



**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
CIVIL APPELLATE JURISDICTION
APPEAL FROM ORDER NO.438 OF 2023
WITH
INTERIM APPLICATION NO.7917 OF 2023**

... Appellant

... Respondent

Mr. Hiren Kamod with Mr. Aatir Saiyed i/by Khurana and Khurana, for Appellant.
Mr. Amit A. Patil with Ms. Samruddhi Bendbhar i/by Ms. Anitha Krishnamurthy and
Parinam Law Associates, for Respondent.

**CORAM : N.J.JAMADAR, J.
RESERVED ON : 17 JULY 2023
PRONOUNCED ON : 13 DECEMBER 2023**

JUDGMENT :

1. This appeal is directed against an order dated 21 February 2023 passed by the learned District Judge on an application (Exhibit 5) in Civil Suit No.19 of 2022 whereby the learned District Judge was persuaded to restrain the Appellant-Defendant from, either directly or indirectly, in any form, publishing or making any statement alleging copyright infringement against the Plaintiff and also from publishing defamatory statements alleging copyright infringement against the Plaintiff, and also

from extracting, excerpting, mutilating any part of the Plaintiff's Literary Work and publishing the same, till the disposal of the suit, which has been instituted for restraining the Appellant-Defendant from giving groundless threat of legal proceeding alleging infringement, under Section 60 of the Copyright Act, 1957.

2. The background facts leading to this appeal can be stated, in brief, as under :

2.1 The Plaintiff is an author and has been self-publishing literary works under her own name "Sapna Bhog" in the romance genre. The Plaintiff has been self-publishing her works on the Amazon Kindle platform since the year 2019. On account of her original authorship of various forms of literary works, the Plaintiff has developed a distinct style of writing and various Plaintiff's works have been featured on best seller lists of Amazon, on many occasions. Amongst many titles, the Plaintiff has ideated on, created and written Indie romance title "The Bond of Brothers".

2.2 The Defendant is also an author. The Defendant has published works in the Indie romance genre.

2.3 The Plaintiff asserts, "The Bond of Brothers" series commenced with the first title "My Ruin". It was published on 17 August 2021 and soon featured on the Amazon Best Sellers list. The second title of "The Bond of Brothers Series", namely, "My Rebel" was published on 26 April 2022. The Plaintiff alleged, the Defendant published a statement on social media platform on 8 May 2022, baselessly and

malafide predicting that the work of the Plaintiff that had yet been unwritten and, therefore, unreleased, would be copied work and the existing second title “My Rebel” was also a copied work. The Defendant indulged in baseless comparison of the Defendant’s literary work “wicked Trap” and the Plaintiff’s then still unwritten third title “My Enemy”. It was falsely alleged that the Plaintiff had copied the Defendant’s cover art of the Defendant’s Series “The Varma Brothers”.

2.4 On 28 July 2022, the Plaintiff avers, the Defendant malafide published a baseless statement that the fourth title in the Plaintiff’s series “My Sinner” is the copy of the Defendant’s title “Devil’s Love”. The insinuation of plagiarism was directed against the Plaintiff. On that day, the Defendant allegedly posted a social media statement in the form of a story alluding that the Plaintiff’s literary work in the Series “The Bond of Brothers” was an unauthorized copy of the Defendant’s literary work, “The Varma Brothers” Series.

2.5 The Plaintiff alleged that the baseless, reckless and malafide statements made by the Defendant mired the name and reputation of the Plaintiff in the esteem of the “Romance Genre” readers. The said allegations damaged the reputation of the Plaintiff and also adversely affected the sales of “The Bond of Brothers” Series. On 2 August 2022, the Defendant mala fide directly named the Plaintiff in a social media post making wild allegations. Thus, reckless allegations of copyright infringement, according to the Plaintiff, generated hate in the minds of the readers. Due to such acts

and omissions of the Defendant, the Plaintiff suffered immense mental agony and harassment. The Defendant indulged in such unlawful acts to derive undue advantage and also lower the Plaintiff's image and that seriously impacted the ratings of the Plaintiff's literary work.

2.6 The Plaintiff, therefore, addressed a legal notice on 8 August 2022, calling upon the Defendant to cease and desist from making such wild allegations, pull down false and defamatory posts and tender an unconditional apology, and also demanded compensation.

2.7 In response thereto, the Defendant made the allegations of copyright infringement against the Plaintiff. The Defendant further contended that she had taken steps to protect her alleged copyrights and lodged a FIR. The Plaintiff was, thus, constrained to institute a suit to seek a declaration that the threat of copyright infringement action was groundless and also to restrain the Defendant from pursuing mala fide, baseless and groundless threat of action for infringement.

2.8 The Plaintiff, inter alia, contended that the claim of the Defendant of infringement of her copyright was wholly unsustainable. In the said suit, the Plaintiff prayed for temporary injunction to restrain the Defendant from making statements of infringement of copyright, defamatory statements and also from pursuing the groundless threat of infringement of copyright. An injunction was also sought to restrain the Defendant from extracting, excerpting, mutilating any part of the

Plaintiff's Literary works and publishing them.

