

(2002) 09 BOM CK 0019

In the Bombay High Court

Case No : Notice of Motion No's. 2884 of 2001 and 309, 315 and 316 of 2002 in
Suit No. 3963 of 2001

Asian Paints (I) Ltd.

APPELLANT

Vs

Jaikishan Paints and Allied Products

RESPONDENT

Date of Decision : 12-09-2002

Acts Referred:

Copyright Act, 1957 — Section 46, 48

Citation : (2002) 4 ALLMR 637 : (2002) 6 BomCR 1 : (2002) 4 BOMLR 941 :
(2003) 1 CivCC 119 : (2002) 4 MhLj 536

Hon'ble Judges : S.J. Vazifdar, J

Bench : Single Bench

Advocate : Ravi Kadam, Manish Saurashtra and Priti Vyas, instructed by Shantilal and Co, for the Appellant; Sudhir Vodital, instructed by Merlyn Monteior, for the Respondent

Judgement

S.J. Vazifdar, J.—As the order in each of the Notice of Motion require to be prefaced with the facts, it would be convenient to deal with them by a common order.

2. Notice of Motion No. 2884 of 2001 was taken out by the plaintiff for interim reliefs.

The defendant took out Notice of Motion No. 309 of 2002 for dismissal of the suit on the ground that this Court has no territorial jurisdiction and for an order returning the plaint under Order 7, Rule 10 of the Code of Civil Procedure. In this Notice of Motion the defendant has also prayed that the plaintiff be refused leave under Clause XIV of the Letters Patent. The defendant is at liberty to urge this contention in the plaintiffs application for leave under Clause XIV of Letters Patent.

Notice of Motion No. 315 of 2002 has also been taken out by the defendant to vacate the ad-interim order dated 27th November, 2001 passed by this Court. However, as Notice of Motion No. 2884 of 2001 is being finally heard it is not

necessary to decide this Notice of Motion.

The defendant has also taken out Notice of Motion No. 316 of 2002 praying for dismissal of the suit under Order 7, Rule 11 read with Section 151 of the CPC on the ground that the plaint discloses no cause of action against the defendant.

3. The plaintiff filed the suit to restrain the defendant by a perpetual order of injunction from using the impugned label "Utkarsh" and/or any other label containing the artistic work, design, lay out, colour scheme, schematic arrangements and get up which is alleged to be an imitation and/or colourable imitation of the artistic work, design, lay out, colour scheme, schematic arrangements and get up contained in the plaintiffs label so as to infringe the plaintiff's copyright contained in the label "Utsav" registered under the Copyright Act. The plaintiff has also sought to restrain the defendant from passing off its goods as those of the plaintiffs by using the impugned trade mark and label of "Utkarsh" and/or any other deceptively similar mark or label to the plaintiffs mark "Utsav" and/or "Utsav" label. Further the plaintiff also seeks to restrain the defendant from using in relation to paint and other allied goods including distemper, the impugned "Utkarsh" label and/or any other mark or label identical with and/or deceptively similar to the plaintiffs "Utsav" mark so as to infringe when registered the plaintiffs "Utsav" label pending an application No. 588219 dated 8th January, 1993. Finally the plaintiff has claimed damages and delivery of all the material bearing the impugned mark under the order of this Court. Notice of Motion No. 2884 of 2001 is for interim reliefs in terms of the aforesaid substantive reliefs.

4. The plaintiff is engaged in the business of manufacturing and/or marketing paints and colouring matter.

5. In 1992, the plaintiff adopted and commenced the use of the trade mark consisting of the word "Utsav" in relation to synthetic distemper, which is a kind of paint. The plaintiff got prepared from an artist Ms. Usha Inamar a label containing original artistic work and published the same, I shall describe the art works of the plaintiff and the defendant later when I deal with the question of infringement.

6. After filing the suit, the plaintiffs applied for leave under Clause XIV of the Letters Patent to join several causes of action relating to infringement of trade mark, passing off and infringement of copyright. That application is pending. It is not necessary therefore at present to deal with the plaintiffs case of infringement of its trade mark (when registered) and passing off as leave under Clause XIV of the Letters Patent has not yet been obtained by the plaintiffs. Mr. Ravi Kadam, the learned counsel appearing on behalf of the plaintiff has therefore confined his arguments to the case of infringement of copyright.

