

Mrf Limited. vs Metro Tyres Limited. on 1 July, 2019

Equivalent citations: AIRONLINE 2019 DEL 972, (2019) 262 DLT 734

Author: Manmohan

Bench: Manmohan

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* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS(COMM) 753/2017

MRF LIMITED.

..... Plaintiff

Through: Mr. Akhil Sibal, Senior Advocate
with Mr. Debarshi Bhuyan,
Advocate.

versus

METRO TYRES LIMITED.

..... Defendant

Through: Mr. Pravin Anand with Ms. Prachi
Agarwal and Mr. Rohan Sharma,
Advocates

Reserved on : 06th May, 2019

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Date of Decision: 01st July, 2019

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

JUDGMENT

MANMOHAN, J I.A. 12770/2017

1. Important issues of law arise for consideration in the present case, namely, whether in a suit for copyright infringement of a cinematograph film, the infringing copy has to be an exact copy made by a process of duplication or a substantial/material copy. Further, whether the copyright infringement test as laid down in R.G. Anand v. M/s Deluxe Films and Ors. (1978) 4 SCC 118 with regard to literary works is applicable to cinematograph films and whether the expression 'to make a copy of the film' means just to make a physical copy of the film by a process of duplication or does it refer to another work which substantially, fundamentally, essentially and materially resembles the original film. Bombay and Calcutta High Courts, by way of reasoned orders, have taken diametrically opposite views.

2. I.A. 12770/2017 has been filed by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure (hereinafter referred to as „CPC). The prayer clause in I.A. 12770/2017 is

reproduced hereinbelow:-

☐ (a) pass an order restraining the Defendant, its members, officers, partners, directors, employees, agents, representatives or any person claiming through them or acting on their behalf, from airing the impugned advertisement marked as ☒ X ; and

(b) pass an ex parte ad interim order in terms of prayer (a) herein above and confirm the same after notice of motion;

and

(c) pass such other and/or further order(s) as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case. FACTS

3. It is the case of the plaintiff that it is engaged in the business of manufacture, marketing and sale of tyres in about sixty-five countries including India and is widely recognized for its quality and customer satisfaction.

4. It is averred in the plaint that during the course of its business, the plaintiff has been manufacturing and selling a range of tyres and one such series is named as MRF NV Series "REVZ". It is further averred that the plaintiff's trademarks "MRF NV SERIES" and "REVZ" are registered under Class 12 of the Trade Marks Act, 1999 and since its commercial launch in June, 2015, the plaintiff has sold almost eighteen lakhs fifty four thousand units of the MRF NV Series "REVZ" tyres till 30th June, 2017, generating a revenue of about Rupees Two Hundred Ninety One crores and Seventy Thousand.

5. It is also averred in the plaint that in order to widely publicise and advertise the MRF NV Series "REVZ" range of tyres, the plaintiff produced an audio-visual advertisement titled as „MRF NV Series present REVZ (hereinafter referred to as „plaintiff's advertisement') which was first aired in TV media on 27th June, 2015 and posted on the internet on 29th June, 2015 on [www.youtube.com](http://www.youtube.com/watch?v=DwUos-8JKxY) with the link <https://www.youtube.com/watch?v=DwUos-8JKxY>. Subsequently, the said advertisement was aired on forty-one television channels.

6. It is the case of the plaintiff that it is the author of the aforesaid advertisement which constitutes a „cinematograph work under Section 2(f) of the Copyright Act, 1957 (hereinafter referred to as „Act, 1957) and is entitled to protect it under Section 14 of the Act, 1957.

7. It is also the case of the plaintiff that it came to its knowledge in October, 2016 that the defendant, who is involved in the same business of manufacturing and marketing of tyres, had produced similar advertisement titled „Bazooka Radial Tyres (hereinafter referred to as „defendant's advertisement').

8. It is averred in that plaint that a bare perusal of the two advertisements shows that defendant's advertisement is nothing but a substantial and material copy of the plaintiff's advertisement. It is

further averred that there are similarities between the plaintiff s and defendant s advertisement, whereby the plaintiff s copyright in its advertisement has been infringed.

9. It is stated that on coming to know about the defendant s advertisement, the plaintiff vide letter dated 18th October, 2016 had filed a bona fide intra-industry complaint with the Advertising Standards Council of India (hereinafter referred to 'ASCI'). However, no substantial action was taken by ASCI as the complaint was merely forwarded to the defendant.

10. It is stated in the plaint that on receipt of the plaintiff s complaint, the defendant instead of replying to the same had filed a suit before this Court being CS(COMM) No. 1484/2016 titled as Metro Tyres Ltd. vs. The Advertising Standards Council of India & Anr. inter alia seeking to restrain the plaintiff herein from issuing groundless threats to the defendants and for restraining the ASCI from proceeding with the said complaint.

11. However, the said suit was dismissed in limine vide order dated 17th March, 2017.

12. It is stated in the plaint that the defendant preferred an appeal being R.F.A(OS) COMM. 5/2017 Metro Tyres Ltd Vs. The Advertising Standards Council of India and Anr. and the same is pending adjudication before a Division Bench of this Court.

13. Since ASCI even after dismissal of the defendant s suit did not proceed with the plaintiff s complaint, the plaintiff filed the present suit.

PLAINTIFF'S ARGUMENTS

14. Mr. Akhil Sibal, learned senior counsel for the plaintiff submitted that in 1957, a cinematograph film was defined under Section 2(f), which is reproduced hereinbelow:-

2. Interpretation xxxx xxxx xxxx xxxx

(f) Cinematograph film means any work of visual recording and includes a sound recording accompanying such visual recording and Cinematograph shall be construed as including any work produced by any process analogous to cinematography including video films;

15. Learned senior counsel for the plaintiff pointed out that as the menace of piracy became a global problem, the aforesaid definition was periodically amended. A chart showing the amendments carried out to widen the scope of Section 2(f) (handed over by learned senior counsel for the plaintiff) is reproduced hereinbelow:-

Pre amendment	Post amendment in 1984
(f) –cinematograph film includes the sound track, if any, and –cinematograph	(f) –cinematograph film includes the sound track, if any, and –cinematograph shall be

shall be construed as including any work produced by any process analogous to cinematography

Explanation - For the purposes of this clause, 'video films' shall be deemed to be work produced by a process analogous to cinematography

In 1994, Section 2(f) was further clarified as follows:

Pre amendment	Post amendment in 1984
S.2(f) –cinematograph film includes the sound track, if any, and –cinematograph shall be construed as including any work produced by any process analogous to cinematography	S. 2(f) 'cinematograph film' means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and –cinematograph shall be construed as including any work produced by any process analogous to cinematography including video films
–Explanation - For the purpose of this clause, –video films shall be deemed to be work produced by a process analogous to cinematography.'	

In 2012, Section 2(f) was further clarified with the specific addition of a definition in section 2(xxa) for 'visual recording' present in the definition of 'cinematographic film' since 1994.