2.9 The Defendant resisted the application. It was alleged that the Plaintiff was guilty of *suggestio falsi* and *suppressio veri*. The tenability of the suit was assailed on the ground that an action under Section 60 of the Copyright Act, was unsustainable as the Defendant had already initiated an action for infringement of copyright by lodging a FIR. It was alleged that the Plaintiff, being a wrongdoer, could not have resorted to a suit under Section 60 of the Copyright Act. Adverting to the proviso to Section 60 of the Act, the Defendant contends that, the suit, to restrain from pursuing groundless threat action of infringement, is misconceived as the Defendant had already lodged a criminal prosecution vide C.R.No.1561 of 2022 with the Cyber Crime Department of Police at Hyderabad, Telangana. The said prosecution constitutes a legal proceeding within the meaning of the proviso to Section 60 of the Copyright Act.

2.10 The Defendant, inter alia, contended that the Defendant is a well known, established and reputed contemporary author, since the year 2016. The Defendant had authored over 36 books. The Defendant had earned enormous reputation amongst the professional space and has garnered dedicated reader base across all countries. She had been featured in various publications, and by Amazon as an inspiration for authors and women entrepreneurs. The Defendant's literary works are original works and she holds exclusive copyright over them. As the best selling author, the Defendant has helped and encouraged other authors, including the Plaintiff. In

fact, the Plaintiff had expressed her wish to be able to write like the Defendant's best selling works.

2.11 The Defendant contends, by no stretch of imagination, an action for infringement of copyright by the Plaintiff at the instance of the Defendant, can be said to be groundless. Literary works of the Defendant are published prior in point of time. A cursory comparison of the Defendant's work "The Varma Brothers" and the Plaintiff's infringed work "The Bond of Brothers" coupled with the date of publication, would indicate that the Plaintiff had resorted to unabashed copying of the Defendant's literary works. Referring to the publications of the Plaintiff in "the Bond of Brothers" Series, in the context of the published literary works of the Defendant, the Defendant contends that there are substantial similarities in over all plot, sequence, setting and characterization. Even the cover of the books has been imitated substantially. Several readers have highlighted similarities between "the Varma Brothers" Series cover and the cover of the Plaintiff's publication. As the Plaintiff did not allow the Defendant to have a fair communication, the Defendant was constrained to post about unabashed infringement of the Defendant's copyright, on the social media platform. In substance, it is the case of the Defendant that the Plaintiff herself being an infringer of the copyrights of the Defendant, cannot claim declaratory and injunctive reliefs.

3. After appraisal of the pleadings, the material on record and the

submissions canvassed across the bar, the learned District Judge was persuaded to grant injunction, holding that the Plaintiff had succeeded in establishing the parameters for grant of interim relief. The learned District Judge repelled the contention of the Appellant-Defendant that in view of the proviso to Section 60 of the Act, 1957, the suit was not maintainable. Placing reliance on the decision of the learned Single Judge of this Court in the case of **Dhiraj Dharamdas Dewani V/s. Sonal Info Systems**¹ the learned District Judge returned a finding that the suit under Section 60 of the Act, 1957 would be maintainable, despite the Defendant having allegedly initiated a criminal action against the Plaintiff. The learned Judge was also of the view that, prima facie, the storylines of the books “The Varma Brothers” Series and “The Bond of Brothers” Series were different. The Plaintiff had, thus, succeeded in demonstrating that there were triable issues. The learned District Judge also found balance of convenience in favour of the Plaintiff and observed that, in the event the Defendant was not restrained, the Plaintiff would suffer an irreparable loss.

4. Being aggrieved by and dissatisfied with the impugned order, the Defendant has preferred this appeal.

5. I have heard Mr. Hiren Kamod, learned Counsel for the Appellant-Defendant and Mr. Amit Patil, learned Counsel for the Respondent-Plaintiff at some length. The learned Counsel took the Court through the pleadings and documents.

1 2012 SCC Online Bom 351

They have also tendered written submissions in elaboration of the submissions canvassed across the bar.

6. Mr. Kamod, learned Counsel for the Appellant submitted that the learned District Judge has approached the issue from an incorrect perspective. It was urged that the learned Judge committed a manifest error in law in placing reliance on the decision of this Court in the case of **Dhiraj Dharamdas Dewani (supra)**, which was declared to be *per incuriam*, and, thus, bereft of any precedential authority, by another learned Single Judge of this Court in the case of **Sanjay Soya Pvt. Ltd. V/s. Narayani Trading Company**².

7. Mr. Kamod submitted that the finding of the learned District Judge that despite the Defendant having initiated criminal action against the Plaintiff for infringement of copyright, a suit under Section 60 of the Act, was tenable, is in teeth of the plain language of the proviso to Section 60 of the Act, 1957, which specifically refers to “prosecution of an action for infringement of the copyright” and is not limited to institution of suit. On this count alone, according to Mr. Kamod, the impugned order deserves to be quashed and set aside.

8. As a second limb of the challenge to the tenability of the suit under Section 60 of the Act, 1957, Mr. Kamod would urge that, in any event, the Appellant-Defendant has instituted a suit against the Plaintiff before the Civil Court at

2 2021 (87) PTC 185 (Bom)

Hyderabad on 9 March 2023 and with the institution of the said suit, the instant suit to restrain the Defendant from pursuing groundless action, becomes infructuous. A strong reliance was placed on the decision of this Court in the case of **Music India Ltd. V/s. Super Cassettes Industries Pvt. Ltd. and Ors.**³ and a judgment of the Delhi High Court in the case of **Super Cassette Industries Ltd. V/s. Bathla Cassettes India**⁴ and the decision of the Supreme Court in the case of **M/s.Mac Charles (I) Ltd. V/s. Indian Performing Right Society**⁵.

