

# FAIR USE OF CINEMATOGRAPH FILMS AND SOUND RECORDINGS: FINDING THE SOLUTION IN THE AMENDMENT

*Lawrence Liang\**

*With enhanced access to cheaper communication technology, a large majority of the public has moved from being mere passive consumers to active creators and re-mixers of content. The Copyright (Amendment) Act of 2012 has also extended the 'fair dealing' provision to all works. In this context, a crucial question that arises is what constitutes 'fair dealing' of cinematograph films and sound recordings, especially in the context of 'criticism and review'. This paper examines the ambit of 'criticism' and the extent to which re-contextualised works such as parodies would be protected as a critique of the original. The provision for fair dealing is also analysed through the prism of the right to freedom of speech and expression. The possibility of conflict between the moral rights of the author of a work and the fair dealing provision is also explored. Through this paper, the author argues for a wider reading of the term 'criticism' along with the recognition of quotation rights, to ensure that the grant of the copyright does not become an unreasonable restriction on free speech and expression.\*\**

## I. INTRODUCTION

“Cinema constantly remakes itself, but whether this is understood as homage, imitation or theft depends upon historically specific technologies such as copyright law and authorship, film reviewing and exhibition practices.”

(Constantine Verevis, 'Film Remakes')

In 2003, film critic and scholar Thom Andersen completed his three hour documentary titled, 'Los Angeles Plays Itself'. Even though the film was celebrated as an insightful enquiry into the relationship between the cities, architecture and cinema, yet, the film has never been officially released and can only be seen in the film festival circuit.<sup>1</sup> The primary reason for the non-release

---

\* B.A. L.L.B. (Hons.), National Law School of India University, Bangalore; L.L.M. in Law and Development at Warwick School of Law on the Chevening Scholarship. The author presently works with the Alternative Law Forum.

\*\* Abstract supplied by Editors.

<sup>1</sup> Chris Higgins, *The Late Movies: Los Angeles Plays Itself*, November 2, 2011, available at <http://mentalfloss.com/article/29146/late-movies-los-angeles-plays-itself> (Last visited on January 4, 2013).

of the film is the potentially high cost that Thom Anderson would have had to incur for payment of copyright royalty. The film is comprised entirely of video clips taken from different films depicting Los Angeles, with a voice over and commentary by the director. Thus, it was impossible for him to obtain permission for the use of all the clips or to pay royalties for their use.<sup>2</sup> In this context, one is forced to question the fate of similar projects and the history of cinema in Mumbai.<sup>3</sup>

This question could have been easily answered in the negative before the Copyright (Amendment) Act, 2012 ('Amendment') but it is perhaps a little more open ended after the Amendment. In this context, the paper attempts to look at the implications of extending fair dealing for the purposes of criticism and review to *all works* through the Amendment, and the extent to which it will be able to accommodate the different use of existing film clips and music.

§ 52(1)(a) of the Indian Copyright Act, 1957, was earlier restricted to literary, dramatic, musical or artistic works. However, the Amendment extends this provision to 'all works'. Most significantly, this means that cinematograph films and sound recordings are now brought within the ambit of § 52(1)(a) and the amended section reads as:

- (1) The following acts shall not constitute an infringement of copyright, namely:
  - (a) a fair dealing with *any work*, not being a computer programme, for the purposes of:
    - (i) private or personal use including research;
    - (ii) criticism or review, whether of that work or of any other work;
    - (iii) the reporting of current events and current affairs, including the reporting of a lecture delivered in public.

<sup>2</sup> *C.f.* BBC New Online, *Micro Budget Film wows Cannes*, May 18, 2004, available at <http://news.bbc.co.uk/2/hi/entertainment/3720455.stm> (Last visited on January 4, 2013) (Tarnation, a surprise hit of the 2004 Cannes and Sundance Film Festivals, highlights how royalty payments may be a serious impediment to contemporary creativity. Jonathan Caouette, an unemployed New York actor and doorman, made the film by editing and combining his own home movies with other video clips and music. Caouette spent \$218 making the film and observed that "[m]aking a movie is not as difficult as it is made out to be" and "[h]opefully this will be a catalyst for people who didn't have a voice before to go out and make a movie." After the film was declared a hit and people were interested in distributing it officially, it was estimated that the total cost for making Tarnation rose to over half a million dollars to obtain rights to use copyrighted music and video clips).

<sup>3</sup> A project of this nature was in fact undertaken in which a short collage film made up of film clips depicting Bombay, was curated by Ashish Rajadhyaksha and Amrit Gangar and this was shown in the Tate gallery.

