Chapter – VI

INFRINGEMENT, REMEDIES AND DEFENCES OF COPYRIGHT.

The copyright owner has the exclusive right to: (i) copy the work, (ii) issue copies of the work to the public, (iii) rent or lend the work to the public, (iv) broadcast the work or include it in a cable programme, (v) perform, shows or play the work in public, (vi) make an adaptation of the work or do any of the above in relation to an adaptation. These exclusive rights comprised in the copyright in the different classes of protected works are spelt out by Section 14 of the Indian Copyright Act 1957. The copyright subsisting in a work is infringed by any person who does or authorises another to do any of these acts restricted by copyright without the licence (that is, without permission, contractual or otherwise) of the copyright owner under Section 51 of the Act. Under the Act both civil\(^1\) and criminal remedies\(^2\) are available to prevent infringement of copyright. While civil remedies include an injunction, an account of profit or damages criminal remedies call for imprisonment and fine. But to sustain a criminal proceeding under the Act the knowledge of the infringing party to infringe the rights shall be proved beyond doubt. While civil remedies compensate the owner, the criminal remedies act as a deterrent against infringing activities. The general defences of copyright infringement are set out by Section 52 of the Act (commonly known as “fair dealing” provisions). The various issues relating to infringement, remedies and defences of copyright need detail deliberation.\(^3\)

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\(^1\) Chapter XII of the Indian Copyright Act 1957.

\(^2\) Chapter XIII, Ibid.

VI. 1. Infringement of Copyright.

i. Infringement is the Foundation of Copyright Liability.

Section 51 of the Act defines the varieties of acts which infringe copyright and all other rights created by the Act. This Section is the foundation of copyright liability. According to Section 51 copyright of a work shall be infringed when any person without a proper licence from the owner: (a) does anything, the exclusive right to do which is conferred upon the owner by the Act; (b) permits to use any place for the performance of a copyrighted work in public for profit, unless he was not aware or had no reasonable grounds for believing that such performance would be an infringement of copyright; (c) makes infringing copies for sale or hire, or selling or letting them for hire; (d) distributes infringing copies either for the purposes of trade or to such an extent as to affect prejudicially, the owner of copyright; (e) by way of trade exhibits in public; (f) imports infringing copies, except for the private and domestic use of the importer. The explanation to the Section further provides that the reproduction of dramatic, literary or musical works in the form of cinematograph film shall be deemed to be an “infringing copy.” Thus when any person carries on any activity which contravenes any rights afforded to the owner of copyright in a work, permits any place for the public performance of the work, makes infringing copies of the work for sale of hire, distributes, exhibits or imports infringing copies of the work for the purposes of trade or so as to prejudicially affect the owner of copyright in the work, infringes copyright. Any dealing in infringing copies too amounts to an infringement. A reproduction of a literary, dramatic, musical or artistic work in the form of a cinematograph film is also deemed to be an infringing copy.

The Copyright Act provides both civil and criminal liabilities. Sections 63, 65 and 67 clearly prescribe that only persons who knowingly infringe copyright are committing penal offences. As regards civil liability, the Act provides that knowledge of infringement on the part of the defendant as a basis of liability. If a defendant permits for profit the use of any place for public performance of copyrighted work, he/she can under Section 51(a)(ii) show that he/she was unaware of subsisting copyright or that he/she had
reasonable grounds to believe that such copyright did not subsist at the relevant time. If this is proved, the plaintiff is only entitled to injunction and account of profits but to no other remedy. But in all other cases defined by Section 51, and the chapter providing for civil liability, the defendant who does anything to infringe copyright or deals in specified manner with infringing copies remains liable for damages for infringement. Thus, infringement is the foundation of copyright liability.

ii. Criteria for Determination of Infringement.

The definition clause of the 1957 Act does not define infringement as such; but the definition of an “infringing copy” in Section 2(m) provides some standards and criteria for the determination that an infringement has occurred. Accordingly it means:

(i) in relation to a literary, dramatic, musical or artistic work, a reproduction thereof otherwise than in the form of a cinematograph film.

(ii) in relation to a cinematograph film, a copy of the film made on any medium by any means;

(iii) in relation to a sound recording, any other recording embodying the same sound recording, made by any means;

(iv) in relation to a programme or performance in which such a broadcast reproduction right or a performer's right subsists under the Act, the sound recording or a cinematograph film of such performance;

if such reproduction, copy or sound recording is made or imported in contravention of the provision of the Act.

To constitute infringement the verbatim copy or an exact reproduction or dealing with the work is not necessary. A resemblance with the original in a large measure is sufficient. It is the degree of resemblance, which makes the infringing work a mere slavish copy of the original. A literal imitation with mirror variations undoubtedly
constitutes infringement\(^4\). Thus the rights get infringed if a substantial part of it is copied. But to determine this substantiality component in the different categories of work is not an easy task. It is judged from case to case. It is here that the judiciary assumes a significant role. The judiciary through various decisions has laid down certain guiding principles in this regard. To determine infringement one has to see whether the impugned rework is slavish imitation and copy of another persons work or it bears the impress of the authors' own labour and originality. The piracy in an alleged infringing copy can also be detected by making a careful examination to see whether any of the deviations and mistakes, in the original has been reproduced into the alleged infringing copy\(^5\). In \textit{Sitanath Basak v. Mohini Mohan,}\(^6\) it was held that mere resemblance of a work by itself is not an evidence of piracy, when the subject matter dealt with is common. This case was an appeal against the order of the trial court injuncting the appellants from publishing a book, which allegedly infringed the copyright of the defendants, book. The appellant claimed that the similarity in the contents is only due to the commonality in the subject matter dealt with in both the books. Even though the Court acknowledged that similarities are bound to occur when a common subject matter is dealt with, it also looked into the degree of similarities and dissimilarities and concluded that the appellant has not only copied the ideas in the defendants book, but also the form and manner of expression of ideas, thus infringing the copyright of the defendant. However, the criteria for determination of infringement is different in respect of each \textit{genere} of protected work.

\textbf{(a) Infringement of Literary, Dramatic, Musical or Artistic Work.}

Reproduction is the only test to determine the infringement of literary, dramatic, musical or artistic work. Thus a literal imitation of the copyrighted work with some variations here and there would undoubtedly constitute infringement. In other words the number of words, paragraphs or pages copied is not decisive; even a small amount of

\(^4\) \textit{Govindan v. E.M. Gopalkrishna Kone, AIR 1955 Mad.391.}

\(^5\) \textit{Lallubhai v. Laxmi Shanker, AIR 1945 Bom 51.}

\(^6\) \textit{AIR 1931 Cal. 233.}
copying may infringe copyright\(^7\). Some decisions apply the criterion of “external” features (“get up and the overall scope of publication”) and “internal” features (“the general layout”, “the manner of treatment” of subject matter, and “the amount of material contained in the book in question”) as relevant to determination of infringement\(^8\). The criterion of “colourable imitation” or “colourable variation” is also often used.

The Bombay High Court has examined the issue of interpretation concerning infringement of copyright in a book by virtue of Section 51(b)(1), making display “by way of trade” or offer to sell copyrighted work\(^9\). The accused advertised in a law journal a list of books, including a book published by the complainants which was allegedly an infringing copy. The question arose whether the words “any person … offers to sell” should be construed in a generic or restricted sense. The generic view would compel the conclusion that “offer to sell” means a proposal for sale; it is a way of soliciting orders for the publication. The restricted view would treat an “offer for sale” through an advertisement as “merely an invitation of an offer or invitation of a proposal”, and not as “offer” itself. An advertisement in a newspaper or a law journal would, on this view, “never become an offer for sale”\(^10\). The High Court preferred the generic construction on the ground that the makers of the 1957 Act had before them the provisions of the *Indian Contract Act* which treat such offers as invitation for proposals rather than an ‘offer’. Moreover, the history of the legislation, both in contract and copyright, was known to the *Indian Parliament*; and yet it elected to define the relevant term without any reference to the law of contract. Above all the legislative intention to “guard the copyright” was decisive for judicial interpretation; accordingly, it was held that the expression “offers for sale by way of trade” or “offering for sale” must “include the newspaper advertisement where the traders merely solicit customers ….” This decision is also notable for its

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\(^7\) *S.K. Dutta v. Law Book Co.*, AIR 1954 All 570.