9. Mr. Kamod strenuously submitted that the legal position is crystalized to the effect that the institution of the suit by a person who claimed infringement of copyright, renders the suit instituted under Section 60 of the Act alleging groundless threat of legal proceedings infructuous and it does not matter whether such former suit is instituted before or after the suit seeking the relief for the alleged groundless threat of legal proceedings. Thus the impugned order cannot stand, submitted Mr. Kamod.

10. It was further urged by Mr. Kamod that the learned District Judge has transgressed the remit of the suit under Section 60 of the Act, 1957. The learned District Judge unjustifiably ventured into the question as to whether a case of infringement of the copyright was made out by the Defendant. In a suit under Section 60 of the Act, the Court had no cause or occasion to embark upon an inquiry as to whether the Plaintiff has prima facie infringed the copyright of the Defendant. The

3 1987 SCC Online Bom 753

4 AIR 1994 Del 237

5 SLP(C) 39994 of 12.

learned District Judge has recorded a finding that there is no infringement of the copyright as claimed by the Defendant in clear transgression of the jurisdiction, submitted Mr. Kamod.

11. Lastly, it was urged that a party who has unabashedly infringed copyright cannot be permitted to take refuge in a suit under Section 60 of the Act, when the person claiming copyright has invoked both civil and criminal remedy. The learned District Judge, according to Mr. Kamod, lost sight of this crucial aspect and went on to hold that the balance of convenience tilts in favour of the Plaintiff and the latter would suffer an irreparable loss. Therefore, it is necessary to interfere with the exercise of discretion by the trial Court, submitted Mr. Kamod.

12. Mr. Patil, learned Counsel for the Respondent-Plaintiff, countered the submissions of Mr. Kamod. Mr. Patil advanced submissions on the premise that the FIR lodged by the Defendant in the instant case, if properly construed, constituted a threat of groundless action. Elaborating the submission, Mr. Patil would urge that the criminal enforcement action is not an action contemplated by the proviso to Section 60 of the Act. Taking the Court through the text of Section 60 of the Act, Mr. Patil would urge that, at best, the lodgment of the FIR can be construed to be commencement of an action and cannot be said to be prosecution. The legislature, according to Mr. Patil, was careful to use the conjunction 'and' in the phrase 'commences and prosecutes'. Therefore, prosecution of an action can only be before

a court of law. Reliance was sought to be placed on the decision of the Supreme Court in the case of **General Officer Commanding, Rashtriya Rifles V/s. Central Bureau of Investigation and Anr.**⁶ wherein the distinction between the phrases – prosecution, judicial proceedings and legal proceedings was explained.

13. Mr. Patil would further submit that the action contemplated by the proviso to Section 60 of the Act, must be an action in which there could be effective and complete adjudication of the disputes which is possible only in proceedings before the Court. Mere lodging of the FIR by itself cannot defeat the statutory right of a person threatened of groundless action to seek relief under Section 60 of the Act. To lend support to this submission, Mr. Patil placed strong reliance on the decisions in the cases of **Rajni Industries V/s. Bhartiya Dhoop Karyalaya and Ors.**⁷, **Chartered Institute of Taxation V/s. Institute of Chartered Tax Advisors of India Ltd.**⁸, **Bristol Myers Squibb Holdings Ireland Unlimited Company and Ors. V/s. Natco Pharma**⁹, and **Siddharth Wheels Pvt. Ltd. V/s. Bedrock Ltd. and Anr.**¹⁰.

14. Mr. Patil urged with tenacity that the decision in **Dhiraj Dharamdas Dewani (supra)**, cannot be said to be denuded of precedential authority completely. One of the propositions enunciated by **Dhiraj Dharamdas Dewani (supra)** that the lodgment of FIR constitutes a threat of groundless action under Section 60 of the Act,

6 (2012) 6 SCC 228
 7 2001 SCC Online Del 480
 8 2019 SCC Online Del. 10037
 9 2020 SCC Online Del. 200
 10 AIR 1988 Del. 228

according to Mr. Patil, continues to be a good law. In fact, the said decision of this Court in the case of Dhiraj Dharamdas Dewani (supra) has been referred with approval by the Delhi High Court in the case of Elofic Industries Ltd. and Anr. V/s. Mobis India Ltd. and Anr.¹¹

15. Mr. Patil would urge that the object of incorporation of Sections 63 and 65 in the Copyright Act, deserves to be kept in view. It is essentially a counter piracy measure. Therefore, the proviso to Section 60 is required to be given restricted meaning so as to avoid absurd consequence, lest a mere lodging of FIR, howsoever mala fide it may be, would take away the statutory remedy under Section 60 of the Act. To buttress this submission, Mr. Patil banked upon the pronouncement of the Karnataka High Court in the case of ANI Technologies & Ors. V/s. State of Karnataka and Anr.¹², a decision of this Court in the case of Keshavlal Premchand V/s. The Commissioner of Income Tax¹³ and a decision of the Allahabad High Court in the case of Anwar Hasan Khan V/s. District Judge, Shahjahanpur and Ors.¹⁴.

