

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Date of decision: 17th May, 2017.**

+ **CS(COMM) 323/2017**
(OLD No.CS(OS) 324/2007)

KANUNGO MEDIA (P) LTD. Plaintiff

Through: Ms. Meera Chature Sankhari and Ms.
Shruti Verma, Advs.

Versus

RGV FILM FACTORY & ORS. Defendants

Through: None.

CORAM:
HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. The plaintiff Kanungo Media Pvt. Ltd. on 20th February, 2007 instituted this suit to restrain the defendant No.1 RGV Film Factory, defendant No.2 Adlabs Films Ltd. and defendant No.3 Super Cassettes Ltd. (T-Series) from using the brand name and title 'NISHABD' for their film on the ground of the same being deceptively similar to the film 'NISSHABD' of the plaintiff and for ancillary reliefs.

2. The suit came up before this Court first on 21st February, 2007 when the counsel for the defendants No.1&2 appeared on caveat and accepted summons of the suit; since the film of the defendants was scheduled to be released on 2nd March, 2007, the application for interim injunction was listed for hearing on 23rd February, 2007.

3. Vide detailed judgment dated 27th February, 2007 on the application of the plaintiff for interim injunction, the interim injunction sought was

refused.

4. FAO(OS) No.68/2007 preferred against the order of refusal of interim injunction was on 19th April, 2007 dismissed as withdrawn with liberty to the plaintiff to, on the grounds of the defendants having concealed material facts before the learned Single Judge, seek appropriate orders from the learned Single Judge.

5. The plaintiff thereafter sought amendment of the plaint and which was allowed on 26th November, 2007. The defendant No.1 filed a written statement and which was adopted by the defendant No.2 (vide order dated 27th November, 2009) and though at one stage time was taken to seek instructions, whether the same written statement could be adopted on behalf of the defendant No.3 also but the same was not done and since none appeared for the defendant No.3, the defendant No.3 Super Cassettes Ltd. was on 25th October, 2010 proceeded against *ex-parte*. The plaintiff filed replication to the written statement of the defendants No.1&2.

6. On the pleadings of the parties, on 25th October, 2010, the following issues were framed in the suit and the suit put to trial:

- “(a) *Whether the plaintiff is the prior user of the word ‘NISSHABD’ as the title/name of a feature film, if so, whether it has acquired such uniqueness and distinctiveness in the user of the said word ‘NISSHABD’?*
OPP
- (b) *Whether the defendant is passing off by using the word ‘NISSHABD’ or any other deceptively similar word with a view to cause confusion among the film enthusiasts, if so, to what effect? OPD*
- (c) *Whether the plaintiff is entitled to permanent injunction as prayed for? OPP*

- (d) *If the issue no. (c) is decided in affirmative, whether the plaintiff is entitled to damages which have been quantified by the plaintiff at Rs.25,00,000/-? OPP*
- (e) *If the issue is issue no. (d) is decided in affirmative, whether the plaintiff is entitled to payment of interest, if so at what rate and for what period? OPP*
- (f) *Whether, the delay in instituting the suit tantamount to acquiescence on the part of the plaintiff and consequently disentitle him to any relief as prayed for? OPD*
- (g) *Relief.”*

7. The plaintiff examined two witnesses as PW-1 and PW-2 and whose examination-in-chief was completed on 9th October, 2013 when the counsel for the defendants No.1&2 sought adjournment on the ground that he had no instructions as to how to proceed further with the matter. On 14th March, 2014, the counsel earlier appearing for defendants No.1&2 sought discharge on the ground that he was not receiving instructions from defendants No.1&2 and was directed to move an appropriate application. However the right of the defendants No.1&2 to cross-examine PW-1 was closed. Vide order dated 23rd July, 2014 on the application of the counsel earlier appearing for the defendants No.1&2, the counsel was discharged.

8. The plaintiff examined another witness as PW-3 and closed its evidence. Vide order dated 6th January, 2015, the defendants No.1&2 were also proceeded against *ex-parte*.

