

MANU/DE/1333/2008

Equivalent Citation: 155(2008)DLT56, (2009)ILR 1Delhi722, MIPR2009(1)274, 2008(38)PTC185(Del)**IN THE HIGH COURT OF DELHI**

IA No. 9600/2008 in CS(OS) 1607/2008

Decided On: 22.09.2008

Appellants: **Warner Bros. Entertainment Inc. and Anr.**
Vs.Respondent: **Harinder Kohli and Ors.****Hon'ble Judges/Coram:**

Reva Khetrapal, J.

Counsel:

For Appellant/Petitioner/plaintiff: Sudhir Chandra Agarwal, Sr. Adv., Binny Kalra, Shwetasree Majumdar and Diva Arora, Advs

For Respondents/Defendant: Arun Jaitley and Rajiv Nayar, Sr. Advs., Prathiba M. Singh, Deepak and Gaurav Miglani, Advs.

Subject: Media and Communication**Subject: Intellectual Property Rights****Acts/Rules/Orders:**

Code of Civil Procedure (CPC) - Section 151, Code of Civil Procedure (CPC) - Order 39 Rule 1, Code of Civil Procedure (CPC) - Order 39 Rule 2; Title Registration Bureau Rules

Cases Referred:

Amritdhara Pharmacy v. Satya Deo Gupta (1963) 2 SCR 484; Hitachi Ltd. v. Ajay Kumar Agarwal 1996 PTC (16); Mobil Oil Corporation v. Pegasus Petroleum Corp. 2 U.S.P.Q. 2d 1677; Dorr-Oliver, Inc. v. Fluid-Quip, Inc. 39 U.S.P.Q. 2D 1990 (7th Cir. 1996); Brookfield v. West Coast (9th Cir. Court of Appeals 9856918); Udai Chand v. Shankar Lal and Ors. AIR 1978 SC 765; Satish Khosla v. Eli Lilly Ranbaxy Limited 1998 IAD (Delhi) 927; Anand Swarup v. Municipal Corporation of Delhi 36 (1998) DLT 304; Micolube India Ltd. v. Maggon Auto Centre and Anr. 150 (2008) DLT 458; Biswaroop Roy Choudhary v. Karan Johar 131 (2006) DLT 458

Disposition:

Application dismissed

Citing Reference:

Discussed		3
Mentioned		7

Case Note:

Intellectual Property Rights - Trade mark - Infringement of - Deceptive Similarity - plaintiff filed a suit for permanent injunction against the Defendant for alleged infringement of their trade mark "HARRY POTTER" - plaintiff further alleged that Defendants trade mark/title "HARI PUTTAR" is visually and phonetically similar to plaintiffs and the Defendants were riding on the popularity of the plaintiffs' thereby diluting the goodwill of the plaintiffs' - Whether the trade mark "HARI PUTTAR" visually and phonetically similar to the trade mark "HARRY POTTER" - Held, no deceptive similarity is made out even after assuming there is any structural or phonetic similarity in the words "Harry Potter" and "Hari Puttar" - Harry Potter films are targeted to meet the entertainment needs of an elite and exclusive audience who is 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 - Further, an illiterate or semi-literate or an educated movie viewer can differentiate both the movies - No infringement has been made out - Application dismissed

Intellectual Property Rights - Trade mark - Infringement of - Delay and Acquiescence - Held, false assertions of the plaintiffs and the suppression of material facts, were intended to cover up delay in approaching the Court - If the plaintiffs stood by knowingly and let the Defendants build up their

business or venture, then the plaintiffs would be estopped by their acquiescence from claiming equitable relief - Acquiescence on the part of the plaintiffs would amount to waiver, if not abandonment of their right - If Defendants had dishonestly adopted a title or mark akin to that of plaintiffs, it was imperative upon the plaintiffs to have nipped the evil in the bud by forwarding to the Defendants a legal notice of CEASE AND DESIST or "carry on at your own peril and risk" - Instead, plaintiff sat by, a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name, etc. - Hence, the action must fail on the grounds of delay and acquiescence - Application dismissed

Intellectual Property Rights - Trade mark - Infringement of - Grant of injunction - Order XXXIX and Section 151 of the Civil Procedure Code, 1908 (CPC) - plaintiff filed application under Order XXXIX, Rule 1 and 2 read with Section 151 of the Code for interim injunction restraining Defendants from releasing film "HARI PUTTAR" - Whether interim injunction can be granted in facts and circumstances - Held, plaintiffs failed to establish prima facie case for grant of ad interim injunction in their favour - Balance of convenience tilts heavily in favour of defendants investing huge sums of money and entered into agreements with various popular third parties - plaintiffs failed to establish irreparable loss or injury caused to them on release of film - plaintiffs by their course of conduct held disentitled to injunction prayed for - Application dismissed

Ratio Decidendi:

"Even if there is any structural or phonetic similarity between the competing marks the real test to determine deceptive similarity is, whether the targeted audience is able to discern the difference between the marks." "If the plaintiffs stood by knowingly and let the Defendants build up their business or venture, then the plaintiffs would be estopped by their acquiescence from claiming equitable relief."

