

The Chancellor Masters & Scholars Of The ... vs Narendera Publishing House And Ors. on 17 September, 2008

Author: S.Ravindra Bhat

Bench: S. Ravindra Bhat

* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ I.A. 9823/2005, 51/2006 & 647/2006 in CS(OS) 1656/2005

Reserved on: 10.07.2008

Pronounced on : 17.09.2008

THE CHANCELLOR MASTERS & SCHOLARS
OF THE UNIVERSITY OF OXFORD

..... Plaintiff

Through Mr. Rajiv Bansal, Advocate

Versus

NARENDERA PUBLISHING HOUSE AND ORS.

..... Defendant

Through Ms. Pratibha Singh, Mr. Sudeep Chatterjee,
Advocates

CORAM:

Mr. Justice S. Ravindra Bhat

1.

Whether reporters of local papers may be allowed to see the judgment? yes

2. To be referred to the Reporter or not? yes

3. Whether the judgment should be reported in the Digest? yes Mr. Justice S. Ravindra Bhat

1. This order will dispose of IA No. 9823/2005, IA No. 647/2006, IA No.51/2006 preferred under Order 39 Rule 1 & 2 and Order 39 Rule 4 of the Code of Civil Procedure, 1908, respectively. The plaintiff alleges violation of copyright in its literary work and seeks an order restraining the defendants from infringing its copyright.

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2. The plaintiff is a well-known publisher of academic books, and started publishing in India in 1912. It has established show rooms in different places of India. The plaintiff avers to publishing substantial number of school books for use from Kindergarten to the twelfth standard, with the help of a team of highly trained and committed editorial, research, production and marketing professionals. These books cover most disciplines including science, mathematics, languages, humanities and economics, for most Educational Boards including CBSE and ICSE.

3. The plaintiff has published, in two parts, a text book for the students of Class XI, following the course structure prescribed by the Jammu & Kashmir State Board of School Education, i.e. [Oxford Mathematics Part A and [Oxford Mathematics Part B (herein after referred to as [The textbooks'). The plaintiff published them in collaboration with the Jammu and Kashmir State Board of School Education (hereafter [The Board'). The plaintiff and the Board entered into an agreement on 26.08.03 for such purpose, and the copyright in the said textbooks vested with the former. The textbooks are specially adapted editions of books authored by one Dr. A.K. Roy of which the copyright vests in the plaintiff through an agreement. It is averred that the said Dr. Roy has employed great efforts and research in the books so that they are effective in the study and understanding of mathematics.

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4. It is further averred that the exercises, their scheme, the answers, placement of topics in the textbooks are unique to the plaintiff and are a result of years of research, hard work, practice and the standard followed by reputed institutions the world over. Every unit in a chapter is so arranged that it is integral and complimentary to others. The contents of the textbooks, it is averred, involve application of substantial skill, judgment, labour and investment of time and money. The units are streamlined for faster progress. The textbooks have maximum clarity with fresh modern designs. The key features of the textbooks are that they have been designed to enable the learner to develop a thorough understanding of basic mathematical principal and processes. Introductions to each chapter reviews the concepts learnt earlier. Graded solved examples develop problem- solving techniques. Short exercise drills are interspersed within a chapter after each major topic. Miscellaneous exercises have been provided at the end of each chapter. Even model test papers have been provided at the end of the book to provide the students a feel of the examination. All this, the plaintiffs claim, make each textbook an original literary work within the meaning of the Copyright Act, 1957 (hereafter [The Act'). It is also averred that the author by a memorandum of Agreement has assigned to the plaintiff the entire copyright in the subject work during the legal term of copyright and the renewals thereof. All rights in the subject work are reserved in favour of the plaintiff. Further, it is claimed that no part of the textbooks can stored CS (OS) 1656/2005 Page 3 in a retrieval system or transmitted in any form or by any means without the prior permission in writing given by the plaintiff, or as expressly permitted by law.

