

## **Sholay, Gabbar and Aag: Analysing the Legality of Copyright and Trade mark Protection for Titles and Characters in Movies**

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Where the copyright protection for titles and characters is weak, and trade mark protection, none too stronger, this has resulted in a situation where the Hindi Film Industry looks elsewhere for creative inputs and freely reproduces plots and characters in an Indian setting: Thus, the researchers argue that if one were to draw lessons from the Hindi Film Industry, perhaps, a stronger copyright and trade mark regime for titles and characters in movies would ensure more creative innovation in the Hindi Film Industry.

### **Introduction**

The movie “Sholay” is perhaps the most popular movie ever to be made in the Hindi Film Industry.<sup>1</sup> With its characters and plot firmly etched in public memory, “Sholay,” has inspired a lot of other movies.<sup>2</sup> One such movie is “Ramgopal Verma ki Aag,” which was released sometime in August 2007.<sup>3</sup> “Inspired from Sholay”, this movie sought to re-tell the story of Sholay in present day Mumbai.<sup>4</sup> This movie was not always “Ramgopal Verma ki Aag”; originally, conceived and made as “Ramgopal Verma Ki Sholay,” this movie was challenged in the Delhi High Court as

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<sup>1</sup> See Internet Movie Database, Sholay available at <http://www.imdb.com/title/tt0073707/> (last visited 1<sup>st</sup> September, 2007).

<sup>2</sup> See Bollywood Studio pays 100 million to remake Sholay, The Hindustan Times, 29<sup>th</sup> August, 2007 available at <http://www.hindustantimes.com/StoryPage/StoryPage.aspx?id=6dd1e119-850d-4261-b1aa-e9b292846691&&Headline=EMSholay+%2fEMremake+to+cost+%24100+million> (last visited 1<sup>st</sup> September, 2007).

<sup>3</sup> See No Sholay in Ramgopal Verma’s Aag, The Hindustan Times, 2<sup>nd</sup> September, 2007 available at <http://www.hindustantimes.com/StoryPage/StoryPage.aspx?id=424c25ff-8b3e-4c95-b6e3-3abf4ae683bf&&Headline=No+EMsholay+%2fEMin+Ram+Gopal+Varma%e2%80%99s+EMAag%2fEM> (last visited 1<sup>st</sup> September, 2007).

<sup>4</sup> See Ramgopal Verma Ki Aag: Official Website available at [www.rgvkiaag.com](http://www.rgvkiaag.com) (last visited 1<sup>st</sup> September, 2007).

infringing the copyright and trade mark underlying the movie Sholay.<sup>5</sup> While the petition before the Delhi High Court is still pending, after an interim arrangement was reached between the parties, the movie was agreed to be released without any mention of the title Sholay or the characters in the movie “Sholay” and “Ramgopal Verma Ki Sholay” became “Ramgopal Verma Ki Aag.”<sup>6</sup> In the backdrop of the conversion from Sholay to Aag, this essay examines the legality of copyright and trade mark protection for titles and characters in movies. The researchers look at the copyright and trade mark protection separately and argues that titles and characters in movies, perhaps receive better protection from trade mark law than from copyright law. The researchers argue that while titles of movies are not likely to be afforded any copyright protection at all, characters are likely to receive protection as a part of a copyrighted work provided they are sufficiently “delineated”. However, the essay argues that any such copyright protection is severely diluted by a possible fair use defence, especially when the work using the characters is a periodic work. As regards trade mark protection, the essay argues that where the title and characters in a movie would be required to show “acquired distinctiveness” for trade mark registration, any action for trade mark infringement would be sustainable only if it would cause a “likelihood of association”. The essay argues that showing such “likelihood of association” is more difficult for more popular movies. In conclusion the essay argues that where the copyright protection for titles and characters is weak, and trade mark protection, none too stronger, this has resulted in a situation where the Hindi Film Industry looks elsewhere for creative inputs and freely reproduces plots and characters in an Indian setting.<sup>7</sup> Thus, the researchers argue that if one were to draw lessons from the Hindi Film Industry, perhaps, a stronger copyright and trade mark regime for titles and characters in movies would ensure more creative innovation in the Hindi Film Industry. The current research though primarily discussing the position of law in India, refers to American and English case law, wherever appropriate. Part II of this essay looks at the law on copyright protection for titles and characters and Part III looks at the law on trade mark protection for titles and characters.