16. Mr. Patil further urged that in the facts of the instant case, the learned District Judge has correctly exercised the discretion. The instant being an appeal against the discretionary order, this Court may not be justified in interfering with the order passed by the learned District Judge, unless the court records a finding that the

11 (2019) 77 PTC 128

12 WP No.32942 of 2017

13 AIR 1957 Bom 20

14 2000 AIHC 3152

order is perverse. In the facts of the case, according to Mr. Patil, no such taint of perversity arising out of consideration of irrelevant material, non-consideration of the material which bears upon the controversy or taking a view which, in the circumstances of the case, no prudent person could have taken, can be attributed. Thus, the impugned order does not deserve any interference, submitted Mr. Patil.

17. The aforesaid submissions now fall for consideration.

18. To begin with, it may be apposite to note few uncontroverted facts. Firstly, the Plaintiff claimed to have invoked statutory remedy under Section 60 of the Act. In addition to the alleged publications on social media, lodging of FIR by the Defendant, was made a part of the cause of action for the said suit. FIR No.1561 of 2022 was lodged on 30 August 2022, initially for the offences punishable under Sections 385 and 506 of IPC. It seems, the Investigating Officer sought permission of the jurisdictional Court to add charge for the offences under Sections 63 and 65 of the Copyright Act, 1957. The suit was instituted on 8 November 2022. Evidently, FIR was lodged prior to the institution of the suit. It is necessary to note that till passing of the impugned order, the Defendant had not instituted any civil proceedings for the alleged infringement of the copyright. The Defendant claimed to have instituted such suit on 9 March 2023. The tenability of the suit under Section 60 of the Act was, thus, contested on the count that the Defendant had already initiated a criminal action by lodging FIR against the Plaintiff, and, thus, the proviso came into play.

19. As the controversy revolves around the remit of a suit under Section 60 and the true import of the proviso to Section 60 of the Act, it may be expedient to extract Section 60, which reads as under :

“60. 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 an 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 does not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of the copyright claimed by him.”

20. From the phraseology of Section 60, it becomes abundantly clear that its object is to provide a remedy to a person who is threatened with a groundless action of infringement of copyright. Two ingredients are discernible. (1) There should be manifest threat of action for infringement by the person who claims copyright in any work. (2) The person threatened ought to be in a position to demonstrate that the threats were groundless in the sense that there was, in fact, no infringement of any legal rights of the person making such threats. The nature of the remedies which the

person threatened with groundless action can have, is also spelled out by the text of Section 60. Such aggrieved person can seek a declaration that the alleged infringement to which the threat related was not, in fact, an infringement of any legal right of the person giving such threat. The aggrieved person can obtain an injunction against continuance of such threat and also recover the damages, if any, which he had sustained on account of groundless threat of action for infringement.

21. The proviso to Section 60, restricts the scope of application of the enacting part of Section 60. It provides that the said Section shall not apply if the person making such threat, with due diligence, commences and prosecutes an action for infringement of the copyright claimed by him. The crucial phrases in the proviso are “with due diligence” and “commences and prosecutes an action for infringement”. The phrase “due diligence” connotes that the action is initiated in good faith and with such care, caution and foresight as the circumstances of the particular case demand. The phrase “commences and prosecutes” in turn, indicates that threat of action ought not to be an empty rhetoric, but prosecution of the cause in the right earnest. If these conditions are satisfied, the action cannot be termed as groundless and, therefore, the main part of Section 60 providing a remedy in case of groundless threat ceases to operate.

22. The import and interplay between the main part and the proviso to Section 60 fell for consideration before this Court in the case of **Music India Ltd.**

(supra), wherein the Defendants, who were found to have prima facie committed breach of the Plaintiff's copyright in the musical works, had instituted a suit in the court of District Judge at New Delhi under Section 60 of the Copyright Act, 1957, a little prior to the institution of the suit for infringement of the copyright before this Court. The Defendants had obtained ad-interim order from the District Court at Delhi in the said suit.

23. In the aforesaid factual backdrop, after adverting to the provisions contained in Section 60 of the Act, this Court concluded that Section 60 ceases to apply after the Plaintiff instituted the suit before this Court and the entire suit (under Section 60 of the copyright Act) instituted by the Defendants therein, including injunction obtained therein, had become infructuous and inoperative. This Court observed, inter alia, that :

“6. The provisions of sec. 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 reasons 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 position 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. The suit before the Delhi District Court is admittedly under sec. 60 of the Copyright Act, 1957. The 1st defendants were therefore entitled to obtain only an injunction against the continuance of any wrongful threat of infringement. Once a suit is filed – as it is filed in the present case – for infringement of the copyright, by the person who has given the threat the suit under sec. 60 becomes infructuous as the Section ceases to apply in such situation. The 1st Defendants have obtained an interim order from the District Court at Delhi in this suit under Sec. 60 of the said Act. The copy of this ad-interim order which is produced before me is illegible. According to the 1st Defendants, they have obtained an order restraining the Plaintiffs from interfering with the rights of the 1st defendants to manufacture and market cassettes containing songs of film ‘Janbaaz’ except the songs sung by Sapna Mukherjee till further orders. It is doubtful whether such an injunction could have been granted under the provisions of sec. 60 of the said Act and prima facie the injunction appears to be without jurisdiction in any case this section has ceased to apply after the plaintiffs have filed the present suit and the entire suit including injunction obtained therein have become infructuous and inoperative.” (emphasis supplied)

24. To the similar effect is the enunciation by the Delhi High Court in the case of **Super Cassette Industries Ltd. (supra)**, wherein it was observed, inter alia, as under :

“6. 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 provision to this Section makes this position 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.....”