5. The plaintiffs allege that in 2005 they came to know about the existence of guide books entitled [Teach yourself mathematics (Fully Solved) Part A and [Teach yourself mathematics (Fully Solved) Part B published by the defendants (hereafter [The guides'), in which the latter have, brazenly violated plaintiff's copyright, and reproduced contents of the plaintiff's books. The

infringing books, it is stated, has been published, to help those students who prefer to mug up the solutions/answers rather than seriously taking the course through text books . It is further claimed that the defendants books have immensely hampered not only the sale of the plaintiff's subject work but has also gravely prejudiced the interest of the students at large . The Plaintiffs aver that the defendants have slavishly reproduced the exercises and their solutions/answers from the subject work and thus made their infringing publication a poor and degrading substitute to the plaintiff's subject work. It is also alleged that such reproduction by the defendants shows a deliberate and malicious intent and design on their part to misappropriate, trade upon and derive benefit from its reputation and goodwill and the copyright in the subject work, enjoyed exclusively by them, worldwide The plaintiffs, therefore, seek an order of interim injunction restraining the defendants from infringing the copyright of the plaintiffs in CS (OS) 1656/2005 Page 4 relation to the textbooks. This Court had, granted an ex-parte injunction; the defendants move for its vacation.

6. Mr. Rajiv Bansal, learned counsel appearing on behalf of the plaintiff, contends that the defendants have indulged in a brazen word-to-word copying of the questions, in the textbooks. The plaintiff, it was urged, had given answers to the questions in the exercises, but did not provide the detailed step-by-step process to arrive such answers. The questions, their arrangement and the sequencing, in the defendants' guides are identical to the plaintiff's textbooks. He argued that the questions form a valuable and central part of the work, and their substantial copying by the defendants amounts to violation of the plaintiff's copyright. He submitted that authors of the guides have saved time and money by relying on the plaintiff's work and their use of the 'original' questions is not incidental. He further argued that guides compete with the original textbooks for market share, and are prepared and sold for commercial purposes. Therefore, he contended that in the absence of a restraint order, the guides would gravely injure the plaintiff's commercial interest.

7. Learned counsel next contended that questions, their arrangement and their selection should be considered original literary works under the Act, and therefore, are entitled to copyright protection. He placed reliance on the oft quoted *University London Press v. University Tutorial Press* [1916] 2 Ch. 601, to assert that question papers are literary works and that copyright CS (OS) 1656/2005 Page 5 could vest in questions. He argued that though there can be a pool of common knowledge and questions from which the questions are drawn, the fact that the questions were not copied and emanated from the author is sufficient enough for the grant of copyright protection. He placed reliance on the judgment reported as *Syndicate Press of the University of Cambridge v. BD Bhandari*, 2005 (31) PTC 58 (Del), to assert that the defense of fair use under section 52 cannot be extended to cases where there is verbatim copy of the questions and the answer key. Further, it was held that guide books like the ones in that case, could not be categorized as reviews and criticism of the original work. Also, the exception under Section 52 (1)(h) applied only if the reproduction is made as a part of the questions and answers in an examination. Reliance was placed on *Mishra Bandhu Karyalaya v. S Koshal*, AIR 1970 MP 261; *Agarwala Publishing House v. Board of High School and Intermediate Education*, AIR 1967 All 91 and *Jadish Prasad v. Parmeshwar Prasad*, AIR 1966 Pat 33 to contend that questions are original literary works and copyright can subsist even if such questions are part of a prescribed syllabus, so long the author employed labour and skill in their publication. Lastly, reliance was also placed on *Blackwood & Sons v. Parasuraman*, AIR 1959 Mad 410, to contend that the plaintiff need not prove any oblique motive or intention to copy on the

part of the defendants, so long the copying involved substantial and vital portions, that is the copying was both quantitative and qualitative.

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8. The defendants contend that the present case is a one of fair use. It is averred that preparation of a guide book, which independently contains the working of every mathematical problem and steps for solving them, cannot be termed an infringement of the textbook. The plaintiff's books do not have any step-by-step working for the various sums at the end of each chapter. It is also averred that the defendants have not copied the contents of each lesson or chapter. Further, it is averred that all students are well aware that the defendant's publications are guide books whereas the plaintiff's publications are textbooks.

