

(1942) 03 BOM CK 0015

In the Bombay High Court

Case No : O.C.J. Appeal No. 22 of 1941 and Suit No. 657 of 1941

K.M. Multani

APPELLANT

Vs

Paramount Talkies of India, Limited

RESPONDENT

Date of Decision : 25-03-1942

Acts Referred:

Citation : AIR 1942 Bom 241 : (1942) 44 BOMLR 505

Hon'ble Judges : Somjee, J; John Beaumont, J

Bench : Division Bench

Final Decision : Dismissed

Judgement

John Beaumont, Kt., C.J.—This is an appeal by the plaintiff against a decision of, Mr. Justice B. J. Wadia. The plaintiff carries on the business of producing and distributing for the purpose of exhibition in India and elsewhere cinematographic motion pictures under the name of Paragon Pictures. The first defendants, who are the respondents, are a company registered in the United States of America, carrying on the business in Bombay and other places in India of importing and distributing cinematographic motion pictures for exhibition in various places in India.

2. It appears from the evidence that during the year 1939, and in the early part of 1940, the plaintiff wrote, or procured the writing of, a story for a film, which was to bear the title of Virginia. The shooting of the film commenced in April, 1940, and on May 16 the name of Virginia was registered with the Sub-Registrar in Bombay, though admittedly such registration conferred no right whatever upon the plaintiff. The film was completed in August, 1940 ; there was a certain amount of advertisement, commencing in September; the certificate of the Censors was obtained in November ; and thereafter some agreements were entered into as to showing the film in other places than Bombay. On March 16, 1941, the film was actually produced at a theatre in Bombay, and ran for two weeks. It is, of course, anticipated that it will be thereafter shown in other places in India.

3. It appears from the evidence of Mr. Kennebeck, who was called on behalf of the respondents, that the respondents also conceived in the year 1939 the idea of producing a picture under the title of Virginia, and in December of that year the title Virginia was registered by the respondents in America. The preparation of the respondents' film proceeded in America more or less contemporaneously with the preparation of the plaintiff's film in India, and the respondents' film was released in America in February, 1941, and was shown in Calcutta on May 2, 1941. Thereupon the plaintiff commenced this suit asking for an injunction to restrain the defendants from distributing or exhibiting the said motion picture imported by them with the name and title of Virginia,

4. It being admitted that the plaintiff has not acquired any legal right to the title Virginia, the suit is what is known as a passing-off action, and there are a great many authorities in which the nature of such an action is discussed. The foundation of a passing-off action is always deception, or possibility of deception, but it is not an action of deceit. In an action of deceit the plaintiff has to prove that he has been deceived by the defendant, and has suffered damage thereby, and that the deceit on the part of the defendant was deliberate.: In a passing-off action it is never the plaintiff's case that he has been himself deceived by the action of the defendant. His case is that other people, the public, have been deceived, or are likely to be deceived. But a private individual cannot sue for a wrong done to the public.

5. The plaintiff must therefore prove that the action of the defendant has infringed some proprietary right of his own. It is not necessary to prove any fraudulent intention on the part of the defendant, although, if a fraudulent intention can be proved, that usually assists the plaintiff's case. It follows, in my judgment, that two issues must always arise in a passing-off action : First, has the name or description or make-up, or whatever it may be, of the wrongful user of which the plaintiff complains, come to be associated in the public mind with the goods, business, or works of the plaintiff ; secondly, is the defendant so describing, or getting up, his goods or whatever it may be, as to be likely to mislead the public into believing that they are acquiring the plaintiff's goods, when in fact they are acquiring the defendants' goods. As Lord Halsbury put it in *Reddaway v. Banham* [1896] A.C. 199 the foundation of a passing-off action is that nobody is entitled to represent his goods as the goods of somebody else. There is, of course, a great variety in the nature of passing-off actions. Sometimes the plaintiff's goods are described by purely fancy names, sometimes by names which are descriptive of their nature, or they may be referred to merely by the name of the plaintiff, and sometimes the defendant may bear the same name. The issues in each case have to be framed with reference to the facts of that case, but, in my judgment, the plaintiff has always to succeed substantially on two issues of the nature above mentioned, the first founding the plaintiff's right to sue, the second the defendant's liability to be sued.

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.

7. In this case I am clearly of opinion that the plaintiff fails to prove either of the matters necessary to his success. On the first point, he has not established that the title "Virginia" is associated in the minds of the public interested in films, with his film. I do not think he has established that fact even in relation to the limited public of Bombay, and he has not attempted to establish it in relation to the public in any other part of the world, though he has claimed an injunction in general terms. There is no evidence of extensive advertisement, though, no doubt, he did advertise on the wall of the cremation ground at Queen's Road, which is a prominent place. But there is no evidence that he spent large sums of money in advertisement. His film has been shown only for a fortnight in Bombay, though, no doubt, it may be shown hereafter elsewhere. His production in India is practically no more than the production of the defendants' picture, which has been shown for a week in Calcutta. In my opinion, it is essential for the plaintiff to go much further than he has gone to establish that when the public go to a film called Virginia, they expect to see the plaintiff's film, and none other.

8. On the second matter which the plaintiff has to prove, he also fails. He has entirely failed to prove that the use by the defendants of the title Virginia in

connection with their film is in any way calculated to deceive. The plaintiff's film is an Indian film in black and white; written in Urdu, depicting an imaginary story, as we are told, of the meeting of Greeks and Romans in the year 4,000 b.c. The story does not purport to be historical. On the other hand, the defendants' film is a film in technicolour, and it depicts modern life in America. The plaintiff took the title; Virginia as being the name of the heroine of his picture, whereas the defendants took the title because the setting of their picture is in Virginia, which is a State in America.

9. In my opinion, there can be no possibility of deception between two things so essentially different. It is, no doubt, unfortunate that two films should have exactly the same title, and the fact may lead to some confusion and inconvenience in the booking and production of the films; But the inconvenience to the plaintiff is no greater than the inconvenience to the defendants. Both parties have without any intention to deceive taken the same title for their films, and the plaintiff has no right to restrain the defendants from using the title, unless he can show that it has become associated in the minds of the public with his film and nobody else's. He has called virtually no evidence at all. His only witnesses were himself and a gentleman concerned with newspapers relating to the film industry. There was no attempt to prove any actual deception, or any likelihood of deception by reason of the identity of these two titles. In my opinion, the learned Judge was quite right in dismissing the plaintiff's suit. |

10. The appeal, therefore, fails, and must be dismissed with; costs.

Somjee, J.

11. I agree and have nothing to add.