7. This brings me to the Notice of Motion Nos. 309 and 316 of 2002 taken out by the defendant. Mr. Vodital, the learned counsel appearing on behalf of the defendants submitted that this Court has no territorial jurisdiction in respect of

the plaintiffs case for infringement of copyright. He submitted that the defendants copyright is registered under the Copyright Act. He further submitted that once the defendants copyright is registered, it cannot be said to infringe any other copyright. At the very least, he submitted, the defendants user is bona-fide. He then submitted that the plaintiff falsely averred that no reply to one of its notices had been received from the defendants.

It will be necessary for me to deal with both these contentions while considering the merits of the plaintiffs case in Notice of Motion No. 2884 of 2001. At present while dealing with the question of jurisdiction, it is not necessary for me to consider these two submissions. They are relevant while dealing with the case on merits but not while deciding the question of jurisdiction for, even if established, these aspects would affect the plaintiffs case on merits but would not deprive this Court of jurisdiction to entertain and try this case.

8. Section 62 of the Copyright Act, reads as under :-

"Jurisdiction of court over matters arising under this Chapter:--

(1) Every suit or other civil proceeding arising under this Chapter in respect of the infringement of copyright in any work or the infringement of any other right conferred by this Act shall be instituted in the district court having jurisdiction.

(2) For the purpose of Sub-section (1) a "district court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908), or any other law for the time being in force, include a district court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or other proceeding or, where there are more than one such persons, any of them actually and voluntarily resides or carries on business or personally works for gain."

Sub-section (2) of Section 62 of the Copyright Act entitles the plaintiff to file a suit or other civil proceedings in respect of infringement of copyright where the plaintiff resides or carries on business or personally works for gain. The plaintiff has established that its place of business is in Mumbai and that it is carrying on business for gain in Mumbai. The whole cause of action relating to infringement of copyright therefore according to them has arisen in Mumbai. The plaintiff has further stated that the defendant manufactures and markets the impugned goods under the impugned trade mark/label outside the jurisdiction of this Court. The act therefore, of passing off and infringement of trade mark has taken place outside the jurisdiction of this Court. In these circumstances, the plaintiff applied for leave under Clause XIV of the Letters Patent.

9. Mr. Vodital further submitted that the plaintiff had cleverly, by combining the case of infringement of copyright with the case for passing off brought the suit within the jurisdiction of this Court. I see no merit in this submission. If the plaintiff is desirous of suing the defendant for infringement of its copyright Section 62 permits him to do so in this Court. If the plaintiff in addition desires to

sue the defendant in respect of passing off in the same suit where the cause of action for passing off has arisen outside Bombay, he is entitled to do so after obtaining leave under Clause XIV of the Letters Patent.

In *Glaxo Operators U.K. and Anr. v. Samrat Pharmaceuticals*, reported in 1984 PTC page 66, the Delhi Court held as under :--

"10. During argument the complaint of the counsel for the defendant was that the plaintiff had acted with cleverness by way of combining his cause of action on the basis of trade mark with the one on the basis of copyright so that they could bring suit in respect of both the causes of action at Delhi, that cleverness should not be encouraged and that, therefore, it should be held that this court has no territorial jurisdiction to entertain the suit. But in my view there is hardly any cleverness. The plaintiffs desire protection against infringement of their rights with respect to their product Glucose-D and Glucon-D. The products are the same while different types of rights are claimed. The plaintiffs claim rights as proprietor of registered trade mark as well as copyright with respect to the carton of the same very product. Not only that the plaintiffs could combine these causes of action on the basis of registered trade mark and registered copyright, but also it was absolutely necessary to have done so because the same were being claimed in respect of the same product."

I am in respectful agreement with the same. This Court, therefore, has jurisdiction to try the suit insofar as it relates to infringement of copyright. In the circumstances, Notice of Motion Nos. 309 of 2002 and 316 of 2002 are dismissed.

10. Notice of Motion No. 315 of 2002 is for vacating the ad-interim order passed in Notice of Motion No. 2884 of 2001. As the main Notice of Motion taken out by the plaintiff is being heard, Notice of Motion No. 315 of 2002 does not survive.

