



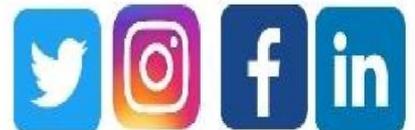
*never rest the business of law
the number supply goods*



Case Commentary

December Edition

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Intellectual

property rights

FOREWORD

More has been said about the writing of lawyers and judges than of any other group, except, of course, poets and novelists. The difference is that while the latter has usually been admired for their writing, the public has almost always damned lawyers and judges for theirs. If this state of affairs has changed in recent times, it is only in that many lawyers and judges have now joined the rest of the world in complaining about the quality of legal prose. My best wishes to all these student contributors, for their future endeavors. My best wishes and assurance to the readers that this will add a lot to the knowledge after reading this perfect case compilation. It's not just for the legal fraternity but for anyone who has an interest in the field of law.

By :

**Vrinda Khanna, Associate
All India Legal Forum**



PREFACE

May there be Peace in Heaven, May there be Peace in the Sky, May there be Peace in the Earth, May there be Peace in the Water, May there be Peace in the Plants, May there be Peace in the Trees, May there be Peace in the Gods in the various Worlds, May there be Peace in all the human beings, May there be Peace in All, PEACE, PEACE, PEACE. Our age-old culture prays for peace and happiness for one and all. Family is the first and oldest social group. It has played an important role in the stability and prosperity of the civilization. Almost everything of lasting value in humanity has its roots in the family. Peace and harmony in the family are important for the all-round development of children. This Compilation of Judgments of the Supreme Court of India and High Court of India by All India Legal Forum is aimed at bringing about desired sensitivity in all duty holders. We're glad to be a part of the All India Forum. Here's an introduction to my team:

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DISCLAIMER

Team AILF India has made all efforts to summarize the cases from original cases retrieved from AIR and SCC. In some cases, the team has tried to summarize cases from the available sources as they could not find original ones.



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PASSING OFF CASE LAW

N.R DONGRE AND OTHERS VS WHIRLPOOL CORPORATION (1996)5 SCC 714

FACTS

The Whirlpool Corporation (WC) was a registered Indian company having foreign collaboration manufacturing various goods such as washing machines, refrigerators etc. with the trademark of '**Whirlpool**'. It also registered its trademark for 1955-57 to 1977, and after that, an application was made for renewal. It was not renewed. At that time, N.R Dongre and others applied for 'Whirlpool' which was granted on 12-8-1992. When it had come to the WC's notice, it appealed to the Delhi High Court for restraining the use of their trademark '**Whirlpool**' by the defendants N.R Dongre and others. The Delhi High Court gave judgment favouring Whirlpool Corporation Considering the defendants' act was passing off. The aggrieved defendants filed an action for passing off and granted the interlocutory injunction. A temporary injunction was granted by the single learned judge of the Delhi High Court in an Original Suit by order dated 31-Oct-1994.

ISSUE

Whether Interlocutory injunction can be granted in a passing-off action even against the proprietor of a registered Trademark.

Whether the trademark reputation of Whirlpool has the trans-border of India.

LAW

It was passing off action Section 27(2) of Trademark Act 1999. Passing off action prevents one person from misrepresenting the goods or services to another, and it has an equitable right of the Common law of England. The right of Passing off action is available for Un-Registered and Non – Renewal Trademark only. The Remedies of Passing off action are in Civil Nature and particularly by way of compensation.

APPLICATION

It was liable for action for deceit under the law of torts and unfair trade competition. The trademark used by the company got registered by another company through deception to obtain economic

benefit reputation by injuring goodwill, and business of the other company is apparent deception and also trade libel and passing off of the goods. Passing off action can be taken by the affected party even against the registered owner of a trademark is maintainable and the party is entitled to protection. An injunction is a relief in equity and is based on equitable principles.

The Whirlpool Corporation has sold the product through the US embassy, which is incorporated in the USA. The Whirlpool Corporation has registered the trademark since 1937, whereas the Defendant applied in 1988. The Whirlpool Corporation has registered in 65 countries and has an extensive business scale.

In **Wander Ltd- & Anr. vs Antox India P. Ltd.** 1990 supp. SCC 727 is sufficient to support this view. We may add that the trial court has taken care to protect the defendants' interest at the interlocutory stage during the trial of the suit in the language used for grant of the interlocutory injunction reserving liberty to apply for its discharge or variation if additional material or subsequent events justify such a course. Passing off a reasonably foreseeable consequence, the business or goodwill of another actually or probably causes damages other traders' business or goods.

CONCLUSION

The court issued an order of the Division Bench of the High Court and dismissed the appeal. It noted the decision of both the courts on the principle of law. There is no ground to interfere with a grant of an injunction. The Supreme court upheld the judgment of the Delhi high court in favour of Whirlpool Corporation.

BENGAL WATERPROOF vs BOMBAY WATERPROOF MFG CO 1997 (1) SCC 99

FACTS

The plaintiff Bengal waterproof ltd is a manufacturing company of raincoat and rubber products under the trade name of Duck Back. The Defendant started the same type of goods under the trade name of 'Dack Back'. The Plaintiff sued the defendant company for passing off before the court of Chief Judge, City civil court Hyderabad.

ISSUE

Whether the Defendant did the infringement in the registered trademark of the Plaintiff.

LAW

It was passing off action Section 27(2) of Trademark Act 1999. Passing off action prevents one person from misrepresenting the goods or services to another, and it has an equitable right of the Common law of England. The right of Passing off action is available for Un-Registered and Non –Renewal Trademark only. The Remedies of Passing off action are in Civil Nature and particularly by way of compensation.

APPLICATION

The Plaintiff sued the Defendant for infringement, but the trial court stated it is passing off their goods as plaintiff trademark.

Defendants set up the defence of res judicata and that the Defendants had not infringed the Plaintiff's trademark. For the purposes of this rule an obligation and collateral security for its performance and successive claims arising under the same obligation shall be deemed respectively to constitute but one cause of action

In the present case, it is evident that when the earlier suit was filed the Plaintiff had a cause of action regarding illegal use of his trademark 'DUCK BACK' by the Defendants and had also a grievance regarding the then-existing deceitful action of the Defendants in trying to pass off its goods' DACK BACK'. Therefore, the cause of action for the first suit was based on the infringement of Plaintiff's trademark and passing off till the date of the suit filed in 1980. It is phonetically similar.

As an act of passing off is deceit and tort every time the Defendant commits such tortious act or deceit, the Plaintiff gets a fresh cause of action to come to the court by appropriate proceedings. Similarly, infringement of a registered trademark would also be a continuing wrong so long as infringement continues.

In **Hindustan pencils vs Indian Stationery products co ltd** the Delhi high court gave the judgment in favor of the Plaintiff and against the defendant infringer and held for filing an infringement action, the Plaintiff's mark must have registration.

Therefore, whether the earlier infringement has continued or a new infringement has taken place cause of action for filing a new suit would obviously arise in favour of the Plaintiff who is aggrieved by such fresh infringements of the trademark or fresh passing off actions alleged against the Defendant.

CONCLUSION

The trial court gave judgment in favour of the Plaintiff in 1982 and ordered the defendant company to pay Rs.25000 as compensation to the plaintiff company .the Defendant appealed to the A.P High court which had reversed the trial court judgement. The learned Trial Judge and the High Court were in error in considering that the Plaintiff's second suit in the present case was barred by Order 2 Rule 2 Sub-rule (3) of the Code of Civil Procedure 1908.

The supreme court upheld the trial court's judgment and set aside the A.P High court's decision.

Universal Pictures Co. vs Harold Lloyd Corporation,

162 F.2d 354 (9th Cir. 1947)

US Court of Appeals for the Ninth Circuit - 162 F.2d 354 (9th Cir. 1947)

12th May 1947

Issues

The Harold Lloyd Corporation filed its complaint against Universal Pictures Co., Inc. and Clyde Bruckman, in the United States District Court for damages, injunctive and other relief. The action arises from alleged infringements upon the motion picture photoplay copyright entitled "Movie Crazy". The defendants deny infringement but admit production and distribution of the alleged infringing motion picture photoplay entitled "So is Your Uncle".

The trial court found and awarded judgment to the plaintiff and against defendants for damages in the sum of \$40,000, \$10,000 for attorney fees, and granted injunctive relief against further violation of plaintiff's rights under its copyright. The court found the total amount of profits realised by the Universal Pictures Co. from distribution of the infringing photoplay was in excess of \$20,000, 20% of which had been derived from the infringements. However, profits as such were not allowed in the award. The defendants' appeal. The Harold Lloyd Corporation cross-appeals on the ground that the damages are inadequate. We shall occasionally refer to the plaintiff-appellee and cross-appellant as Lloyd and defendant-appellants and cross-appellees as Universal and Bruckman.

The motion picture photoplay "Movie Crazy", starring Harold Lloyd, was produced by the appellant during the years 1931 and 1932 at a cost exceeding \$650,000 and was copyrighted. Lloyd's ownership has been continuous and is unchanged. Bruckman was employed by Lloyd during the production of "Movie Crazy" to assist as a writer and director, and he was paid \$42,900 for his services. During the year 1943, Bruckman was employed by Universal as a writer for a motion picture photoplay entitled "So is Your Uncle", the alleged infringing film.

The trial judge found that Universal and Bruckman knowingly, willfully, and deliberately incorporated in "So is Your Uncle" a sequence of 57 consecutive scenes, constituting the "Magician's Coat Sequence", directly from "Movie Crazy". He further found that "So that Your Uncle" was exhibited in more than 5,000 theatres throughout the United States in deliberate violation of Lloyd's copyright after it had been given full information of the misappropriation.

The issues on appeal are as follows: (1) Is there substantial evidence to support the finding of the fact that appellants deliberately misappropriated the sequence of 57 scenes, and if it did, does such fact constitute an infringement of the "Movie Crazy" copyright; (2) Is there substantial evidence to sustain the finding that Lloyd suffered \$40,000 actual damage thereby.

LAW

The pertinent parts of the Copyright Act, 17 U.S.C.A. 1 et seq., are as follows:

Section 1. "Any person entitled to that, upon complying with the provisions of this title, shall have the exclusive right:

(d) To perform or represent the copyrighted work publicly if it is a drama or, if it is a dramatic work and not reproduced in copies for sale, to vend any manuscript or any record whatsoever thereof; to make or to procure the making of any transcription or record thereof by or from

which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever;"

Section 5. "The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

(d) Dramatic or dramatico-musical compositions;

(1) Motion-picture photoplays;

(m) Motion pictures other than photoplays.

Section 25(b) of the Act of 4th March 1909, Ch. 320, 35 Stat. 1081, 24th August 1912, Ch. 356, 37 Stat. 489, 17 U.S.C.A. § 25(b), Copyrights, provides in part: "To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement or instead of actual damages and profits such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion, allow the amounts as from now on stated

APPLICATION

The Court: As I have indicated to counsel, the figures that come out of Hollywood sound like the national debt and they do not register very strongly with this court, and if they did register with the special master I would not follow them."