\(^8\) *J.N. Bagga v. AIR Ltd.*, AIR 1969 Bom. 302.

\(^9\) Ibid., at pp.305-306.

\(^10\) Ibid., at pp.307.
approach which in effect maintains that Indian copyright law must be construed in Indian
terms.

In *Kesari Maratha Trust v. Devidas Tukaram Bagul*,\(^\text{11}\) the claim of copyright in
photograph published in a newspaper came for consideration. The plaintiff took the
photo of a well known author in an artistic manner and the same was first published with
the permission of the plaintiff in the cover of the Book “Rang Maza Vegale”. The name of
the plaintiff was also mentioned at the bottom of the photo. The defendant published the
same photograph without the permission of the plaintiff in the newspaper. The plaintiff,
the photographer sent a notice to the defendant claiming copyright on the photograph
and requested them to tender an apology for using it without his consent and publishing
the same in the newspaper. On refusal of the request the plaintiff filed the present suit
for injunction and nominal damages of one rupee and the same was granted by the trial
court. On appeal it was argued that the photographer had no copyright in the
photograph since it was taken at an award function and even if there was copyright the
defendants had not infringed it since there was no notice of copyright and the use was a
fair use. Rejecting these arguments the high court concluded that the photographer had
copyright since it was taken by the plaintiff with the permission of the author. On the
question of notice of copyright the court observed, thus:

“This is a case in which the appearance of the plaintiff’s name
below the photograph was a sufficient notice to the
defendants. As per law the plaintiff is admittedly, the author of
the copyright in the photograph …. The ignorance of legal
aspect of the matter by the defendants that copyright did not
exist and it belonged to the author of the photograph is no
excuse for them to infringe the copyright”.

\(^{11}\) 1999 IPLR 71(Bom) See also *Fritco-Lay India v. Uncle Chipps Private Ltd.*, 2000 PTC 341(DB Del);
In *Ushodaya Enterprises Ltd. v. T.V. Venugopal*\(^2\) the Andhra Pradesh High Court examined the question of infringement of copyright in the artistic work of the word “EENADU”. The plaintiff since 1974 was using the word EENADU for newspaper, TV broadcast, food, chit fund, hotel etc. without registration. In 1995 the defendants started using the same words with different artistic background for selling *agarbathi*. On receipt of notice from the plaintiff they stopped using it for some time but obtained copyright registration of the artistic work in EENADU and started selling *agarbathi*. After this the plaintiff also obtained copyright registration of their artistic work in EENADU. The present suit was filed alleging infringement of copyright and trademark of this artistic work. The trial court decreed the suit granting a limited injunction on the ground of passing off and infringement of copyright in the Telegu letters and the single judge of the High Court\(^3\) reversed that decision. On appeal regarding infringement of copyright the division bench made the following observation.

“There is no doubt in our mind to hold that the plaintiff is the owner of the artistic work EENADU as it has been using the same as a Masthead of the newspaper right from the year 1974 and it owns the copyright throughout India. Any attempt made by the defendant with slightly changed version suffixing and affixing anything to the EENADU artistically created word which resembles the plaintiffs artistic work cannot ensure to the benefit of the defendant and the defendant cannot lay a claim for ownership of the said artistic work. As held by the Supreme Court in *Cadila’s* case, if the court comes to the conclusion that there is a similarity between the marks of both the plaintiff and defendant, the dissimilarities assume insignificance. As indicated above, though there are dissimilarities between Ex. A8 and A59, but phonetically and visually the inscription EENADU artistic work is one and the

\(^2\) 2001 PTC 727 (AP)

\(^3\) *T.V. Venugopal v. Ushodaya Enterprises Ltd.*, 2001 PTC 247(AP).
same. Thus, having regard to these facts and in the light of the decision of the Supreme Court in Cadila’s case, the plaintiff is entitled to claim that the defendant has infringed his copyright.”

It is submitted that the above observation of the court is wrong for the following reasons: Firstly, the Supreme Court case on Cadila is the one that laid down the principles for passing off remedy for trademark violation and not for copyright infringement. Therefore, the application of the ratio of this case in a case of infringement of copyright is to say the least, incorrect. Secondly, the test to be applied in a case of copyright infringement is the one laid down by the Supreme Court in R.G. Anand. According to this case the test to be followed is one of substantial copying without the application of independent skill, labour and judgment. It is unfortunate that the court missed this binding precedent. In the present case the court should have applied this test and found out whether the artistic work of defendant was a slavish copy of the work of the plaintiff. Instead of this the court applied phonetic and visual similarity test that is applied for trademark infringement. Thirdly, it is the fundamental principle of copyright law that the work protected must muster the minimum originality in the expression of the form. It is well accepted that there is no copyright on words, names characters, slogans etc. since it lacks the minimum originality requirement. The court also failed to apply this test in this case. There cannot be any copyright in the word EENADU. Different persons for creating different artistic works can use the same word. This seems to be the reason why copyright registration was granted to both the works. Applying the principles of copyright infringement the court could only prevent the use of the artistic work in the word and not the word per se. It is clear from the observation of the court that there are dissimilarities. If the artistic work of the defendant is not a slavish copy of the work of

14 2001 PTC 727 (AP) at p. 746.

15 Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. 2001 PTC 300.

plaintiff it is against law to conclude that there is copyright infringement since there is phonetic and visual similarity.

The Indian courts have recognized copyright protection for different persons for pictures-artistic work-of Gods and other personalities like Mahatma Gandhi. Thus, it is the mechanical reproduction of artistic work without the application of knowledge, labour, judgment, skill or taste that is prohibited under copyright law. It is true that a word that is not protected by copyright can enjoy protection as a trademark. In such cases it is the passing off law or principles of infringement of trademark that is to be applied to prevent the use of the word. Extending the principles of passing off remedy for copyright infringement can result in disastrous consequences. Copyright is available without registration not only in India but also in other countries. But trade mark protection is based on the principles of use of the mark in trade of goods or services in a territory. So it may not be possible for a person to get trade mark protection if there is no use of the mark but still possible to claim copyright protection. If this overlap is not correctly understood and applied by the courts it may lead to unfair advantages. In this case the trial court prevented the use of the mark by the defendants only in the State of Andhra Pradesh on the ground of passing off even though the injunction was sought against the use of the mark in the entire country. The division bench of the High court extended this on the ground that the copyright protection is available throughout India.

(b) Infringement of Copyright by Film Producers.

The asymmetry between film producers and authors of other protected works becomes accentuated when the author of dramatic or literary work has established infringement. This is so also because of the fact that “a film has a much broader perspective, wider field and bigger background” and it is always possible for the film maker to give “a colour and complexion” which distinguishes in many ways the story or dramatic theme from the film. The Supreme Court of India, testify to the considerable


18 2001 PTC 727 (AP) at p. 754-55. (Supra Note 13).
difficulties in this area, however, adopted in *R.G. Anand v. Delux Films*\(^\text{19}\) the doctrine of *dominant impact* even as regards this question. The test was formulated thus: “If the viewer after seeing the film gets a total impression that the film is by and large a copy of the original play, violation of copyright may be said to have been proved”\(^\text{20}\). There were a large number of similarities between the play and the film but the court held that similarities do not constitute infringement. As regards themes, the court found that the film dealt with the themes of provincialism, evils of a caste-ridden society and the evils of dowry whereas the play only dealt with the first theme. The court which heard the script of the play and saw the movie came to the conclusion that “from scene to scene, situation to situation, in climax and anti-climax, pathos and bathos, in texture and treatment and purpose and presentation is materially different from the play”\(^\text{21}\).

However, the decision was not entirely unanimous Justice Pathak (as he then was) did not think that there was any need for the court to examine “all the several themes embraced within the plot of the film” to decide infringement if “the treatment of the theme in the stage play has been made the basis of one of the themes in the film story and the essential structure of that treatment is clearly and distinctly identifiable in the film story.” The private can appropriate the labours of another by ensuring that “his own product … covers a wider field than the area included within the scope of the earlier product” and in “the common area covered by two productions to introduce changes in order to disguise the attempt at plagiarism”. Justice Pathak felt that it was not open for the Supreme Court to interfere with the findings of fact; but he indicated that were it so open he would have had no hesitation in holding that copyright was infringed on the facts of this case. He took pains to issue a clarification towards the end of his opinion which is worth reproducing in full:

“In another, and perhaps a clearer case, it may be necessary for this Court to interfere and remove the impression which

\(^{19}\) AIR 1978 SC 1613.

