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## Contents

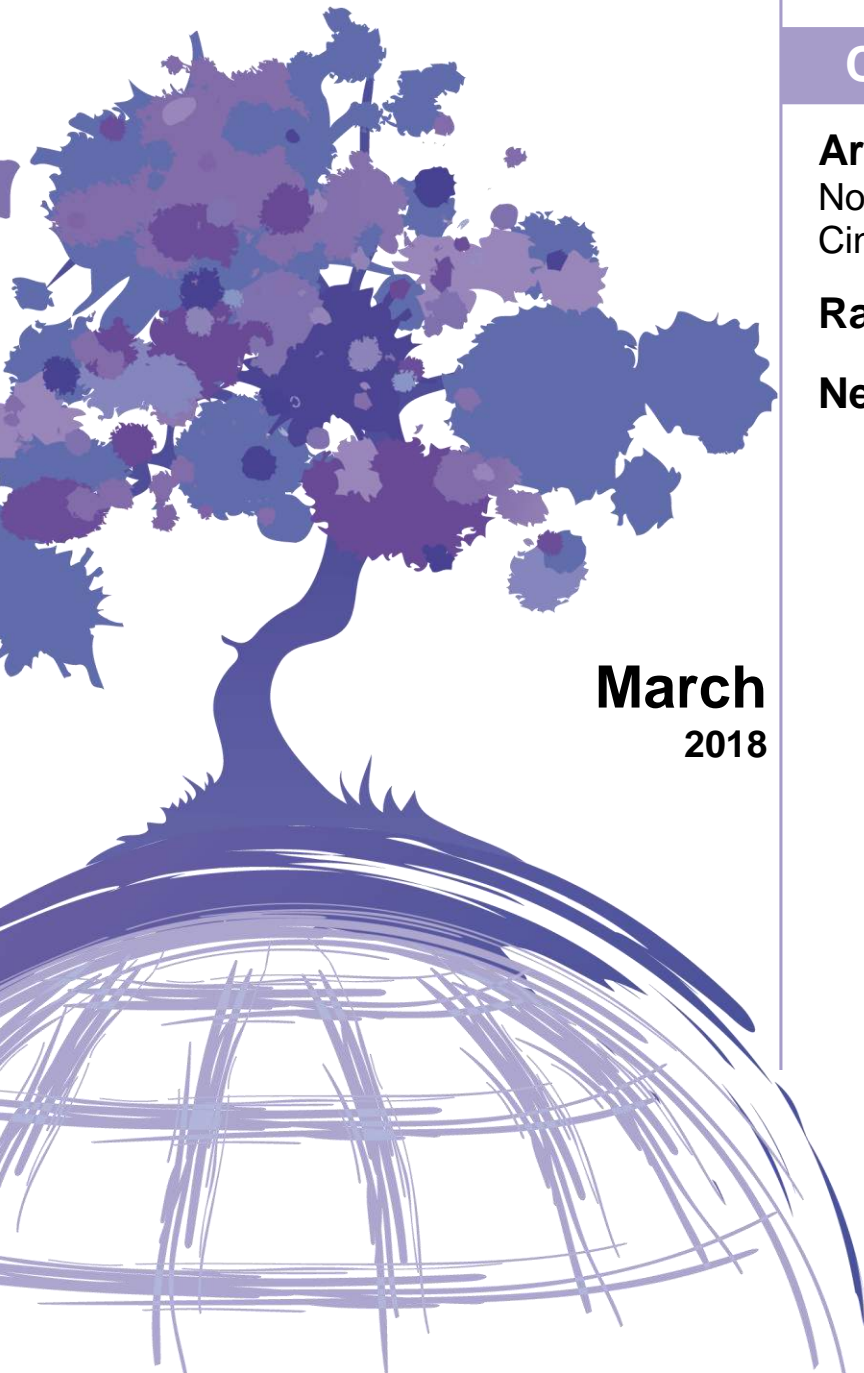
### Article

No Copyright in Title of a  
Cinematographic Film.....2

Ratio Decidendi.....5

News Nuggets .....7

**March**  
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## Article

### No Copyright in Title of a Cinematographic Film

By **Aditya Kaushik**

The Division Bench of the Madras High Court, in February 2018, dealt with the concept of copyright protection of Title of Cinematographic Film in the case of *M/s Lyca Productions v. J.Manimaran & Ors.*<sup>1</sup>. The Appellant (M/s Lyca Productions) was restrained by an Order dated 19-2-2018 of the Single Judge in a civil suit for copyright infringement brought by the Respondent No. 1 (J. Manimaran) from using Respondent No. 1's cinematograph film title "KARU" as part of its film title "LYCAVIN KARU". The Respondent No.1 had, in the suit, sought reliefs like declaring them as the prior registered title holder of the feature film "KARU" and having all the rights over the title including copyright and nomenclature; grant of permanent injunction against the Appellant from infringing its copyright over the title of the film "KARU" with or without any prefix or suffix. The Single Judge passed an interim injunction order restraining the Appellant here from using "KARU" as part of the title of its cinematograph film till the disposal of the suit. On appeal by the Appellant, the Division Bench reversed the findings of the Single Judge and set aside the interim injunction order, by holding that there cannot be any copyright in the title of the cinematograph film or any other copyrightable subject matter. The Bench held that under Section 13 and 14 of the Copyright Act, 1957 there is no copyright in the title, and it is the entire work which is protected by copyright. The Civil Suit filed by Respondent No. 1 here is still pending for further proceedings before the Single Judge.

#### *Brief facts:*

The Respondent No. 1 filed a Civil Suit C.S. No. 65 of 2018 claiming to be the sole proprietor of M/s. J.S. Screens, engaged in production of Tamil feature films. They were enrolled as a member of the Respondent No. 3, Film and Television Producers Guild of South India. The Respondent claimed to have applied for registration of his film titled "KARU" with the Guild on or about 3-9-2011 and the said registration was approved with effect from 28-9-2011. The Respondent pleaded that, at the material time there was no other film with the title "KARU" registered with the said Producers Guild (Respondent No. 3) or the Producer Council (Respondent No. 2). Therefore, as a member of the Guild, Respondent No.1 claimed entitlement to all protection and privileges as available to the members. The Appellant however, is