The Court

Counsel, can't you see the court's viewpoint after everything I have said? I will repeat it. These figures of \$100,000, \$200,000 are entirely out of line. You might as well mention the national debt. If you want to proceed along the same line, I will give you all the leeway you want. You may fill up the record with it and make it as large as you want. I will sit here and listen, but as far as having any material weight with this court is concerned, it will not."

"The Court: At different times during this case when I have endeavoured to bring the parties together I warned you that probably when we finished neither side would be happy because when one person insists on \$300,000, I move the decimal point over.

CONCLUSION

It is contended that the court impliedly held the expert testimony to be untrue since his figure differed from those figures suggested by the expert witnesses. This is not true, since the court made allowances for certain limiting factors to scale down the damages. The court did not make an incidental finding of value and completely disregard the opinion of the experts, for it considered other evidence which limited the values placed thereon by the experts, such as the Columbia short, the age of the picture, star appeal, the wide margin between the cost of picture and claimed damages, and several other such limiting factors. There was also considerable evidence recognised which supports the value placed thereon, such as a present demand and an open market for films successfully displayed, the present-day number of re-issue and remake pictures being advertised, and people remember the picture for this sequence. The judge determined actual damages in finding the lessened value of the copyright because of the infringement.

CASE COMMENT ON

Suresh Kumar vs The Sub Inspector Of Police (2007)

INTRODUCTION

This case comment is on a judgment that analyses a couple of writ petitions, namely, W.P.C. Nos. 4921 and 7057 of 2007, on whether Section 63 of the Copyright Act, 1957 should be assigned a cognisable nature. This Section deals with an offence where an entity infringes the rightful copyright of another entity. In the respective cases leading up to the writ petitions, the police were found treating the offence as mentioned above, is cognisable. The judgment examines to what extent was such treatment justified.

After analysing the Copyright Act's relevant provisions, 1957, and the First Schedule of the Code of Criminal Procedure, 1973, the court, concluded that the offence under Section 63 is indeed cognisable. In coming to its decision, the court even cited a number of precedents where other judges had undertaken the same view.

BACKGROUND

Section 63 of the Copyright Act, 1957 states that if a person is found guilty of infringing the copyright in a work or any other right that has been conferred by any of the provisions of this act, such person shall be punished with some minimum imprisonment of six months that can increase to as high as three years, in addition to a minimum fine of fifty thousand rupees that

may be extended to a whopping sum of two lacs. However, if such copyright infringement is done with any object other than enhancing one's business profits, the punishment can be relaxed. In this case, the court may impose a fine that is less than the stipulated minimum penalty under this Section or imprisonment of less than six months, i.e., the minimum stipulated period of imprisonment for an offence under this Section.

A harmonious reading of Section 63 of this Act with the First Schedule of the Code of Criminal Procedure shall give a fair idea as to why the offence under Section 63 may be considered to be of a cognisable nature. The First Schedule of the latter treats an offence as cognisable when it is punishable with a minimum imprisonment of three years and maximum imprisonment of seven years respectively. For a better understanding, let us take a look at how the Parliament has

categorised our recognised offences into three kinds:

- Offences that are punishable with death, or life imprisonment, or imprisonment for a period of more than seven years;
- Offences that attract imprisonment of three years which can be extended to a period of seven years but not more; and
- Offences that only attract fines or imprisonment of less than three years.

According to the Court, the offence under Section 63 of the Act falls in the second category as the maximum period of imprisonment awarded for the offence is three years. Nothing about the classification specifies that the imprisonment of three years here has to be the lower limit for the punishment. As a result, even if those three years constitute the upper limit of the punishment, it should very well be a part of the second category. Moreover, as specified in the First Schedule of the Code of Criminal Procedure, such offences shall be considered to be cognisable. Different other High Courts have taken the same view as well.

ANALYSIS

With all due respect to the Hon'ble High Court of Kerala's decision and fair judgment, I choose to significantly differ with the given decision in my personal opinion on this point of law. The following are my reasons for doing the same:

- **Offence Only Partially cognisable** – Section 63 of the Copyright Act metes out minimum imprisonment of six months which is not enough to constitute a cognisable offence. The punishment can be fixed anywhere between six months and three years, three years being the most severe penalty for the said offence. According to the First Schedule of the Code of Criminal Procedure, an offence just becomes cognisable if it is punishable with three years' imprisonment. So, technically the offence under Section 63 is cognisable only when the punishment is in its severest form, i.e., only when the offence is as grave as it could be. At other times, when the punishment awarded is imprisonment of less than three years, the offence takes up the nature of the third category mentioned under the head "Background" above. Moreover, only because a part of the punishment is cognisable in nature – that too contingent on the degree of the offence's seriousness – recognising the entire offence is cognisable maybe a little too questionable.

- **Offence Not Grave Enough** – For an offence to be recognised as cognisable and non-bailable in nature, the requisite mens rea must be high enough to match the punishment. In other words, the offence committed should be serious enough to justify the legal repercussions faced on its account. A cognisable offence has to be a non-compoundable act, the punishment for which cannot be compromised with. Such an offence should have the capacity to affect not just one person but the society at large. When it comes to the offence under Section 63 of the Copyright Act, the punishment prescribed is similar to that of theft under Section 379 of the Indian Penal Code, 1860, the only differences being that the latter does neither impose a mandatory fine nor specify a lower limit for the punishment. Being a kind of intellectual theft itself, infringement of copyright is rightly treated similarly. However, in terms of punishment, both these offences become cognisable in their severest forms. That is, they remain non-cognisable to a large extent for the majority of the time. This can only mean that the offences are not that grave and serious about starting with. They sure can become serious at one point of time, but that should not mean that they are treated as cognisable the entire time, especially when the mens rea of the accused – an imperative element in a cognisable offence – has not even been established yet.

CONCLUSION

As pointed out above, it has been repeatedly held that the offence under Section 63 of the Copyright Act, 1957 is cognisable by all means. Perhaps treating the entire offence as cognisable is an easier approach altogether and helps the court arrive at a suitable conclusion faster. And although it is not difficult to see why such a decision may prevail through different precedents, what should also be taken into account is the possibility of applying the doctrine of severability to such offences. In my honest opinion, the offence mentioned above is only partially cognisable and should be treated as such.

M/s. Arudra Engineering Private Limited

Vs

M/s. Patanjali Ayurved Limited

Facts of the case

Arudra Engineers Pvt. Ltd. is a company producing industrial lubricant since the year 1993. The Petitioners had registered "Coronil-92B" as their trademark. The company had filed a petition in the High Court of Madras against Patanjali Ltd. and Divya Yog Mandir Trust for infringing their trademark "**Coronil**". M/s Arudra Engineers Private Limited, the Plaintiff, a company registered under the Companies Act, is in the business of chemical cleaning and manufacturing of material handling systems and polymeric epoxies for various factories in and outside India. The Plaintiff has stated that the company has been in this business for the past 20 years and has built a reputation within its fraternity. The Plaintiff has a registered trademark in the name of '**Coronil-92B**' and **Coronil-213 SPL** in the year 1993 which has been renewed and is in force till 2027.

The Defendants, M/s Patanjali Ayurved Limited and Divya Yog Mandir Trust, had also introduced a product in the market called 'Coronil Tablet' which had been claimed as a cure for the Covid-19 virus or as an immunity booster to prevent cough and cold.

Therefore, the Plaintiff filed a suit seeking protection of its registered trademark from infringement by the Defendants.

The Plaintiff, through its plaint, Claimed the following:

1 seeks the grant of a permanent injunction restraining the Defendants or anybody acting under them from using the trademark and

2. requests for a direction to the Defendants to deliver up to the Plaintiff for the destruction of the entire stock of products or any other material bearing the disputable trademark 'Coronil' and
3. costs of the suit.

Issues involved

1. Whether the Defendants were infringing the Plaintiff's registered mark under The Trade Marks Act, 1999?
2. Whether the registered trademark 'CORONIL' of the Plaintiff can be protected under Section 29(4) of the Trade Marks Act, 1999?

Contentions of the Plaintiff

1. The use of marks similar to the Plaintiff's registered trademark by the Defendants can confuse the people's mind, causing irreparable loss to the Plaintiff.
2. The Plaintiff is engaged in the manufacture and supply of anti-corrosion products, hence the name Coronil -92B and Coronil-213 SPL adds to the Plaintiff's product's distinctive character.
3. The Defendants are taking undue advantage of the registered trademark of the Plaintiff.

Contentions of the Defendants

1. The use of the mark 'Coronil' as an immunity booster is a 'due cause' under the act, and thus the Defendant cannot be said to be infringing the mark of the Plaintiff.
2. The term reputation in India is synonymous to a well-known trademark as described under the act. Hence the Plaintiff's mark does not qualify for the same.

Analysis

Section 29(4) in The Trade Marks Act, 1999 reads as follow:

A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

- (a) is identical with or similar to the registered trademark; and

(b) is used in relation to goods or services which are not similar to those for which the trademark is registered; and

(c) the registered trademark has a reputation in India, and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark.

It was contended that section 29(4) of the act provides protection from infringement of a registered trademark by a person who is not a registered proprietor and uses a mark identical or similar to the registered trademark in relation to dissimilar goods or services. It further states that the use of the registered trademark is without due cause and takes unfair advantage of the registered trademark's reputation and is detrimental to the registered trademark's distinctive character.

The Plaintiff further stated that the shift in the stand of the Defendants from initially projecting a treatment for novel coronavirus to later stating it as an immunity booster but retaining the same old pictorial representation in the label and the name 'Coronil' shows that the Defendants are infringing the registered trademark of the Plaintiff without any due and cause.

The Madras high court observed that:

- 1) There is a possibility of confusion exists since both the marks are exactly the same
- 2) Possibility of dilution exists since the Defendants have not shown due cause in naming their product 'Coronil', when, in fact, their product does not cure Coronavirus.
- 3) Defendants have not established that their mark 'Coronil Tablet' is registered;

A single-judge bench of Justice C. vs Karthikeyan upheld its initial interim injunction vide order dated 17.07.2020, which was already granted in favour of the Plaintiff and thus, made it further absolute restraining the Defendants from using an identical mark "Coronil" and imposed costs to the tune of Rupees Ten Lac to be jointly paid by the Defendants in its recent judgment dated 06.08.2020.

Case Comment

We are of the view that the present order might be right on some aspects but is clearly wrong on certain established principles governing ex-parte matters. The Plaintiff might be a registered

proprietor, and also, the marks are deceptively similar. However, the goods in question are different.

