographs taken from film it may be noted that the contention is contrary to the plain wording in Section 14. The section itself speaks about the work or any substantial part thereof. They also fully, apply to Section 14(d)(i). There is no material on record to hold that the defendants, have taken a photograph of any image of the plaintiffs' film. No single image is identical, as even in the first image there are material differences. The image/still allegedly copied and incorporated in the Tide T.V. commercial is not a 'photograph' as defined, which provides that where anything which forms part of or is included in the cinematographic film does not fall within the definition of photograph. The frame or image which forms part of a film is excluded from photograph. Such image, therefore, does not fall within the meaning of 'photograph' in Section 14(d)(i). As the defendants have not made a photograph of any image of the plaintiffs' film, the question of infringement by copying the single image does not arise. Section 16 provides that there is no copyright except as provided under Section 14 of the Copyright Act or under any law for' the time being in force. It is no doubt true that the plaintiffs have relied on the Judgment in Spelling Goldberg Production (supra). I am, however, in agreement with the defendants that the judgment, can be differentiated for the following reasons:

(1) the wording in the English Copyright Act in this regard is different from Section 14(d)(i) read with Section 2(s) of the Indian Copyright Act.

(2) in the Spelling Goldberg's case, on facts, it was established that the defendants had acquired a physical copy of the plaintiffs' film and had made an actual copy, of a part thereof. Hence, it was held that the defendants had made a copy of the plaintiffs' film. The position, on facts, in the instant case is completely different. The defendants have not made a copy of the plaintiffs' film, but have shot their own film independently. (3) prima facie the alleged image/still forming part of the defendants' T.V. commercial is not identical and has material differences, On a perusal of Section 14(d)(i) it is clear that the contention is contrary to the plain wording of Section 14. The opening part of Section 14 gives the meaning of 'copyright' as being the exclusive right, subject to the provisions of the Copyright Act, 1957 to do or authorise the doing of any of the following acts in respect of the work or any substantial part thereof.....

The words 'in respect of a work or any substantial part thereof....' appearing on the opening part of Section 14 fully applies to Section 14(d)(i). As noted earlier no photograph of any image of the plaintiffs' film has been taken and in any event the image/still allegedly copied and incorporated in the Tide T.V. commercial is not a photograph as defined by Section 2(s).

Section 2(s) provides that where anything which forms a part of or is included in a cinematographic film does not fall within the definition of 'photograph' under the Act. Under Section 2(s), 'a frame or image which forms a part of the film is excluded from photograph'. Hence, such image does not fall

within the meaning of photograph in Section, 14(d)(i). Since the plaintiffs have not made a photograph of any image from the plaintiffs' film the question of infringement by copying a single still does not arise. Further, there are several differences even in the first image which forms part of the defendants' film. Considering this and as Section 16 of the Act provides that there is no copyright except as provided in the Copyright Act, 1957 or under any law for the time being in force, a single image or a single frame taken from a cinematographic film cannot constitute infringement of copyright as it is not photograph within the meaning of Section 2(s) and hence not a copy of the film within Section 14(d)(i).

For all the aforesaid reasons, it is clear that, insofar as contention is concerned, the plaintiffs have not been able to establish that the defendants have infringed their copyright by making a copy of their film or a substantial part of their film. That contention must, therefore, be rejected.

9. Next submission to be dealt with is the infringement of a copy and artistic work. At the outset it may be pointed out that the plaintiffs' claim copyright in an artistic work. This is based on the contract entered into with Balaji Films. Under Section 17 subject to the proviso, the Author of a work is the owner of the copyright therein. In the case of an artistic work made by an Author in the course of his employment subject to the agreement to the contrary, the person engaging is the first owner of the copyright. In the case of a photograph taken or a painting or portrait drawn or an engraving or a cinematographic film made for valuable consideration at the instance of any person, such person shall in the absence of any agreement to the contrary to the first owner of the copyright. There is nothing on record to show that the Author of the artistic work was employed by Balaji under contract of service to hold that Balaji were the owners of the copyright, who have transferred their rights in favour of the plaintiffs.

The contention of the plaintiffs is that the artistic work at Exhibit 'C' has been reproduced exactly by the defendants at Exhibit "E". Under Section 14(c) the plaintiffs as the copyright owners are entitled to reproduce the work in any material form including depiction in any cinematographic film. The plaintiffs have included the, artistic work in their film and as such are entitled to exclusive right in the said artistic work under Section 14(c). The defendants by including the work in the commercial have infringed the plaintiffs' copyright. It is contended that it is the plaintiffs who had expended time, energy and money in the original. Therefore, the contention of the defendants that the work is not original is misconceived. It is submitted that originality merely means effort expended or that it involves skill, labour and judgment in its creation. On the contrary no amount of skill, labour and energy expended in copying will give copyright.