"Interim injunction cannot be granted if plaintiff have failed to establish a prima facie case and establish any irreparable loss or injury or if the balance of convenience lies in favour of the Defendant. "

JUDGMENT

Reva Khetrapal, J.

1. This order shall dispose of the plaintiffs' application under Order XXXIX Rules 1 and 2 read with Section 151 of the Code of Civil Procedure seeking an interim injunction, inter alia, restraining the defendants from releasing the defendants' film under the trademark/title "HARI PUTTAR". The application has been filed in a suit for permanent injunction restraining infringement of trademarks, passing off, dilution, damages and rendition of accounts of profits earned by the defendants by use of the impugned trademark/title; and for an order of transfer of the domain name www.hariputtartheilm.com to the plaintiffs.

2. The plaintiffs assert in the plaint that the plaintiff No. 1 applied for and secured trademark registration in India for the word mark "HARRY POTTER" under Nos. 1111702 in Class 9, 1111703 in Class 16, 917454 in Class 25, 917453 in Class 28 and 1246560 in Class 41, and that the defendants are guilty of infringing the aforesaid registered trademarks of the plaintiffs by the act of naming their film "HARI PUTTAR", which is visually and phonetically similar to the plaintiffs' trademark "HARRY POTTER".

3. The plaintiffs further assert that "HARRY POTTER", it is well known, is the protagonist of a series of seven novels written by British author Ms. J.K. Rowling, which chronicle the adventures of the adolescent wizard Harry Potter together with his best friends Ronald (Ron) Weasley and Hermione Granger, who are his classmates from the Hogwarts School of Witchcraft and Wizardry. The narrative begins with infant Harry's heroic survival against the evil magic of the dark wizard Lord Voldemort who killed Harry's parents but failed to send Harry to the same fate, for which the latter earned the sobriquet of "The Boy Who Lived". Owing to his tragic circumstances, Harry was forced to live with his "muggle" (Non-magical or rather human) Aunt Petunia, Uncle Vernon and cousin Dudley. The seven books, viz., Harry Potter and Sorcerer's Stone, Harry Potter and the Chamber of Secrets, Harry Potter and the Goblet of Fire, Harry Potter and the Order of Phoenix, Harry Potter and the Prisoner of Azkaban, Harry Potter and the Half-Blood Prince and Harry Potter and the Deathly Hallows, grippingly tell the story of Harry's many adventures, his trysts with good and evil, the destruction of his enemies and about his struggle for survival.

4. plaintiffs further assert that a series of five films based on the aforesaid novels have already been released, while the sixth is on the anvil and scheduled to be released on 21st November, 2008. The Harry Potter series of films have received wide acclaim and the overwhelming popularity of the books as well as the films has made the HARRY POTTER trademark instantly identifiable and recognizable as being associated with the plaintiffs.

5. The defendant No. 1 Mr. Harinder Kohli, is a citizen of the United Kingdom, and the proprietor of Dream Town Productions Ltd., i.e., the defendant No. 2, who claims that he has produced several films and animation projects and has distributed worldwide, animated classics such as Peter Pan, Alice in Wonderland,

manupatra Hunchback of Notre Dam, Jungle Book, etc. in various European languages such as German, Dutch, Spanish, French, etc. The defendant No. 3 - Munish Puri, is the Chief Operating Officer of the defendant No. 4 Company - Mirchi Movies Limited, and is one of the co-producers of the film "Hari Puttar - A Comedy of Terrors" with the defendants No. 1 and 2. The defendant No. 4 - Mirchi Movies Limited, is a part of the Times Group and is a wholly owned subsidiary of Times Infotainment Media Limited, which is also in the business of producing films including the landmark "Being Cyrus".