Pre amendment	Post amendment in 2012
S.2(f) 'cinematograph film' means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and –cinematograph shall be construed as including any work produced by any process analogous to cinematography	S. 2(f) 'cinematograph film' means any work of visual recording and includes a sound recording accompanying such visual recording and –cinematograph shall be construed as including any work produced by any process analogous to cinematography including video films
	S. 2 (xxa) –visual recording means the recording in any medium, by any method including the storing of it by any electronic

including video films.

means, of moving images or of the representations thereof, from which they can be perceived, reproduced or communicated by any methods;

16. Learned senior counsel for the plaintiff stated that a comparison of the plaintiff's and defendant's advertisements showed a similar sequencing, form, treatment and expression. He contended that the defendant's advertisement contained material and broad similarities which

showed that the defendant's intent was to copy the plaintiff's advertisement. He stated that the coincidences which appeared in the two advertisements were neither incidental nor based on mere chance.

17. Learned senior counsel for the plaintiff emphasised that apart from other similarities, it was highly unlikely that the defendant independently and without copying the advertisement of the plaintiff:

(i) by "mere chance" chose to begin its advertisement with a similar spaceship like gate/door which opens to take the viewer into a futuristic chamber;

(ii) by "mere chance" chose to thereafter depict a similar robotic arm manipulating a computer screen/electronic panel;

(iii) by further "chance" chose to portray a similar robotic arm etching similar looking grooves, with a similar red laser beam onto the respective tyres and;

(iv) lastly, again by innocent coincidence, depicted a similar looking motorcycle with the same colour combination!

18. Learned senior counsel for the plaintiff pointed out that a perusal of third-party advertisements of manufacturers of tyres showed that there was a possibility of varied forms of expression, sequencing, manner of presenting and treatment of an advertisement in a futuristic setting. He stated that the overall impression of third-party advertisements was clearly and materially different from that of the plaintiff's and defendant's advertisements.

19. Learned senior counsel for the plaintiff contended that the similarities between the plaintiff's and defendant's advertisement were on fundamental and substantial aspect of the mode of expression adopted in the copyrights works. Though he admitted that there were some differences in the two advertisements, yet according to him, the same were minor and immaterial as an infringing copy need not be an exact copy but a substantial and material one.

20. Learned senior counsel for the plaintiff submitted that in a suit for copyright infringement of a cinematograph film the test is of an overall impression of an average viewer and not a microscopic analysis which underscores differences/divergences. In support of his submissions he relied upon the judgment of the Apex Court in R.G. Anand v. M/s Deluxe Films and Ors. (1978) 4 SCC 118. The relevant portion of the said judgment is reproduced hereinbelow:-

¶46. Thus, on a careful consideration and elucidation of the various authorities and the case law on the subject discussed above, the following propositions emerge:

1. There can be no copyright in an idea, subject-matter, themes, plots or historical or legendary facts and violation of the copyright in such cases is confined to the form, manner and arrangement and expression of the idea by the author of the copyrighted

work.

2. Where the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur. In such a case the courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant's work is nothing but a literal imitation of the copyrighted work with some variations here and there it would amount to violation of the copyright. In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.

3. 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.

4. 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.

5. Where however apart from the similarities appearing in the two works there are also material and broad dissimilarities which negative the intention to copy the original and the coincidences appearing in the two works are clearly incidental no infringement of the copyright comes into existence.

6. As a violation of copyright amounts to an act of piracy it must be proved by clear and cogent evidence after applying the various tests laid down by the case-law discussed above.

7. Where however the question is of the violation of the copyright of stage play by a film producer or a director the task of the plaintiff becomes more difficult to prove piracy.

It is manifest that unlike a stage play a film has a much broader prospective, wider field and a bigger background where the defendants can by introducing a variety of incidents give a colour and complexion different from the manner in which the copyrighted work has expressed the idea. Even so, if the viewer after seeing the film gets a totality of impression that the film is by and large a copy of the original play, violation of the copyright may be said to be proved. DEFENDANT'S ARGUMENTS

21. Mr. Pravin Anand, learned counsel for the defendant stated that the present case is not a case of trademark infringement or passing off and therefore it is not a „confusion based action against the defendant.

22. Learned counsel for the defendant emphasised that in Section 13(1) of the Act, 1957 the word „original is not used with respect to cinematograph film.

23. Learned counsel for the defendant contended that a cinematograph film is treated differently under Section 13(3) of the Act, 1957 as all the underlying works which contribute to the making of a film are protected independently.

24. Learned counsel for the defendant submitted that upon a conjoint reading of Sections 2(m)(ii), 14(d)(i) and 51 of the Act, 1957, it was apparent that to establish copyright infringement in a cinematograph film, it was essential to show that the impugned work was an actual copy of the plaintiff's advertisement/cinematograph film. He emphasised that it had to be shown that an actual copy of the copyrighted film had been made by a process of duplication.

25. Learned counsel for the defendant submitted that the expression „to make a copy of the film meant to make a physical copy of the film itself and not another film which merely resembled the original film. He further submitted that copying had to be of the same signals, i.e. same images and sound recordings and not any other version that had been independently created by the defendant, for example by reshooting the subject matter of the copyright film. Consequently, according to him, Act, 1957 granted a limited and narrow protection to a cinematograph film.

26. Learned counsel for the defendant stated that in the present case the defendant had made neither a physical copy of the impugned advertisement over a physical medium nor a copy of a photograph of any image, which formed a part of the impugned advertisement. Thus, according to learned counsel for defendant, plaintiff had miserably failed to establish copyright infringement in the impugned advertisement. In support of his submissions, he relied upon a judgment of a learned Single Judge of Bombay High Court in *Star India Private Limited v. Leo Burnett (India) Pvt. Ltd.* (2003) 27 PTC 81 (Bom). The relevant portion of the said judgment is reproduced herein below:-

□As pointed earlier contrasting sections 14(d) and (e) on the one hand and sections 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 case of literary, dramatic or artistic work seems to be different. A narrow copyright protection is accorded to a film/sound recording than for literary, dramatic or artistic work. The reason perhaps could be that they have to be original to satisfy the test of copyright ability, whereas the requirement of originality is absent for claiming copying in cinematograph films/sound recordings.

27. Learned counsel for defendant extensively referred to the judgment in *Norowzian v. Arks Ltd and Others*, 1996 FSR 394 relied upon by the Bombay High Court in the aforesaid judgment. He also relied on the judgment of the Madras High Court in *Thiagarajan Kumararaja vs. Capital Film Works (India) Pvt. Ltd. & Ors.*, MANU/TN/3844/2017 and judgment of the Federal Court of Australia in *Telmak Teleproducts Australia Pty Ltd v Bond International Pty Ltd* 1985 (5) IPR 203.

28. Learned counsel for the defendant contended that the plaintiff's reliance on the judgment of the Apex Court in *R.G. Anand v. Deluxe Films* (1978) 4 SCC 119, was misconceived as the said judgment was concerned with a script (literary work) and not with a film. He further contended that the tests for comparison of a literary work and a film are completely different, as for a film there had to be an exact copy of the film or portions thereof, whereas for a script or literary work, the Court may examine whether the reader, spectator or viewer got an unmistakable impression that one work was a copy of the other.

29. He further submitted that the plaintiff attempted to establish copyright infringement by a dissection of the rival narratives and comparison of isolated scenes - which was untenable in law. He stated that the plaintiff had selectively picked six to eight isolated concepts from its advertisement and argued that they constituted the kernel. He submitted that the aforesaid argument of the plaintiff was erroneous as concepts could not form the „kernel“ or the heart of a work.