As noted earlier there is no sufficient material which at this stage must result in the Court coming to or drawing a conclusion as to who is the first owner of the copy right. At any rate neither Balaji nor the person who has created the work in favour of Balaji have sued the plaintiffs for violating the copyright in their work. Considering the number of episodes already broadcast, it will, therefore, not be possible to accept this contention on behalf of the defendants that considering Section 55 of the Act the plaintiffs not being the owners of the copyright are not entitled to sue and seek reliefs. The plaintiffs have sought to on the Agreement dated 9th April, 2000 under which the plaintiffs are claiming right. By virtue of Article 6(a) and Article 8 all rights of Balaji have been given/assigned in

favour of the plaintiffs. I, therefore, do not accept the contention of the defendants that at this prima facie stage the plaintiffs have been unable to show their copyright in the artistic work.

Is the logo lettering as an original artistic work Section 13(1)(a) of the Act provides that copyright can subsist only in an original artistic work. The contention of the defendant is that the logo consisting of the two hands is a symbol in common use and in the public domain and open to anyone to use. Reliance is placed on the affidavit of Shefali Chaddha dated 14th June, 2002 and the wedding invitation card annexed thereto. The holding hands it is contended are a hackneyed and well known form of representing the handing over of something from one to another and are a commonly used symbol. Prima facie the question will be whether Author has spent any skill labour, wisdom of his own in devising the logo, merely taken something available and known to the public. The defendants have placed some material on record to show that said work is in the public domain. At any rate at this stage it is not possible to hold that the artistic work even if original as required under Section 13(1)(a) has been copied, though there are similarities.

Insofar as artistic work claimed in the style of lettering in the title of the plaintiffs' film it is contended that as it is in common use and in the public domain and open to anyone to use, the Author has not created the artistic work by his own skill, labour, wisdom but has merely taken the lettering style from a pool or source commonly available to all. There is no originality, hence no copyright. Reliance is placed again on the further affidavit of Shefali Chaddha dated 14th June, 2002 and the annexures showing the different types of lettering available to the public from the microsoft programme.

Considering the material on record and the contentions, it is not possible for this Court at this prima facie stage to come or arrive at a conclusion considering the contention of the defendants that the logo is a symbol in public use and domain and similarly so the lettering, and considering the material produced to consider granting relief as prayed for. The defendants have been using the artistic work and the logo as their own creation and, therefore, at the highest and considering the earlier part of the discussion, damages on this count in the present case would be an adequate answer if the plaintiffs ultimately, succeed.

The defendants have also submitted that even otherwise there could be no copyright in the artistic work and style of lettering since they form a part of the plaintiffs' cinematographic film! As the defendants' work is original work, there can be no infringement. At any rate, for reasons earlier stated, at the highest, the defendants, if they ultimately establish and for reasons earlier stated can be compensated by way of damages.

10. That brings us to the last issue of passing off. On behalf of the plaintiffs it is contended that passing off is a single common cause of action which can apply, to an extremely wide range of factual situations. Being a cause of action available in common law, the Court will guide itself on basis of strong common sense approach to the facts of each case. It is contended that the Courts must adopt the tort of passing off to fit changing situations. In the instant case it is contended by the plaintiffs' that the motive for the defendants misappropriation of the plaintiffs' goodwill is obvious. The defendants have attempted to encash the goodwill generated by the plaintiffs serial to boost the

sale of the defendants' product. This is actionable per se. If such conduct is not enjoined, it would amount to a licence to every defendant in the case like the present to appropriate the benefit of goodwill assiduously built up by another. The law of passing off, it is contended, is meant to counter precisely such conduct.

The classic submission of passing off, it is contended requires (a) existence of goodwill or reputation attached to the plaintiffs' serial and characters in the serial in the minds of the public viewers; (b) misrepresentation by the defendants to the public such as is likely to lead the public to believe that either there is a business transaction/association between the serial's character or the commercial or that the serial and the characters in the serial endorse and/or approve the defendants product Tide detergent, and (c) that the plaintiffs have suffered or are likely to suffer loss or damage by reason of the defendants appropriation of the plaintiffs' goodwill or reputation.

Dealing with the requirement of goodwill or reputation, it is contended that is evidenced by the tremendous popularity of the plaintiffs' serial as is evidenced its continuance on television since July, 2000 till date both in the serial and in the characters. In the minds of the television viewing public the serial and the characters enjoy tremendous goodwill and reputation. This is established by the fact that the film has achieved highest TRP compared to any other television serial. The plaintiffs are the owner of the goodwill and reputation generated by the said serial and the characters therein. The goodwill and reputation is a merchandising commodity and can be exploited by the plaintiffs alone. The fact that the defendants 'Chose to copy the plaintiffs' film is best evidence of goodwill of the plaintiffs' and its serial characters. On the issue of misrepresentation by the defendants, it is pointed out that the defendants by using the characters from the plaintiffs' serial viz., Tulsi, Savita, J.D. Uncle in the defendants advertisement, the defendants have misrepresented to the public that the original J.D., Savita and Tulsi are appearing in the defendants programme. By doing this, the defendants are implying a connection between the plaintiffs' characters and the defendants' commercial. It is contended that these characters have acquired an everyday bearing and reputation which now casts beyond the serial is established, by the long run of the serial and the defendants' action in misappropriating these characters. The only reason for doing this is to attract the patronage of those who would confuse them in some way with that of Tulsi, Savita and J.D. and the plaintiffs' serial. The defendants are, therefore, misrepresenting to the public by adopting a fraudulent device of encashing the goodwill, painstakingly built up by the plaintiffs. Considering the enormous goodwill and publicity enjoyed by the plaintiffs' serial, the confusion in the minds of the public is inevitable.

