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Court : Delhi

Decided On : Nov-20-2006

Reported in : LC2007(1)175; 2007(34)PTC81(Del)

Judge : A.K. Sikri, J.

Acts : Indian Copyright Act, 1957 - Sections 2, 3, 13(1), 13(4), 14, 51 and 52(1); Code of Civil Procedure (CPC) - Sections 151 - Order 1, Rule 10(2) - Order 7, Rule 11

Appeal No. : IA No. 9333/2005 in CS (OS) No. 1324/2005

Appellant : Suneet Varma Design Pvt. Ltd. and anr.

Respondent : Mr. Jas Kirat Singh Narula and anr.

Advocate for Def. : Viraj Datar, Adv. for Defendant No. 1, ; Pravin Anand and ;

Advocate for Pet/Ap. : H.L. Tikku, Sr. Adv. and; Yashmeet, Adv

Judgement :

A.K. Sikri, J.

1. The plaintiff No. 2 claims that he is a renowned designer of international repute, engaged in creation or fabrication of wearing apparels which are exclusive in shape, configuration and pattern. Over the years his designs have been acclaimed by people all over the world. He is the Managing Director of plaintiff No. 1, which is a private company. The plaintiffs are also having exclusive outlets in various cities from where their finished products are sold. It is also claimed that the garments designed by the plaintiffs are in great demand on account of their originality and quality and are considered as trend setters in the modern fashion industry. Owing to such large and enviable presence the products have acquired immense goodwill and reputation all over India. According to the plaintiffs, designing apparels and garments is a highly skilled activity requiring an ingenious mind and ever creative spirit, an unwavering focus and the ability to think beyond the existing norms and standards. The process of creating a new design begins in the form of development of new ideas in the designer's mind. These ideas are then put on paper by the designer in the form of sketches, the said sketches being the expression of ideas mentioned above. Once this preliminary work is completed, the process of applying the design to the fabric commences wherein a successful apparel designer also requires a number of committed and skilled garments and professional designers. therefore, the plaintiffs are having a team that continuously strive to give shape to the new and fresh designs developed and created by the plaintiff individually and ingenuously. The plaintiffs also claimed that because of the reputation and goodwill which they enjoyed, the moment a particular design is introduced in the market the same is taken off the shelves almost instantaneously and the members of trade and purchasing start associating those designs with the plaintiffs and with the plaintiffs alone. The plaintiffs have filed this suit for permanent and mandatory injunction and rendition of accounts for infringement of copyright of the plaintiffs in a particular dress designed by them. The dress in question is for women and consists of a blue poncho and a heavily embroidered trousers. The blue poncho and trousers consists of specific fabric cuts and original artistic embroidery. This is the original and distinctive creation of the plaintiffs and was a part of their Fall/Winter Collection-2003 and first exhibited at a fashion show held at the Hyatt Regency Hotel on 18th October 2003. This dress has also featured in the plaintiffs' advertisement campaign published in

various noted and widely read fashion magazines, including magazines like Elle (April 2004 issue), Libaas (Vol. 17-2003) and Femina. However, without obtaining any permission or consent of the plaintiffs, the said dress is used by the defendant No. 2 in his film 'Bunty Aur Bubli'. Miss Rani Mukherji, heroine and the central female protagonist of this film is shown wearing this dress. Plaintiffs came to know of this for the first time when an article was published in the Times of India supplement of April 23, 2005 with the caption 'Reigning Rani' depicting Rani Mukherji wearing the said dress. Since the defendant No. 1, another designer had allegedly created this dress for this film produced by the defendant No. 2, the defendant No. 1 is also arraigned in this suit as a person who infringed the copyright of the plaintiffs in the said design. The plaintiffs immediately got legal notice dated 10th May 2005 issued to both the defendants.

2. Reply of defendant No. 1 through his counsel was that he did not design the costume but had purchased the same from a retail shop named 'Baby Bell (Concession)' in a shopping mall named 'Options' in Mumbai. In so far as the defendant No. 2 is concerned, reply through his counsel dated May 18, 2005 was sent taking the defense that it had engaged defendant No. 1 as a costume designer and it was also stated therein that one of the terms of the agreement was that the costumes/designs conceptualised, formulated and exhibited for the film should not be plagiarized and/or infringing of copyrights of any other party. Not satisfied with these Explanations and still perceiving the acts of the defendants as violation of plaintiffs' copyright, suit is filed for permanent injunction, mandatory injunction and damages.