6. In April, 2007, the defendant No. 4 entered into a Film Acquisition Agreement with the defendant No. 2 and, as per this agreement, the defendant No. 4 now owns the entire rights in the said film with a profit sharing arrangement between the defendants No. 2 and 4. At the time of the execution of the said agreement, the film was tentatively titled as "HARI PUTTAR", which title was conceived by the defendants No. 1 and 2. However, subsequently, the defendants No. 3 and 4 modified the said title as "Hari Puttar - A Comedy of Terrors". The defendants' film title is registered in India with the "Indian Motion Picture Producers' Association (IMPPA)" and "The Film and Television Producers Guild of India Limited", and the defendants have also applied for registration with international bodies like the Title Registration Bureau, Motion Picture Association of America, Inc.

7. The plaintiffs, who claim that the movie "HARI PUTTAR" is an infringing variant of the plaintiffs' trademark "HARRY POTTER", seek stay of the release of the movie principally on the ground that the phonetic and structural similarity between the titles "HARRY POTTER" and "HARI PUTTAR" tantamount to the defendants riding on the popularity of the plaintiffs, thereby infringing the plaintiffs' registered trademark and diluting the goodwill of the plaintiffs. Relying upon the decisions of the Hon'ble Supreme Court in *Amritdhara Pharmacy v. Satya Deo Gupta* MANU/SC/0256/1962 : [1963]2SCR484 and *Hitachi Ltd. v. Ajay Kumar Agarwal* 1996 PTC (16) (DB), the learned senior counsel for the plaintiffs, Mr. Sudhir Chandra urged that the question whether there is similarity between the two titles has to be approached from the point of view of an "unwary purchaser of average intelligence and imperfect recollection".

8. According to the plaintiffs' counsel, the publicity surrounding the defendants motion picture by repeated references and allusions to the plaintiffs' trademark "HARRY POTTER" is creating immense confusion and deception in the minds of the potential audience of the former's film, resulting in the dual torts of unfair competition and passing off.

9. plaintiffs' counsel also invited my attention to a variety of press articles from websites, including the defendants' own website, to show that the motion picture "HARI PUTTAR" is being touted as the desi version of "HARRY POTTER". The pitching in the press by the actors in the defendants' promotional video, namely, Zain Khan and Shamita Shetty, according to him, further compounds the confusion.

10. The plaintiffs' counsel contends that as soon as they came to know that the defendants No. 1 and 2 were producing a motion picture film tentatively titled as "HARRY PUTTAR", the plaintiff No. 1 addressed a letter on 20th December, 2005 voicing its concern to the defendant No. 1, which was followed by further correspondence between the parties. In fact, it is strenuously urged by Mr. Sudhir Chandra, learned senior counsel for the plaintiffs that the plaintiffs had four times put the defendants to notice, but despite this the defendants persisted in their infringing activities. Reliance is placed by Mr. Chandra on the doctrine of Initial Interest Confusion propounded in the cases of *Mobil Oil Corporation v. Pegasus Petroleum Corp.* 1677 2 U.S.P.Q., *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.* 1990 39 U.S.P.Q. (7th Cir. 1996) and *Brookfield v. West Coast* (9th Cir. Court of Appeals 9856918) to buttress his contention that the defendants are passing off their film as that of the motion picture of Warner Brothers. In particular, Mr. Chandra relied upon the following relevant extract from *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, Volume 3, pages 23-19:

Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion....

The analogy to trademark initial interest confusion is a job-seeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or a "type." The misrepresentation has enabled the job-seeker to obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.

Initial interest confusion can be viewed as a variation on the practice of "bait and switch".

11. Mr. Arun Jaitley, the learned senior counsel for the defendants, on the other hand, contends that the defendants are not using the words "HARRY PUTTAR" as initially proposed nor they have any intention of doing so, but what was proposed to be used as a title for the film were the words "Hari Puttar - A Comedy of Terrors". It is submitted by him that as the title itself reveals the theme of the film has nothing to do with "HARRY POTTER", and the film is in fact a comedy entertainer with an abundance of humour quotient. The name itself is derived completely from the theme, story line and character depiction of the movie and this is established from the following facts:

(i) The name of the main protagonist in the film is Hariprasad Dhoonda.

- (ii) Hari is a derivation from the short form of the main character name.
- (iii) 'Puttar' in Punjabi means 'son' and the focus in the film is on the son of the family, who is the real hero of the movie.
- (iv) The language of the movie is a mix of Hindi and Punjabi.
- (v) The focus of the defendants' film is a family portrayal; whereas Harry Potter relates to a school where magic is taught, i.e., Hogwarts School of Magic.
- (vi) The film is based on the boy's heroic deeds, portrayed in a humorous manner, completely different to the Harry Potter books or films which are fictional thrillers with a high quotient of magic thrown in.

