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IN THE HIGH COURT OF DELHI AT NEW DELHI

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Date of Decision: 17th August, 2023

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CS(COMM) 100/2022

VENUS WORLDWIDE ENTERTAINMENT PRIVATE
LIMITED

..... Plaintiff

Through: Mr. Pravin Anand, Mr. Dhruv
Anand, Ms. Udita Patro, Ms. Sampurna
Sanyal and Mr. Achuthan Sreekumar,
Advocates

versus

POPULAR ENTERTAINMENT NETWORK
(PEN) PRIVATE LIMITED & ANR.

..... Defendants

Through: Mr. Darpan Wadhwa, Senior
Advocate with Mr. Rishi Agrawal,
Mr. Karan Luthra, Ms. Megha Bengani,
Mr. K. Vir Singh, Ms. Manavi Agarwal,
Ms. Neelakshi Bhaduria and Mr. Amer
Vaid, Advocates.**CORAM:****HON'BLE MS. JUSTICE JYOTI SINGH****JUDGEMENT****JYOTI SINGH, J.****I.A. 2379/2022** (under Order XXXIX Rules 1 and 2 CPC, by Plaintiff)

1. Present judgment shall dispose of an application filed on behalf of the Plaintiff under Order XXXIX Rules 1 and 2 CPC seeking interim injunction restraining the Defendants and others acting on their behalf from infringing Plaintiff's registered 'KHILADI' trademarks in relation to cinematographic films/movies/motion pictures, including the release of the film bearing an identical or



deceptively similar title/name KHILADI in any format i.e. cinema hall, DVD/VCD, OTT Platforms etc.

2. As per the averments in the plaint, Plaintiff is a Company incorporated in 1988 under the Companies Act, 1956 and is a large production house engaged in producing and distributing cinematographic films/movies across India. Plaintiff claims to have produced several blockbuster movies under its banner for over 30 years which include iconic films such as Baazigar, Main Hoon Na, Dhadkan etc.

3. It is averred that the first film produced by the Plaintiff was a film titled 'KHILADI' in the year 1992, which was the first hit movie of Mr. Akshay Kumar and which gave him the epithet 'Khiladi'. The movie is remembered over the years for its immense success since it broke all traditional barriers of Indian film making, being one of its kind in the genre of 'action thriller' and 'murder mystery'.

4. It is averred that the success of the film 'KHILADI' triggered a series of films bearing the word 'Khiladi' in some form or manner viz. Main Khiladi Tu Anari (1994), Sabse Bada Khiladi (1995), Khiladiyon Ka Khiladi (1996), Mr. and Mrs. Khiladi (1997), International Khiladi (1999), Khiladi 420 (2000) and Khiladi 786 (2012). The first two movies from these i.e. 'KHILADI' and 'Main Khiladi Tu Anari', were produced by the Plaintiff. Plaintiff acquired all rights, title and interest in the film 'KHILADI' through an Assignment Agreement dated 14.05.1997, between M/s. United Seven and M/s. Venus Records and Tapes Pvt. Ltd. (Plaintiff's predecessor). The rights assigned in the movie were in perpetuity and included the territory of India. The assignment granted television, satellite and free television rights and under Clause 2.3 of the Agreement, rights to use



the name, tradename and trademark were specifically conveyed. Thus, Plaintiff is the sole and exclusive proprietor of the title/mark/name 'KHILADI' in respect of cinematographic films/movies/motion pictures.

5. It is averred that Plaintiff is the registered proprietor of the trademark 'KHILADI' and its formative trademarks. Registrations are across Classes 9 and 41 and are valid and subsisting. It is stated that trademark 'KHILADI' has acquired a secondary meaning and any reference to or use of the mark by a third party, without Plaintiff's license or consent, would result in confusion as to the source of origin of goods and services. The secondary meaning garnered by the said trademark is a result of various factors such as: (a) immense popularity of the film released in 1992, which achieved cult status; (b) film had a worldwide collection of Rs. 6 Crores despite the budget being Rs. 1.8 Crores and was the 10th highest grossing film of 1992; and (c) film led to a series of subsequent movies adopting the word 'KHILADI'.

6. It is stated that the word 'KHILADI' as a film title is inherently distinctive having no discernible meaning being arbitrary in respect of film. Even assuming that it is a suggestive trademark, it is still inherently distinctive and worthy of high degree of protection without even proof of secondary meaning. In any event, due to immense success of the movie the trademark 'KHILADI' even when used on its own, has acquired a secondary meaning as emanating from the Plaintiff. Plaintiff's trademark 'KHILADI' has garnered extensive goodwill and reputation and the trademark has become easily identifiable by members of the public and trade, as originating from the Plaintiff. The affinity is so close that if another movie producer



uses the mark 'KHILADI' as a name/title of its movie, it would undoubtedly lead to blurring of distinctiveness and exclusivity attached to the 'KHILADI' trademark.

7. It is averred that Defendant No. 1 is an Indian Film and Distribution Company established in the year 1987 and is involved in production and distribution of cinematographic films in Hindi, Telugu and Tamil languages while Defendant No. 2 appears to be a producer of the forthcoming film 'Khiladi' in Telugu along with Defendant No. 1, as is apparent from its name appearing on the promotional banner available in public domain.

8. It is stated that the present suit was triggered by the fact that on 07.02.2022, Plaintiff learnt of the forthcoming release of the film titled 'Khiladi' (hereinafter referred to as the 'impugned film') by the Defendants on 11.02.2022, in Telugu language, purportedly an action-thriller *albeit* it was likely to be available in Hindi language also.

9. It bears relevance to state that the suit was first listed on 10.02.2022 when summons were issued to the Defendants and were accepted on their behalf. The order records that the impugned film was to be released in cinemas on 11.02.2022 and therefore, after some arguments, Mr. Pravin Anand, counsel for the Plaintiff, on instructions, did not press for an *ex parte* order qua the theatrical release. He, however, informed the Court that the movie was likely to be released on a later date on Digital/OTT Platforms and across other technological media viz. DVD/VCD and sought interim orders qua the imminent launch. Upon hearing the parties, Court directed the counsel for the Defendants to take instructions if the slogan/tagline 'Play Smart' on the Posters, could be changed for the release across other platforms, so as to address Plaintiff's concern. The matter was



adjourned to 17.02.2022 on which date Plaintiff sought time for filing rejoinder to the reply filed by the Defendants to the present application and the application was re-notified for 25.02.2022 and thereafter listed on various dates. Before the application could come up on 21.03.2022, Plaintiff filed an application being I.A. 4083/2022 seeking restraint against the Defendants from taking further steps or making further commitments that would irretrievably change the balance of convenience. In the alternative, a prayer was made to list the application before 21.03.2022 on account of the imminent release of the impugned movie on Disney-Hotstar OTT Platform. It is on this date that the Defendants informed the Court that their film 'KHILADI' had already been released on Disney-Hotstar OTT Platform on 11.03.2022 and application had become infructuous. The application was disposed of as not pressed with liberty to the Plaintiff to seek appropriate remedy as the grievance of the Plaintiff was that the release of the impugned film by the Defendants on 11.03.2022 was an overreach. Sum and substance is that no relief was granted to the Plaintiff at that stage and the present application was thereafter argued on merits.

CONTENTIONS ON BEHALF OF THE PLAINTIFF:

10. Plaintiff is the registered owner and proprietor of the trademark 'KHILADI' as well as other 'KHILADI' formative trademarks in relation to cinematographic films, motion pictures etc. The trademark 'KHILADI' is registered in class 41 and the registration is valid and subsisting. Plaintiff's use of 'KHILADI' trademark goes back to the year 1992 as reflected from the trademark application dated 24.02.2017 which was filed claiming user from 05.06.1992. This fact is not disputed by the Defendants and nor have the Defendants



disputed the validity, distinctiveness or the proprietorship of the trademark 'KHILADI'.

11. Plaintiff is thus entitled to enforcement and protection of its proprietary rights under Section 28 of the Trade Marks Act, 1999 (hereinafter referred to as the 'Act'). Present case satisfies the triple identity test: (a) competing marks are identical; (b) products/services with which the trademark is associated i.e. cinematographic films and entertainment services, are identical; and (c) territory is identical i.e. India. Case of the Plaintiff therefore squarely falls under Section 29(2)(c) of the Act and by virtue of Section 29(3) likelihood of confusion is to be presumed, being a statutory presumption. Even if it is assumed that there is no confusion as to the source of service, at the very least, there is likelihood of confusion as regards association, sponsorship, endorsement etc. This has become extremely significant in today's day and time where films are co-produced by various production houses, enhancing the possibility of confusion. Reliance is placed on the judgment of the Supreme Court in *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai and Others, 2022 SCC OnLine SC 61*.

12. Plaintiff's film 'KHILADI' was a blockbuster film known in every household in India. The film launched Mr. Akshay Kumar as a star and earned him the sobriquet of 'Bollywood's Mr. Khiladi' or 'Khiladi Kumar'. Plaintiff's trademark 'KHILADI' by dint of commercial success of the movie, widespread popularity and recognition gained through extensive promotion and advertising, is exclusively associated with the Plaintiff and no one else. The film released in 1992 has created an indelible association between the trademark 'KHILADI' and the Plaintiff in the minds of general public.



13. It was obligatory upon the Defendants to conduct a trademark search before adopting an identical mark/name for its cinematographic film and had they done so, they would have learnt of the Plaintiff's registrations under multiple classes including Classes 9 and 41. Reliance is placed on the judgments in *Jagdish Gopal Kamath and Others v. Lime & Chilli Hospitality Services, 2015 SCC OnLine Bom 531* and *Midas Hygiene Industries (P) Ltd. and Another v. Sudhir Bhatia and Others, (2004) 3 SCC 90*.

14. Conduct of the Defendants is totally dishonest, which is also evident from the fact that apart from using Plaintiff's trademark in entirety, they have also adopted and used the silhouette of a man folding his legs apart, as a part of one of the alphabets, similar to the Plaintiff's depiction of a man on its 'KHILADI' trademark. Therefore, there is complete visual and conceptual similarity in the competing marks apart from phonetic similarity.

15. It is a settled law that titles of cinematographic films are worthy of protection as strong trademarks so long as the film title has achieved a secondary meaning. Some film titles that uniquely connote the film in question like Sholay, Zanjeer, Deewar like the Plaintiff's 'Khiladi' need to be protected. Reliance is placed on the judgments in *Anil Kapoor Film Co. Pvt. Ltd. v. Make My Day Entertainment and Another, 2017 SCC OnLine Bom 8119* and *Kanungo Media (P) Ltd. v. RGV Film Factory & Others, 2007 SCC OnLine Del 314*.

CONTENTIONS RAISED ON BEHALF OF THE DEFENDANTS:

16. The impugned film was released in theatres, both in Telugu and Hindi dubbed version, on 11.02.2022 and is, in fact, no longer running on theatres. The film was made available on OTT/Satellite Platforms



on 11.03.2022 and 14.03.2022, respectively. Accordingly, no interim injunction should be granted as that would amount to the impugned film being permanently removed from being accessible to the public since the film is different from a packaged good. While the latter can be simply recalled and released after being repacked, the same is not possible in case of a film.

17. Plaintiff has no registration for the word mark 'KHILADI' and a bare perusal of the registration being T.M. No. 3491374 would show that it is a device mark for a poster having several features and the word 'KHILADI' is only one part of the device mark. Plaintiff has itself claimed exclusivity and distinctiveness in the device mark as a whole before the Registrar of Trade Marks in its reply dated 15.09.2017 and therefore, it is not open to the Plaintiff to claim distinctiveness in the word 'KHILADI', as this would amount to achieving indirectly what it could not achieve directly before the Registrar. Reliance was placed on the judgments in *Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd., AIR 1955 SC 558* and *Vardhman Buildtech Pvt. Ltd. & Ors. v. Vardhman Properties Ltd., 2016 SCC OnLine Del 4738*, to support the argument that where a distinctive label is registered as a whole, such registration cannot give any exclusive statutory right to the proprietor to the use of any particular word or name contained as a part of the mark. Thus, no case of infringement is made out by the Plaintiff.

18. Plaintiff is guilty of material suppression inasmuch as it has not filed before this Court the documents pertaining to registration filed before the Registrar of Trade Marks and has deliberately concealed in the plaint that registrations are with respect to device marks and the narrative in the plaint is malafidely crafted to portray as if the Plaintiff



has exclusive proprietary rights over the word mark 'KHILADI', which is wholly incorrect. For the proposition that suppression of material facts is fatal for grant of temporary injunction, reliance was placed on the judgment in *Warner Bros. Entertainment Inc. & Anr. v. Harinder Kohli & Ors., 2008 SCC OnLine Del 1081*.

