

Legal Issues - Seminar Series

Legal Issues in 'IP in Films, Documentaries, Mass Media & Broadcasting, News, Telecasts, Television, Webinars, Streaming'

Issue: Does the unauthorized use of a trademark by way of spoken use in a critical comment result in infringement?

Related Provisions

❖ Section 29(4), Trade Marks Act, 1999

“ 2. *Infringement of registered trade marks*

(4) A registered trade mark 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-

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.”

Related Provisions

❖ Section 29(8), Trade Marks Act, 1999

“ 2. *Infringement of registered trade marks*

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising-

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(c) is against the reputation of the trade mark”

❖ Section 29(9), Trade Marks Act, 1999

“ 2. *Infringement of registered trade marks*

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”

Relevant Judicial Decisions

❖ **Tata Sons Limited vs. Greenpeace International and Ors. [2011:DHC:515]**

“40...A textual reading of the statute makes it clear that the intent of the draftsmen was that a breach of Section 29 (4) would take place when another commercial/entrepreneurial body is exploiting that same trademark. However in this case, neither of the defendants are involved in any profit making endeavor or competitive business with the plaintiff. Further, the defendants have proffered precedent that goes on to support the fact that a bona fide user of the trademark shall be an infringement of trademark law only when the user is a similar/competitive profitmaking endeavour as the plaintiff (Express Bottlers Service Pvt. Ltd. v. Pepsi Inc., 1989-PTC-14 (Calcutta High Court)). The Court is also of the opinion that the defendants argument that they can make reasonable comment, ridicule, and parody of the registered trademarks, is persuasive...”

Relevant Judicial Decisions (contd.)

❖ **Tata Sons Limited vs. Greenpeace International and Ors. [2011:DHC:515]**

“42. The above analysis would show that the use of a trademark, as the object of a critical comment, or even attack, does not necessarily result in infringement. Sometimes the same mark may be used, as in Esso; sometimes it may be a parody (like in Laugh it Off and Louis Vuitton). If the user’s intention is to focus on some activity of the trademark owners, and is “denominative”, drawing attention of the reader or viewer to the activity, such use can prima facie constitute “due cause” under Section 29 (4), which would disentitle the plaintiff to a temporary injunction, as in this case. The use of TATA, and the ‘T’ device or logo, is clearly denominative. Similarly, describing the Tatas as having demonic attributes is hyperbolic and parodic...The Court cannot annoit itself as a literary critic, to judge the efficacy of use of such medium, nor can it don the robes of a censor. It merely patrols the boundaries of free speech, and in exceptional cases, issues injunctions by applying Bonnard principle. So far as the arguement by the plaintiff that it is being “targeted” is concerned the Court notes that the defendants submit that the major gains through the port accrue to the Tatas....”

Relevant Judicial Decisions (contd.)

❖ **Bata India Ltd. vs. Prakash Jha Productions and Ors. [SLP (C) No. 32998 of 2012]**

“...we are of the view that the same is in poor taste and the wordings indicating the names of certain Business Houses could have been avoided. However, we are also of the view that there does not appear to be any intention in the song to besmirch the reputation of any particular Business House or commercial enterprise and that the entire song has been written in a manner which attempts to depict the producer’s view of the state of society today...wordings of the song are not likely to be taken literally by the viewers.”

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Relevant Judicial Decisions (contd.)

❖ **Prakash Jha Productions vs. Bata India Limited & Ors. [2012:DHC:6771-DB]**

“11. The contention urged is that the stanza in question per se defames the house of Bata by portraying as if the house of Bata is akin to a blood sucking bat which survives on the blood of other living species; in the thematic setting of the film it will be the blood of the poor and the impoverished urges the counsel...”

“...12. The rival viewpoint projected is that the song is no more than a rhetoric hyperbole and any person viewing the cinematographic film or hearing the song would understand, in its contextual setting, that it reflects the story of the struggle between the “have nots” and the “haves”...”

Relevant Judicial Decisions (contd.)

❖ **Prakash Jha Productions vs. Bata India Limited & Ors. [2012:DHC:6771-DB]**

“17. The real demand of objectivity in social analysis, is therefore not to extricate oneself, even in a contrived effort, from the social phenomenon and the mainstream of life, as it were, but to be critically aware of the subjective predilections and value premises in order to continuously examine them, check them, re-evaluate them, in order to “minimize” their impact on the cognitive process – “minimize” because total elimination is an impossibility...

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...19. The movie raises a burning social issue which we find is a matter of public debate on the streets and the press. The struggle between the “haves” and the “have nots”. The struggle for political power and the control over the philosophy of the State.”*

Relevant Judicial Decisions (contd.)

