

CITMA REVIEW

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DESIGNS PINNED DOWN

*From US strategy to UK filing data
and EU decisions, our authors
map the latest designs territory*

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ಕಾರ್ತವೀರ್ಯ | ಗಂಧರ್ವ ರಾಜು | ದಿವ್ಯಾಕಾಶ | ಸ್ವರ್ಗ ರಮೇಶ್ | ಸಮೀಶ್ ಅಜೀಶ್
ವಿಶಾಲ ಕರ್ನಾಟಕಕ್ಕೆ ಪಂಚರತ್ನ: ಶ್ರೀ ವಿಶಾಖಾ ಜನೀಯ ಸ್ಟಾರ್ ವೆಡ್ಡಿಂಗ್ಸ್



FIGHTS



With Bollywood a vital economic engine, Shilpi Mehta Nanda considers some notable IP conflicts in India's film industry

William Shakespeare may have written: "What's in a name? That which we call a rose / By any other word would smell as sweet". But this is a position with which the Indian film industry surely disagrees, if evidence from a plethora of legal battles over the titles of Hindi films is any indication.

A film's title is certainly important in connecting that motion picture to the audience and distinguishing a product (the film) from others. A title is the first contact between the audience and the film, and it is thus crucial that it makes an excellent first impression. So what protection is accorded to this very valuable IP asset?

In terms of titles for single motion pictures (those that are not part of a series) the Kanungo Media case offers a reasonable primer on the concept of trade mark protection.¹ The Court, quoting McCarthy, held that titles of single literary works/motion pictures have to acquire secondary meaning in order to be protected under trade mark law. In particular, the Court noted that:

"... Regardless of the arbitrary or fanciful nature of the title as compared with the contents of the single book, play, movie, record, etc, secondary meaning is required. Thus, unlike ordinary marks, literary titles of single works which are inherently distinctive are not accorded immediate protection, absent proof of secondary meaning and consumer recognition."²

The Court further held that, to justify a temporary injunction in a case of an unregistered title, and to establish a secondary meaning, the title of the motion picture should be capable of associating itself with the particular work or source, and there should be a likelihood of confusion of source, affiliation, sponsorship or connection of potential consumers/audience.

In the above-mentioned case, the Plaintiff (Kanungo Media Pvt Ltd) had produced a Bengali-language film entitled *Nishabd* in 2005. The

film was shown at various film festivals and won several prizes, but was not commercially exploited. In April 2006, the Defendants announced that they were producing a Hindi-language film with the name *Nishabd*. The Court, after reviewing the evidence, found that the general public associated the title *Nishabd* more with the Defendants' film than with the Plaintiff's, because of the wide publicity and extensive advertisement of the Defendants' film.

The Court also gave weight to the fact that the Plaintiff's film was a Bengali documentary, whose viewership was substantially smaller than the Defendants' mainstream Hindi film. It said that, though the Plaintiff's film had achieved critical acclaim at film festivals, the viewership at such events is limited and of a particular type.

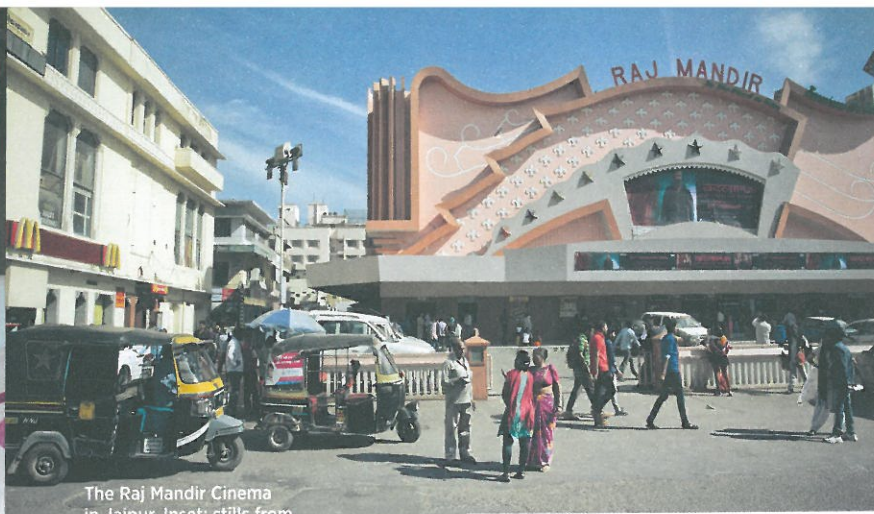
The Court further provided a list of factors that can infer secondary meaning in literary titles: (i) the length and continuity of use; (ii) the extent of advertising and promotion, and the amount of money spent; (iii) the sales figures on purchases or admissions, and the number of people who bought or viewed a work; and (iv) the closeness of the geographical proximity and product markets of plaintiff and defendant.