12. In short, it is submitted that the meaning of the title, the language of the film and the theme of the film have no commonality with any of the Harry Potter books and films. Additionally, it is submitted that irrespective of the translation, "Harry Potter" in English or Hindi and "Hari Puttar" in English, Hindi or Punjabi are phonetically different and distinct. The fact that by deliberate mis-pronunciation or deliberate slant of tongue "Hari Puttar" may be pronounced as "Harry Potter" cannot be a ground for phonetic similarity.

13. Apart from the merits of the case, Mr. Jaitley, the learned senior counsel for the defendants stressed upon the fact that the plaintiffs, even otherwise, have disintitiled themselves to the equitable relief of injunction on account of deliberate suppression of material facts in the plaint itself. Emphasis has been placed also upon the conduct of the plaintiffs throughout. Thus, it is alleged that:

- (i) At the time of the filing of the suit, the plaintiffs deliberately suppressed the correspondence of June, 2007 with the Motion Picture Association of America, Inc. (MPAA), and claimed that the cause of action arose in March, 2008.
- (ii) In the midst of hearing, after the defendants had concluded their arguments, the plaintiffs obtained a letter from the MPAA dated 5th September, 2008, without disclosing the communication addressed by the plaintiffs to Motion Picture Association of America, Inc.
- (iii) In rejoinder arguments, an affidavit was sought to be filed, stating that there were no posters of "Hari Puttar" in any film theatres or any promotion in McDonalds, completely forgetting that it had been pleaded in paragraph 31 of the plaint that:

...A fresh cause of action arose thereafter on 5th July, 2008 when a poster of the defendants' film was spotted in a movie theatre.

14. Adverting to each of the aforesaid grounds, it is contended by Mr. Jaitley that there is no manner of doubt that the conduct of the plaintiffs is far from being above board, and in fact the same leaves much to be desired. Reference was made by Mr. Jaitley to paragraph 25 of the plaint to show that the plaintiffs deliberately suppressed and did not disclose the material fact of correspondence with the Motion Picture Association of America, Inc. in June, 2007, claiming that the cause of action had arisen in March, 2008. Paragraph 25 of the plaint, which deals with the cause of action for filing the plaint, reads as follows:

25. After the communication of June, 2006 various/occasional inquiries and searches by the plaintiff suggested that Defendants Nos. 1 and 2 were not making any progress with the "HARI PUTTAR" movie project. Fairly believing that the project was shelved (which is not unusual for many, especially smaller, films in the development stage) and that the plaintiff's concerns therefore, required no further redressal, the plaintiff No. 1 was shocked when market intelligence revealed in March 2008 that Defendants had apparently completed the film, secured a partner in Defendant No. 4, and were publicizing it under the title of "Hari Puttar : The Comedy of Terrors" with the intention of releasing the film sometime later in the year. The plaintiffs additionally discovered that the Defendants had registered the domain name www.hariputtarthe.com and were not only publicizing their movie on the said website but were also using the mark HARI PUTTAR in conjunction with a "TM" logo on the said site as evidence of their attempt to claim ownership over a mark that was so blatantly a phonetic variant of the plaintiffs' famous trade mark. The plaintiffs were also surprised to recently find that Defendant No. 4 had applied for trademark registration of "HARRY PUTTAR".

15. My attention was drawn next by Mr. Jaitley to the plaintiffs' affidavit, sought to be filed in the midst of arguments, stating that there were no posters of "Hari Puttar" in any film theatres nor there was any promotion of the film in McDonalds. This affidavit, it was strenuously urged, was in direct variance and conflict with the stand adopted by the plaintiffs in the plaint as well as in the present application, in that, it is

manupatra specifically stated in paragraph 31 of the plaint as well as in paragraph 24 of the present application as follows:

31. ...The cause of action arose after a lapse of more than two years, in the month of March, 2008 when reports in the Indian press and market intelligence suggested that the Defendant Nos. 1 and 2 had teamed up with Defendant Nos. 3 and 4 and had in fact gone ahead and actually completed a movie which they had officially and conclusively titled Hari Puttar and were looking to release it sometime in the future.

A fresh cause of action arose thereafter on 5th July, 2008 when a poster of the Defendants' film was spotted in a Movie Theatre containing the words Hari Puttar in bolder and more prominent font than all the other literature on it, resulting therefore, in an infringement of plaintiff Number 1's registered trademark Harry Potter and passing off the Defendants' film as that of the plaintiffs....