The amendment has brought about a much needed correction to an archaic anomaly, whereby fair dealing did not extend to cinematograph films and sound recordings. However, the question that still remains is what constitutes fair dealing with respect to cinematograph films and sound recordings, especially in terms of ‘criticism and review’? A common problem that the copyright doctrine faces is that of a ‘one size fits all’ approach. Further, the copyright doctrine is applicable to different categories of works, thereby ignoring medium specificity.<sup>4</sup> The idea of ‘criticism and review’ reveals an inherent bias towards the print medium and the challenge would be to think of its extension to films and sound recordings. This leads us to a range of important questions, such as, does the incorporation of cinematograph films and sound recordings within the ambit of ‘criticism’ and ‘review’ solve the problem that plagues most film makers, namely, the ability to use small segments of a film or sound recording as a part of their film? One may also question whether there is a difference between quotation rights that are recognized for literary works and the use of a pre-existing cinematograph film clip within a film. Another question that requires contemplation is the extent of modification of an existing film or sound clip to create a ‘parody’ or ‘spoof’. Also, assuming that the creation of a parody is allowed under fair dealing, does it run the risk of violating the moral rights of the author?

In an era defined by You Tube and Facebook, we have seen a dramatic rise of amateur videos that build on existing materials, to create subversive or derivative videos which either critique the original video or use it as political satire.<sup>5</sup> In light of the other developments that have been brought about by the Amendment such as the rights of writers or fair dealing for the disabled,<sup>6</sup> the extension of fair dealing to cover ‘sound recordings’ and ‘cinematograph films’ would seem almost innocuous. In this context, I would argue that this Amendment leads to a number of conceptual challenges at the intersections of free speech and copyright. Further, it also raises the crucial issue of how copyright intersects with cultural and aesthetic practices. Much of the Amendment rests on how we interpret ‘criticism’ and ‘review’ in the domain of film and musical practice. The intention behind providing a fair dealing exception for criticism and review was the recognition that while writing or commenting about a work, the critic or commentator would have to reproduce a portion of the original work to illustrate their argument. This can be inferred from the history

---

<sup>4</sup> See generally Anne Barron, *Copyright and the Claims of Art*, (2002) I.P.Q: NO. 4, 368; Anne Barron, *The Legal Properties of Film*, (2004) 67(2) MODERN LAW REVIEW 177-208 (Anne Barron’s contribution to the debates on medium specificity and the problems posed to copyright).

<sup>5</sup> See, e.g., *Arnab Mash Up*, <http://www.youtube.com/watch?v=pBSKgkOppI> (Last visited on January 4, 2013) (The remix of the painted and dented exchange between Arnab Goswamy and Abhijeet Mukherjee, is an example of just how quickly people respond to political issues).

<sup>6</sup> Pranesh Prakash, *Analysis of the Copyright (Amendment) Bill, 2012*, May 23, 2012, available at <http://cis-india.org/a2k/blog/analysis-copyright-amendment-bill-2012> (Last visited on January 4, 2013).

of criticism and review in print media and literary criticism in particular, which required either the quoting of a passage from a novel or poem. However, one may question the meaning and interpretation of criticism and review when it comes to films and music.

On the one hand, one could extend the logic of ‘direct’ criticism and review which entails speaking or writing about a film or piece of music, whereby the film or music clips are used as a supplement to such direct criticism. However, this is somewhat straight forward. Hence, if a news anchor uses a film clip and speaks about it, then he will fall within the ambit of this amendment as well as the exception for the reporting of current events.<sup>7</sup>

However, contemporary media and artistic practices place lesser reliance on this direct mode of criticism and review and instead, engage in a critique that ‘shows’ rather than ‘tells’. Thus, it uses or re-contextualises the original material in a way that allows us to see a facet of that work or another work.<sup>8</sup> An example of such forms is the Eclectic Method, wherein a group of video artists remix the clips of cult films by working with a repetitive loop after adding a layer of soundtrack, as a way of critiquing the recurring images of violence in our mediatised lives. In one of their works,<sup>9</sup> they used a fight sequence from Quentin Tarentino’s film, ‘Kill Bill’, to create a sense of the frenzied violence that underwrites film cultures. Namita Malhotra, a media practitioner in Bangalore, created a queer remix<sup>10</sup> of Karan Johar’s film ‘Kal Ho Na Ho’, in which the original film is edited in a way that makes it a love story between Shahrukh Khan and Saif Ali Khan while Preity Zinta gets in the way of their love. Both these examples are merely illustrative of a much wider trend in which people use existing materials as parody and quotation to generate new works. We shall examine their legal status in the next section of the paper.

## II. TRANSFORMATIVE AUTHORSHIP: FROM APPROPRIATION ART TO PARODY

One of the earliest U.S. cases in which the Court of Second Appeal had to address the status of appropriation art was that of *Rogers v. Koons* (‘Koons decision’).<sup>11</sup> Art Rogers, a professional photographer sued a re-

<sup>7</sup> The last few years have seen a fair number of cases on the question of whether the use of film clips or clips from sound recordings by entertainment programs, is covered by the news reporting exception. Since the focus of this article is only on criticism and review, I shall not be discussing those cases.

