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IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment delivered on: 10.01.2018

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FAO 235/2017 & CM APPL. 19611/2017

M/S RAVINDER SINGH & SONS

..... Appellant

Through: Mr. M.K. Miglani, Advocate and
Mr. Jithin M. George, Advocate.

Versus

M/S EVERGREEN PUBLICATIONS

(INDIA) LTD & ANR.

..... Respondents

Through: Mr. Sushant Mahapatra, Advocate and
Mr. Aruni Poddar, Advocate.

CORAM:

HON'BLE MR. JUSTICE NAJMI WAZIRI

NAJMI WAZIRI, J (Oral)

1. This appeal impugns an interim injunction dated 15.04.2017 restraining the appellant from printing, publishing, offering for sale, selling or otherwise dealing, directly or indirectly, question Papers of ICSE Class-X Examinations.

2. The facts of the case are that, the respondent had purchased the copyrights of question papers for the years 2015, 2016 & 2017 for all subject of ICSE Class-X Examinations for an amount of Rs. 1.35 crores. The respondent's publication was titled: "Examination Question Papers ICSE March 2006 (under arrangement with) The Council for the Indian School Certificate Examinations New Delhi" (all rights reserved). The book was priced at Rs. 25. It only had question papers with no model answers or any

guidance to answering them.

3. For granting the injunction, the impugned order has reasoned as under:-

*“20. I have gone through the record also and the material provided on the record by both the parties. It may be seen that the judgment **Chancellor Masters and Schoolers of University of Oxford Vs Narender Publishing House in I.A. 9823/2005,51/2006 and 647/2006 in CS (OS) 1656/2005** as relied by the defendant is pertaining to fair dealing and fair use of the articles.*

*21. It is seen that in case **Syndicate of the Press of the University of Cambridge on behalf of the Chancellor, Masters and School Vs. B.D. Bhandari & Anr. (2011(47) PTC 244 (Del)(DB)**. Some of the questions of that English Grammar of Martin Hewings were picked from the exercise and answers were prepared by using the same textbook. On the other hand, in the present case the infringed publication is containing all the questions and answers of the plaintiff. It is further seen that the work of defendant in present case cover all the questions of plaintiff which can be held as a substitute for the plaintiff work which also cannot be said that defendant has even complied the alleged infringed work with sufficient efforts skill and creativity and further the purpose is also not different. In the present case there is Ten Year question bank for which plaintiff has copyright, however defendant without any efforts and creativity took all the questions word by word and provided their own answers to such questions. Such a copy work can be fairly held as infringed work. As such the ratio of the case law as relied above by Ld. Counsel for defendant is not applicable in the present case. The case law relied upon by Ld. Counsel for defendant no. 1 though hold correct position of law, however are not applicable under the facts and circumstances of the present case.*

*Ld. Counsel for plaintiff further relied upon a case titled as **Solochana Amma Vs. Narayanan Nair** decided by Hon'ble Supreme Court of India on 24.09.1993 wherein Section 11 of CPC elaborately discussed. Section 11 of CPC embodies the rule of conclusiveness as evidence or bars as a plea as issue tried in an earlier suit founded on a plaint in which the matter is directly and*

substantially in issue and became final.

22. *The objection of Ld. Counsel for the defendant qua territorial jurisdiction of this Court has been argued extensively by both the Ld. Counsels. Both the Ld. Counsels have relied upon judgment **Indian Performing Rights Society Ltd. Vs. Sanjay Dalia and Ors.** The law laid down in the aforesaid judgment had different facts than the present one. In that case, none of the defendants were residing or working for gain at the place where the jurisdiction was invoked. However, in the present case, defendant no.3 is based in Delhi and hence the plaintiff rightly invoked the territorial jurisdiction in Delhi.*

*It is the case of the defendant that defendant no.3 has merely been made a proforma party of the suit. It is further argued that defendant no.3 is a body established under the Delhi Education Act. However, there is an RTI reply issued by Delhi Government, filed on record, wherein it is stated that the Government has no control over the defendant no.3 and defendant no.3 is a private Board. To support their arguments, Ld. Counsel for the plaintiff relied upon case law **National Stock Exchange of India Ltd. Vs. Central Information Commission & Ors., Pawan Kumar Vs. State of Punjab & Ors., Rahul Mehra and Anr. Vs. UOI, Shiv Kumar Akela Adv. & Ors. Vs. The Registrar Society Funds and Chits under the Societies Registration Act 1860 & Ors. And Bhawna Rishi Cooperative Housing Building Society Vs. A.P. Information Commission & Anr.***

23. *Ld. Counsel for defendant no.3 argued that defendant no.3 has granted exclusive right for the printing and publication of question papers pertaining to year 2015 to 2017 to the plaintiff who has an exclusive right to do so. Any infringement by anybody in any manner is in gross violation of the copyright granted to the plaintiff in view of MOU executed between defendant no.3 and plaintiff. It is further argued by Ld. Counsel for defendant no.3 that defendant no.3 has no objection if the present application of plaintiff is allowed and defendant no. 1 & 2 are restrained from printing and publishing the question papers as prayed by the plaintiff.*

Arguments raised by Ld. Counsel for defendant no.3 supports the prayer of interim injunction made in the present application by

the plaintiff.