It is theft submitted that the appropriation by the defendants of the plaintiffs' characters and representing a connection between their commercial and the characters therein, is bound to cause loss and of damage to the plaintiffs directly by way of loss in merchandising inasmuch as the, owner of such characters and the, serial would have been able to merchandise characters. The defendants by making use of the characters for use of a commercial and unauthorizedly are utilizing the goodwill of the plaintiffs' characters without paying in licence fees to the plaintiffs and without the plaintiffs' permission. The defendants therefore have deprived the plaintiffs of such licence fees and merchandising profits. Further, as the plaintiffs have no control of the quality over the defendants product any inadequacy or shortfall in the same would rub off directly on the plaintiffs. The defects

in the defendant's commercial could in the long run adversely affect the plaintiffs and the plaintiffs' serial. As the Court in the passing off action is concerned with 'likelihood damages', it is submitted that there is sufficient cause for loss and damage made out by the plaintiffs. Reliance in support thereof has been placed in the case of Shaw Brothers (Hong Kong) Ltd. v. Golden Harvest (Hong Kong) Ltd., 1972 RPC 559; Hexagon Pty. Ltd. v. Australian Broadcasting Commission, 1976 RPC 628 and Mirage Studios and Ors. v. Counter-Feat Clothing Company, 1991 FSR 145.

It is then submitted that the tort of passing off is wide enough to take within its fold the deceitful and dishonest action of stealing the goodwill of another for commercial gain so as to mislead the public. The tort of passing off is not static but is developing tort and it is incumbent upon the Court to mould the relief in a given case to accord with the changing times. Placing reliance on Shaw Brothers (Hong Kong) Ltd., (supra) it is contended that the Hong Kong Full Court rightly relied upon the decisions of the U.S. Circuit Court of Appeals in the Lone Ranger inc. cases wherein it was observed as follows:

"In all, the effect of the advertisement is to create the impression that the original 'Lone Ranger', made famous by radio programmes is appearing with the circus....."

It was a U.S. Circuit Court of Appeals which pointed out that :

".....any advertisement that he is the 'Lone Ranger' must be avoided, as must any other language tending to imply connection with the 'Lone Ranger' of plaintiffs' radio programme of any form of advertising which would lead the public to believe that there is such connection."

These observations of the U.S. Circuit Court of Appeals, it is contended, stand good for the present case also. Reference in the same judgment is also made to the following observations:

"The principle is applicable that not only must one tell the truth but he must tell it in a truthful way, that is, so as not to deceive the public."

"We entertain no doubt as to the power and duty of a Court of equity to afford relief under such circumstances.....that a Court of equity should enjoin any form of 'passing off which involves fraudulent appropriation, through devices calculated to deceive or mislead the public, of the business or goodwill which another has built up."

It is also contended that the defendants conduct is fraudulent in the extreme. The defendants have not only and deliberately appropriated to itself what is essentially the characters and symbols of the plaintiffs' serial so as to attract the public, but are doing so for commercial gain. The defendants wish to boost the sale of their products by encashing the goodwill of the plaintiffs. A more fraudulent case than the present case would be difficult to find given the fact that the defendants are a large multinational Company and are well advised. It is all the more obvious that there is no innocence in the action of the defendants. Reliance is placed on the observations by Judge Murphy in the second

Lone Ranger case, which are as under :

"Where a defendant expressly and deliberately commits a fraud by representing that his goods or services are those of the plaintiff, or that plaintiff is in some way connected with or interested in his business, equity will grant relief. Even in the absence of express and deliberate fraud equitable relief will be granted where there is shown bad faith on the defendant's part, i.e., an intention of the defendant to gain advantage from the reputation and goodwill of the plaintiffs trade-mark or trade-name.....":

Coming to the test of common field of activity, it is contended, that there is no necessity for both the parties to be in the same field of activity. Reliance is placed on Kirloskar Diesel Recon. (P.) Ltd. and Ors. v. Kirloskar Proprietary Ltd. and Ors., 1997 (17) PTC 469, to contend that this Court has rejected the requirement that there should be common field of activity in determining whether there was any passing off. Reliance is placed on the following observation:

"With the passage of time, law on requirement of common field of activity in a passing off action has radically changed. There is no requirement for a common field of activity to found a claim in passing off."

It is pointed out that in Kirloskar's case this Court approved the decision in Mirage Studios and Others (supra) where Browne-Wilkinson, V.C. observed as under:

"The so-called requirement of law that there should be a common field of activity is now discredited. The real question in each case is whether there is a result of misrepresentation a real likelihood of confusion by deception of the public and consequent damage to the plaintiff. The focus shifted from the external objective test of making comparison of activities of parties to the state of mind of public in deciding whether it will be confused."