30. In the alternative, he stated that in fact a mere comparison of the plaintiff's and defendant's advertisement/cinematograph film made the numerous differences evident. A tabular comparison of the differences between plaintiff and defendant's advertisement handed over by learned counsel for the defendant is reproduced hereinbelow:-

31. Learned counsel for the defendant stated that the aforesaid table proved that there was no intent on the part of the defendant to copy the plaintiff's work. He lastly stated that the defendant's advertisement had been independently created and had received awards.

REJOINDER ARGUMENTS

32. In rejoinder, learned senior counsel for the plaintiff submitted that in India as well as in certain European countries that followed the author's right tradition for copyright protection, the subject matter of protection in a film was both the audio visual „work“ as well as the „recording“ or other manifestations of the work.

33. Mr. Sibal pointed out that initially under the International Berne Convention 1908 (hereinafter referred to as the 'Berne Convention'), a cinematograph film was provided dual protection, as a series of photographs and as a „dramatic work distinct from its script. Thus, under the Berne Convention, a „cinematograph work had been protected as an „original work and work of authorship. He contended that the final report of the Berlin Conference specifically stated that with respect to cinematograph works protected as dramatic work "judges will assess the matter in the same way as for ordinary literary and artistic works .

34. Learned senior counsel for the plaintiff contended that Article 14(2), as modified in the 1928 Rome Act of the Berne Convention, highlighted the difference between the intangible and the tangible property in a film.

35. He submitted that the concept of protection in a cinematograph film was further enunciated in the 1948 revision of the Berne Convention (Brussels revision) as cinematograph works were specifically included in the non-exhaustive list of works in Article 2(1) of the Berne Convention.

36. He stated that the 1967 revision to the Berne Convention (Stockholm revision) strengthened the existence of an independent protection to the intangible intellectual property in a cinematograph work specifically stating in Article 14bis that the owner of a copyright in a cinematographic work shall enjoy the same rights as the author of an original work. The Berne Convention also protected the rights of authors whose works were used (or adapted) for the creation of cinematograph works under Article 14 and the rights in cinematograph works themselves under Article 14bis.

37. Learned senior counsel for the plaintiff pointed out that reproduction right was included under Article 9 of the Berne Convention and was applicable to cinematograph works under Article 14bis. He contended that the reproduction right extended to reproduction in any manner or form.

38. In contrast he submitted that under the laws in the United Kingdom (UK) and Australia, which had been followed by the Bombay High Court in *Star India Private Limited v. Leo Burnett (India) Pvt. Ltd.* (supra) the subject matter of protection in a film was the „recording only as distinct from the intangible „work .

39. Learned senior counsel for the plaintiff stated that before the Act, 1957, the law relating to copyright in India was also the British parliamentary legislation i.e. the Imperial Copyright Act, 1911 as modified by Indian Copyright Act, 1914. He contended that to comply with the Berne Convention, cinematograph works were given express protection under the Imperial Copyright Act, 1911 under Section 1(2) and Section 35(1) which defined dramatic work to include cinematograph work of original character. He submitted that thus the right in a dramatic work contained in the film could be infringed without actually lifting its frames or images.

40. Learned senior counsel for the plaintiff submitted that under the Copyright Act, 1956 (UK) a radical departure was made from the Imperial Copyright Act, 1911. Under the Copyright Act, 1956 (UK), cinematograph works were excluded from the definition of the photographs and dramatic work and cinematograph films were defined separately under Section 13(10) of the Copyright Act,

1956 (UK). He submitted that a film was no longer protected as a „work and the maker of the film was not designated as the author. Consequently, according to him, a narrow scope of infringement of copyright in a cinematograph film was granted by giving a restrictive definition to the terms „film and „copy .

41. Learned senior counsel for the plaintiff stated that under the Copyright, Designs and Patents Act, 1988 (UK) [for short "UK Act, 1988"] the definition of „film was once again amended and was defined as the visual recording itself. He submitted that the possibility of protection of the audio-visual work (i.e. cinematograph work) as dramatic work was reinstated by the removal of the exclusion from the definition of dramatic works under Section 3(1) of the UK Act, 1988.

42. Learned senior counsel for the plaintiff submitted that with the change in the definition of film under the UK Act, 1988 and the protection of a cinematograph work as a dramatic work, although it did so unconventionally, the United Kingdom met the minimum standard of protection under the Berne Convention. He pointed out that „A User s Guide to Copyright under the UK Act, 1988, specifically states □Clearly if a film is capable of receiving protection as a dramatic work in its own right, then replicating and reshooting scenes from an earlier film is capable of infringing the earlier film (as distinct from the works appearing in it) if a substantial part is copied. Therefore learned senior counsel for the plaintiff submitted that the test for infringement of a film under the UK Act, 1988 was of substantial reproduction.

43. Learned senior counsel for the plaintiff further submitted that the judgment in *Norowzian v. Arks Ltd and Others* (supra) extensively relied upon by the Bombay High Court had been specifically overruled in Appeal on the question of law by the Court of Appeal in *Norowzian v. Arks Ltd. &Ors.*, (2000) FSR 363. He pointed out that although the Appeal Court s decision was unanimous, their reasoning was not. In the judgment of Lord Justice Nourse, it was unnecessary to have regard to any other material as an aid to construction of the UK Act, 1988. His view was that the definition of „dramatic work in the UK Act, 1988 was at large and should be given its natural and ordinary meaning, namely „a work of action, with or without words or music, which is capable of being performed before an audience , and that a film would often, although not always, fall within that definition. In contrast, Lord Justice Buxton held that the UK Act, 1988 should be interpreted consistently with UK s obligations under the Berne Convention, which required all cinematographic works to be included within the Act s definition of dramatic works even in cases where the natural meaning of dramatic work might not embrace the particular film in question.

44. Learned senior counsel for the plaintiff emphasized that any reference to the judgment of the United Kingdom and also Australia (as the Australian Copyright Act, 1968 in pari materia with the UK Act, 1956) would be inapposite as the scheme of the Indian Copyright Act is different.

SUR-REJOINDER ARGUMENTS

45. Learned counsel for the defendant emphasised that in *Zee Entertainment Enterprises Limited Vs. Gajender Singh and Others*, 2007 SCC OnLine Bom. 920 the Bombay High Court has held that the judgment in *Star India Private Limited* (supra) is not based merely on the foreign judgments but

on the provisions of the Act, 1957.

46. Learned counsel for the defendant further pointed out that a perusal of the scheme of the Act, 1957 shows that the terms „copy and „reproduce have been used differently, thereby denoting that the terms have separate and distinct meanings.

47. Learned counsel for the defendant stated that under Section 2(d) of Act, 1957, the producer is the author of a cinematograph film and is defined under Section 2(uu) of Act, 1957 as a person who takes the initiative and responsibility for making a work.