\(^{20}\) Ibid., at pp.1631-32.

\(^{21}\) Ibid., at pp. 1633-34.
may have gained ground that the copyright belonging to an author can be readily infringed by making immaterial changes, introducing in substantial differences, and enlarging the scope of the original theme so that a veil of apparent dissimilarity is cast around the work now produced. The Court will look strictly at not only blatant examples of copying but also at reprehensible attempts at colorable imitation”.22

One hopes against all hopes that film producers in India will heed this warning. More important, one hopes that the bar and the Bench will take due note of this viewpoint at a stage when factual determinations of infringement are made. Otherwise, judicial rectitude expressed by Justice Pathak might yet once again triumph over copyright justice. The formulation of criteria adopted by Justice Pathak really deserve to become operative law – a point that those engaged in the revision of copyright law ought to bear in mind. But for the present it would appear that film producers are virtually immune from the discipline of copyright law, as is poignantly illustrated by the decision. We now examine. A.L.S. Productions v. Jayalakshmi23 shows that even if an author of literary or dramatic work can successfully prove infringement, it may be very difficult for the author to get any of the effective civil remedies provided by the Act. The trial court had in this case awarded the author all available reliefs: first, the possession of infringing copies; second, damages for infringement; third, decree for proportion of profits earned by the film; and finally, a preventive injunction. The High Court reversed all the three first reliefs on grounds which betray not even a marginal sensitivity to copyright justice. Section 58 provides that the author shall be the owner of all infringing copies. But Section 2(m) excludes the reproduction of literary, dramatic, musical works in form of cinematograph films from its definition of infringing copies. The High Court conceded that the author of a literary work also had the right to made a cinema film under Section 14(a)(iv); and that the film owner had clearly plagiarised a key dramatic

22 Ibid.
23 (1972) 85 Mad. L.W. 58.
sub-plot in the literary work. But it took the view that Section 2(m) prevented it from ordering relief under Section 58.

The decision may appear technically correct but can be assailed on both exegetical and policy grounds. The definition and interpretation clause begins; typically, that the works defined therein shall have the meaning assigned to them “unless the context requires otherwise.” Section 58 in terms applies to “all infringing copies of any work in which copyright subsists.” The question then is for the purposes of Section 58: Is there any work in which copyright subsists and is infringed? If the answer is in the affirmative, the context requires that the term “infringing copy” be so interpreted as a copy that violates the subsisting copyright. Section 2(m) definition is not designed to frustrate the few effective remedies available for infringement of copyright; Section 58 provides one such remedy. If the definition is very strictly construed, even for purposes of a remedial or regressive section like Section 58, the result would be that the violator of valid copyright would remain the proprietor of works which violate copyright. And the author of a literary, dramatic and artistic work will never be in a position to take ownership of films which violate his copyright. Such result is not intended by the Act in view of explanation to Section 51 which clearly provides that for the purposes of the Section the reproduction of literary, dramatic, musical or artistic works in the form of a film shall be deemed an infringing copy. Given the approach of the Madras High Court in this very case, the only remedy would be a preventive injunction against exhibition, which may not be much of a remedy given the long delays in disposal of cases.

Of course, it is possible on a similar strict construction to argue that under Section(2)(m)(ii) the owner of copyright in a cinematograph work can also not avail of Section 58 remedy because an infringing copy of the film means only copy of the film or recording of its soundtrack. But if literary, dramatic or artistic works were made in a manner infringing the copyright of the film manner (owner), she too cannot effectively urge that she is the owner of infringing copies. In practice, it is more likely that the film maker will plagiarise from other genres of work rather than vice versa. But in theory Section 58 process would remain applicable only to the same classes of work but not across different classes of work provided by the statute. Notionally, and in reality, this
limitation of Section 58 remedy, which enhances inhibition against easy infringement, should remain available in all situations.

The High Court also reversed the award of damages. It seems necessary in Indian law, as in English law, for the author to prove the infringement value of copyright in order to successfully claim damages. The High Court reversed the trial court’s ruling awarding a damage of Rs. 2500 despite the finding of infringement. The petitioner, said the court, was not able to prove any actual damage nor was even able to suggest the manner in which the damage should be evaluated. A general statement that she had suffered a mental setback at piracy was not considered adequate. What is strange is that the decree for Rs. 10,000 awarded to her was also set aside by the High Court on the ground that the petitioner was unable to prove the “proportion of profits made by the film … attributable to profits made through the infringement of her copyright”. The court even held that there was no evidence to show “that the side plot did at all account for any part of the profits of the appellant”; there was, therefore, no rational basis even for apportioning profits. This aspect of the decision provides in our view a good example of “mechanical jurisprudence” and merrily sacrifices the rights of the author at the alter of the law of pleadings.

The Bombay High Court (per Jamadar J.) in the Kamala case\(^{24}\) seems to have continued this trend. The case is unusual both for its facts and the law it seems to have generated. In late April – early May of 1981 the Indian Express carried a series of shocking stories concerning flesh trade in the state of Madhya Pradesh; its team of reporters actually bought a young girl named Kamala on payment of Rs. 2,300 for “half the price one pays for a buffalo in Punjab”. Vijaj Tendulkar, among India’s foremost playwrights, adopted the story in a play which was staged “about 150 times in 32 cities in 7 languages”. The script of the play was published in book form and was on sale. Apart from the issue of libel successfully urged by the plaintiffs against the film maker, it appears that the case raised a question of, as it were, double infringement of the copyright of the newspaper. Interestingly, the playwright denied having read the articles

in the *Indian Express* but acknowledged having read similar stories in a leading fortnightly *India Today*; the film maker admitted having read the newspaper articles but claimed that the film was an adaptation of the play. Did then the play infringe the ‘copyright’ of the newspaper and the film infringe that of the playwright? The court ruled, following *Anand*, on the one hand that there cannot subsist any copyright in “ideas, information, natural phenomena and events” which are common property and on the other that the film significantly differs (as it almost always does) from the newspaper articles, assuming that these provided “the materials on which one claiming the copyright has worked”. On the first proposition, one well settled in copyright jurisprudence, there is, of course, not much room for criticism. But on the second the formulation for holding infringement of copyright as “misconceived” does afford plenty of room for anxiety. For, the learned single judge holds, in so many words, that:

> The form, manner or arrangement of a drama and movie are materially different from a newspaper article and by very nature of the media there is a fundamental and substantial dissimilarity in the mode of expression of the idea in a newspaper article and in a state play or in a movie”.

This “nature of media” test, if one may so call it, makes it virtually impossible the task of proving what the court earlier calls the distinction between “the materials upon which one claiming copyright has worked and the product of the application of his skill, judgement and labour and literary talent to these materials”. If it is the nature of the media which determines the *prima facie* claim of validity of the plea of infringement no further enquiry into similarities or dissimilarities is relevant. Indeed, given this orientation, any purported enquiry would, as happens in Indian decisions, simply end up in a massive demonstration of dissimilarities.

(c) **Infringement of Copyright by Importation.**

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25 Ibid., at p.233.
Copyright in a work is infringed by anyone who imports into India any ‘infringing copies’ of the work. The only exception permitted is the importation of not more than one copy of the work for the private or domestic use of the importer. Infringing copy means in this context a copy or reproduction of the work made or imported in contravention of the provisions of the Act. The question that can arise, and has in the past in fact arisen, is: can an exclusive licensee for publishing a copyright work in India prevent import of copies of the work lawfully made in any other country, say, by the owner of the copyright himself or by his assignee or licensee, on the ground that such importation would amount to an infringement of the copyright of the work? Does such import constitute an import of an ‘infringing copy’ and, as such, an infringement by importation? These questions have been answered in the affirmative by the Delhi High Court in *Penguin Books Ltd. England v. M/s. India Book Distributors,*26 while allowing an appeal from an interlocutory order denying interim injunction. This decision of the Delhi High Court accords with the Australian and English decisions in similar cases, though the language of the Indian statute is not on all fours with the copyright statutes of those countries. It has been opined that the question of parallel imports has to be viewed from the perspective of our national self-interest and when so viewed this judgement is not in the interest of Indian reader who must get books at lower prices. This question must be considered by experts and a policy decision reached.