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<sup>5</sup> See Ramu’s Sholay Turns Into Aag, The Times of India, 20<sup>th</sup> July, 2007 available at [timesofindia.indiatimes.com/Ramus\\_Sholay\\_turns\\_into\\_Aag/articleshow/2208664.cms](http://timesofindia.indiatimes.com/Ramus_Sholay_turns_into_Aag/articleshow/2208664.cms) (last visited 1<sup>st</sup> September, 2007).

<sup>6</sup> See id.

<sup>7</sup> See Sholay- Bollycat of Magnificent Seven available at <http://www.bollycat.com/> (last visited 1<sup>st</sup> September, 2007).

## ***De Minimis* and Delineation: Copyright Protection for Titles and Characters in Movies**

Copyright law recognises the principal of *de minimis non curat lex*,<sup>8</sup> according to which any work which is insufficiently significant is not to be offered copyright protection.<sup>9</sup> Thus, the name of a famous singer “Elvis,”<sup>10</sup> the name of a fictional television detective “Kojak,”<sup>11</sup> or the song title “The Man who Broke the Bank at Monte Carlo” were all denied copyright protection on the ground of *de minimis*. Titles, whether that of movies or of other copyrightable works, by themselves, are considered not possessing sufficient significance to be afforded copyright protection.<sup>12</sup> However, there are cases, where titles have been considered to be of sufficiently extensive nature and importance, to cross the *de minimis* threshold barrier.<sup>13</sup> But these cases deal with titles, which while being of sufficiently important nature, are in fact artistic capturing of the titles in stylized versions and therefore pass the *de minimis* threshold. The principle of *de minimis* is well recognised in India too and any title, too trivial by itself, is refused copyright protection.<sup>14</sup> While there is no case law directly declining copyright protection to titles of movies on the ground of *de minimis*, in *Associated Electronics & Electrical Engineers v. Sharp Tools*,<sup>15</sup> copyright over a single word was declined. Thus, a title of a movie, protected as a cinematograph film, would not be afforded copyright protection. It is also submitted that giving such a protection to titles would seriously impinge on regular usage of such titles in their ordinary context, thus defeating the utilitarian purpose of copyright law.<sup>16</sup> Copyright law does not protect ideas and affords protection to

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<sup>8</sup> This Latin maxim literally translates into “law does not concern itself about trifles”. See Black’s Law Dictionary 431 (1990).

<sup>9</sup> David Bainbridge, *Intellectual Property* 42 (2002).

<sup>10</sup> See *Elvis Presley Trade marks* [1997] RPC 543.

<sup>11</sup> See *Tavener Rutledge Limited v. Trexapalm Limited* [1977] RPC 275.

<sup>12</sup> See *Ladbroke Ltd. v. William Hill Ltd.* (1964) 1 All. E.R. 465.

<sup>13</sup> See *Shetland Times Limited and Dr. Jonathan Wills* [1997] FSR 604 & *I.P.C. Magazine Limited v. MGN Ltd.* [1998] FSR 431.

<sup>14</sup> See *Malayala Manorama v. V.T. Thomas* AIR 1988 Ker 29.

<sup>15</sup> MANU/KA/0061/1991: AIR 1991 Kant 406: ILR 1991 KAR 1916: 1991 (1) KarLJ 482.

<sup>16</sup> See Anthony Reese, *A Map of the Frontiers of Copyright* 85 Tex. L. Rev. 1979.

expression alone.<sup>17</sup> It follows that for characters in a movie to be protected, the character must be expressed in one copyrightable form or other. Movies, while as such protected as a cinematograph film, have other underlying, independently copyrightable works. For instance, the screenplay and the script of the movie are copyrightable as a literary work and the music of the movie is copyrightable as a musical work.<sup>18</sup> Thus, for characters in a movie to receive copyright protection, they must be expressed in or as one these copyrightable works.<sup>19</sup> Ordinarily, characters of a movie, apart from being expressed in the cinematograph film itself would be expressed in other underlying literary works such as the script and screenplay. The question that arises with respect to copyright protection of characters is this: Does the borrowing of a character expressed in a copyrightable work, violate the copyright in that work? The American case law on this point upholds the “character delineation test,” which mandates that for the borrowing of a character to constitute an infringement of the work which contains the character, the work must “sufficiently and distinctively delineate the particular character”.<sup>20</sup> Thus, in *Walt Disney v. Air Pirates*,<sup>21</sup> where the Defendants had portrayed Disney’s characters in incongruous settings, the Court applying the “character delineation test,” held that Disney held copyrighted works sufficiently delineated the characters for the Defendants work to constitute copyright infringement. Again in *Anderson v. Stallone*,<sup>22</sup> the Court held that the character “Rocky” in the Rocky movie series is sufficiently delineated so as to afford protection to the character from an attempt to express the character in another movie.<sup>23</sup>