3. Both the defendants have filed the written statements contesting the suit on various grounds and it is not necessary to state in detail the defenses taken by these defendants at this stage as we are concerned with the present application which is filed under the provisions of Order 1, Rule 10(2) read with Section 151 of the Code of Civil Procedure for deletion of name of the defendant No. 2 from the array of parties. Of course, ground taken in this application forms the basis of one of the defenses taken in the written statement also.

4. It is alleged in the application that Yash Raj Films Pvt. Ltd., the defendant No. 2, is a renowned producer of cinematographic films and has produced films that have been tremendously successful in all parts of the world. The defendant No. 1 was engaged by the defendant No. 2 to prepare the clothes for the characters of the film 'Bunty Aur Bubli'. It is a case of the defendant No. 2 that present suit is not maintainable against it as it does not disclose any cause of action and, therefore, name of the defendant No. 2 is liable to be struck off from the array of parties. This plea is based on the provisions of Section 52(1)(u)(ii) of the Indian Copyright Act, 1957 (hereinafter referred to as 'the Act'), which exempts from infringement of copyright the inclusion in a cinematographic film of any artistic work when such inclusion is by way of background or incidental to the principal matters represented in the film. It is submitted that the clothes worn by the actors and actresses in films are always by way of background or merely incidental and hence fall within the aforesaid defense. Moreover, the clothes also rapidly change from scene to scene and sometimes are changed several times in a long sequence and hence can only be incidental to the principal matters represented in a film. It, therefore, could hardly be reasonable or even required by law to expect a film producer to take any permission from the designers of every one of the hundreds or sometimes thousands of clothes used in cinematographic films, specially in India cinema where the principal characters change attires several times even in a long sequence. It is further submitted that in so far as the dress in question as shown in the film is concerned, it appears for a few seconds in the film and it does not amount to infringement of copyright of any artistic work on behalf of the defendant No. 2, which is the producer of the film in question. It is also submitted that by virtue of being the producer of the film and the owner of all materials, including clothes worn by the various characters in the film, this becomes a part of wardrobe of the film and the defendant No. 2 is entitled to use the said clothes in any manner that it deems fit. Such a use would not amount to infringement of copyright.

5. Mr. Praveen Anand, Learned Counsel appearing for defendant No. 2, dilated on the aforesaid plea taken in the application by contending that the legislative intent in enacting Section 52(1)(u)(ii) of the Act where certain acts are not to be treated as infringement of the copyright, was manifest inasmuch as when a film is shot

many such artistic works, including buildings, exterior or interior of any place and hundreds of locations would be covered in the film where such a film is shot. If permission is required from all such persons even when the inclusion is only by way of background or is otherwise incidental to the principal matters represented in the film, it would be impossible for any producer to make a film. The Indian Copyright Act is modeled along the lines of the U.K. Copyright Act. An extract from an authority on U.K. Copyright law summarizes the three key justifications for the enactment of a provision such as Section 52(1)(u) as follows:

(i) In relation to photographers, film makers and broadcasters, it is justifiable on the grounds that it will often be very difficult to obtain permission from the owners of all the works reproduced in the photograph, film or broadcast;

(ii) The incidental use of a work will in any event not detract from the market of the original and in certain circumstances may even enhance it;

(iii) Such a provision allows film makers and broadcasters a degree of artistic freedom by allowing them to set the activities of their characters in a wide variety of settings.

6. There is also an interesting example given where it is stated that without some form of exception an artist, photographer, film maker or broadcaster could not even include images of a building in his work, without infringing the architect's copyright.

7. He also referred to the following passage from the 15th edition of 'Coping and Skone James on Copyright' relating to the permissibility of incidental inclusion of copyright material whereunder three suggestions are given for such a provision:

There would seem to be three justifications for such a provision. First, in relation to photographers, film makers and broadcasters, it is justifiable on the grounds that it will often be very difficult to obtain permission from the owners of all the works reproduced in the photograph, film or broadcast. Consider the live broadcast of a sporting event. Without such a provision a broadcaster might infringe copyright by broadcasting a sound recording which is being played over the public address

system or by including shots of an advertising hoarding. A second justification is that the incidental use of a work will in any event not detract from the market for the original and in certain circumstances may even enhance it. This point has been accepted in a number of United States American cases, with the result that incidental inclusion has been held to fall within the fair use defense, there being no specific provisions in the United States Act dealing with this matter. The third justification for such a provision is that it allows film makers and broadcasters a degree of artistic freedom by allowing them to set the activities of their characters in a wide variety of settings. Thus no special permission is needed to film against the background of a play being performed in a theatre. Indeed without some form of exception an artist, photographer, film maker or broadcaster could not even include images of a building in his work without infringing the architect's copyright. Overall, these provisions have a great deal of importance for photographers, advertisers, film makers and broadcasters.