16. This is reiterated in the present application, in paragraph 24, where it is stated as follows:

24. ...After a poster of the movie was spotted at Spice Cinemas in Sector-25, NOIDA on July 5, 2008, it appeared that the movie was slated for a soon upcoming release.

17. It is urged by Mr. Jaitley that the plaintiffs' affidavit and their contention in rejoinder arguments that, there were no posters of "Hari Puttar" in any theatre nor there was any promotion of the film are blatantly false and an intended cover-up for the plaintiffs' inaction during the period 2006 to 2008.

18. Next, it is urged by the learned senior counsel for the defendants that another completely mystifying fact is how the letter dated 5th September, 2008 purporting to be from the Motion Picture Association of America, Inc. managed to surface with the epithet "To Whom It May Concern", to state that pursuant to the TRB Rules, the film "Hari Puttar" may not be used by Times Infotainment Media Ltd. for a theatrical film release in the United States at this time. The plaintiffs, it is further urged, though have filed this document in the midst of arguments have not deemed it fit to make any disclosure as to the communication addressed by them to the Motion Picture Association of America, Inc. to warrant the Motion Picture Association to send this mail to the plaintiffs, intact with the cause title and suit number of the present suit and a copy of the rules of the "Title Registration Bureau" enclosed therewith.

19. Faced with the aforesaid, Mr. Chandra, the learned senior counsel for the plaintiffs sought to urge that the plaintiffs had nothing to gain from the suppression of the aforesaid facts, and the said facts had not been stated as the same were not found to be relevant.

20. I am unable to accede to the aforesaid contention for the simple reason that the words used in paragraph 25 of the plaint are clear evidence, in fact, what is termed as smoking gun evidence, of the fact that the plaintiffs wanted to create in the plaint the impression that after the communication of June, 2006, the plaintiffs fairly believed that the project had been shelved and were, in fact, shocked when market intelligence revealed in March, 2008 that the defendants had completed the film. There is no manner of doubt, in my mind, that the aforesaid assertion was made for the specific purpose of obtaining an ex parte ad interim injunction from this Court and in a bid to persuade the Court that the completion of the film had suddenly hit the plaintiffs, who had no idea of the completion of the same. I say so on the basis of the following facts extracted from the plaint itself.

21. It is the case of the plaintiffs in the plaint that the plaintiffs first came to know that the defendants were conceptualizing a film tentatively titled "Harry Puttar" in December, 2005 in respect of which a "friendly letter" was addressed by the plaintiffs on 20th December, 2005 to the defendants in order to ascertain the truth of the rumors as well as to reserve the plaintiffs' rights at the outset (see paragraph 19 of the plaint). A response to the said letter was given by the defendants on 24th January, 2006 stating as follows:

"HARI PUTTAR"

I'm writing to you in response to your letter of 20 December 2005 concerning "Hari Puttar".

Although Dream Town Productions is of course aware of the existence of the Harry Potter books and films, our film "Hari Puttar" is in no way based on nor could it be confused with any characters, themes, incidents or elements of Harry Potter. Hari Puttar is an entirely original literary work of my own authorship which bears no material resemblance to Harry Potter. Our film, "Hari Puttar", is based upon the original script and constitutes an original copyright work which is not in any way related to Harry Potter products.

With regard to the use of the title "Hari Puttar", it is important that the cultural context of the words "Hari" and "Puttar" are recognised. "Hari" is short for the Hindi name "Hariprasad, Harinder (as per my name), Harish, Harpreet" e.t.c. and is pronounced "Hurry". "Hari" is also used differently to associate with a religious deity (for example "Hari Krishna, Hari Ohm, Hari Ram" which are also names of "Hindu Gods") "Puttar" in Hindi and Punjabi means "son". Therefore, in the local language and dialect, "Hari Puttar" is not readily associated with "Harry Potter".

Further, we consider that "Hari Puttar" is a distinctive and original title for the original script and film which Dream Town owns and does not, contrary to the assertions set out in your letter, infringe any rights that Warner may have in respect of "Harry Potter".

Given that "Hari Puttar" is an original work and does not infringe Warner's rights, Dream Town Productions will defend any action or attempt by Warner to limit Dream Town Production's right to exploit its intellectual property, and will seek to recover any losses arising therefrom.