The curb the growing menace of unauthorised videographic reproduction of copyright cinematograph films, video films are now specifically brought within the definition of ‘cinematograph films’ as works produced by a process analogous to cinematography. It is now required in case of video films that the following particulars must be displayed on the video cassette or other container when the film is exhibited, named: (i) if the video film is made of a cinematograph film which is required by the *Cinematograph Act 1952* to be certified for exhibition, a copy of the certificate granted by the Board of Film Certification; (ii) the name and address of the person who has made the video film and a declaration that he has obtained the necessary licence or consent for making the video film from the owner of the copyright in the work in respect of which

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26 AIR 1985 Del. 29 (DB).
the film is made; and (iii) the name and address of the owner of the copyright in the work in respect of which the video film is made. Contravention of this requirement is made punishable with imprisonment of up to three years and with a fine.

In *State of Andhra Pradesh v. Nagoti Venkataraman*, the Supreme Court held that keeping in view the object underlying Sections 52A and 68A of the Act, it would be infringement of copyright, if the particulars on video films etc. as mandated under Section 52A are missing. The absence of the evidence of the owner of the copyright does not constitute lack of essential elements of copyright. However, in the instant case, the Supreme Court after holding the accused guilty changed the sentence of six months imprisonment and fine of rupees three thousand imposed by the trial court as upheld by the sessions court to only fine of rupees ten thousand, as it felt that the punishment by way of fine only would meet the ends of justice.

To deter people from making unauthorized reproduction of copyright sound recording, it is now mandatory that the following particulars must be displayed on the sound recording and on any container thereof when the sound recording is published, namely (i) the name and address of the person who has made the sound recording (ii) the name and address of the owner of the copyright in such work and the year of its first publication. Contravention of these requirements is made punishable with imprisonment of up to three years and with a fine.

**V. 2. Remedies for Infringement of Copyright.**

Under the *Copyright Act 1957* both civil and criminal remedies are available against infringement of copyright. In the case of innocent infringements some of these remedies are not available.

(i) **Civil Remedies.**

Sections 54 to 62 of the *Copyright Act* provide civil remedies. As per Section 55 of the Act in the case of infringement of copyright “the owner of the copyright shall,
except as otherwise provided by this Act, be entitled to all such remedies by way of injunction, damages, accounts and otherwise as are or may be conferred by law for the infringement of a right”. Thus an owner of Copyright28 is entitled for all such civil remedies like injunction, damages, accounts and other remedy conferred by law.

a. Injunctions.

The main remedy sought in most Copyright suits is an injunction to restrain the defendant from continuing to do acts which constitute infringement29. It is the only remedy available against a defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that copyright subsisted in the work (the innocent infringer).30 The plaintiff cannot recover damages in such cases, though the court may order the defendant to pay the plaintiff the whole or part of the profits made by him by the sale of the infringing copies as it may consider reasonable in the circumstances. The law relating to injunction is contained in the Specific Relief Act, 1963. Invariably in such actions a temporary injunction is sought to restrain the defendant from continuing to infringe the copyright of the plaintiff pending disposal of the case (pendente lite), since damages are rarely an adequate remedy for the injury suffered by the plaintiff. Also an ad interim injunction ex-parte pending service of notice of the suit is usually sought. As at this stage the parties have yet to adduce evidence in support of their respective claims, the court has to proceed on the prima facie situation, the probabilities of the case and the balance of convenience in granting or denying an

28 According to Section 54 of the Copyright Act 1957 “the expression “owner of copyright” shall include –

(a) an exclusive licensee;

(b) in the case of an anonymous or pseudonymous literary, dramatic, musical or artistic work, the publisher of the work, until the identity of the author or, in the case of an anonymous work of joint authorship, or a work of joint authorship published under names all of which are pseudonyms, the identity of any of the authors, is disclosed publicly by the author and the publisher or is otherwise established to the satisfaction of the Copyright Board by that author or his legal representatives.”

29 The Copyright Act 1957, Section 55(1).

30 Ibid., Proviso to Section 55(1).
interim injunction. The principles laid down in English precedents are frequently relied upon and followed in India. The law governing interlocutory injunctions is contained in the Civil Procedure Code, 1908, Order 39, Rules 1 and 2. It is, however, expressly provided that the remedy of injunction is not available to restrain the construction of a building or other structure which infringes, or which if completed would infringe, the copyright in some other work after the construction has been commenced, or so as to require the building to the extent constructed to be demolished.\textsuperscript{31}

Now the question arises what are the principles are to be followed in granting an injunction in case of infringement of copyright? In a suit for permanent injunction while the court is considering interlocutory application, the court is not called upon to decide the real dispute between the parties. The court is called upon to see whether the party who has approached the court has a plausible case and whether there is a possibility of such case succeeding at the trial. If that test is satisfied then it is the duty of the court to see whether the damages the plaintiff is likely to suffer for the action of the defendants complained of can be compensated in money and if so whether there is a standard of ascertaining such compensation. If such compensation can be ascertained and afforded in money then the interlocutory order of injunction should normally be refused. But if on the other hand, the court is of the view that such compensation cannot be compensated and ascertained in money then it is the duty of the court to see the balance of convenience in connection of the parties. If the balance of convenience is in favour of plaintiff then the court shall normally issue an interlocutory order of injunction upon undertaking of the plaintiff to compensate the defendant against whom the order of injunction is passed if at the trial, it is held that the plaintiff is not entitled to such permanent injunction. On the other hand, if it is found that the balance of convenience is against passing such order, the court will normally refuse to pass interlocutory injunction. It is also duty of the court to preserve \textit{status-quo} as far as practicable dealing with such a matter.\textsuperscript{32}

\textsuperscript{31} Ibid., Section 59(1).

\textsuperscript{32} Gramophone Company of India Ltd. v. Santi Films Corporation Ltd., AIR 1997 Cal 63 at p.74.
The need for specific pleading in the plaint on the allegations that the case of the plaintiff will fall within the scope of a particular Section in the Act was insisted upon by the Supreme Court in *Gramophone Co. of India Ltd. v. Mars Recording Pvt. Ltd.*\(^\text{33}\). In this case the respondent-plaintiff after complying with the formalities under Section 52(1)(j) of the *Copyright Act* started making audio cassettes of the musical works owned by the Gramophone Company. Faced with threats of seizure of cassettes through the police from the owner of copyright, the plaintiff filed a suit for injunction preventing appellants-defendants from interfering with the production and sale of cassettes. The lower court granted the injunction and the same was approved by the High Court\(^\text{34}\). On appeal the Supreme Court set aside the order on the ground of absence of specific pleading and observed:

“To attract the provisions of Section 52(1)(j) of the Act or to fall outside the scope of Section 2(m) of the Act it is necessary to plead and establish these aspects of the case as contended for respondent No.1, Before we examine the tenability of the contentions raised, we think it necessary that the parties shall lay factual foundation in the pleadings. If, as contended for respondent No.1. these aspects bring out the true controversy between the parties and there are no pleadings to that effect in either form or content, to proceed to grant any temporary injunction or to decide the matter will be hazardous. Therefore, we set aside the order made by the High Court affirming the order of the trial court granting temporary injunction. It is open to the parties to raise appropriate pleadings by amendments or otherwise. We also

\(^{33}\) 2001 PTC 681(SC)

\(^{34}\) *Gramophone Co. of India v. Mars Recording Pvt. Ltd.* 2000 PTC 117.
make it clear that it is open to the parties to seek appropriate interim orders after amendment of pleadings”.\textsuperscript{35}

From the reported judgment it is worth noting that there is no evidence to show that the defendant has raised this contention before the Supreme Court or before the lower courts.

b. **Damages and Account of Profits.**

Besides the injunction, Section 55 of the *Copyright Act* provides remedies of damages and accounts. However, the remedy of injunction can be joined either with that of damages or accounts, but the remedies of accounts and damages can in no case be joined\textsuperscript{36}. Thus in a suit for infringement of copyright, the publishers of a book sought relief of injunction against the producers and distributors of the picture which filmed the theme of the book to restrain the screening of the picture any further. The publishers claimed the relief of accounts as well as of damages. No complaint was filed by the publishers about adequacy of damages and the decree of damages became final. The Andhra Pradesh High Court dismissed the appeal and held that it could not be said that injunction was not the appropriate remedy. Further, since damages were awarded and the decree of damages became final, the publishers were not entitled to the relief of accounts. The court further held that the remedies of damages and accounts are remedies in the alternative and the two reliefs are incompatible\textsuperscript{37}.