<sup>8</sup> It is pertinent to note that the provisions under §52(1)(a) explicitly allows for that, when it says ‘criticism or review, whether of that work or any other work’. In this paper, we shall pay attention to these acts of transformative use.

<sup>9</sup> See Kill Bill Mix, available at <http://vimeo.com/1202573> (Last visited on January 4, 2013).

<sup>10</sup> Kal Ho Na Ho short movie – Part 1, available at <http://www.youtube.com/watch?v=hEw-DjabFp4> (Last visited on January 4, 2013).

<sup>11</sup> 960 F.2d 301.

nowned sculptor, Jeff Koons, for infringing his copyright in a photograph that he had taken of a couple with pups. The photograph had been exhibited at the San Francisco Museum of Modern Art and Koons used the same image to create a painted sculpture titled 'String of Puppies'. His sculpture was a re-creation of the photograph and was intended to look exactly like the photo with slight modifications, including clown-like noses on the blue puppies and daisies in the hair of the grinning man and woman in the photograph. Koons raised the defense of parody and in particular, claimed that his artistic practice relied on re-contextualizing existing images to change their symbolic meaning. The Court went into the four-factor test to determine whether the use of the photograph was 'fair use' and held that Koons's use of the photograph could not be covered by the defense of parody or fair use for the following reasons:<sup>12</sup>

- a. The Court held that if the copies were made for commercial and for-profit purposes, then it is presumptively unfair as per the case of *Sony Corp of America v. Universal City Studios*;
- b. The use could not be considered as 'parody' or 'criticism' because it did not comment directly on the artist's work;
- c. Since Rogers' photograph was imaginative and creative and not factual in nature, a stricter approach to copyright infringement of the same had to be taken as opposed to that taken in cases of factual work;
- d. The extent of Rogers' work copied was more than necessary to parody it;
- e. Finally, it held that there had been potential harm caused to the market for Rogers' Puppies as Koons intended to profit by his work.

The Koons decision spurred critical responses from various artists and raised questions about whether copyright law had a distinct understanding of 'criticism' as compared to what was considered as an 'acceptable' standard by artists.<sup>13</sup> The case was further complicated by the fact that the appropriating artist Koons, was better known than the person from whom the image had been appropriated. The history of appropriation in art is a long one and has come to be recognized as a form in itself,<sup>14</sup> and some of the most celebrated artists of the 20th century including Picasso, Duchamp and Andy Warhol have been appropriation artists. Scholars argued that the Court in Koons de-

<sup>12</sup> *Id.*

<sup>13</sup> For interesting inter disciplinary accounts of the Koons case, *See*, COPYRIGHT AND PIRACY: AN INTERDISCIPLINARY CRITIQUE (Bently, L., Davis, J. & Ginsburg, J.C. ed., 2010); MERRYMAN, J.H., ELSÉN, A.E. & URICE, S.K., LAW, ETHICS, AND THE VISUAL ARTS.

<sup>14</sup> *See generally*, CUTTING ACROSS MEDIA: APPROPRIATION ART, INTERVENTIONIST COLLAGE, AND COPYRIGHT LAW (K. McLeod & R. Kuenzli eds., 2011); *See also*, APPROPRIATION (D. Evans ed., 2009); J. WELCHMAN, ART AFTER APPROPRIATION: ESSAYS ON ART IN THE 1990s (2001).

ployed a very narrow understanding of ‘criticism’, which failed to appreciate how re-contextualisation is not merely an act of copying but production of a new meaning in art.<sup>15</sup> In contrast to the straight forward test which relies on a common man’s perception of determining whether the two pieces of works are substantively similar, re-contextualisation invites the viewer to see beyond the apparent similarities between two works and reflect upon the ontological link between ideas of originality and the experience of art itself. ‘Criticism’ in the context of appropriation art, need not necessarily be direct criticism of the underlying work that has been copied. Instead, it is more about the nature of the artistic object, its relationship to the art and the commodity culture in general.<sup>16</sup> Thus, when Andy Warhol used the Campbell soup can, it was less of a statement on Campbell soups and more on the mediated idea of mass consumption.<sup>17</sup> By placing a work of art in a different context, artists seek to dislodge the work of art from its semiotic comfort zone. It has also been argued that the idea-expression dichotomy in copyright law is inadequate to the task of determining how new ideas in art are created. In the Koons case, the Court’s ruling has been criticized by arguing that in art works, the appropriation of expression is a precondition for the articulation of new ideas.<sup>18</sup>