48. He pointed out that an amendment to include principal director as an author was proposed in 2010, but was rejected by the Rajya Sabha in the debate on Copyright Amendment Bill 2010 for the following reasons:-

a. No liability/responsibility is assigned to the directors. b. Directors get huge money as fees or percentage of profit under a mutual contract which takes full care of the rights of the directors (para 3.3., 3.4., 3.8, 3.11) c. Directors take an equity risk. Producers alone suffers (para 3.4, 3.8, 3.11) d. If the film is a hit, benefits the director (para 3.4)

49. He further stated that film making involves a number of crafts handled by different agencies/individuals. Identifying only the principal director as author would not be just. The relevant portion of the aforesaid report relied upon by learned counsel for the defendant is reproduced hereinbelow:-

¶xxx xxxx xxxx xxxx xxxx 3.7. The Committee shares the apprehensions of the stakeholders about the proposed inclusion of principal director as author in clause 2 (d) (v) of the Act. Department's admission that ¶such a provision is not prescribed in most of the jurisdictions like USA and the matter is taken care of through other means corroborates such apprehensions. It is again intriguing that none of the international treaties namely WCT and WPPT or even Rome Convention stipulate such a concept. It is well established that the producer is the kingpin who invests substantive money, raises finance through institution, utilizes persons/expertise and brings out a product i.e. film. He takes such initiative and responsibility for making the work and chooses the director on certain offer. It is also an undisputed fact that a director plays a major role in the making of a film but in co-ordination with the producer only. The Committee is also surprised to note that nowhere in the proposed Bill, the term ¶principal director has been defined whereas the definition of the term ¶producer has been provided under section 2 (uu) of the Copyright Act, 1957. The Committee feels that this definition of producer ought to have been modified in the context of the proposed amendment. It was also pointed out that the term ¶principal director' was not defined under the Berne Convention also. The Committee is not convinced by the contention of the Department that such a definition is not required due to the clear understanding in the film world about the identity of principal director as there are different directors responsible for different aspects of film making like music director, art director, action director etc. More so there is no word as ¶principal director' in the parlance of the cine industry at all as ¶director' is the term used for any person who co

ordinates 'in general way' while others are on specific work as music, art, dance etc. xxx xxx xxx 3.11 In view of the above, the Committee is of the view that the proposed amendment to include principal director as author of a cinematograph film along with producer may create confusion and lead to uncalled for situations instead of serving the purpose intended for. Committee's opinion rests on the premise that there is a system existing presently where under producers and directors are free to negotiate on their own terms and conditions. Under these negotiations/contracts, directors are not only paid their negotiated salary/fee but also certain rights in perpetuity relating to the script. Further, as per the existing system, the principal director is not taking any equity risk in the production/performance of a film and it is the producer alone who runs the risk of his investment not being recovered. The Committee strongly feels that the proposal of joint ownership is unfair. It, therefore, recommends that the proposal to include principal director as author of the film along with producer may be dropped altogether.

50. Learned counsel for the defendant lastly submitted that techniques used by the directors are not protected by copyright as they are subject matter of patents. He contended that most of the techniques used by the directors are in public domain, such as colorimetry, 3-D, animation etc. COURT'S REASONING COPYRIGHT SUBSISTS IN A 'CINEMATOGRAPH FILM' AS A WORK INDEPENDENT OF UNDERLYING WORKS THAT COME TOGETHER TO CONSTITUTE IT. FURTHER, THOUGH THE COPYRIGHT SUBSISTS IN THE CONSTITUENT PARTS, YET THE COPYRIGHT VESTS SEPARATELY AND INDEPENDENTLY IN THE COMPOSITE WHOLE - THE FILM.

51. Having heard learned counsel for the parties, this Court is of the view that the Act, 1957 confers a bundle of exclusive rights on the owner of a "work" and provides for remedies in case the copyright is infringed. The relevant portion of Statement of Objects and Reasons of the Copyright (Amendment) Act, 1994, is reproduced hereinbelow:-

Effective copyright protection promotes and rewards human creativity and is, in modern society, an indispensable support for intellectual, cultural and economic activity. Copyright law promotes the creation of literary, artistic, dramatic and musical works, cinematograph films and sound recordings by providing certain exclusive rights to their authors and creators.... (emphasis supplied)

52. In fact, under the Act, 1957 a „cinematograph film is protected as a „work and not merely as a tangible recording. Section 2(y) of the Act, 1957 defines "work" as including a cinematograph film. Section 2(y) reads as under:-

2(y) "work" means any of the following works, namely:-

(i) a literary, dramatic, musical or artistic work;

(ii) a cinematograph film;

(iii) a sound recording;

(emphasis supplied)

53. A „cinematograph film“ under Section 2(f) means "any work of visual recording and includes a sound recording accompanying such visual recording... A film in India is therefore a 'work of recording' as opposed to a mere 'recording' under Section 5B of the UK Act, 1988. Consequently, while the Indian definition is wider and more robust, the definition and protection of films under English law is narrower both in scope and width.

54. A 'cinematograph film' is also mentioned under Section 13(1) of the Act, 1957 as a „work“ in which copyright subsists. The relevant portion of the said Section reads as under:-

13. Works in which copyright subsists.-- (1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works, that is to say,--

(a) original literary, dramatic, musical and artistic works;

(b) cinematograph films; and.... (emphasis supplied)

55. Further, Section 13(4) of the Act, 1957 stipulates that copyright in underlying works like literary, dramatic and musical are separate, independent and in addition to the rights vested in the owner of a „cinematograph film“. The relevant portion of the said Section reads as under:-

13. Works in which copyright subsists.--

xxxx xxxx xxxx xxxx (4) The copyright in a cinematograph film or a sound recording shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or, as the case may be, the sound recording is made. (emphasis supplied)

56. It is pertinent to mention that the Copyright Bill, 1955 was referred to a Joint Committee. In its report, the Committee specifically stated that 'a cinematograph film is an independent work which will enjoy copyright apart from its component parts. The Statement of Objects and Reasons of the Act, 1957 specifically states that 'a cinematograph film will have a separate copyright apart from its various components namely, story, music, etc.

57. Consequently, copyright subsists in a „cinematograph film“ as a work independent of underlying works that come together to constitute it. Further, though the copyright subsists in the constituent parts, yet the copyright vests separately and independently in the composite whole -

the film.

A FILM IS RECOGNISED AS BEING MORE OR GREATER THAN THE SUM OF ITS PARTS.

58. In fact, a „cinematograph film“ is something more or greater than the sum of its parts. This Court is of the view that Section 13(1)(b) refers to the „superstructure“ built on the „foundation“ of the „original underlying work“. This aspect was recognized by Justice V.R. Krishna Iyer in the footnote in *Indian Performing Right Society Ltd. v. Eastern Indian Motion Pictures Association and Others*, (1977) 2 SCC 820. The relevant portion of the said judgment is reproduced hereinbelow:-

¶20. A cinematograph is a felicitous blend, a beautiful totality, a constellation of stars, if I may use these lovely imageries to drive home my point, slurring over the rule against mixed metaphor. Cinema is more than long strips of celluloid, more than miracles in photography, more than song, dance and dialogue, and, indeed, more than dramatic story, exciting plot, gripping situations and marvellous acting. But it is that ensemble which is the finished product of orchestrated performance by each of the several participants, although the components may, sometimes, in themselves be elegant entities. Copyright in a cinema film exists in law, but Section 13(4) of the Act preserves the separate survival, in its individuality, of a copyright enjoyed by any ¶work notwithstanding its confluence in the film. This persistence of the aesthetic ¶personality of the intellectual property cannot cut down the copyright of the film qua film. The latter right is, as explained earlier in my learned Brother's judgment set out indubitably in Section 14(1)(c). True, the exclusive right, otherwise called copyright, in the case of a musical work extends to all the sub-rights spelt out in Section 14(1)(a). A harmonious construction of Section 14, which is the integral yoga of copyrights in creative works, takes us to the soul of the subject. The artist enjoys his copyright in the musical work, the film producer is the master of his combination of artistic pieces and the two can happily coexist and need not conflict. What is the *modus vivendi*?