9. It is averred that the defendants' books are an independent creation by Prof. Harish Sharma who is a known Mathematics teacher. He has solved the sums that are contained at the end of each lessons of the plaintiff's prescribed textbook. The guide does not infringe the copyright of the plaintiff in any manner whatsoever. The defendants' books are not a substantial reproduction of the plaintiff's textbooks. A mere comparison of the two in terms of appearance, contents etc., clearly establishes this. The defendant, relying on section 52 of the Act, aver that since their books are in the form of answers to questions contained in the plaintiff's prescribed text book for the purposes of education, no copyright can be claimed nor infringed. They aver that various State Boards prescribe textbooks of publishers for students and there is possibility of existence of several Guide Books for the same textbook. They only facilitate students' preparation for examinations. If such CS (OS) 1656/2005 Page 7 guide books are not permitted to be published the result would be contrary to public interest and interest of the student community.

10. Ms. Pratibha Singh learned counsel appearing for the defendants, argued that at least 101 questions appearing in the plaintiff's books are copied or reproduced from the work another well-known author-Mr. RD Sharma. She drew the attention of this Court in this regard to the amended written statement and a comparative table of questions common to the plaintiffs books and the book authored by the said Mr. RD Sharma. She contended that the questions appearing in the plaintiff books from part of the common pool of questions used by authors, schools, guides and students in India, and contended that the nature of the subject is such that it would be impossible for one author to claim copyright over a set of questions. She categorized the questions in the plaintiff's books, their selection and the manner of arrangement as derivative works, for which a higher standard of creativity must be proved in order for them to copyrightable. In this regard she relied on *Eastern Book Company v. Modak*, (2008) 1 SCC 1. It was argued that since the plaintiff's work cannot demand any copyright protection, no question of infringement arises.

11. It was contended that the plaintiff's books have not been pirated or reproduced verbatim/completely, and therefore, the defendants' actions do not amount infringement within Section 14 (a) (i)-(v) and (vii). The defendants' contend that their books would not constitute adaptation under CS (OS) 1656/2005 Page 8 section 2 (a), and therefore, cannot be violative of section 14 (a) (vi).

12. Ms. Pratibha Singh next argued that the such use by the defendants of the Plaintiff's questions of the plaintiff amounts to fair use under section 52(1) (a) and 52(1)(h) of the Act, assuming, arguendo, that there is copyright infringement. She contended that in relation mathematical works, publication of a guide to solve questions in the plaintiff's work amount to "review", of the plaintiff's literary work and therefore covered by section 52(1)(a). Furthermore, the present case also falls under Section 52(1)(h) as the reproduction of the literary work was as a part of answers to those questions. She argued that while deciding whether the defendants' books amounted fair use, one cannot lose sight of the fact that the books are based on the Board's Syllabi which prescribed the plaintiff's books as exclusive textbooks. She argued that once the book is declared a part of a syllabus, then, students are free to use the questions in it any manner and therefore, guide books that help students solve these questions will also be covered under the fair use exception to copyright.

13. Counsel argued, placing reliance on *RG Anand v. M/s Delux Films*, (1978) 4 SCC 118 that there can be no copyright in ideas and therefore, the questions per se are not subject matter of copyright. She contended that if the same ideas were being presented in different manner, even though both the works are based on the same source, then too it would not amount to infringement. She submitted that the surest way to find out infringement is CS (OS) 1656/2005 Page 9 to see if the reader having read both the works is clearly of the opinion that the subsequent work appears to be a copy of the original.

14. Learned counsel placed reliance on the various judgments to assert that the publication of guide books to help students study and answer questions amounts to fair use under the Act; (Ref. *V Ramaiah v. K Lakshmaiah* (1989) PTC 137; *EM Forster v. AN Parasuraman* AIR 1964 Mad 331; *Kartar Singh Giani v. Ladha Singh*, AIR 1934 Lah 777 and *Romesh Chowdhry v. Ali Mohamad Nowsheri*, AIR 1965 J&K 101). Therefore, she argued that such use by the defendants of the questions that appear in the plaintiffs books, constitute fair dealing under section 52 and the injunction must be vacated.

15. Two primary issues need to be gone into at this stage. First is whether that part of the work of the plaintiff, which the defendants have reproduced, prima facie merits copyright protection. Secondly, if it does, have the defendants sufficiently made out a "fair dealing" or a "fair use" defence at this stage.