9. The plaintiff filed yet another application for amendment of the plaint by adding averments with regard to the fact of registration of the plaintiff's trade mark during the pendency of the suit. The said application was dismissed vide detailed judgment dated 20th July, 2015 observing that the

suit as filed in the year 2007 was on the ground of passing off but was being sought to be converted into a suit for infringement and which could not be permitted and the subsequent registration in favour of the plaintiff furnished a fresh cause of action to the plaintiff on which the plaintiff could file a fresh suit.

10. The plaintiff preferred FAO(OS) No.588/2015 against the order of dismissal of its application aforesaid for amendment and which was allowed vide order dated 12th January, 2016. The order allowing the appeal records the presence, besides the counsel for the plaintiff, also of the counsel for the defendant No.3.

11. Owing to the amendment aforesaid, notice was again ordered to be issued to the defendants No.1&2. The defendant No.2 Adlabs Films Ltd. failed to appear despite service on 19th August, 2016 and the right of the defendant No.2 to file written statement to the amended plaint was closed vide order dated 10th January, 2017. The defendant No.1 could not be served by ordinary means and was vide order dated 13th January, 2017 permitted to be served by publication and failed to appear despite publication and is now proceeded against *ex-parte*. The defendant No.3 who had appeared before the Division Bench as aforesaid also did not file any written statement to the amended plaint and its right to file written statement was closed on 2nd September, 2016 and the counsel for the defendant No.3 also stopped appearing.

12. In this state of affairs, the suit is today listed. None appears for any of the defendants. The defendants, in pursuance to the amendment allowed of the plaint vide order dated 12th January, 2016 in FAO(OS) No.588/2015, are

again proceeded against *ex-parte*.

13. The need to relegate the plaintiff to *ex-parte* evidence pursuant to the amendment aforesaid of the plaint is not felt owing to the dicta in ***Satya Infrastructure Ltd. Vs. Satya Infra & Estates Pvt. Ltd.*** 2013 SCC OnLine Del. 508. I have heard the counsel for the plaintiff.

14. The case of the plaintiff as per the last amended plaint is (i) that the plaintiff in the year 2005 had produced a feature film titled 'NISSHABD' which though was not released commercially owing to paucity of funds but was screened at various international film festivals where it won several awards; (ii) that the word 'NISSHABD' has acquired such distinctiveness that any use thereof by any person or company was bound to cause confusion amongst the film enthusiasts and members of the public; (iii) that such use will result in conveying an impression that a movie with the title 'NISSHABD' is the production of the plaintiff company or connected with the plaintiff company; (iv) that it came to the knowledge of the plaintiff that the defendant No.1 RGV Film Factory carrying on business of film / video production had applied to the Central Board of Film Certification (CBFC) with respect to a film with the title 'NISHABD'; (v) that the defendant No.2 Adlabs Films Ltd. had financed/invested in the said movie and the defendant No.3 Super Cassettes Ltd. had acquired audio rights in the said movie; (vi) that the use by the defendants of the title 'NISHABD' for their film will lead to confusion, even though the contents of the movie of the plaintiff and of the defendants are poles apart; (vii) that the defendants having knowledge of the accolades won by the plaintiff's film are trying to exploit the same; (viii) that the plaintiff on 2nd February, 2007 applied to the Trade Mark Registry to

get both 'NISSHABD' and 'NISHABD' registered as marks over which it had rights; (ix) that the plaintiff during the pendency of the suit had acquired registration of 'NISSHABD' as well as 'NISHABD' with effect from 2nd February, 2007 in Classes 9 & 41; (x) that the search conducted by the plaintiff revealed that the defendants had not applied for registration of the trade mark 'NISSHABD' or 'NISHABD'; (xi) that if both the films 'NISSHABD' and 'NISHABD' are screened together, it is bound to create total confusion causing huge losses to the plaintiff and severely prejudicing the rights of the plaintiffs; (xii) that the defendants, besides being liable for the tort of passing off, are also liable for infringement of the trade mark of the plaintiff; (xiii) that there can be no genuine reason for the defendants to use the name 'NISHABD' as a brand name for its production except with the object of misleading and confusing the public into thinking that the film of the defendants is in some way associated or connected with the plaintiff and thereby reap the benefit of the reputation acquired by the plaintiff.