❖ **Hamdard National Foundation and Ors. vs. Hussain Dalal and Ors. [2013:DHC:2985]**

“14. A further reading of Section 29 (9) would make it clear that the said section provides that it is an infringement of the trade mark by way of the spoken use of the words which are contained in the trade mark and their visual representation thereof. What is an infringement is not merely visual representation of the product in the bad light under the provision of Section 29 (9) of the Act but it is the infringement of the trade mark if the same is caused by way of spoken use of the words and the visual representation of the said words. This is evident from the grammatical reading of the section which in the continuation and completion of the sentence reads “by their visual representation”, all this would mean that visual representation of the spoken words is an infringement of trade mark.

Relevant Judicial Decisions (contd.)

❖ **Hamdard National Foundation and Ors. vs. Hussain Dalal and Ors. [2013:DHC:2985]**

“15. Now, the cinematograph film is a visual representation of the motion picture containing sound recordings, dialogues which are presented in the audio and video format before the public at large. The said cinematograph film is definitely covered within the ambit of the visual representation which is larger genus under the provisions of Section 29 (9) of the Act. Thus, the provision of the Section 29 (9) further makes a statutory infringement of the registered trade mark if the same is caused by the spoken words.”

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Relevant Judicial Decisions (contd.)

❖ **Hamdard National Foundation and Ors. vs. Hussain Dalal and Ors. [2013:DHC:2985]**

“16. The tests for the adjudging the said infringement would remain the same which are prevalent in the field of the trade mark. Either the said spoken words should cause the infringement by making a mis-statement or causing confusion and deception which is the gist of the passing off action or in the alternative, the said spoken words should cause infringement by way of diluting the distinctive character and repute of the trade mark which may either intention or unintentional.”

“17. It is well settled that the intention to defraud is not essential ingredient of the passing off action, thus, the infringement or passing off which has been caused innocently or fraudulently would not make a difference if the same falls within the ambit of the infringement as a matter of law and fact.”

Relevant Judicial Decisions (contd.)

❖ **Dr. Reddy's Laboratories Limited vs. Eros International Media Limited and Ors. [2021:DHC:1054]**

“18...The fictitious entity of Drishti Refineries Limited is involved in the business of setting up refinery plants, which is completely distinct from that of the Plaintiff. The afore-noted usage of acronym ‘DRL’, has no correlation with the Plaintiff’s primary trademark – Dr. Reddy and/or its body corporate i.e. Dr. Reddy’s Laboratories Ltd. Thus, prima facie, the Court does not find merit in the contention of the Plaintiff that the aforesaid portrayal would amount to the general populace drawing an association with the Plaintiff company. Besides, ‘DRL Township’ / ‘DRL Township Group’ cannot be appreciated, de hors the context of the movie, wherein the complete name of the fictitious entity, Drishti Refineries Limited, is stated to have been used explicitly...Therefore, in view of the Court, the prima facie case is not made out in favour of the Plaintiff, to suggest that the average movie-goer would associate the name ‘DRL Township’ in the movie as a reference to the Plaintiff’s brand or business. The well-established ‘ordinary person test’ also leads to the same conclusion.”

Relevant Judicial Decisions (contd.)

❖ **Dr. Reddy's Laboratories Limited vs. Eros International Media Limited and Ors. [2021:DHC:1054]**

“20. Next, we shall deal with Plaintiff reliance’s on Section 29(8) of the Act...to contend that the use of ‘DRL’ by the Defendants constitutes infringement, as the advertisement is against the reputation of the Plaintiff’s trademark...the Court does not find any similarity, direct or indirect correlation, or association with the use of ‘DRL’ by the Defendants with the Plaintiff’s mark/brand, the question of the usage being against the reputation of the trademark of the Plaintiff becomes merely speculative...The use of a trademark in the course of trade, and in connection with the sale of goods or services, constitutes infringement, if it is used in such a manner that it is likely to cause confusion in the minds of a consumer as to the identity of those goods or services. Therefore, the use of ‘DRL’ by the Defendants cannot be examined in vacuum. One can easily notice that the Defendants’ use of DRL, certainly, is not akin to the use of a trademark, in respect of the goods/services for which the Plaintiff is the proprietor. Therefore, the Court does not find a prima facie case of infringement...”

Conclusion

- The legal framework for infringement by spoken word or visual representation for a critical comment leans towards protecting critical commentary and parody.
- However, certain judicial precedents show tension between protecting trademark owners from exploitation and upholding creative expression and free speech, leading to inconsistent legal outcomes.
- It is inherently difficult for courts to balance brand protection with the need for open public discourse, reflecting the challenge of harmonizing legal principles with free speech and creative expression.

THANK YOU!

Questions?

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