24. The objection as taken by defendant with regard to exclusive license of the plaintiff in view of MOU dated 20.04.2015, cannot sustain as defendant no.3, the board itself submitted in the Court that they have entered into MOU with plaintiff with regard to the question papers for ICSC Board throughout India.

25. The further objection of the defendant no.1 is that provisions of Section 17(l)(dd) and 54(b) have no application to the present case in as much as the alleged works are not Government works. It is further argued that no particulars are given as to what is the Constitution of defendant no.3 and who are the members and if they are from the Government of Delhi or Central Government.

*26. It is an admitted fact on behalf of defendant no.3 that defendant no. 3 is a society registered under the Societies Registration Act, 1960 and recognized under Delhi Education Act as a Statutory body to conduct the examination at par with CBSE and has been constituted to conduct examinations of ICSE and ISC Board and as such covered under definition of Sections 17(dd) of the Copyright Act, 1957. From the averments of defendant no.3 it is evident that defendant no.3 is discharging public function of conducting examination under Delhi Education Act 1973 and thus it has to be considered as public authority. Since defendant no.3 falls under Public Authority, hence Section 17(dd) of Copyright Act applies to it and as per the aforesaid act in case of a work made or first published by or under the directions or control of any public undertaking such public undertaking shall in the absence of any agreement to the contrary shall deem as the first owner of the copyright therein. The plea of plaintiff to the aforesaid objection that if a private body is discharging public function it has to be considered as public authority. This contention of plaintiff is further fortified with case law titled as *Rupender Kashyap Vs. Jiwan Publishing*.*

27. The other objection qua the present application of Ld. Counsel for the defendant that the question papers of defendant no.3 cannot be held literary work and subject to copyright. To substantiate his arguments, Ld. Counsel for the defendant submitted that the work of defendant is totally different from the work of

plaintiff. It is an idea only suggested to the students to prepare their answers. To support his arguments, Ld. Counsel for defendant relied upon judgments **Chancellor Masters and Schoolers of University of Oxford Vs Narender Publishing House in I.A. 9823/2005, 51/2006 and 647/2006 in CS (OS) 1656/2005**, **Syndicate of the Press of the University of Cambridge on behalf of the Chancellor, Masters and School Vs, B.D. Bhandari & Anr. (2011(47) PTC 244 (Del)(DB).**

Ld. Counsel for defendant submitted that picking of question from the exercises of prescribed books and reproducing the same in the form of guide with detailed answers, does not amount to infringement.

28. On the other hand, Ld. Counsel for plaintiff argued that the work of plaintiff has a copyright. Merely, doing labour or spending some amount cannot be held a creative work. To substantiate his arguments, Ld. Counsel for the plaintiff relied upon case law **Rupender Kashyap** (supra).

The law laid down in **Rupender Kashyap** case, it is held that if there is a copyright in the question paper, the publishing answer book using such question papers, will amount to infringement of copyright.

29. In view of my above discussion, I am of the opinion that plaintiff has prima facie established a case for interim injunction in his favour in view of aforementioned observations and balance of convenience lies in the favour of the plaintiff and the plaintiff has shown the irreparable loss that is caused to him if the interim injunction is not granted. Consequently, the application under Order XXXIX Rule 1 and 2 CPC moved on behalf of plaintiff is allowed. Defendant no. 1 and 2 by themselves, through their agents, servants, dealers, stockiest, representatives, sellers, distributors and all other persons acting on their behalf are restrained from printing, publishing, offering for sale, selling or otherwise dealing, directly or indirectly, in "Examination Question Papers for ICSE Class-X Examinations" conducted by defendant no.3 till the disposal of the suit.

30. Since, the application u/O XXXIX Rule 1 and 2 decided in favour of the plaintiff, therefore, the application of the defendant u/O

XXXIX Rule 4 is dismissed consequently.

31. Nothing in this order shall be construed as my observations on the merits of this case. Application stands disposed off accordingly.”