As I am sure you can appreciate, the "Hari Puttar" script is confidential and commercially sensitive and we are not, therefore, willing to disclose it to any third party at this stage of its development and production. However, in the event that Warner becomes interested in distributing "Hari Puttar", we would be willing to send you a copy of the script in the event negotiations are developed.

22. Thereafter, the plaintiffs by letter dated April 11, 2006 addressed to the defendant No. 1, Mr. Harinder Kohli asked the defendants to reconsider the title in view of the likelihood of the confusion and unfair advantage from the reputation in "Harry Potter", to which the defendants by letter dated 3rd May, 2006 responded by sending the script, both in Hindi and English, with the details of the characters and the examples of the proposed advertising, which reads as follows:

Hari Puttar ('the Film')

I write further to my earlier e-mail dated the 20 April 2006 and our conversation of yesterday's date and I now enclose the following:

1. the script, which is in both Hindi and English;
2. details of the characters; and
3. examples of the proposed advertising.

Please note that due to filming deadlines the Film was not shot exactly as per the script; certain scenes were shortened or removed completely.

Once you have had the script translated into English you will see that my client's Film is in no way based on or related to Harry Potter. I note from your letter to my client dated 11 April 2006 that you state there already exists confusion in the public between your film and my client's Film, and you rely on various newspaper articles to confirm your point. However, these articles have been written without sight of the script or, more importantly, the Film and given the content of my client's Film I cannot see how it can be truly confused with your film.

My client has already explained the cultural context of the words "Hari" and "Puttar". Furthermore, the word "Puttar" is often used throughout the Film, an example of which can be found in the script on page 3.

23. By a letter dated 7th June, 2006, the plaintiffs, however, again expressed their concern over the title of the film, to which the defendants on 14th June, 2006 responded as follows:

Hari Puttar ('the Film')

Thank you for your letter dated 7 June 2006. My client has noted your concerns, although it still does not believe that its film's title infringes your intellectual property rights.

However, in order to bring this matter to a satisfactory conclusion my client is willing to alter its film's title to one of the following:

1. Mera Hari Puttar. Please note that this translates as "Hari our Son".
2. Shree Hari Puttar. Shree means Mr. or Sir.
3. Hari Puttar The Real Hero. A caveat will also be inserted that states that "this film has no connection or association with Warner Bros' film: Harry Potter

As you can see my client is trying to deal with your concerns in a prompt manner, and I would therefore be grateful if you would kindly do so too. I now look forward to hearing from you.

24. The response evoked to the aforesaid letter from the side of the plaintiffs is contained in letter dated 28th June, 2006, thanking the defendants for proposing three alternative film titles for their review and suggesting that the title for the defendants' film does not use the words "Hari Puttar". Thereafter, there appears to be a complete and total silence from the side of the plaintiffs. No cease and desist notice or any legal notice

manupatra whatsoever appears to have been addressed by the plaintiffs to the defendants, and even the attempt of the defendants to have their film registered with the Motion Picture Association of America, Inc. in the year 2007 does not appear to have propelled the plaintiffs into filing a suit against the defendants. Why the plaintiffs did not attempt to file a suit against the defendants at this juncture is indeed mystifying, for, no doubt could have been left in the mind of the plaintiffs at least at this juncture that the defendants intended to complete the film. The plea put forth by the plaintiffs in paragraph 29 of the plaint that plaintiffs fairly believed that the defendants had shelved the project is, therefore, in my view, clearly aimed at misleading the Court by suppression of the true facts.

25. The matter does not end here. The defendants assert having provided various inputs into the film after the parties ceased to correspond with each other in the summer of 2006. It is the case of the defendants in the reply filed by them (See paragraphs 12 and 13 of the reply) that in the intervening two years, the defendants No. 1 and 2 entered into a Film Acquisition Agreement with the defendant No. 4, who provided the following inputs:

12. ...

a) Complete re-editing of the film - done by well known editor Hemal Kothari who has edited movies like "Pyar Ke Side Effects", "Love Story 2050" and many more.

b) New background score - done by Aadesh Srivastava;

c) Composing three new songs for the film and shooting two promotional videos of two of these songs. These songs too have been composed by Aadesh Srivastava, an established and extremely popular music composer in the Indian Film Industry. The lyricist of the said songs is Sameer who again is an extremely well known lyricist. These songs have been sung by well known playback singers like Shaan, Sunidhi Chauhan, Sukhvinder Singh, Neha Bhasin. Sameer (winner of SAREGAMAPA little champs 2007) and Aishvarya (winner of Chote Ustad 2008) have also sung a number each in the said film. In fact, the title track of this film is composed around and links the content of the film with its main character. Defendant No. 4 has also entered into an agreement with Super Cassettes Industries Limited for the assignment of the music rights of the said film. The music for the films is going to be released globally by Super Cassettes Industries Limited - the owners of the music label T-Series, one of the largest music labels in India with large repertoire of music rights of popular films.