Plaintiff rightly relies on Section 29 (4) of the Trade Marks Act, 1999, which is applicable in case of different goods/services between the parties. However, while granting the president order, the Learned Single Judge of the Madras High Court failed to appreciate that Section 29 (4) (b) has to be read with Section 29 (4) (c) of the Trade Marks Act, 1999. Unless conditions in Section 29 (4) (c) are satisfied, there is no Infringement made out under Section 29 (4).

Section 29 (4) (c) requires a Plaintiff whose seeking a finding on Infringement of Trade Mark to prove that the registered trademark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark.

The Learned Single Judge does not even read Section 29 (4) (c) in the order. Further, the said

Section's requirements are not even started to have complied; at least prima facie, in the present matter. The Learned Single Judge only finds a prior registered trademark and issues an ex-parte Injunction.

In our humble view, before granting an ex-parte order, the Learned Single Judge should have considered and given a finding on Section 29 (4) (c) of the Trade Marks Act, 1999.

Further, the Learned Single Judge does not observe that the Plaintiff:

1. has a prima facie case; and
2. has a balance of convenience in its favour, and
3. will suffer Irreparable Harm and Injury in an ex-parte injunction is not granted.

Bereft of such findings, most importantly, on Section 29 (4) (c), we believe the order was vulnerable and can be set aside. The Plaintiff does claim customers abroad, but the test of Section 29 (4) (c) is a reputation in India. The Ex-parte order is not based on such finding of reputation.

HUL V EMAMI: THE TRADEMARK BATTLE

BACKGROUND

The aftermath of George Floyd's death gave rise public outrage against racial discrimination and the #Blacklivesmatter movement. In response to this, various corporate and multinational companies worldwide took decisions to make their brands less discriminatory. One such company in India was Hindustan Unilever Limited ("HUL") who rebranded its fairness enhancing cream 'Fair and Lovely' to 'Glow and Lovely' and 'Fair & Lovely for Men' to 'Glow and Handsome'. HUL's decision garnered much criticism from the consumers as well as its rival brand Emami. Emami claims that it had rebranded its product 'Fair and Handsome' to 'Glow and Handsome' and launched it digitally a week before HUL announced it is rebranding. Emami alleged HUL's decision to be an unfair business practice since their products now had the same brand name.

The rivalry between Emami and HUL is not new. Both brands have had a history of defaming the other in advertisements and promotional strategies. The rift began in the late 2000s when Emami, realising the potential in fairness creams for men, launched its brand 'Fair and Handsome' in June 2005. HUL followed soon after with 'Fair and Lovely for Men' in 2006. Since then, both companies have been bad-mouthing each other in advertisements, and the courts have settled several controversies. However, in the men's fairness cream category, Emami has always enjoyed a more significant market share which currently is over 65% With the renaming of its brand to 'Glow and Handsome', HUL attempts to capture more market share than before.

BONE OF CONTENTION

The bone of contention in this matter is the use of the word mark 'Glow and Handsome' as has been filed for by both HUL and Emami.

TRADEMARK HISTORY TILL DATE

HUL has been attempting to find a suitable name to rebrand its product 'Fair and lovely' since September 2018. It has thus filed for several trademarks such as 'Even & Lovely', 'Always Lovely', 'Glow and Lovely', 'I am Lovely', 'Bright & Lovely', 'Truly Lovely', 'Care & Lovely', and 'Bold & Lovely'. A few of these trademarks have been granted while others have been objected or refused.

'Glow and Lovely' and 'Glow and Handsome' were two such word marks that had been refused by the Trademark Registry on the grounds of non-distinctiveness and designating intended purpose. Review petitions filed by HUL have been rejected as recently as 18th February 2020. Thus, an appeal has been preferred against the order of refusal which is currently pending with the IP Appellate Board.

The move of HUL rebranding itself to 'Glow and Lovely' and 'Glow and Handsome' on 25th June can be said to be a tactful move to gain popularity and acquire secondary meaning in the minds of consumers. The media coverage given to the HUL's decision has already attracted widespread attention from consumers. Further, in order to expand their trademark base and strengthen their claim, they have filed two more applications for device marks of 'Glow and Handsome' on 16th June 2020 and 25th June 2020.

On the other hand, Emami claims to have announced its rebranding from 'Fair and Handsome' to 'Glow and Handsome' digitally one week before HUL's launch. It also claims to have made filings with relevant authorities beforehand. However, this does not appear to be true. Emami may claim prior launch of the product but its filings for wordmarks and device marks have been as recent as 25th June 2020 and 27th June 2020. Two of its wordmarks have passed formality checks and are pending approval from the Registry while its device marks have been sent for Vienna codification.

RELIEF GRANTED BY BOMBAY HIGH COURT

In response to Emami's 'groundless' threats, HUL approached the Bombay High Court for an ad-interim relief to protect itself. The Bombay High Court granted relief while observing that:

"Prima facie it does appear that having filed its trademark application in September 2018 and subsequently on 25th June 2020 for the mark 'GLOW & HANDSOME', the Plaintiff (HUL) is the prior adopter of the said mark." [**Hindustan Unilever Limited vs Emami Limited**, LD/VC/IA/1/2020, decided on 06-07-2020]. The relief granted directs Emami to give HUL a prior written notice, seven days in advance before initiating any legal proceedings over the Trademark for "Glow & Handsome". However, there is still uncertainty around various legal issues relating to the trademark grant, which will have to be resolved by the courts. Two questions that will need to be determined by courts in all likelihood pertaining to:

1. Distinctiveness of 'Glow and Handsome'; and

2. Determination of prior users of the mark in question.

ANALYSIS OF THE SITUATION

HUL made a smart decision in 2018 when it decided to file applications for the several prospective marks as an alternative to 'Fair and Lovely'. The filing of fresh applications for the trademark 10 days before its announcement was also a good decision taken by HUL's IP team who were vigilant. However, it did not use those marks in relation to any goods until 25th June 2020 when the rebranding was announced.

On the other hand, Emami failed to file applications to register its brand name 'Glow and Handsome' until a week after its digital launch. Though Emami could build a case on deceptive similarity, its legal position is weak compared to HULL since registration is the primary proof of ownership. In this situation, the only route for Emami would be to claim 'prior use' of the trademark and allege failure to use the trademark by HUL.

Prior Use of Trademark in India

Indian Trademark Act, 1999 holds priority in adoption and use over priority in registration to determine a mark's owner. Section 34 of the Act states that a trademark's registered proprietor cannot interfere with a prior user's rights of an identical or similar mark. This principle protects a bonafide owner from being stripped of his rights over his trademark. The Supreme Court has recognised four principles governing the right to a prior user [**Neon Laboratories Ltd. vs Medical Technologies Ltd. and Ors**]:

1. The use of a mark resembling the registered mark must be in relation to the same goods and services as the registered mark;
2. The prior user must have been in continuous use of the trademark in India;
3. The trademark must be put to use by the proprietor;
4. The mark must have been used from a date before using the registered trademark or the date of registration, whichever is earlier.

If the IP Appellate Board accepts HUL's appeal for grant of 'Glow and Handsome' and if the application is registered, it will be dated to the date of its application in September 2018. In such a situation, the prior claim use may also be weak since Emami put the mark to use only in June 2020.

CONCLUSION

The present dispute between Emami and HUL is a classic example of why businesses must not wait to launch or release its product/ services and file trademarks beforehand. HUL's practice of filing trademark applications in advance before launching the product has given it an upper hand in the forecasted legal disputes. On this basis, the Bombay High Court has held HUL to be the prior adopter of 'Glow and Handsome prima facie and has granted it a preemptive order mandating Emami to give seven days prior notice before filing a legal suit.



M/S Lahari Recording Company vs Union of India

Introduction

Section 31 D and section 31 (1) (b) of the Copyright Act, 1957 was challenged of its constitutional validity by the petitioner in this case before the Supreme Court. Section 31 D was introduced into the Copyright Act by an amendment in 2012, and the Copyrights Rules also supplemented this.

Section 31 D deals with the statutory license for broadcasting the literary and artistic works (or the sound recordings). The Section provides any broadcasting organisation with the permission to broadcast any published literary or artistic work by the author or the copyrights owner provided that certain conditions have to be followed. Before broadcasting or before the work's performance, a prior notice has to be issued to the copyright holder about the intention of broadcasting, and an amount of royalty has to be paid to the copyright owner. The Section further provides that these royalties will be different for television broadcasts and radio broadcasts and they will be essentially decided by the Copyright Board or the Appellate board. Also, there are the Copyright societies that exist to enforce and protect the enforcement of the copyright holders' rights where they help in granting licenses on behalf of the right holder and file litigation on behalf of her/him. They are also authorised to pay the royalty to the copyright owner and distribute it among the members. However, these societies are now alleged to have infringed the rights for their personal gains.

Along with this, 'online broadcasting' was incorporated into the ambit of section 31 D. Owing to the vast growth of the internet and owing to the prevalent communication with the help of the internet, it led to the extension of the scope of broadcasting via radio and television to broadcasting via internet. Since 'broadcasting' means 'conveying to the population', online broadcasting or internet broadcasting can be included within its definition. This inclusion was issued in an office memorandum by the Department of Industrial Policy and Promotion (DIPP) on 5th September 2016.

Section 31(1) (b) after its amendment in 2012 brings out a system of 'compulsory licensing' where the broadcasters have conferred the license even if the copyright owner refuses. The complainant can seek a license from the Appellate board, and the board can also grant the license without the owner's consent if it opines the person (complainant) as 'qualified' for the license.

Hence both the sections 31 D and 31(1) (b) of the copyright act, 1957 are challenged to ultra-vires

the constitution for their infringement of articles 14, 19(1) (g), 21 and 300A.

Background

The purpose of the amendment of the copyright act in 2012 was to bring the statute up-to-date, in level with the recent technological advancements and to make it compliant to the international treaties. Subsequent to these amendments and inclusions, there were various petitions filed before different high courts and the Supreme court questioning the validity of the office memorandum by the DIPP that it is out of its competence and the amended provisions, especially regarding the articles 14 and 19(1) (g) of the Constitution.

- M/s Eskay Video Pvt. Ltd. vs Union of India

This case brought the constitutional validity of the sections 31 D and 31(1) (b) in question before the Calcutta High court. Section 31(1) (b) being connected to rules 6 to 10 of the copyright rules and section 31 D being connected to copyright rules 29 to 31 was argued to be violative of articles 14, 19(1) (g) and 300 A.

The petitioners contend that their agreements with the broadcasters for the voluntary licenses get disrupted as the broadcasters turn towards the appellate board by terminating their agreements with copyrights owners for even more convenient terms. The amended provision of section 31(1) (b) allows the broadcasters to copyrighted work and communicate with the public even if the rights holder refuses the broadcasting. The complainant can concern the appellate board on reasonable terms where the board can grant the license without the copyright owner's consent if it deems as 'qualified'. This is contended as violative of Article 14 as the owner is deprived of the right to be heard from choosing to whether to grant the license or not. Unrestricted power is conferred on the appellate board to grant the license and fix and set the terms relating to it such as the royalty. This method thus contradicts the essentials of artian extensive and, ultimately renders the exclusive rights of the copyright owner redundant.