19. The word 'KHILADI' is a generic word which translates into 'Player' in English language and has been widely used in a number of films and shows across the Indian film industry and is common to trade. There are more than 40 films and/or shows in various languages which have been produced with the name 'KHILADI' and out of this only two are to the credit of the Plaintiff. In fact, in 2013 a film titled 'KHILADI' was released in Bengali language. The word 'KHILADI' is a descriptive word of a non-distinctive character and not a coined or an arbitrary word as alleged by the Plaintiff. This is also fortified by the fact that an application for registration of the word 'KHILADI' by Mr. Akshay Kumar was refused by the Registrar of Trade Marks.

20. Plaintiff's film 'KHILADI' was released in the year 1992 i.e. 30 years ago. No announcement of a proposed release of a film with the Title 'KHILADI' has been pleaded by the Plaintiff, which would show that there is possibility of confusion in the minds of the consumers. In any case, Plaintiff has been unable to show that the word 'KHILADI' is synonymous with Plaintiff's work and that the general public identifies the word 'KHILADI' only with the Plaintiff. No *prima facie* case of likelihood of confusion or passing off of the Plaintiff's film has been made out against the Defendants. Since the impugned film is already out of the theatres and is only running on OTT/Satellite Platforms, the likelihood of confusion in any event in the minds of the public is close to zero as any person who wishes to watch a film on an



OTT Platform will view the entire poster of the film, which includes photograph of the actors, title of the film and other details like the producer, director etc. and make a choice accordingly. In the present case, the cast of the impugned film includes Sh. Ravi Teja as against Sh. Akshay Kumar in the Plaintiff's film and there can be no cause for confusion in the photographs of two actors. Thus, no *prima facie* case is made out by the Plaintiff for grant of injunction.

21. No case of balance of convenience or irreparable harm and injury has also been made out by the Plaintiff. Plaintiff is also guilty of gross delay inasmuch as the impugned film was announced way back on 18.10.2020 and the Plaintiff approached this Court after a delay of almost two years i.e. on 10.02.2022, which was one day prior to scheduled release date of the said film. The film of the Defendants was announced on 18.10.2020 and since then Defendants promoted the film in public domain incurring huge expenditure. Defendant No.2 has made investment in production of the film, which has a stellar star cast. Defendants have entered into several service agreements, supplier agreements and agreements with owners of OTT Platforms and if the film is interdicted at this stage, breach of agreements would attract various penalties and legal complications. If Defendants are directed to change the title of the film, it would entail changing the posters, designs, marketing campaigns and in turn incurring expenses running into several crores. Reliance was placed on the judgments in *John Hart Jr. and Another v. Mukul Deora and Others, 2021 SCC OnLine Del 3499*; *Dr. Reddy's Laboratories Limited v. Eros International Media Limited and Another, 2021 SCC OnLine Del 1298* and *Biswaroop Roy Choudhary v. Karan Johar, 2006 SCC OnLine Del 828*, for the proposition that delay in approaching the



Court has been held to be fatal for grant of temporary injunction in relation to movies.

22. Plaintiff was fully aware of the release of the film as on 18.10.2020, when the lead actor of the impugned film posted the announcement of the film on his official Twitter handle. On 19.10.2020, knowledge of commencement of the film and the pooja ceremony was also in public domain. The first glimpse of the impugned film was released on 26.01.2021, followed by a teaser on 12.04.2021. On 31.03.2021, articles were published in leading newspapers confirming the release of the upcoming film though later the release was postponed on account of Pandemic COVID-19. On 25.01.2022, an article was available in the public domain, announcing Hindi debut of Ravi Teja with 'KHILADI' on the Valentine's day weekend.

23. Defendant No. 2 possesses a Censor Certificate issued by Central Board of Film Certification ('CBFC') under the Cinematograph Act, 1952 issued on 09.02.2022 and 11.02.2022 for Telugu language and Hindi (dubbed) language, respectively. It also has a title registration for the film titled 'KHILADI' issued by Telangana State Film Chamber of Commerce on 12.11.2019. There is no provision for change of title of the film in the Bye-laws and Rules and Regulations of CBFC and once the film is certified by CBFC under the Cinematograph Act, 1952 or commercially exhibited/ released in theatres, then the title or any part thereof cannot be changed by anyone including the film's producer. This is evident from the answer given by CBFC to one of the FAQs, which is as follows:-



“14. What is the procedure for change of title after certification?”

After certification, normally a title cannot be changed unless the Regional Officer is satisfied that there is a very genuine reason for change of title. Even here, titles cannot be changed for a film which has already been released in a theatre. Application should be made under Rule 33, payment should be made online. Only in exceptional circumstances / after clarifying with local CBFC office, the fees may be paid offline, demand draft should be paid in favour of the designated Accounts Officer of that region. An affidavit should also be given on a stamped paper that the films has not been commercially exhibited. Title Registration should be obtained from the concerned body.”

CONTENTIONS ON BEHALF OF THE PLAINTIFF IN REJOINDER

24. There is no delay in approaching the Court disentitling the Plaintiff to an injunction inasmuch as Plaintiff learnt for the first time of Defendants’ infringing activities i.e. forthcoming release of impugned film only on 08.02.2022. This fact is stated on oath in Mr. Ratan Jain’s affidavit who is Director of the Plaintiff Company. The knowledge was through a Hindi trailer of the original Telugu film made by the Defendants. Immediate steps were taken to draft the plaint and the suit was listed on 10.02.2022 on urgent mentioning i.e. before the release of the impugned film. As a matter of fact, the Indian film industry produces around 1800 films annually in 41 languages and it would be unreasonable to expect the Plaintiff to be aware of release of every upcoming film, especially those in regional languages, such as the impugned film. In fact, the dishonesty of Defendants is apparent from the fact that Defendants admittedly registered the title of their film with Telangana State Film Chamber of Commerce and not with one of the four main film associations which are well-recognized and pervasive in Hindi film industry. Registration of the Hindi dubbed version of the film with the said Chamber of



Commerce was only on 08.02.2022 and no delay can thus be attributed to the Plaintiff. The CBFC certification of the Telugu version of the impugned film was given on 09.02.2022 while that for the Hindi dubbed version was granted only on 11.02.2022. It was dishonesty on the part of the Defendants in not informing the Court on 10.02.2022 that it was still to receive CBFC certification for the Hindi dubbed version. In fact, the impression given was that all formalities were completed and the movie was slated for release on 11.02.2022. This misrepresentation and suppression led to non-grant of relief to the Plaintiff as the impression given was that Plaintiff had approached the Court at the last minute.

25. Contentions of the Defendants that it is not possible to change the title having obtained CBFC certification, particularly, once the film has been released is misconceived and contrary to the decision in *Shri Babuji Rawji Shah v. S. Hussain Zaidi & Ors., SLP(C) No.15711/2021, decided on 24.02.2022*, wherein the Supreme Court has held that an injunction action can be initiated even after a certificate is issued under the Cinematograph Act. In any event, it is a matter of common knowledge that in the film industry CBFC certification only relates to theatrical release of the films. Ministry of Information and Broadcasting, in an RTI reply has clarified that CBFC primarily certifies films for theatrical release and the Ministry has no control over films appearing online. In fact, in *Mr. Shivaji Rao Gaikwad v. M/s. Varsha Productions, 2015 SCC OnLine Mad 158*, the Madras High Court had granted an injunction in respect of a film despite CBFC certification.

26. Defendants have vehemently contended that there are various third parties who have trademark registrations for the mark



‘KHILADI’ and according to the Defendants, Plaintiff has itself admitted in the plaint that six such films containing the word ‘KHILADI’ have been released. The contention is baseless for manifold reasons. Firstly, none of the third-party trademark registrations cited by the Defendants are for ‘KHILADI’ word per se. Each of them have a suffix or a prefix with the word ‘KHILADI’. Secondly, when Mr. Akshay Kumar sought to register the trademark ‘KHILADI’ it was the Plaintiff who had opposed and the application was abandoned which only supports the stand of exclusivity of Plaintiff’s proprietorship over the mark ‘KHILADI’. Thirdly, each of the six films mentioned by the Defendants have a prominent prefix or suffix and till date no film has been released with the word ‘KHILADI’ alone, save and except, that of the Plaintiff. Even assuming for the sake of arguments that there are others who are using ‘KHILADI’ word per se, it is a settled law that Plaintiff is not expected to chase every infringer as held in *Pankaj Goel v. Dabur India Ltd., 2008 SCC OnLine Del 1744*. It is also settled that there is a distinction between ‘common to the register’ and ‘common to the trade’ and mere presence of the mark on the Register does not prove its use as held in *Century Traders v. Roshan Lal Duggar & Co., 1977 SCC OnLine Del 50*. Lastly, for the plea of ‘common to the trade’ to succeed, use by third parties should be substantial as held in *Express Bottlers Services Private Ltd. v. Pepsico Inc. & Ors., 1988 SCC OnLine Cal 62*, which in the present case Defendants have been unable to substantiate.

27. Defendants have contended that Plaintiff can only assert rights over the device mark as a whole and in the absence of registration in the word ‘KHILADI’, Plaintiff cannot dissect the device mark and



assert a separate right over the word 'KHILADI'. The contention deserves to be rejected as it is a settled law that even in respect of device marks, test is to identify and compare the essential and dominant elements of the mark, since it is these elements that create a commercial impression in the minds of the public. The dominant and essential part of the device mark is 'KHILADI' and the Plaintiff can assert its rights both under the Statute and common law for its protection. Reliance was placed on the judgment in *Shambhu Nath & Brothers & Ors. v. Imran Khan, 2018 SCC OnLine Cal 7145* and *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel and Others, (2006) 8 SCC 726*.

28. It is wrong for the Defendants to contend that balance of convenience is in favour of the Defendants only because the film has been released and they have entered into various commercial arrangements. Plaintiff is a registered proprietor of the trademark 'KHILADI' which has been extensively associated with the Plaintiff. If the interim injunction is not granted Plaintiff will be deprived of its right and opportunity to come out with a subsequent franchise 'KHILADI' film and would also be deprived of potential merchandising opportunities in relation to 'KHILADI' trademarks and movie. Moreover, the present suit is for vindication of Plaintiff's statutory rights and no amount of monetary damages can be a substitute for grant of injunction at this stage, particularly, when Plaintiff has made out a *prima facie* case of infringement against the Defendants. Irreparable harm and injury in the present case continue to persist since Defendants' film under the infringing title is continuing to remain on the OTT Platforms. Plaintiff is thus entitled to grant of injunction restraining the Defendants from continuing the



impugned film on the various platforms under the infringing title. Defendants cannot raise a plea of estoppel as there is no estoppel against a statutory right and once the Plaintiff's trademark is registered, statement made before the Trade Marks Office cannot be read out of context to deny protection to the Plaintiff. [*Ref. H&M Hennes & Maurtiz AB and Anr. v. HM Megabrands Pvt. Ltd. & Ors., 2018 SCC OnLine Del 9369 and KEI Industries Limited v. Raman Kwatra and Another, 2022 SCC OnLine Del 1459*].

29. I have heard learned counsel for the Plaintiff and learned Senior Counsel for the Defendants.

30. Present application has been filed by the Plaintiff seeking injunction restraining the Defendants and their agents etc. from using Plaintiff's registered 'KHILADI' trademarks or deceptively similar marks/title/name of any cinematographic films, motion pictures etc. on cinema halls, DVD/VCDs and OTT Platforms amounting to infringement as well as passing off.

31. When the suit was filed, Plaintiff had averred in the plaint that it was on 07.02.2022 that it learnt of the forthcoming release of the film titled 'KHILADI' by the Defendants and although the film was stated to be released in Telugu language, it would also be available in Hindi language to be released in cinemas on 11.02.2022. It is averred in paragraph 22 that Plaintiff was shocked to learn of this unlawful activity through a newspaper article originally published on 05.02.2022. Paragraph 23 contains an averment that Plaintiff thereafter learnt that there were other news articles and dedicated Wikipedia pages regarding the upcoming impugned film, which was initially to be released in April, 2021, but was postponed due to Pandemic COVID-19. Therefore, when the suit was filed, according to



the Plaintiff, the movie of the Defendants was yet to be released and in this backdrop an injunction was sought.

32. Summons were issued in the suit on 10.02.2022 when the suit was listed on urgent mentioning. The order records that parties were heard for over an hour till 05.00 pm. It is also recorded in the order that the movie was scheduled to be released in cinemas on 11.02.2022 and on this count, Mr. Pravin Anand, counsel for the Plaintiff, on instructions, stated that he would not press for an *ex parte* order qua the theatrical release. As noted above, the impugned movie was also released on OTT/Satellite platforms on 11.03.2022 and hence, no interim injunction was granted to the Plaintiff at that stage.