4. The said order has been impugned by the defendant (present appellant) on the ground that the guidebook offered by it takes forward the original work, course and syllabus prescribed by the ICSE Board. Hence, the defendant's guide book is not limited to the questions published by the plaintiff. In this regard, he relies upon a judgment of a Division Bench of this Court in ***Syndicate of the Press of The University of Cambridge on Behalf of the Chancellor, Masters and School Vs. B.D. Bhandari & Anr.*** 2011 (47) PTC 244 (Del.) (DB). The facts of that case were:-

“2. The appellant, Cambridge University Press, the printing and publishing house integratedly attached to the University of Cambridge is one of the oldest printing and publishing houses of the world. ‘Advance English Grammar by Martin Hewings’, one of the leading publications of the appellant and the subject matter herein, has been prescribed and used by many universities all over the Globe including India. This work is also prescribed in Guru Nanak Dev University, Amritsar, Punjab for the students of B.A. Part I, II, III. The grievance of the appellants is that the respondents are publishing and selling books, as titled aforementioned, which do contain illegal and unauthorized ad verbatim reproduction of literary content of the grammar exercises and keys thereto given in units 1 to 120 of the appellants' publication titled ‘Advance English Grammar by Martin Hewings’.

3. Raising this grievance, the appellant filed the aforesaid Suit on the Original Side of this Court to restrain the respondents herein from selling books published by them entitled MBD English Guide B.A./B.Sc./B.Com Part-I (Guru Nanak Dev University), MBD English Guide B.A./B.Sc./B. Com

Part - II (Guru Nanak Dev University) and MBD English Guide B.A./B.Sc./B. Com Part - III (Guru Nanak Dev University) on the premise that these books contained illegal and unauthorized reproduction of literary content of the appellants' publication titled 'Advance English Grammar by Martin Hewings'. Along with the Suit, the appellants also filed application under Order 39 Rule 1 and 2 seeking ad interim injunction.

4. The appellants succeeded in obtaining an ex parte interim injunction to restrain the respondents from utilizing and incorporating the ad verbatim text from the appellants' work, which was later on also confirmed during the pendency of the Suit. On the basis of pleadings, the following issues were framed in the Suit:

“1. Whether plaintiff No.1 is the owner of the copyright of the literary work titled “Advance English Grammar”? OPP

2. Whether the defendants have reproduced verbatim plaintiffs' work titled “Advance English Grammar” in their three publications titled “MBD English Guide” one each for B.A., Part I, II and III? If yes, whether complete set of exercises and answer keys, scheme of exercises, answers and placement of topics have been all reproduced?

3. Whether reproduction of plaintiffs' work by the defendants amount to infringement of the plaintiff's copyright in the said work?

4. Whether plaintiffs are entitled to the relief of permanent injunction?

5. Whether plaintiffs are entitled to claim of damages against the defendants? If yes, to what amount of damages, the plaintiffs are entitled to?

6. Whether plaintiffs are entitled to rendition of accounts of profits?

7. Whether plaintiffs are entitled to delivery up of all infringing material including plates?

8. Whether the activities of the defendant fall under the concept of fair dealing under the Copyright Act, 1957? OPD

9. Relief.”

5. In FAO (OS) No. 458/2008 titled: ***The Chancellor Masters & Scholars of the University of Oxford vs Narendra Publishing House & Ors.***, the issue was:-

“90. This appeal is preferred by the appellant/plaintiff against the interim order dated 17.09.2008 passed by the learned Single Judge whereby *ex parte* injunction granted in favour of the appellant vide orders dated 05.12.2005 has been vacated. As is clear from the Cause Title itself, the appellant is trading as Oxford University Press (hereinafter referred to as ‘the Press’), which was established in 15th Century by the University of Oxford and has innumerable publications with worldwide circulation. It is *inter alia* claimed that the Press has become household name through a diverse publishing programme that includes scholarly works in all academic disciplines, Bibles, music, school and college textbooks, children's books, materials for teaching English as a foreign language, business books, dictionaries, reference books, journals and electronic publishing. It is also claimed that it has developed substantial reputation and goodwill not only in England, but also in all parts of the world including India where it first set up its establishment in the year 1912 in Bombay (now Mumbai). Led by a team of highly qualified and committed editorial, market research, design and production professions, the Educational Division of Oxford University Press, India offers a wide range of books/resources from Kindergarten through to grade twelve in various disciplines such as English language, Science, Mathematics, Environmental Studies, Social Sciences, General Knowledge, Computer Education, Value Education, Humanities, Economics, Art and Craft. The complete range of books prescribed by various School Education Boards such as CBSE, ICSE and other State Boards is an added feather to the appellant's growing list of titles. The present case concerns one such Mathematics book prescribed by the Jammu and Kashmir State Board of

Education for Class XI.

It is governed by stringent quality parameters for which the appellant is well-known all over the world. The Press textbooks are published and revised after a thorough survey of the market for current syllabus, trends and curriculum changes in various disciplines as per the guidelines prescribed by the various examination bodies, such as the CBSE, ICSE and various State Boards. This is done to ensure conformation both to the requirements of the various examining bodies and to the changing times. This is achieved, inter alia, by tapping the modifications required in the existing courses and gathering first-hand feedback on the existing courses from teachers, educators and decision makers. The books of the appellant/Press not only incorporate and reflect the latest teaching methodologies on the basis of the inputs of teachers, but also ensure effective classroom application, inasmuch as it takes into account the views of both teachers and need of the students. It may be worth mentioning the Press brings authors and teachers together to share theories and ideas and to give sound advice based on a real understanding of teaching needs and helps create better textbooks by a combined and concerted effort of all.

