

(2012) 04 DEL CK 0077
In the Delhi High Court
Case No : CS (OS) No. 2662 of 2011

Titan Industries Ltd.

APPELLANT

Vs

M/s Ramkumar Jewellers

RESPONDENT

Date of Decision : 26-04-2012

Acts Referred:

Copyright Act, 1957 — Section 17(b)
Criminal Procedure Code, 1973 (CrPC) — Section 340

Citation : (2012) 04 DEL CK 0077

Hon'ble Judges : Manmohan Singh, J

Bench : Single Bench

Advocate : Pravin Anand, with Ms. Tanvi Misra, for the Appellant; Arjun Kumar, for the Respondent

Judgement

Manmohan Singh, J.—The plaintiff has filed the present suit seeking permanent injunction restraining the infringement of copyright, misappropriation of personality rights, passing off damages, rendition of accounts of profit, delivery up, etc. The plaintiff is a company registered under the Indian Companies Act, 1956 having its corporate office at Golden Enclave, Tower "A" Airport Road, Bangalore and its regional office is at 2 A, Old Ishwar Nagar, Main Mathura Road, New Delhi. Plaintiff was established in the year 1987 as a joint venture between TATA group and the Tamil Nadu industrial Development Corporation (TIDCO) and is engaged in manufacturing and marketing watches, clocks and jewellery.

2. Some of the brands owned by the plaintiff for its range of products include TITAN, SONATA, FASTRACK, XYLYS, RAGA, OCTAIN, REGALIA, TITAN EYE+, ZOOP! For watches and clocks; ZOYA, GOLD PLU+ and TANISHQ for jewellery amongst several other brands.

3. According to the plaintiff, the plaintiff has a well known brand name TANISHQ in relation to jewellery. This year TANISHQ is endorsing Mr. Amitabh Bachchan and Mrs. Jaya Bachchan for its diamond jewellery collections. The agreement dated 17.03.2011 between the plaintiff and Mr. Amitabh Bachchan is called as

"Agreement For Services" for engagement of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan for promoting and marketing the plaintiff's jewellery under the brand name TANISHQ. The relevant terms of the Agreement for Services are as follows:

9. INTELLECTUAL PROPERTY

(i) AMITABH BACHCHAN acknowledges, represents and undertakes to TITAN that all the intellectual Property Rights in relation to the SERVICES to be performed hereunder by AMITABH BACHCHAN shall vest solely and fully with TITAN and AMITABH BACHCHAN shall have no right whatsoever in respect of the work, materials or any other product produced as an outcome of the SERVICES or incorporates any part of the services performed by AMITABH BACHCHAN ("Materials")....

(ii) AMITABH BACHCHAN acknowledges that any work conceived, created reduced to any medium of expression and/or delivered as part of the delivery of SERVICES pursuant to this Agreement by AMITABH BACHCHAN shall be works made for hire to the extent permitted by law, and shall at all times be the sole and exclusive property of TITAN. Where such work does not qualify as works made for hire, AMITABH BACHCHAN shall be deemed to have assigned all right, title and interest in and to such work exclusively to TITAN.

(iii) TITAN retains the first and sole right to exercise all copyrights in all work/material conceived, created, reduced to any medium of expression and/or produced pursuant to this Agreement....

(iv) By this Agreement, AMITABH BACHCHAN irrevocably and unconditionally waives and renounces all rights (including but not limited to, moral rights) under all laws, which may now or hereinafter be recognized, in all work performed or delivered by him during the course of the delivery of SERVICES hereunder.

(v) Notwithstanding anything contained anywhere in the agreement, TITAN irrevocably agrees to exploit any of the services, including but not restricted to services rendered under this agreement which is construed as work for hire or collectively as materials during the term only....

4. The said advertisement focuses on generating awareness and educating consumers on diamond jewellery particularly about the 4 C's, which are necessary to identify the quality of diamond, being cut, clarity, colour and carat of the diamond. The advertisement has been displayed extensively through several mediums, with the star couple personally promoting and advertising TANISHQ jewellery.