I. The Idea-Expression Dichotomy and the Doctrine of „Merger

16. A foundational element of copyright law is that it does not grant the author of a literary work protection on ideas and facts. (*Baker v. Seldon*, 101 US 99 [1879], *Nichols v. Universal Pictures Corp.*, 45 F.2d (2d Cir. 1930), *RG Anand v. M/s Delux Films*, (1978) 4 SCC 118) It is only the creative CS (OS) 1656/2005 Page 10 expression of such ideas and facts that is rewarded by law, by conferring a privilege to exclusively exploit such expression for a limited time. Law does not protect every such expression. The law affords protection to expressions that are fixed in a medium and are "original". In India Section 13 of the Copyright Act states that only "original" literary, artistic, dramatic and musical works are subject matter of copyright. A literary work, in order to qualify as work in which

copyright can subsist, must therefore be original.

17. The content of what is meant by 'originality' has undergone a paradigm shift from the days of 'sweat of the brow' doctrine enunciated in *University of London Press (supra)* to the 'modicum of creativity' standard put forth in *Fiest Publication Inc. Vs. Rural Telephone Service*, 199 US 340 (1991). The Supreme Court too recognized this shift and in *Eastern Book Company v. DB Modak (supra)*, following the approach laid down by the Canadian Supreme Court in *CCH Canadian Ltd., Vs. Law Society of Upper Canada* (2004) SCC 13, rejected the sweat of the brow doctrine, (which conferred copyright on works merely because time, energy, skill and labour was expended, that is, originality of skill and labour), and held that the work must be original "in the sense that by virtue of selection, co-ordination or arrangement of pre-existing data contained in the work, a work somewhat different in character is produced by the author". It is noteworthy that our Supreme Court noticed that the two positions i.e. the sweat of the brow on the one hand, and 'modicum of creativity' were extreme positions; it CS (OS) 1656/2005 Page 11 preferred a higher threshold than the doctrine of 'sweat of the brow' but not as high as 'modicum of creativity'. Thus, our law too has recognized the shift, and mandates that not every effort or industry, or expending of skill, results in copyrightable work, but only those which create works that are somewhat different in character, involve some intellectual effort, and involve a certain degree of creativity. It is in the light of this standard of originality, that the plaintiffs claim to copyright in the questions as well the copyright in the arrangement of the exercises in each chapter and the internal arrangement of questions therein, needs closer scrutiny.

18. An aspect peculiar to copyright law, is the 'doctrine of merger,' is involved in this case. This doctrine posits that where the idea and expression are intrinsically connected, and that the expression is indistinguishable from the idea, copyright protection cannot be granted. Applying this doctrine courts have refused to protect the expression of an idea that can be expressed only one manner, or in a very restricted manner, because doing so would confer monopoly on the idea itself. The decision in *Herbert Rosenthal Jewelry Corporation v. Kalpakian*, 446 F.2d 738(1971) is illustrative in this regard. In that case the plaintiffs sued the defendants asking them to refrain from manufacturing bee shaped jewel pins. The Court held that the jewel shaped bee pin was an idea that anyone was free to copy, the expression of which could be possible only in a few ways, therefore, no copyright could subsist in it.

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19. The decisions relied on by the plaintiff [*Mishra Bandhu (supra)* & *Agarwala Publishing House (supra)*] to assert that copyright can vest in questions and question papers too, are all prior to the decision in *Eastern Book Company (supra)*. Besides the fact the standard for conferring copyright protection since *University of London (supra)* has undergone dramatic transformation, the facts of that case in relation to the doctrine of fair dealing can be distinguished on the ground that the allegedly infringing work in that case contained merely the answers and not the solutions to the questions. This fact was noted and emphasized by that Court also.

20. In the present case, the plaintiff's claim concerns mathematical questions and answers. Besides asserting the work put in by Dr. Roy, and the effort in arranging such questions at appropriate stages, chapters or units in the textbooks, the plaintiff do not show how such effort is original to conform to the minimum degree of creativity mandated by Indian law, post Eastern Book Company (supra). Mathematical questions are expression of laws of nature. The "discovery" of such laws cannot confer monopoly to those who describe it. The reason is that language is a limited medium, which enables description of such laws of nature - in only a few ways. Recognition of copyright as inhering in the questions themselves (as the plaintiff suggest the court to do), without existence of the "creative" element of originality would deny access to ideas, thus robbing one of the primary objectives of copyright law (promotion of creativity) of vitality, thereby stifling intellectual CS (OS) 1656/2005 Page 13 growth. Interestingly, section 3 (k) of the Patents Act, 1970 explicitly denies any form of patent protection to a mathematical method or algorithms. Prima facie, Parliament could not have intended that innovations such as new mathematical questions, denied benefit of patent protection--which if granted is of restricted duration--could be refused, but a wider protection in time, by way of copyright, could have been granted.