11. This leaves for consideration Notice of Motion No. 2884 of 2001 taken out by the plaintiff.

The plaintiffs case is that in 1992 it got prepared from Ms. Usha Inamar a label containing original artistic work, design, layout, distinctive schematic arrangements, distinctive colour scheme and get up and published the same. The plaintiff obtained registration thereof as evidenced by registration certificate dated 30th September, 1994 issued under the Copyright Act. The Registration Number is A-52668/94. The registration certificate states that the label was first published in 1992 by the plaintiff.

(a). The plaintiff also applied for registration of the label under the Trade and Merchandise Marks Act, 1958 under an application dated 8th January, 1993 bearing No. 588219 which is pending. The plaintiff has also filed an application for registration of the word mark "ASIAN PAINTS UTSAV" in class II under application No. 579838 dated 26th August, 1992. As stated earlier the present application is not based on the plaintiffs case of passing off or infringement of the plaintiffs trade mark. I intend therefore, to refer only briefly to the plaintiffs

averments in respect thereof without expressing any opinion regarding the same.

(b). The plaintiff claims to have been using the said trade mark "Utsav" and the "Utsav" label in respect of paint continuously, extensively and openly since the year 1992 in relation to paints. The plaintiff markets the goods through a wide network of dealers, stockists and distributors spread throughout the country. It is not necessary to deal in detail for the present purpose with the plaintiff's efforts to promote its products under the said trade mark. Suffice it to say that six months sale of the plaintiff's products bearing the said trade mark and copyright ranges from Rs. 5,91,08,000/- for the year 1995-96, to Rs. 22,87,82,000/- for the year 1999-00. The plaintiff spent towards advertising and promotional expenses Rs. 1,50,00,000/-, Rs. 1,80,00,000/- and Rs. 2,45,00,000/- during the years 1997-98, 1998-99 and 1999-2000.

12. In or about July, 2001 the plaintiff came across a paint manufactured by the defendant bearing the trade mark "Utkarsh" and the impugned label which according to the plaintiff contains a design, layout and get up and even colour scheme similar to the plaintiff's said label.

13. The plaintiff by its advocate's letter dated 26th July, 2001, served a cease and desist notice upon the defendant. The defendant by its advocate's letter dated 6th August, 2001 replied to the same. In paragraph 9 of the reply, it was stated that the defendant had obtained a certificate of registration of copyright in respect of the impugned work and that therefore, the defendant was not liable for infringement of the plaintiff's copyright.

Thereafter, the plaintiff by its advocate's letter dated 26th September, 2001 forwarded certain information and the documents sought by the defendant's advocate in their letter dated 6th August, 2001. The defendant was also called upon to forward a copy of the copyright registration alleged to have been obtained by the defendant.

In paragraph 9 of the plaint after referring to the letter dated 26th September, 2001, it is stated; "so far no reply has been received by the plaintiff to the plaintiff's attorney's letter dated 26th September, 2001."

14. Mr. Vodital; submitted that the Notice of Motion ought to be dismissed, as according to him the plaintiff falsely stated that there was no reply to its advocate's letter dated 26th September, 2001, when in fact it was replied to by the defendant's Advocate's letter dated 3rd October, 2001. The letter dated 3rd October, 2001 is annexed to the defendant's written statement. According to Mr. Vodital, this letter dated 3rd October, 2001 was suppressed because the plaintiff wanted to suppress the following part of the letter :

"4) As to para d : As regards the certificate of Copy Right of our "UTKARSH" Label bearing No. A-58350/2001, may be obtained by you from the office of Copy Right, which is the office of Public Record."

Mr. Ravi Kadam, on the other hand submitted that omission was inadvertent.

15. I agree with Mr. Kadam. There really is no question of suppression. In the letter dated 3rd October, 2001, which according to Mr. Vodital the plaintiff had suppressed, the defendant merely referred to the fact that it has obtained the certificate of registration in respect of the impugned label and stated that the plaintiff could obtain the same from the "office of the Copyright". I fail to see how there can be any case of suppression. The defendant's advocate's reply dated 6th August, 2001 which is annexed as Exhibit-I to the plaint also stated that the defendant had obtained a certificate of registration of Copyright in respect of the infringing work. If the plaintiff wanted to suppress the defendant's statement to this effect, it would have also suppressed the letter dated 6th August, 2001, In the circumstances, Mr. Vodital's submission is rejected.