25. The aforesaid judgment in the case of **Super Cassette Industries (supra)**, was referred with approval in the order passed by the Supreme Court in the case of **Mac V/s. Indian Performing Right Society (supra)**, as under :

The judgment and order in the matter of “Super Cassette Industries Ltd. V/s. Bathla Cassettes India (P) Ltd. (supra), has further clarified the proviso which makes the position clear 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.”

26. The aforesaid enunciation of law would indicate that once an action is initiated for the alleged infringement of copyright by the person who claims to be the owner thereof, albeit bona fide and with due diligence, the aspect of infringement or otherwise of the copyright, is to be adjudicated in such a proceeding and the remedy

for the alleged groundless threat of legal proceeding ceases to operate. The fact that such action for infringement of the copyright has been initiated by the person claiming the copyright subsequent to the institution of the suit under the main part of Section 60, is of no consequence. Even if the proceeding for infringement of copyright is instituted subsequently, a suit for groundless threat becomes infructuous as Section 60 itself ceases to apply. It thus emerges that where a person claiming copyright has already instituted a proceeding for infringement of the copyright, a suit under Section 60 seeking remedy for groundless threat cannot be entertained. If such proceeding is instituted even after the institution of the suit under the main part of Section 60, still the proviso becomes operative and the suit under Section 60 becomes infructuous.

27. The reason is not far to seek. The object of Section 60 is not to restrain a person claiming to be the owner of the copyright from instituting a proceeding for infringement of the copyright. Its true purpose is to provide remedy in case of groundless threat of legal proceedings or liability. Once such proceeding for infringement of copyright is instituted, with due diligence, the rights and liabilities of the parties must be decided in the said proceeding.

28. As noted above, in the case at hand, the issue before the learned District Judge was whether the lodging of the FIR constituted an action for infringement of the copyright within the meaning of the proviso to Section 60 as, admittedly, till the decision of the application, the Defendant had not instituted a suit for infringement of

the copyright.

29. Lodging of the FIR, according to Mr. Patil, did not constitute an action as contemplated by the proviso to Section 60 of the Act, 1957. The thrust of the submission of Mr Patil was that such an action ought to be in the nature of a proceeding, which could afford effective and complete adjudication of the dispute. It was submitted that, of necessity, such proceeding ought to be before a court of law.

30. In the case of **Rajni Industries V/s. Bhartiya Dhoop Karyalaya and Ors. (supra)**, on which reliance was placed by Mr. Patil, the question arose in the context of the provisions contained in Section 120 of the Trade and Merchandise Marks Act, 1958 which were, by and large, identical with Section 60 of the Copyright Act. A learned Single Judge of the Delhi High Court, after adverting to the decision in the case of **Siddharth Wheels Pvt. Ltd. V/s. Bedrock Ltd. and Anr. (supra)**, enunciated the legal position as under :

“11. On a reading of the aforesaid provisions of Section 120 (1) & (2) of the Act and position of law laid down in the aforesaid judgments, the predominant position of S. 120(2) becomes evident. In particular the judgment in Sidharth Wheels Pvt. Ltd.'s Case (supra) lays down very clearly the remedy of Section 120(1) is available only when a proceeding is threatened and ceases to operate once a proceeding in a Court of Law has been instituted as is clear form the language of the Sub-section (2) of Section 120 which is predominant in nature and which prohibits the operation of Sub-section (1) in a situation where an action is commenced by the registered user under Section 51 of the Act. Sidharth Wheel's Judgment (supra) further holds that the only qualification for the applicability of S.120 (2) is that the

suits under S. 120 (1) & S.120 (2) must have the same subject matter. The above test of similarity of the matter is fully satisfied by the plaintiff's own pleading in IA 8591/99, filed under Section 24 of CPC. Therefore, if the Registered Proprietor of the trade mark commences and prosecutes an action against the person threatened, for infringement of the trade mark, then S. 120(1) ceases to apply and action under it cannot be maintained. There is no dispute in the present case that not only a criminal complaint has been filed under Section 200 of Cr.P.C. by the defendant in the month on August, 1999 against the plaintiffs for committing offences under Section 77, 78 and 89 of Trade & Merchandise Marks Act, 1958 read with Section 420/34 of IPC Along with an application under Section 93 Cr.P.C. for issuance of warrants for search & seizure of goods bearing false trade mark, labels, etc.; but prior to the date of the filing of the present suit, i.e., 25th of August, 1999; a Civil Suit had also been filed by the defendants on 19th of August, 1999. Thus the two proceedings, i.e., criminal complaint and civil suit filed by the defendants could constitute a cause of action under Sub-section(1) such cause of action ceases to be available once proceedings specified under Section 120(2) are initiated."