15. The defendants No.1&2 contested the suit as originally filed for relief on the ground of passing off only, on the following pleas (a) that the film of the plaintiff is in Bengali, while the film of the defendants is in Hindi language; (b) that the films in different languages have different viewership; (c) that the films in Bengali have a limited viewership and market; (d) that the film of the plaintiff though claimed to have been completed in May, 2005 was admittedly not commercially released; the film of the defendants was commercially released worldwide on 2nd March, 2007; (e) that neither of the two films could be passed off for another; (f) that a CBFC certificate for a particular name for a regional language cannot be permitted to monopolise the name for the entire country; (g) that the plaintiff as far back as on 8th

May, 2006 had written to Western India Film Producers' Association (WIFPA), the guild which approves the names, making an objection to the use of the name 'NISHABD' by the defendants; (h) that on the very same day i.e. 8th May, 2006, WIFPA wrote back to the plaintiff that in view of the difference in language of the two movies, the name could be used by the defendants; (i) that the plaintiff has suppressed the said relevant facts from the suit; (j) that the plaintiff had neither challenged the decision of WIFPA nor made WIFPA a party in the suit; (k) that on 16th June, 2006, a notice was issued by the Association of Motion Pictures and T.V. Programme Producers regarding use of the name 'NISHABD' by the defendants stating that any person having any objection may notify the same within seven days; no objection was made by the plaintiff; it seems that since the plaintiff was already satisfied with the answer of WIFPA, the plaintiff choose not to object; (l) that the defendants had thereafter proceeded to make the film, spending crores of rupees and the suit was filed at the last minute with *mala fide* motive; (m) that "film world would not even know that the movie named 'NISSHABD' exists"; (n) that there is no similarity and connection between the two movies; (o) that the plaintiff itself in the plaint has claimed its film to have won accolades as 'NISSHABD REACHING SILENCE' and not just 'NISSHABD'; (p) that owing to the differences in language, the story line, actors, producer, director, there is no possibility of confusion; (q) that the film of the plaintiff if at all has any reputation is for a Bengali film having limited audience while the film of the defendants in Hindi language with much wider publicity and audience; (r) that CBFC does not certify or register a name but only issues a certificate for censorship for a title already registered; CBFC does not maintain a register of names; it maintains a

register of certificates granted; (s) that the defendants did not even know of the film of the plaintiff; (t) that the plaintiff had applied for registration much after the defendants acquired huge name and reputation for their feature film 'NISHABD'; (u) that the applications for registration were with dishonest intention; (v) that classes 9 & 41 in which registration was sought are for packaging materials and services etc. and for this reason also no question of infringement of trade mark arises; (w) that the plaintiff can only gain from the wide publicity and promotion carried out by the defendants of their film 'NISHABD'; (x) that the plaintiff has not shown any expenditure spent on production or promotion of its film 'NISHABD'; on the other hand, the defendants have spent Rs.8 crores on production and Rs.1 crore on promotion of their film 'NISHABD'; (y) that the defendants' feature film 'NISHABD' was widely published in the media from May, 2006 and the plaintiff, who claims to be associated with the film industry, must have known but chose not to object; (z) that adoption by the defendants of the title 'NISHABD' for their film is not dishonest.