33. Defendants have taken an objection against grant of injunction after the release of the movie on all platforms, on the ground that an interim order would amount to Defendants' film being permanently removed from being accessible by public after it has been released which would be extremely detrimental to its reputation. Objection is also raised on the ground that there is gross delay on the part of the Plaintiff in approaching the Court which disentitles the Plaintiff from seeking a temporary injunction. While it is the case of the Plaintiff, as pleaded in the plaint, that it learnt of the forthcoming release on 07.02.2022, Defendants plead and urge that the film was announced on 18.10.2020, after which the film was extensively promoted, which is evident from promotional materials in the public domain. Reliance is placed on the official Twitter handle posting the announcement of the film on 18.10.2020; advertisement as well as articles in public domain on 19.10.2020 announcing the commencement of the film and Pooja Ceremony; first glimpse of the film on 26.01.2021; release of the teaser on 12.04.2021; articles in leading newspapers on



31.03.2021; postponement of the film due to Pandemic COVID-19 announced on 05.05.2021; film teasers in August, 2021 on public domain on the YouTube Platform, followed by an article in the public domain announcing the debut of Sh. Ravi Teja in a Hindi movie set for release on Valentine's Day weekend. Interestingly, while the Plaintiff has pleaded the date of knowledge as 07.02.2022 in the plaint, in the written submissions filed subsequently it is stated that it gained knowledge on 08.02.2022, when Plaintiff came across the Hindi trailer of the original Telugu film. The question that thus arises is if delay defeats the grant of temporary injunction which is an equitable relief.

34. It is trite that delay by itself cannot defeat the claim of a party if it is able to establish infringement/passing off. However, while considering grant of interlocutory injunctions in relation to release of movies, Courts have ordinarily declined to grant interim relief where parties have approached belatedly or on the eve of the release of the films by the opposite parties. Judicial precedents show that a thin distinction has been drawn between 'goods' and 'films', when it comes to delay in approaching the Court and in this context, I may allude to the judgment of this Court in ***Kanungo Media (P) Ltd.*** (*supra*), where one of the questions before this Court was '*what would be the effect of delay in bringing the cause to the Court*'? The question was answered as follows:-

"31. Such a silence on the part of the plaintiff may amount to giving up rights, if any, he had. What is more important is that consciously he allowed the defendants to go ahead with the production of the movie 'Nishabd'. Since the storyline of the defendants' movie is totally different, even if it was being shot with the said story, it was not of any concern to the plaintiff. However, what would be of relevance to us is the actions and steps taken by the defendants in the adoption of the title 'Nishabd' for their movie.



In April 2006, the defendants had announced that they were producing the film by the name 'Nishabd'. In July 2006, the Association of Motion Pictures granted a certificate to the defendants for registering the feature film with this title in India. On 18-7-2006 the said Association had even issued a circular, which was sent to all producer members. Various articles in the media appeared regarding this movie. The producer and the director wanted to project the bold theme, which this movie had and the articles focused this theme of the movie. After the completion of the movie and before its release, as it has become a necessary marketing strategy, the defendants also started promotional work of the movie. It is stated that a sum of Rs 1.5 crores is the advertisement budget for this movie and large part of it has already been spent. The defendants even launched website of this movie. Music rights have already been sold to the Defendant No. 3. They have started producing and distributing compact discs and cassettes in the market, which are available at all music stores all over the world and also from the internet. Since December 2006, trailers of the defendants' movie have been running in various cinema halls. Posters and publicity material of the film have also been distributed. The lead cast in the movie is Amitabh Bachchan and Jiah Khan. Amitabh Bachchan is indubitably an established and accomplished actor of prominence, who many perceive to be a living legend. What is emphasised by the defendants is the impact of publicity of the defendants' film with title 'Nishabd' by keeping him in the forefront of such promos. Jiah Khan is a debutant and the producers have tried to launch her as a new face aptly suited for such a role. With this kind of promotion given by the defendants to their forthcoming film, it is claimed that general public today associate title 'Nishabd' more with the defendants' film and not the plaintiff's.

32. *When the matter is examined in the aforesaid backdrop, the plaintiff has lost the chance in getting temporary injunction by not approaching the court earlier. By his inaction and allowing the things to happen in the aforesaid manner, it has slipped an opportunity. Things would have been different had we considered this case when the film was being shot by the defendants or even completed but before the promotional work of the film started by the producers. The plaintiff could have argued that he is the senior user of the title and it is his film alone which has not only been produced much earlier but has been shown in various Film Festivals and has won awards and, therefore, has acquired secondary meaning, namely, title 'Nishabd' is associate with his film. I consider that favourable critical reaction to the work may be treated as evidence of secondary meaning for the title, as a highly praised work is more likely to be known to the public by name. In fact, "any publicity is good publicity" and, therefore, it is not necessary that to acquire secondary meaning, work has to be popular, for even bad reviews and advertisements, public comments may bring about widespread*



identification of the literary work by its title. May be, consideration of the plaintiff's claim say even in July/August 2006 could have yielded positive results for it. In presenti, because of the publicity of extravagant nature of the defendants' film in the form of articles published in the journals and newspapers, posters, website, release of film's music, the forthcoming film of the defendants is known more than that of the plaintiffs. The plaintiff has allowed it to happen. It is because of this that the plaintiff even cannot claim that the title 'Nishabd' is associated only with its movie or the public does not know about the defendants' movie.

33. Prima facie, as of today the claim of the plaintiff's movie's title 'Nisshabd' appears to be blurred in comparison with the defendants' movie's title 'Nishabd'. For the same reason, as the defendants' forthcoming movie has acquired much publicity, there is hardly any question of confusion. One cannot, in the process, lose sight of the fact that the plaintiff's film is a documentary and in Bengali language whose viewership would be substantially less than a Hindi movie. Further, no doubt, the plaintiff's movie has achieved critical acclaim but only in the Film Festivals where not only the viewership is limited but of a particular category. Therefore, in today's context in so far as the question of granting temporary injunction is concerned, the plaintiff has not been able to meet the above requirements.

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38. Consequently, I am therefore, of the view that injunction of the nature pressed by the plaintiff cannot be granted to the plaintiff at this stage when it approached the court barely 10 days before the proposed release of the defendants' film with the same title. This injunction application is, therefore, dismissed. It is made clear that entire discussion in the order is on the prima facie view of the mater and observations made in this order are only tentative."

35. In ***Biswaroop Roy Choudhary (supra)***, Plaintiff had sought an interim injunction restraining the Defendant from using the trademark/title 'KABHI ALVIDA NAA KEHNA'. Defendant had contested the grant of interim injunction on the ground of delay amongst other objections and had also placed material on record to show that Plaintiff had knowledge of Defendant's proposed activities.

In this context, this Court held as follows:-

"13. Delay in approaching the Court, so far as grant of equitable relief is concerned, is always fatal. If the plaintiff is a serious



producer of film, he ought not to have ignored gossip within his trade, whether it was in the form of Press reports or exchange of communication to the Guild or Association claiming the same title. At this present moment I am unable to find any plausible reason for not filing the present case at least upon the defendants performing its Mahoorat. The plaintiff has waited for the defendants to expend large sums of money and energy in the completion of the film with the same title, thereby shifting the balance of convenience in favour of the defendant. The situation that is arrived at is that the likelihood of passing off is almost wholly eradicated. The subsisting claim may, at the highest, be the use of a title which the plaintiff has itself failed to use. The right as well as the loss can only be determined after the Trial.

14. *It is legally loathsome to protect 'squatter', in the sense that if a trademark or title is not effectively exploited the plaintiff cannot be assisted in blackmailing or coercing another user into settling the plaintiff's claim for money by filing litigation. At this stage of the proceedings I cannot but view this Suit as mala fide."*

36. Similar situation came before this Court in ***John Hart Jr. and Another (supra)***, where the Plaintiffs sought to injunct release of the film 'THE WHITE TIGER' by Defendant No. 1 therein and an objection was taken by the said Defendant that the claim asserted by the Plaintiffs was highly belated. Relying on the aforementioned judgments as well as the judgment in ***Warner Bros. Entertainment Inc. & Anr. (supra)***, Court declined to grant injunction on the sole ground of unquestionable delay in approaching the Court. Relevant paragraphs of ***John Hart Jr. and Another (supra)*** are as follows:-

"27. No case, in my view, for grant of any interlocutory injunction, as sought by the plaintiffs, exists, for the following reasons:

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A reading of para 121 of the plaint makes it apparent that, since October, 2019, the plaintiffs have been acutely aware of the possibility of release of the film, of which injunction is sought in the present plaint/application. It is no answer, to the delay in moving this Court, to say that, owing to intervention of COVID pandemic, the plaintiffs were under the impression that no shooting would take place or. that the film would not be released. Neither can it be the stand of the plaintiffs, in the wake of the aforesaid legal notice, that



they expected due diligence on the part of any person seeking to produce a film based on “The White Tiger” and to be informed of any such proposal, prior thereto. There are several authorities for the proposition that a plaintiff who approaches the court at the eleventh hour, seeking interlocutory injunction against the release of a cinematographic film, is disentitled to any such relief. The relevant passages, from Biswaroop Roy Choudhary, Kanungo Media (P) Ltd., Warner Bros. Entertainment Inc. and Vinay Vats may, in this context, be reproduced:

“13. Delay in approaching the Court, so far as grant of equitable relief is concerned, is always fatal. If the plaintiff is a serious producer of film, he ought not to have ignored gossip within his trade, whether it was in the form of Press reports or exchange of communication to the Guild or Association claiming the same title. At this present moment I am unable to find any plausible reason for not filing the present case at least upon the defendants performing its Mahoorat. The plaintiff has waited for the defendants to expend large sums of money and energy in the completion of the film with the same title, thereby shifting the balance of convenience in favour of the defendant. The situation that is arrived at is that the likelihood of passing off is almost wholly eradicated. The subsisting claim may, at the highest, be the use of a title which the plaintiff has itself failed to use. The right as well as the loss can only be determined after the Trial.”

(Emphasis supplied)

(from Biswaroop Roy Choudhary)

“34. In International Film Service Co. Ltd. v. Associated producers Inc. 273 F. 585 (D.C.N.Y. 1921), it was held that “The plaintiff succeeds as soon as he shows an audience educated to understand that the title means his play”. I am conscious of the argument of the learned counsel for the plaintiff that only because the plaintiff is a small time producer and, therefore, could not commercially release the film earlier, though he intends to do it now, title of his film should not be hijacked by those who consider themselves mighty and have reach in the film industry. There is a lot of substance in this argument. However, it is stated at the cost of repetition that such an argument would have been worth its weight had the plaintiff approached the court earlier and taken action to nip in the bud the attempt of the defendants in choosing this title for their film. In fact, knowing his limitations viz. if he allows the defendants to publicise their film with title ‘Nishabd’ he would lose out, should have made him more vigilant in promptly approaching the court. By delay it has allowed the damage to be



caused to itself inasmuch as, today overwhelming section of public associate this title with the defendants' film.

35. In this context, it would be apt to quote from the judgment of the Supreme Court in the case of Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel (2006) 8 SCC 726 where it is held as under:—

“103. Acquiescence is a facet of delay. The principle of acquiescence would apply where : (i) sitting by or allowing another to invade the rights and spending money on it; (ii) it is a course of conduct inconsistent with the claim for exclusive rights for trade mark, trade name, etc.”

37. Learned counsel for the plaintiff had referred to the judgment of the Supreme Court in the case of Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia, (2004) 3 SCC 90 and of this court in Glaxo Group Ltd. v. Vipin Gupta, (2006) 7 AD (Delhi) 688 to contend that injunction could not be refused only on the ground of delay and laches. It has to be borne in mind, in the first place, that it would be a principle applicable in the case of registered trade mark. Secondly and more important, is the distinction between the cases of passing off action in goods/trading and passing off action in literary works. In the former case one product is competing with the other and there are two competitors. However, as far as literary work is concerned, as has been pointed out above, it is a specific, separate and unique commercial item and not as one product among many competing products. Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Thus, in fact, this is the genesis for the adoption of the test of secondary meaning of title of a literary work. Therefore, it would be difficult to hold that delay is not fatal in such cases.

38. Consequently, I am therefore, of the view that injunction of the nature pressed by the plaintiff cannot be granted to the plaintiff at this stage when it approached the court barely 10 days before the proposed release of the defendants' film with the same title. This injunction application is, therefore, dismissed. It is made clear that entire discussion in the order is on the prima facie view of the mater and observations made in this order are only tentative.”

(Emphasis supplied)

(from Kanungo Media (P) Ltd.)