91. In the present case, we are concerned with two books of the appellant titled “Oxford Mathematics Part A” and “Oxford Mathematics Part B” (hereinafter referred to as ‘the subject works’). These textbooks meant for the students of Class XI following the course structure prescribed by the Jammu & Kashmir State Board of School Education.

93. The grievance of the appellant is that knowing the importance and imperative need of the subject works to the students in Jammu & Kashmir and knowing that a copy of the prescribed book would sell well in the market, the respondents have in complete violation of the appellant's copyright in the subject works and in with a view to make substantial illegal and unearned profits, conspired and published “Teach Yourself Mathematics (Fully Solved) Part A” and “Teach Yourself Mathematics (Fully Solved) Part B” (hereinafter referred to as

'the infringing books'), the contents of which the defendants have brazenly copied, reproduced and incorporated from the subject works. The infringing books copies in toto the exercises given in the subject works. The infringing works contain only those exercises and problems which are contained in the subject works and have been copiously copied therefrom. Neither do they bring any new problems/exercises in the infringing works, nor do they take the minimal effort of making ostensible changes in the order/arrangement of those problems and exercises. It may be relevant to mention at this stage that the arrangement of pre-available text is a subject matter of copyright even on the very high touchstone of the modicum of creativity.'

6. In RFA (OS) No. 21/2009 titled: ***Syndicate of the Press of the University of Cambridge on behalf of the Chancellor, Master & School vs B.D. handari & Anr.*** it was held that questions at the end of each chapter themselves comprised original work and would therefore be given protection. However, the Court is of the view that insofar as the questions at the end of each chapter in the text book were concerned and a separate Council was provided to them for the benefit of these work sequences, the test of creativity and skill judgment was made therefore the guide book would not be an infringement upon the question papers set at the end of each chapter of the text books. Relevant paragraphs in the judgment are:-

"12. The legislative text, which has the bearing upon the issue involved therein, is "ORIGINAL LITERARY". In order to reach at any conclusion in this regard, it is necessary to examine the requirement of originality under abovementioned Section and concerned tests developed under the IPR jurisprudence by Indian as well as foreign authorities and the courts.

13. Black's Law Dictionary (7th ed.) defines originality as "the quality or state of being the product of independent

creation and having a minimum degree of creativity” It further says that although “originality is a requirement for copyright protection but this is a lesser standard than that of novelty in patent law.” Justice Frank in Alfred Bell & Co. Vs. Catalda Fine Arts, Inc., [191 F .2d 99, 102 (2nd Cir.1951)] observed that “original” in reference to a copyrighted work means that the particular work ‘owes its origin to the author.’ No large measure of novelty is necessary.” J A L Sterling in his celebrated work titled “World Copyright Law” clearly summarizes the English position on the issue of originality as below:

“Although a number of interpretations have been given to the term, there are certain points on which agreement seems to have been firmly established. Primary among these points are two basic concepts, First that the work must not be merely a copy of a previous work, and secondly that the work is the result of the investment of individual skill, judgment or labour “[Page 303, 2nd ed].”

16. The Supreme Court of India has found many occasions to reiterate that the test of originality in India is same as in the UK which is based on the "skill, judgment and labour". In Eastern Book Company and Ors. Vs. D.B. Modak and Anr.(AIR 2008 SC 809), the Indian Apex court was categorical to observe that:

“Copyrighted material is that what is created by the author by his own skill, labour and investment of capital, maybe it is a derivative work which gives a flavour of creativity.”

27. The exercises depict originality, as it has originated from the author. It is nobody's case that the author has copied these exercises from other source. It also satisfies the test of “skill, judgment and labour” as laid down in Eastern Book Company and Ors. (supra).

28. We may also draw sustenance from the judgment of the House of Lords in the case of Ladbroke (Football), Ltd. Vs. William Hill (Football), Ltd. [1964] 1 All ER 465. That was a case where the respondents were well-known bookmakers who