- Anand Bhushan & Ors. vs Union of India.

In this case, it was prayed that the Sections 11(2), 12(2), 31, and 33A (2) of the copyright amendment act, 2012 along with certain copyright rules where the petition was filed before the Delhi High court. The petitioners claim that they are aggrieved by Section 31 of the copyright act, Page 27 of 56

which is the provision for certain compulsory licenses and claims that it is arbitrary and excessive in its regime.

Under section 31, once the copyright board has granted the compulsory license to any of the applicants, it can grant such license to any number of persons fundamentally against the principle of natural justice and is arbitrary. The petitioner also challenged the Rules 56(3), 56(4), 56(5) & 56(6) and section 33 A which conferred on the copyright board a provisional power to interfere and regulate every aspect of the tariff fixation.

The court held that the rules challenged by the petitioner do not counter the right of the Copyright Society to fix and claim reasonable tariffs.

The court dismissed the writ petition and concluded by stating, "Impugned Rules do not bring into existence or create substantive rights or obligation not contemplated and beyond what is envisaged and postulated by the provisions of the Act itself."

- South Indian Music Companies vs Union Of India

The prayer of the petitioner, in this case, is to declare sections 11, 12, 31, 31 D of the copyright Act, 1957 as ultra vires of the articles 14, 19(1) (g), 50, 245 and 300 A of the Indian Constitution.

The petitioner stated that section 31 is infringing article 14 as it focuses only on the 'sound recordings' for granting the compulsory license and there are no adequate guidelines for the board's power to grant licenses. It was also contended that section 31 D of the copyright act, 1957 is infringing article 19(1) (g) as it was providing for the fixed royalties for radio broadcasting, thus countering the principle of reasonable classification.

Analysis

The provisions of section 31 limited the scope of broadcasting to radio and television, but this was expanded to internet thus bringing online broadcasting into the ambit by an office

memorandum by the DIPP which was challenged that it is not competent enough to take that measure. The practices under section 31 D that is functioned by the copyright societies are explained adequately in **Entertainment Network (India) Ltd vs Super Cassette Industries Ltd & Ors**. Also, the constitutional validity of the sections 31 and 31 D after amendment were upheld by the Madras High Court where it was observed as the mechanism of public interest in relation with a private interest in the case of the **South Indian Music Companies vs Union of India**.

This was later challenged in the cases of **M/s Eskay Video Pvt. Ltd. vs Union of India and M/S Lahari Recording Company vs Union of India** which are yet to be given the verdict and is now under stay.

Conclusion

In the context of licensing under section 31 D, the Supreme Court recognised the concept of co-existing copyright by referring to the case of **Gramophone Co. Ltd. vs Stephen Carwardine & Co**. It was concluded that once a license is conferred by a copyright owner or by someone who is authorised to confer it, to communicate it to the public or broadcast it, there is no need for a separate license or authorisation of the communication of the owner's literary work or sound recording. However, still, it is not opposed to the idea of getting authorisation for broadcasting. This was supported by the case of **Indian Performing Right Society Ltd. vs Eastern Indian Motion Pictures Association and others**. Hence, section 31 D was incorporated with the intent of public interest and in empowering the growth of radio and television broadcasting and was ultimately held as not ultra vires.

F. Hoffmann-La Roche Ltd, vs Cipla Ltd., Mumbai Central

FACTS

Considered to be a landmark case, took place between a Swiss multinational health-care company, i.e., Roche and an Indian Multinational Pharmaceutical and Biotechnology Company, i.e., Cipla. The dispute arose in Delhi High Court over Roche's drug 'Erlotinib' that Roche sold as a different name, 'TARCEVA' as both are based on the same compound which is 'Erlotinib Hydrochloride'. The said drug was a significant breakthrough for cancer treatment and was approved by the U.S Food & Drug Administration and the European Union. The drug

was also patented in India as the Patent was granted by the Controller General of Patents, New Delhi, in 2007. Subsequently, Cipla, an Indian Multinational Pharmaceutical and Biotechnology Company, having its registered office in Mumbai, announced the launch of a generic version of Tarceva (Erlotinib).

Hearing this news, Roche claimed that Cipla had infringed Patent in 774, also known as 'Erlotinib Hydrochloride' which is licensed to Roche. The Plaintiff further alleged that the drug had been developed after years of research and was also protected by law and therefore, the defendant company had no right to manufacture, sell or offer to sell any version of the drug Tarceva and is henceforth violating the legal rights of the plaintiffs.

Subsequently, a suit of infringement of Patent's right was filed by the Plaintiff along with an application seeking an ad-interim injunction.

RESPONSE OF CIPLA

One of the respondent's contentions was that the Patent so granted to Erlotinib was invalid as it was a derivative of 'Quinazoline', a known patent. The respondent further added that the composition of Erlotinib was same as that of Quinazoline except for one substitution and therefore is not an inventive step(section 2(1)(ta) of Patent Act, 1970)

The respondent further contended that the complete specification did not sufficiently and fairly describe the invention or the method by which it was performed as for any drug to be qualified as patentable under section 3(d), what is essential is that one shows that there is any improved efficacy of the said drug which was not the case.

Lastly, the respondent contended that it was in the public interest as it pointed out the huge difference in the price between the drug sold by Roche, which was a Rs. 4,800 tablet and the drug sold by Cipla for approximately Rs. 1,600. In furtherance to this, the responded stated that since the drug in question was a life-saving drug, the factor of it being in the interest of the public should be given importance and taken into account.

RESPONSE OF ROCHE

After the contentions of the respondent, the Plaintiff submitted the following:

Firstly, the Plaintiff contended that section 3(d) of the Patents Act, 1970 is not applicable since it prohibits only derivatives of a 'known substance' and 'erlotinib' is not salts, esters,

polymorphs, particle size, a mixture of isomers, etc. of a known substance and is, therefore, a novel compound.

Secondly, the Plaintiff stated that when determining where the balance of convenience lies, it is appropriate to consider the issue of 'accessibility' to, and use of, the territory's invention. It is not, however, necessary that the drug has to be manufactured in India.

Lastly, the compounds of Erlotinib are different from the properties of the drug cited.

JUDGEMENT

SINGLE JUDGE RULING

The single judge noted the following two points:

1. Validity of the Patent-

The question of the validity of the Patent raised on the ground of obviousness and that Erlotinib being a derivative of an already known compound as the increased efficiency criteria were also not met forth was outrightly dismissed by the judge and held that the Plaintiff's contention was not apparent for a person skilled in the same art to have to replace methyl or ethyl.

2. Public Interest

The court accepted the contention of respondents of it being done in the public interest as the generic drug version of Erlotinib manufactured and marketed by Cipla was available at one-third of the price of what was being sold by Roche. The court further noted that since Tarceva was imported and not manufactured, the right to access to life-saving drugs and the need for secure long term supplies is a serious issue in India and therefore the generic version of drug not being in India would cause a serious injury.

Therefore, the judge rejected Cipla's plea, as many innocent people would be affected unnecessarily. Roche filed an appeal against the order of the single judge.

DIVISION BENCH RULING

The division bench observed the following:

In this case, the bench was of the view that the Patent in question-related to a mixture of Polymorphs A and B, whereas Roche's Tarceva drug consisted of only Polymorph B for which a patent had not been granted and therefore there was no infringement. The court realised that

a life-saving drug was in question, and hence the drug made available by Cipla was three times less prices than the drug manufactured by Roche.

The court, therefore, dismissed Roche's appeal and upheld the order of the single judge.

ANALYSIS

The case is one of the first cases of patent infringement in India after independence undoubtedly marked a turning point in understanding what patent infringement means, its importance, and the party's right. Even though it is perceived that getting a patent would mean creating a monopoly on the market, the direct reading of section 3(d) makes it clear that a mere discovery and a known form of known substance does not fall within the ambit of the invention and can therefore not be patented. The legislature's intent behind such a section was clearly to make Anti- Evergreening laws by restricting obvious form and substances. The case also threw light on the importance of public interest than that of an individual's interest. However, the question that arises is whether the public interest is more important than the rights of an individual or a company... this is undoubtedly something to ponder upon.

Sartaj Singh Vs. Gurbani Media Pvt.Ltd.

Title and citation

Sartaj Singh Pannu Vs. Gurbani Media Pvt. Ltd.& Ors. In the high court of Delhi O.M.P 1602 of 204

Facts

Sartaj Singh Pannu, a young film director, is the petitioner in the petition under section 9 of A&C Act, 1996. Pannu wants to seek orders restraining Gurbani Media Pvt. Ltd. and its Manager Director Mr Harinder Singh from releasing the film Nanak Shah Fakir without giving him credit as the film's sole director.

Issue

Can the waiver of moral rights be made in the Copyright Act in India?

Decision

Single Judge Bench of Delhi High Court stated: "The court is not prepared to go as far as to deny the right of a Director to waive his right to be credited as such if for any reason he does

not want his name to be associated with the film. As long as the waiver is voluntary, it cannot be said to be opposed to public policy."

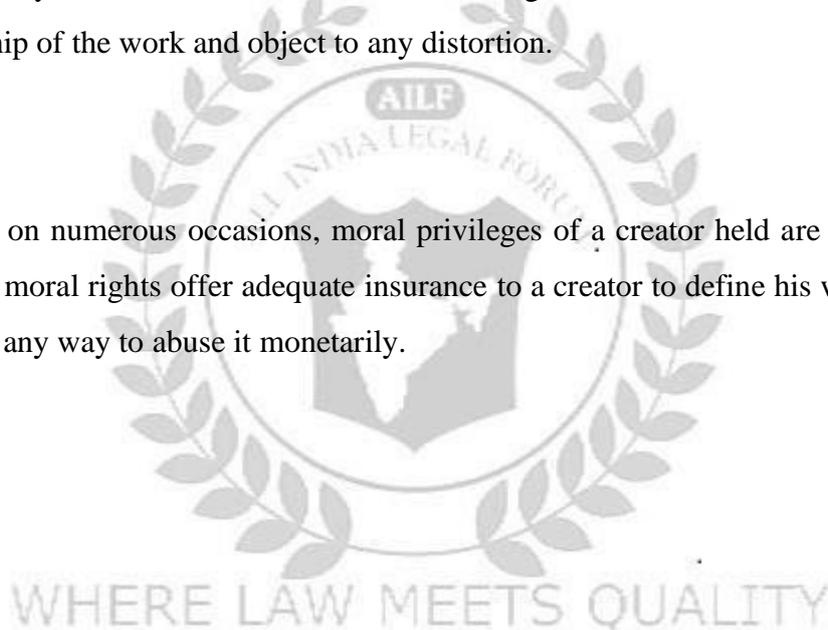
Analysis/Reasoning

India incorporated moral rights into its copyright Act, 1957. Section 57 of the act addresses the author's rights explicitly, emphasising extending such rights beyond purely economic considerations. These moral rights have been given statutory recognition and comprise the right to: Claim authority of work and prevent any distortion modifications of a work which would be prejudicial to the author's reputation. These provisions are clearly based on Article 6bis of the Berne Convention of which India is a signatory.