“34. Viewed from any angle, the plaintiffs have failed to establish a prima facie case for the grant of an ad interim



injunction in their favour. The balance of convenience also tilts heavily in favour of the defendants, who have invested huge sums of money, apart from entering into copious agreements and business tie ups with various third parties, including Britania, McDonalds, etc. In a manner of speaking, the plaintiffs have sat on the garden fence and allowed the defendants to traverse the whole of the garden path, before attempting to throw a spanner in the release of the film at the eleventh hour. If the plaintiffs were so keen and so wary of protecting their rights, it was incumbent upon them to vigilantly guard the same. This, the plaintiffs have failed to do and, as a matter of fact, the conclusion to the contrary clearly emerges from a reading of the documentary evidence on record. The plaintiffs have equally failed to establish that any irreparable loss or injury will result to them on the release of the film”

(Emphasis supplied)

(from Warner Bros. Entertainment Inc.)

“20. There is yet another reason, as to why I am not inclined to accede to the prayer of the plaintiff for grant of ad interim injunction. Mr. Aggarwal has acknowledged that, at the very least, the trailer of the film “Lootcase” was released on 16th July, 2020. I may note, in this context, that Mr. Neeraj Kishan Kaul contests this statement and submits that the promos of his client's film “Lootcase” had been in the public domain since June, 2019. Either which way, there is no justification for the plaintiff having approached this Court on the eve of the release of the film “Lootcase”, which is slated to be released tomorrow, i.e. 31st July, 2020 and seeking injunction against such release. It is further submitted, by Mr. Kaul, that the story of the film has been covered in the print as well as electronic media since September, 2019.

21. This case, therefore, appears, prima facie, to constitute yet another example of the misuse of the judicial process, regarding which Patel, J., has so trenchantly commented, in the following passages from Dashrath D. Rathore v. Fox Star Studios India, on which Mr. Kaul places reliance:

“6. Let me outline what granting such an application involves. If allowed, there will be an urgent hearing two days from now, on Thursday at the earliest, the day before the defendants' film releases. That hearing will take the better part of the day; most certainly a couple of hours. Both sides will want to argue the matter fully. Then I must dictate a judgment in Court. This must be transcribed that very evening. My staff, which work long hours — some commute two hours in one direction — must work late into the night to complete the transcription to deliver it to me for correction.



Assuming I carry out those corrections in soft copy myself, as is my usual practice, that will take another several hours. All this only so that these plaintiffs, who chose to come late though they could have come earlier, can have in their hands by 11 : 00 am on Friday morning a judgment complete in all respects. As I said, in a given case, with demonstrated urgency, yes, we do this, and we do. But to allow this in a case where the plaintiffs have deliberately waited till the last minute is grossly unfair not only to the Court's infrastructure and hard pressed staff but to other litigants waiting their turn. The attempt is, clearly, to pressure the defendants into making a statement of some kind or, worse yet, to pressure the Court into passing some hurried pro tem order for want of time with little or no assessment on merits, a wholly unfair advantage. A plaintiff who waits till the last minute must face the consequences of a failed gambit of this kind.

28. Dr. Tulzapurkar for the 1st defendant points out that, apart from the obvious differences, the delay in bringing suit cannot be accidental. On their own showing, the plaintiffs knew about the defendants' film since 24th February, 2017. They knew of the release date of 24th March, 2017. From that date of knowledge, i.e., for the last four weeks, they have chosen to wait, and have not come to Court until a mere three days before the release of the film. They have only served a copy of the plaint and Notice of Motion on the defendants only at 7.00 p.m. last evening and have sought this morning urgent circulation. By this time 800 theatres countrywide have been booked for release. Distribution rights have been created. Third party rights have intervened. There cannot be any question of irreparable injury to the plaintiffs in a situation such as this or of the balance of convenience favouring the plaintiffs even assuming that a prima facie case is made out, which in his submission, it is not. He submits that it is not enough to make out some prima facie case; to get an injunction of this kind, the plaintiffs must make out so overwhelming a prima facie case that all other considerations pale into insignificance. Unless I conclude that the plaintiffs have indeed made out a case of this strength, in his submission, no injunction can or should follow.

29. I agree with Dr. Tulzapurkar on all counts. I see no vestige of a prima facie case for the grant of ad-interim relief. Certainly, the balance of convenience can in no sense be said to be favour the plaintiffs. It is clearly with the defendants. As to the question of irretrievable injury, I notice that at no point did Mr. Saboo or Mr. D'Costa offer or volunteer to provide sufficient security — or indeed any kind of security — should the



plaintiffs' Motion ultimately fail to secure the defendants against loss.””

(Emphasis supplied)

(from Vinay Vats)

Even on the sole ground of unconscionable delay in approaching this Court, therefore, the plaintiffs stand disentitled from seeking any interlocutory injunction against release of the film.

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iii) In a case such as this, it is also not possible to hold, prima facie, that the prejudice that would result to the plaintiffs, were interlocutory injunction, as sought, not granted, is greater than that which would result to the defendants, were such injunction to be granted. The financial stakes, on both sides, are considerable. In case the defendants, as they assert, have been acting on the basis of rights validly assigned to them, there can obviously be no ground to injunct the release of the film. The release of a film is merely the culmination of a protracted exercise involving production, promotion and publicity, and I am, prima facie, inclined to agree with Mr. Sethi that if, at this point of time, release of the film is stayed, it will result in serious and irreparable repercussions to the defendants.

iv) Further, it is a well-settled principle that, where the loss occasioned to the plaintiff is capable of being adequately compensated in monetary terms, an injunction, especially of release of a cinematographic film, ought not to be granted⁵. Plaintiff No. 1 is, admittedly, not the original creator of the artistic work “The White Tiger”. He, even as per his own showing, claim to have been assigned the right to film the said novel, under a Literary Option Agreement dated 4th March, 2009. In view thereof, even if the defendants are allowed to release the film, and the plaintiffs ultimately succeed in the suit, I am of the opinion that it would be possible to recompense them monetarily, even in respect of the emotional trauma, which, according to Mr. Sankhla, Plaintiff No. 1 would suffer, as a result of his not being able to be the first to film “The White Tiger”.

28. On a holistic consideration of the facts, the extant legal position and especially as the plaintiffs have chosen to move this Court less than 24 hours before the release of the subject film, I am of the opinion that the plaintiffs are not entitled to any interim injunction, staying the release of the film. The prayer for interim injunction is, therefore, rejected.”



37. In *Dr. Reddy's Laboratories Limited (supra)*, Plaintiff sought interlocutory injunction restraining the release of a film named 'Hathi Mere Sathi', titled 'Kaadan' in Tamil and 'Aranya' in Telugu, through various media platforms. On the question of delay in approaching the Court, it was held as follows:-

“C. Delay in approaching the Court

25. *The Court finds considerable merit in the objection of the Defendants regarding delay on the part of the Plaintiff in seeking legal relief. The Defendant has pointed out that the teaser of the movie, which contained the alleged infringing use, was published in the month of February, 2020 and has garnered millions of view on YouTube. Yet, the Plaintiff has approached the doors of justice just days before the release of the movie. In fact, it is the admitted case of the Plaintiff that upon sighting the alleged use of its mark in 2020, the Plaintiff sent a legal notice dated 3 March, 2020, but the teaser was not brought down by the Defendants. The Plaintiff, despite receiving no response for the same, the Plaintiff did not approach the Court. According to the justification provided by Mr. Lall, the lack of release of the movie on its originally set date of 2 April, 2020, along with the lack response to its notice, led the Plaintiff to assume that same is an admission of the facts contained in its notice. Mr. Lall submits that the present suit is timely, because when the Plaintiff noticed that the Defendants have launched a trailer video of the movie on YouTube on 4 March, 2021 and was apprised of its release on 26 March, 2021, the Plaintiff issued the notice dated 8 March, 2021, which was replied to by the Defendants on 12 March, 2021, refuting the assertions in the legal notice, and the present suit was filed without delay on 17 March, 2021. This line of reasoning is not convincing in the slightest and cannot justify the delay of filing the present action, the timing which is highly suspect and belated, being just few days before the date of release of the movie. The cause of action for the Plaintiff to approach the Court, arose as early as, February, 2020 and the present suit filed after nearly one year of first coming into the knowledge of the infringing action. This laxity would disentitle the Plaintiff of the discretionary relief of injunction, which is based on equity. In this one year, the Defendants have gone ahead with the preparations for the release of the movie by expending monies, time and energy and entering into contracts with third parties. This, as rightly contended by the Defendant, would tilt the balance of convenience in its favour. The Plaintiff has tried to differentiate the judgment of this Court in John Hart (supra), by justifying that the belated action was under a bona fide belief that the movie of the Defendants was not released, however the same is clearly misplaced. Besides, the judgment of this Court in Hindustan*



Pencils (P) Limited v. Indian Stationery Products Co.,⁹ would not advance the Plaintiffs case, as the facts in the said case are clearly distinguishable. The said case was regarding trademark infringement, where the Defendants had continued to do its business by using the registered device and word mark of the Plaintiff. The Court therein held that such a use by the Defendants was at its own peril and cannot be set up as a defense. Further, the Court in the said case noted that it was not in dispute that the mark used by the Defendants was similar to that of the registered mark of the Plaintiff and there was, thus, a clear breach of the Plaintiff's right under the Act. However in the present factual matrix, the injunction is being sought against the release of the movie, when the balance of convenience has clearly shifted in the favour of the Defendants, and thus the case is distinguishable on facts. In the opinion of this Court, on the ground of delay itself, the Plaintiff would be disentitled to the relief of injunction as sought for in the present application.

Conclusion

26. Thus, on the consideration of the facts and circumstances noted above and the legal position on the subject, in the considered opinion of this Court, the Plaintiff has failed to meet the three-pronged test for grant of injunction. The Plaintiff does not have a prima facie case in its favour, the balance of convenience is in favour of Defendants and not in favour of the Plaintiff. The Plaintiff has not been able to make out a case of irreparable loss that it would suffer if the movie is released. The Plaintiff can always, in such circumstances, if it succeeds in establishing its case in trial, cement its claims for compensation and damages. In these circumstances, the present application is completely devoid of merits and accordingly, the same is dismissed.”

38. Returning back to the facts of the present case, there is a categorical averment by the Defendants that the announcement of their film was in the public domain way back on 18.10.2020 when Sh. Ravi Teja posted the announcement of the film ‘KHILADI’ on his official twitter handle. In rejoinder to the reply, Plaintiff has stated that it learnt of the trailer of the film in Hindi on 08.02.2022 when the same was released on YouTube and Facebook handles of Defendant No. 1 and also saw the poster of the Hindi version of the film on Instagram handle of Defendant No. 1, mentioning the release date as 11.02.2022. Investigation revealed that the trailer of the film in Telugu was



released on 07.02.2022 on YouTube handle of Aditya Music. The suit was prepared in a day on 09.02.2022 and filed and listed on 10.02.2022 on urgent mentioning. It is also stated that Indian film industry produces large number of films approximately 1800 films in a year in 41 languages and it is impossible to keep a track and in any case delay cannot come in the way of grant of injunction if the action of the Defendants amounts to infringement of Plaintiff's registered trademark. Significantly, there is no denial to the dates and events given by the Defendants, save and except, general and evasive denials. From the pleadings of the Defendants and the documents placed on record, it is *prima facie* evident that there was enough material in the public domain since October, 2020 to put the Plaintiff to notice of the upcoming movie. The film teasers were also available in the public domain in July-August, 2021 *albeit* the release was postponed on account of Pandemic COVID-19. Leading newspapers carried articles confirming the release of the film in March, 2021 including an article published on 25.01.2022 announcing the debut of Sh. Ravi Teja in a Hindi film. Being in the same industry and having access to all social and media platforms, it is unbelievable that Plaintiff was unaware of the making and proposed release of Defendants' movie 'KHILADI'. Yet, Plaintiff waited to approach Court on the eve of the release at its own risk and peril. This delay to my mind is fatal to the case of the Plaintiff apart from the fact that Plaintiff has been unable to make out a *prima facie* case of infringement and passing off for reasons I shall advert to in the later part of the judgment. Plaintiff has placed reliance on the affidavit of Mr. Ratan Jain, Director of the Plaintiff Company to substantiate that there was no delay. The statements made in the affidavit can only be tested during the trial and will not further the



case of the Plaintiff at this stage, in view of plethora of documents filed by the Defendants to show information of the impugned film in public domain since 2020.

39. There are two other objections which were pressed by the Defendants with vehemence, which according to them, disentitle the Plaintiff to any interim injunction. It is stated in the written statement filed by Defendant No. 2 that Plaintiff is: (a) guilty of *suppressio veri suggestio falsi* for deliberately and wilfully suppressing material documents from the Court wherein it is acknowledged that the word 'KHILADI' is of non-distinctive character; and (b) misrepresenting and portraying as if Plaintiff has registration in the word 'KHILADI', deliberately omitting to state that registration is in the device marks. False declaration has been given in the Statement of Truth that all relevant documents have been filed while the most crucial document i.e. the Legal Proceedings Certificate has not been filed.