had done business for many years in fixed odds football betting sending out to their clients each week during the football season a fixed odds football coupon. The coupon was a sheet of paper on which were printed sixteen lists of matches to be played each week; each list was headed with an appropriate name and offered a variety of wagers at stated odds and contained explanatory notes. One of the lists contained the full list of matches to be played at the end of the week this list being determined by the Football League who owned the copyright in it. The other lists were shorter lists of matches selected by the respondents from the full list. Altogether the coupon offered 148 varieties of wager at widely differing odds. A great deal of skill, judgment, experience and work had gone into devising the coupon for the respondents had to select from the very great variety of possible wagers those that would appeal to the punter while being profitable to the respondents, and had then to arrange and describe the selected wagers in an attractive way on the coupon. The respondents had not altered their coupon since 1951, though the selection of matches in the lists was necessarily changed each week. Some of the wagers offered by the respondents were commonly offered by other bookmakers. The appellants, who were also well-known bookmakers, decided to enter the field of fixed odds football betting in 1959, and in devising their coupon for the 1960/1961 season they copied from the respondents' coupon fifteen out of the sixteen lists arranging them in the same order as they appeared in the respondents' coupon, in many cases with the same headings and almost identical varieties of wager, and with similar explanatory notes. They did not copy the odds offered by the respondents but worked these out for themselves and since the respondents' and the appellants' coupons were published simultaneously each week there was no copying of matches selected by the respondents. The respondents claimed copyright in their coupon and alleged infringement by the appellants. By the Copyright Act, 1956, Section 2(1) copyright subsisted in every "original" literary work, a literary work including, by virtue of Section 48(1), compilation. Under Section 2(5)(a) and Section 49(1), copyright gave the exclusive right to

reproduce a substantial part of the work in any form. Though the appellants admitted copyright in the respondents' selection of matches and statement of odds (neither of which they had copied) they denied copyright in the rest of coupons. It was not disputed that, as regards a compilation (such as the coupons), the originality requisite to render a work original of the purpose of Section 2(1) was a matter of degree depending on the amount of skill, judgment or labour that had been involved in making the compilations. It was held that for the purpose of determining whether the respondents' coupon had the originality requisite to render it original work within Section 2(1) of the Copyright Act, 1956, it was right to take into account the considerable skill, judgment and labour expended by the respondents in the selection of types of wagers, for the production of the coupons was an object of the work so done and that work was preparatory work which could not properly be excluded. Moreover (per Lord Evershed) after the work of deciding the wages had been done, there still remained the further task, requiring considerable skill, labour and judgment, of expressing and presenting the chosen wagers for the eye of the customer. Accordingly, there was copyright in the respondents' coupon.

67. 'Guide' as defined in Oxford English Dictionary is "a manual or book of instruction on a specified subject". Webster Dictionary defines a guidebook as "something that offers basic information or instruction". A true nature of guide book is to help, assist, support the students to understand any problem given in a prescribed publication. A guide book provides explanation, step by step process for reaching the answer, fine points, detailed analysis of any problem, etc. The guide book is a kind of commentary based on the original work to enable students to give effective answers to questions set in examinations. Such a guide book would be the original creation even if it were regarded as part abridgment and part commentary upon the original work. In *E.M. Forster & Ors. Vs. Parasuram* [AIR 1964 331], it has been laid down that the guide book was a kind of commentary based upon the original work to enable students to give effective answers to questions

set in examinations. In Kelly Vs. Morris [1866 LR 1 Eg. 697], which is also referred to with approval by the Supreme Court in Eastern Book Company (supra), it was laid down that the compiler of a directory or guidebook, containing information derived from sources common to all, which must of necessity be identical in all cases if correctly given, is not entitled to spare himself the labour and expense of original inquiry by adopting and republishing the information contained in previous work on the same subject. In V. Ramaiah Vs. K. Lakshmanaiah [1989 PTC 137], the defendant published —Sri Vidya Excellent Guide: for the BA, B.Com. and B.Sc. students with respect to Telugu textbooks “Girija Kalyanam”. The learned Single Judge of the Andhra Pradesh High Court held as follows:

“4. The question, therefore, is whether the act of the respondent in writing the guide is an infringement of the copyright of Girija Kalyanam.....

6. In this case the Court below considered in extenso the question at issue. I have gone through the guide consisting of three portions. The first portion gives meaning to difficult words in the book written by the author Ramakrishnaiah; the second portion consists of annotations, illustrations of the meanings and the circumstances under which the theme has been used. The third part consists of four probable questions and answers that may be likely to be prescribed by the examiner from the topic Girija Kalyanam. Merely because the author of the guide, viz., the respondent used the language couched in the text-book his conduct does not necessarily mean that he pirated the words. It is only a guide and was written to help the students to understand the meaning, significance and answers that have to be written for the questions therein or the answers to be given to the words used by the author.....

7. I do not find any justification to hold that the respondent-defendant pirated the language used or the subject used ad nauseam so as to come within the meaning “infringement”..... “”

70. Textbooks/guidebooks, by their very nature, are “derivative works” and the standard to protect derivative

works has been laid down authoritatively by the Supreme Court in *Eastern Book Company (supra)*. The Apex Court in Paras 37, 38 & 39 has laid down the test of originality in a derivative work is higher than the “sweat of the brow” principle in the following words:

“37. In *Kelly v. Morris*, (1866) LR 1 Eq. 697, School of thought propounded is that, at least in respect of compilations, only time and expenses are necessary which is industrious collection.