8. It is for this reason, argued the counsel, that such a provision exempting film makers is found in statutes of various countries such as New Zealand, Australia, Ireland and Pakistan apart from UK and India. Arguing that the provision contained in Indian law is *para materia*, Learned Counsel referred to the following two cases decided by the Courts in the United States while submitting that there was no case law on the subject available in India:

(1) *Amsinck v. Columbia Pictures Industries Inc.* 33 USPQ2d 1131

In the above case, the Defendants released a film containing about 1 minute 36 seconds of a mobile containing the Plaintiff's copyrighted artwork consisting of pastel-colored teddy bears, called the 'Baby Bears Artwork'.

The Court held that such use does not amount to copying as:

- (a) it is not meant to supplant demand for the copyrighted work,
- (b) does not diminish interest in the work,
- (c) it is not mechanical, and

(d) it is fleeting and impermanent.

(e) the plaintiff had not suffered any demonstrable harm from the defendant's use of the work; and

(f) The film does not pose a threat for future licensing of work or sales to other motion pictures.

(2) *Mura v. Columbia Broadcasting System Inc.* (1965) 245 F. Supp. 587

In this case, the case concerned copyrights covering three hand puppets, which were allegedly displayed by the Defendants on its show.

The Court held that the Defendant's use did not amount to infringement as:

(a) any use of the plaintiff's puppets was only to portray music in an incidental manner or tell a story within the program;

(b) the electronic image produced is not permanent.

9. He submitted that in the present case the defendant No. 2 does not claim to be the owner of the copyright in outfit which is the subject-matter of the suit and there is no dispute between the plaintiff and the defendant No. 2 on this ground. The outfit in question is shown only by way of background or is purely incidental and one dress could have easily been replaced with another in any given scene. Inclusion of this dress does not detract from the market for the plaintiff's dress and rather enhances it. The inclusion is fleeting, as industry practice dictates that the clothes of actors are changed almost minute to minute. By pointing out these features of the use of the outfit in question in the film, Learned Counsel submitted that such a use was clearly permissible under Section 52(1)(u)(ii) of the Act and, therefore, prayer made in the application should be allowed.

10. The plaintiff has resisted this application and passionate plea was made by Learned Counsel for the plaintiff for dismissal of this application as mis-conceived and filed as a delaying tactic. It is submitted that provisions of Order I Rule 10(2) of the CPC would not even be applicable in a case where the defendant raised a defense on the substantive question of fact and law to be adjudicated upon to

strike out its name from the array of parties. It is argued that under the garb of this application, the defendant No. 2 is actually seeking order for the rejection of the plaint against it for which the relevant provision is Order 7 Rule 11 of the CPC and for examining the issue on the touchstone of Order 7 Rule 11 of the CPC one has to look into only the averments made in the plaint and the documents by the plaintiff and not the so-called defenses raised by the defendants. It is submitted that in any case the defense taken under Section 52(1)(u)(ii) raised by defendant No. 2 is devoid of any merit inasmuch as the suit of the plaintiff is for infringement of copyright in the artistic work. The plaintiff being the owner of 'original artistic work' has exclusive right under Section 14(c) of the Act to reproduce the said work as under:

(i) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;

(ii) to communicate the work to the public;

(iii) to issue copies of the work to the public not being copies already in circulation;

(iv) to include the work in any cinematograph film;

(v) to make any adaptation of the work;

(vi) to do in relation to any adaptation of the work any of the acts specified in relation to the work in Sub-section (i) to (iv).

11. It is also submitted that owner of copyright has a bundle of rights including the right to include the artistic work in any cinematographic film. If this exclusive right is violated, it constitutes an act of infringement under Section 51 of the Act, as would be clear from the combined reading of Sections 13(4), 14(c) and 14(d) of the Act. It is submitted that the copyright in an artistic work is independent under Section 13(1)(a) of a copyright in a cinematographic film under Section 13(1)(b) of the Act. 'Artistic work' is separately defined in Article 2(c) as against the 'cinematographic film' defined in Section 2(f). The 'author' in respect of artistic work and in respect of cinematographic film is also separately defined under Section

3(b)(i) and 3(b)(v) respectively. Learned Counsel argued that the provisions of Section 52(1)(u)(ii) need to be examined keeping in view the aforesaid provisions of law. This Section provides an exception to the case of infringement against the inclusion of artistic work in a cinematographic film only if (a) the same is made by way of background or (b) is otherwise incidental to the principal matters represented in the film.