FAMOUS FACES

In *Sholay Media and Entertainment Pvt Ltd v Parag M Sanghavi*³, the Delhi High Court restrained the Defendant from manufacturing, selling, offering for sale, distributing, advertising and in any other manner using the registered and extremely well-known film title *SHOLAY* or any other deceptively similar mark amounting to an infringement of the Plaintiff's famous and registered trade mark. The rationale of Indian courts in only protecting such well-known titles was summed up by Justice AK Sikri in *Kanungo Media*. He explained that a literary work is a "specific, separate and

1. *Kanungo Media (P) Ltd v RGV Film Factory* (2007) (34) PTC 591 (Del); 138 (2007) DLT 312
 2. *McCarthy on Trademarks and Unfair Competition*, 3rd edition (1995), Vol 1
 3. *CS (OS) No 1892/2006*, order dated 5th October 2006





The Raj Mandir Cinema in Jaipur. Inset: stills from *Bride and Prejudice*

unique commercial item and not one product among many competing products". The justice continued: "Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Thus, in fact, this is the genesis for the adoption of the test of secondary meaning for [the] title of a literary work."

In *Biswasroop Roy Choudhary v Karan Johar*⁴, the Plaintiff sought an interim injunction restraining the Defendants from using the title of the motion picture *Kabhi Alvida Naa Kehna*. The Court held that: "Neither party has conceived or authored the words 'Kabhi Alvida Naa Kehna' since admittedly they are part of the lyrics of an extremely popular film song of a vintage spanning over a quarter century and have been on the lips of any number of persons on any given day, throughout India." It issued the caution that: "Where words or phrases in common parlance are sought to be used with exclusivity, the court should take care to determine which of the parties has ended its journey or traversed an appreciably longer way in the use of such words as a trademark or as a title."

SERIES TITLES

In contrast to the treatment of single titles, a series of titles of motion pictures are seen to serve a source-identification function and thus are protected under Indian trade mark law. For example, the series of titles related to *Munna Bhai MBBS*, *Lage Raho Munna Bhai* and *Munna Bhai Chale Amerika*; *Dhoom* and *Dhoom 2*; *Krrish*, *Krrish 2* and *Krrish 3*; *Hera Pheri* and *Phir Hera Pheri* are well protected under Indian trade mark law. The Delhi High Court in *Kanungo*



Media specified that the titles of a series of motion pictures function as a trade mark to indicate that each edition comes from the same source as the others and, therefore, such titles are registerable as trade marks.

COPYRIGHT PROTECTION

Film titles are not protected under copyright law in India, as they do not pass the threshold of being more than *de minimis*. In *Kanungo Media*, the Court held that the title of a literary work cannot alone be protected by copyright law in India, when considered separately from the plot, characterisation, dialogue, theme song, etc.

And the Supreme Court, in *Krishika Lulla v Shyam Vitalrao*

FILM IN INDIA: REGISTRATION BASICS

Protected under:
Trade Marks Act, 1999

Type of registration:
Service mark

Class:
41 (Fourth Trade Mark Rule, 2001)

Registration categories:
Title of a series of films; single film

Notable registration conditions:
Secondary meaning, in the case of the title of a single film. Established with relation to: duration and continuity of use; strength of advertisement and promotion; production budget; scale of sales and distribution.

*Devkatta*⁵, held that, generally, there would not be any copyright protection for titles of literary works. In that case, the Respondent had written a synopsis of a story titled "Desi Boys" and emailed it to two people. The Respondent sued the Appellants, claiming that they had infringed on his copyright in the title *Desi Boys*, having released a film by that name throughout India in November 2011. The Supreme Court said that the title of a work is not complete by itself, taken separately from the work. Moreover, the combination consists of "Desi" and "Boys", which are common words, and there cannot be said to be anything original about it.

Ultimately, the title is an important and indispensable part of the bundle of IP rights a producer has in a motion picture. Accordingly, while Indian law aims to avoid consumer confusion in the marketplace, it also protects producers who have invested in a motion picture and its title from infringement and unfair competition. ●



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4. 131 (2006) DLT 458
5. Criminal Appeal No 258 and 259 of 2013, decided on 15th October 2015