The plaintiff was the owner and publisher of the first directory. The defendant came out with another directory. The plaintiff sought an injunction against the defendant to restrain the publication of the defendant's directory on the allegations that the defendant was guilty of appropriating the information contained in the plaintiff's directory and obtained the benefit of many years of incessant labour and expense. The defendant, on the other hand, contended that there had been no unfair or improper use of the plaintiff's work. Information which was given in the plaintiff's directory was entitled to be used and adopted as long as he did not servilely copy it. The defendant had bestowed his independent time, labour and expense on the matter and thus had in no way infringed the copyright of the plaintiff. Granting injunction, the Court held that in the case of a directory when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road- book, he must count the milestones for himself. In the case of a map of a newly discovered island he must go through the whole process of triangulation just as if he had never seen any former map, and, generally he is not entitled to take one word of the information previously published without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and the only use that he can legitimately make of a previous publication is to verify his own calculations and results when obtained. The compiler of a directory or guidebook, containing information derived from sources

common to all, which must of necessity be identical in all cases if correctly given, is not entitled to spare himself the labour and expense of original inquiry by adopting and re-publishing the information contained in previous works on the same subject.

38. In the case of Parry v. Moring and Gollancz, Cop Cas (1901-1904) 49, the plaintiff, after obtaining permission from the representatives of the owner of certain letters, updated, chronologically arranged and translated them into modern English for their inclusion in his book. Later, the defendant published, as one of the series, an edition of the letters prepared by the plaintiff. The plaintiff, therefore, brought an action against the defendant alleging infringement of his copyright. The plaintiff maintained his copyright in his version of the text apart from the copyright in the text. It was held that there is copyright in the work of editing the text of a non- copyright work. The editor of a non-copyright work is not entitled to take the text from the edition of a rival editor and use it as a copy for the purpose of his own work.

39. In Gopal Das v. Jagannath Prasad and Another, AIR 1938 All. 266, the plaintiffs were the printers and publishers of the books. The book titled Sachitra Bara Kok Shastra was printed for the first time in 1928 and had run into four editions since. The defendants printed and published another book titled Asli Sachitra Kok Shastra in 1930. The plaintiffs case was that the book published by the defendants was a colorable imitation of their book and an infringement of plaintiffs copyright. It was held by the Court that the plaintiffs compiled their book with considerable labour from various sources and digested and arranged the matter taken by them from other authors. The defendant instead of taking the pains of searching into all the common sources and obtaining his subject matter from them, obtained the subject matter from the plaintiffs book and availed himself of the labour of the plaintiffs and adopted their arrangement and subject matter and, thus, such a use of plaintiffs book could not be regarded as legitimate. It was held that a person whose work is protected by copyright, if he has collected the material with considerable labour, compiled from various sources of work in itself not original, but which he has

digested and arranged, the defendant could not be permitted to compile his work of like description, instead of taking the pains of searching into all the common sources and obtaining the subject-matter from them and to adopt his arrangement with a slight degree of colourable variation thereby saving pains and labour which the plaintiff has employed. The act of the defendant would be illegitimate use. The Court held that no one is entitled to avail himself of the previous labour of another for the purpose of conveying to the public the same information, although he may append additional information to that already published.”

71. Here in this context, we have to examine whether publication of such a guidebook amounts to ‘fair use’. Internationally, the concept of fair use in derivative works has been considered in a large number of cases including the Google case, *Perfect 10, Inc. Vs. Amazon.com Inc.* [508 F.3d 1146]. The use by Google of various keywords and thumbnails were held to be non-infringing and the US Court of Appeal of the 9th Circuit held as follows:-

“..... A work is “transformative” when the new work does not “merely supersede the objectives of the original creation” but rather “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.....”

As noted in Campbell, a —transformative work is one that alters the original work “with new expression, meaning, or message.....”

We conclude that the significantly transformative nature of Google's search engine, particularly in light of its public benefit, outweighs Google's superseding and commercial usages of the thumbnails in this case. In reaching this conclusion, we note the importance of analyzing fair use flexibly in light of new circumstances. *Sony*, 464 U.S. at 431-32, 104 S.Ct. 774; *id.* At 448 n. 31, 104 S. Ct. 774 (Section 107) endorses the purpose and general scope of the judicial doctrine of fair use, but there is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological

change.” (quoting H.R. Rep. No.94-1476, p. 65-66 (1976), U.S. Code Cong. & Admin. News 1976, p.5680). We are also mindful of the Supreme Court's direction that “the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.....”

72. In *Hubbard & Others (supra)*, the Court laid down certain yardsticks to measure “fair dealing” in the following manner:

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

Next, you must consider the proportions. To take long extracts and attach short comments may be unfair. But, short extract and long comments may be fair. Other considerations may come to mind also. But, after all is said and done, it must be a matter of impression. As with fair comment in the law of libel, so with fair dealing in the law of copyright.....”

