Miss. Kajal Aggarwal Vs The Managing Director, M/s. V.V.D. and Sons P. Ltd.

Court: Madras High Court

Date of Decision: Dec. 22, 2011

Acts Referred: Copyright Act, 1957 â€" Section 13(4), 17

Citation: (2012) 1 CTC 812 : (2012) 1 LW 330

Hon'ble Judges: R. Mala, J; R. Banumathi, J

Bench: Division Bench

Advocate: V. Manohar, for the Appellant; P.V.S. Giridhar for M/s. P.V.S. Giridhar Associates, for the Respondent

Final Decision: Allowed

Judgement

Hon"ble Mrs. Justice R. Banumathiand Hon"ble Ms. Justice R. Mala

R. Banumathi, J.
Being aggrieved by refusal to grant interim injunction restraining the respondent from using the profile of appellant in the

cinematograph film, audio, video cassettes and C.Ds in promoting the product of the respondent, the plaintiff has preferred this appeal.

2. Case of appellant/plaintiff is that she is an actress having good number of fans and the appellant agreed to endorse the products of the

respondent/defendant. Case of appellant/plaintiff is that the respondent approached the appellant for promoting their products of hair oil and

coconut oil through various mediums of advertisements like film, Television, magazines, hoarding, etc.. The parties have entered into an agreement

dated 29.12.2008. As per the terms and conditions of the said agreement, the appellant agreed to be a model for promoting the objects of the

respondent in mass media such as press, hoarding, package material etc. As per the terms, the said agreement is valid for a period of one year.

Case of appellant is that the agreement entered with the respondent expired in December 2009 itself and thereafter the respondent has no manner

of right to use the videos, photographs, printed materials or picture of the appellant in any of their products. The appellant has further alleged that

even after expiry of the agreement, the respondents have been advertising their products using her pictures/name and the action of the respondent

amounts to the violation of the breach of terms of the agreement and misused. Further case of appellant is that her popularity increased multi-fold

and there is much demand for her presence as brand ambassador for the products of many reputed companies including multi-national companies

and due to the conduct of the respondent, her reputation and commitment given to other companies was greatly affected. After issuing legal notice

dated 12.9.2011, the appellant had filed the suit - C.S.No.635 of 2011 claiming damages of Rs.2,50,00,000/-and also for permanent injunction

restraining the respondents from using or publicising or projecting or promoting or advertising the materials with the presence of the appellant''s

profile or her presence in any form. Along with the suit, the appellant has filed Application in O.A.No.787 of 2011 seeking interim injunction

restraining the respondent from using the image of the appellant in their products and also from advertising the appellant''s

endorsement/advertisement video in television Channels, websites, Internet or in any other form or media.

3. The respondent/defendant has entered appearance and filed counter contending that in December 2008, the appellant was an ordinary model

and acting in Ad films and respondent has used the same for the purpose of marketing and promoting their products, particularly hair oil and

coconut oil. According to the respondent, there is no convention or custom in the field of advertising that the advertisement would be permissible

only for one year and as such the appellant''s claim that respondent cannot use the materials produced in the year 2008 for more than a year is

incorrect and untenable. The respondent holds copyright over Ad film and all rights in the said film vest in the respondent and that the appellant has

no manner of right over the same since she has been paid the sum demanded by her for acting in the same. Stating that the appellant has not made

out a prima facie case and claiming copyright in the promotional films/video cassettes, the respondent/defendant filed counter praying for dismissal

of the application.

4. Before the learned single judge, respondent/defendant has undertaken that henceforth respondent will not use still photographs or other profile

of the appellant on any of its products except with the written consent of the appellant. In so far as injunction against ad films is concerned, the

learned single judge held that clause 4 of the agreement was to the effect that Ad films etc., would become the property of respondent/defendant to

use at its discretion without any restriction and in view of clause 4 of the agreement, the appellant has no prima facie case to seek injunction against

the use of ad films, being copyright of respondent/defendant. Recording the undertaking of the respondent, the learned single judge partly allowed

the application restraining the respondent/defendant from using still photographs and other profile of the appellant on their products, print media,

Internet, etc. Referring to clause 4 of the agreement,the learned single judge however held that the respondent/defendant shall be entitled to use the

profile of the appellant in Ad films, subject to the final decision of the suit.