**Article 6bis says that after the transfer of the said rights, the author shall have the right to claim authorship of the work and object to any distortion.

Conclusion

Consequently, on numerous occasions, moral privileges of a creator held are allowed by the courts and the moral rights offer adequate insurance to a creator to define his work even after he moves it in any way to abuse it monetarily.



Aman Nath Sehgal Vs. Union of India

Title and citation

Aman Nath Sehgal Vs. Union of India, 117 (2005) DLT 717, 2005(30) PTC 253 Del.

Facts

Mr Aman Nath Sehgal is the world-renowned sculpturist and has been conferred with several awards for his beautiful creations and contribution to the Indian heritage. In 1957, India commissioned Mr Sehgal for the bronze mural for the most prominent International Convention Hall in the country's Capital. The bronze sculpture of about 140ft. Span and 40ft. Sweep over five years to complete and kept on the wall of a Lobby in the Convention Hall. These embellishments became a part of Indian art heritage. In 1979 when the government pulled down the sculpture and dumped it in the storeroom. When Mr Sehgal came to know about this ill-treatment, he made representations to the government authorities to restore the mural, but nobody listened to his concern, so Mr Sehgal filed a petition in the Delhi High Court for recognition and enforcement of his rights on the mural.

Issues

1. Whether the Plaintiff is entitled to the special rights under section 57 of the copyright act even after the copyrights are vested in the defendants' interest?
2. Whether there are any damages regarding any distortion, mutilation, modification, or other act related to the said work done before the expiration of the term of copyright?

Judgement

The Court held that the mural whatever be its form today is too precious to be reduced to scrap and languish in the Government of India's warehouse. Only Mr Sehgal has the right to recreate his work and therefore has the right to receive the broken-down mural. He also has the right to be compensated for the loss of reputation, honour and mental injury due to the offending acts of UOI.

The court passed the mandatory injunction against the UOI, directing it to return the mural to Mr Sehgal within two weeks. Court also granted Rs. 5 lacs to Mr Sehgal and transferred all the mural rights to Mr Sehgal; he can recreate it and even sell it.

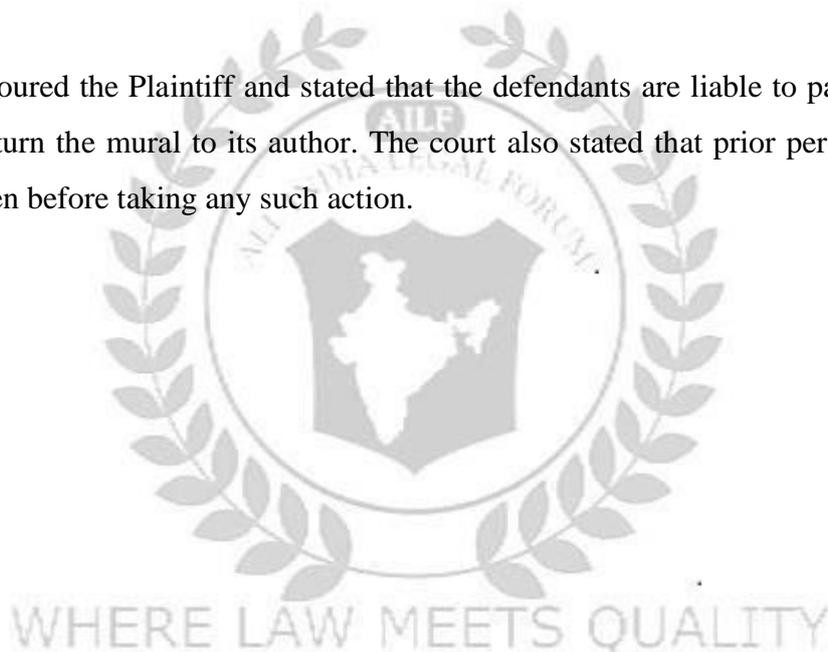
Analysis

The work of art or any work with some kind of creativity involves some kind of sentiments or the sense of ownership. These moral values always are respected. Special rights under section 57 of the Copyright Act are fundamental laws, which give the author or any person who makes anything to claim the damages against any kind of distortion, mutilation or modification without the author's consent. This is the landmark case in which moral rights were considered.

The moral rights exist even after the assignment of the copyright. The court stated that the mural was moved and dumped without the permission of the Plaintiff. It has been removed from the public's view, which shows that it was prejudicial to the author's honour or reputation.

Conclusion

The Court favoured the Plaintiff and stated that the defendants are liable to pay the damages and also to return the mural to its author. The court also stated that prior permission should always be taken before taking any such action.



Mannu Bhandari Vs. Kala Vikash Pictures Pvt.Ltd

Title & Citation

Mannu Bhandari Vs. Kala Vikash Pictures Pvt. Ltd. (AIR 1987 Del 13)

Facts

Mannu Bhandari(M) was the author of the novel 'Aap ka Bunty'. She assigned the filming rights of her movie to the Kala Vikas Pictures Pvt. Ltd.(K).M has filed a case so as to restrain the screening of the film made by K. In M's opinion. At the same time, her novel was a literary work, the film has been heavily mutilated and commercialised and if released will lower her reputation of a research scholar in the eyes of public and her admirers as they are likely to conclude that she has fallen prey to big money in the film world and has consented to mutilation and distortions.

Issues

- 1. What is the extent of the powers of the Court under Section 57?**
- 2. Whether assignee of copyright can claim any rights based on the**
- 3. Which is inconsistent with the provisions of Section57?**
- 4. Whether the movie can be filmed as it is with the changes?**

Decisions

The court clarified the following observations in this case-

- Section 57 of the copyright act 1957, which deals with moral rights protection in India lifts the author's status beyond the material gains of copyright and gives it a special status.
- Author's right to restrain distortion of his work is not limited to cases of literary reproduction of his work. The restraint order like an injunction can be passed even when a film is produced based on the author's novel.
- The language of Section 57 is of the widest amplitude and cannot be restricted to literary expression only. Video and audio manifestations are directly covered.

- The special protection given to the authors under the Indian Copyright law is emphasised by the fact that the remedies of a restraint order or damages can be claimed: "even after the assignment either wholly or partially of the said copyright".
- Section 57 this overrides the terms of the contract of assignment of copyright.
- It is obvious after reading section 57 that permissible modifications are such which do not convert the film into an entirely new version from the original novel.
- The modifications should not distort or mutilate the original novel.
- After giving due considerations of the facts, the Defendant made certain modifications and deletions in the movie before the screening.

Analysis /Reasoning

The Court held that when it passes a judgement under Section 57, it does not sit as a sentinel of public morals. Accordingly, the court cannot impose its views on the works of art. The concern of the court is to merely examine how the new avatar is true and authentic and what changes are necessary due to constraints of a medium Section 57 confers additional special rights on the author which can be seen by the fact that the right exists even after the assignment of the copyright and accordingly a contract negates the special rights and remedies guaranteed by section 57.

Conclusion

Consequently, on numerous occasions, moral privileges of a creator held are allowed by the Courts and the moral rights offer adequate insurance to a creator to defend his work even after he moves it is anyway at all to abuse it monetarily.

SARABHAI INTERNATIONAL LTD AND ANOTHER VS

SARA EXPORTS INTERNATIONAL

AIR 1988 DEL 134

FACTS

In the instant case, the Plaintiff, a leading Indian export house engaged in export of drugs, pharmaceuticals and allied items, chemicals etc. under the trade name Sarabhai chemical. Sarabhai international ltd filed suit for the perpetual injunction, infringement of trademark, passing off and rendition of accounts against the defendants sara exports international who were doing similar business under the trade name "Sara export international ". There was sufficient documentary evidence on record to establish that the trading style Sarabhai chemicals and the trademarks Sara / Sarabhai and Sarabhai emblems had acquired an extensive reputation, goodwill and name all over India and abroad in respect of medical, pharmaceutical and veterinary preparations and said trading style and trademarks exclusively associated with the Plaintiff and none else. The articles mentioned above bearing the trademark Sara and Sarabhai denoted and connoted there were standard fields of activities regarding Plaintiff and Defendant's similar goods. The adoption of trading style Sara exports internationally by the Defendant and the general public in India and the importers and general public abroad. The use of the trading style Sara exports International created an impression in the mind of the general public, dealers and importers that the Defendant may be an organisation or a division or branch of the Plaintiff.

ISSUE

Whether perpetual injunction can be granted in a passing-off action even against the proprietor of a registered Trademark. Whether trading style confuses public. Whether is deceptively similar to a trademark.

LAW

It was passing off action Section 27(2) of Trademark Act 1999. Passing off action prevents one person from misrepresenting the goods or services to another, and it has an equitable right of the Common law of England. The right of Passing off action is available for Un-Registered and Non – Renewal Trademark only. The Remedies of Passing off action are in Civil Nature and particularly by way of compensation. Moreover, an infringement of trademark, passing off and rendition of accounts against the defendants.

APPLICATION

They were using the trading style SARA Exports International by the Defendant in India and abroad. Created confusion in public and created an impression in the mind of the general public, dealers and importers that the Defendant may be an organisation or a division or branch of the

Plaintiff. The articles mentioned above bearing the trademark Sara and Sarabhai denoted and connoted there were standard fields of activities regarding Plaintiff and Defendant's similar goods.

CONCLUSION

The Delhi High Court gave judgement in favour of the Plaintiff. Their Lordships held that in the circumstances held that defendants' word/mark Sara in their trading style was an apparent infringement of Plaintiff registered trademark. Further on account of deceptive trading style "Sara Exports International "which includes the central portion of registered trademark of the Plaintiff, the Defendant was passing off enabling others or causing and assisting others to pass off their goods and or business as goods and business of the plaintiffs.

NEWSPAPERS LTD. VS RATNA SHANKAR PRASAD

ISSUES

Newspapers Ltd. sought a declaration that they had the exclusive right to bring publication and sale of the entire works of late Sri Jai Shankar Prasad under the agreement dated 16th December 1936 and the registration of the copyright in favour of Ratna Shankar is ineffective in the exercise of the rights of the plaintiff.

There was also a prayer for permanent injunction restraining defendants, their agents, servants and representatives and assigns from printing, publishing and selling the works of late Sri Jai Shankar Prasad and from interfering with the plaintiff's right of printing publishing and selling the works of late Sri Jai Shankar Prasad and from infringing the rights mentioned above of the plaintiff in any other manner.