40. Reading of the plaint shows that Plaintiff has oversimplified and overstated its case. A holistic reading of the plaint shows that Plaintiff is seeking exclusive proprietary rights over the word 'KHILADI' and this is the foundation of the allegations of infringement and passing off against the Defendants. This is amply clear from paragraph 26 of the plaint as an illustration, wherein the comparative table shows that only a portion of the device mark containing the word 'KHILADI' has been carefully extracted, instead of comparing the device mark as a whole. This is perhaps due to the realisation that the device mark of the Plaintiff and the rival mark are incomparable. For ready reference, paragraph 26 is extracted hereunder:-



“26. The Plaintiff’s apprehension of imminent loss and damages is further strengthened by the fact that the Defendants’ forthcoming film has used the trademark ‘KHILADI’ simpliciter without any prefix or suffix, in isolation. What is also noteworthy is that the name of the Defendants’ film is printed in block upper-case letters on their theatrical promotional banners, with the silhouette of a man standing with his legs apart encapsulated in one of the letters. This is deceptively similar to the Plaintiff’s depiction and use of its “KHILADI” trademark on the promotional banners of its ‘Khiladi’ movie, wherein also there is a silhouette of a man holding his legs apart as part of one of the letters. The two contrasting depictions are given below:

PLAINTIFF’S DEPICTION OF ITS TRADEMARK	DEFENDANTS’ DEPICTION OF THE IDENTICAL MARK


41. At this stage, it would be relevant to refer to a comparative of the rival marks of the parties, which *prima facie* shows not only dissimilarity in the rival marks, but also supports the contention of the Defendants that an impression is created as though Plaintiff has statutory enforceable right in the word KHILADI. Comparative of the rival marks is as follows:-

PLAINTIFF’S REGISTERED DEVICE MARK	DEFENDANTS’ IMPUGNED MARK




42. There is *prima facie* also merit in the contention of the Defendants that Plaintiff has suppressed material documents from this Court, more particularly, its own stand before the Registrar of Trade Marks. It is stated in the written statement filed by Defendant No. 2 that Plaintiff had applied for registration of the device mark 'KHILADI' bearing TM No. 3491374 on 24.02.2017. On 11.03.2017, the Registrar of Trade Marks issued the First Examination Report, objecting to the registration of its device mark 'KHILADI' in view of



Section 11 of the Act and cited conflicting marks '  ',



'KHILADI' and '  '. Response of the Plaintiff to the First Examination Report vide letter dated 15.09.2017 is important and is extracted hereunder:-

"After perusal of the search report issued by your good office we humbly say and submit that the marks cited in the search report bearing application nos.2178688, 2832774 and 3019917 are visually and structurally altogether different from the applied label mark "KHILADI". The applied label mark essentially consisting of words "KHILADI" written in artistic and stylized manner at the bottom of the label along with picture of star caste of the film Akshay Kumar, Ayesha Julka, Deepak Julka and Shabeena depicted on the label. On comparing the applied mark with the cited marks as a whole there is absolutely no similarity whatsoever.

Therefore, it is distinctive and there would be no confusion in the minds of the consumers and traders with respect to the applicants mark and cited marks.

In view of the above the objections raised in this para may kindly be waived."

43. It is clear that Plaintiff sought registration in the device mark as a whole and it is thus not open to the Plaintiff to claim exclusivity on part of the mark i.e. word 'KHILADI' in view of the well accepted



and recognised doctrine of prosecution history estoppel and law of anti-dissection, which admits of only one exception where the Plaintiff's asserted mark is the dominant part of a composite/label/device mark.

44. It needs no reiteration that a party who suppresses material facts is not entitled to claim interim injunction, which is an equitable relief. In *S.P. Chengalvaraya Naidu (Dead) By LRs. v. Jagnath (Dead) By LRs. and Others, (1994) 1 SCC 1*, the Supreme Court has observed that it is legal duty cast upon the Plaintiff to come to Court with true case and prove it by true evidence. Courts of law are meant for imparting justice between the parties and one who comes to the Court must come with clean hands. It was observed that '*we have no hesitation to say that a person whose case is based on falsehood has no right to approach the Court. He can be summarily thrown out at any stage of the litigation.*' It was also observed that where a party withholds a vital document in order to gain advantage on the other side, he would be guilty of playing fraud on the Court as well as on the opposite party. In *Mohan Devi v. Daljeet Singh & Ors., 2007 SCC OnLine Del 1344*, this Court held that injunction is a discretionary relief and a party which suppresses material facts is not entitled to the relief. [Ref. *Kent RO System Limited and Another v. Gattubhai and Others, 2022 SCC OnLine Del 791*]. Plaintiff is thus disentitled to an interim injunction on both these counts.

45. Plaintiff has placed reliance on the judgments in *H&M Hennes & Maurtiz AB and Anr. (supra)* and *KEI Industries Limited (supra)*, to contend that there is no estoppel against a statutory right and once Plaintiff's trademark is registered, statements made before the Trade Marks registry cannot be read out of context to deny protection to the



Plaintiff. In my view, none of these judgments would inure to the advantage of the Plaintiff on account of the observations of the Division Bench of this Court in ***Raman Kwatra and Another v. KEI Industries Limited, 2023 SCC OnLine Del 38***, relevant paragraphs of which are as follows:-

*“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of *Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd. (supra)* holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.*

44. The respondent had applied for the word mark “KEI” in Class 11 (Application No. 3693719). The Trade Marks Registry had cited three marks in its Examination Report including the impugned trademark (Application No. 3256919). In its response to the Examination Report, the respondent had, inter alia, stated “.....the services of the Applicant are different to that of the cited marks and therefore, there is not any likelihood of confusion....” Clearly, in view of the aforesaid statement, it would not be open for the respondent to contend to the contrary in these proceedings.”

46. I may also allude to a recent judgment of the Bombay High Court in ***PhonePe Private Limited v. Resilient Innovations Private Limited, 2023 SCC OnLine Bom 764***, relevant paragraphs of which are as follows:-

“28. In this regard, the aspect of prosecution history estoppel assumes significance. The plaintiff is not justified in contending that once it has obtained registration for its trademark, the stand taken



on its behalf in proceedings leading upto grant of such registration cannot haunt the plaintiff in subsequent legal proceedings. This Court in the case of *Unichem Laboratories Limited v. IPCA Laboratories (supra)* held as follows:—

“28. On the other hand, Mr. Dwarkadas, learned Senior Counsel appearing on behalf of the Defendant No. 2, submits that the Plaintiffs have not approached this Court with clean hands. They have suppressed from this Court the fact that the Application No. 1077469 made by the Plaintiffs for registration of the word mark “LORAM” and the Application No. 1192320 filed by the Plaintiffs for registration of the label mark “LORAM” have been opposed by four companies. They are opposing the registration of the word and label marks. Further Mr. Dwarkadas has relied upon the compilation and more particularly page Nos. 37 to 47 thereof to urge that in the opposition that is filed by the Plaintiffs to the application made by M/s Haryana Formulations Pvt. Ltd., they took a stand that the word mark “LORAM” is common to the trade and there are several entities and manufacturers using and adopting identical mark. Once the Plaintiffs have taken such stand in the opposition proceedings and they have suppressed it from this Court in the present case, then, all the more their conduct can be safely termed as dishonest and blameworthy. This itself disentitles them from claiming any discretionary and equitable reliefs. In any event, suppression of stand taken by the Plaintiffs in the opposition proceedings is deliberate. What they are urging in the present suit is directly contradictory to the stand taken by them before the Trade Marks Registry. Mr. Dwarkadas has invited my attention to paragraph No. 11 (page 5 of the plaint) and paragraph Nos. 2.3 (page 36 of the first affidavit in rejoinder). He has also highlighted the fact that on this ground alone, the injunction should be denied.”

29. In a similar situation, in the case of *S. K. Sachdeva v. Shri. Educare Limited (supra)*, the Division Bench of Delhi High Court found that discretion ought not to be exercised in favour of a person, who approaches the Court with unclean hands. That was in the backdrop of the plaintiff therein having suppressed its own stand taken before the Registrar of Trademarks during consideration of its application for registration of the trademark. The interim injunction granted by the learned Single Judge was set aside on this ground, indicating that the principle of prosecution history estoppel can certainly be invoked by the Court. The relevant portion of the Delhi High Court judgment reads as follows:—

“18. We are of the view that the interim injunction is liable to be vacated in view of various factors. First of all, the respondents themselves have taken a categorical stand that the word ‘SHRI RAM’ is the name of a popular figure and deity in Hinduism and



no one proprietor can claim exclusive rights on the mark 'SHRI RAM'. Secondly, their stand that the mark 'SHRI RAM' is common to trade and several 'SHRI RAM' formulative marks are peacefully co-existing on the register of trademark. Thirdly, the appellants have prima facie shown that there were several schools in existence using the name 'SHRI RAM' in existence even prior to the adoption of the mark by the respondents. Fourthly, the respondents are guilty of concealment and misrepresentation and, lastly, discretion should not be exercised in favour of a person who approaches the court with unclean hands."

30. *In the present case, it is an admitted position that the plaintiff did not place before this Court its own stand when the Registrar of Trademarks in the examination report had observed that there were earlier similar trademarks such as, 'Phone Pe Deal', 'Phone Pe Store', 'Phone Pe Crore', 'pe', 'pay' etc. The plaintiff had taken a stand that such cited marks were not similar to its mark 'PhonePe' for the reason that the mark 'PhonePe', taken as a whole, was distinct from such marks viz. 'Phone Pe Deal', 'Phone Pe Store', 'Phone Pe Crore' etc.*

31. *Having taken such a stand, it was a factor relevant to the controversy in the present case, for the reason that the trademark of the defendant is 'postpe'. This Court is of the opinion that by not placing its own stand taken before the Registrar of Trademarks in respect of cited marks like 'Phone Pe Deal', 'Phone Pe Store', 'Phone Pe Crore', etc., the plaintiff dis-entitled itself to grant of discretionary reliefs under Order XXXIX, Rules 1 and 2 of the CPC. The test in such cases is that if the defendant is likely to suffer prejudice due to such suppression on the part of the plaintiff, discretionary relief ought not to be granted. In the present case, this Court is of the opinion that prejudice was certainly caused to the defendant, but for the defendant itself making enquiries and bringing the material before this Court as regards the stand taken by the plaintiff in the proceedings before the Registrar of Trademarks. When the plaintiff had claimed before the Registrar of Trademarks that its mark 'PhonePe', taken as a whole, cannot be said to be the similar to marks like 'Phone Pe Deal', 'Phone Pe Store', 'Phone Pe Crore' etc., it was clearly relevant for the stand taken in the present case that the mark of the defendant 'postpe', taken as a whole, can be said to be deceptively similar to the registered trademark of the plaintiff 'PhonePe', taken as a whole.*

32. *Hence, this Court is of the opinion that the principle of prosecution history estoppel is correctly invoked by the defendant in the present case. The plaintiff cannot successfully claim discretionary reliefs in the backdrop of such conduct."*



47. Plaintiff has not filed replication to the written statement of Defendant No. 2 and therefore insofar as pleadings are concerned, at this stage, the pleas of the Defendants are uncontroverted and unrebutted. In the written submissions, however, Plaintiff has sought to defend its response to the First Examination Report by emphasising on the words “*essentially consisting of the word ‘KHILADI’*”. This Court is unable to fathom how the inclusion of these words can take the Plaintiff out of its clear stand that registration was sought in the device mark as a whole. Interestingly, in the reply to the First Examination Report, Plaintiff has stated that on comparing the applied mark with the cited marks, as a whole, there is absolutely no similarity whatsoever and being distinctive, there would be no confusion in the minds of the consumer between the Applicant’s mark and cited marks. Two things flow out of this response. If the Plaintiff was emphasising that there is no similarity referring to the device mark, then clearly it can claim no monopoly on the word ‘KHILADI’. However, if the Plaintiff was referring to the word ‘KHILADI’ then it is estopped from now contending that the Title ‘KHILADI’ given by the Defendants to their film is similar and would cause confusion.

48. This Court cannot subscribe to the argument that prosecution history is irrelevant while suing for infringement, since it is now more than well-settled that once a party obtains registration for its trademark, the stand taken in the proceedings leading upto the grant of registration will haunt the Plaintiff in all subsequent legal proceedings.