5. It is averred in the plaint that plaintiff's TANISHQ jewellery is extensively publicized through print and electronic media. Over the years plaintiff has invested heavily in advertising and promoting its brands through celebrities and promoting its TANISHQ jewellery and for this Diwali season, it launched Mr. Amitabh Bachchan and Mrs. Jaya Bachchan as the brand ambassadors of

TANISHQ diamond jewellery.

6. The said advertisement titled "True Diamonds" portrays the age old romance of the star couple featuring as husband and wife on screen as well after a period of ten years. The said advertisement is based on the complex subject of diamonds and displays the required message in an uncomplicated way. The advertisement is for the festive season, particularly Diwali when the demand of jewellery is very high in the markets. Therefore, the campaign was at a widespread scale and the focus was on generating awareness and educating consumers on diamond jewellery. The agreement dated 17.03.2011, between the plaintiff and Mr. Amitabh Bachchan was called the "Agreement For Services".

7. As per the plaintiff, the defendant M/s Ramkumar Jewellers, has put up hoardings all over the city of Muzzafarnagar in Uttar Pradesh, depicting Mr. Amitabh Bachchan and Mrs. Jaya Bachchan as the endorsers of defendant's jewellery. The said hoardings put by the defendant are exact copies of the plaintiff's hoardings put all over the country for promoting TANISHQ jewellery and the same is also a part of the advertisement film promoting TANISHQ featuring Mrs. & Mr. Bachchan. Therefore, the defendant is guilty of infringing the plaintiff's copyright in its "True Diamonds" advertisement by misusing and misrepresenting the biggest advertisement of the plaintiff to mislead the public into believing that its jewellery is associated with the plaintiff's TANISHQ brand of jewellery and the defendant is passing off its goods as that of the plaintiff.

8. The pictures of the plaintiff's hoardings as well as the pictures of the hoardings put up by the defendant in the city of Muzzafarnagar, Uttar Pradesh depicting the celebrity couple i.e. Mr. Amitabh Bachchan and Mrs. Jaya Bachchan as the endorsers of defendant's jewellery are illustrated below:

9. In the written statement filed by the defendant it is stated that alleged hoardings have not been put up by the defendant and the defendant has no objection if, the same are removed. The depiction of the alleged copyright of the plaintiff is a mischief played by some unknown persons or as usually the case, some jealous competitors of the defendant have hatched a conspiracy to get the defendant into trouble. Infact, as soon as the said mischief came to the knowledge of the defendant, the defendant, immediately on 05.09.2011 made a complaint to the police of the said mischief committed against the defendant by unknown persons.

10. After service, the defendant duly appeared and filed its written statement. The plaintiff has also filed the replication denying the pleas raised in the written statement.

11. Today, when the matter came up before the Court for further proceedings, the learned counsel for the defendant has referred para-16 of the written statement, and makes the statement on behalf of the defendant that the defendant has no objection if a decree for permanent injunction is passed in favour of the plaintiff and against the defendant, provided, the plaintiff foregoes

its relief for damages and cost.

12. I have heard Mr. Pravin Anand, learned counsel for the plaintiff in the matter.

13. By virtue of Section 17(b) of the Copyright Act, 1957, the plaintiff is the first owner of the copyright in the said advertisement and this fact is substantiated by the endorsement agreements which clearly state that ownership of copyright is with the plaintiff. This dishonest adoption of an identical advertisement for their products on the hoardings, by the defendant and reproduction of the celebrities in exact environment situation amounts to infringement of rights vested with the plaintiffs.

14. Protection of Personality Rights of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan in the plaintiff's advertisement for TANISHQ Diamonds titled "True Diamonds":

I. Plaintiff's standing to sue on behalf of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan :

Plaintiff has an exclusive license from Mr. Amitabh Bachchan and Mrs. Jaya Bachchan titled "Agreement For Services" dated 17th March 2011 for the endorsement of TANISHQ Diamond jewellery for a specified period. The plaintiff is the owner of copyright in all works/material conceived, created, reduced to any medium of expression and/or produced pursuant to this Agreement particularly Clause 9(iii) and 10 of the same.

The plaintiff has indemnified Mr. Amitabh Bachchan and Mrs. Jaya Bachchan against infringement or violation of any third part rights relating to the advertisement, promotion or sale of the products.