Limited the plaintiff claimed relief for a permanent injunction restraining

These three appeals are directed against the common judgment and decrees of the First Addl. District Judge, Allahabad dated 20th April 1974 in two connected suits and arose in the following circumstances.

LAW

Late Sri Jai Sankar Prasad was a voracious writer. He has written dramas, novels, Essay, stories and poetry. By 16th December 1936, he had completed 24 books, on which date he entered into an agreement with the Newspapers Ltd. Allahabad is a public limited company, carrying

on the business of printing, publishing and bringing out a Hindi Daily Newspaper known as 'Bharat'.

Under the agreement it was stipulated that Newspapers Ltd. at its own risk and expense would produce and publish the 24 books mentioned in the agreement and any other book that might be written, compiled or edited by the author in question; that during the legal term, of restricted copyright the publishers shall have the exclusive right of producing and publishing the works and the author will not during the continuance of this agreement publish or permit to be published any other edition, translation or abridgement or extract of the works and the copyright of the works shall remain the property of the author. Considering this agreement, the publisher agreed to pay the author a royalty of 20 percent of the advertised retail price on all copies sold during the legal term of unrestricted copyright. The account was to be made up annually to 31st March and delivered on or before 1st July and settled in the ensuing September.

Under the agreement it was stipulated that Newspapers Ltd. at its own risk and expense would produce and publish the 24 books mentioned in the agreement and any other book that might be written, compiled or edited by the author in question; that during the legal term, of restricted copyright the publishers shall have the exclusive right of producing and publishing the works and the author will not during the continuance of this agreement publish or permit to be published any other edition, translation or abridgement or extract of the works and the copyright of the works shall remain the property of the author. Considering this agreement, the publisher agreed to pay the author a royalty of 20 percent of the advertised retail price on all copies sold during the legal term of unrestricted copyright. The account was to be made up annually to 31st March and delivered on or before 1st July and settled in the ensuing September.

Sri Rajeshwari Prasad appearing for the respondent Sri Ratna Shankar Prasad, on the other hand, argues that the rights of the parties would be governed by the old act of 19-14, which was in force on the date of the agreement and also on the date of the death of the author. He relies on the provision to Section 5 (2) of the Copyright Act 1914.

It would be appropriate at this stage to refer to the relevant provisions of the act. Section 5 of the Indian Copyright Act 1914 in so far as it is material for the purposes of this case reads as under:

"5 (2) The owner of the copyright in any work may assign the right, either wholly or partially and either generally or subject to limitations, to the United Kingdom or any self-governing

dominion or another part of His Majesty's dominions to which this act extends, and either for the -whole term of the copyright or for any part thereof, and may grant any interest in the right by license, but no such assignment or grant shall be valid unless it is in writing signed by the owner of the right in respect of which the assignment or grant is made, or by his duly authorised agent;

Provided that, where the author of a work is the first owner of the copyright therein, no assignment of the copyright, and no grant of any interest therein, made by him (otherwise than by will) after the passing of this act, shall be operative to vest in the assignee or guarantee any rights with respect to the copyright in work beyond the expiration of twenty-five years from the death of the author. The reversionary interest in the copyright expectant on the termination of that period shall, on the death of the author notwithstanding any agreement to the contrary devolve on his legal personal representative as part of his estate and any, an agreement entered into by him as to the disposition of such reversionary interest shall be null and void. However, nothing in this proviso shall be construed as applying to the assignment of the copyright in a collective work or a license to publish a work or part of work as part of a collective work."

Section 3 of the Act of 1914, however, contemplates that the term for which copyright shall subsist shall, except as otherwise expressly provided by this act, be the life of the author and a period of fifty years after his death. Sri Shanti Bhushan relies on Section 3 and contends that even under the old Act of 1914, the copyright was to subsist for fifty years after the author's death. Section 8, however, is subject to the other provisions of the act and as an observed earlier proviso to Sub-section (2) of Section 5 of the Indian Copyright Act of 1914 provides that the copyright was to be operative only for a period of twenty-five years after the death of the author. This overrides Section 3 of the said Act. On an analysis of the provisions mentioned above it is quite clear that if the rights of the parties were to be governed by the Act of 1914, then the copyright was to extend only for twenty-five years after the author's death. The question is whether the present case would be governed by the old Act of 1914 or by the New Act of 1957. Section 79 of the Copyright Act of 1957 is a saving. Sub-section (5) of Section 79 provides:

"Except as otherwise provided in this Act, where any person is entitled immediately before the commencement of this Act to copyright in any work or any right in such copyright or to an interest in any such right, he shall continue to be entitled to such right or interest for the period for which he would have been entitled thereto if this Act had not come into force."

The saving clause also indicates that the rights and liabilities accrued and incurred under the old act are not be affected by the New Act.

APPLICATION

The agreement dated 16th December 1936 was entered at a time when the Imperial Copyright Act of 1911 and the Indian Copyright Act 1914 based on the Act of 1911 were in force. However, the said Acts were subsequently repealed by the Copyright Act No. XIV of 1957, which came into force with effect from 21st January 1958.

Sri Jai Shankar Prasad died on 15th November 1937 leaving behind his son Sri Ratna Shankar Prasad. Sri Ratna Shankar Prasad had been accepting the royalty after his father's death for some time, but by notice dated 21st July 1957, he asked the Newspapers Limited to stop publication and sell the books his father. By another notice dated 22nd June 1964 he claimed to be the absolute holder of the copyright. To give strength to his claim, Ratna Shankar Prasad also moved 25 applications to register his name as a copyright holder. The Deputy Registrar, Copyright, New Delhi, allowed his application by Ms order dated 22nd December 1971 and directed his name's entry. However, on appeal by the Newspaper Limited, the Deputy Registrar's order, copyright dated 22nd December 1971 was set aside by the Copyright Board.

Under the Copyright Act of 1957, a copyright in a literary work exists during the author's lifetime and until fifty years from the author's death. After Jai Shankar Prasad's death on 15th November 1937 his son Ratna Shankar Prasad, defendant No, 1 continued to recognise the plaintiffs in terms of the agreement, and he received royalty up to the year 1971. In the year 1964 the defendant No. 1 construed himself to be the absolute holder of the copyright in the works of his late father, but he subsequently waived his claim by accepting royalty, and he did not make any interference into the rights of the plaintiff. Again when some differences accrued in the month of June 1971 between the plaintiff and defendant No. 1 the defendant No. 1 by notice dated 1-7-1971 illegally and wrongly attempted to forbid the plaintiff from printing, publishing or selling the work of his father to which the plaintiff replied but the defendant No. 1 got his name registered by order dated 22nd December 1971. The same was, however, set aside on appeal by the Board of Copy-lights. The agreement dated 16th December 1936 is not an agreement between the parties relating to the disposition of the reversionary interest and the proviso of Sub-section (2) of Section 5 of the Indian Copyright Act cannot be invoked especially because that act had already been repealed by Act No. XIV of 1957. However, the

defendant No. 1 threatened the plaintiff by his advertisement in the month of October 1971 in Prakashan Samachar to publish the unpublished works of late Sri Jai Shanker Prasad in collaboration with defendant No. 2. Hindi Pracharak Sans-than. Under the circumstances, the plaintiff has claimed to file the suit for the reliefs aforesaid.

The claim was resisted by defendant No. 1 on various grounds; the main being that the legal term of restricted copyright for the plaintiff ended after the expiry of 25 years of the death of the author, that he had always been the owner of the copyright and had never waived his right by accepting the royalty; that of the four books viz. Indrajal, Imwati, Prasad Sangeet and Kavya Aur Kala Tatha Anya Nibandh written by the author after 16th December 1936, the book Prasad Sangeet being a compilation of selected poems and Kavya aur Kala tatha Anya Nibandh being the compilation of selected literary essays were not the subject matter and could not be a subject-matter of the agreement dated 16th December 1936; that the agreement dated 16th December 1936 was not an assignment of copyright in the 24 books named therein or any future works of the author; that late Sri Jai Shankar Prasad was suffering from tuberculosis for a considerable time prior to his death and he was not in a fit condition to write any literary work for more than one year prior to his death and so the agreement remains inoperative for any future works of the author; that the agreement of 1936 was without consideration; that the Copyright Act of 1914 was in force at the time of the agreement and at the time of the death of the author and as such the rights of the parties would be governed by the Act of 1914; that in view of Section 5 of the Act of 1914 assignments made in favour of the publisher became inoperative and ineffective after 25 years of the death of the author and the reversionary right in the copyright thereafter devolved on defendant No. 1; that the agreement in so far as it purports to have made a disposition of such reversionary interest is null and void. The jurisdiction of the court was also questioned.

In suit No. 17 of 1972 filed by Ratna Shankar Prasad against the Newspapers the defendant Newspapers Limited from printing, publishing or selling any literary works of late Sri Jai Shanker Prasad published or unpublished and to call upon the defendant to render a full and complete account of the printing, publishing and sale of the publication of late Shri Jai Shanker Prasad and to pass a decree for such amount as may be found due and also for directing, the defendant to surrender the unsold copies of all the publications of late Sri Jai Shanker Prasad together with all blocks, pictures, manuscript, negative and other things used in connection with the printing and publication of the books. It is unnecessary to refer to the parties' pleadings

in detail since the defence set up by Sri Ratna Shankar Prasad in Suit No. 4 of 1972 is virtually the plaintiff allegation in this suit and vice versa.

The next contention of Sri Shanti Bhushan is that the legal term does not mean the legal term on the agreement's date but a legal term as extended from time to time by various amendments in the act. Even assuming that at the time of the agreement the legal term for which the copyright could be extended was 25 years after the death of the author but if before the expiry of that period the New Act came into force and extended the period of legal terra from 25 years to fifty years, the appellant would be entitled to the benefit of that extended period.

CONCLUSION

The pleadings of the parties gave rise to a number of issues. The issues in the two suits being similar were taken up and disposed of by the trial court together. The trial court came to the following conclusions on the issues involved in the two suits:

The Newspapers Limited has been assigned the copyright of all the works of the Author late Sri Jai Shanker Prasad vide agreement dated 16th December 1936 upto 14th November 1962, and they had an exclusive right of publication, production and sale of all the works of the author. The agreement dated 16th December 1936 is legal, valid, binding and is for consideration and effective upto 14th November 1962.

The provisions of Section 5 (2) of the Act, 1914 are applicable to this case, and the repeal of that act does not affect the parties' rights. The estoppel ingredients had not been made out in this case, nor has the waiver or acquiescence on the part of the defendant is proved.