not a member of the said Guild, but is a member of Tamil Film Producer Council, a society similar to the Producer Guild, comprising, *inter alia*, of film producers. Respondent No. 2 and 3, i.e. the Guild and the Council, co-ordinate with each other to ensure that there is no duplication of registration of film titles. The registered title holders alone are entitled to use the titles registered with the said Respondents to the exclusion of other members. The titles so registered by members cannot be used by others, even as prefix or suffix with other words. The Respondent No. 1 further claimed to have made huge investments for his film "KARU", which is 90% complete, is likely to be completed within a short period of time and that he was shocked to come across hoardings and

<sup>1</sup> O.S.A. No. 63 of 2018

advertisements in dailies of a film produced by the Appellant under the same title "KARU". The Respondent No.1 alleged that Appellant registered its film title "KARU" with the Council in 2017, six years after Respondent No.1 had registered the said title with the Guild and that adoption of the said title by Appellant is unfair due to earlier registration of the said title by Respondent No.1. The Respondent No. 1, therefore prayed for interim injunction restraining the Appellant here from imitating or infringing Respondent No. 1's copyrights over its original motion film titled "KARU" with any other suffix or prefix or any other word.

The Appellant contended before the Single Judge that the film produced by them is registered as "LYCAVIN KARU" and Censor certificate has also been obtained for that. It was further contended that the title of the film of the Appellant is different from the title "KARU", which was produced by the Respondent No.1. The Appellant stated that the title of the film was modified after obtaining 'No objection' from M/s. Think Big Studios and registered the title of its film as "LYCAVIN KARU" on 28-9-2017. The Appellant further contended that while the film produced by the Respondent No. 1 is a thriller, the film "LYCAVIN KARU" produced by the Appellant is based on a ghost story and therefore there is no similarity between the two films.

The Single Judge primarily held that release of two movies with same title in the same language either simultaneously or in quick succession (2 to 3 months) will cause confusion which does not require any scientific study. It was further held that a combined reading of Sections 14(1)(d), 13(1)(b) and 2(y)(ii) of the Copyright Act, 1957, clearly reveals that copyright subsists in a cinematographic film and the title would definitely form part of the film, since the film itself is identified only by its title. The Single Judge thus, restrained the Appellant from releasing its film with the title "KARU".