73. We may also usefully refer to the following passage from the judgment of the Supreme Court of United States in the case of *Luther R. Campbell aka Skywalker, et al. Vs. Acuff-Rose Music, Inc.* 510 US 569 (1994):

“The first factor in a fair use enquiry is “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes. This factor draws on Justice Story's formulation, “the nature and objects of the selections made”. Folsom v. Marsh, supra. The enquiry here may be guided by the examples given in the preamble to section 107, looking to whether the use is for criticism, or comment, or news reporting, and the like, see section 107. The central purpose of this investigation is to see, in Justice Story's words, whether the new work merely

“supersede[s] the objects” of the original creation, Folsom v. Marsh; accord, Harper & Row, supra (“supplanting” the original), or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is “transformative” Level 1111. Although such transformative use is not absolutely necessary for a finding of fair use, Sony, supra, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, see, e.g., Sony, supra, at 478-480 (BLACKMUN, J., dissenting), and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.¶

74. The breadth of the fair use doctrine use was put to test in Harper & Row Vs. Nation Enterprises 471 US 539 (1985) where the Court noted that there are four factors relevant in determining whether the use was fair: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work and proceeded to test the facts on each of these grounds.

75. The contours of the fair use standard shifted somewhat with the decision in Campbell Vs. Accuff-Rose Music (supra). The Supreme Court unanimously upheld the claim of the defendants in the abovementioned case that their parody to the plaintiff's song "Oh, Pretty Woman" was covered by the fair use exception. It was uncontested that the defendant's song amounted to infringement but for the “fair use” exception. The Court held that all the traditional four factors employed to reach a conclusion of fair use are to be treated together, no in isolating and no undue preference can be given to anyone of them. In relation to the first factor, it was held that Court must look into the nature of the use, i.e., whether it was for educational purposes or for review or criticism. The central

enquiry was to see if the work merely supersedes and supplants the original work or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; in other words, whether and to what extent the new work is 'transformative'. Transformative works, the Court held, have a greater change of falling within the fair use defence and such 'works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright. If one may put it differently, the question to be addressed would be, is there a value addition, which alters the original work in a significant measure. The second factor which evaluates the nature of the copyrighted work, is intended to find out if the work actually merits copyright, i.e., whether copyright law was intended, at its core, to cover such works. However, the Court cautioned that this factor is not likely 'to help much in separating the fair use sheep from the infringing goats', in cases where the subsequent work is transformative. The third factor, which deals with the extent of copying, the Court explained, citing Sony Corp. of America (supra) that it does not entail that the reproduction of the entire work would militate against the finding of fair use. There could be cases where the copying could be substantial and the Courts observe fair use, at the same time there could be cases where the copying through insubstantial could be held as infringement. Lastly, the Court observed that in the fourth factor, the Courts have to "consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market".

76. It follows from the above discussion that when a published work is prescribed as text book, a 'guide' can be published provided it fulfils the test of a 'derivative work'. At the same time, this guide book has to be materially different from the textbook. Guide book should not be verbatim reproduction of the text book. If a guide book reproduces the original work to a great measure without its contribution, it may amount to plagiarism and may infringe the copyright law

of the person in original work. On the other hand, if guide book written in a different format, albeit, dealing with the subject matter which is contained in the original book, with a purpose to help, assist and support the students, the problems given in the text book, then it would be a work different from the original work. The guiding principle is to see as to whether such guide book provides explanation and/or step by step process for reaching the answer, detailed analysis of any problem with the objective of making the task simpler in understanding the subject provided in the textbook. In writing this guide book, if the contribution of aforesaid nature is made, it may be treated as a work which is somewhat different in nature. This is the crucial test which is to be applied and has been characterized as the transformative character of the use by the American Courts. Therefore, the task would be to ascertain as to whether the purpose served by the guide book is substantially different from the purpose served by the textbook. If the guide book is different in character and not a mere substitute of the original work/textbook, it would be treated as transformative. However, the character must be substantially different and it is not sufficient that superficial changes are made with basic character of the textbook creeping in the guide book. In that eventuality, it would not qualify as a work of transformative character. If this directive work in the guidebook has assumed different character, it would not amount to infringement of the original work, though it would have been drawn, to certain extent, from the original work. And, in that sense, it would amount to 'fair use' as described in Amazon. Com. Inc. (supra).

77. Interestingly, counsel for both the parties were ad idem on the aforesaid narration about the doctrine of fair use and the judgments cited above were referred to by both the parties. Its application on this principle on the facts of the present case where the perception of the two sides differ and we have to ascertain as to who is correct.