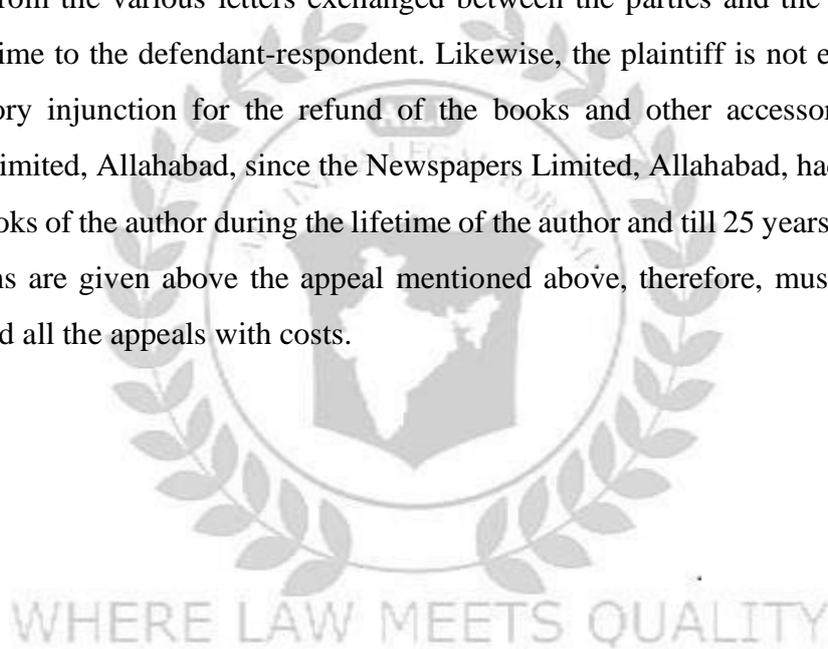
The agreement in question does not amount to a partial assignment simply because the rights of drama etc. are not given by the author. The order dated 13th July 1972 passed by the Board of Copyrights on the appeal filed by the Newspapers Limited could not be a bar in the decision of the parties' rights. The agreement dated 16th December 1936 has the effect of disposition of reversionary interest within the meaning of Section 5 of the Copyright Act of 1914. Ratna Shanker Prasad is entitled to a royalty of 15 per cent on textbooks and 20 per cent on the rest of the author's books.

The defendant's accounts were furnished to him by the plaintiff upto 31st March 1973, and as such, Ratna Shanker Prasad is not entitled to any accounting.

Suit No. 17 of 1972 for accounting was not barred by time.

In the result Suit No. 4 of 1972 was dismissed with costs while Suit No- 17 of 1972 was decreed for an injunction and the Newspapers Ltd. Allahabad was restrained from printing, publishing or selling any literary work of late Sri Jai Shanker Prasad whether published or unpublished. Other reliefs claimed by the plaintiff were however rejected. The plaintiff's claim for accounting and the mandatory injunction has been dismissed.

This leads to the other Appeal No. 153 of 1974 filed by Ratna Shanker Prasad. By this appeal, Ratna Shanker Prasad wants to have a decree for accounting. The trial court dismissed that part of the claim on the finding that it had already been accounted upto 1973, We have examined the record, and we fully endorse the finding recorded by the lower appellate court. That finding is warranted from the various letters exchanged between the parties and the payment made from time to time to the defendant-respondent. Likewise, the plaintiff is not entitled to relief for a mandatory injunction for the refund of the books and other accessories lying with Newspapers Limited, Allahabad, since the Newspapers Limited, Allahabad, had every right to publish the books of the author during the lifetime of the author and till 25 years after his death, For the reasons are given above the appeal mentioned above, therefore, must also fail. The court dismissed all the appeals with costs.



Rupendra Kashyap vs Jivan Publishing House

ISSUES

This is an application seeking grant of an ad-interim injunction in a suit filed by the plaintiff seeking relief of permanent a junction restraining the defendants No. 1 and 2 from publishing, printing or selling 3pics of question papers and for a rendition of account delivering up etc. complaining of infringement of plaintiffs copyright by defendants No. 1 and 2.

Breaching the plaintiff's rights, defendants 1 and 2 are publishing question papers of the CBSE's examinations which is an infringement of the plaintiff's copyright. It is incumbent in law for the plaintiff to trace the title to each person who has contributed to the said examination paper.

It is also submitted that the defendants have been printing and publishing question papers for over 25 years and ever since the inception of the board in 1952. The defendants are two out of 30-40 publishers over the country who have engaged in such activity for the past decades. Thus the suit suffers from laches, acquiescence and inordinate delay.

It is also submitted that the suit is against the public interest. A Government organisation having been given the responsibility to conduct examination cannot be permitted to monopolise publication of question papers required by students for their study and research.

In view of the submissions made by the learned counsel for the parties, the following questions arise for determination at this stage :

- (I) Whether a question paper set for the purpose of examining by Cbse can form the subject matter of copyright?
- (II) Who would be the owner of the copyright?
- (III) Whether the plaintiff has the cause of action for bringing the suit?
- (IV) Whether the action brought by the plaintiff suffers from delay and laches and acquiescence?

LAW

The words "literary works" in S. 13 are not confined to works of literature in the commonly understood sense but include all works expressed in writing whether they have any literary merit or not. The word" original" in S. 13 does not imply any originality of ideas but merely

means that the work in question should not be copied from some other work and should originate in the author being the product of his labour and skill. Thus question papers are "original literary works" within the meaning of Section 13 And copyright can be claimed in respect of them.", I am in respectful agreement with the view so taken. It was also not disputed at the hearing that the question papers on which examination is conducted by defendant No.3 constitute literary 'work" within the meaning of Clause (0) of Section 2 of the Copyright Act.

An extract from the manual of rules and regulation of Cbse has been filed which contains the Government of India Resolution dated 1.7.79 as amended after that from time to time. Therefore the status and constitution of the Cbse can be spelt out.

The board has been constituted to enable it to play a useful role in the field of secondary education, to raise the standard of secondary education, to make the services of the board available to various educational institutions in the country and to meet the educational needs of those students who have to move from State to State. The board shall conduct an examination at the secondary stage of education and other examinations as it may consider fitting subject to the approval of the controlling authority or as it may be called upon to conduct by the Government of India, Ministry of Education. The Secretary to the Government of India Ministry of Education and Social Welfare is the board's controlling authority.

The board shall consist of the following: i) Chairman ii) Vice Chairman (Director of Education, Delhi ex-officio). iii) One representative each of the Education Departments of the Union Territories accepting Delhi which wishes to avail of the board's services. iv) One representative each of the Territorial Councils of the Union Territories other than Delhi subject to their availability of the board's services. v) Three representatives of the Education Department of Delhi Administration, one of whom shall be an Assistant Director Education (women) vi) One representative each of the Education Departments of the Delhi Municipal Corporation and the New Delhi Municipal Committee. vii) One representative of the Ministry of Scientific Research and Cultural Affairs (now merged with the Ministry of Education & Social Welfare) conversant with the problems of Technical Education.viii) A representative of the Ministry of Health conversant with Medical education and Health Education problems in schools. ix) A representative of such other Ministries and Departments of the Government of India may be decided by the Controlling Authority. x) Two representatives of the University of Delhi to be elected by its Academic Council. xi) Three representatives of the Inter-University Board. xii) Two Headmasters of Public Schools to be nominated by the Indian Public Schools Conference.

xiii) Two representatives each of the special category of schools designated as such by the Controlling Authority who may also prescribe the method of nomination or selection xiv) One Headmaster/Principal of High and Higher Secondary Schools (other than the special schools affiliated with the board and located in the various States (other than the Union Territories) to be elected from amongst themselves. xv) Four Principals of Higher Secondary Schools in Delhi to be elected from amongst themselves by the Principals of Higher Secondary Schools affiliated with the board, at least one of whom shall be the principal of a Girls School. xvi) One Headmaster/Principal of High/Higher Secondary School from each of the Union Territories (excepting Delhi) availing of the board's services to be nominated by the respective administrations. (xvii) Head of the Central Institute of Education Delhi (ex-officio)

(xviii) : One person to represent the following professional bodies to be appointed by the Controlling Authority: (a) Engineering. (b) Agriculture (c) Medicine. (d) Industry and Commerce. (e) Fine Arts (f) Home Science.

(xix) Not more than four persons to be nominated by the Controlling Authority from amongst eminent educationists or teachers of the Institutions affiliated with the board whose services it may be considered necessary or desirable to secure for the board, keeping in view the

Composition of the Board

(xx) Not more than three persons to be co-opted members as per clause 6 (xx) shall function as the board's Governing Body. "

The board may acquire properties- moveable and immovable- and invest surplus funds of the Board in Government securities or banks approved by the controlling authority. The controlling authority shall appoint the Chairman and the Vice-Chairman on such terms and conditions of service as the controlling authority may decide. The controlling authority shall appoint Secretary upon such condition and for such period as the controlling authority may think fit. The constitution of the board may be altered and modified by the controlling authority.

It is thus clear that in the matter of the board's composition and its functioning, it has a public structure and is controlled by the Secretary to the Govt of India. The board is a society registered under the Societies Registration Act, 1860. It has been constituted for a public purpose and is controlled by the Central Government.

The claim for privilege is justified under Section 123 read with Section 162 of the Indian

Evidence Act, 1872. Reference may be had to the law laid down by the Supreme Court in **State of Punjab vs Sukhdev Singh, State of U.P. vs Raj Narain and others**, and by the High Court of Patna in the State of **Bihar vs Kastur Bhai Lal Bhai**.

The objectivity of standards and fairness and impartiality in holding the examinations cannot be maintained without the names of paper setters, moderators, printers, examiners, valuers and even tabulators- all those associated with the process right from preparing for examinations to the stage of declaring the results- being kept a guarded secret. The disclosure of such vital information, whether before, after or during the examinations, is bound to cause irreparable injury to the public interest. The claim of privilege is sustained. However, the relevant documents have been produced by the Cbse in a sealed cover, and the court has perused those documents.

Under Section 2(j) of Copyright Act' exclusive licence' means a licence which confers on the licensee or persons authorised by him to the exclusion of all other persons (including the owner of the copyright) any right comprised in the copyright in work, and "exclusive licensee" shall be construed accordingly. Under Section 14, copyright means exclusive right in case of literary work to do the following acts (amongst others):

- (I) to reproduce the work in any material form;
- (ii) to publish the work.
- (iii) to produce/reproduce or perform or publish any translation of the work and
- (iv) to make any adaptation of the work. The above-said insigina of the copyright is found to have been licensed to the plaintiff to exclude all other persons, and therefore, the plaintiff is an 'exclusive licensee' entitled to maintain an action for infringement of copyright.

APPLICATION

The Cbse defendant No.3 has supported the plaintiff. According to it no person other than the plaintiff could print, reprint, produce or reproduce, publish, distribute, circulate, sale or offer to sell, past years question papers of CBSE except the plaintiff in accordance with the terms of the agreement entered into between the plaintiff and CBSE.

Section 52(1)(a)(i) and Section 52(1)(b)(iii) of the Copyright Act, 1957 confer upon the defendant a complete defence since they have been using the Board examination papers as a

part of their several works and books in various forms in which they include answers to the said questions which are completely composed by them or persons on their behalf and in this view of the matter what they are doing is a fair dealing of the literary work for purposes of research and private study.