The debate over appropriation and transformative authorship was renewed in 1994 when the Supreme Court of the U.S. decided *Campbell v. Acuff-Rose* (‘Campbell case’).<sup>19</sup> Roy Orbison’s song *Pretty Woman* was parodied by the rap group 2 Live Crew, who used the song’s opening line, the song’s meter, the 4/4 drum beat and bass riff. 2 Live Crew had sought a license from Orbison before releasing the song. Since the license was not given to them, they proceeded with the release. Orbison sued for copyright infringement and 2 Live Crew raised the defence of ‘parody’ as ‘fair use’. The Supreme Court upheld their argument, basing its reason on the crucial idea of what constitutes a parody and what amounts to transformative authorship of a work. According to Justice Kennedy:

<sup>15</sup> E. Kenly Ames, *Beyond Rogers v. Koons: A Fair Use Standard for Appropriation*, 93 COLUM. L. REV. 1473 (1993).

<sup>16</sup> See, Johnson Okpaluba, *Appropriation Art: Fair Use or Foul?* in DEAR IMAGES: ART, COPYRIGHT AND CULTURE, LONDON (K. Schubert & D. McLean eds., 2002) (Johnson Okpaluba identifies three types of appropriation. First, the copying of whole images with or without attribution to the copyright owner. Here, the original may be altered, such as Marcel Duchamp’s addition of a moustache to a postcard of the *Mona Lisa* or it may be copied in unaltered form as in Sherrie Levine’s reproductions of iconic photographs by Walker Evans and Edward Weston. Second, the practice of montage that involves incorporating images from several sources into a new work, as seen in the screen prints of Robert Rauschenberg. Third, the practice of simulationism or the appropriation of whole genres and styles. As Okpaluba elucidates, appropriation practices pervade the avant-garde movements of the early twentieth century such as Dada and Surrealism, coming to fruition with Pop Art in the 1960s, where commodity images and the techniques of mechanical reproduction coincide and continue to the present day).

<sup>17</sup> EDWARD LUCIE-SMITH, ARTODAY 10 (1999).

<sup>18</sup> See generally, Okpaluba *supra* note 16.

<sup>19</sup> 510 U.S. 569 (1994).

“The parody must target the original, and not just its general style, the genre of art to which it belongs, or society as a whole [...] This prerequisite confines fair use protection to works whose very subject is the original composition and so necessitates some borrowing from it [...] If we allow any weak transformation to qualify as parody, however we weaken the protection of copyright”.<sup>20</sup>

The Court held that the impugned version of the song is transformative in nature and hence it did not infringe upon the rights of the copyright holder. The Court held that the goal of copyright law is served by the creation of such works, and the focus should be on whether the new work merely supersedes the objects of the original creation, or whether (and to what extent) it is ‘transformative’, thereby altering the original work with a ‘new expression, meaning, or message’.<sup>21</sup> It further held that more transformation in the new work would lead to decreasing significance of other factors, like the commercial nature of the work that may weigh against the finding of fair use.<sup>22</sup> The Court further held that, “the heart of any parodist’s claim to quote from the existing material is the use of some elements of the prior author’s composition, and to create a new one that, at least in part, comments on that author’s work.”<sup>23</sup> However that tells courts very little about where the line must be drawn.<sup>24</sup> Thus, like other uses, parody has to be tested on the basis of the ‘relevant factors’.<sup>25</sup> The Court held that the presumption against fair use on the basis of the ‘commercial’ nature of the work, was just restricted to it being a presumption, which did not mean that every commercial work was automatically taken out of the ambit of the fair use defence.<sup>26</sup> However, the Court held that this factor is only relevant to this extent which would further vary with the context. Thus, this is another reason that militates against the claim of “elevating commerciality to hard presumptive significance”.<sup>27</sup>

The closest equivalent that we have of the Campbell case is a decision from the Kerala High Court in *Civic Chandran v. Ammini Amma*.<sup>28</sup> In this case, Civic Chandran was a dramatist who wrote a play ‘Ningal Are Communistakki’ which was based on ‘Ningal Enne Communistakki’, authored by Thoppil Bhasi, a famous Malayalam playwright. Bhasi’s play was a legendary text which played a formative role in the creation of communist sensibilities

<sup>20</sup> *Id.*, 599.

<sup>21</sup> *Id.*, 579.

<sup>22</sup> *Id.*

<sup>23</sup> *Id.*, 569-570.

<sup>24</sup> *Id.*, 570.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.*, 585 (The Court held that it is only a separate factor that may “weigh against a finding of fair use”).

<sup>27</sup> *Id.*

<sup>28</sup> 1996 PTR 142 (Ker).

within Kerala and Chandran's play attempted to revisit some of the premises of the earlier play, with a specific intent of critiquing the failure of the communist party in uplifting the depressed classes. In order to do this, the defendant had copied substantial portions of the drama and altered them. He was sued for infringing Bhasi's copyright and it was argued that there was a substantive reproduction of the original play which resulted in infringement. Chandran claimed that his version was a 'counter drama', a popular mode of critiquing existing works which even Bhasi had deployed in the past.