DOMAIN NAME: "www.hariputtarthefilm.com

13. Defendant No. 4 registered the domain name www.hariputtarthefilm.com on 02.05.2007, i.e. more than a year ago, and has an active website operating under the said domain name. The said website inter alia provides its viewers with a brief outline of the story of the said film, a short promotional footage, wallpapers, etc. for download and certain other basic information relating to the said film.

26. As regards financial inputs and business tie-ups, the defendants in paragraphs 14 and 15 of their reply further assert as follows:

FINANCIAL INVESTMENT:

14. The Defendants have made huge investments in the film in issue. The total investment made in this movie as of today is between Rs. 10 to 15 Crores. This, however, does not include the investments being made by other entities which are involved in various co-branding, business tie-ups and other activities that are being undertaken in relation to the said film.

BUSINESS TIE-UPS:

15. The Defendant No. 4 has entered into various business tie ups with well known Indian and Foreign Brands for the said movie such as Britannia, Mc Donalds, etc. The relevant details of these tie ups are set out hereunder:

A) TIE UP WITH BRITANNIA:

The Defendant No. 4 has entered into an in-film branding agreement with Britannia Industries Limited in Jan-Feb 2008 for the movie in issue. Through this film, the animated character of the brand mascot of the latter's famous product "Britannia Treat" would be launched. This brand mascot is named

"Funtoon". The animated character of the said mascot i.e. "Funtoon" along with the animated character of the main protagonist of the said film "Hari Puttar" are in fact the Sutradhars of the said film. The animation work and special effects of the said film have been done by Tata Elxsi - a multi national company has worked on various well known films like Kal Ho Na Ho, Boom, Funtoosh, Chupe Se, Agnipankh etc.

B) TIE UP WITH McDONALDS:

The said film is being promoted in around 134 outlets of McDonalds on all-India basis where McDonalds Happy Meal would carry merchandise of the said film in the month of September 2008. In addition to this, the said McDonalds outlets will also promote the said film through in-store branding of the said film during the month of September 2008.

C) TIE UP WITH DIAMOND COMICS

Diamond Comics is one of the most popular publications for children in India. It is published in various languages like Hindi, English and Bengali and has a circulation of about 7.5 lakhs. The said Comics carry a promotion of the movie in the July, August & forthcoming September Edition of every Diamond Comic Book. The promotion is a 2 page exclusive on the movie in issue.

27. The above, in my view, seems to have impelled the plaintiffs into placing on record the affidavit of one Shri Dinesh Chander Sharma, holding himself out to be a professional investigator, stating on oath that none of the movie halls mentioned by him in the affidavit have posters or promotional material of the film "Hari Puttar", and further stating on oath that none of the McDonalds outlets at Lajpat Nagar, Khan Market and Nehru Place have any posters or promotional material for "Hari Puttar".

28. It may be mentioned that time was sought by the defendants to file a reply affidavit, but it was not deemed necessary to grant the same in view of the fact that the aforesaid affidavit was at complete variance with the statement made in the application itself that the defendants were publicizing their film and it was "after a poster of the movie was spotted at Spice Cinemas in Sector-25, NOIDA on July 5, 2008, it appeared that the movie was slated for a soon upcoming release."

29. It is the settled position both in law and in equity that a deliberate suppression of material facts, viewed singularly or coupled with blatantly false assertions, so far as the grant of equitable relief of injunction is concerned, is fatal. The plaintiffs in the instant action have attempted to lightly brush off their intentional non-disclosure by feigning oversight, contending that they had nothing to gain from the aforesaid non-disclosure. What has been lost sight of is that it is a cardinal principle of law that a person who seeks the equitable relief of injunction must come to the Court with clean hands. In *Udai Chand v. Shankar Lal and Ors.* MANU/SC/0391/1978 : [1978]2SCR809, it was held by the Hon'ble Supreme Court that the Court would be justified in revoking the leave to appeal if the same was obtained by making mis-statement of a material fact which was of decisive importance in the case. It was held that a party who approaches the Court invoking the exercise of its overriding discretions must come with clean hands. If there appears on his part any attempt to over reach or mislead the Court by false or untrue statements or by withholding true information which would have a bearing on the question of exercise of discretion, the Court would be justified in refusing to exercise the discretion or, if the discretion has been exercised, in revoking the leave to appeal granted even at the time of hearing of the appeal. Again, in the cases of *Satish Khosla v. Eli Lilly Ranbaxy Limited* MANU/DE/0763/1998 : 71(1998)DLT1 and *Anand Swarup v. Municipal Corporation of Delhi* 36 (1998) DLT 304, this Court reiterated the legal principle that a person approaching the Court must disclose all relevant facts if he seeks an injunction. In a recent decision of this Court in the case of *Micolube India Ltd. v. Maggon Auto Centre and Anr.* MANU/DE/0180/2008 : 150(2008)DLT458, it was again held that the plaintiff cannot be let off by accepting its plea of feigned ignorance.