The Appellant appealed the said order of the Single Judge, wherein both the parties raised similar contentions. Division Bench reversed the findings of the Single Judge *vide* Order dated 22-2-2018, setting aside the injunction Order.

### *Contentions of the parties:*

The Appellant filed an appeal, contending that the film produced by them is registered as "LYCAVIN KARU" and Censor certificate has also been obtained for that. It was further contended that the title of the film of the Appellant is different from the title "KARU" of the film, which is being produced by the Respondent No.1. The Appellant alleged that the title of the film was modified after obtaining 'No objection' from M/s. Think Big Studios and registered the title of its film as "LYCAVIN KARU" on 28-9-2017. It was further contended that while the film produced by the Respondent No.1 is a thriller, the film "LYCAVIN KARU" of the Appellant is based on a ghost story and therefore there is no similarity between the two films. The Appellant took a stand that there is no practice in the Cinema industry for producers to become members of organizations such as Respondent No. 2 and 3 (the Guild and the Council) and get the titles of films registered and therefore, the Single Judge erred in arriving at a finding that since Appellant itself had registered its film's title with the Council, therefore there is a practice in the industry for registering titles of the films. The Appellant further argued that it is not a member of the Guild with whom Respondent no.1 has registered the title "KARU" and therefore, not bound by the rules/ regulations of the said Guild. The Appellant further placed reliance on Delhi High Court judgment in *Biswaroop Roy Choudhary v. Karan Johar*<sup>2</sup>, to contend that Courts should be wary to injunct use of words or phrases in common parlance in respect of which

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<sup>2</sup>2006 (33) PTC 381 (Del.)

a claim for exclusive use is staked by an applicant for injunction.

Per contra, the Respondent No. 1 contended that he applied for the registration of the title "KARU" with the Respondent No. 3 in 2011, which was subsequently approved as per the internal rules and regulations of the Respondent No. 3. Respondent no.1 further contended that the Producers Guild is the oldest organisation of its kind and its members comprise, *inter alia*, film producers spread across South India and that it safeguards the interest of its members and acts strictly in terms of its bye-laws. The Respondent No.1 alleged that he is the prior and registered title holder of Tamil feature film titled "KARU" and its rights, title, copyright and nomenclature solely and exclusively belongs to him and therefore, once the title of a film is registered, no other member may reuse the title, or a part of it. It was also contended that the title "KARU" was protected under the Copyright Act, 1957 and its adoption by the Appellant for its film is unfair. It was claimed that they have made huge investments in the aforesaid film "KARU"; that 90% of its production has completed and the remaining part is also likely to be completed within a short time. He further alleged that due to adoption of a title "KARU" by Appellant for its feature film, unnecessary and untold embarrassment is being caused to the name and reputation of the Respondent No. 1. It was further contended that it had become an established practice in the Cinema industry for producers to become members of organizations such as the second and the third defendant/respondent and get the titles of films registered and once a title was registered, no other producer could make a film under that title.

### *Decision of the court:*

The Division Bench after hearing the parties reversed the findings of the Single Judge. The Division Bench took note of the fact that the

dispute between the parties relates only to the title "KARU" and it is nobody's case that film of the Appellant is a copy of the film of Respondent No.1, with the themes of the two films being admittedly different. The Division Bench went through Section 13, 14 and 16 of the Copyright Act, 1957 and held that what is protected under the Copyright Act is the work which is relatable to a cinematograph film, that is to say, the visual recording, including sound recording, produced by process analogous to cinematography. The title, which may be a commonly used word, cannot be protected under the law of copyright. Section 13 makes it clear that there is no copyright in a title, it is the entire work which is protected by copyright. The Bench placed reliance on the Supreme Court judgment in *Krishika Lulla & Ors. v. Shyam Vithalrao Devkatta and Anr.*<sup>3</sup>, to hold that a title is not an original literary work and does not qualify for being described as work. It is incomplete in itself and refers to the work that follows. The Bench also relied on its judgment in *E.M.Forster v. A.N.Parasuram*<sup>4</sup> and Delhi High Court's judgment in *Kanungo Media (P) Limited v. RGV Film Factory*<sup>5</sup>, to hold that there is no originality in adoption of the title "KARU", which is a common Tamil word, meaning "foetus" and figuratively "concept" and/or "theme".