The calculation of damages in case of infringement of copyrighted work is a controversial issue. The formula for calculation of damages in cases where the copyright work is not priced and the award of exemplary damages came for consideration in *P.N. Krishnan Murthy v. Co-operative for American Relief Everywhere*\textsuperscript{38}. In this case the

\textsuperscript{35} 2001 PTC 681 AT P.686.

\textsuperscript{36} *Pillalamarri Lakshmikantan and others v. Ramkrishna Pictures*, AIR 1981 AP 224.

\textsuperscript{37} Ibid.

\textsuperscript{38} AIR 2001 Del 258.
plaintiff-appellant is the author of the story *Lakshma Kills A Tiger* and the registered owner of copyright from 1969. Under licence the story was converted into a comic booklet by *Care* for children in many languages and published through CAP a publication unit owned by the plaintiff. In 1970 *Care* under licence from the plaintiff contracted CAP for the publication of 15 lakh copies of the same story in Malayalam. But CAP terminated this contract because of difference of opinion. *Care* with the help of another publisher published the book and circulated it free to the children in Kerala. The plaintiff filed the present suit for infringement of copyright in 1971. Though the trial started in 1972 and the plaintiff completed his evidence in 1973 it took many years for the defendant to complete the evidence. The defendant could not produce any evidence regarding the accounts and the records available at New York were reported to have been destroyed. The district court finally in 1998 (after 27 years) found that there was infringement of copyright granted injunction and awarded 17.50 per cent of the cost of the publication of one copy of the book i.e, a total of Rs. 2,31,000/- with 18 per cent interest from the date of suit for damages. Both the parties appealed to the High Court. The defendants contended that there was no copyright violation since the work was created under employment. Since there was no evidence produced by *Care* to show that there was a valid assignment of right for the translation of the work in Malayalam and based on the evidence on record, the High Court concluded that there was copyright infringement. Regarding the contention of the plaintiff on the calculation of damages, the court after considering the fact that the book was not priced or sold in the market but freely distributed in Kerala State and also that the plaintiff could not prove his actual loss of profit, accepted the formula adopted by the trial court and observed:

“The trial court has taken the cost of publication of the book at Rs. 1/- and has awarded 17.50% of the same to the plaintiff .... We are conscious of the argument of the plaintiff that 17.50% of this cost which is taken as the basis by the trial court was the amount which the plaintiff would have received had there been printing and publication of the book in question by the plaintiff as per the contract dated 15th September, 1970 and the plaintiff is not claiming the said
cost but is claiming damages on account of infringement. However, the absence of any other yardstick, even for the purpose of damages we consider 17.50% of the cost as reasonable particularly when the book is not a priced one and royalty in the normal course would be attracted on the basis of the price of the book. Therefore, we feel that if the plaintiff is given 17.50% of the cost and if the cost of printing and publication of the book is taken as Rs. 1/- that would be an adequate compensation to the plaintiff”.

The court found that 9,847 million copies of the book were published and circulated. Based on this the court calculated Rs. 16,92,950/- as damages. It was also contended by the plaintiff that the defendant deliberately delayed the suit at the trial court for a period of more than 25 years and on that ground claimed for exemplary damages. Rejecting this the court opined:

“No doubt conduct of the Care during the proceedings before the trial court has not been proper. However, one has to keep in mind that the project in question for which the book was to be distributed and in fact distributed to the poor children was a benevolent project of public service. The books were distributed free of cost to the children and therefore, we do not deem it fit to grant any exemplary damages against the defendants”.

The court seems to be benevolent to an intentional organization who has not only deliberately violated the copyright of an author but also with all its financial might fought the case at the lower court for a period of 27 years harassing the author monetarily and mentally. This seems to be a fit case to award exemplary damages to send a clear message that be it for charitable purpose or not the parties that too financially sound should not abuse the process of law that too in case of intellectual property infringement.

c. **Other Remedies (Anton Piller Orders, Mareva Injunctions etc.).**
Besides the above stated remedies, Section 55 of the Act recognises other remedies "as are or may be conferred by law for infringement of a copyright", like, *Anton Piller Orders, Mareva Injunctions* etc. In England the High Court has jurisdiction on an application made to the court by a plaintiff *ex parte* and in *camera* to make a mandatory order requiring a defendant to permit the plaintiff and his representative to enter the defendant's premises, as specified in the order, to inspect articles and documents relevant to the proceedings and to remove them or take copies of them and even to take proceeds of the infringing articles\(^{39}\). This form of an order originally made under the court's inherent jurisdiction by Lord Denning in *Anton Piller KG v. Manufacturing Processes Ltd.*\(^{40}\) has now received recognition in the TRIPs Agreement\(^{41}\). The order is not a search warrant. It has repeatedly been clarified by Lord Denning in *Anton Piller KG* that the order is not a research warrant; the order only authorizes an inspection by permission of the defendant. Entry without his permission would be a trespass. The defendant is, however, ordered by the court in *personam* to give his permission with the result that, if he does not do so, he is in contempt of court, but the plaintiff is still not entitled to enter in the absence of permission.

The *Anton Piller Order* is only to be made in the most extreme circumstances for the form of the order is drastic and its aftereffects are far reaching. It involves serious inroads on the principles of personal freedom, such as presumption of innocence, the right not to be condemned unheard, protection against arbitrary searches and seizure, and privacy. It is at the extremity of the court's powers and is frequently accompanied by


\(^{40}\) (1976) Ch. 55 (In short "Anton Piller Order")

\(^{41}\) TRIPs Agreement contains a similar provision to “Anton Piller Order” under Paragraph 2 of Article 50. As per the Paragraph 2 the judicial authorities must be empowered, where appropriate, to adopt provisional measures without the defendant being (*inaudita altera perte*), in particular where delay is likely to cause irreparable damage to the right holder or where there is a demonstrable risk of evidence being destroyed. This is similar to *Anton Piller Order* followed in the United Kingdom and other commonwealtb counties, whose purpose is to preserve the evidence by preventing the destruction or concealment of evidence by an alleged wrongdoer.
a *Mareva Injunction*\(^{42}\) which prevents a defendant from taking action, such as disposal of assets, designed to frustrate subsequent orders of the court in favour of the plaintiff. As in the case of *Anton Piller Orders*, there are now standard forms of *Mareva Injunction* for use in the Queen’s bench and Chancery divisions of the High Courts. The combination of the *Anton Piller Order and Mareva Injunction* has the effect of destroying a defendant’s business without the defendant being in a position to set the order aside before it is executed\(^{43}\). They have become the ultimate weapons to combat copyright piracy.

The justification for the exercise of this exceptional jurisdiction is: that on the facts of the particular case, it is essential that the plaintiff should have inspection, so that justice can be done between the parties where there is a grave danger, that if a defendant is forewarned, he may destroy evidence of vital importance in the litigation, or conceal from the court and from the plaintiff such evidence, or that the evidence may be lost or taken out of the jurisdiction, depriving the plaintiff of his remedy and thereby defeating the ends of justice. The following three conditions must be satisfied before the court will make an order:

(i) the plaintiff must show that he has an extremely strong *prima facie* case;

(ii) the plaintiff must show that he has suffered, or is likely to suffer very serious and irreparable damage, if an order is not made; and

(iii) there must be clear evidence that the defendant has in his possession incriminating documents or things and that there is a real possibility that he may destroy such material before any *inter partes* application can be made on notice.

The court proceeds on the basis that the overwhelming majority of people will comply with its order as to production and delivery of documents. In order to safeguard the defendant, the order expressly limits the persons who are entitled to inspect, defines

\(^{42}\) *Mareva Compania Naviera v. International Bulk Carriers SA* (1980) 1 All ER 213.