49. Plaintiff has also urged that the word ‘KHILADI’ is the dominant part of its registered device mark and thus the anti-dissection law would not apply to claim infringement. This argument needs to be tested in light of the provisions of the Act and judicial



precedents on the subject. Registration of a trademark, if valid, gives a registered proprietor of the trademark the exclusive right to use the trademark in relation to goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark, in the manner provided by the Act, by virtue of Section 28 of the said Act. Section 29 of the Act lays down the regime under which infringement can be claimed by a registered proprietor of a trademark. In order to prove and establish infringement, even at the *prima facie* stage, registered proprietor will have to show that the registered trademark is infringed by a person who not being a registered proprietor or a person using by way of permitted use, uses in the course of trade a mark which because of (a) identity with the registered trademark and similarity of goods/services covered by the trademark or (b) similarity to the registered trademark and identity/similarity of goods/services or identity with the registered trademark or (c) identity of the goods/services is likely to cause confusion in the public or have an association with the registered trademark.

50. Indisputably, most of the registered trademarks of the Plaintiff are 'device marks' and Plaintiff does not have registration in the word 'KHILADI'. TM No. 3491381 is the only word mark registration in favour of the Plaintiff for the mark 'Main Khiladi Tu Anari' and is not similar to the impugned mark when seen as a whole. TM Nos. 2424449 and 2424448 for 'Khiladi 2' are also device marks. In *Ashok Chandra Rakhit Ltd. (supra)*, it was held by the Supreme Court that where a distinctive label is registered as a whole such registration cannot possibly give any exclusive statutory right to the proprietor of the trademark to use of any particular word or name contained therein



apart from the mark as a whole. Paragraph 14 from the judgment is as follows:-

“14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. As said by Lord Esher in Pinto v. Badman [8 RPC 181 at p 191] :

“The truth is that the label does not consist of each particular part of it, but consists of the combination of them all”.

Observations to the same effect will be found also in In re Apollinaris Company's Trade Marks [LR (1891) 2 Ch 186] , In re Smokeless Powder Co., In re Clement and Cie [LR (1900) 1 Ch 114] and In re Albert Baker & Company and finally in the Tudor case referred to above which was decided by Sargant, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in a trade mark registered as a whole although the registration of the mark as a whole does not confer any statutory right with respect to that part.”

51. On this aspect, I may also refer to the judgment of this Court in ***Vardhman Buildtech Pvt. Ltd. & Ors. (supra)***, relevant passages from which are as follows:-

“8. On a plain reading of Section 15(1), it is evident that where a proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he is permitted to apply to register the whole and the part as separate trade marks. In the present case, the respondent is the proprietor of the label/mark which includes the words ‘VARDHMAN PLAZAS’. The respondent is claiming exclusivity in respect of the word ‘VARDHMAN’. It is clear that he had the option to make an application for registering the word ‘VARDHMAN’ as a separate trade mark. Assuming that he could have had the word mark registered, it is an admitted fact that the respondent made no such application. Section 17 of the said Act makes it clear when a trade mark consists of several matters, as it does in the present case, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. There is no dispute that the label/mark, taken as a whole, is



the exclusive property of the respondent. The learned counsel for the appellants has no quarrel with this at all. The issue arises when the respondent claims exclusive right to a part of the label/mark and particularly to the word 'VARDHMAN'. Section 17(2) is a non-obstante provision [vis-à-vis sub-section(1)], which stipulates that when a trade mark contains any part which is not the subject matter of a separate application by the proprietor for registration as a trade mark or which is not separately registered by the proprietor as a trade mark or contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered. In the present case, neither has the respondent separately registered 'VARDHMAN' as a trade mark nor has any such application been made. Furthermore, the word 'VARDHMAN' is itself of a non-distinctive character and is not only common to this trade but to several other businesses. Consequently, the registration of the label/mark which contains the words 'VARDHMAN PLAZAS' does not confer any exclusive right on the respondent insofar as a part of that mark, namely, 'VARDHMAN' is concerned.

9. *We now come to Section 28 of the said Act which deals with the rights conferred by registration. It is clear that by virtue of Section 28, the registration of a trade mark, if valid, gives to the registered proprietor of the trade mark the exclusive right to the use of the mark in relation to the goods or services in respect of which the trade mark is registered and, importantly, to obtain relief in respect of infringement of the trade mark in the manner provided by the Act. What is important to notice is that Section 28(1) begins with the words 'subject to the other provisions of this Act'. In other words, Section 28 would have to be read as subject to Section 17 of the said Act. Consequently, in our opinion the registration of the label/mark in favour of the respondent, which includes the words 'VARDHMAN PLAZAS', does not confer an exclusive right on the respondent insofar as part of the mark, which has reference to the word 'VARDHMAN', is concerned.*

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11. *The decision of the Supreme Court in Ramdev Food Products Pvt. Ltd. (supra) was in respect of the Trade Marks Act, 1958 and not in respect of the Trade Marks Act, 1999. This is the most important distinguishing feature apart from others which we need not refer to. Insofar as the decision of the Division Bench in United Biotech Pvt. Ltd. (supra) is concerned, in that case, the registered trademark was 'ORZID' and the infringing word was 'FORZID'. Clearly that was a case which would fall under Section 29 as amounting to infringement of the registered trade mark 'ORZID'. Although, in that case also the mark which was registered was not a word mark but a label/mark which contained only the word*



‘ORZID’. Here, the words contained in the label/mark are ‘VARDHMAN PLAZAS’ and not just ‘VARDHMAN’. Therefore, in our view, the decision in United Biotech Pvt. Ltd. (supra) does not aid the arguments advanced by the learned counsel for the respondent.”

52. Since the Plaintiff has registrations only in the device marks, it cannot claim exclusivity or monopoly over the word ‘KHILADI’ as that would amount to achieving something indirectly which the Plaintiff was unable to achieve directly. Even otherwise, in trademark law jurisprudence, protection to a trademark depends on whether the mark is generic, descriptive, suggestive, arbitrary or fanciful. Marks which are generic, descriptive or suggestive have a low level of protection while those which are arbitrary have a high degree of protection. If a person adopts the mark which is generic or descriptive, he runs the risk of the mark having low threshold of protection in which case the Plaintiff would be required to show that the mark adopted has acquired distinctiveness on account of extensive user, by leading secondary evidence and establishing that the mark is identifiable only with his goods and also that the Defendant has adopted an identical or deceptively similar mark. [*Ref. M/s. Three-N-Products Pvt. Ltd. v. M/s. Kairali Exports and Anr., 2018 SCC OnLine Del 6397*]. In the referred case, this Court held that Plaintiff has adopted the word ‘AYUR’ and thus runs the risk of lesser level of legal protectability. Therefore, by adopting the word ‘KHILADI’ as a part of the device mark assuming that it is open to the Plaintiff to claim its exclusive use, Plaintiff ran the risk of a third party using the same mark. It needs no gainsaying that the word ‘KHILADI’ is a generic word of non-distinctive character and means ‘Player’ in English language. It is not a coined term which would have enabled it



a high degree of protection, besides the fact that it is common to trade as far as the film industry itself is concerned and as pointed out by the Defendants there are over 40 films/TV shows by this name.

53. The position adopted by the Plaintiff that 'KHILADI' is the dominant part of its registered trademark and entitles the Plaintiff to claim infringement on the ground that it is similar to the Defendants' movie title, is *prima facie* misconceived. In *M/s. South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr., 2014 SCC OnLine Del 1953*, the Division Bench of this Court held that the rule of anti-dissection mandates that the Courts while dealing with cases of trademark infringement involving composite marks, must consider the marks in their entirety as an indivisible whole rather than truncating or dissecting them into the component parts and make comparison with the corresponding parts of the rival marks to determine the likelihood of confusion. The *raison d' tre* underscoring the said principle is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole and not by its component parts. The Division Bench also delineated the parameters of identifying the dominant part of the mark. It was also held that dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. The question therefore is whether the word 'KHILADI' is a dominant part of the device mark of the Plaintiff and *prima facie* the answer is in the negative.

54. Court has arrived at this *prima facie* conclusion for two-fold reasons. First and foremost, a bare perusal of the device mark shows that the word 'KHILADI' is not the dominant part of the mark as



substantial portion of the device mark comprises of several features/elements such as the picture of the star cast of the movie and the word 'KHILADI' with a little silhouette of a man is inscribed at the bottom over the names of the producer, director, musician and cinematographer. Secondly, the word 'KHILADI' does not qualify as a dominant portion of a device mark in view of the observations of the Division Bench in *M/s. South India Beverages Pvt. Ltd. (supra)*. In the said judgment, the Court has held that usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and accorded greater protection. In the said case, the mark of the Plaintiff 'HAGGEN-DAZS' was a unique combination of Danish-sounding words which have no recognized meaning whatsoever in any language or etymology and are arbitrary. In view of this judgment of the Division Bench which binds this Court, the inexorable conclusion *albeit prima facie* that can be drawn is that 'KHILADI' is not the dominant part of Plaintiff's device mark, being generic and non-distinctive.

55. This leads the Court to the next step of comparison between the rival marks as a whole to examine if a case of infringement is made out. In order to prove infringement, Plaintiff would have to establish similarity/identity of the rival trademarks which is one of the crucial and essential ingredients under Section 29(2) of the Act. Comparative table of the two rival marks is extracted in the earlier part of the judgment and in my *prima facie* view there is no deceptive similarity least of all identity. Before proceeding to deal further with this issue it



would be relevant to refer to the judgment of this Court in *Kanungo Media (P) Ltd. (supra)*. In the said case, Plaintiff had brought a suit for injunction against the Defendants for adopting the title ‘Nishabd’ for their movie since the Plaintiff had produced a film with a title ‘Nisshabd’. The claim was predicated on statutory rights of copyright and infringement as well as common law right of passing off. Relevant it is to note that the case related to an alleged appropriation of title and as in the present case, it was not a case where there were any allegations of usurpation of the work of the Plaintiff by the Defendants and admittedly the plot and storyline of the two films was completely different with not an iota of semblance of similarity between the two on this aspect. Court agreed with the Plaintiff that legal protection for literary titles lies in the field of trademark and unfair competition but significantly observed that in case of titles of single literary work, to claim protection it is necessary to prove that such a title has acquired secondary meaning. Underlying assumption behind the rule is that only if such title has acquired such a secondary meaning that it is capable of associating itself with the particular work or source, question of likelihood of confusion of source, affiliation, sponsorship or connection in the mind of potential buyers/users would arise. The Court also laid down the test of secondary meaning in respect of literary titles as explained by McCarthy on Trademarks and Unfair Competition, Third Edition (1995) Vol. I. Following paragraphs would be relevant in this context:-

“13. However, legal protection for literary titles lies in the field of trademark and unfair competition. In general, such titles are protected according to the fundamental tenets of trademark and unfair competition law. McCarthy has described this and even provided the test which has to be applied while determining the infringement in the realm of trademark as under:—



“In general, such titles are protected according to fundamental tenets of trademark and unfair competition law. That is, such titles cannot be used by a junior user in such a way as to create a likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers. For these purposes, titles of literary and entertainment creations and works are treated in much the same way as the trademarks of other commercial commodities.

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15. *That is not to say that titles of single literary work do not enjoy trademark protection, but in order to become entitled to this protection, it is necessary to prove that such a title has acquired secondary meaning. To quote McCarthy one again:*

“The law of literary titles is unique in one important respect. That is, the courts have given trademark protection to literary titles of one-shot, single works only upon a showing of secondary meaning, even though the title is not descriptive of the contents of the work. Regardless of the arbitrary or fanciful nature of the title as compared with the contents of the single book, play, movie, record, etc., secondary meaning is required. Thus, unlike ordinary marks, literary titles of single works which are inherently distinctive are not accorded immediate protection, absent proof of secondary meaning and consumer recognition.”

16. *Underlying assumption behind this rule is that only if such title has acquired the secondary meaning and is capable of associating itself with the particular work or source, the question of likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers/users would arise. This aspect shall be considered in some detail later in the discussion.*

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19. *The test of secondary meaning in respect of literary titles is explained in the following manner by McCarthy (supra):—*

“The test of secondary meaning for literary titles is essentially one of determining whether, in the minds of a significant number of people, the title in question is associated with a single source of the literary work. That is, are people likely to assume that defendant's work is connected in some way with the producers of plaintiff's literary effort? The association need be only with a single, anonymous source. That is, the consumer need not know the trade name of the source, but is entitled to assume that all works or goods under that title are controlled by some single source.”