5. Challenging the impugned order, the learned counsel for appellant contended that as per clause 9 of the agreement, the agreement was valid only

for particular period from 29.12.2008 to 28.12.2009 and only clause 9 will prevail. It was further submitted that when the respondent has given an

undertaking that they will not use still photos and other profile of the appellant in their product, the same holds good in respect of Ad films also and

while so the learned judge erred in saying that the appellant has not made out a prima facie case in respect of Ad film, video cassettes. Learned

counsel would further submit that the entire agreement will have to be considered as a whole and the learned single judge ought to have held that

the respondent has no right to exploit the profile of the appellant in their product beyond one year.

6. Laying emphasis upon Clause 4 of the agreement, learned counsel for the respondent/defendant contended that clause 4 is governed by

Copyright laws and there could be no restriction as to the time frame in using the Copyright. The learned counsel for respondent would further

submit that the respondent is the owner of the copyright and clause 4 cannot be restricted by clause 9 of the agreement. In support of his

contention, learned counsel placed reliance upon a decision of the Bombay High Court in the case of Fortune Films International Vs. Dev Anand

and Another,

7. The points falling for consideration are:

1. By virtue of clause 4 of the agreement, whether respondent is entitled to use profile of the appellant in Cinematograph film, audio and video

cassettes even beyond the period of one year.

and

2. Whether the learned judge was right in saying that the plaintiff has not made out a prima facie case in respect of use of her profile in

cinematograph film, video cassettes, etc.,

8. The appellant had entered into agreement on 29.12.2008 and it was agreed that the agreement shall be for a period of twelve months from

29.12.2008 to 28.12.2009. It is not disputed that the appellant has entered into an agreement with the respondent agreeing that her pictures/profile

be used for promoting the products of respondent for a period of one year through various media of advertisement like magazines, Hoardings,

packaging material, films, television etc.,

9. Clause 2 of the agreement dated 29.12.2008 contained a non-competitive clause i.e., to the effect that the appellant will not be model for

another Hair oil and Coconut oil brand for a period of twelve months from the date of agreement. Clauses 3 and 4 of the agreement reads as

follows:-

3. That the Party of the Second Part agrees that her picture and signature may be used in any other mass media such as Press, hoarding,

Packaging materials, etc., and any other promotion material created by the Party of the First Part.

4. That the Cinematography Film, Audio, Video Cassettes, CDs and or any other promotional material in the medium so developed between both

the Parties will be the copyright of the Party of the First Part.

10. Before the learned trial judge, respondent/defendant has undertaken that henceforth respondent will not use still photographs or other profiles

of the appellant on any of its products. Even according to the respondent/defendant, when the still photographs or other profiles of the appellant is

not to be used for any of their products beyond one year, it is preposterous to contend that clause 9/ time restriction will not extend to video

cassettes/cinematograph film and other videocassettes.

11. Laying emphasis upon the expressions used in clause 4 of the agreement ""..Cinematograph film, Audio, video cassettes or any other

promotional material in the medium so developed between the parties will be the copyright of the Party of the First Part (respondent)"", learned

counsel for respondent submitted that in clause 4 it has been made clear that the respondent will be the owner of the copyright and therefore

Clause 4 is governed by copyright laws. According to respondent, the respondent will have the copyright of the cinematograph films/video

cassettes for a period of sixty years and the copyright vested in the respondent cannot be restricted by the time limit stipulated in clause 9.

12. Contending that even though cine artiste performs in a cinematograph film, the copyright of the film would be vested with the producer, the

learned counsel placed reliance upon decision of Bombay High Court in Fortune Films International Vs. Dev Anand and Another, In the said case,

the plaintiff was a cine artiste of a Hindi motion picture produced by the 1st defendant. In the agreement, the correspondence exchanged between

the parties inter alia provided that the cine artiste would be paid remuneration of Rs.7 lakhs and it was further provided that the copyright in the

cine artiste''s work in the motion picture was to vest with the Cine artiste till full payment of the agreed amount was made to him. In the said case,

as per the terms, the cine artiste claimed the copyright. Negativing the said contention of Cine artiste, after considering the scope of artistic work,

the Bombay High Court held that the copyright does not recognise the performance of an actor, which is protected by the Copyright Act. In the

said judgment, the Bombay High Court held as under:

22. We now have to consider whether the performance of the cine artiste would fall within the definition of ""cinematograph film"" to be found in