If this test of 'state of mind of public' is applied, it will be clear that the public associates the characters Tulsi, Savita and J.D. with the plaintiffs' serial alone. The presence of these characters acted by the same actors in the defendants' commercial will lead to an inference that there is a connection between the plaintiffs serial and the defendants commercial and in any event, will mislead the public in believing such a connection. This is actionable per se.

It is then contended that the plaintiffs' case of passing off is also based on debasement and erosion of its goodwill. It is pointed out relying on the judgment of the Delhi High Court in Daimler Benz Aktiengesellschaft v. Hybo Hindustan, , and approved by this Court in Kirloskar's case (supra), trademark law is not intended to protect a person who deliberately sets out to take advantage of somebody's reputation. It is the submission of the plaintiff that in the instant case the defendants have calculatedly taken the risk of utilizing the goodwill of the plaintiffs' serial in the hope that no action will be taken by the plaintiffs. Referring to the pleadings it is pointed out that plaintiffs have

mentioned about Star Plus Channel alongwith themselves and the said serial, the paragraph itself would clarify that the owners of the goodwill in the serial and the fictional characters in it are the plaintiffs. The submission that Star Plus is the owner of the goodwill and not the plaintiffs is misconceived. It is well known that in a given case, the plaintiff himself may be unknown to customers, it is necessary to show to the customer who knew whatsoever about the plaintiff. It is sufficient to prove that the purchaser of his goods recognised, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods. See paragraph 16.32 of Kerry's Law of Trade Marks and Trade Names-12th Edition.

It is, therefore, submitted that the plaintiffs have established that fictional characters can enjoy goodwill and the goodwill in such fictional characters belong to the owner of the serial. Adverting to the defendants' submission that no passing off action will lie until the plaintiffs involve themselves in any character merchandising and merchandising the characters it is contended is misconceived. The judgments relied upon by the defendants, it is contended, are based on the hard line of approach to goodwill. English Courts in approach to goodwill as the basis of passing off have consistently taken a hard line view to the effect that unless the plaintiffs themselves carry on the very business of which act complaint is made in a suit, there is no risk of confusion and hence no passing off. This line of cases it is contended has been disapproved and not following in India. A Division Bench of the Madras High Court in *Haw Par Bros. v. Tiger Balm Co.*, 1996 PTC 311, in spite of the Judgment in *The Athletes Foot Marketing Associates Inc.* being cited, granted the injunction. Similarly a Division Bench of the Delhi High Court in *Rob Mathys India Pvt. Ltd. v. Synthes Ag. Chur*, 1997 PTC 699, has expressly observed that Courts in India have not adopted this line of reasoning. It is then contended that the decision of *Oliver J., in Lingstad and Ors. v. Anabas Products Ltd.*, 1997 FSR 62, is peculiar to the facts of that case and would not be good law in India. This decision follows *Watson J's.*, earlier decision in *Tavener Rutledge Ltd.*

11. On the other hand, on behalf of the defendants, it is contended that in order to succeed in a case of passing off, the plaintiffs must establish the test as laid down by Lord Diplock in *Advocaat's* case. The three classic tests, required and which can give rise to a cause of action are absent. The plaintiffs' own case is as pleaded in paragraph 19 of the plaint wherein it is set out that the public associated the plaintiffs, the plaintiffs' serial their characters and Star Plus with each other. The plaintiffs' serial is shown on Star Plus Channel which is not owned by the plaintiffs. Goodwill does not accrue to the plaintiffs. The plaintiffs have no goodwill or reputation. It is the case of the plaintiffs that their serial/film is associated exclusively with the Star Plus Channel by the public. It means that the public is aware that the plaintiffs' cinematographic film/serial is available and can be seen only on the Star Plus Channel and nowhere else and the Star Plus Channel alone is associated with and broadcasts the plaintiffs' serial. The defendants Tide T.V. commercial, to it contended, is not aired or broadcasted on the Star Plus Channel at all. Therefore, when the public sees the defendants Tide commercial on any other channel, the question of the public associating the defendants' commercial with the plaintiffs film/serial cannot and does not arise, on the plaintiffs own case and averments in paragraph 19 of the plaint. This rules out any possibility or likelihood of the one being taken by the other or of the public being misled of one with the other or the public having association with the other. The plaintiffs, therefore, fail in the alleged claim of passing off on

their own case and averments in the plaint.

12. It will, therefore, be essential to examine whether the plaintiff has established the basic ingredients giving rise to a cause of action in a case of breach of the tort of passing off. The three predicates to be established may be reiterated as under:

(1) The plaintiffs goodwill and reputation, in the mark amongst the public (2) The defendants misrepresentation that the article is that of the plaintiffs; and (3) Actual, damages or real likelihood of damage to the plaintiffs by the defendants' act.