30. Then again, in the instant case, the false assertions of the plaintiffs and the suppression by them of material facts, were quite obviously intended by them to be a cover up for their delay in approaching the Court, which delay, so far as the grant of equitable relief is concerned, is again a material circumstance (though not necessarily a conclusive one). It is settled law that if the plaintiffs stood by knowingly and let the defendants build up their business or venture, then the plaintiffs would be estopped by their acquiescence from claiming equitable relief. Acquiescence on the part of the plaintiffs would amount to waiver, if not abandonment of their right. If, according to the plaintiffs, the defendants had dishonestly adopted a title or mark akin to that of plaintiffs, it was imperative upon the plaintiffs to have nipped the evil in the bud by forwarding to the defendants a legal notice of CEASE AND DESIST or "carry on at your own peril and risk". Instead, the plaintiff sat by, a course of conduct inconsistent with the claim for exclusive rights in a trademark, trade name, etc. Needless to say that delay by itself may not necessarily be a ground for refusing injunction, but delay would be relevant in adjudging a change in the subject mater in an action brought about by a

manupatra situation in which the plaintiff sat on the fence, watching the defendant enrich its trade by investment of money and labour and involving third party rights in the same.

31. In the present case, I am not inclined to accept the contention of the plaintiffs that they had nothing to gain from omitting to state the facts. As delineated above at considerable length, the plaintiffs were projecting their case as if they were under the impression that the defendants had shelved the project and to their utter shock in March, 2008 on spotting a poster they became aware of the fact that the defendants were bent upon releasing the film. The hiatus between June 2006 and June 2008 is thus sought to be bridged by the plaintiffs by feigning ignorance of the defendants intent to complete the film and release the same. The conduct of the plaintiffs, even otherwise, leaves much to be desired as they persisted in their course of misleading the Court by filing the affidavit dated 8th September, 2008 in rejoinder arguments, completely forgetting that the stand taken in the plaint was to the contrary and, yet again, by procuring a letter from the Motion Picture Association of America, Inc., withholding the information as to how the Motion Picture Association of America, Inc. had sent an e-mail to the plaintiffs mentioning the suit number of the present suit and other details and enclosing the Rules of the "Title Registration Bureau".

32. It also cannot be lost sight of that in dealing with applications for ad interim injunctions, the Court, inter alia, takes the statements set out in the aforesaid applications as well as in the plaint to be statements of fact which are to be accepted at their face value. Any suppression or concealment of the material facts cannot, therefore, but be viewed as an attempt to pollute the stream of justice.

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 liked 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.

35. In *Biswaroop Roy Choudhary v. Karan Johar* reported in MANU/DE/2753/2006 : 131(2006)DLT458 , a learned Single Judge of this Court, while holding that he was unable to find any plausible reason for not allowing the release of a film, the title of which allegedly was infringing the plaintiffs trademark rights, pertinently held as follows:

12. 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....

36. Applying the above parameters, it is impossible to ignore the fact that the defendants have painstakingly trudged a considerable distance in the production of the film, which is now complete and at the stage of release within a matter of days. During the sojourn of the defendants, the plaintiffs at the most may be said to have half-heartedly whimpered against the use of the title "Hari Puttar" by the defendants, but thereafter they chose to squat comfortably and thus ensconced, have been watching the defendants' progress step by step

manupatra towards their goal, to the finishing line. Their belated attempt to trip up the defendants at the finishing line is a course of conduct which, in my opinion, is diametrically opposed to the cardinal principle of vigilentibus non dormientibus enquitur and cannot be countenanced by a Court bound to take into consideration legal as well as equitable considerations.

37. To conclude, the plaintiffs by their course of conduct are held disentitled to the injunction prayed for. The instant application is accordingly dismissed.

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