16. This brings me to the main question in Notice of Motion No. 2884 of 2001 viz. whether the defendant has committed the act of infringement in respect of the plaintiffs said art work.

17. I will now describe the art works of the plaintiff and the defendant.

(a) The plaintiffs work :--

The top half of the background is yellow and the lower half is red. At the top of the label are placed alternatively red and green right angle triangles positioned such that the right angle appears on the top at the left. Across the yellow portion the word "Utsav" appears in red letters. Above the letters "Ut" are the words "asian paints" in green. Above the letters "s" and "a" is a device comprising of a circle with sprockets forming a jagged perimeter made up of eight equilateral triangles coloured red and green alternatively. The word "Utsav" is underlined in green. Centering and below the word "Utsav" appear the words "SYNTHETIC DISTEMPER", Below the words "SYNTHETIC DISTEMPER", the background is red.

The yellow and red background are divided by a wavy line.

In the middle of the red background is a blank yellow rectangle. To the left of it is a white circular devise with sprockets forming a jagged perimeter. To the right of it is a sketch of a little boy with his left hand on his waist and a paint brush in his right hand stretched downward. Below the yellow box is the corporate name of the plaintiff with its address.

As in the front portion the label at the back contains similar yellow and red backgrounds and identically placed and coloured triangles. The lettering and symbol on the yellow background are similar to those on the front except a bit smaller. However on the yellow portion at the back the words "asian paints" also appear in red below the word "Utsav". The division between the yellow and red portion is also by a wavy line. On the portion with the red background however there are "DIRECTIONS FOR USE" ending with the corporate name of the plaintiff.

18. There is no dispute that copyright subsists in the said work. Nor is there any dispute that the plaintiff is the first and only owner thereof.

19. I will now describe the defendant's work :--

The defendant's label at the top contains triangles identically coloured and placed as in the plaintiffs label. The background of the label is also divided almost equally in red and yellow colours. The division of the background is also by a wavy line. On the yellow background the word "Utkarsh" is written in the same colour and lettering as the plaintiffs word "Utsav". As in the case of the plaintiffs label the defendant's label above the word "Utkarsh" has its name "Jaikishan Paints". Next to that is also a circular device. The shape of each component however is different from that of the plaintiffs device. Further all the components are red in colour. This is, in the overall context, only a minor variation. A green line appears under the word "Utkarsh" as in the case of the plaintiffs label. It is only a bit thicker in the defendant's label. Below the name appears the word "SYNTHETIC DISTEMPER", in lettering larger than the defendant, but in the same colour, green. Below these words appear the word "washable", which is not there in the plaintiffs case. In the red background, there is a circular device as in the yellow background but in the same position as the circular device in the plaintiffs label on the red background. In the red portion there is a white portion in a different shape. Above that is a yellow box in which appears the word "aquamarine". To the right of the white portion appear the logo containing the letters "JP". Below the white portion are the words "Jaikishan Paints".

The reverse side is also divided into yellow and red backgrounds in the same manner as the front. The yellow background on the reverse is similar to that of the front portion except that the lettering is smaller and it also contains the defendant's name and logo.

The red background is divided from the yellow by the same wavy line, containing the directions for use, the name and address of the defendant and the contents of the pocket.

20. The Supreme Court in R.G. Anand Vs. Delux Films and Others, laid down the following as proposition No. 3 in paragraph 46 :--

"3. One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original."

21. I have no hesitation in holding that the defendant has materially and substantially copied the plaintiff artistic work. Kekewich in Hanfsataeng v. W. A. Smit & Sons (1905) Ch. 519 laid down the following test to determine whether defendant's work is a mechanical copy of the plaintiffs or whether it was an independent production, employing his own skill and labour :

"A copy is that which comes so near to the original as to suggest that original to

the mind of the person seeing it."

The test has been approved by the Supreme Court in *R.G. Anand v. Delux Films* (supra).