The Court opined that Chandran's counter-drama fell within the purview of 'criticism' under § 52(1)(a)(ii). The Court noted that the copying was not done in a "whole or substantial manner, to convey the same idea which the author of the drama wanted to convey".<sup>29</sup> The Court noted that the purpose of the work was not merely to imitate the drama, but to use the theme, form of presentation, characters, dialogues and technique adopted in writing the drama.<sup>30</sup> The Court also noted that there is no possibility of market substitution of the original work with the counter-drama. Hence, there was no copyright infringement. In an extremely significant paragraph it held that:

"...The only point to be noted is that appropriation or part of drama as part of the counter drama was not for the same purpose for which the drama was written and was for the purpose of criticism of the theme, events and the ideology of the book and its author. At any rate, it was not for the purpose of imitating or reproducing the drama like the copyrighted drama or to produce the same drama with some insignificant changes here and there... There is every reason at least prima facie to think as contended on behalf of the appellants that the portions of the drama were made part of the drama only to make the criticism of the drama and the events discussed in the drama more effective and dramatic. The counter drama is a criticism of the drama only in part. It is not a work in which the drama and its author alone are criticized. Substantial portion of the counter drama is intended also to criticize various political and social developments of current importance and to bring about a new political and social system curing those defects on account of which the movement led by the party and the characters in the drama failed according to the author of the counter drama or the characters in it. If, as a matter of fact, and as contended by the appellants, the drama, its ideas, events and its author are sought to be criticized in the counter drama along with various other contemporary developments in the political and social fields, there is strong reason to

---

<sup>29</sup> *Id.*, ¶ 20.

<sup>30</sup> *Id.*, ¶ 20.



accept at least prima facie the contention that the quotations were made mainly for the purpose of effectively criticizing the drama...”.<sup>31</sup>

In this context, how do we distinguish the reasoning of the Courts in the Campbell case and Civic Chandran case? I submit that one way of looking at the difference between the two is that while the Campbell case was primarily concerned with the question of whether there had been transformative authorship, the Court in the Chandran case gave consideration to the intended nature of the second work. In other words, if the Campbell case is underwritten by an actor/authorship perspective, the Chandran case is informed more by actions or speech considerations. The figure of the ‘romantic author’ in copyright combines with the idea of the ‘speaking subject’ in the first amendment under the U.S. Constitution to create a justification for forms of appropriation, but underlying the two is still the idea of originality- a concept that has had a contested career in the history of art. While artists like Sherry Levine are hailed as pioneering practitioners whose work questions fundamental aesthetic assumptions such as originality and authorship, they have been less successful in convincing the courts dealing with the copyright law of their intention. In a famous case, the estate of Walker Evans, the famous depression era photographer, successfully obtained an injunction against the sale of Levine’s series ‘After Walker Evans’ in which she had photographed Evan’s original pictures.<sup>32</sup> Levine sought to interrogate the very idea of the signature, its ambivalent presence in the history of photography and its considered importance in art history. However, if the focus is excessively on the question of ‘transformation’ and not on the nature of speech, a case like this would not qualify within the fair use doctrine.

One of the limitations of the Campbell case was the fact that in upholding parody as criticism, it seemed to limit the nature of criticism and laid down the principle that a parody ‘necessarily’ had to target the original work. In the Chandran case, the focus is on the nature of criticism itself and counter drama is seen as a member of the larger genus of ‘criticism’. The Court in the Chandran case does not limit criticism to the targeting of the original work alone. In fact, it acknowledges that criticism in a derivative work may be wider in scope and one that targets general political ideology. In the context of new media practices, the focus on speech as opposed to authorship becomes crucial. Unlike U.S., which saw a direct first amendment challenge to copyright in *Eldred v. Ashcroft* (also known as the Copyright Term Extension case),<sup>33</sup> India has not had too many instances in which copyright and free speech have over-

<sup>31</sup> *Id.*, ¶ 20.

<sup>32</sup> See Laura Gilbert, *No Longer Appropriate*, THE ART NEWSPAPER May 9, 2012, available at <http://www.theartnewspaper.com/articles/No-longer-appropriate/26378> (Last visited on March 18, 2013).

<sup>33</sup> *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

lapped as competing claims in the court. However, it is not difficult to imagine that we will see more of such cases in the future over the question of ‘criticism and review’.