31. In the case of **Siddharth Wheels Pvt. Ltd. V/s. Bedrock Ltd. and Anr.** (supra), the question before the Delhi High Court was whether the suit under sub-section (1) of Section 120 of the Trade and Merchandise Marks Act, 1958, can be continued inspite of the Defendants therein commencing and prosecuting an action for declaration and injunction against the Plaintiff and if such suit survives, the nature of interim order to be made therein. A learned Single Judge of the Delhi High Court, after analysis of the text of Section 120 of the said Act, 1958, which is almost *pari materia*, Section 60 of the Copyright Act, held that

“there can be no doubt that the subject matter of the action under sub-Section (2) must be the same as that of the proceedings threatened and forming part of the cause of action under sub-Section (1) of Section 120 of the Act. Otherwise, the very purpose and object sought to be achieved by the Legislature by enacting the two sub-sections together in S. 120 of the Act would be frustrated.Legislative provision must be construed to make sense and to make it meaningful rather than to render it vague and ambiguous the only way to achieve that object is to reasonably construe sub-section (2) as requiring an action for infringement of trade mark to be commenced and prosecuted for an effective and complete adjudication of all matters in controversy between the parties in respect of the use of the trade mark.

32. In **Bristol Myers Squibb Holdings Ireland Unlimited Company and Ors. (supra)**, another learned Single Judge of the Delhi High Court, in the context of allegations of infringement of Patent, considered the import of Section 142 of the Trade Marks Act, 1999 and Section 60 of the Copyright Act, and, observed as under :

“15. Prior to the Patents Act, 1970, the law relating to patents was governed by the Indian Patents and Designs Act, 1911 (hereinafter, the 1911 Act) which, vide Section 162 of the Patents Act, 1970, was repealed insofar as it related to patents. Section 36 titled "Remedy in case of groundless threats of legal proceedings" of the 1911 Act, while enabling a person to institute a suit to obtain an injunction against the continuance of threat of legal proceedings or liability in respect of an alleged infringement of patent, in proviso thereto provided that the said provision shall not apply if any action for infringement of the patent was commenced and prosecuted with due diligence. The same was thus at par with the provisions in the other statutes governing the intellectual property rights of Trade Mark and Copyright. However, while enacting the 1970 Act and providing Section 106 therein, the proviso as

existed to the pari materia provision in the 1911 Act, was deleted.....

33. In the case of **Chartered Institute of Taxation (supra)**, the controversy arose in the context of the provisions of Section 142 of the Trade Marks Act, 1999 which are more or less similar to that of Section 60 of the Act, 1957. The Court observed as under :

“12. Reference in this regard may also be made to (i) Super Cassette Industries Ltd. Vs. Bathla Cassettes India (P) Ltd. (supra); (ii) Dolphin Laboratories Pvt. Ltd. Vs. Kaptab Pharmaceuticals, AIR 1981 Cal 76 holding that while restraining a person from making unjustified threats, it is not open to the Court to restrain him from taking the matter to a Court of Law and from agitating his rights there; the right to institute a suit was held to be an important and vital right incapable of being interfered with except by a statutory bar; (iii) Value Invest Wealth Management (India) Private Limited Vs. B.G. Kishore Kumar 2011 SCC OnLine MP 2397, where notice issued by the defendant to the plaintiff asking the plaintiff to cease and desist from infringing the trade mark of the defendant was held to be not a groundless threat within the meaning of Section 142 of the Trade Marks Act, reasoning the said notice to be in aid of intending legal proceedings and further holding that the defendant could not be restrained from exercising its legal rights; and, (iv) Sachdeva and Sons Industries Pvt. Ltd. Vs. Jain Riceland Pvt. Ltd. MANU/PH/2565/2016 holding that a proceeding under Section 142 of the Trademarks Act or Section 60 of the Copyright Act does not lie against a legal action.”

34. Considered in the light of the aforesaid enunciation of law, the text of the proviso to Section 60 of the Act, 1957, becomes more clear and understandable. On the one hand, the object of Section 60 of the Act, is not to restrain a person claiming

copyright from instituting a proceeding for infringement of the copyright. On the other hand, as noted above, the aforesaid phrases employed in Section 60 warrant that such a proceeding must be a meaningful one and prosecuted with due diligence. Such proceeding ought to be capable of affording resolution of the disputes between the parties on the aspect of the infringement of the copyright, effectively and completely. The word “action” is governed by the expression “commences and prosecutes.... for infringement of copyright”. Thus, a proceeding which may not afford the adjudication and resolution of the dispute over the alleged infringement of the copyright, would not constitute an “action” contemplated by the proviso.

35. This leads me to the fulcrum of the submission of Mr. Kamod that FIR does not amount to a groundless threat within the meaning of Section 60, but constitutes an ‘action’ under the proviso thereto.

36. Manifestation of threat can be in varied forms. Section 60 of the Act, employs the words “by circulars, advertisements, or otherwise, threatens”. On the first principles, the threat of a criminal prosecution, either by way of notice or lodging a complaint or report with the police, falls within the ambit of threat envisaged by Section 60 of the Act. For that purpose, resort to the proposition in the case of **Dhiraj Dharamdas Dewani (supra)**, may not be necessary. Therefore, the reliance on the decision in the case of **Dhiraj Dharamdas Dewani (supra)**, by the learned District Judge, to draw support and sustenance to the finding that the lodging of the

FIR constitutes a threat within the meaning of Section 60 of the Act, appears to be of decisive significance.

37. The real question that wrenches to the fore is, can the FIR be construed as a threat, or does it satisfy the description of an 'action' under the proviso to Section 60 of the Act? Let's explore an answer. As noted above, if a proceeding partakes the character of action contemplated by Section 60, it cannot be construed as groundless threat and, resultantly, Section 60 itself ceases to operate. The groundless threat of legal proceeding or liability can be in varied forms. The legislature has, therefore, designedly used the expression "or otherwise". The form of groundless threat cannot be confined in a straight jacket by making an effort to give illustrations. In fact, if properly construed, the form and manifestation of groundless threat hardly matters. What is of salience is, whether the threat of legal proceeding or liability in relation to infringement of copyright is groundless.