What strikes one immediately is that the work contained in the label is the placement and colour of the triangular flags at the top, the division of the background of the label almost equally into yellow and red colours, the demarcation between the upper yellow and the lower red portions being created with the devise of a wavy line and the lettering of the text/name in green, yellow and red. It is further pertinent to note that the names of the plaintiff and the defendant are written in the same font/lettering as well as in the same colour. The names of the plaintiff and the defendant are also in the same colour. It is impossible to believe that the defendant's label was the creation of original art Work. Having seen the plaintiffs and the defendant's work I clearly get impression that the defendant's work is a copy of the plaintiffs work.

22. Mr. Vodital submitted that there are three important dissimilarities between the plaintiff and the defendant's works which militate against the plaintiffs case of piracy by the defendant. Firstly, it is submitted that in the labels, the brand names are different. However, this is bound to be so. Even there as I have stated above, the manner in which the same are written, is very similar. Secondly, he submitted that the manufacturer's names were different. That again is bound to be so as the defendant certainly cannot adopt the plaintiffs name or vice-versa. While dealing with the question of infringement of copyright this can hardly be a circumstance in the defendant's favour. Nothing turns on the names of the manufacturers or the brand names being different. To hold the contrary would lead to an absurd result enabling a person to pirate the work of another and justify the same by saying that it is his trading name or brand name that appears on the work and not the others. Lastly, he submitted the picture of a little boy with a brush in his hand, which appears in the plaintiffs work is missing in the defendant's label. Factually this is correct. But this circumstance can be of no assistance to the defendant when it is clear that the entire work is otherwise clearly pirated by the defendant. Some differences may arise between two works. However, the same can always be incorporated as has been done by the defendant in the present case. A substantial and material part of the defendant's work has been the creation resulting from piracy of the plaintiffs work. It is obvious that the variations in the defendant's work have been incorporated by the defendant after it copied the material and essential part and aspects of the plaintiff's work. If that is so then it can hardly be contended on behalf of the defendant that its work is an independent production of its artist employing his own skill and labour.

23. Mr. Vodital then submitted that as the defendant had its work registered under the Copyright Act, there can be no question of the same infringing the work of another. Sections 45 and 48 of the Copyright Act read as under:--

"45. Entries in Register of Copyrights:--

(1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights. (Provided that in respect of an artistic work which is used or is capable of being used in relation to any goods, the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in Section 4 of the Trade and Merchandise Marks Act, 1958 (48 of 1958), to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by any person other than the applicant.)

(2) On receipt of an application in respect of any work under Sub-section (1), the Registrar of Copyright may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights."

48. Register of Copyrights to be prima facie evidence of particulars entered therein :--

The Registrar of Copyrights shall be prima facie evidence of the particulars entered therein and documents purporting to be copies of any entries therein, or extracts therefrom certified by the Registrar of Copyrights and sealed with the seal of the Copyright Office shall be admissible in evidence in all courts without further proof or production of the original."

24. Registration under the Copyright Act is optional and not compulsory. Registration is not necessary to claim a copyright. Registration under the Copyright Act merely raises a prima-facie presumption in respect of the particulars entered in the Register of Copyright. The presumption is however not conclusive. Copyright subsists as soon as the work is created and given a material form even if it is not registered. See *Burroughs Wellcome (India) Ltd. Vs. Uni-Sole Pvt. Ltd. and another*, . Thus even if the plaintiffs work was not registered, the plaintiff having established that it had created the same prior to the defendant, mere registration by the defendant of its work cannot defeat the plaintiff's claim.

25. Moreover in the present case the plaintiffs work is also registered under the Copyright Act. The plaintiffs work was registered prior to the registration of the defendant's work. Mr. Kadam relied upon the aforesaid judgment of the Delhi High Court, in support of his submission that in cases where it is not possible to be definite as to who was the original creator, the person who got registration earlier should be presumed to be the author or original creator of the artistic work. It is not necessary to express any view on this aspect in view of the contents of the extracts from the Register of Copyright in respect of the said works. The extracts contain entries to the effect that the year of first publication

was 1992 in respect of the plaintiffs work and 1998 in respect of the defendant's work. The presumption u/s 48 therefore operates in favour of the plaintiff.

On this ground also, the plaintiff must succeed.

26. In the circumstances, Notice of Motion No. 2884 of 2001 is made absolute in terms of prayer (a). The defendant shall pay the costs of this Notice of Motion to the plaintiff fixed at Rs. 5000/-.