The Bench also held that Respondent No.2 or 3 are not registered Copyright Societies under Section 33 of the Copyright Act, 1957 and are thus, incompetent to administer any right in any work including cinematograph films. It was also held that there is also no statutory basis for the alleged trade practice on the basis of which the Respondent No.1 claimed relief in the suit. The Division Bench also took a stern view against the judgment delivered by the Single Judge for not

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<sup>3</sup> (2016) 2 SCC 521

<sup>4</sup> AIR 1964 Mad 331

<sup>5</sup> (2007) 1 Del 1122

following the consistency in rendering judgments. A Bench of the High Court cannot take a view contrary from the one taken by another Bench of co-ordinate strength of the same High Court. The earlier registration by the Respondent No.1 of the title “KARU” with Respondent No. 3 did not confer any right to the Respondent No.1 to exclusive use of the title so registered, to the exclusion of other producers. The Bench further held that the Single Judge erred in law in giving undue importance to the size of depiction of LYCAVIN before KARU since the suit was not one for passing off. Thus, the Order of the Single Judge was set aside allowing the Appellant to release its film with the title “LYCAVIN KARU”. The matter is now pending for further proceedings.

## Conclusion

The obvious and unmistakable take-away from this case is that no amount of hard work put in a copyrightable subject matter can create a Copyright in something in which Copyright never vested under law and that sympathy for a weaker party to a litigation cannot outweigh the law pronounced by the Courts. This case also throws light on the widespread practice in India, of producers’ institutions creating registration processes and dispute resolution procedures for regulating the use of titles not provided for under the Law. Even though some title registration documents suggest that it grants exclusive use or facilitates ‘mutual arrangements’ between the film fraternity, the same has no effect in the Court of Law.

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## Ratio decidendi

### Patents - Counter claim in infringement suit better than revocation in IPAB

In a case involving revocation application before IPAB and infringement suit before the High Court, Delhi High Court has held that effect of taking defence under Section 107(1) of the Patents Act or of making a Counter claim under Section 64 would be same. Observing that IPAB was not in position to grant relief as patent term had expired, and that proceedings in Civil Court will have precedence, the High Court allowed proceedings in the suit to continue. It permitted the defendant to withdraw IPAB proceedings and to file Counter claim in present suit.

The Court noted that Section 107 of the Patents Act, unlike the Trademarks Act, confers concurrent jurisdiction in the IPAB and the Civil

Court to grant the relief of revocation. It was held that even if the analogy of Section 10 of CPC were to apply, it would be more convenient and expedient that the proceedings in this suit continue, rather than be stayed during the pendency of the revocation proceedings before the IPAB. [*Unilin Beheer v. Balaji Action Buildwell* – Order dated 29-1-2018 in CS (COMM) 1683/2016, Delhi High Court]

### Patent infringement – Prior study having contrary findings is not ‘prior art’

The Delhi High Court has held that the combination containing both Metsulfuron Methyl and Sulfosulfuron as prepared by the plaintiff was novel and not obvious. The uniqueness of plaintiff’s composition comprising of such compounds was that it was effective against both

grassy and broad leaf weeds. Allowing the interim injunction, against the defendants, the Court was of the view that the combination is not to be treated as prior art or prior public use as the findings here were contrary to the study of a prior research done on the same chemical combination.

It also observed that composition of products for registration of the herbicidal composition of the plaintiff and defendant were same, and that only difference between the products was absence of a stabilizer which cannot be considered as an essential ingredient. Further observing that plaintiff had a strong prima facie case in their favour, it was held that mere non-disclosure of the finding of the Insecticides Board by the plaintiff, *prima facie* cannot be held to be material suppression of facts and injunction refused on the said count. [*UPL Ltd. v. Pradeep Sharma* – Order dated 21-2-2018 in CS (COMM) 556/2017, Delhi High Court]