56. The judgment is particularly important for the present case since the Court also laid down what could be the relevant evidence from which secondary meaning for a literary title may be inferred as a question of fact. Insofar as the test of likelihood of confusion of literary titles is concerned, the Court observed that it was the same as applied to trademarks in general. The ratio of the judgment is that the total visual impression of the whole item reaching consumers is to be seen to ascertain the likelihood of confusion and little assistance can be taken from a meticulous comparison of the words, letter-by-letter and syllable-by-syllable. Relevant paragraphs are as under:-

“23. Even if the work has not been released, a sufficient amount of pre-release publicity of the title may cause a title to acquire recognition sufficient for protection. Relevant evidence form which secondary meaning for a literary title may be inferred as a question of fact include : (1) the length and continuity of use; (2) the extent of advertising and promotion and the amount of money spent; (3) the sales figures on purchases or admissions and the number of people who bought or viewed plaintiff's work; and (4) the closeness of the geographical and product markets of plaintiff and defendant.

24. In so far as test of likelihood of confusion of literary titles is concerned, it is the same as applied to trade marks in general. In considering the likelihood of confusion similar literary titles, the court often takes into consideration the total visual impression of the whole item reaching consumers. It is held by courts that little assistance can be taken from a meticulous comparison to words letter by letter, syllable by syllable pronounced with clarity to be expected from a teacher of elocution. The two marks are to be compared in totality and stress is to be laid on common features rather than on distinctive features.”

57. In this context, it will be useful to refer to the judgment of the Division Bench in ***Vasundhara Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani and Another, 2022 SCC OnLine Del 3370***, where the Court while examining the composite marks held as follows:-

“32. It is well settled that a composite trademark or label trademark is not required to be dissected to determine whether there is any deceptive similarity with another trademark. The question



whether there is any deceptive similarity between two trademarks has to be ascertained by examining the marks in question as a whole. In South India Beverages India Private Limited v. General Mills Marketing Inc, 2014 SCC OnLine Del 1953, the Division Bench of this Court had explained the ‘anti-dissection rule’ in some detail. The Court reiterated that “conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their components parts for comparison”. However, the Court had also observed that “while a mark is to be considered in entirety, yet it is impermissible to accord more or less importance or ‘dominance’ to a particular portion or element of a mark in cases of composite marks”.

33. *Having stated the above, it is also necessary to bear in mind that examining the dominant part of the trademark for comparing it with the conflicting mark is solely for the purpose of determining whether competing marks are deceptively similar when viewed as a whole. It is, thus, not permissible to hold that two competing marks are deceptively similar by examining a portion of one mark and comparing it with the portion of another mark, if the composite marks viewed as a whole are dissimilar. It is relevant to refer to the text from McCarthy on Trademarks and Unfair Competition, which explains the said principle as under:—*

“23.15 Comparing Marks : Differences v. Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole : Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the “anti dissection” rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, conflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” The anti-dissection rule is based upon a common sense observation of



customer behavior : the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important than minor points of difference. A court should not engage in "technical gymnastics" in an attempt to find some minor differences between conflicting marks.

However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption: "An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains."

[Underlined for Emphasis]

34. In the facts of the present case, the learned Single Judge had found that the appellant held registration of the device marks/composite marks that contain the word 'Vasundhra' but it did not have any registration of the word mark 'VASUNDHRA'. It is material to note that the appellant had applied for registration of the word mark but the same has not been granted to it as yet. The Court had, thus, found that the appellant did not have an exclusive right to use the word 'Vasundhra' except as part of its device trademarks."

58. With the observations of the Court in this judgment in the backdrop, it is clear that the Court is not required to examine the rival composite device marks by a meticulous comparison of each feature



and the mark as a whole has to be seen to ascertain any similarity which could lead to likelihood of confusion in the mind of public. Plaintiff does not have registration in the word KHILADI and has no exclusive right to use it except as part of device mark and when the latter is compared with the impugned mark, there is *prima facie* no similarity. Plaintiff's mark contains prominently displayed pictures of the star cast i.e. Sh. Akshay Kumar, Ms. Ayesha Julka, Sh. Deepak Tijori and Ms. Sabeeha. On the other hand, mark of the Defendants is primarily the picture of Sh. Ravi Teja with the word KHILADI appearing at the bottom and applying the first impression test one cannot be confused with the other. The *sine qua non* of an action for infringement i.e. deceptive similarity and confusion is *prima facie* missing in the present case and *sans* evidence of confusion or deceptive similarity in the device marks, at this stage a finding of infringement cannot be rendered in favour of the Plaintiff, in the absence of registration in the word 'KHILADI'.

59. Additionally, it is not the case of the Plaintiff that the storyline or the plot of the movie of the Defendants is similar to the Plaintiff's film 'KHILADI'. The lead cast in the two movies is different and while the Plaintiff's movie was in Hindi language, the movie of the Defendants is in Telugu as well as a Hindi-dubbed version of Telugu. It cannot be lost sight of the fact that the viewership of a Telugu film will be substantially different and perhaps lesser as compared to a Hindi movie. The two lead actors in the respective movies are well-known and celebrated actors and no confusion can possibly arise between the two, particularly looking at the fact that the posters of the movies are different on a holistic ocular comparison and the movie of the Defendants is only on OTT/Satellite platforms where a viewer is in



a position to make a choice to watch the movie by first looking at the posters and the other details of the director, production house etc. These details are clearly found mentioned on the mark/poster of the Defendants' film. No doubt that the movie 'KHILADI' was a huge success and also gave a pedestal to the lead actor and earned him the sobriquet of 'Khiladi Kumar', as rightly stated by the Plaintiff, but it is settled that whether or not a trademark has acquired a secondary meaning is a matter of trial and secondly, this factor cannot give monopoly to the Plaintiff over the word 'KHILADI' for the purpose of claiming infringement, in the absence of registration in the word 'KHILADI', which the Plaintiff was entitled to apply for, but consciously chose not to do so, perhaps in view of the non-distinctive nature of the said word.

60. It was also asserted by the Defendants and not denied by the Plaintiff that as many as 40 films/shows have been produced in various languages with the name 'KHILADI' out of which only two were produced by the Plaintiff. The argument of the Plaintiff that most of the films were released with a title with prefix/suffix to the word 'KHILADI' cannot inure to its advantage considering that Plaintiff does not have any registration in the word 'KHILADI' and as held above can claim no monopoly or proprietary right on it. Making and release of as many as 40 movies/shows also supports the case of the Defendants that the word 'KHILADI' is common to trade and it makes no difference if the titles were with/without suffix/prefix as this goes to show how frequent the word has been used in the film industry. Defendants have also stated that in 2013 a film was released under the Title 'KHILADI' in Bengali language, which is unrebutted. Plaintiff's film 'KHILADI' was released in 1992 more than 30 years



ago and from then till now if 40 film/shows under the name 'KHILADI' with or without prefix/suffix have been released, at this stage, Plaintiff cannot assert likelihood of confusion.

61. Next is the claim of passing off, which is a tortious liability and rights flow from the common law unlike infringement which has its genesis in a Statute. The foundation and ethos of an action of passing off lies in misrepresentation and deceit. The three ingredients of an action of passing off are: (a) goodwill and reputation; (b) misrepresentation; and (c) loss and injury to the goodwill and reputation arising out of likelihood of confusion amongst members of the public with imperfect recollection and average intelligence. Therefore, to succeed in an action for passing off, Plaintiff will have to show that each of the three ingredients exist.

62. Plaintiff contends that he has an insurmountable reputation in the registered trademark 'KHILADI' and Defendants have adopted an identical mark with a dishonest intention to ride on the Plaintiff's reputation. It is asserted that Plaintiff's 'KHILADI' trademark is distinctive and has acquired secondary meaning for myriad reasons such as extensive use of the mark, promotion and advertising, humongous success of the films and substantial revenue generated. It is claimed that the film is an iconic movie like Sholay, Zanjeer, Deewar and the only reason why Defendants have chosen to use 'KHILADI' as a title of their movie is to misrepresent and confuse people into believing that the impugned movie is from Plaintiff's production. This is leading to dilution of the mark and damage and injury to the reputation of the Plaintiff. Defendants, on the other hand, have countered the submissions by urging that Plaintiff's first film was released in 1992 and the second one in 1994 and since then no



film has been produced by the Plaintiff with the word ‘KHILADI’ while several others have been produced and released worldwide. On OTT Platforms there can be no confusion even otherwise as anyone who wants to watch a film will first view the poster of the film and then make a choice.

63. A similar issue arose before the Bombay High Court in *K.M. Multani v. Paramount Talkies of India, Ltd., and Others, 1942 SCC OnLine Bom 86*, where a suit was filed alleging passing off in respect of a film produced by the Plaintiff titled ‘Virginia’. Defendant No. 1 imported an American film into India called ‘Virginia’ and restraint was sought by the Plaintiff with damages as an alternative claim. Plaintiff alleged that law of passing off is a species of unfair competition by which one person attempts to obtain by deceptive devices the benefit of reputation which another has established for himself in any particular trade or business. The action is intended to enforce the well-known equity, namely, to prevent a Defendant from doing that which is calculated to mislead the public and to lead them to think that which belongs to the Defendant is a thing which belongs to the Plaintiff. There must, however, be a strong probability of confusion in the usual course of trade to prove passing off. Defendants contested the claim by arguing that there is no resemblance whatsoever between the two rival films except for the name. The storyline, plot, the incidences depicted etc. were different. Learned Single Bench of the Bombay High Court dismissed the suit and the appeal was also dismissed by the Division Bench. I may pen down that being very old judgements, both judgements are reported in continuity in the Reporter. Para 15 onwards are the views of the Division Bench as follows:-



“9. The question therefore which arises in this case is whether the name Virginia has become associated to such a considerable extent with the plaintiff that the Court would allow him a monopoly of the name by declaring that no one else can use it as the title of his film. The word ‘Virginia, as I have said before, is a geographical name, and the tendency of the Courts at present is to restrict the monopoly of the use of geographical names as business or trade names. Apart from that the plaintiff must, in order to succeed, prove that by reason of the defendants’ Action his business has suffered, or that there is a tangible risk or probability of its suffering damage. The probability must be a strong one. In (1899) A.C. 83 [(1899) 1899 A.C. 83 : 68 L.J. Ch. 74 : 79 L.T. 645 : 15 T.L.R. 110, North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co..] the Manchester Brewery Co. Ltd., was carrying on business under that name for years. The appellants bought an old business called “The North Cheshire Brewery Co. Ltd.,” and then (without intending to deceive) got themselves incorporated and registered under the name “The North Cheshire and Manchester Brewery Co. Ltd.” It was held upon the evidence that as a matter of fact the name of the appellant company was calculated to deceive, and that therefore the appellants must be restrained by injunction in the usual way. In all these cases the question really, is not one of law but a question of fact to be decided upon the evidence in the case, if any. In deciding such question the Court has to consider not merely the similarity of name, but the similarity in the make-up, the similarity in the subject-matter and other surrounding circumstances. In (1940) A.C. 112 [(‘40) 27 A.I.R. 1940 P.C. 55 : 187 I.C. 449 : 1940 A.C. 112 : 109 L.J.P.C. 11 : 161 L.T. 396 : 83 S.J. 796 : 56 T.L.R. 9 : (1939) 4 All. E.R. 192, Francis Day and Hunter, Ltd. v. Twentieth Century Fox Corporation, Ltd.] it was held that the respondents had not passed off the exhibition of their motion picture entitled “The Man Who Broke the Bank at Monte Carlo” as a performance of the appellants’ song of the same name. The song and the motion picture were completely different and were incapable of comparison in a reasonable sense. But Lord Wright stated that (p. 125):

“Their Lordships do not wish to be taken to say that in no circumstances can there be a ‘passing off’ by the use of the same title for a literary, artistic or musical work, though it is difficult to imagine such a case where there are no the circumstances, other than the mere title calculated to mislead.”

10. In this particular case the surrounding circumstances, the difference in the get up, in the language, in the plot and cast, do not lead to the necessary result that there would be a strong probability of confusion of the two pictures in the mind of the public, and therefore a strong probability of deception, There is no doubt a similarity or rather sameness in the title. The fact that both films are motion pictures is not an additional circumstance calculated to lead



to any confusion. The fact that both are films and the fact that both are called Virginia do not in my opinion make up a prima facie case for the plaintiff. It has not been proved but merely conjectured that the identity of the names might lead to confusion between the two films. As I have said before, the one is an Indian and the other a foreign film. The subject-matter of the two films and the get-up are different. The difference in the get-up does form an element in considering the question of the probability of the deception. Plaintiff has not led any evidence of actual deception as the alleged infringement was recent, nor has he led any evidence of members of the public that they themselves would be deceived. Such evidence, though not strictly necessary, is often useful as a guide to the Court in determining the question of the probability of the deception. The want of such evidence cannot be got over by calling an expert witness and asking him generally what effect the sameness in the names of the two films would have on the public. It was pointed out in 67 I.A. 212 [(40) 27 A.I.R. 1940 P.C. 86 : 187 I.C. 658 : I.L.R. (1940) Kar. P.C. 171 : 67 I.A. 212 : I.L.R. (1940) All. 446 (P.C.), Thomas Bear & Sons (India) v. Prayag Narain.] , that the vital element in a passing off action was the probability of deception which might depend on a number of matters as well as the question of similarity or the marks or of the get-up. Viscount Maugham observed at p. 217 that there was no such person as “an expert in human nature,” and it was now well settled that a witness could not be called to say that it was likely that purchasers of the goods would be deceived. It is equally futile in my opinion to call an expert and to ask him what percentage of the cinema-going public go merely by the title of the film, unless there is a basis for any calculation made by him, and there can be none in the case of a calculation which is based partly on experience and partly on guess-work. The Court, moreover, can draw its own inference, for the matter does not depend entirely upon any evidence of confusion by sameness or similarity in the names resulting in an injury.