The two items being considered are prima facie different-one a serial of several episodes to the knowledge of the public and the other a fleeting commercial of totally 30 seconds, of which the breach complained of is only of 10 seconds. In the commercial, the Tide detergent is prominently featured. A member of the public mistaking the film/serial for the T.V. commercial or the T.V. commercial of 30 seconds for the film/serial or believing some association amongst the two or its characters is too fanciful, farfetched at least at this stage there is no material. The plaintiffs' work consists of a film which is a long soap opera and on the plaintiffs own averment is so popular that the public knows what the serial is about. The defendants' T.V. commercial, on the other hand, is of 30 seconds duration of which 20 seconds promote the 'defendants' product Tide detergent. The defendants' commercial is for promotion their own product 'Tide' under these circumstances prima facie it cannot be mistaken for the film/serial of the plaintiffs. The defendants have not presented their commercial as a film/serial. In these circumstances it is debatable whether any member of the public is likely to believe it to be so. The test always obviously is of a 'prudent person'. [See R.G. Anand (supra)] for a thing to be passed off. If this test is applied of a normal, prudent person, would such prudent person be confused and will take one for the other. See *Francis Day and Hunter Ltd. v. Twentieth Century Fox Corporation Ltd. and Ors.*, 1940 A.C. 112 (P.C.); *R.G. Anand (supra)*, *Green v. Broadcasting Corporation of New Zealand* 1989 RPC 469, *Miss World (Jersey) Limited and Anr. v. James Street Productions Limited and Ors.*, 1981 FSR 309 and *Dicks and Yates*, (1881) 18 Ch. D. 76.

Considering these decision, what the Court must apply and consider are not merely hypothetical or fanciful possibilities but to consider the real probabilities and the practicalities of the situation. Thus compared the work of the plaintiffs which altogether will be about 87 hours duration or a single episode of 30 minutes shown on the Star Plus Channel and the other a T.V. commercial of 30 seconds never shown on Star Plus Channel with Tide detergent being the focus and dominant part thereof, the question of being passed off for the other or of one being associated with the other or the public being misled or confused in any manner to believe one to be the other or even associating the defendants' commercial with the plaintiffs or their serial or the characters therein is very much doubtful. It is, therefore, clear considering the material on record and the test of a prudent person, it is not possible that a reasonable person or the public would be misled or confused in any manner to believe and/or associate the defendants' commercial with the plaintiffs' cinematographic film and or the characters therein.

The second predicate which is to be considered is whether the defendants are guilty of misrepresentation and thereby occasioned damage to the plaintiffs or possibility of damage. The plaintiffs' serial is a film which has its viewers and which is not telecast on the same Channel as that of the defendants' commercial. It is only in the event those watching the plaintiffs' film happen also to come across the defendants' commercial, an occasion would arise of misrepresentation. The defendants' commercial cannot in anyway affect the viewership of the plaintiffs' film or the potential TRPs or sponsorship value/possibilities thereof. Therefore, the possibility of any damage caused not any likelihood of damage, much less of real damage being caused, or too remote. The field which the plaintiffs' serial occupies as a film/soap opera is different from the field of defendants' commercial that of an advertisement of detergent Tide. While the field of activity being common is not an essential element of passing off, the field, of activity whether it is the same or different, is always a relevant consideration to determine the question. See Kerry's Thirteenth Edition, paragraph 14.75 to 14.77. A Division Bench of this Court in *Aktiebolaget Volvo of Sweden v. Volvo Sheets Limited of Gujarat (India)*, 1998 IPLR 63, has observed that the absence of common field of activity therefore is not fatal but it is not relevant either in deciding whether there is a likelihood of confusion. It is an important and highly relevant consideration. This Court further observed that the crux of passing off action lies in a possible deception. The existence of common field of activity is always a relevant consideration. If there is a common field of activity, possibility of deception is very high and if there is no common field, of activity, possibility is less but it cannot be laid down as a rule of law that there can be no possibility at all. Considering this aspect, there is no material on record, at least at this stage, to arrive at a conclusion that the plaintiffs have satisfied the essential pre-requisite of damage. If that be the case and as no passing off arises and as such no injunction can be granted. See *Merchandising Corporation of America Inc. and Ors. v. Harpbond Limited and Ors.*, 1983 FSR 32.

I then come to the third ingredient required, namely, reputation. The plaintiffs' claim to reputation is a reputation in the film/serial as a film/serial. It is no doubt true that, according to the plaintiffs' own averment, it is linked to the Star Plus Channel. Assuming it not to be so, the burden lies on the plaintiffs that they have a reputation which exists. The plaintiffs' claim to reputation is based on the film and characters. The reputation does not extend to or separately exist in any particular person or dialogue in or part of a serial so that any member of the public would associate any particular incident or script or word or sentence or scene in the film with the plaintiffs alone. There is no such material on record. It is not the plaintiffs' case that a member of the public on seeing elsewhere a scene or incident similar to one in the plaintiffs film will think that what he has seen elsewhere is the plaintiffs' film is necessarily associated with the plaintiffs' serial or is put out by the plaintiffs. The plaintiffs have no monopoly over such incidents/scenes and at least no evidence has been produced to establish this, which is purely a question of fact. The entire case of the plaintiffs is based on an incident in one of the episodes of the film. The incident is an ordinary serial one in a family. It is not exclusive or particular to the plaintiffs' film. Probably the public view the scene without any regard to its source and solely, as a part of the defendants work promoting the product 'Tide'. At any rate, there is no material, at this stage, to hold that the public associates the defendants' commercial Tide detergent as coming from or of the plaintiffs. The case of the plaintiffs is, as of today, that they have not endorsed any products based on the serial or its characters. The necessary element of citation required has, therefore, not been established as such, the plaintiffs would not entitled to reliefs as prayed.