78. Keeping in view the aforesaid parameters, we may discuss the work of the respondents in the form of guidebook produced by them. We repeat that while looking into this

aspect, we keep in mind that the guide book, by its very nature, “derivative work” and it would qualify for protection if this work meets the test laid down by the Supreme Court in Eastern Book Company (supra) as well as in other cases taken note of above. On that basis, it is to be found as to whether the work of the respondents is “transformative” in nature and add something new, with a further purpose or different character, altering the first work of the appellants.

7. Accordingly, the Court concluded as under:-

“87. Coupled with these aspects, when we keep in mind that the book of the appellant is a prescribed textbook for the University and on the one hand, and respondents wanted to bring out an all-comprehensive guidebook for the help of the students in all the courses of English and not limiting it to Grammar alone, the purpose of this guidebook produced by the respondents would be materially different and it would satisfy the guiding test laid down by the Supreme Court in Eastern Book Company (supra).

88. In the ultimate analysis, since Issue No.3 as framed in the Suit is to be decided in favour of the defendants/respondents and against the plaintiff/appellant, the Suit fails. Thus, we are of the view that it was rightly dismissed by the learned Single Judge by affirming the said decree/judgment.”

8. In the latter appeal, the issue as to whether the question paper set would be considered as a review or guidebook, the Court answered as under:-

“116. That apart, in the present case, it is to be borne in mind that the appellant's book is prescribed as textbook in Class XI in Jammu & Kashmir. Therefore, it would be permissible for a person to write, review, critic or guide book on the said work. Insofar as guide book is concerned, with which we are concerned, it is to be shown that it provides explanation, step by step process for reaching the answer to the mathematical problems. Thus, it would be permissible for the

person writing the guide book to take the questions from the exercises prescribed at the end of each chapter in the appellant's book. At the same time, it is to be shown that the person writing the guide book has given step by step answer to the said questions which part is not present in the appellant's work and the same is done for facilitation of the students, particularly, weaker sections so that they are able to get the assistance from such guide book for easy and better understanding. When we apply this test to the present case, we come to the conclusion that the respondent's guide book has met this requirements/qualifications. It is rightly pointed out by the learned Single Judge that the appellant's text does not contain or describe the step by step process or arriving at solutions or answers whereas the respondent's guide book provides the same. The appellant's text book contains the theoretical or explanatory contents in respect of each chapter, that is not taken/adopted by the respondent in its book. There is no copy of these contents by the respondents. The respondent has simply used the questions and contribution of the respondents lies in providing step by step reasoning. This is for different purpose. Learned Single Judge has rightly remarked that many academics may not like these guide books and to a purist or one who delights in intellectual pursuits, such works may be distasteful or even offensive, nevertheless, such works/guide books are produced and designed to cater to weak category of students in their understanding of the subjects. The purpose and manner of the use of the questions, which are found in appellant's text books by the respondent is, therefore, different. Once we qualify the work of the appellant entitled to copyright on the ground that it involves creativity, the same standard would apply to the respondent's work as well. There is a creativity attached in giving step by step solution to the questions. It is a matter of common knowledge that many Mathematical problems can be solved in the different manner. It is also equally a matter of common knowledge that even if there is only one manner of solving a particular Mathematical problem, it may be solved with fewer steps and for better and easy understanding, other person may evolve more steps.”

9. The learned counsel for the respondent has sought the applicability of the said judgment to the present Court on the ground that **Syndicate** (supra) dealt with supplying answers to questions listed at the end of each chapter of the prescribed textbook. Additionally, the guide book also had some other module questions, therefore, the structure of the book and answers supplied were entirely different from the books published by the present appellant. He submits that the question papers published by the plaintiff have been purchased in its entirety in the same sequence with the same commas and fullstop in their guide books. No additional module questions have been attempted, added or suggested by the infringing publisher.

10. Referring to the offending book by the publisher, the learned counsel for the respondent submits that even certain portions of the syllabus which were excluded from the examination, were identically reproduced by the defendant publisher. In other words, the publisher based his entire case on the question papers of the ICSE Board. These question papers were acquired for a monetary amount of Rs. 1.35 crores and the defendant has sought protection from infringement of its rights.

11. The appellant/infringing publisher has published question papers with answers, in the same sequence with commas and full stops in the guidebook as the rights have been purchased by respondent no. 2 – ICSE and has not produced any additional module questions to be attempted by or suggested for the reader. There is a near reproduction of the question papers purchased by the respondent/plaintiff. This is an infringement of the copyright in the question papers purchased by the respondent for which an injunction ought to be granted and it has been so done. For the above reason, the contentions of

the appellant are untenable.

12. For the aforesaid reasons, the Court finds no reason to interfere with the impugned order, hence, the rational and the conclusion arrived at cannot be faulted with.

13. In the circumstances, the appeal being without merit is dismissed along with pending application.

JANUARY 10, 2018

RW

NAJMI WAZIRI, J.