12. He further submitted that the only submission made on behalf of the defendant No. 2 in support of its case is that the dress (in which valid copyright subsists) used by Rani Mukherji in the film is incidental to the principal matters represented in the film or as a background. The words 'incidental to the principal matters' could only logically be interpreted to mean incidental to the character if the artistic work in question is in respect of dress. The artistic works of other nature like cartoons, puppets, photographs and objects at public place, may be used as incidental to the principal story line of film but the dress of an artist cannot be incidental to the film or subject matter thereof. For example, if a cinematographic film is based on historical or mythological events, the dress of ancient time may in some circumstances be considered to be incidental to the principal matters or characters of the film. In the epic of Tipu Sultan, Ramayana or Mahabharata or a film showing tribal characters, the dress which is incidental to the character may in some cases fall within the purview of Section 52(1)(u)(ii). However, the infringing dress used by Defendant No. 2 as part of the cinematographic film 'Bunti Aur Babli' can, by no stretch of imagination, be described as the artistic work incidental to the character and thereby to the principal matters represented in the film.

13. Learned Counsel also pointed out that the defendant No. 2 has not only used the infringing dress as part of the cinematographic film but has also reproduced the artistic work relating thereto in the form of inlay cards used for audio/videos cassettes, CDs, DVDs posters, promotional material of the film etc. The said material would not fall within the definition of 'cinematographic film' and would be outside the purview and scope of Section 52(1)(u)(ii). His submission was that the reproduction of the artistic work in which the plaintiff holds copyright by way of publication of inlay cards for audio/video cassettes, CDs, DVDs posters, promotional material of the film etc. constituted infringement of plaintiff's copyright

independently of the use thereof as dress of leading actress in the film. The said acts of reproduction and distribution would not fall within the definition of cinematographic film and would be outside the purview and scope of Section 52(1)(u)(ii). The printed material, as aforesaid, is separately and distinctively distributed than the cinematographic film and Section 52(1)(u)(ii) is not a defense to the said illegal acts of infringement.

14. Arguing that the case at hand is to be decided keeping in view the provisions of the Act and reliance could not be placed on the provisions of the Copyright Acts of other countries, his submission was that judgments of the foreign courts would have no relevance to decide the issue at hand.

15. Before advertng to the arguments raised, let us be clear about the parameters of the present application and the stage at which it is filed. By means of this application, which is filed under Order I Rule 10(2) CPC, the defendant No. 2 wants that its name be deleted from the array of parties. This prayer is founded on the averments that the present suit is not maintainable against it in view of the provisions of Section 52(1)(u)(ii) of the Act. Thus, counsel for the plaintiffs is right in his submission that application is essentially under Order 7 Rule 11 CPC for rejection of plaint qua the defendant No. 2 on the ground that the suit against the defendant No. 2 is barred under the aforesaid provisions of law. Whether the aforesaid provisions can be applied straightaway without going into the factual matrix and determining the same through evidence in the first instance, is the question which requires determination. For this, we will have to see as to what are the averments, on the basis of which the plaintiff No. 2 has founded his cause of action, and if those averments are proved, whether the plaintiffs would succeed in getting a decree.

16. The plaintiff No. 2 has founded his case on the basis of alleged infringement of his copyright in the artistic work, namely the dress in question, designed by him. It is his case that the dress worn by Rani Mukherji was designed by him, which is the original artistic work. The use of the said dress in the film is, therefore, violation of Section 14(c) of the Act, which confers upon the plaintiff exclusive right to use/reproduce his original artistic work and if the said right is violated, it constitutes

an act of infringement under Section 51 of the Act. It is also the case of the plaintiff that the defendant No. 2 has not only used the infringing dress as part of the cinematographic film, but has also reproduced the artistic work relating thereto in the form of inlay cards used for audio/video cassettes, CDs, DVDs, posters, promotional material of the film, etc. and all these material would not fall within the definition of cinematographic film and, thus, outside the scope of Section 52(1)(u)(ii) of the Act.