21. As far as the sequencing and schematic arrangement of the questions

- in the various chapters is concerned - the plaintiff say that the textbook conforms to the specifications and requirements of the J& K Board. Here, the plaintiffs had to show original effort, unique to their schematic arrangement or sequencing. In education, the dictates of the "learning content" are such that each level demands a "curve". These "learning content" and "learning curve" elements are inherent in the syllabi evolved by examination bodies such as J & K Board or the CBSE. The plaintiff therefore, had to show how it evolved an arrangement so unique that the scheme is entitled to copyright protection, independent of the dictates of the Board. The involvement of the Board, in the creation of the syllabus, negates such originality. This is not to suggest that there can be no creativity in such schematic arrangement; the court merely infers that prima facie there is no material in support of it; the plaintiff have made no attempt to show this creativity, apart from placing the textbooks on the record. For those reasons, this court prima facie is of the opinion that the plaintiffs' claim of copyright in questions, answers, and their CS (OS) 1656/2005 Page 14 requiring or arrangement, is insubstantial.

II. The Fair Use defense

22. The next question is whether such copying will be covered under the fair use exemption provided under Section 52 of the Act, assuming that the plaintiffs prima facie have established a copyright claim. Relevant parts of Section 52 of the Act are extracted below:

Section 52 - Certain acts not to be infringement of copyright The following acts shall not constitute an infringement of copyright, namely:--

(a) a fair dealing with a literary, dramatic, musical or artistic work not being a computer programme] for the purposes of-

(i) Private use including research;

(ii) criticism or review, whether of that work or of any other work;

XXXXXXXXXX

(h) the reproduction of a literary, dramatic, musical or artistic work-

(i) by a teacher or a pupil in the course of instruction; or

(ii) as part of the questions to be answered in an examination; or

(iii) in answers, to such questions;

23. The doctrine of fair use or fair dealing is an integral part of copyright law. It permits reproduction of the copyrighted work or use in a manner, which, but for the exception carved out would have amounted to infringement of the copyright. In a seminal article published in 1990 Judge Pierre N Leval, wrote:

"The doctrine of fair use need not be so mysterious or dependent on intuitive judgments. Fair use should be perceived not as a CS (OS) 1656/2005 Page 15 disorderly basket of exceptions to the rules of copyright, nor as a departure from the principles governing that body of law, but rather as a rational, integral part of copyright, whose observance is necessary to achieve the objectives of that law....Fair use should not be considered a bizarre, occasionally tolerated departure from the grand conception of the copyright monopoly. To the contrary, it is a necessary part of the overall design. Briefly stated, the use must be of a character that serves the copyright objective of stimulating productive thought and public instruction without excessively diminishing the incentives for creativity".

(TOWARD A FAIR USE STANDARD, 103 HARV. L. REV. 1105 (1990)) One of the earliest decisions to deal with the doctrine of fair use was *Folsom et al. v. Marsh et al*, 9 F. Cas. 342, 1841 US App, where the Supreme Court laid down the following:

□n short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work. Many mixed ingredients enter into the discussion of such questions. In some cases, a considerable portion of the materials of the original work may be fused, if I may use such an expression, into another work, so as to be undistinguishable in the mass of the latter, which has other professed and obvious objects, and cannot fairly be treated as a piracy; or they may be inserted as a sort of distinct and mosaic work, into the general texture of the second work, and constitute the peculiar excellence thereof, and then it may be a clear piracy."