21. The solution is simple. The film producer has the sole right to exercise what is his entitlement under Section 14(1)(c) qua film, but he cannot trench on the composer's copyright which he does only if the ¶music is performed or produced or reproduced separately, in violation of Section 14(1)(a). For instance, a film may be caused to be exhibited as a film but the pieces of music cannot be picked out of the sound track and played in the cinema or other theatre. To do that is the privilege of the composer and that right of his is not drowned in the film copyright except where there is special provision such as in Section 17, proviso (c). So, beyond exhibiting the film as a cinema show, if the producer plays the songs separately to attract an audience or for other reason, he infringes the composer's copyright.

Anywhere, in a restaurant or aeroplane or radio station or cinema theatre, if a music is played, there comes into play the copyright of the composer or the Performing Arts Society. These are the boundaries of composite creations of art which are at once individual and collective, viewed from different angles. In a cosmic perspective, a thing of beauty has no boundary and is humanity's property but in the materialist plane on which artists thrive, private and exclusive estate in art

subsists. Man, the noblest work of the Infinite Artist, strangely enough, battles for the finite products of his art and the secular law, operating on the temporal level, guardians material works possessing spiritual values. The enigmatic smile of Mona Lisa is the timeless heritage of mankind but, till liberated by the prescribed passage of time, the private copyright of the human maker says, □hands off .

22. The creative intelligence of man is displayed in multiform ways of aesthetic expression but it often happens that economic systems so operate that the priceless divinity which we call artistic or literary creativity in man is exploited and masters, whose works are invaluable, are victims of piffling payments. World opinion in defence of the human right to intellectual property led to international conventions and municipal laws, commissions, codes and organisations, calculated to protect works of art. India responded to this universal need by enacting the Copyright Act, 1957.

23. Not the recommendations in conventions but provisions in municipal laws determine enforceable rights. Our copyright statute protects the composite cinematograph work produced by lay-out of heavy money and many talents but does not extinguish the copyrightable component parts in toto. (emphasis supplied)

59. Although, there may be techniques used in films which are protected under Patent law; however, a cinematograph film is greater than the sum of its component parts and enjoys the full protection under copyright law as other works.

60. Moreover, a „cinematograph film“ may not infringe any of its underlying works, namely, a literary, dramatic, musical or artistic work, but may nevertheless lack originality because it infringes another cinematograph film. In other words, in terms of Section 13(3)(a), a film must not be a copy of any other work, including any other film.

61. A Division Bench of the Calcutta High Court in *Shree Venkatesh Films Pvt. Ltd. vs. Vipul Amrutlal Shah & Ors.*, 2009 SCC OnLine Cal 2113 has taken a similar view. The Calcutta High Court has also treated the so called „original underlying works as raw materials“ from which an entirely different work like a cinematograph film may be created. The relevant portion of the said judgment is reproduced hereinbelow:-

□22. A cinematography film is a homogenous material. It is a collection or collage or ensemble of various works like story, screenplay, dialogue, sound track, video images, lyrics etc. Each of these works may also enjoy copyright protection. By operation of law or by contract or assignment the producer of the film may be vested copyrights in the above works. For example, the producer may employ a storywriter or a screenplay writer or a singer under a contract of employment. In that case the employer, subject to contract, is the first owner of the copyright. Otherwise, the author of the work may retain his individual copyright. (See Section 17 of the Copyright Act) Now, when all these works are put together and a cinematography film is made, a new copyright over the film is vested in the maker of the film or its producer. When the film as a whole is exhibited the individual owners of copyright in works who have permitted

the film to be made cannot claim copyright but if a part of the film is segregated and the individual work is culled out and exhibited then the individual owner can assert his copyright. Now, suppose the producer of the film without taking permission of the owners of the copyrighted works exhibits the film, the film may not have any copyright at all as a substantial part of the film in infringement of other work or works. (Section 13(3)(a) of the Copyright Act.)

23. The authority for the aforesaid legal position with regard to copyright in cinematography film is to be found in the decision of the Hon'ble Supreme Court in Indian Performing Right Society Ltd. v. Eastern India Motion Picture Association & Ors., reported in MANU/SC/0220/1977: AIR 1977 SC 1443.

24. However, not each and every work is entitled to copyright protection. Copyright protection is extended to original literary, dramatic, musical and artistic works;

cinematograph films and sound recording (Sec. 13(1)(a),(b)&(c) of the Copyright Act). In order to claim copyright there must be some originality in the work. The author of a work may obtain raw materials for the work from any or many sources but will only be entitled to copyright if these raw materials are converted, by use of his labour skill, capital and intelligence to create another material or work which is something different from the raw materials and has an element of novelty. (See Macmillan Company Limited v. K.J. Cooper, reported in AIR 1924 PC 75.) xxx xxx xxx xxx

29. We have made a scene by scene comparison of the two films and we prima facie hold that the Bengali film is substantially if not a verbatim copy of the Hindi film as a whole. We have also gone through the story of Purab or Paschim and prima facie hold that there is substantial innovation in the story of Namastey London. So, prima facie there is infringement of its story and screenplay in the Bengali film. (emphasis supplied)

62. Consequently, a „cinematograph film“ is recognised as being more than the sum of its parts.

THOUGH THE EXPRESSION 'ORIGINAL' IS MISSING IN SECTION 13(1)(b) OF THE ACT, 1957, YET THE REQUIREMENT OF ORIGINALITY OR INTELLECTUAL CREATION IS BROUGHT IN THROUGH SECTIONS 13(3)(a) AND 2(d).

63. Though the expression „original“ is missing in Section 13(1)(b) of the Act, 1957, yet the requirement of originality is brought in through Section 13(3)(a) which has to be read with the definitions of „cinematograph film“ and „author“ under Sections 2(f) and 2(d) of the Act, 1957.

64. Section 13(3)(a) reads as under:-

xxxx xxxx xxxx xxxx (3) Copyright shall not subsist--

(a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work; (emphasis supplied)

65. Section 13(3)(a) of the Act, 1957 implies that a copyright in a film cannot subsist if a substantial or material part of the said film is an infringement of copyright in any other work. In the opinion of the Court, this can only happen if a cinematograph film possesses originality greater than the originality of its underlying works.

66. Further, Section 2(d) states "an author means, in relation to a cinematograph film, the producer. Authorship entails originality. Without originality, there can be no authorship.

67. The concept of originality in copyright law is however not used universally in a completely uniform manner. Under certain national laws - mainly those which follow the common law tradition - it is sufficient that a production in the literary and artistic field is the result of "skill and labour" or the "sweat of the brow", while some other national laws - in certain countries following the civil law tradition - apply a more demanding originality test. Under the latter laws, it is not sufficient that a production is a result of intellectual creation; in addition to that, it is also a condition that, in a way, it must be an "individual creation, reflecting the personality of the author".