Presently, one of the striking features is that unlike traditional press and electronic media which require heavy investments in infrastructure, access to communication technologies has been relatively democratized through the expansion of the blogosphere and social networks. This in turn has resulted in the transformation of a large numbers of persons from passive consumers of media to active creators and re-mixers of content. In this new media landscape, forms of political speech are also changing and one can increasingly see the use of parody and satire to critique the government and corporations. Marlin Smith, in an analysis of copyright, parody and the public domain, makes a case that a proper understanding of the scope of fair use would require us to distinguish between different forms of speech and parody, whereby the latter is a form of social discourse that involves a substantive exchange of speech, and prohibition of the same in the name of copyright, tantamounts to a content-based restriction on speech.<sup>34</sup>

One can see the development of similar principles in an extremely significant decision in trademark law. In *Tata Sons v. Greenpeace International*,<sup>35</sup> Greenpeace International had created an online game called ‘Turtle v TATA’, where they used the Tata trademark of “T” within a circle without the plaintiff’s permission. The plaintiffs alleged that their trademark had been infringed and that the defendants had maligned their reputation. The aim of the game was “to help the yellow turtles eat as many little white dots as possible without running into Ratty (presumably after Ratan Tata, chairman of the Tata Group), Matty, Natty or Tinku.” The defendants argued that their use of the trademark was protected by § 29(4) of the Trade Marks Act, 1999,<sup>36</sup> i.e., since the trademark was used for criticism, fair comment and parody, such use would not amount to infringement of the trademark. They claimed that “a bare perusal of § 29 (4) of the Trade Marks Act 1999 would show that it envisages the use of a registered trademark, for purposes of criticism, fair comment and parody so that such use would not amount to an infringement of

---

<sup>34</sup> Marlin Smith, *The Limits of Copyright: Property, Parody, and the Public domain*, 42 DUKE L.J. 1233, 1249.

<sup>35</sup> 178 (2011) DLT 705.

<sup>36</sup> Trade Marks Act, 1999, § 29(4): A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

trademark”.<sup>37</sup> They further argued that the use of a trademark for any of the aforesaid purposes, is justified on the grounds of freedom of speech and expression, which is evident from the phrase ‘without due cause’ used under § 29 (4) of the Trade Marks Act, 1999.<sup>38</sup> Moreover, it was argued that the dilution of trademark can be established if the use of the mark in question is in the ‘course of trade’ as mandated under Section 29(4).<sup>39</sup> The defendants claimed that the acts of Greenpeace India amounted to a “peaceful, creative and nonviolent/non-confrontationist mechanism of registering protest” and it simply expressed concerns over the project, “which was perceived as an environmental disaster in the making”.<sup>40</sup>

The defendants (Greenpeace) also relied upon an important European decision *Esso Francaise SA v. Association Greenpeace France*,<sup>41</sup> as well as the decision of the South African Constitutional Court in *Laugh It off Promotions CC v. Freedom of Expression Institute*,<sup>42</sup> (‘Laugh It Off Promotions case’) both of which held that the right to free speech could not be restricted “at the behest of third parties’ intellectual property rights”.<sup>43</sup> In the South African case, the Court held that the effect of parody by using the trademark has to be seen in the given context.<sup>44</sup>

In this case, the Delhi High Court relied upon Justice Sachs’s opinion in the Laugh It Off Promotions case and stated the importance of striking a balance between the constitutional guarantee of free speech and the right to property.<sup>45</sup> Introducing the idea of the ‘paradox of parody’, the Court observed that “the closer the object of the parody is to the parody itself, the more intense, the paradox will be”.<sup>46</sup> It noted that a good parody is both ‘original’ and ‘parasitic’, as well as ‘creative’ and ‘derivative’.<sup>47</sup> The Court further elaborated and held that if the parody has drawn too much from the original, it would be considered as an infringement, as the amount of originality is too less. Yet, it noted, that parody as a creative work relies heavily on the original. It is based on the ability of the audience to recognise the parodied work and relate it to the original work. Moreover, the Court held that some of the parodists ‘intend to entertain’, others seek to engage in ‘social commentary’,<sup>48</sup> while the third

<sup>37</sup> 178 (2011) DLT 705, ¶ 20.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

<sup>41</sup> 2003 ETMR 66.

<sup>42</sup> 2006 (1) SA 144 (CC).

<sup>43</sup> 178 (2011) DLT 705, ¶ 24.

<sup>44</sup> *Id.*

<sup>45</sup> *Id.*, ¶ 41 (Discussing the Laugh It Off Promotions case, ¶ 83 wherein Court held that, “it should not make any difference in principle whether the case is seen as a property rights limitation on free speech, or a free speech limitation on property rights”).

<sup>46</sup> *Id.*, ¶ 41 (Refereing to the Laugh It Off Promotions case, ¶ 79).

<sup>47</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 76).