24. The breadth of the fair use doctrine use was put to test in *Harper & Row v. Nation Enterprises* 471 US 539 (1985). Harper had contracted to publish President Ford's memoirs. In exchange for \$ 25,000, Harper allowed Time Magazine to extract 7500 word passage from the book, which dealt with the pardon to President Nixon. The Editor of *Nation Magazine* wrote an article relying on an unauthorized version of the memoir, which reproduced CS (OS) 1656/2005 Page 16 300 to 400 words of the passage contracted to the *Time Magazine*. The article in *Nation* appeared before the article in *Times* and the latter refused to pay up the balance money to Harper. Harper brought an action for infringement of copyright, and *Nation* put up a fair use defense. The Court noted that the four factors identified by Congress (17 U. S. C. §107) as especially relevant in determining whether the use was fair were: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work and proceeded to test the facts on each of these grounds. In its analysis, the Court applied much emphasis on the commercial character of the defendant's use and its implication on the potential market of the copyrighted work. While doing so it recalled the observations made in *Sony Corp. of America v. Universal City Studios, Inc.*, 464 US 417 (1984), that "every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright". The Court, while fortifying the commercial-non-commercial divide, held that the fourth factor was the single most important factor while determining fair use. It is however, important to note the dissenting opinion of Justice Brennan in this regard. He regarded the majority opinion as conferring monopoly on historical facts and not merely on the exception. He cautioned that this approach would prove counter- productive to the very CS (OS) 1656/2005 Page 17 end of granting copyright protection and observed that:

"In my judgment, the Court's fair use analysis has fallen to the temptation to find copyright violation based on a minimal use of literary form in order to provide compensation for the appropriation of information from a work of history. The failure to distinguish between information and literary form permeates every aspect of the Court's fair use analysis, and leads the Court to the wrong result in this case. Application of the statutorily prescribed analysis with attention to the distinction between information and literary form leads to a straightforward finding of fair use.."

25. The contours of the fair use standard shifted somewhat with the decision in *Campbell v. Accuff-Rose Music*, 510 US 569 (1994). The Supreme Court unanimously upheld the claim of the defendants that their parody to the plaintiff's song *'Oh, Pretty Woman'* was covered by the fair use exception. It was uncontested that the defendant's song amounted infringement but for the *'Fair use'* exception. The Court held that all the traditional four factors employed to reach a conclusion of fair use are to be treated together, not in isolation and no undue preference can be given to any one of them. In relation to the first factor, it was held that Court must look into the nature of the use, i.e. whether it was for educational purposes or for review or criticism. The central enquiry (according to the Court) is to see if the work merely supercedes and supplants the original work or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; in other words, whether and to what extent the new work is *'transformative'*. The Court borrowed the latter expression from Judge Pierre Leval (supra). Transformative works,

CS (OS) 1656/2005 Page 18 the Court held, have a greater chance of falling within the fair use defense and such □works thus lie at the heart of the fair use doctrine,,s guarantee of breathing space within the confines of copyright . If one may put it differently, the question to be addressed would be is there a value addition, which alters the original work in a not insignificant measure. The second factor, which evaluates the nature of the copyrighted work, is intended to find out if the work actually merits copyright, that is, whether copyright law was intended, at its core, to cover such works. However, the Court cautioned that this factor is not likely □to help much in separating the fair use sheep from the infringing goats', in cases where the subsequent work is transformative. The third factor, which deals with the extent of copying, the Court explained citing Sony (supra), does not entail that the reproduction of the entire work would militate against the finding of fair use. There could be cases where the copying could be substantial and the courts finds fair use, at the same time there could be cases where the copying though insubstantial could be held as infringement. Lastly, the court observed that the fourth factor, where the market harm to the copyrighted work had to be assessed, could not be the sole determinative factor. The Courts have to "consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market". The Court went on to hold that the CS (OS) 1656/2005 Page 19 defendants use, was covered by the doctrine of fair use and did not amount to infringement.

26. The Court's holding in Campbell, has been followed in Sun Trust Bank v. Houghton Mifflin, 268 F.3d 1257 (11th Cir.2001) (vacating the injunction on □The Wind Done Gone' a fictional work based on Margaret Mitchell's Gone With the Wind); Bill Graham Archives v. Dorling Kindersley, 2006 US App LEXIS 11593 (holding that reproduction of images appearing in posters and tickets, in a coffee table biography fall within the fair use exception) and very recently in Peter Letterese & Associates v. World Institute of Scientology Enterprises, D.C. Docket No. 04-61178-CV-PCH (July 8, 2008).

27. In the United Kingdom, in Hubbard v. Vosper, (1972) 2 WLR 389, the Court while dealing with the question of what amounts to fair use observed as follows:

"It is impossible to define what is 'fair dealing'. It must be a question of degree. You must consider first the number and extent of the quotations and extracts. Are they altogether too many and too long to be fair? Then you must consider the use made of them. If they are used as a basis for comment, criticism or review, that may be a fair dealing. If they are used to convey the same information as the author, for a rival purpose, that may be unfair. Next, you must consider the proportions.