11. *Plaintiff was at some pains to describe that section of the public who in his opinion were most likely to be misled by the sameness of the name of the two films. He said it was the section of the public consisting of those who patronize both English and Indian films; they were the persons who were most likely to be misled. He said that they were the majority of the cinema-goers, but on what basis he says so is not dear. He further stated that a large portion of that majority went only by title and never cared to read the advertisements or posters to find out whether it was a foreign or an Indian picture. Now the section of the public who patronize both foreign and Indian films would generally consist of educated or fairly educated persons, and it is not clear on what grounds it could be said that they would go only by reading the name of the film or on the recommendation of others without the slightest inquiry as to what the film was about or whether it was Indian or foreign. In the*



same case in (1940) A.C. 112 [(‘40) 27 A.I.R. 1940 P.C. 55 : 187 I.C. 449 : 1940 A.C. 112 : 109 L.J.P.C. 11 : 161 L.T. 396 : 83 S.J. 796 : 56 T.L.R. 9 : (1939) 4 All. E.R. 192, Francis Day and Hunter, Ltd. v. Twentieth Century Fox Corporation, Ltd.] , it was stated at p. 126 that the member of the public, who is supposed to be likely to be deceived, must, to start with, be assumed to know what he was wanting to see or hear. If he was presumed to be wanting to know whether what he was about to hear or see was a song or a film, I see no reason why he should not also be presumed to know, which he can know without much effort, whether the film which he was about to see was a foreign or an Indian production. It is not sufficient to say that any thoughtless person might unwarrantably jump to the conclusion that the two films were the same. Anyone who took some trouble would certainly find out the difference between the two. Counsel referred to the recent judgment in 42 Bom. L.R. 924 [(‘41) 28 A.I.R. 1941 Bom. 3 : 193 I.C. 392 : 42 Bom. L.R. 924, J.C. Eno. Ltd. v. Vishnu Chemical Co.], but that case really does not apply. In that case the plaintiffs had acquired a right to the exclusive use of the words “Fruit Salt,” and it was held that the defendants had no right to use the words in any other language in connexion with similar goods.

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15. *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 (1896) A.C. 199 [(1896) 1896 A.C. 199 : 65 L.J.Q.B. 381 : 74 L.T. 289 : 44 W.R. 638, Reddaway v. Banham.] the foundation of a pas-sing-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 or 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.

16. *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 (1940) A.C. 112 [('40) 27 A.I.R. 1940 P.C. 55 : 187 I.C. 449 : 1940 A.C. 112 : 109 L.J.P.C. 11 : 161 L.T. 396 : 83 S.J. 796 : 56 T.L.R. 9 : (1939) 4 All. E.R. 192, Francis Day and Hunter, Ltd. v. Twentieth Century Fox Corporation, Ltd.] 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 of 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 in (1888) 38 Ch. D. 139 [(1888) 38 Ch. D. 189 : 58 L.J. Ch. 36 : 59 L.T. 187 : 36 W.R. 433, Licensed Victuallers' Newspaper Co. v. Bingham.] 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 is that time to found a passing-off action.*

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18. *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."

64. In this context, I may usefully allude to a judgment of this Court in **Warner Bros. Entertainment Inc. & Anr. (supra)**, where the Court has carved out a thin but an important distinction between consumer goods or product and a movie and held as follows:-

"33. Apart from the above, after careful consideration, I am of the view that even assuming there is any structural or phonetic similarity in the words "Harry Potter" and "Hari Puttar", what has to be borne in mind is that the Harry Potter films are targeted to meet the entertainment needs of an elite and exclusive audience — the cognoscenti — an audience able to discern the difference between a film based on a Harry Potter book on the one hand and a film which is a Punjabi comedy on the other, the chief protagonist of which is Hariprasad Dhoonda. It is not the case of a consumer good or product, which stands on an entirely different footing. Necessarily, the yardstick must also differ, bearing in mind the fact that a consumer product such as a soap or even a pharmaceutical product may be purchased by an unwary purchaser or even an illiterate one, but the possibility of an unlettered audience viewing a HARRY POTTER movie are remote, to say the least. To put it differently, an illiterate or semi-literate movie viewer, in case he ventures to see a film by the name of Hari Puttar, would never be able to relate the same with a Harry Potter film or book. Conversely, an educated person who has pored over or even browsed through a book on Harry Potter or viewed a Harry Potter film, is not likely to be misled. Such a person must be taken to be astute enough to know the difference between a Harry Potter film and a film entitled Hari Puttar, for, in my view, the cognoscenti, the intellectuals and even the pseudo-intellectuals presumably know the difference between chalk and cheese or at any rate must be presumed to know the same.

34. Viewed from any angle, the plaintiffs have failed to establish a prima facie case for the grant of an ad interim injunction in their favour. The balance of convenience also tilts heavily in favour of the defendants, who have invested huge sums of money, apart from entering into copious agreements and business tie ups with various third parties, including Britania, McDonalds, etc. In a manner of speaking, the plaintiffs have sat on the garden fence and allowed the defendants to traverse the whole of the garden path, before attempting to throw a spanner in the release of the film at the eleventh hour. If the plaintiffs were so keen and so wary of protecting their rights, it was incumbent upon them to vigilantly guard the same. This, the plaintiffs have failed to do and, as a matter



of fact, the conclusion to the contrary clearly emerges from a reading of the documentary evidence on record. The plaintiffs have equally failed to establish that any irreparable loss or injury will result to them on the release of the film.”

65. Applying the observations and principles laid down in the aforesaid judgments, in my *prima facie* view, Plaintiff has been unable to make out a case for passing off. The plot of the two movies, the lead cast, difference in the language leading to a different class of viewers etc. are distinguishing factors and it is difficult to accept that merely on account of commonality of the word ‘KHILADI’, the moviegoers are likely to be deceived or confused. Confusion and deception caused by misrepresentation are vital elements in a passing off action. As rightly canvassed by the Defendants, Plaintiff has not made a movie with the title ‘KHILADI’ post 1994 and nor it is the case of the Plaintiff that it intends to do so in the near future. This Court also agrees with the Defendants that the movie is out of theatres and is only on the OTT/Satellite platforms and any viewer would first carefully look through the entire poster of the film, including actors, film Title, storyline, director etc. before making a choice to watch the film and in this context, the pictures of the actors would be enough to enable the viewer to make a choice and understand that Defendants’ film has no relation to the Plaintiff’s ‘KHILADI’. It was observed by this Court in *Biswaroop Roy Choudhary (supra)* that when words or phrases are used which are in the common parlance, the risk is inevitable and normally, proprietary or exclusive use of a common word should not be given *jural imprimatur*.

66. Arguments were canvassed on behalf of the parties on whether titles of movies can be changed post release and if so, the procedure. Much was also argued on CBFC certifications. While the Plaintiff



argued that even post release of a film, the title can be changed, Defendants argued to the contrary and added that even assuming they can be changed, it entails change of campaigns, designs etc. involving huge expenditure. However, this Court need not detain itself on this controversy for the reason that Court is not directing the Defendants to change the title or the get up of the poster in view of the *prima facie* finding that Plaintiff has not established infringement/passing off against the Defendants. The argument that Defendants ought to have conducted a search before adopting the mark/title for the impugned movie has no legs to stand in the present case as Plaintiff does not have registration in the word KHILADI. In respect of the title registration certificate from Telangana State Film Chamber of Commerce, Defendant has explained that there is no legal requirement to approach any particular association or body for the title certificate and he approached this authority because the film is originally in Telugu language and because Defendant No.2, the producer operates from Telangana. There is no material on record to rebut this stand and in any case, this is irrelevant to the issue of alleged infringement/passing off at least at this stage.

67. The judgments relied upon by the Plaintiff no doubt lay down various propositions of law, which are beyond any debate, however, the same do not aid the Plaintiff. *Renaissance Hotel Holdings Inc. (supra)*, deals with infringement of the registered word mark 'Renaissance', which the Supreme Court found was infringed by the Defendants' mark 'Sai Renaissance' on ground of visual, phonetic and structural similarity as also because use of the impugned mark by the Defendant as a trade name was hit by Section 29(5) of the Act. However, in the present case, Plaintiff does not have registration in the



word 'KHILADI' and comparison of the registered device mark with the Defendants' mark shows no similarity. In *Ahmed Omerbhoy & Anr. v. Gautam Tank & Ors., 2007 SCC OnLine Del 1685*, relied upon by the Plaintiff, there was registration in the word 'Postman' as well as the device mark 'Postman' and in that context, this Court held that since the impugned mark 'Super Postman' was similar, goods were the same and the area in trade is also common, triple identity rule was satisfied, infringement and passing off were made out. Judgment in *M/s. Hindustan Pencils Private Limited v. M/s. India Stationery Products Co. & Another, 1989 SCC OnLine Del 34*, was also relied on by the Plaintiff to contend that delay cannot come in the way of grant of interim injunction if the Plaintiff is able to make out a case of infringement. There can be no quarrel with the proposition. However, as aforementioned, in cases relating to movies, Courts have ordinarily denied injunction where the Plaintiff approaches the Court close to the scheduled date of the release of the movie. For the same reason, the judgment in *Midas Hygiene Industries (P) Ltd. and Another (supra)* will not inure to the advantage of the Plaintiff. The judgment in *Anil Kapoor Film Co. Pvt. Ltd. (supra)* in fact favours the Defendants where it is observed that a moviegoer is not gullible to not know what he/she wants to see, hear or read and that the title of the movie, without any content similarity cannot warrant interim injunction. The judgment in *Kanungo Media (P) Ltd. (supra)* also does not help the Plaintiff as the Plaintiff has not been able to establish that 'KHILADI' has acquired secondary meaning and/or association to its movie.

68. Reliance on *Mr. Shivaji Rao Gaikwad (supra)* is also misplaced as the case does not deal with infringement of a registered trademark but is predicated on using the celebrity personality of



Mr. Rajnikant using his caricature. Plaintiff relied on the judgment passed by the Supreme Court in the case of *Shri Babuji Rawji Shah (supra)*, for the proposition that an injunction can be granted even after CBFC Certificate has been issued to a movie for its Title. However, the said judgment does not inure to the benefit of the Plaintiff as in the said case, Petitioner approached the Court before release of the movie ‘Gangubai Kathiawadi’ alleging defamation and the question in the case was about morality/defamation vis-a-vis CBFC certification and even then the Court refused to grant injunction on three factors i.e. (i) phenomenal expenses incurred in producing the film; (ii) film was scheduled to release on the next day; and (iii) balance of convenience was in favour of the Respondent therein. Argument on CBFC certification even otherwise is irrelevant at this stage for the reasons stated above.

69. The judgments in *Shambhu Nath & Brothers & Ors. (supra)* and *Ramdev Food Products (P) Ltd. (supra)* also do not help the Plaintiff, as in both the cases the Courts had come to a conclusion that the words ‘Toofan’ and ‘Ramdev’ respectively were essential/dominant part of the Plaintiffs’ registered marks.

70. For the aforesaid reasons, this Court is of the view that the Plaintiff has failed to make out a *prima facie* case in its favour and balance of convenience also does not lie in favour of the Plaintiff. Rather, the balance of convenience tilts in favour of the Defendants and it is the Defendants who will suffer irreparable loss and injury if the injunction is granted.

71. The application is accordingly dismissed.

72. Needless to state that the observations and opinion of the Court expressed in the present judgment are only tentative and *prima facie*



and will have no bearing on the final adjudication of the suit on merits.

CS(COMM) 100/2022 & CCP(O) 18/2022, I.A. 4359/2022

73. List before the Roster Bench on 12.09.2023, subject to orders of Hon'ble Judge In-charge (Original Side).

JYOTI SINGH, J

AUGUST 17, 2023/Shivam