68. Although the differences in respect of the concept of originality still exist under national legislation, there is a trend that the distinction is fading away, and a kind of convergence is taking place in this respect between the above-mentioned different schools of thought and legal systems. According to Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms, the direction of this trend is that mere "sweat of the brow" is not sufficient for a production to qualify as a work; for this, it is also necessary that it be an "intellectual creation". However, at the same time, this is the only condition; that is, it is not justified to require some "higher" level of creativity, or some "reflection of the personality of the author" going beyond the mere requirement of "intellectual creation".

69. The requirement that a work is supposed to be an intellectual creation does not mean that it should be new according to the concept of "novelty" as used in the field of industrial property.

70. The Supreme Court has taken a similar view in *Eastern Book Company & Ors. vs. D.B. Modak & Anr.*, (2008) 1 SCC 1. The relevant portion of the same is reproduced hereinbelow:-

¶32. The word "original" does not mean that the work must be the expression of original or inventive thought. The Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and in the case of literary work, with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work--that it should originate from the author; and as regards compilation, originality is a matter of degree depending on the amount of skill, judgment or labour that has been involved in making the compilation. The words "literary work" cover work which is expressed in print or writing irrespective of the question whether the quality or style is high. The commonplace matter put together or arranged without the exercise of more than negligible work, labour and skill in

making the selection will not be entitled to copyright. The word "original" does not demand original or inventive thought, but only that the work should not be copied but should originate from the author.....

xxx xxx xxx

54.The Court approved the principles enunciated in *University of London Press Ltd. v. University Tutorial Press Ltd.* [(1916) 2 Ch 601] dealing with the meaning of the words "original literary work" that the original does not mean expression of original or inventive thought. The Copyright Act is not concerned with the original ideas, but with the expression of thought. The originality which is required relates to expression of thought and the Act does not require that the expression must be in original or novel form. The work must not be copied from another work--that it should originate from the author."

(emphasis supplied)

71. Merely because the producer is the owner of the copyright under the Act, 1957 does not mean that there is no creative input by the Director or that the scope of the copyright protection for a film under the Act, 1957 is in any manner narrower than with respect to other works. This is reflected in the Report of the Parliamentary Standing Committee on the Copyright (Amendment) Bill, 2010.

72. This Court is of the opinion that the context in which the words "work" and "author" are used indicates that films normally qualify as „intellectual creations'.

73. In fact, this Court is of the view that a film is rarely used for purposes of reproducing underlying work alone. A film normally gives form to creation or underlying work. One has to imagine, interpret the subject, arrange the scenes as well as sets, direct the moves of the actors, take the shots and develop the negatives may-be in a particular hue to create a film. It is not the question of monopolizing an idea or a subject or the underlying work but of protecting the „intellectual creation" i.e. the form given to the idea or the development of the subject or underlying work. Consequently, a cinematograph film is normally an original work as it is an „intellectual creation" .

THE EXPRESSION "TO MAKE A COPY OF THE FILM" IN SECTION 14(d)(i) DOES NOT MEAN JUST TO MAKE A PHYSICAL COPY OF THE FILM BY A PROCESS OF DUPLICATION.

FURTHER, AS THE SCOPE OF PROTECTION OF A FILM IS AT PAR WITH OTHER ORIGINAL WORKS, THE TEST IN *R.G. ANAND'S* (SUPRA) CASE WOULD APPLY. ACCORDINGLY, THE COURT WILL HAVE TO COMPARE "THE SUBSTANCE, THE FOUNDATION, THE KERNEL" OF THE TWO FILMS/ ADVERTISEMENTS TO CONSIDER WHETHER ONE WAS "BY AND LARGE A COPY" OF THE OTHER.

74. The exclusive rights with respect to „works" as defined under Section 2(y) of the Act, 1957 are provided in Section 14 of the Act, 1957. With respect to a cinematograph film, the exclusive right to

make a copy of a film has been provided for under Section 14(d)(i) since the inception of the Act, 1957. Section 14(d)(i) defines „copyright to mean the exclusive right to make a copy of the film. The relevant portion of the said Section is reproduced hereinbelow:-

□4. Meaning of Copyright.--For the purposes of this Act, □copyright" means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:--

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(d) in the case of a cinematograph film,--

(i) to make a copy of the film, including--

(A) a photograph of any image forming part thereof;or (B) storing of it in any medium by electronic or other means;

(ii) to sell or give on commercial rental or offer for sale or for such rental, any copy of the film;

(iii) to communicate the film to the public; (emphasis supplied)

75. Unlike the narrow definition of □Copy' in Section 17 of the UK Act, 1988, the term □Copy' has not been defined under the Act, 1957.

76. The ordinary, dictionary definition of □copy' is not confined to an □actual' copy made by a process of duplication, but is wider one and includes an imitation or reproduction. The Shorter Oxford English Dictionary defines □copy' as □to imitate'. The Oxford English Reference Dictionary defines □reproduction' as □a copy of work of art'.

77. In international treaties relating to copyright, □copy' and □reproduction' are used interchangeably. The Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms states □copying' is a □synonym of reproduction' and defines □copy' as □The result of reproduction of a work or object of related rights. It may be permanent or temporary/transient; it may be tangible or intangible; it may be perceived directly by human beings or only by means of appropriate equipment and, in general, it may exist in any manner or form.

78. No good reason has been indicated to read down the ordinary dictionary meaning of □copy' or for it to mean something narrower under the Act, 1957 in terms of the legislative objective/purpose or keeping with India's international obligations, both of which are consistent with the ordinary, wider definition of □copy'.

79. Consequently, as the scope of protection of a film is at par with other original works, this Court is of the opinion that the test laid down in R.G. Anand's (supra) case would apply.

80. Further it is clear from a reading of the test laid down in R.G. Anand's (supra) that it is not confined to a literary work and is of general application and has been applied as such since then. Significantly, the „substantiality test is found in the opening words of Section 14 and therefore applies equally to Section 14(d) of the Act, 1957.

81. The Calcutta High Court in Shree Venkatesh Films (supra) has taken a similar view. The relevant portion of the said judgment is reproduced hereinbelow:-

¶25. The next legal issue which has to be considered is the meaning to be ascribed to the word ¶copy . Does copy mean

(a) a carbon copy or an exact replica of the original? Or

(b) a substantial replica of the original or a substantial replica of a part of the original or

(c) a substantial similarity of the copied work with the original work is in the both works viewed by viewer of ordinary prudence.

26. Where there is an alleged substantial similarity in the film taken as a whole with another film, in the opinion of the said viewer there is infringement of the copyright in the film. A part of a film, e.g. story and screenplay may similarly enjoy copyright. A narrow meaning of the word ¶copy is an apposite and should never be given.

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28. The copyright Act as a whole is to be appreciated. It is true that Section.14(d) of the Act states that infringement of copyright of a film would take place by its copying. That is, in our opinion, only one type of infringement where the physical film or any electronic form of it is ¶carbon copied or replicated'. It covers a case where the whole film or a part of it is stolen and exhibited and situations analogous thereto. Infringement has other elements, which we have discussed above. In that context ¶copy' has to be given a broad meaning, as held by the Supreme Court in R.G. Anand's case (supra). (emphasis supplied)

82. Consequently, this Court is of the view that ¶to make a copy of the film' does not mean just to make a physical copy of the film by a process of duplication, but it also refers to another film which substantially, fundamentally, essentially and materially resembles/reproduces the original film. Accordingly, the blatant copying of fundamental /essential/distinctive features of the plaintiff's advertisement on purpose would amount to copyright infringement. Consequently, the Court will have to compare "the substance, the foundation, the kernel of the two advertisements to consider whether one was "by and large a copy of the other and whether an average viewer would get an

unmistakable impression that one work was a copy of the other.