To take long extracts and attach short comments may be unfair. But, short extracts and long comments may be fair. Other considerations may come to mind also. But, after all is said and done, it must be a matter of impression. As with fair comment in the law of libel, so with fair dealing in the law of copyright. The tribunal of fact must decide."

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28. Indian law too, in relation to copyright infringement is interesting. The Supreme Court in *RG Anand (supra)* had to adjudicate whether the film produced by the defendant had in any manner infringed the copyright held by the plaintiff in his play. The Court after referring to a number of authorities on the subject observed that the same idea might be developed in different ways and is the defendants work is nothing but a colourable imitation of the plaintiffs work, then it would amount to infringement. It set out the following as the test for determining infringement:

□One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original."

Remarkably, the court, presciently in its judgment propounded a principle resembling the 'transformative work' doctrine developed in the United States much later. It held that:

"Where the theme is the same but is presented and treated differently so that the subsequent work becomes a completely new work, no question of violation of copyright arises."

29. In *Ramaiah (supra)*, the Andhra Pradesh High Court had to consider whether a guide book prepared to help students understand and study a text called 'Girija Kalyanam' amounted to infringement. The Court took note of the fact that the guide consisted of three portions, the first of which gave meanings to the text. The second portion contained annotations and CS (OS) 1656/2005 Page 21 illustrations of the meanings and the third portion consisted of probable questions and answers. The Court distinguished the facts from that in *Blackwood and Sons v. AN Parasuraman (supra)*, where the infringing work merely eliminated certain passages from the original work and retained the essential part of the narration in substantial form. Since, the guide was found to be much more than a mere replication of the earlier work, incorporating questions and answers, analysis etc, the injunction was refused.

30. In *EM Forster (supra)*, the Court had to determine whether a guide published for the novel 'A Passage to India' violated the copyright in the original novel. Here again, the Court noted that there was no verbatim reproduction of the entire novel. The guide was divided into different portions, which consisted of an introduction to the characters, the life and philosophy of EM Forster, a brief introduction to the works of EM Forster and of course an abridged version of the novel; though not chronological. The Court observed, referring to *Kartar Singh Giani v. Ladha Singh*, AIR 1934 Lah 777 that in the guise of copyright law the plaintiff cannot ask the courts to close all the avenues of research, scholarship and all frontiers of human knowledge. The court found that the guide did not constitute an infringement and therefore, did not go into the question of fair dealing. In *Romesh Chowdhry (supra)* too, the facts involved publication of guide books to books published by the University in accordance with its syllabi. The Court found that the guides were not colourable imitations of the University publications CS (OS) 1656/2005 Page 22 and amounted to criticism and review of those books. It also observed that since the University in their syllabus published these

books for the students, [The matter had gone into the hands of the students and no copyrights on the strict sense of the term remained with the complainant .

31. The question of fair dealing came up for consideration in *Civic Chandran v. Ammini Amma* 1996(16) PTC 670. The defendants had published a play [Ningal Are Communistakki', that was intended to be a critique of a famous play [Ningal Enna Communistakki'. The court referred to *Hubbard v. Vosper* (supra) and *RG Anand* and concluded that the play was meant to be a critique and therefore, constituted fair dealing under section

52. It observed that the latter work was not market competitor to the prior work, and by itself constituted a literary work with some amount of originality. Moreover, the Court held that the nature of the work, that is to criticize the social structures in Kerala, by itself meant that certain sequences, events and incidents would be common to both the prior and the subsequent work, and that the latter was not meant to imitate the former. Injunction was therefore, denied.

32. Copyright law is premised on the promotion of creativity through sufficient protection. On the other hand, various exemptions and doctrines in copyright law, whether statutorily embedded or judicially innovated, recognize the equally compelling need to promote creative activity and ensure that the privileges granted by copyright do not stifle dissemination of CS (OS) 1656/2005 Page 23 information. Two doctrines that could be immediately be summoned are the idea-expression dichotomy and the doctrine of [Fair use or fair dealing. Public interest in the free flow of information is ensured through the idea- expression dichotomy, which ensures that no copyright is granted in ideas, facts or information. This creates a public pool of information and idea from which everyone can draw. At the same time, as Judge Leval observes, all creativity is in part derivative, in that, no creativity is completely original; [Each advance stands on building blocks fashioned by prior thinkers (Bernard Shaw expressed it by saying that Shakespeare was a [tall man , but he (Shaw) was taller as he stood Shakespeare's shoulders). Judge Leval further observed that most important areas of intellectual creativity like philosophy, literature and sciences are referential, and require continuous reexamination of existing theses.