### Trademark infringement – Identical manner of use important, while difference in packing not material

In a case involving alleged infringement of trademark, Delhi High Court has held that difference if any in the cartons in which the goods may be sold or packed will not affect deception otherwise likely between the two marks. Further observing that the manner in which the defendant was using its mark “VKG” was identical to that in which the plaintiff was using its mark “VKC”, it was held that use of the subject mark by the plaintiff in conjunction with another mark and use by the defendant of its mark with the mark “PU” will also not alleviate the deception and confusion otherwise likely. The Court in this regard was also of the view that merely because the name of the father of the defendant is V.K. Gupta, the adoption of the mark “VKG” cannot be said to be *bona fide*. The defendant was hence restrained from using the mark “VKG” or any other mark

deceptively similar to the plaintiff’s mark in relation to footwear. [*Veekesy Rubber Industries Pvt. Ltd. v. Deepak Gupta* – Order dated 12-2-2018 in CS (COMM) 49/2017, Delhi High Court]

### Trademarks – Prior use, similarity and likelihood of confusion

In a case involving passing off of a trademark, when both marks were registered, Delhi High Court has confirmed its interim injunction. The Court in this regard noted that plaintiff had built substantial goodwill and reputation, and was much prior user of brand TRI VOLIB as compared to defendant’s mark TRI-VOBIT 2. It was observed that prior user is considered superior than that of any other rights. The High Court also held that the marks were *prima facie* phonetically and structurally similar, and there was likelihood of confusion as drugs were for the same ailment. Plea that defendant was a prior user of mark VOBIT and had only added a prefix TRI, was rejected by the Court observing that according to the settled legal position, the trademarks have to be taken as a whole. [*Sun Pharma Laboratories Ltd. v. Lupin Ltd.* – Order dated 19-2-2018 in CS (COMM) 918/2016, Delhi High Court]

### Copyrights - Interim relief must not be interpreted by violating the Act

Delhi High Court has rejected the contention that the licence issued by Deputy Registrar, instead of by the Appellate Board, under Section 31D(1) of the Copyright Act, 1957, is in compliance with the Punjab & Haryana High Court Order. The Court in this regard observed that there was no indication that P&H High Court had directed to pass an Order contrary to the provisions of the Copyright Act. It noted that the P&H High Court had merely directed the respondents to decide the representations. The Deputy Registrar of Copyrights however granted an interim statutory license which was contested as being without

jurisdiction. The Delhi High Court was of the prima facie view that such directions had to be complied in accordance with law and thus, if the Registrar of Copyrights did not have the power to

issue a statutory licence, no such license could be granted. [*SAREGAMA India v. UOI* – Order dated 12-2-2018 in W.P. (C) 1155/2018, Delhi High Court]



## News Nuggets

### Copyright in photograph - Work must be 'substantially similar'

Affirming district court's dismissal of copyright infringement, US CoA for the Ninth Circuit has held that defendant incurs no liability if he copies only 'ideas' or 'concepts' used in plaintiff's photograph. The Court in the case *Rentmeester v. Nike*, assessing objective similarities of two works, observed that Nike's photographer made own creative choices resulting in an image and derivative logo not substantially similar to copyrighted photograph. It was held that the plaintiff cannot copyright the pose itself.

### Permanent injunction granted against infringement of mark 'INDIA TODAY'

Observing that plaintiffs (Today Merchandise) were prior registered user of the trade mark and domain name [www.indiatodaygroup.com](http://www.indiatodaygroup.com), Delhi High Court has granted permanent injunction against use of the mark 'India Today' in class 7 of the Trade Marks Act.

The Court in its *ex-parte* Order dated 5-3-2018, while disposing off the suit, observed that the defendant ([www.indiatodays.com](http://www.indiatodays.com)) had neither entered appearance nor filed their written statement or denied documents of the plaintiff.

### UK High Court upholds patent and design infringement claim

England and Wales High Court in the case *L'Oreal Societe v. RN Ventures* has upheld claims of infringement of patent and Community Registered Designs of defendant's 'Magnitone products', with unique brush heads and specific movements. The Court relied upon experiments conducted by various expert witnesses, and established CJEU legal principles. The product in issue comprised of electronic facial skin care device intended to deep cleanse pores. They used an oscillating circular head with rings of bristles arranged in concentric circles.

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