THIS COURT IS OF THE OPINION THAT THE BOMBAY HIGH COURT JUDGMENT IN STAR INDIA PRIVATE LIMITED V. LEO BURNEET (INDIA) PVT. LTD. (SUPRA) NOT ONLY GIVES A RESTRICTED AND NARROW INTERPRETATION TO THE RIGHTS OF THE COPYRIGHT OWNER IN A CINEMATOGRAPH FILM, BUT IS ALSO NOT IN CONSONANCE WITH THE BERNE CONVENTION INASMUCH AS IT DOES NOT PROTECT A CINEMATOGRAPH WORK AS AN ORIGINAL WORK. FURTHER, IT WAS NOT BROUGHT TO THE NOTICE OF THE BOMBAY HIGH COURT THAT THE JUDGMENT IN THE CASE OF NOROWZIAN V. ARKS LTD AND OTHERS, 1996 FSR 394 (EXTENSIVELY RELIED UPON IN THE SAID CASE), HAD BEEN OVERRULED ON THE ISSUE OF LAW BY THE COURT OF APPEAL [(2000) FSR 363]

83. This Court is of the opinion that the Bombay High Court judgment in Star India Private Limited v. Leo Burneet (India) Pvt. Ltd. (supra) gives a very restricted and narrow interpretation to the rights of the copyright owner in a cinematograph film. With respect, the interpretation of the Bombay High Court in Star India Private Limited v. Leo Burneet (India) Pvt. Ltd. (supra) is not warranted on the natural and ordinary meaning of the statutory provision in Act, 1957.

84. A subsequent Bench of Bombay High Court in Zee Entertainment Enterprises Ltd. (supra) was of the view that the submissions made by producers of cinematograph films were not without force, but the learned Judge, considered himself bound by Star India Private Limited v. Leo Burneet (India) Pvt. Ltd. (supra). The relevant portion of Zee Entertainment Enterprises Ltd. (supra) is reproduced hereinbelow:-

□89. I heard them at considerable length especially in view of Mr. Dwarkadas's strenuous efforts in persuading me to the view that I am not bound by the judgment. I am bound by the judgment. Being bound by the judgment. I do not consider it necessary to refer to the extremely detailed and if I may say, with respect, well researched arguments by all the learned Counsel.

190. I must however in fairness to Mr. Dwarkadas, clarify that I do not for a moment suggest that the submissions made by him are without force. Nor do I suggest that his submissions do not require serious consideration. Indeed, this important question of law under the Copyright Act is of enormous general and public importance with drastic consequences to the entire entertainment industry and, in particular, to the film and television industry and to producers of cinematographic films.

191. I however decline the invitation to consider these questions as I consider myself bound by the judgment in Star India Pvt. Ltd. v. Leo Burnett (India) Pvt. Ltd. (emphasis supplied)

85. The Bombay High Court's view in Star India Private Limited v. Leo Burneet (India) Pvt. Ltd. (supra) is also not in consonance with the Berne Convention inasmuch as it does not protect a cinematograph work as an original work.

86. This Court is further of the view that it was not brought to the attention of the Bombay High Court that the judgment in the case of *Norowzian v. Arks Ltd and Others*, 1996 FSR 394 [extensively relied upon in the case of *Star India Private Limited v. Leo Burneet (India) Pvt. Ltd.* (supra) rendered on 24th September, 2002] had been overruled on the issue of law and the Court of Appeal in *Norowzian v. Arks Ltd. & Ors.*, (2000) FSR 363 [hereinafter referred to as "*Norowzian (No.2) (appeal)*"] had held that a film is entitled to protection as an original work.

87. This Court is of the view that the Calcutta High Court in *Shree Venkatesh Films* (supra) has rightly observed as under:-

□We are prima facie of the view that the two Single Bench decisions of Bombay High Court referred to above and the Chancery Bench decision also referred to above do not describe the law properly .

(emphasis supplied)

88. Consequently, this Court respectfully disagrees with the view of the Bombay High Court in *Star India Private Limited v. Leo Burneet (India) Pvt. Ltd.* (supra).

RELIANCE PLACED BY THE DEFENDANT ON THIAGARAJAN KUMARARAJA (SUPRA) AND TELMAK TELEPRODUCTS AUSTRALIA PTY LTD (SUPRA) IS MISPLACED

89. This Court is also of the view that the defendant's reliance on the judgment of Madras High Court in *Thiagarajan Kumararaja* (supra) is misconceived in law as it deals with the issue of infringement of copyright in a script, while the present suit is with regard to infringement of copyright in a film. Furthermore, the portion of the judgment relied upon by the learned counsel, only makes a passing reference to copyright in films without any discussion. Since the relied upon portion is obiter, it offers no assistance to the defendant.

90. This Court is also in agreement with the submissions of learned senior counsel for the plaintiff that the judgment of Australian Court is of no help to the defendant as the Australian Copyright Act, 1968 is *pari materia* with the UK Act, 1956 and is different from the scheme of the Act, 1957.

IT IS SETTLED LAW THAT WHERE INDIA IS A PARTY TO AN INTERNATIONAL TREATY, THE STATUTE WOULD BE GIVEN A □PURPOSIVE CONSTRUCTION IN FAVOUR OF THE TREATY. THIS IS FOR THE REASON THAT WHAT IS SOUGHT TO BE ACHIEVED BY THE INTERNATIONAL TREATY IS A UNIFORM INTERNATIONAL CODE OF LAW. CONSEQUENTLY, THE ACT, 1957 IS REQUIRED TO BE INTERPRETED IN CONSONANCE WITH THE BERNE CONVENTION WHICH STATES THAT A CINEMATOGRAPHIC WORK IS TO BE PROTECTED AS AN ORIGINAL WORK AND THAT THE OWNER OF COPYRIGHT IN A CINEMATOGRAPHIC WORK SHALL ENJOY THE SAME RIGHTS AS THE AUTHOR OF AN ORIGINAL WORK.

91. In the Statement of Objects and Reasons of the draft Copyright Act, 1955, it was specifically stated that one of the objects was to make adequate provision for fulfillment of international obligations in the field of copyright which India might accept. Subsequently, when the Copyright Amendment Bill 1984 was tabled in Parliament, the Minister of State had stated, "Copyright protection in India is governed by our Copyright Act, 1957. India is a member of the two international Conventions on Copyright, namely, the Berne Convention for the Protection of Literary and Artistic Works, 1971, and the Universal Copyright Convention, 1952..."

92. The definition of Berne Convention in The Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms is reproduced hereinbelow:-

"Berne Convention The Berne Convention for the Protection of Literary and Artistic Works of September 9, Protection 1886, completed in Paris on May 4, 1896, revised in Berlin on November 13, 1908, completed in Berne on March 20, 1914, revised in Rome on June 2, 1928, in Brussels on June 26, 1948, in Stockholm on July 14, 1967, and in Paris on July 24, 1971, and amended on September 28, 1979. When, in this Glossary, a reference is made to the Berne Convention, it is a reference to its latest text, that is, to the Convention as revised in Paris in 1971 and as amended in 1979.