The only Indian case dealing with copyright protection of characters is *Malayala Manorama v. V.T. Thomas*.<sup>24</sup> In this case copyright protection over two cartoon characters (“Bobby” and “Molly”) was claimed by the Newspaper, in whose service the cartoons were sketched by the Defendant. On the Defendant leaving the Newspaper’s employment, the

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<sup>17</sup> Garnett et. al., Copinger and Skone James on Copyright 30-31 (1999).

<sup>18</sup> See Kurtz Leslie A., The Independent Legal Lives of Fictional Characters, 1986 Wisconsin Law Review 429 (1986).

<sup>19</sup> See id.

<sup>20</sup> *Nicholas v. Universal Pictures Corp.* 292 US 902 (1931).

<sup>21</sup> 439 U.S. 1132 (1979).

<sup>22</sup> 11 U.S.P. Q 2d. 1161 (C.D. Calif. 1989).

<sup>23</sup> See also *Universal City Studios v. Kamar Industries* 1982 Copyright L. Decisions (CCH) 25, 452 (SD Tex. 1982), where the character ET from the ET series was afforded copyright protection.

<sup>24</sup> MANU/KE/0072/1988: AIR 1988 Ker 291.

Newspaper claiming copyright over the character sought to restrain the Defendant from using these two characters in his sketches. On facts the Court held that the Defendant had expressed the characters in artistic works before entering into employment with the Newspaper and with the copyright over such artistic works vesting with the Defendant, the Defendant could continue to use the characters.<sup>25</sup> In the absence of any case law in India on protection of characters in movies and substantial similarity between the Indian and American law on copyrightable works, it is submitted that the “character delineation test” would apply in India as well. While the “character delineation test” to determine the copyright protection over character might appear to be providing for a strong copyright protection to characters, it is in fact severely limited by the prevailing norms of fair use, especially those relating to periodic works, which necessarily borrow some element of the original work, whether the character or otherwise.<sup>26</sup> Thus, in *Suntrust Bank v. Houghton Mifflin Company*,<sup>27</sup> where the literary work (*Wind Done Gone*) borrowed the characters, the background plot and even partly the title from the original work (*Gone With The Wind*), the Court held that the literary work in question is a periodic work and hence, is covered by fair use.

### **Distinctiveness and Association: Trade mark Protection for Titles and Characters in Movies**

Titles of movies and names of characters in movies, in general, are undoubtedly ‘marks’ and capable of distinguishing the goods of one person from another, are arguably ‘trade marks’ as well.<sup>28</sup> In analysing the trade mark protection available to movie titles and names of characters in a movie, the scope of registration of titles and name of characters as a trade mark and the likelihood of a trade infringement action or a passing-off action being upheld, need to be separately addressed. The Trade Marks Act, 1999 prohibits registration of a trade mark of certain “absolute” and “relative” grounds.<sup>29</sup> Lack of distinctiveness, i.e. where the mark is not “capable of distinguishing the goods or services of one person from another person” is one such

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<sup>25</sup> See id at Para. 5-10, 21.

<sup>26</sup> See *Jay Lee, Campbell v. Acuff-Rose Music: The Sword of the Parodist Is Mightier than the Shield of the Copyright Holder*, 29 U.S.F. Law Rev., 279 (1994).

<sup>27</sup> 268 F.3d at 1257 (11th Cir. 2001).

<sup>28</sup> See Section 2(1)(m) and 2(1)(zb) of the Trade Marks Act, 1999.

<sup>29</sup> See Sections 9 and 11 of the Trade Marks Act, 1999.