<sup>48</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 78).

category of parodists may have ‘duplicitous commercial aspirations’.<sup>49</sup> The fact that the message conveyed by the parody could have been conveyed through any other means should not weigh against the parodist’s claims.<sup>50</sup>

Moving away from a classical understanding of free speech as a right that mediates the relationship between citizens and the state, the Court demonstrated a keen understanding of how speech works in the current context, as corporations have become powerful institutions who derive, in part, their power from their ability to control the semiotic landscape. The Court observed that:

“In a society driven by consumerism and material symbols, trademarks have become important marketing and commercial tools that occupy a prominent place in the public mind. Consequently, companies and producers of consumer goods invest substantial sums of money to develop, publicise and protect the distinctive nature of their trademarks; in the process, well-known trademarks become targets for parody. Parodists may then have varying motivations for their artistic work; some hope to entertain, while others engage in social commentary, and finally others may have duplicitous commercial aspirations. Rutz states that “[o]ften laughter is provoked not at the expense of the original work and its author, but at the dislocation itself. The public may find pleasure in recognising the parody’s object; on the other hand, reactions may be anger or shock, depending on the context in which the parody is set.”<sup>51</sup>

The Court held that a determination of whether free speech rights should prevail over property rights or *vice versa*, depends less on the easy demarcations and more upon the fact specific context in which the parody occurs.<sup>52</sup> One of the tests that should be applied is to see whether the parodying activity is primarily ‘communicative’ in character or ‘commercial’ in nature.<sup>53</sup> The Court observed that mere existence of some degree of the latter does not in itself preclude a free speech claim.<sup>54</sup> Finally, the Court held that criticism could well have taken a different form. However, there is ‘specificity’ in the manner in which parody works, because it is an instance in which the medium is the message. In other words, the Court held that, “more the trademark itself

<sup>49</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 78).

<sup>50</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 87).

<sup>51</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 78).

<sup>52</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 83).

<sup>53</sup> *Id.* (Refereing to the Laugh It Off Promotions case, ¶ 86).

<sup>54</sup> *Id.*

is directly the target and the instrument, the more justifiable will its parodic incorporation be<sup>55</sup>.

The last case that I would like to mention is *University of Oxford v. Narendra Publishing House*,<sup>56</sup> in which the Court held that the doctrine of fair use must be interpreted so as to strike a balance between the exclusive rights granted to the copyright holder, and the competing interest of enriching the public domain. The Court held that § 52 cannot be interpreted to stifle creativity and at the same time, it must discourage blatant plagiarism. It, therefore, must receive a liberal construction in harmony with the objectives of copyright law. § 52 of the Act only specifies the broad heads and the actions under the same which would not amount to infringement. Resort must, therefore, be made to the principles enunciated by the courts to determine fair use. It is only by linking ‘criticism and review’ to a wider understanding of how social speech works that we can arrive at principles within copyright law, which would adequately address the question of public interest. The question of how we understand the scope of fair dealing depends to a large extent on how we perceive copyright itself. If we see copyright as a private property system, then fair dealing will always be seen as the exception that is carved out of private property rights. However, if we begin our analysis of copyright not as a private property system, but as public rights to creative works, then fair dealing would be properly understood as the repository of public rights in works that are still under their statutory term of copyright protection.<sup>57</sup> The next section of the paper shall focus on the issue of moral rights of the author and the right to criticism and review under the provision of fair dealing.

### III. MORAL RIGHTS AND PARODY

The Amendment has raised another conflicting situation with respect to the relationship between the moral rights (or special rights) of the author and the right to criticism and review. § 57(1)(b) of the Act confers upon the author a right to restrain or claim damages with respect to any distortion, mutilation, modification or other act in relation to the said work, if such distortion, mutilation, modification or other act would be prejudicial to his honour or reputation.<sup>58</sup> There are neither qualifications with respect to the special rights

<sup>55</sup> *Id* ( Refereing to the Laugh It Off Promotions case ,¶ 87).

<sup>56</sup> 2008 (106) DRJ 482.

<sup>57</sup> To allow fair use is to ensure that copyright does not unduly encroach upon the permissible subject matter of speech.

<sup>58</sup> Copyright Act, 1957, § 57(1): Independently of the author’s copyright and even after the assignment either wholly or partially of the said copyright, the author of a work shall have the right—

- (a) to claim authorship of the work; and
- (b) to restrain or claim damages in respect of any distortion, mutilation, modification or other act in relation to the said work if such distortion, mutilation, modification or other act would be prejudicial to his honour or reputation.

of an author nor any reference to its relation with the fair dealing exceptions provided under § 52 of the Act. Thus, we can foresee instances where authors are disgruntled, either with a parody of their work or with its distortion or mutilation, which in turn prejudices their honour/reputation. In such instances, they could claim not only an infringement of their copyright but also a violation of their special rights.