38. Mr. Kamod laid emphasis on the fact that the proviso to Section 60 employs the terms, "commences and prosecutes". No word used by the legislature can be construed to be redundant. The use of the word "prosecutes" indicates that the criminal prosecution for infringement of the copyright was envisaged by the legislature as an action contemplated by the proviso to Section 60 of the Act.

39. The proposition that the court should adopt such interpretation which does not render the word used by the legislature redundant is well recognized.

Reliance placed by Mr. Kamod on the Constitution Bench judgment in the case of **Nathi Devi V/s. Radha Devi Gupta**¹⁵ appears to be well founded. The Supreme Court held as under :

“14. It is equally well settled that in interpreting a statute, effort should be made to give effect to each and every word used by the legislature. The courts always presume that the legislature inserted every part thereof for a purpose and the legislative intention is that every part of the statute should have effect. A construction which attributes redundancy to the legislature will not be accepted except for compelling reasons such as obvious drafting errors. (see State of U.P. V/s. Dr. Vijay Anand Maharaj¹⁶, Rananjaya Singh V/s. Bajjnath Singh¹⁷, Kanai Lal Sur V/s. Paramnidhi Sadhukhan¹⁸, Nyadar Singh V/s. Union of India¹⁹, J.K.Cotton Spg. And Wvg. Mills Co. Ltd. V/s. State of U.P.²⁰ and Ghanshyamdas V/s. CST²¹.

15. It is well settled that literal interpretation should be given to a statute if the same does not lead to an absurdity.”

40. Consistent with the aforesaid position in law, even if we were to give full play to the word “prosecutes”, it cannot be said to have been used only in the context of “the prosecution of criminal action”. The word “prosecutes” is compatible with commencement and prosecution of a purely civil action as well. Therefore, for the mere reason that the word “prosecutes” is used in the proviso to Section 60, it cannot be urged that the proviso covers the FIR.

15 (2005) 2 SCC 271

16 AIR 1963 SC 946

17 AIR 1954 SC 749

18 AIR 1957 SC 907

19 (1988) 4 SCC 170

20 AIR 1961 SC 1170

21 AIR 1964 SC 766

41. Mr. Kamod further submitted that the use of the word “prosecutes” in the proviso to Section 60 is required to be appreciated in the light of the fact that under the Copyright Act, 1957, a person whose copyright has been infringed, has both civil and criminal remedies. Inviting attention of the Court to the provisions contained in Sections 63 and 65 of the Copyright Act, 1957, Mr. Kamod would urge that the legislature has provided criminal remedy, in equal measure. Therefore, it cannot be said that FIR does not constitute an action within the meaning of the proviso to Section 60 of the Act.

42. Indisputably, the infringement of copyright gives rise to both civil and criminal liability. A person whose copyright is infringed can set the criminal law in motion to prosecute and punish the infringer. Where a private complaint is lodged before the criminal court or FIR is lodged with all the particulars requisite for determination of the question of infringement of copyright, which eventually leads to a trial on the question of infringement of copyright, it would be rather difficult to hold that the FIR would not constitute an action within the meaning of the proviso to Section 60 of the Act. Had the legislature intended that it is only the ‘suit’ for infringement of the copyright, which would render the main part of Section 60 inoperative, the legislature could have used the said expression. Instead, the legislature has designedly and advisedly used the term “action”

43. Thus the position which obtains is that, whether the FIR constitutes a

threat of groundless action under the main part of Section 60 or constitutes an ‘action’ under the proviso thereto, turns on the facts of the given case. It would be hazardous to lay down an abstract proposition that FIR does not amount to threat of groundless action or that once FIR is lodged, main part of Section 60 ceases to operate *eo instante*. In my view, the proper question to be posed is, whether the FIR satisfies the description of an “action” ?

44. Reverting to the facts of the case, it is imperative to note that the FIR No.126 of 2022 was registered by Cyber Crime Police Station initially for the offences punishable under Sections 385 and 506 of IPC. Subsequently, the Investigating Officer, with the permission of the learned Magistrate, seems to have added the offences punishable under Sections 63 and 65 of the Copyright Act, 1957. Though an endeavour was made on behalf of the Plaintiff to urge that there is no clarity as to the date on which Sections 63 and 65 came to be added, yet, in view of the consistent legal position noted above, the aspect as to whether the charges for the offences punishable under Sections 63 and 65 of the Act, 1957 came to be added prior or subsequent to the institution of Section 60 suit, pales in significance.

45. I have perused the allegations in the FIR. Indeed, there is an allegation of attempt to extort Rs.25 Lakhs from the Defendant – first informant and intimidation on phone by a person claiming to be a policeman. At the same time, the allegations in the FIR are primarily of the alleged unabashed copying of the literary work of the first

informant. In fact, the Defendant has alleged that the Plaintiff had resorted to copying of the scheme, character and plot of the story of “the Varma Brothers” of the Defendant, in writing “the Bond of Brothers”. Prima facie, the allegations of infringement of copyright have been made with sufficient clarity.