absolute ground for refusal of registration of trade marks.<sup>30</sup> It is submitted that movie titles and more importantly, movie characters, portraying real life on-screen, lack the capability of inherent distinctiveness, as they are likely to adopt everyday names for characters and even titles. Thus, lacking inherent distinctiveness, to acquire registration, trade marks in movies titles and names of characters must show acquired distinctiveness, in the sense of having acquired a secondary meaning, i.e. where the title or the name of the character, though non-distinctive by themselves, have acquired distinctiveness on account of wide spread popularity or usage.<sup>31</sup> Thus, it is submitted that movie titles and more so, movie characters, can be registered as a trade mark only if they have acquired distinctiveness. A case point is the registration of the movie “Sholay” and character name “Gabbar” and “Gabbar Singh”.<sup>32</sup> While admittedly, “Sholay” and especially, “Gabbar Singh” are not everyday names, the trade mark registration for “Sholay” and “Gabbar Singh” was undoubtedly facilitated by the pervasive popularity of the movie and its characters, whereby the name of the movie and the characters came to be exclusively associated with the movie and its makers. In other words, while possibly lacking inherent distinctiveness, distinctiveness acquired on account of mass popularity of the movie, facilitated trade mark registration of the title and the characters. In any action for infringement of trade mark (and an action for passing-off) it needs to be shown that the use of the infringing mark would cause a “likelihood of association” with the registered mark in a manner that an average consumer would believe that the infringing mark originates and is provided for by those providing for the registered mark.<sup>33</sup> Thus, in case of use of title and characters of a movie in another movie, it must be shown that the average viewer would associate the second movie as originating from the makers of the first movie. A generalisation in this regard would be difficult to arrive at; however, it can be argued that the more popular a movie is and the more well known its makers are, the less the chances of any subsequent movie, using similar title and characters, being associated with the first movie.<sup>34</sup> Thus, it is submitted that a movie with the title “Ramgopal Verma Ki Sholay,” is not likely to be associated with the original Sholay, especially considering

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<sup>30</sup> See Section 9(a) of the Trade Marks Act, 1999.

<sup>31</sup> See *Kanungo Media (P) Ltd. v. RGV Film Factory and Ors.* MANU/DE/7193/2007: 138 (2007) DLT 312. See also *MJM Productions v. Kelley Productions, Inc.* 68 U.S.P.Q.2d 1131.

<sup>32</sup> See supra note 5.

<sup>33</sup> See supra note 9 at p. 532.

<sup>34</sup> See *MJM Productions v. Kelley Productions, Inc.* 68 U.S.P.Q.2d 1131.



the usage of the director's name (Ram Gopal Verma) in the title of the movie itself. However, chances of association are higher in cases where the movie, whose title and characters, are being used, is not a cult movie like *Sholay*.<sup>35</sup> While the law in India on this subject is not much developed, a passing-off action on use of title of a movie came up before the Delhi High Court in *Kanungo Media (P) Ltd. v. RGV Flim Factory and Ors.*<sup>36</sup> In this case, the Plaintiff contended that the title of the Defendant's movie "Nishabd" is deceptively similar to the Plaintiff's movie "Nisshabd" and hence, the Defendant must be restrained from using this title for the movie. The Court reviewing the law held that for a passing-off action to be sustained the condition of acquired distinctiveness or secondary meaning and likelihood of association both need to be shown. The Court in this case found that the Defendant's movie is in fact more known than the Plaintiff's movie and moreover, since the Plaintiff did not take any steps on having come to know of the making of the Defendant's movie, the title in the Plaintiff's movie has acquired no distinctiveness or secondary meaning to prevent the use of the title by the Defendant.<sup>37</sup>

## Conclusion

This essay has shown that there exists no copyright protection for movie titles and while characters in movies can be afforded protection if they are sufficiently delineated in copyrightable works, such a protection is severely constrained by existing norms of fair use defence for periodic works. As regards trade mark protection, movie titles and characters can be registered if they have acquired distinctiveness; however, infringement can be sustained only if there is a 'likelihood of association' and more popular the movie is, less is such a likelihood. In sum, it can be concluded that whereas trade mark protection to characters and titles in a movie, is stronger than copyright protection; however, both the regimes do not provide adequately strong protection to titles and characters in a movie. While the Hindi Film Industry is one of the largest film industries in the world, its creative input is suspect and it is known to borrow characters plot etc, freely from other film industries, especially from Hollywood: the movie *Sholay* itself borrows in various themes from movies such as *Magnificent Seven* and *Akira Kurosowa's Last Samurai*.<sup>38</sup> Where titles and characters in movies are weakly protected by copyright and trade mark laws, legal challenges for infringement have being few

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<sup>35</sup> See id.

<sup>36</sup> MANU/DE/7193/2007: 138 (2007) DLT 312

<sup>37</sup> See Id. at Para 32-33

<sup>38</sup> See supra note 7.

and far between. Thus, drawing a lesson from the current state of the Hindi Film Industry, any step to strengthen copyright and trade mark protection over titles and characters in movies would lead to more creative innovation in the Hindi Film Industry, and thus, would be a welcome step.

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