Let me now independently deal with the claim of passing off on the basis of character merchandising. Are there sufficient pleadings in the plaint to base a claim of character merchandising. The case of passing off has to be established on facts and essential basis must be the pleadings in the plaint. However, there are some averments which possibly can enable the plaintiffs to argue the tort of merchandising. In fact it has been argued at the bar and parties have been heard. In this context I propose to deal with the issue based on the material and arguments advanced. The serial has been running for over two years. It is not the case of the plaintiffs that till date they have done any character merchandising in relation to the film or serial or that they have entered into any agreement for that purpose. The entire claim is based on potential for character merchandising. The case of the plaintiffs as pleaded in paragraph 10 of the plaint is that they are considering using the serial and the characters therein for the purpose of endorsing products and service for a fee. Reliance is placed in the judgment of *The Athletes Foods Marketing Associates Inc. v. Cobra Sports Limited and Anr.*, 1980 RPC 343. In that case the plaintiffs carried on business in the U.S.A. and elsewhere in which they granted franchises to independent stores to carry on business in the supply of footwear to athletes under the name 'The Athlete's Foot'. The first defendants carried on business as retailers of shoes in the name of 'Athlete's Foot Bargain Basement'. A prospective franchisee in U.K. had even gone so far as to order goods and stationery with a view to establishing a chain of stores under the name 'The Athlete's Foot' in the U.K. In this case really what was in issue was an action in passing off and not really character merchandising. We may then consider the case in *Tavener Rutledge Limited v. Trexapalm Limited*, 1975 FSR 479. The plaintiff Company in that case was using the word "Kojakpops" as a brand name for its lollipops. Other manufacturers had adopted similar names but had ceased to do so shortly before the defendant Company came on to the market. "Kojak" was the name of a television series, the leading (fictitious) character being a detective who had the habit of sucking lollipops. The plaintiff Company did not have a licence to use the name from the proprietors of the television series. The defendant Company, which claimed that it did have such a licence, began to sell the lollipops under the brand name "Kojak Lollies". The plaintiff commenced an action. The question posed was, do those two fields of activity interest in any such way as would enable the Universal City Studios to claim that, by putting out their lollipops as "Kojakpops", the plaintiffs were infringing any right of Universal City Studios? The Court observed in its judgment, the answer to that is in the negative, because there is no relevant field of activity either actual or existing in the mind of the public which is common to both of them. The Court observed further that the business of what is called character merchandising, has become very well known in our present times and everyone who has a character, whether real or fictional, to exploit, does so by the grant of licences to people who wish to use the name of the real or fictional character, but when one has a fictional character such as Kojak, obviously Kojak in that sense does not exist and no one would imagine that the lollipops put out by the plaintiff Company have been actually endorsed by Kojak, still less by the actor who plays the fictional character. The Court observed that what has to be established is that he had become well known that people in the situation of licensors of these names exercised quality control over any product bearing their name, so that as soon as anyone in the street came to the conclusion that a product was licensed by the owners of some series, such as the Kojak series, he would say to himself not only. "This must have been licensed by them", but also; "and that is a guarantee of its quality".

In *BBC Worldwide Ltd. and Anr. v. Patty Screen Printing Ltd. and Ors.*, 1998 FSR 665, the action for passing off was of the product Teletubbies, on the grounds that the plaintiffs had built up a reputation in relation to the merchandising of the Teletubby characters and that the goods of the defendants would lead to deception of the public or, alternatively, it would amount to putting instruments of deception into the hands of the other defendants which would in turn lead to the deception of the public into believing that the products of which complaint has been made in the action are products of, or associated with, or put out with the authority of the plaintiffs. The question the Court answered was as under:

"It seems to me the it inevitably must be a question of fact whether or not members of the public seeing the T-shirts in issue will be deceived. To succeed on this part of the case the plaintiffs will need to show that they have built up the necessary reputation so that members of the public would look at this type of artwork and consider it to represent the plaintiffs or products made with the plaintiffs' approval.....".