\(^{43}\) Jonathon Rayner James and Gillian Davies (Ed.), *Copinger and Skone James on Copyright*, (Vol.1) Sweet and Maxwell, 1999 at p.1040.
the premises which can be inspected and specifies the purposes for which the inspection is allowed. For example, the order provides that it is to be served and carried out in the presence of a supervisory solicitor who is experienced in the working of Anton Piller Order and who is wholly independent of the plaintiff and his solicitor. It is the supervising solicitor's duty to ensure that the order is carried out with meticulous care and he can give reliable evidence on what happens on execution of the order. He should identify the other representatives of the plaintiff and his solicitors to the defendant and must give the defendant an opportunity of considering the order, consulting his own solicitor and applying to the court to vary or discharge the order. He should prepare a full report on what took place and send a copy to the plaintiff’s solicitors and to the judge who made the order for the purposes of the court file. Further safeguards for the defendants are set out in the practice directions and can be seen in the body of the draft order prescribed by the court.

Prior to the new form of Anton Piller Order the position was that while the order stood, a defendant who refused access to his premises was in default of the order and ran the risk of committal to prison, even if his refusal of consent was his intention to apply to have the order discharged. However, if that party succeeded in getting the order discharged, it was unlikely that he would be held guilty for any breach of the order while it subsisted. The new form of order now provides for the position to be held while an application is made for discharge of variation and a defendant who simply refuses access without availing himself of those provisions is likely to face severe penalties for contempt, even if he manages to persuade the court that he intended to apply to set aside the order.

The court may be persuaded to discharge an Anton Piller Order on the grounds of non-disclosure and order costs to be awarded on an indemnity basis with immediate taxation. The court will be within its right to consider the following, amongst other, relevant factors, while considering an application for discharge:

(i) Whether an injustice has been caused to the defendant;
(ii) In considering the question the court should have regard to all the evidence on the application to discharge, including the result of the execution of the orders.

The owners of the protected works in India too, more particularly in cinematograph films and sound recordings, have been seeking orders similar to Anton Piller Orders and Mareva Injunctions against pirators in ‘sound recordings’, ‘cinematograph films’ and ‘video recordings’. In view of rampant video and record piracy in India, it is necessary to statutorily provide for these powerful procedural weapons in the armoury for copyright protection. In Buegrus Europe Limited V. Vwean Industries Eng. Co.44 the Calcutta High Court examined the scope and validity of the Anton Piller45 type ex parte orders issued in India. The plaintiff filed a suit for infringement of the copyright in his artistic design and requested for ex parte temporary injunction and recovery of records. This was refused by the lower court and on appeal the single bench of the High Court passed an interim ex parte injunction. The court also appointed a special officer of the court authorising him to enter into the premises of the defendant as mentioned in the cause title and any other premises within the power and control of the defendant and to inspect the same and seize all goods, papers, documents, challans and invoices showing orders of the products. The period of the order was for 14 days and the court directed the plaintiff to issue notice to the defendant. It was contended by the defendant that the order was obtained by misrepresentation since the design was registered and the cancellation proceedings is pending. It was also contended that the design was in practice for a period of ten years. According to the defendant as per section 15 of the Copyright Act once the design was registered there was no protection for the same under the Copyright Act and in this context the order of search issued for violation of copyright needed to be cancelled. The plaintiff relied on Anton Piller orders

44 2005 (30) PTC 279. See also CISOCO Technologies v. Shrikanth, 2005 (31) PTC 538 (Del.).

and argued for the continuation of the orders. After examining various cases based on *Anton Piller* the court concluded:

> “Going by the aforesaid well-settled principles this court holds that there was lack of bonafides and good faith in the pleadings on the basis of which an ex parte order of injunction on the line of *Anton Piller* was obtained from this Court. From the discussion made in the earlier part of this judgement it is clear that utmost good faith of the plaintiff is the condition precedent from granting an injunction on the lines of *Anton Piller*. Admittedly good faith on the part of the plaintiff is lacking. The Court at an ex parte stage accepted the pleading to be true and correct and passed the order. But if there had been a full disclosure of facts, the Court might not have passed the order. That the pendency of cancellation is a relevant fact and cannot possibly be disputed”.

The court refused the injunction and directed the plaintiff to pay a cost of 2000 GMs to the Calcutta High Court Legal Services Authority. This case clearly indicates the possibility of the abuse of the *Anton Piller* type orders in India. It is important to note that in England the courts had a tough time and finally the legislature intervene to regulate the abuse of the order by the plaintiff. In the context of increasing demand to use *Anton Piller* type orders in India it is important that the Indian courts keep these developments in mind and issue orders only in clear cases that too with sufficient preconditions to protect the interest of the defendants so that abuse of the order could be limited.

**d. Specific Remedy in the Case of Threat.**

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The above stated remedies are available in the case of infringement of copyright. Besides this there are certain remedies available in the case of groundless threat of legal proceedings under Section 60 \(^{48}\) of the *Copyright Act 1957*. The provisions of Section 60 make it clear that if a person is threatened with any alleged infringement of copyright and if, in fact, the actions of the persons threatened do not constitute any infringement of the legal rights of the person who makes such threats, he can file a declaratory suit and obtain an injunction against the continuance of such threats. He can also obtain damages which he may have sustained by reason of such threats. These provisions are designed to protect a person against any wrongful threats relating to infringement of copyright and the only relief which can be asked for is an injunction against the continuance of such threats and damages occasioned by reason of such threats. The proviso to this Section makes this provision amply clear because it provides that this Section will have no application if a person, who has made such threats, commences and prosecutes with due diligence an action for infringement of the copyright claimed by him. Once a suit is filed for infringement of the copyright by the person who has given the threat, the suit under Section 60 becomes infructuous as the Section ceases to apply in such a situation.\(^{49}\)

e. **Jurisdiction of Court.**

\(^{48}\) Section 60 of the *Copyright Act 1957* reads: “Remedy in the case of groundless threat of legal proceedings – Where any person claiming to be the owner of copyright in any work, by circulars, advertisements or otherwise, threatens any other person with any legal proceedings or liability in respect of an alleged infringement of the copyright, any person aggrieved thereby may, notwithstanding anything contained in Section 34 of the Specific Relief Act, 1963 (47 of 1963) institute a declaratory suit that the alleged infringement to which the threats related was not in fact in infringement of any legal rights of the person making such threats and may in any such suit –

(a) obtain an injunction against the continuance of such threats; and

(b) recover such damages, if any, as he has sustained by reason of such threats:

Provided that this Section shall not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of the copyright claimed by him”.

\(^{49}\) *Super Cassette Industries Ltd. v. Bathla Cassettes India (P) Ltd.*, AIR 1994 Del 237.
Now question arises in which court the suits or other civil proceedings are to be instituted in the case of infringement of copyright? A suit or other civil proceedings relating to infringement of copyright can be initiated in the 'District Court' having jurisdiction under Section 62(1) which enables the copyright owner to sue for infringement in the District Court within whose jurisdiction he actually and voluntarily resides or carries on his business or personally works for gain and not necessarily where the infringement occurred. This is a special jurisdictional provision for the protection of copyright owners which was not available to a trademark owner or patent owner. But now in the Trade Marks Act 1999 a similar provision has been incorporated. It is legally permissible for a trade mark owner to claim protection for his trade mark under the trade marks legislation but also copyright protection for the words or device in his trade mark label. It has, therefore, become common practice to get trade mark labels registered in the copyright register. In infringement actions where protection both under the Copyright Act as well as the Trade Marks Act/passing off action is sought, the issue relating to jurisdiction has resulted in conflicting decisions which will be investigated in detail during my research.