46. In the facts of the case, at this stage, the aspect as to whether the aforesaid FIR passed the muster of “action” under the proviso to Section 60 does not merit an answer in view of subsequent development, which denuded the said FIR the character of proceeding in which the issue of infringement of copyright could be agitated and adjudicated. The Plaintiff instituted a Petition, being Criminal Petition No.2788 of 2023, in the High Court for the State of Telangana at Hyderabad under Section 482 of the Code of Criminal Procedure, 1973. The High Court stayed all further proceeding against the Plaintiff – Petitioner therein, in Crime No.1561 of 2022 by Cyber Crime Police Station, Hyderabad. The High Court, inter alia, noted that the Civil Court had found that there may be similarities in between the books written by the Plaintiff and Defendant, however, it did not amount to copyright infringement.

47. Mr. Kamod, learned Counsel for the Appellant submitted that the situation which thus obtained was that the Appellant-Defendant cannot prosecute an action envisaged by the proviso to Section 60 of the Act. It was urged that the definitive finding by the learned District Judge that there was no infringement of copyright, virtually rendered the Defendant remediless.

48. Faced with the aforesaid situation, the Defendant seems to have instituted the suit for infringement of copyright post passing of the impugned order. Nonetheless, the action represented by the said suit may fall within the ambit of the proviso to Section 60 of the Copyright Act.

49. Evidently, the learned District Judge had not had the benefit of the case of infringement of copyright set up by the Defendant in the said suit. It is necessary to examine and assess, what is the nature of claim of infringement of copyright, the averments made in the plaint in the context of the alleged infringement and ultimately the prayers in the suit, to ascertain as to whether the subject matter of the action under the proviso to Section 60 of the Act, is the same as that of the proceeding threatened and forming part of the cause of action for the suit under the main part of Section 60 of the Act. In each of the judgments referred to above, including the decisions in the cases of **Music India Ltd. V/s. Super Cassettes Industries Pvt. Ltd. and Ors. (supra)**, **Super Cassette Industries Ltd. V/s. Bathla Cassettes India (supra)**, **Siddharth Wheels Pvt. Ltd. V/s. Bedrock Ltd. and Anr. (supra)**, and **Chartered Institute of Taxation V/s. Institute of Chartered Tax Advisors of India Ltd. (supra)**, upon consideration of the nature of the suit instituted for the alleged infringement of the trade mark or copyright, as the case may be, the Court could arrive at a conclusion as to whether the proviso to Section 60 or sub-Section (2) of Section 120 of the Trade and Merchandise Marks Act, 1958 and Section 142 of the Trade

Marks Act, 1999, came into play. Since the said suit was not instituted before the impugned order came to be passed, it may not be appropriate to interfere with the impugned order on the abstract ground that subsequently a suit for infringement of the copyright has been instituted by the Defendant.

50. The submission of Mr. Kamod that the learned District Judge has exceeded the jurisdiction in delving deep into the questions as to whether there is indeed infringement of the copyright of the Defendant, and in recording a definitive finding that there is no such infringement of copyright by ascribing elaborate reasons, appears to carry substance. The observations in para Nos.35 to 45 of the impugned order give an impression that the learned District Judge has recorded a definitive finding, at an interim stage, that though there is similarity in the works, there is no infringement of copyright.

51. It is true to determine the question as to whether the alleged infringement to which the threat related was not, in fact, an infringement of any legal right of the person giving such threat, it is necessary to examine the claim of infringement. However, such an inquiry cannot partake the character of determination as to whether there is indeed no infringement of copyright, lest such a finding has the propensity to preempt and prejudge an action for infringement of copyright, which the owner may institute. Such an inquiry can be legitimately embarked upon in an action covered by the proviso to Section 60 of the Act. The impugned order, in my

considered view, transgresses the remit of determination under the enacting part of Section 60 of the Act, as it ventures deep into the arena of infringement of the copyright or otherwise, in substance.

52. In the peculiar facts of the case, in my view, it would be necessary to have the determination by the trial Court on the issue as to whether the aforesaid suit for infringement of the copyright falls within the ambit of the proviso to Section 60 of the Act and its resultant effect on the instant suit and the order passed therein. I am, therefore, impelled to remit the matter back to the learned District Judge for deciding application afresh after considering the plaint in the suit instituted by the Defendant purportedly for infringement of copyright and providing an opportunity of hearing to the parties with regard thereto.

53. As the impugned order is in operation since 21 February 2023, I deem it appropriate to continue the said order as an ad-interim relief, till afresh decision on the said application.

54. Hence, the following order :

ORDER

- (i) The appeal stands partly allowed.
- (ii) The impugned order dated 21 February 2023 stands quashed and set aside.
- (iii) The application (Exhibit 5) is remitted back to the Court of

learned District Judge, Pune, for determination afresh. after providing an opportunity to the Defendant to place a copy of the plaint in the suit instituted by the Defendant in the City Civil Court at Hyderabad and a further opportunity of hearing to both the parties.

(iv) Till the decision of the application (Exhibit 5) afresh, the impugned order shall continue to operate as an ad-interim order.

(v) The parties shall appear before the learned District Judge, Pune, on 4th January 2024.

(vi) The learned District Judge is requested to make an endeavour to decide the said application (Exhibit 5) as expeditiously as possible.

(vii) Interim Application also stands disposed.

(viii) No costs.

(N.J.JAMADAR, J.)