Sub-section (f) of Section 2. The definition only protects the film as well as the sound tract which is married to the film proper (i.e. the visual

sequence). The copyright in the entire film may cover portions of the film in the sense that the owner of the copyright in the film will be entitled to

the right in portions of the film; but this idea or concept cannot be extended to encompass an idea that there would be one owner of the

cinematograph film and different owners of portions thereof in the sense of performers who have collectively played roles in the motion picture. In

this connection reference may be made to Indian Performing Right Society Ltd. Vs. Eastern Indian Motion Pictures Association and Others, . In

paragraph 21 of the report Krishna Iyer J. in an aside (as expressly indicated in paragraph 20) refers to cinematograph film in the following words:

A cinematograph is a felicitous blend, a beautiful totality, a constellation of stars if I may use these lovely imageries to drive home my point, slurring

over the rule against mixed metaphor. Cinema is more than long strips of celluloid, more than dramatic story, exciting plot, gripping situations and

marvellous acting. But it is that ensemble which is the finished product of orchestrated performance by each of the several participants, although the

components may, sometimes, in themselves be elegant entities. Copyright in a cinema film exists in law, but Section 13(4) of the Act preserves the

separate survival, in its individuality, of a copyright enjoyed by any "work" notwithstanding its confluence in the film. This persistence of the

aesthetic personality of the intellectual property cannot cut down the copyright of the film qua film.....

23. These words, however, do not take the case of the cine artiste any further. The question is: whether he has any copyright in his performance? If

there is and it is covered by the definition of "work" to be found in Sub-section (y) of Section 2, then it will be protected notwithstanding that the

copyright in the entire film, the composite work, may vest in the producers. If, however, the performance of the cine artiste does not satisfy this

definition, then there is no question of any dichotomy and co-existence, since there is no "work" in the cine artiste"s performance which is

protected by the Act. In the view that we have taken of the definition of ""artistic work"", ""dramatic work"" and ""cinematograph film"", it would appear

that the Copyright Act, 1957, does not recognise the performance of an actor as ''work'' which is protected by the Copyright Act.....

13. The facts of the above case stand entirely on different footing and the above decision is not applicable to the case on hand. In the present case,

we are concerned with the commercial use of the profile. The video films with the use of the appellant''s picture/profile promoting the products of

the respondent.

14. ""'Copyright"" means all the rights conferred by the Copyright Act, 1957 upon its order in respect of its literary, dramatic or artistic work in

respect of a cinematograph film or record. It is the expression of thought or information in some concrete form, which is protected and not the

ordinary thought or information. As per Section 17 of the Copyright Act, the author of the work shall be the first owner of the copyright. Provisos

to Section 17 carve out the exceptions to the general rule.

15. As per proviso (a) to Section 17, where the author makes:-

(a) a literary, dramatic or artistic work,

(b) in the course of his employment by,

(c) the proprietor of a newspaper, magazine or similar periodical,

(d) under a contract of service or apprenticeship,

(e) for the purpose of publication in a newspaper, magazine or similar periodical, and, if all the above mentioned conditions are fulfilled, and

(f) there is no agreement to the contrary, then only in so far as the copyright relates to the publication of the work in any newspaper, magazine or

similar periodical, or the copyright relates to the reproduction of the work for the purpose of its being so published, the said proprietor shall be the

owner of the copyright; but, in all other respects, the author shall be the first owner of the copyright;

16. As per proviso (b) to Section 17, Subject to the provisions of Clause (a) of section 17, that is, if the provisions of Clause (a) have no

application, then, where

(a) (i) a photograph is taken, or

(ii) a painting or portrait is drawn, or

(iii) an engraving or a cinematography film is made,

(b) for valuable consideration at the instance of any person, then subject to the provisions of Clause (a) of this section, that is, unless the case falls

under Clause (a) and in the absence of a contract to the contrary, such person shall be the first owner of the copyright therein, but, in all other

cases, the author shall be the first owner of the copyright.

17. As per Section 17, proviso(c), where

(a) the author makes a work,

(b) in the course of his employment,

(c) under a contract of service or apprenticeship, and

(d) the case does not fall within Clause (a) or Clause (b) of the section,

(e) and there is no agreement to the contrary,

the employer shall be the first owner of the copyright, but, in all other cases, the author shall be the first owner. Thus, the author or the compiler is

the first owner of the copyright, but if (a) he is employed by another under a contract of service, and (b) the compilation is made in the course of

the employment and (c) If there is no agreement to the contrary the employer is the first owner of the copyright.