Children's Television Workshop Inc. v. Woolworths (N.S.W.) Limited, 1981 RPC 187, is a judgment of the Supreme Court of New South Wales-Equity Division. It was about a character "Muppet". The issue before the Court was that there were numerous Muppet products on the market in Australia all of which had been made under licence from the first plaintiff. The third plaintiff was a potential licensee for Muppet characters in the form of plush toys. The defendants sold certain plush toys which had physical characteristics similar to those of the Muppet characters "Oscar the, Grouch". "Big Bird" and "The Cookie Monster", which had not been made under licence from the first plaintiff. On the grant of interim relief the Court held that the toys sold by the defendants would be taken by the public to be toy representations of the Muppet characters; that the first plaintiff had established a business reputation in Australia in relation to toys. The Muppet characters were only recognised because they were "out of the first plaintiffs' show and there was an association in the minds of the public between the first plaintiff and the representations of its characters in any form, and certainly in toys of the present sort, and that established the reputation of the first plaintiff in them; the third plaintiff has no such reputation; until it established itself as licensee and carried on business in this field it would not be proper to assume an association between it and the sale of the Muppet characters as would entitle it to claim that the defendants' toys were being passed off as products emanating from it or as products made under its licence; that the defendants and the plaintiffs were operating in a common field of business activity. The business of the plaintiffs, and that of the first plaintiff in particular, was to get its character reproductions on to the, market in various forms and sold to the public; this was done through licensing arrangements which generated revenue. The business of the defendants was to get goods on to the market. As far as passing off was concerned, it did not matter that in the former case the goods came on to the market via a licensing arrangement; and the activities of the defendants were likely to lead to confusion and deception. The deception was that the public would believe that the first plaintiffs as a licensor were associated with the defendants in putting the goods on to the market or in permitting the defendants to sell them.

Considering the test applied in the various judgments, there is no evidence whatsoever of any member of the public associating any particular character in the serial as being associated exclusively with the plaintiffs, when that character is being used otherwise than in the course of the

film as a character therein and in connection with any other business or product. There can be and is no evidence to this effect because, admittedly, the plaintiffs have not done any character merchandising. As there is no evidence which is a pre-requisite for passing off action, the plaintiffs action must fail on that count.

Character merchandising involves the exploitation of fictional characters or the fame of celebrities by licensing such famous fictional characters to others. The fictional characters are generally drawings in which copyright subsists, e.g., cartoon and celebrities are living beings who are otherwise very famous in any particular field, e.g.; film stars, sportsmen. It is necessary for character merchandising that the characters to be merchandised must have gained some public recognition, that is, achieved a form of independent life and public recognition for itself independently of the original product or independently of the milieu/area in which it appears. Only then can such character be moved into the area of character merchandising. This presumes that the character has independently acquired such reputation as to be a commodity in its own right independently of the goods or services to which it is attached or the field/area in which it originally appears. It is only when this is established on evidence as a fact, that the claimant may be able to claim a right to prevent any one else from using such a character for other purposes. In the instant case, the plaintiffs, admittedly, have not done any character merchandising at all so far as any character in their film/serial is concerned. There is no question, therefore, of any character in the serial having acquired any public recognition or reputation or an independent life of its own separately from its position as a character in the serial. There is no material on record to show that any character in the serial has become a commodity in its own right, independently of the film/serial. In these circumstances, the question cannot arise of the plaintiffs making any claim to exclusive right to a character or be entitled to any reliefs on the alleged basis that the public associates any character in the serial exclusively with the plaintiffs, in relation to the business of character merchandising. On the facts of this case, there is no fictional character involved like 'Superman', Teletubbies' or 'Lone Ranger'. In the serial there are ordinary people in common life who play the role of some character or the other. At least from the material on record there is nothing special in any, of the characters of which it can be said' that they have gained any public recognition for itself with an independent life outside the serial. This, the plaintiffs have failed to establish.

It is no doubt true that the plaintiffs have relied upon the judgment in Shaw Brothers (Hong Kong) Limited v. Golden Harvest (H.K.) Ltd., 1972 RPC 559. The character concerned was a fictional character 'the One Armed Swordsman'. It was a case of use of the very character in one film and in another film. In the instant case as already held the plaintiffs have not established any reputation in any particular character in the serial at all. It is also not a case of one film against another film and further the defendants are not merchandising any character from the serial by means of their T.V. commercial.

In Hexagon Pty. Limited v. Australian Broadcasting Commission, 1976 RPC 628, the case was of fictional character of fantasy called 'Alvin Purple'. On facts it was held that the plaintiffs had built up goodwill in the films entitled 'Alvin Purple', and the character in the rival film was the same character as 'Alvin Purple' In the plaintiffs' film. On facts it was held that this was a case of passing off.

In *Mirage Studios v. Counter-Feat Clothing Company Limited* (supra) the case was of a fictional cartoon character called 'Ninja Turtles'. The plaintiffs had done extensive character merchandising of those cartoon characters with over 150 licenses having been granted to use those characters in respect of a wide range of goods. On facts and evidence on record, the Court held that the plaintiffs' business was to license the reproduction of the said cartoon characters on goods sold by other, people, which licensing business they had extensively carried on. The public were aware that the characters were connected with the plaintiffs.

The case of *Fletcher Challenge Ltd. v. Fletcher Challenge Pty. Ltd. and Ors.*, 1982 FSR 1, would not apply as it is not based on character merchandising.