16. The plaintiff, in its replication to the written statement of the defendants filed prior to the last amendment of the plaint, besides reiterating its case has pleaded (I) that the defendants as on 21st February, 2007, when the suit came up first before this Court, had not even acquired the certificate from CBFC, which was granted only on 22nd February, 2007 and which fact was concealed from the Court; (II) that the plaintiff's film was released commercially on 16th March, 2007 at Nandan, Kolkata; one of the main reasons for seeking a temporary injunction and stay of release of the Hindi movie was that it was clashing with the release of the plaintiff's movie; (III) that in view of the reply of WIFPA, there was no point of writing further to

WIFPA and the plaintiff also thought that it was premature to take any legal action on the defendants at that stage because the film of the defendants was at production stage only and its title could change; (IV) that the plaintiff was also overawed with the prospect of taking a fight against the “mighty Bollywood industry”; (V) that the only course left with the plaintiff was the CBFC, believing that the same title would not be given to anyone else in the name of fair play; (VI) however when the plaintiff saw massive TV publicity showing clippings of the defendants’ film, the plaintiff got concerned and realised that if it allowed another film with similar title released prior to release of its film, it ran the risk of losing its title ‘NISSHABD’ as the defendants would positively prevent the plaintiff from using the similar title; (VII) that the plaintiff also realised that if it decided to dub its film in any other language, it will have to seek the CBFC’s approval and CBFC would certainly not allow it to use ‘NISSHABD’ as its Hindi title as already a similar sounding title exists; (VIII) that it is with this realisation that the plaintiff decided to approach the Court; (IX) that the plaintiff was under a *bona fide* belief that CBFC would block the title of the defendants’ film owing to having already certified the plaintiff’s film; (X) that the defendants’ plea of ignorance of plaintiff’s film shows “total arrogant indifference to regional filmmakers who are trying to produce good cinema”; (XI) that ‘NISSHABD’ is the title of the plaintiff’s film and “Reaching Silence” is the English translation thereof—films screened abroad do generally carry a translated name which could be in English or other languages; (XII) that similar sounding names had in fact created confusion in the minds of the public and distributors—after the dismal box office crash of the defendants’ film ‘NISHABD’, no distributor is ready to take on the plaintiff’s movie and

screen it, as they fear that no audience will come to see this classic film thinking it to be the flopped film.

17. Though the orders on the application for interim relief have no bearing at the time of final decision of the suit but in cases of present nature where evidence mostly comprises of self serving statements of the witnesses, it is not improper to look at the reasons which prevailed for granting or refusing interim relief and to see whether anything to the contrary has emerged in evidence. Supreme Court also in ***Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.*** (2002) 2 SCC 147 has held that evidence in suits pertaining to infringement of trade mark and/or of the genre of passing off is not of much relevance and the Court has to form its own opinion. The same observation is to be found in the judgment of this Court in ***Larsen & Toubro Vs. Lachmi Narain Trades*** (2008) 149 DLT 46 (DB) and ***Staar Surgical Company Vs. Polymer Technologies International*** 2016 SCC OnLine Del 4813. I have thus proceeded to look into the reasons which prevailed with this Court in refusing interim injunction to the plaintiff and find this Court to have reasoned (i) that the case of the plaintiff is of appropriation of a title and not of usurpation of the work of the plaintiff by the defendants; (ii) that like human beings, literary work produced by the author or the work of entertainment produced by a producer needs a title to be identified; (iii) that the law in India on the subject is not much developed; (iv) that American Courts have taken a uniform view that title alone of a literary work cannot be protected by Copyright Law; (v) that protection of literary titles lies in the field of trade mark and unfair competition; (vi) that titles may relate to two types of works i.e. titles of single literary works and titles of series of literary works; (vii) that titles of series of books, periodicals