18. For proper appreciation of the provisos to Section 17, we may usefully extract some of the illustrations given in T.R.Srinivasa Iyengar''s

Commentary on The Copyright Act, Seventh Edition, 2010, at page 186, which reads as under:

..... (3) A makes an artistic work in the course of his employment by B, the proprietor of a magazine, under a contract of service, for the purpose

of publication in the magazine. No agreement is made between A and B with regard to the copyright in the work. B is the first owner of the

copyright in the work insofar as the copyright relates to the publication of the work in any magazine or similar periodical, or to the reproduction of

the work for the purpose of its being so published. But, in all other respects, A is the first owner of the copyright in the work.

(4) A makes an artistic work or a cinematograph film for Rs.15,000 at the instance of B. There is no agreement between A and B with respect to

the copyright in the work. B is the first owner of the copyright in the work or the film.

(5) cinematography film producer A, engages on contract of service for valuable consideration B, C and D as music composers and sound

recorders for his film. The copyright in music and sound recorded on the sound tracts of the film vests in the producer A, and he is the first owner

of the copyright, in the absence of any contract to the contrary.

(5) A makes a work in the course of his employment under a contract of service with B. There is no agreement between the parties with respect to

the copyright in the work. B is the first owner of the copyright.

By perusal of the above various illustrations, it is seen that the emphasis is ""in the absence of contract to the contrary"".

19. In the case on hand, the appellant, being the model for promoting the products of the respondent, was under the contract of service, of course,

the work/video film/video cassette having been produced by the respondent shall be the work of respondent. As per proviso (c) to Section 17, the

respondent will be the owner of the copyright only in the absence of any agreement to the contrary. As pointed out earlier, the appellant had

entered into contract with the respondent as per which the agreement shall be in force only for a period of twelve months. When the agreement is

only for a period of one year, claiming copyright over the cinematography films, video cassettes, can the respondent use the profile of the appellant

in cinematography film, video cassettes beyond one year is the point for consideration

20. The terms of the contract will have to be read as a whole. The intention of the parties has to be ascertained from the recitals in the agreement.

The recitals of the agreement, in particular, clauses 3 and 4 will have to be read in the light of clause 9 of the agreement, which stipulates that the

agreement is for a period of one year. The merits of the contention of the respondent that clause 4 is not to be restricted by the stipulated time in

clause 9 could be gone into only at the time of trial when the parties adduce oral and documentary evidence. In our considered view, both clauses

3 and 4 will be governed by clause 9 of the agreement i.e., the right of the respondent to use the picture/profile of the appellant in their

advertisements/cinematograph film/video cassette, C.Ds etc., would be valid only for a period of one year. The learned single judge did not keep in

view clause 9 of the agreement. The learned single Judge was not right in saying that the appellant has no prima facie case in respect of

cinematograph film/video cassettes.

21. The underlying idea of commercial advertisements/ video film is to promote the product of the manufacturer/promoter. The

manufacturer/promoter employs a model/actress and uses their profile for endorsing their products and thereby aiming to increase their marketing.

While so doing, the manufacturer/promoter acquired limited right of using the reputation of the actress/model. In the advertisement films, though

video is taken, ultimately, it is the reputation of the actor/model, which is exploited as per the terms of the contract. The manufacturer/marketing

agency has no right to continue the use of picture/profile of the actress/model after the expiry of the period of contract.

22. On the question of injury to the appellant, the appellant has alleged that now her popularity has increased and that other reputed companies

including multi-national companies have approached her. Because of the continued use of profile of the appellant by the respondent, there were

unwarranted queries and that her future advertisement prospects are seriously affected. An actress/model lends his or her name/reputation earned

for various products and the respondent used to exploit the profile of the appellant under the period of agreement. It is likely to cause confusion

affecting advertisement prospects of the appellant. If the respondent continues to telecast their products through Televisions and other medias, it

would cause irreparable injury to the appellant and it would be difficult to assess the damage suffered by her. Balance of convenience is only in

favour of the plaintiff. In these circumstances, we are unable to endorse the views taken by the learned single judge that in view of clause 4 of the

agreement the appellant cannot seek for injunction restraining the respondents from using her profile in the Ad films. The findings of the learned

single Judge refusing injunction restraining the respondent from using the appellant''s profile in Cinematograph films/ audio, video cassettes does not

reflect the available materials and is liable to be set aside.

23. In the result, the Original Side Appeal is allowed and O.A.No.787 of 2011 in C.S.No.635 of 2011 is allowed in toto. However, there is no

order as to costs. Consequently, the connected miscellaneous petition is closed.