13. I will deal with the last of the submissions of future potential for character merchandising. It is the contention of the plaintiffs that future potential of character merchandising in relation to the characters in the serial is affected by the defendants actions of making the commercial. As laid down earlier, *prima facie*, authorities show that an action based on character merchandising there must be in fact, character merchandising and that mere potential for merchandising the character by itself is not sufficient. However, it is not possible to rule out the proposition that the mere potential for merchandising is not sufficient to maintain an action, A character may have grown out beyond the film when the people would identify and, therefore, there is a probability of it being potentially merchandised. On the facts of this case there is no such material, of any from character setting this roles None of the models or actors have acquired such fame or a character has become identifiable in the minds of the public, which can be said to be particularly merchandised. The plea of the plaintiff is that the public associate the characters. Tulsi, Savita and J.D. with the plaintiffs serial. There is nothing to show that the characters Tulsi, Savita or J.D. by themselves are capable of being marketable independently or jointly. They are merely the main characters in the serial as the material now stands.

In the instant case, the defendants are merely promoting their own product, that is, Tide detergent. Can it be said that the defendants' act of promoting their product Tide would in any manner affect the plaintiffs' future potential of merchandising the character in their serial. There is, no material of real likelihood of damage being caused to the plaintiffs' by the acts of the defendants. The mere act of T.V. advertisement by the defendants cannot prejudice the plaintiffs' chances of exploiting their merchandising rights if any in respect of the characters in the serial. The fields of activity of the plaintiffs and of the defendants are totally different. As noted this is a relevant consideration in passing off action. When the fields of activity are different, the stronger is the evidence necessary to establish misrepresentation and the real likelihood of damage. To succeed in a case of character merchandising the plaintiffs must establish as a fact, by material and evidence, that the public would look at the character and consider it to represent the plaintiffs or to consider the product in relation in which it is used as has been made with the plaintiffs' approval. On material on record the plaintiffs have failed to establish this. This plaintiffs cannot establish it as they have not even begun character merchandising in respect of the characters in the serial. On the contrary, members of the public viewing the T.V. commercial will in all probability associate with the product Tide of the defendants and not with the plaintiffs' serial or character therein. The defendants have pleaded, and in my opinion rightly, that they are a major consumer goods Company, well known in their own

right and their products including Tide have their own reputation amongst the public; Tide will be associated with the defendants and not with the plaintiffs. The issue of misrepresentation is a question of fact which in the instant case the plaintiffs have failed to discharge.

At any rate of plaintiffs ought to have established that the acts of the defendants have caused damage or that there is real likelihood of damage. See *Merchandising Corporation of America Inc. and Ors., v. Harpbond Limited and Ors.*, 1983 FSR 32; *Stringfellow and Anr. v. McCain Foods (G.B.) Limited*, 1984 RPC 501; *Lingstad and Ors. v. Anabas Products Limited*, 1977 FSR 62. The Court's bare observation that the need for a real possibility of confusion is the basis of the action. It is necessary to show that reasonable people might think that the plaintiffs activities were associated with the defendants' goods or business, and on evidence the Court must be satisfied that there is a real possibility of confusion *Miss World (Jersey) Limited & Anr.*, (supra) and *Kerly's Law of Trade Marks and Trade Names*, Thirteenth Edition, Paragraphs 14.75 to 14.77. Establishing passing off by goods in which the claimant does not trade, calls for special evidence to establish that the defendants' action would induce the belief, if any, that his goods are those of the claimant, at least that his business is an extension of or somehow connected with that of the claimant or that his goods have been some-how approved or authorized by the claimant. In relation to character merchandising, unless the public can be shown to be will aware of merchandising in the particular field, there will be, in general, no obvious link between the production of television programmes or films and the manufacturer of toys, clothes etc., with which character names may be profitably used. Once merchandising is well on the way, some one will have the goodwill.

14. From the above, that therefore is clear is that there do arise triable issues. The test is not, however, merely of triable issues. They must be strong triable issues as explained in *American Cyanamide v. Ethicon Ltd.*, 1975 (1) All E.R. 504, which principles have been reiterated by the Apex Court in *Colgate Palmolive (India) Ltd. v. Hindustan Lever Ltd.*, . Looking at the material on record, the plaintiffs have failed to establish a strong prima facie case. That by itself would disentitle the plaintiffs to the reliefs prayed for.

Even assuming otherwise, the material on record and the contentions advanced would only show that what the plaintiffs are pleading by way of passing off action/character merchandising as a future potential. Real likelihood of damage or probability of damage has not been established. The defendants commercial is meant to promote their product 'Tide'. In these circumstances, to my mind, it is clear that the plaintiffs have not been able to satisfy, at this stage, that the balance of convenience is in their favour and/or irreparable injury would be caused to them, if the defendants are allowed to air their T.V. commercial. At any rate, the plaintiffs can always be compensated by way of damages if they succeed as it the plaintiffs' case themselves, that the defendants are a financially sound Company.

15. Considering the above, to my mind, no case is made out for the grant of any relief and, consequently. Motion stands dismissed. In the circumstances of the case, each party to bear their own costs.