or newspapers do function as a trade mark to indicate that each edition comes from the same source as the others and therefore such titles are even registrable as trade mark; (viii) that such 'series title' enjoy the same protection as usual trade mark; (ix) that the title of a newspaper serves a trade mark function to the reader who is shopping among competing newspapers; (x) that cases of series of books with the same title are also known; (xi) that this trend has also picked up in television serials which run into hundreds of episodes; (xii) of late there have been cases of motion pictures made in series—the trend started in Hollywood with 'The Godfather', 'Rocky', 'Die Hard', 'Mission Impossible', 'The Matrix', 'Jurassic Park' etc. and has percolated in Indian film industry as well with the movies 'Hera Pheri – Phir Hera Pheri', 'Dhoom – Dhoom II' and 'Munna Bhai MBBS – Lage Raho Munna Bhai'; (xiii) that the titles of single literary work do not enjoy trade mark protection but in order to become entitled to this protection, it is necessary to prove that such a title has acquired secondary meaning i.e. the title is capable of associating itself with the particular work or source; (xiv) that only if it is so would the likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential patrons arise; (xv) that the test of secondary meaning for literary titles is essentially one of determining whether in the minds of a significant number of people the title in question is associated with a single source of the literary work; (xvi) that each literary work is a specific, separate and unique commercial item and not as one product among many competing products—each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works; (xvii) that the evidence necessary to establish secondary meaning of literary work is

evidence of an audience educated to understand that the title means the work of a particular artist; (xviii) that relevant evidence from which secondary meaning for a literary title may be inferred as a question of fact includes (1) the length and continuity of use; (2) the extent of advertising and promotion and the amount of money spent; (3) the sales figures on purchases or admissions and the number of people who bought or viewed the work; and (4) the closeness of the geographical and product markets of the plaintiff and defendants; (xix) that the plaintiff on 8th May, 2006 was made aware by WIFPA that the title ‘NISSHABD’ was free for registration in languages other than Bengali and even for “T.V. serial or Music Album” and as the defendants’ proposed film was in Hindi language, it could be registered with WIFPA; (xx) notwithstanding the same, the plaintiff remained silent and did not take any action; (xxi) that the reason given of the plaintiff’s inability to file the case earlier, of financial difficulties, does not inspire confidence; (xxii) that the plaintiff did not even lodge a protest with WIFPA or with any other authority including CBFC; (xxiii) that such silence on the part of the plaintiff amounted to giving up its rights, if any; (xxiv) that the plaintiff thereby allowed the defendants to go ahead with the production of the movie ‘NISHABD’; (xxv) that the defendants in April, 2006 announced intention to produce the film by the name ‘NISHABD’; in July, 2006, the Association of Motion Pictures granted a certificate to the defendants for registering the feature film with this title in India; (xxvi) that on 18th July, 2006, the said Association of Motion Pictures issued a circular which was sent to all producer members; (xxvii) that various articles regarding the movie appeared in the media; (xxviii) that the theme of the defendants’ film was bold and all the articles published with respect to the film focused on that theme; (xxix)

that the defendants went about launching a website about the movie and selling the music rights; (xxx) that since December, 2006, trailers of the defendants' film had been running in various cinema halls; posters and publicity material of the film have also been distributed; (xxxi) that owing to the lead cast of Amitabh Bachchan and Jiah Khan in the defendants' movie, the publicity of the defendants' movie was immense; (xxxii) that the plaintiff by its inaction and allowing things to happen in such manner, slipped an opportunity of enforcing its rights as a senior user of the title; (xxxiii) that owing to the immense publicity of the defendants' film, the film of the defendants was known more than that of the plaintiff; (xxxiv) that the plaintiff thus cannot claim that the title 'NISHABD' is associated only with its movie or that the public does not know about the defendants' movie; (xxxv) that as of then, the claim of the plaintiff's movie title 'NISSHABD' was blurred in comparison to the defendants' movie title 'NISHABD'; (xxxvi) that the plaintiff's film is a documentary and in Bengali language whose viewership is substantially less than a Hindi film; and, (xxxvii) that the film festivals wherein the plaintiff's film had achieved critical acclaim also have a limited viewership and of a particular category.