The written statement filed by defendant No.3 has been amended to introduce the additional pleas in defence by reference to Section 17(dd) of the Copyright Act. It is submitted that Cbse came into existence in its present form on 1.7.62. It is a society registered under the Societies Registration Act, 1960. It is controlled by the Secretary, Department of Education, Ministry of Human Resource Development. It was constituted to conduct examinations at a secondary level of education. Defendant No.3 is a 'public undertaking' as contemplated by Section 17(dd) of the Copyright Act as it is owned and controlled by the Government and has been incorporated under a resolution of the Government of India. The defendant No.3 has the exclusive copyright in the question papers used by it in its various examinations. It has examination bye-laws, instructions to the paper-setters and instructions to the moderators. The rights of Cbse are not limited to the use of the papers in the examination only. It can assign and/or license its right for publication and get a royalty.

In the examination bye-laws paper setters/ moderators are appointed for a period of three years. The term can be renewed. In order to minimise any probability of leakage, the identity of paper-setters and moderators is kept anonymous and is not disclosed even after expiry of their term.

Issues no. {6(I)} The first question needs a short and summary disposal. In view of the law laid down in Jagdish Prasad Gupta v Panneshwar Prasad Singh 1966 Patna 33, Agarwala Pub House v Board of H.S. & I Education and University of **London Press Ltd vs University Tutorial Press Ltd.** (1916)-2 Ch. D. 601. It cannot be doubted that an examination question paper is a literary work' within the meaning of Section 13(1)(a) and Section 2(0) of the Copyright Act, 1957. In Agarwala Publishing House Khurja's case (supra) it has been held by W. Brown J: "Examination question papers are "original literary works" within the meaning of S. 13 of the Copyright Act, and copyright can be claimed in respect of them.

Issues NO.{6(II)} Section 17, the relevant part thereof, provides as under: "17. First owner of copyright-Subject to the provisions of this act, the author of a work shall be the first owner of the copyright therein: Provided that - in the case of a work made or first published by or under the direction or control of any public undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein. Explanation - For

this clause and Section 28A, "public undertaking" means- (I) an undertaking owned or controlled by Government; or (II) a Government Company as defined in Section 617 of the Companies Act, 1956 (1 of 1956); or (III) a body corporate established by or under any Central, Provincial or State Act.

The term 'public undertaking' is not defined anywhere in the copyright. Act. In the context, the word 'public' means something belonging to the people, pertaining to a community or a nation in contradiction with something belonging to a private individual. The public undertaking would be an undertaking engaged in or concerned with the community's affairs, or the public and not owned or controlled by any individual or anyone having a private interest. The Cbse is discharging a public function in the field of imparting education. It has the governmental authority and privilege to conduct public examinations. The examinations conducted by it are universally recognised as having authority and sanction of the government behind. It is discharging one of the governmental functions. It has governmental supervision. It is clear that Cbse is a society which is functionally and structurally impregnated with the governmental character and discharging a public function. It is, therefore, a public undertaking.

On behalf of the plaintiff, some documents secured by him from defendant No.3 have been filed. One is detailed instructions to be followed by the paper setters before and while setting the papers apart from the guidelines to be kept in view. The relevant part of the board's rules and regulations has been extracted in the said instructions. One of them is that the question paper shall be the exclusive property of the board and its copyright shall also vest in the board.

Every paper setter has to sign a certificate of acceptance to this effect and submit it to the board along with the office copy of the question paper. Therein it is stated:- "The question paper if accepted shall be the exclusive property of the board and copyright thereof shall vest in it and I hereby assign to the said board the copyright and all other rights in the said paper including those of the copyright in such a manner as the board may think fit. "

The terms and conditions on which the paper setters set papers to go to show that the paper setters perform such a job under the direction and control of the CBSE.

Issues NO. {6(III)} (18) Copy of the agreement dated 2.7.91 entered into between the Board defendant No.3 and the plaintiff has been filed. It would be useful to notice the relevant clauses thereof.

The preliminary part of the agreement states the board (first-party) has decided to appoint a sole licensee -the plaintiff (second party)- to print, publish and sell the yearly question papers to consider the license fee to be paid by the plaintiff. Clause (2) provides the copyright in the question paper to remain always with the board. Clauses (3), (9), (12) and (13) arc relevant and are extracted and reproduced hereunder:- "3. That the first party hereby grants the second party the sole license to print, publish and sell the past question papers for classes X and Xii from 1990 examinations onwards at a price to be decided and approved by the first party in writing each year before its publication, in consideration of a fee @ 25% of the printed price of the question papers to be paid by the second party to the first party. 9. That the second party will be responsible for ensuring that no other firm uses the prescribed question papers of the board illegally and in case of violations of the rights of the First party the second party on behalf of the first party shall take such steps and legal actions as may be deemed appropriate. 12. That the first party shall issue a notification/circular to all the concerned registered publishers and institutions affiliated with the first party by way of issue of notification in three National Daily Newspapers and Board's quarterly journal with respect to the license being granted to the second party to print and sell the past year's question papers. 13. That the second party will be solely responsible for the correct printing and publishing of the past question papers of the first party from 1990 onwards examination during this agreement's subsistence.

Clause (4) obliges the plaintiff to sell a minimum of 50,000 copies of question papers each for class X and Xii in a year or else to pay a license fee on such minimum guarantee figure of sale. In case of infringement of copyright, the plaintiff has been allowed to issue legal notice.

The agreement is in writing, signed by both the parties and attested by two witnesses.

According to clause 12 of the agreement referred to in para (18.1) above, the Cbse has published notifications in the newspapers, publicly notifying the plaintiff having been appointed an exclusive licensee for publication of examination papers for the previous years commencing 1990 onwards. All such notifications published in Jansatta, Delhi dated 13.9.91, Nav Bharat Times, New Delhi dated 4.8.91, Times Of India New Delhi dated 4.8.91 have been filed.

In the written statement of defendants, 1 and 2 vide para 4 of the preliminary objections, as also in reply to the application, reference has been made to Section 52(1)(a)(i) and S 52(1)(b)(iii) of the Copyright Act as providing the defences available to defendants 1 and 2. In the Copyright Act, there is nothing like sub-clause (iii) to be found under clause (b) of sub- section (1) of

Section 52 of the Act. That reference appears to be mistaken. It would, therefore, suffice to deal with the plea raised by reference to S. 52(1)(a)(i) of the act, which provides among other things, that a fair dealing with the literary work for the purpose of research or private study does not constitute an infringement of copyright. The words 'research or private study' have been substituted by the words 'private use, including research' by the Copyright (Amendment) Act, 1994 (Act 381 of 1994). What is contemplated is a defence to the person conducting research or private study which while doing so, if dealing fairly with a literary work, may not incur the wrath of the copyright having been infringed.

However, if a publisher publishes a book for commercial exploitation and in doing so infringes a Copyright, the defence under section 52(1)(a)(i) would not be available to such a publisher though the book published by him may be used or be meant for use in research or private study. The defence raised by defendants 1 and 2 based on Section 52(1)(a)(i) is not available to them and the plea so raised has to be rejected. The works published by defendants No.1 and 2 and brought on the record are an apparent infringement of copyright vesting in defendant No.3 and licensed exclusively to the plaintiff. The plaintiff does have a cause of action.

10. issues No {6(IV)} There is no question of delay, laches or acquiescence. The agreement was entered into with the plaintiff on 2.7.1991. Every year's question papers and each question paper would be the subject matter of copyright. Infringement of copyright as regards each of the papers would constitute an independent and fresh cause of action. The suit has been filed on 22.7.93 after giving notices. The action cannot be said to be delayed or suffering from vice or laches or acquiescence.

It was also submitted on behalf of defendants 1 and 2 that it would not be in the public interest and not in the students' interest if the right of publication in the examination papers was permitted to remain in the plaintiff's monopoly. This argument bears a fallacy. Knowledge of the questions appearing in the examination papers conducted for the previous years is undoubted of immense use to the students and scholars, but that information is available in the publication made by the plaintiff.

It is not the case of defendants 1 and 2 that the plaintiff is making any misuse of the exclusive license given to him by withholding the examination papers' publication. On the contrary, the Cbse has taken care to see in its agreement with the plaintiff that a minimum number of copies of examination papers are published. The plaintiff publishing examination papers under the license given by the Cbse subject to payment of royalty accompanied by a minimum guarantee

is not going to gain by withholding publication either wholly or partially if there be a demand of such question papers in the market. Moreover, the law as to copyright in India is governed by a statute which does not provide for defence in the name of public interest. An infringement of copyright cannot be permitted merely because it is claimed to be in the public interest to infringe copyright.

CONCLUSION

The proforma referred to hereinabove having been duly signed by paper setters leaves no manner of doubt that the applicability of S. 17(dd) is clearly attracted to the facts of the case and Cbse defendant No.3 would be the first owner of the copyright in the examination papers. Even if the ownership had vested in the paper setter than it has stood assigned to the board. It may be noted that there is no particular form prescribed for assignment and it may be affected by any document in writing, even by a letter. The only requisites of the assignment are that it must be in writing and it must be signed by the assignor or his duly authorised agent.

The plaintiff has made out a strong prima facie case in his favours. Irreparable injury is likely to be caused to the plaintiff by infringement of copyright. The quantum of damages suffered by the plaintiff on account of illegal acts of defendants 1 and 2 would be incapable of being estimated in terms of money. The plaintiff is, therefore, entitled to the grant of injunction as prayed for.

I.A. 1656/93 for the grant of an interim injunction is allowed. The defendants 1 and 2 are restrained from causing an infringement of the plaintiff's copyright in all the past years question papers of an examination conducted by defendant No.3 from 1990 onwards by publishing, printing, selling and offering to sell the infringing copies of the said question papers.

ABOUT ALL INDIA LEGAL FORUM

All India Legal Forum (AILF), the brainchild of several legal luminaries and eminent personalities across the country and the globe, is a dream online platform which aims at proliferating legal knowledge and providing an ingenious understanding and cognizance of various fields of law, simultaneously aiming to generate diverse social, political, legal and constitutional discourse on law-related topics, making sure that legal knowledge penetrates to every nook and corner of the ever-growing legal fraternity. AILF also houses a blog that addresses contemporary issues in any field of law. We at AILF don't just publish blogs but we also guide the authors when their research paper is not up to the mark.

AIM OF AILF

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PEOPLE BEHIND AILF

The biggest asset of AILF is our team of more than 400 law students across the country to tackle basic problems which a legal researcher encounters in day to day life. Putting forward the basic tools and ideas needed for researching and drafting, AILF seeks to help and encourage people to write research papers efficiently and effectively. AILF is not just a blog but a platform to make legal research effortless and undemanding. We at AILF consider dedication and determination as ultimate requisition to be a good researcher and we thrive to instill these values.



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