33. The doctrine of fair use then, legitimizes the reproduction of a copyrightable work. Coupled with a limited copyright term, it guarantees not only a public pool of ideas and information, but also a vibrant public domain in expression, from which an individual can draw as well as replenish. Fair use provisions, then must be interpreted so as to strike a balance between the exclusive rights granted to the copyright holder, and the often competing interest of enriching the public domain. Section 52 therefore cannot be interpreted to stifle creativity, and the same time must discourage blatant plagiarism. It, therefore, must receive a liberal construction in harmony with CS (OS) 1656/2005 Page 24 the objectives of copyright law. Section 52 of the Act only details the broad heads, use under which would not amount to infringement. Resort, must, therefore be made to the principles enunciated by the courts to identify fair use.

34. One crucial test, of the four-factor test, as developed by the American courts, is the transformative character of the use. The Courts should in cases like the present ask whether the purpose served by the subsequent (or infringing) work is substantially different (or is the same)

from the purpose served by the prior work. The subsequent work must be different in character; it must not be a mere substitute, in that, it not sufficient that only superficial changes are made, the basic character remaining the same, to be called transformative. This determination, according to the Court is closely knit with the other three factors, and therefore, central to the determination of fair use. If the work is transformative, then it might not matter that the copying is whole or substantial. Again, if it is transformative, it may not act as a market substitute and consequently, will not affect the market share of the prior work.

35. In the present case, this court has considered the plaintiff's textbooks, as well as the defendant works. The following aspects stand out;

(a) The plaintiff's textbooks, so far as they contain the theory portions, have not been copied;

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(b) The plaintiff's books do not contain the steps, or process aiding

the solutions (or answers) to the questions/ problems, in each chapter. The learner is expected, on the basis of the text and the theory, to apply his mind, and solve such problems

(c) The defendants' copies do not contain the text and the theory portions, analyzing the problems;

(d) The defendants' copies contain the questions as well as answers, which are found in the plaintiffs' textbooks;

(e) The defendants provide the problem solving step-by-step method to arrive at answers to the questions.

36. A careful analysis of the above would show that whereas the plaintiffs' texts do not contain or describe the step-by-step process of arriving at solutions (answers), the defendants' books provide them. The defendants' books do not contain the theoretical or explanatory content- they are present in the plaintiffs' textbooks. The use of questions and answers by the defendants, who provide the step-by-step process of reasoning, is for a different purpose. Though to a purist or one who delights in intellectual pursuits, such works may be distasteful, - even offensive - there is no gainsaying that they neither pretend to be textbooks, nor reproduce all that are contained in them. They are designed to cater to a category of student weak in their understanding of the subject.

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37. The purpose and manner of use of the questions found in the plaintiff's textbooks, by the defendants is thus different; additionally, in their books, missing in the plaintiff's works are the steps or process of problem solving. Thus, the defendants' works can be said to be 'transformative', amounting to 'review' under Section 52 (1) (a) (ii) of the Act. Here, the term 'review' has to be interpreted in the context. The plaintiffs claim to copyright is premised the work being a 'literary' one. The review - or commentary, of a part of such mathematical work - too would have to be seen in

the background of this claim.

38. "Review" according to the Shorter Oxford Dictionary (Fifth edition) means "view, inspect or examine a second time or again.. In the context of a mathematical work a review could involve re-examination or a treatise on the subject. In that sense, the defendants' revisiting the questions, and assisting the students to solve them, by providing the "step by step" reasoning prima facie amounts to a review, thus falling within the "fair dealing" provision of Section 52 (1) (a) (ii) of the Act.

39. For the above reasons, the interim injunction granted is hereby vacated. IA No. 9823/2005 and IA No.51/2006 are accordingly disposed off. CS(OS) 1656/2005 List before the Joint Registrar on 22nd October, 2008.

Dated: 17th September 2008

S RAVINDRA BHAT, J

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