18. I have scanned the affidavits by way of examination-in-chief of PW-1 Jahar Kanungo, Director of the plaintiff and PW-2 Nitin Kumar Rajput, Chartered Accountant of the plaintiff and the statement of PW-3 Mukesh Kumar, Office Assistant, CBFC to see whether the plaintiff in its evidence has satisfied any of the tests which were laid down in the judgment supra on the application for interim relief.

19. PW-1 in his affidavit by way of examination-in-chief has merely

reiterated and proved the contents of the plaint and replication relating to the production of the film 'NISSHABD' of the plaintiff and which in any case were not specifically denied in the written statement of the defendants No.1&2. In addition PW-1 has purported to prove as Ex.P-25 the amount spent on production of its film 'NISSHABD'. However the said document having not been proved in accordance with law was not admitted into evidence. Though PW-1 has also parroted the title 'NISSHABD' to have acquired distinctiveness but the same does not amount to evidence thereof.

20. PW-2 in his affidavit by way of examination-in-chief has proved expending of €121,000 by the plaintiff on production of the film titled 'NISSHABD' and of Rs.45,76,398/- on production and distribution of the film within India, till 31st March, 2009.

21. PW-3 has proved the certificates issued by CBFC for the film of the plaintiff and the defendants.

22. The counsel for the plaintiff during the hearing has handed over the photocopies of the certificates dated 2nd March, 2011 of registration of the name marks 'NISSHABD' and 'NISHABD' with effect from 2nd February, 2007 in Class 9 with respect to scientific, nautical, surveying and electric, photographic, cinematographic, apparatus for recording, transmission or reproduction of sound or images; magnetic data carrier, recording discs, CDs, DVDs, CD ROMs, DVD ROMs, VHS Tapes, audio tapes (prerecoded) and in Class 41 relating to entertainment and which are taken on record.

23. I have considered, whether in the light of the evidence led any different opinion from that taken at the stage of interim application is to be taken. It is not the case of the counsel for the plaintiff that there is any

change in law in the interregnum or that the application of law at the interim stage was erroneous.

24. As would be obvious from the aforesaid narrative, the plaintiff has not proved anything new in the evidence. There is absolutely no evidence of the title 'NISSHABD' of the plaintiff having acquired any distinctiveness or of the viewership of the film of the plaintiff or of the collections from the commercial release claimed in the replication, of the film of the plaintiff. I fail to see as to how in this state of affairs any final relief also can be granted to the plaintiff. Moreover, the plaintiff by its plea in the replication, of the film of the defendants having flopped and being a failure at the box office, has also admitted that the defendants have not benefited anything by adopting the name of the film of the plaintiff. The question of the plaintiff being entitled to any damages thus also does not arise. The registration obtained by the plaintiff during the pendency of the suit cannot also thus be of any avail to the plaintiff. The plaintiff has not established any use by the defendants of the trade mark post the grant of registration on 2nd March, 2011 to the plaintiff. Though it cannot be said that the film of the defendants has ceased to be in circulation as even old films continue to be screened on television or in some towns or for some other special reason but it cannot be said for the reasons already recorded in the judgment at the interim stage that any case of infringement in future also is made out.

25. Resultantly, the suit of the plaintiff is dismissed.

26. I have wondered about the aspect of costs. Though the defendants were proceeded *ex-parte* after the denial of interim injunction but the fact remains that the plaintiff did drag them to the Court and inspite of being

unsuccessful in obtaining interim injunction persisted with the suit for the last over ten years, without making any effort to prove its case. Litigants cannot be permitted to so take the time of the Court without even making out any semblance of a chance of succeeding. Such conduct is to be discouraged with imposition of costs payable to legal aid or to other like cause. However, in the light of the fact that the plaintiff produced its film with financial assistance from “Fonds Sud Cinema” grant awarded by the French Government for production of feature film and which feature film won international accolades and considering that the plaintiff otherwise does not appear to have had any commercial or critical success thereafter, I refrain from doing so.

Decree sheet be drawn up.

RAJIV SAHAI ENDLAW, J.

MAY 17, 2017

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(Corrected and released on 31st May, 2017).