In Surendra Kumar Maingi v. M/s. Dodha House, a suit for infringement of trade mark and copyright of the mark Maingi’s Todha with the label and wrapper of the plaintiff by the defendant was filed in Ghaziabad where the plaintiff carried on business. The jurisdiction of the Ghaziabad Court was challenged on the basis of Section 105 of the Trade & Merchandise Mark Act 1958 by the defendant since he was carrying on business in Faridkot and not in Ghaziabad. It was contended by the plaintiff that since the suit was also for infringement of copyright, the Ghaziabad Court had jurisdiction under Section 62 of the Copyright Act. This contention was rejected by the court after relying upon the judgements of the Punjab & Haryana High Court and Delhi High Court

50 Section 62(2) of the Copyright Act 1957.
51 Section 134(2) of the Trade Marks Act 1999.
52 AIR 1998 All 43.
in *H.P. marketing and Processing Corporation v. M.M. Breweries*\(^5^3\) and *C.B. Dembla Trading v. Bharat Sewing Machine Co.*,\(^5^4\) respectively where a common view was taken by both courts that for joinder of suits the court must have jurisdiction to try both cases. However, thereafter Delhi High Court has taken a contrary view in *P.H. Diesels Ltd. v. M/s. Patel Field Marshal Industries*,\(^5^5\) where the court held that the joinder of suit was necessary to avoid conflicts of decisions, even though the court had no jurisdiction in one case. The question remained open whether the plaintiff should be extended the benefit of Section 62(1), when his action is at the core to enforce his trade mark rights. However, the new provision in the *Trade Mark Act, 1999* has resolved this conflict.

In *Arte Indiana v. Mittulaul Lalah*\(^5^6\) the division bench of the Bombay High Court examined the question whether actual infringement must take place within India for a court to invoke jurisdiction for copyright infringement. In this case the plaintiff field a letters patent appeal to invoke the original jurisdiction of the court to jointly sue the defendant for copyright and trade mark violation. The defendant was exporting from Madras to Kuwait products violating the copyright and trade mark of the plaintiff. The plaintiff staying in Mumbai filed the suit under Section 62 of the *Copyright Act* at the Mumbai Court. It was argued that since the infringement was taking place at Kuwait and not within the jurisdiction of any court in India, the Mumbai court had no original jurisdiction as per the provisions of the letters patent. Since copyright and the jurisdiction to file infringement suit at the place of residence of the plaintiff are creation of separate statutes the single bench held that to invoke original jurisdiction there must be actual infringement within the jurisdiction of the court. On appeal the division bench referring to clause 14 of letter patent reversed this and observed:

“A bare reading of the aforesaid clause shows that the accrual of the cause of action within the territorial jurisdiction

\(^{53}\) *AIR 1981 P & H 117.*

\(^{54}\) *AIR 1982 Del 230.*

\(^{55}\) *AIR 1998 Del 225.*

\(^{56}\) *2000 PTC 140.*
of this Court is not contemplated to permit joinder of cause of action. Clause 14 only contemplates that this Court shall have original jurisdiction in respect of one of such causes of action to permit two separate cause of action being combined together in one suit”.

Similar view was taken by the Delhi High Court also in earlier cases⁵⁷.

(ii). Criminal Remedies.

a. Statutory Scheme.

Sections 63 to 70 of the Copyright Act 1957 deal with the criminal remedies. The Act makes it an offence for any person knowingly to infringe (a) the copyright in a work or (b) any other right conferred by the Act (e.g., broadcast reproduction right; author’s special rights), or knowingly to abet such infringement⁵⁸. It is, however, clarified that the construction of a building or other structural work which infringes or which, if completed would infringe the copyright in some other work is not an offence under the Act.⁵⁹ The Act now provides for minimum punishment, though the court is given power to impose a lesser punishment for adequate and special reasons to be mentioned in the judgement. The punishment increases for the second or further conviction⁶⁰. Further, it is an offence knowingly to make, or be in possession of any ‘plate’ for the purpose of making ‘infringing copies’ of any work in which copyright subsists. The Act also provides for offences in relation to the register of copyrights kept under the Act and for false representations made for the purpose of deceiving or influencing any authority of

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⁵⁸ The Copyright Act 1957, Section 63.

⁵⁹ Ibid., Explanation to Section 63.

⁶⁰ Ibid., Section 63.
The Amendment Act has also widened the powers of the police. It empowers any police officer, not below the rank of a sub-inspector, if he is satisfied that an offence of infringement of copyright in any work 'has been, is being, or is likely to be' committed, to seize without warrant, all infringing copies of the work 'wherever found'. He is thereupon required to produce before a magistrate all copies and plates so seized as soon as practicable. The court trying the offence is empowered to order, whether the accused is convicted or not, that all copies of the work or all plates in the possession of the accused, which appear to the court to be infringing copies or plates for making infringing copies, be delivered up to the owner of the copyright.


There have been very few prosecutions under the Act and the cases that have gone to Appellate Courts show that the High Courts do not view criminal prosecution for infringement of copyright with due seriousness as is reflected in judgements of Delhi High Court and Bombay High Court in Siaram Silk Mills v. State and Gulfam Exports and Others v. Sayed Hamid respectively. In Sitaram Silk Mills, based on the complaint of the owner of the copyright a prosecution was initiated for copyright infringement under Section 63 of the Copyright Act and the trade mark infringement under Sections 78 and 79 of the Trade Marks Act 1958 read with Sections 420, 489 and 486 of IPC. A search was conducted in pursuance of the directions of the magistrate and infringing goods were seized. The magistrate also took cognizance of the offence. However, a petition was filed before the High Court under Section 482 of Cr. P.C. for compromise of the criminal case. The court after identifying the party’s role observed thus:

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61 Ibid., Section 67 and 68.
62 Ibid., Section 64.
63 Ibid., Section 66.
64 (2001) PTC (21) 600 (Del).
65 2000(20) PTC 496.
"In view of the above no useful purpose would be served by permitting the above complaint and proceedings to continue. Accordingly, the petition is allowed. The above noted FIR and the proceedings emanating therefrom are quashed, subject to the payment of Rs. 10,000/- as costs to the Legal Aid and Advice Board, Patialal House. Petition stands disposed of."  

The offence under Section 63 being one punishable with a maximum of three year imprisonment and a fine of Rs. 2 lacs, with a minimum of six months imprisonment and a fine of Rs. 50,000/-, the order seems not proper exercise of the power under Section 482 Cr P.C. Such approach on the part of the court defeats the intention underlying the amended provisions of 1984 which were intended to make it clear that the infringement of copyright is a serious offence and needs to be dealt with sternly. This only shows that the attitude of the court still is to treat copyright infringement a civil wrong rather than a serious offence.

Earlier, in Gulfam Exports\textsuperscript{67}, the Bombay High Court was also reluctant to invoke criminal jurisdiction while a civil suit was pending. In this case the respondent, the owner of copyright, filed a private complaint in the court of the magistrate in 1991 alleging violation of copyright and after enquiry by the police, process, was issued to the petitioner. The petitioner filed petition for quashing of the process on the ground that the copyright was not registered and a civil suit was pending. Even after repeated notice, the respondent did not appear in the matter. The court after hearing the petition concluded that the complaint must be quashed since the copyright was not registered and the civil suit was pending and that there was delay in filing the criminal case. The unusual reasons given by the court were:

"The complainant had already gone to the Civil Court and the matter is pending at appellate stage in this Court. The interim order of injunction was already running against the petitioners"

\textsuperscript{66} (2001) PTC (21) 600 (Del).

\textsuperscript{67} Gulfam Exports & Others v. Sayed Hamid, 2000(20) PTC 496.
when the matter was in the trial court and the suit was already decided in favour of the complainant in the Civil Court and the petitioners are still debarred from using the disputed trade mark ... In the context of aforesaid facts I am of the view that, it would be in the interest of justice that the complaint should be quashed and set aside”. 68

It seems, the court did not correctly appreciate the scheme underlying the provisions of the Copyright Act regarding registration and that the legislature in its wisdom has treated infringement of copyright not only a civil wrong but also a serious criminal wrong. The registration is not mandatory for claiming copyright protection under the Act and the existence of civil remedies is not a bar for criminal prosecution. The offences under the Copyright Act are cognizable offences and, therefore, need to be sternly dealt with.

