

(2017) 10 MAD CK 0076

In the Madras High Court

Case No : 942 of 2017 in C S No 747 of 2017

A. Rajendran

APPELLANT

Vs

Thenandal Studios Limited

RESPONDENT

Date of Decision : 06-10-2017

Acts Referred:

Citation : (2017) 10 MAD CK 0076

Hon'ble Judges : Dr. Anita Sumanth

Bench : SINGLE BENCH

Advocate : Dr. Anita Sumanth

Final Decision : Dismissed

Judgement

1. The suit has been filed praying for an injunction restraining the respondents permanently from passing off of the title for a motion film, "MERRASALAITAN" with "MERSAL". Inter alia ad interim relief is sought of the same nature as the main relief.

2. The applicant is a film producer claiming to be active in the industry for over a decade. He claims proprietary right over the title "MERRASALAITAN" on the ground that the title had been registered with the Tamil Nadu Film Producers Council (hereinafter referred to as "TNFPC"), having obtained a no objection in this regard from M/s.Green Apple Pictures that had earlier registered the title "NAAN MERRASALAITAIN".

3. It thus came to be that the title "MERRASALAITAN" was registered by the applicant with the TNFPC as early as in 2014. The registration is being renewed year on year. As a follow through to this, the applicant would claim to have entered into agreements with various artists, musicians, editor, designer, design and publicity personnel, lyric writer, dialogue writer, production manager and other persons between August 2014 and January 2016 and to have paid them advances for their services ranging from Rs. 5.00 lakhs to Rs. 12.00 lakhs. Thus, according to the applicant, significant investments have been made by him

towards the proposed production of the film titled "MERRASALAITAN".

4. Though the plaintiff would aver that a Pooja had been performed and a first look poster issued on 17.8.2016, no evidence has been placed before me to establish these statements. All it appears is that the title was indeed registered with the TNFPC and services of various technical and creative personnel had been engaged, though admittedly, serious production is yet to commence.

5. The challenge in the application is to the adoption of the title "MERSAL" by the first respondent production house of which the second respondent is proprietor, in a motion picture, starring Mr.Vijay that came to the knowledge of the applicant on 20.06.2017. The applicant would state that a complaint had been filed before the TNFPC in this regard on 21.6.2017, but that no action had been taken by the TNFPC thereon. As a counter blast, the respondent, it appears, has registered the name "MERSEL" as a devise mark with the Trade Mark Registry on 30.6.2017 and an opposition raised in this regard by the applicant.

6. The adoption of the title "MERSAL" in the forthcoming production of the respondents is, according to Mr.AR.L.Sundaresan, learned senior counsel appearing for Mr.A.V.Arun, learned counsel for the applicant, nothing but passing off of the title "MERRASALAITAN" in over which the applicant claims proprietary right. An argument was taken to the effect that the forthcoming production of the respondents starring Mr.Vijay was variously titled "MOONDRU MUGAM", "SOOLAM" and "VIJAY 61" and it was solely for the purpose of riding upon the reputation of the applicant as well as passing off the title "MERRASALAITAN" which had come to be associated with the applicant, that the respondents had changed the name of the production to "MERSAL".

7. Mr.Sundaresan, would emphasise that if the film "MERSAL", imminent for release by the respondents, and his clients' film "MERRASALAITAN" are screened together, it would, apart from creating a confusion about the film, also result in prejudice and loss to the applicant. However, it is admitted that the story/idea of the forthcoming film of the respondents is no way similar to the applicant's film, which, as the Court is informed, is at a very nascent stage of production now.

8. Mr.P.S.Raman, learned senior counsel appearing for Mr.S.Vijayan, learned counsel for respondent No.1 would oppose the relief sought for strenuously and for various reasons. He would point out that the word "MERSAL" is a generic word in Tamizh over which none could claim exclusive right. Moreover, the registration of a title with the TNFPC is solely to serve the purpose of avoiding duplication of titles and does not create any other enforceable right over such title. With respect to the allegation of passing off, he would brush aside the same, stating that the remedy of passing off requires one to establish exploitation of the exalted reputation and superior resources of one by another. He would wonder whether the respondents could lay claim to such elevated status and, point out that, in fact, nothing had been placed on record to establish

such a position.

9. He would also object to the statement of the applicant that the name "MERSAL" had been adopted consciously as a means of passing off and in substitution to earlier titles that had been proposed for the film. He would deny vehemently that "SOOLAM" have ever been proposed as a title for the subject film. As regards "VIJAY 61", he would state that it was common practice in the industry to name the film after the main artist with a chosen number appended to the name. This was only an interim arrangement adopted as a means to reference the film, till the appropriate name was finalised. All in all, he would reiterate that the claim was entirely baseless and liable to be rejected.

10. Heard learned counsel in detail and perused the papers.

11. The present prayer is limited to an allegation of passing off of the title "MERRASALAITAN" with "MERSAL". The right claimed is in the title of the film, one that admittedly, does not exist as in of today. While the applicant would claim to have protected his right over the title by registering it with the TNFPC, the prayer sought is not one in regard to infringement and rightly so since mere registration of the title with the TNFPC, would, in any event, not afford any statutory protection in this regard. In fact, the Supreme Court, in *Krishika Lulla v. Shyam Vithalrao Devkatta* (2016 (2) SCC 521), concludes that no copyright would subsist in the title of a literary work and the only remedy that could be sought, if at all, is in an action for passing off.