93. India became a party to the Berne Convention on 1 st April, 1928. While Articles 1 to 21 of the said Convention came into force in India on 06th May, 1984, Articles 22 to 38 of the Convention came into force on 10th January, 1975.

94. The Berne Convention expressly states that a cinematographic work is to be protected as an original work and that the owner of a copyright in a cinematographic work shall enjoy the same rights as the author of an original work. Articles 2, 9(1), 14 and 14bis (1) read as under:-

"ARTICLE 2 (1) The expression "literary and artistic works" shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words, cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography;

photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science. xxxx xxxx xxxx xxxx (5) Collections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections.

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ARTICLE 9

(1) Authors of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works in any manner or form.

ARTICLE 14

XXXX

XXXX

XXXX

XXXX

(1) Authors of literary or artistic works shall have the exclusive right of authorizing;

(i) the cinematographic adaption and reproduction of these works and the distribution of the works thus adapted or reproduced;

(ii) the public performance and communication to the public by wire of the works thus adapted or reproduced.

(2) The adaption into any other artistic form of a cinematographic production derived from literary or artistic works shall, without prejudice to the authorization of the author of the cinematographic production, remain subject to the authorization of the authors of the original works.

(3) The provisions of Article 13(1) shall not apply. ARTICLE 14bis (1) ¶(1) Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in the preceding Article. (emphasis supplied)

95. The records of various Diplomatic Conferences adopting and revising the Berne Convention reflect that the reason for which Article 2(1) of the Convention does not explicitly state that works are intellectual creations is that this element of the concept of works was considered to be evident. This was stated explicitly at the 1948 Brussels Revision Conference where the General Report - referring to certain categories of works - emphasised as follows: "You have not considered it necessary to specify that those works constitute intellectual creations because..if we are speaking of literary and artistic works, we are already using a term which means that we are talking about.....an intellectual creation within the sphere of letters and the arts .

96. In one place, the text of the Berne Convention itself contains a direct reference to the fact that only intellectual creations qualify as works. It is not included in Article 2(1) of the Convention on "literary and artistic works" (where, as mentioned above, this was evident), but in Article 2(5) concerning collections (where it was found advisable to stress this element of the concept of literary and artistic works).

97. This Court is further of the opinion that Article 14bis (1) of the Berne Convention stipulates the width and scope and extent of copyright protection in a film. It expressly provides that a cinematographic work shall be protected as an original work and that the owner of such a work shall

enjoy the same rights as the author of an original work.

98. Article 14bis (2), on the other hand, leaves the question of who is the „owner of a cinematographic work to domestic legislation.

99. It is settled law that as far as India's approach to treaty obligations is concerned, Article 51(c) of the Constitution of India (appearing under Part IV, Directive Principles) makes the position clear as it states:-

"51. Promotion of international peace and security.--The State shall endeavour to--

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(c) foster respect for international law and treaty obligations in the dealings of organised peoples with one another;"

100. The aforesaid Article came up for interpretation before the Indian Supreme Court in Commissioner of Customs, Bangalore Vs. G.M. Exports and Ors., (2016) 1 SCC 91 wherein it has held as under:-

"23. A conspectus of the aforesaid authorities would lead to the following conclusions:

(1) Article 51(c) of the Constitution of India is a directive principle of State policy which states that the State shall endeavour to foster respect for international law and treaty obligations. As a result, rules of international law which are not contrary to domestic law are followed by the courts in this country. This is a situation in which there is an international treaty to which India is not a signatory or general rules of international law are made applicable. It is in this situation that if there happens to be a conflict between domestic law and international law, domestic law will prevail.

(2) In a situation where India is a signatory nation to an international treaty, and a statute is passed pursuant to the said treaty, it is a legitimate aid to the construction of the provisions of such statute that are vague or ambiguous to have recourse to the terms of the treaty to resolve such ambiguity in favour of a meaning that is consistent with the provisions of the treaty.

(3) In a situation where India is a signatory nation to an international treaty, and a statute is made in furtherance of such treaty, a purposive rather than a narrow literal construction of such statute is preferred. The interpretation of such a statute should be construed on broad principles of general acceptance rather than earlier domestic precedents, being intended to carry out treaty obligations, and not to be inconsistent with them.

(4) In a situation in which India is a signatory nation to an international treaty, and a statute is made to enforce a treaty obligation, and if there be any difference between the language of such statute and a corresponding provision of the treaty, the statutory language should be construed in the same sense as that of the treaty. This is for the reason that in such cases what is sought to be achieved by the international treaty is a uniform international code of law which is to be applied by the courts of all the signatory nations in a manner that leads to the same result in all the signatory nations."

(emphasis supplied)

101. In *Vishaka and Others Vs. State of Rajasthan and Others*, (1997) 6 SCC 241 the Supreme Court has held that in the absence of a suitable legislation in any sphere, international convention and norms so far as they are consistent with constitutional spirit, can be relied upon.

102. Hence, even where India is not a party to an international treaty, rules of international law which are not contrary to domestic law are followed by the courts in this country. Further, where India is signatory, the statute would be given a "purposive" construction in favour of the treaty. Even if there is a difference between the language in the statute and the corresponding provision of the treaty, the statutory language should be construed in the same sense as in the treaty. This is for the reason that in such cases what is sought to be achieved by the international treaty is a uniform international code of law which is to be applied by the courts of all the signatory nations in a manner that leads to the same result in all the signatory nations.

103. Consequently, this Court is of the opinion that the Act, 1957 is required to be interpreted in consonance with the Berne Convention which protects the film not merely as a fixation, but also as an original work. The meaning of the term 'cinematograph film' as interpreted by this Court is therefore in consonance with the Berne Convention. This view is also consistent with the judgment of the Court of Appeal judgment in *Norowzian (No.2)* (appeal).

HOWEVER, AFTER APPLYING THE TEST STIPULATED IN *R.G. ANAND V. M/S DELUXE FILMS AND ORS. (SUPRA)*, THIS COURT IS OF THE PRIMA FACIE VIEW THAT THE TWO ADVERTISEMENTS ARE NEITHER SUBSTANTIALLY NOR MATERIALLY SIMILAR.

104. However, after viewing the plaintiff's and defendant's advertisements and applying the test stipulated in *R.G. Anand v. M/s Deluxe Films and Ors. (supra)*, this Court is of the prima facie view that the two advertisements are neither substantially nor materially or essentially similar. The plaintiff's advertisement is more futuristic in comparison to the defendant's. In fact, the expressions behind both advertisements are different. While the plaintiff's advertisement's emphasis is on the manufacturing process of the tyre and its radial design, the defendant's advertisement seeks to display the durability of the tyre by showing that it rides well on all terrains.

105. The similarities pointed out by learned senior counsel for the plaintiff such as the presence of a robotic arm or a red motorbike are not enough to show that the substance, the foundation and the

kernel of the defendant's advertisement is by and large a copy of the plaintiff's advertisement.

106. Moreover, as the present suit has been filed more than one year after the defendant's advertisement had been first aired in September, 2016, this Court is of the view that the plaintiff is not entitled to any interim order.

107. Consequently, the present application for injunction is dismissed, but without any order as to costs.

CS(COMM) 753/2017 List on 19th July, 2019 before the regular Roster Bench.

MANMOHAN, J JULY 01, 2019 js/ka/rn