In State of Andhra Pradesh v. Nagoti Venkataramana, 69 the Supreme Court examined the need to identify the owner and prove the ownership of copyright before convicting the accused for an offence under the Copyright Act. The inspector of police Tenali, Guntur district of Andhra Pradesh, in one of his regular raids, seizes 90 video cassettes of various films in Telugu, Hindi and English from the video library of the accused and charged him for an offence under Section 52A read with Section 63 of the Copyright Act. He was convicted by the lower courts. On appeal, the high court acquitted him on the ground that the owners of the film were not identified and the prosecution failed to adduce evidence to prove the ownership of the film. The Supreme Court on appeal examined the question whether the identification of the owner of the copyright was a precondition for the conviction of an offence under the Act. The court after examining various provisions in the Act dealing with punishment found that the objective of introducing Section 52A was to prevent piracy of cinematograph film and

68 Ibid., at pp.500-501.

69 22 1PLR 123 (1979)
sound records and protect the interest of the owner of copyright and the public\textsuperscript{70}. The Act mandates the punishment of the accused in case of violation of the provisions. In this context the court rejecting the contention that the identification of the owner of copyright was a precondition for conviction under the Act observed thus:

"In view of the finding of the courts below, the offence would fall under Section 68A of the Act. It would, therefore, be unnecessary for the prosecution to track on and trace out the owner of the copyright to come and adduce evidence of infringement of copyright. The absence thereof does not constitute lack of essential elements of infringement of copyright. If the particulars on video films etc., as mandated under Section 52A do not find a place, it would be infringement of copyright".\textsuperscript{71}

The court is correct in its conclusion. If one examines the scheme of criminal law, it is clear that any one can initiate a criminal prosecution and in case of serious offences, the police officer is duty bound to investigate the crime. Even in the offences like theft, trespass etc. on property under the \textit{Indian Penal Code 1960} it is the possession and not ownership of property that is important.

The constitutional validity of Section 64 of the \textit{Copyright Act} authorizing the police officer to conduct search without warrant was challenged in \textit{Girish Gandhi v. Union of India}\textsuperscript{72}. According to the petitioner since no procedure was laid down in the section, the power granted under the Section was arbitrary and hence violative of the constitutional right. Rejecting this the court observed:

"Section 64 clearly mentions that police officers is to seize the material, if he is so satisfied. But what does the word

\textsuperscript{70} Ibid., at p.131.

\textsuperscript{71} Ibid., at p.132.

\textsuperscript{72} AIR 1997 Raj 78.
“satisfaction” mean. It is inborn that police officer will not act until and unless he has got some type of information on which information he is satisfied and his satisfaction shall be objective. It cannot be imagined that only because, Section 64 empowers the police officer to seize the material to his satisfaction, that he would act malafide or arbitrary. If he does so, there is ample remedies available in he appropriate courts and the aggrieved person is always free to safeguard his interest in this respect by resorting to the legal remedies. The power given to the police officer is not at all arbitrary …”

Section 4 of the Criminal Procedure Code 1973 (Cr P.C.) mandates the investigation of the offences under the Indian Penal Code and other special legislation according to the procedure laid down under the Cr P C. Only in cases where there is express procedure in the special legislation, the application of the provisions of the Cr. P.C. is exempted. This makes it clear that the police officer exercising the power under section 64 of the Copyright Act is bound to follow the procedure under the Cr. P.C. in case of search and seizure without warrant. In this context as rightly concluded by the Court the Section is constitutionally valid.

The analysis of cases indicate the continuous effort of the judiciary to grapple with the problems that crops up in the process of interaction between the existing statute law and new socio economic development that takes place in the country.

(iii) Administrative Remedies.

In order to prevent importation of infringing copies in India, the Copyright Act 1957 makes available an effective and quick administrative remedy to the owner of copyright. Section 53(1) of the Act empowers the Registrar of Copyrights to make an order prohibiting the importation into India of copies of a copyrighted work made outside India which, if made in India, would infringe copyright in the work, on the application of

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73 Ibid., at p. 84.
the owners of copyright in such work, or his duly authorised agent, after making such inquiry as he deems fit.

The issue of importation into India of the infringing copies of the work protected by copyright came before Supreme Court in Gramophone Company of India Ltd v Birendra Bhadur Pandey and Others. The appellant in this case, the Gramophone Company of India Ltd., was the owner of copyright in musical records and cassettes. The appellant received information from the customs authorities at Calcutta that a consignment of pre-recorded cassettes sent by Universal Overseas Private Ltd, Singapore to M/s. Sungawa Enterprises, Kathmandu, Nepal had arrived at Calcutta port by ship, and was awaiting dispatch to Nepal. Due to broken condition of the consignment which was lying at the Calcutta docks, the appellant learnt that a substantial number of cassettes were pirated works.

The appellant sought intervention of the Registrar of Copyrights for action under section 53 of the Copyright Act 1957. As the Registrar was not taking expeditious action on the application of the applicant, and as it was apprehended that the pirated cassettes would be released for transportation to Nepal, the appellant filed a writ petition in the Calcutta High Court seeking a writ in the nature of mandamus to compel the Registrar to pass an appropriate order under section 53, and to prevent release of the cassettes from the custody of the custom authorities.

The single judge of the Calcutta High Court issued a rule nisi and made interim order permitting the appellant to inspect the consignment of cassettes, and if any of the cassettes were thought to infringe the appellant’s copyright, they were to be kept apart until further orders of the Registrar. After causing the necessary inspection to be made, the Registrar was directed to deal with the application under section 53 hearing interested parties within a time span of eight weeks.

On an appeal, the Calcutta High Court held that the word ‘import’ did not merely mean bringing the goods into India, but comprehended something more, ie,

74 AIR 1984 SC 667.
incorporating and mixing or mixing up of goods imported with the mass of the property in the local area. Keeping in view the treaties with Nepal, the court took the view that there was no importation when the goods entered India en route to Nepal.

The Supreme Court appeal preferred by the appellant, held that the word ‘import in sections 51 and 53 meant ‘bringing into India from outside India’, that it was not limited to importation for commerce only, but included importation for transit across the country. The court stated that the interpretation, far from being inconsistent with any principle of international law, is entirely in accordance with international conventions and treaties between India and Nepal.75

Section 53(2) of the Act empowers the Registrar of Copyrights, or any person authorised by him in this behalf to (a) enter any ship, dock or premises where any such copies as are referred to in section 53(1) may be found; and (b) examine such copies. The purpose of the above provision is to determine whether such copies infringe the copyright in the work of the applicant. Rule 23 of the Copyright Rules 1958 requires the Registrar or any person authorised by him in this behalf to take action under section 53(2) in collaboration with customs authorities.

All copies of the work to which the order of the Registrar applies shall be deemed to be goods of which the import has been prohibited under section 11 of the Customs Act 1962 and all the provisions of the Customs Act shall have effect accordingly. Section 11 of the Customs Act 1962 provides, inter alia, that if the Central Government is satisfied that it is necessary for the protection of patents, trademarks and copyrights, it may prohibit either absolutely or subject to conditions, the import or export of goods of any specified description.

Powers of Proper Officer under the Customs Act.

Under section 110 of the Customs Act 1962, if the proper officer has reason to believe that any goods are liable to confiscation under the Act, he may seize such goods. However, where it is not practicable to seize any such goods, the proper officer

75 AIR 1984 SC 667, P. 680.
may serve an order on the owner of the goods that he shall not remove, part with, or otherwise deal with the goods except with the prior permission of such officer. It is mandatory to give a notice of the seizure of the goods to the owner of goods within six months, otherwise the goods shall be returned to the person from whose possession they were seized. However, the period of six months may be extended by another period of six months if sufficient cause is shown. Under section 111(d), any goods which are imported or attempted to be imported or are brought within the Indian custom waters for the purpose of being imported, country to any prohibition imposed by law shall be liable to confiscation. The pirated copyright goods are covered under this provisions.\textsuperscript{76}

All infringing copies confiscated under Customs Act shall not vest in the government, but shall be delivered to the owner of the copyright in the work. However, importation of one infringing copy of the work is allowed for the private and domestic use of the importer.

The remedy available to copyright owner under section 53 is different from and in addition to the civil remedy available for the infringement of copyright under section 55. The remedy available under section 53 of the Act is quasi-judicial in nature as an appeal can be made to the Copyright Board against the order of Registrar under section 72 of the Copyright Act.

\textsuperscript{76} Law relating to Intellectual Property Rights by Dr. V.K. Ahuja. Lexis Nexis Butterworth’s. Student series, New Delhi, India, 2007, pages 186-188.