Haelan Laboratories v. Topps Chewing Gum [202 F2d 866]

A man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i.e., without an accompanying transfer of a business or of anything else.

This right might be called a "right of publicity". For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

II. "Publicity right" of a Celebrity

A celebrity is defined as a famous or a well-known person. A "celebrity" is merely a person who "many" people talk about or know about.

When the identity of a famous personality is used in advertising without their permission, the complaint is not that no one should not commercialize their identity but that the right to control when, where and how their identity is used should vest with the famous personality. The right to control commercial use of human identity is the right to publicity.

Ali v. Playgirl 447 F Supp 723 "A distinctive aspect of the common law right of publicity is that it recognizes the commercial value of the picture or representation of a prominent person or performer, and protects his proprietary interest in the profitability of his public reputation or persona"

D.M. Entertainment Pvt. Ltd. v. Baby Gift House and Ors. [CS (OS) No. 893 of 2002] "In the present instance the commercial use of an individual's identity is intended to increase the sales of product by fusing the celebrity's identity with the product and thereby the Defendant's were selling those dolls, on the basis of publicity value or goodwill in the artist's persona into the product i.e. doll."

No one was free to trade on another's name or appearance and claim immunity

III. The basic elements comprising the liability for infringement of the right of publicity:

Validity: The plaintiff owns an enforceable right in the identity or persona of a human being.

Identifiability: The Celebrity must be identifiable from defendant's unauthorized use Infringement of right of publicity requires no proof of falsity, confusion, or deception, especially when the celebrity is identifiable. The right of publicity extends beyond the traditional limits of false advertising laws.

IV. Methods of proving identification of the Plaintiff

If the plaintiff is very well known and widely recognized celebrity a simple comparison of the defendant's use and the plaintiff's identifying features may itself be sufficient to create a strong inference of identifiability.

This is termed as unaided identification. This on its face comparison is relevant for the present proceedings as the hoardings of the defendant clearly show Mr. Amitabh Bachchan and Mrs. Jaya Bachchan, being an exact replica of the plaintiff's own hording advertising its Tanishq Diamonds with Mr. Amitabh Bachchan and Mrs. Jaya Bachchan.

V. Other methods of proving significant identification:

1. Evidence of a number of elements in the context of defendant's use which add up at a geometric rate to point to the plaintiff.

2. Direct or circumstantial evidence of the defendant's intent to trade upon the identity of the plaintiff, from which identifiability can be presumed.

15. According to the defendant's own written statement in para 3, owner is a

leader of the trade locally and has leading jewellery store in Muzaffarnagar, UP.

16. Defendant's lack of intent or knowledge as stated in the written statement :

The liability of infringement by the defendant is based on the identifiability of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan from the defendant's advertisement which is the exact replica of the plaintiff's advertisement being the proof of identifiability. There is a direct interrelationship between identification and defendant's state of mind. The defendant's use of the personality rights of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan in its advertisement itself contains a clear message of endorsement and the message is false and misleading. Further, since Mr. Amitabh Bachchan and Mrs. Jaya Bachchan are clearly identifiable there would be an infringement of the right of publicity for it is not tied down to any proof of falsity. The right to publicity extends beyond the traditional limits of false advertising laws.

17. An application u/s 340 of the Code of Criminal Procedure has been filed by the plaintiff being Cr. M.A. No. 5064/2012. The said application was not pressed as the defendant agreed to suffer a permanent injunction as per the prayer in the present proceedings.

18. Therefore, in view of the circumstances mentioned hereinabove, a decree for permanent injunction in favour of the plaintiff and against the defendant is passed to the following effect:

i.) An order of permanent injunction restraining the defendant, its servants, agents, directors and employees from infringing the plaintiff's copyright in the advertisement for Tanishq diamonds titled "True Diamonds"; and

ii.) An order of permanent injunction restraining the defendant, its servants, agents, directors and employees from misappropriating the personality rights of the celebrities Mr. Amitabh Bachchan and Mrs. Jaya Bachchan.

19. Decree be drawn accordingly.

20. The plaintiff forgoes the other reliefs claimed in sub-paras (f), (g) and (h) of para-32 of the plaint. A decree be drawn accordingly. Pending applications stand disposed of.