12. Though Mr.Sundaresan would claim that the word "MERSAL" has been coined by the applicant, the claim has only to be made to be rejected. The word "MERSAL" appears to be a corruption of the word கபுலம். which according to modern Tamizh dictionaries is a noun meaning "(fz;fspy; bjhpa[k;] gak; epiwe;j fyf;fk;; (kdj;jstpy;) kpuz;L nghFk; epiy; kUl;rp; fright; dismay; bewilderment." vd;idg; gh;h;j;jk; mtDila fz;fspy; xU kpul;rp-kpul;rpia Vw;gLj;Jk; etPd; bjhHpy;El;gk;/ The word ""bkh;ry;" thus appears to be a local and casual adoption of the word "kpul;rp" a pre-existing word in Tamizh, available for use in all its colour and connotation as the language would allow.

13. The Bombay High Court in the case of *Anil Kapoor Film Co. Pvt. Ltd. v. Make My Day Entertainment & another* (2017 SCC Bombay 8119) considered the veracity of an action for passing off in a similar situation. The plaintiff in that case was proposing to make a film entitled "Veere Di Wedding" finding to his chagrin that the first defendant also made a film with the same name. Protection had been sought by the plaintiff for this title by registering the same with the Indian Film and Television Producers Council. It had specifically been contended that the name had come to be associated with the film proposed to be released by the plaintiff by reason of wide advertisement. Media reports revealed that considerable reputation and goodwill had been acquired by the plaintiff in relation to the aforesaid title. The public, according to the plaintiff in that matter, had thus come to identify the said film with his production house.

14. Notwithstanding the efforts made by the plaintiff, the Bombay High Court declined injunction rejecting the argument of passing off. It was emphasised that a case for passing off has to establish deception and loss of reputation occasioned by such deception. If one were to test the aforesaid two parameters in the present case, there is not a shred of evidence on record to show that the respondent has exploited the reputation of the applicant in connection with the use of title in question. The alleged action for passing off has to be seen in the context of whether the title in question has been exploited by the applicant at all. As it has revealed, the title has not been put to use by the applicant even for itself and the question of riding on the reputation of the applicant qua the title MERSEL thus hardly arises.

15. Admittedly, the applicant has not initiated any action of note in this regard between 2014 when the title is stated to have been registered with the TNFPC till date. Promotional material has been placed on record but, as Mr.Sundaresan would fairly admit, the advertisements are yet to see the light of the day. The applicant would make a lukewarm attempt to state that production has commenced now. Even assuming so, such preliminary action at this late juncture is a far cry from the stringent threshold required to justify an action for passing off which is that the exploitation of the title is to such degree that the public is aware of the proposed production and is awaiting the same expectantly. This situation does not arise in the present case. An action for passing off and presumption of confusion has necessarily to be based on concrete material and cannot be granted on an admittedly anticipated act sometime in the vague future.

16. A Division bench of the Bombay High Court in K.M.Multani v. Paramount Talkies of India - AIR 1942 Bombay 241 rejecting an injunction in similar circumstances states thus: "6. The film industry is comparatively modern, and apparently the only case of a passing-off action relating in any way to a film is the recent decision of the Privy Council in Francis Day and Hunter, Ltd. v. Twentieth Century Fox Corporation, Ltd. [1940] A.C. 112 where the complaint was that a film was being produced by the! defendants under the same name as a song the copyright in which belonged to the plaintiffs. The Privy Council held that there could be no possibility of deception of the public by producing a film under the name of a well-known song. Courts frequently have to adapt old established principles to new conditions of life, and it is quite possible that in relation to the film industry some developments may take place in the law relating to passing-off. The evidence in this case is that the title of a film is very important; and another peculiarity of a film is that its life is comparatively short. It is not like a book which may be in circulation for years. It might be very difficult to establish the reputation of a film under a particular title, and its association in the public mind with the plaintiff, by evidence of the actual production of the film. I can imagine a case in which the advent of a film under a particular title had been very extensively advertised, and arrangements made for the booking of the film, and in which some other person produced a film under the same title shortly before the advertised film arrived. It is quite possible that

in a case of that nature a passing-off action would succeed, although generally the plaintiff must establish the reputation of his property by actual results. See the case of *Licensed Victuallers Newspaper Company v. Bingham* (1888) 38 Ch. D. 139 in which the plaintiffs sued to restrain the defendants from publishing a newspaper under the same title as the plaintiffs' newspaper and failed on the ground that the plaintiffs' newspaper had only been published for three days before the date of action, and the Court held that sufficient reputation could not be acquired in that time to found a passing-off action."

17. Useful reliance can also be placed on the decision of the High Court of Justice - Chancery Division in *Hodgkinson Corby Limited and another v. Wards Mobility Services Limited* (1995 FSR 169), in which, the Bench, while reiterating the well settled position that the foundation of an action to pass off lies in deception, holds that it was critical for the person alleging passing off to show that the public was actually moved to buy the product passed off, under a misconception that it was the original. In the present case, the allegation of passing off is itself made only in respect of a title to a non-existent film as on date. The entire case of the applicant is based on the premise of probabilities and assumptions - assumed right to the title, assumed prejudice to reputation caused by non-existent use of the film title and assumed deception by the respondents. The prayer, for passing off simpliciter, cannot be sustained in the facts and circumstances of this case.

18. The request for injunction is dismissed and the application stands dismissed.