17. The importance of costumes being worn by the actors in a film, particularly by the heroes and the heroines of a film, cannot be downplayed. In the films which are produced now-a-days, much importance and emphasis is given to the dresses which the lead actors would wear in such a film. It is for this reason that the producers are now engaging the services of professional designers. It is realized that this enhances the prospects of the film inasmuch as such designer dresses, projected through the lead actors who are icons of the audience, become trend setters. When in the posters and on inlay cards etc, the photographs of the actors is shown with such costumes, it is with the purpose of promotion of the movie as well as of audio/video cassettes, CDs, DVDs etc. of the film. Many times, for a particular role to be played by an actor in a film, the costumes are designed in such a way as to bring out the character that particular actor is to play. The styling of the movie, therefore, is becoming as important as dialogue, screenplay or music. The audience look at an actor in the movie and then notice what he/she is wearing. To promote particular dress used in a film, actors have started walking on the ramp-way during fashion shows. Bollywood has become integral to Indian fashion. In fact, in the award ceremonies, there are specific awards for best costumes in a film. therefore, it cannot be presumed, per se, that for all kinds of clothes worn by the actors in a film provisions of Section 52(1)(u) of the Copyright Act would be applicable. May be, this argument would be relevant for most of the dresses worn in a film, however, whether a particular dress/costume in a film was only by way of background or incidental to the principal matters represented in the film will have to be viewed after the evidence is led.

18. In the instant case, the dress in question designed by the plaintiff, indubitably, is worn by the lead actress of the film Rani Mukherji. Prima facie, the importance

given to this dress cannot be counter-minded inasmuch as the defendant No. 2 itself thought that it would be of some worth to show Rani Mukherji wearing this dress on various promotional materials as well as on the inlay cards used on audio/video cassettes. Rani Mukherji must have worn, in public scenes of the film 'Bunty Aur Bubli', innumerable dresses. Why the defendant No. 2 chose only this dress for the purpose of promotion of the film? Prima facie, the defendant No. 2 thought that it was an eye-catching costume which would appeal to the public at large and would enhance the promotional prospects of not only the film but the sale of audios/videos in all forms, including cassettes/CDs/DVDs. thereforee, at this stage and without evidence being recorded, plea of the defendant No. 2 that this particular costume worn by Rani Mukherji was by way of background or merely incidental cannot be accepted. Whether the attire in question played prominent role in the film or was by way of background or merely incidental, thereforee, is a question of fact for which the parties will have to lead evidence.

19. There is yet another aspect which has to be kept in mind while deciding this application. Nobody has disputed the claim of copyright of the plaintiffs in the infringing dress and his claim that the dress in question is a blue poncho and trousers consisting of specific fabric cuts and original artistic embroidery. It is also not disputed that no permission or consent of the plaintiffs was taken by the defendants while using the same in the film and making Rani Mukherji, central female protagonist of the film, wear the said dress. As per the defendant No. 2, the producer of the film, it had engaged the defendant No. 1 as a costume designer and one of the terms of the agreement with the defendant No. 1 was that the costumes/designs conceptualised, formulated and exhibited for the film should not be plagiarized and/or infringing of copyrights of any other designer. Thus, the defendant No. 2 is conscious of the fact that the costumes/ dresses to be used in the film, which were to be designed by the defendant No. 1 for the said film, should not belong to some other designer and the defendant No. 2 had specifically warned the defendant No. 1 of any kind of plagiarism as the defendant No. 2 was apprehensive that there could be a copyright infringement. Interestingly, the defendant No. 1 has admitted that he has not designed the costume in question and his defense is that he had purchased the same from a retail shop named 'Baby Bell (Consession)' in a shopping mall, namely 'Options' in Mumbai. Thus, in

any case, the defendant No. 2 becomes necessary and/or proper party and cannot be deleted from the array of parties even on this ground. Whether the defense of the defendant No. 1 or that of the defendant No. 2 has any merit and what are the legal consequences of the aforesaid defenses, would be decided only after the evidence is led by the parties. This is yet another reason that prayer made by the defendant No. 2 in the present application cannot be allowed at this stage.

20. Thus, on facts, as appearing, provisions of Section 52(1)(u)(ii) of the Act are applicable as ultimately it would be a matter of trial to adjudge as to whether the wearing of the dress in question by Rani Mukherji in the film is by way of background or merely incidental or it played prominent role to depict the character of the film.

21. For the aforesaid reasons, it is not necessary to go into the other arguments, namely the applicability of the cases cited by Learned Counsel for the defendant No. 2 or the arguments raised by the plaintiffs that those cases decided by foreign courts would have no bearing in the context of Indian Copyright Act. This issue would be relevant after the evidence is led and the defendant No. 2 shall be entitled to raise these issues at that stage, depending on the evidence that comes on record.

22. With the aforesaid directions, the application filed by the defendant No. 2 is dismissed.

23. CS (OS) No. 1324/2005

List before the Regular Bench on 13th February 2007.

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