Geri Yonover writes about an amusing imaginary case between Leonardo Da Vinci and Marcel Duchamp.<sup>59</sup> Duchamp had famously drawn a moustache over a copy of Da Vinci's Mona Lisa, thereby transforming the iconic and perhaps the most widely recognised visual work in history, into a parodic interpretation that mixes a critique of gender and beauty with a history of how great works can be sacralised. In this context, Yonover envisages a scenario wherein, Da Vinci would claim the violation of his moral rights on basis of the vandalizing action.<sup>60</sup> The right to integrity is a right that has more meaning with respect to the physical copy of a work or an original copy of a work<sup>61</sup> as opposed to films and sound recordings. In the case of *Shostakovich v. Twentieth Century-Fox Film Corp*<sup>62</sup>, one of the earliest cases that directly raised a moral rights claim, the New York Court rejected Shostakovich's argument that use of his music in an anti-Soviet movie violated his moral rights, such that it falsely imputed disloyalty towards his country, to him.

The court reasoned that:

“There is no charge of distortion of the compositions or any claim that they have not been faithfully reproduced. Conceivably, under the doctrine of Moral Right the court could in a proper case, prevent the use of a composition or work, in the public domain, in such a manner as would be violative of the author's rights. The application of the doctrine presents much difficulty however. With reference to that which is in the public domain there arises a conflict between the moral right and the well-established rights of others to use such works. So, too, there arises the question of the norm by which the use of such work is to be tested to determine whether or not the author's moral right as an author has been violated. Is the standard to be good taste, artistic worth, political beliefs, moral concepts or what is it to be? In the present state of our law the very existence of the right is not clear, the

<sup>59</sup> Geri J. Yonover, *The “Dissing” of Da Vinci: The Imaginary Case of Leonardo v. Duchamp: Moral Rights, Parody and Fair Use*, 29 VAL. U. L. REV. 935 (1995).

<sup>60</sup> Geri J. Yonover, *Artistic Parody: The Precarious Balance: Moral Rights, Parody, and Fair Use*, 14 CARDOZO ARTS & ENT LJ 79.

<sup>61</sup> *See Amar Nath Sehgal v. Union of India*, 117 (2005) DLT 717.

<sup>62</sup> 80 N.Y.S.2d 575 (N.Y. Sup. Ct. 1948).

relative position of the rights thereunder with reference to the rights of others is not defined nor has the nature of the proper remedy been determined.”<sup>63</sup>

It seems that the dilemma identified by the Court continues to plague us and we are far from resolving it through the Amendment. In *Fisher v. Dees*, the Court of the Ninth Circuit rightly identified the paradox when it stated “the parody defence to copyright infringement exists precisely to make possible a use that generally cannot be bought”.<sup>64</sup> We have seen many instances in Hindi cinema where the concerned persons have attempted to deny remake rights on the grounds that it would violate the sanctity of the original film.<sup>65</sup> In cases where it is impossible to obtain permissions not only because of economic consideration but also because of the desire to shield the sanctity of the original work from criticism, it becomes crucial to work out a balance between the right to integrity and the right to criticize a work on the basis of the fair dealing exception.

#### IV. CONCLUSION

The history of art and cultural theory is marked by a tradition of acts of appropriation and if one were to simply look at a lexicon of terms from art history (bricolage, centro, collage, palimpsest, refiguration etc) one would see a world that is conceptually wide in its understanding of appropriation. Copyright, in contrast, delimits a narrower field of ‘criticism and review’ in which a certain amount of appropriation of a work is deemed legitimate. It would be important for the law to import ideas from different practices into its understanding of criticism if we are to ensure that copyright is not used as an unreasonable restriction on free speech. The importation of the idea of parody is clearly a welcome move towards expanding our understanding of criticism but as we have seen parody itself may be inadequate to the tasks of accommodating forms of uses of existing material which directly critique the original work. What we need is either an explicit recognition of quotation rights for films and sound recordings or the reading of quotation rights within the ambit of criticism by the judiciary. As we move into the realm of the post media world we have to acknowledge that the history of media itself becomes a form of language available to us, and our ability to draw on the history of media becomes a prerequisite for us to critically engage with our contemporary era. As Gerard Genette

<sup>63</sup> *Id.*

<sup>64</sup> 794 F.2d 432 (1986).

<sup>65</sup> See, Planet Bollywood, available at <http://www.planetbollywood.com/displayReview.php?id=091007023830> (Last visited on 10/03/2013) (Admittedly, though it is not the best example of an appropriating work attempting to interpret a cult film, yet, Ram Gopal Verma’s film ‘Aag’ was supposed to be a remake of Sholay, but he was denied permission by Ramesh Sippy who obtained a court order against his use of the name ‘Sholay’. The remaking of cult films is very much a part of film history and one instance of this is Gus Van Sant’s homage to Alfred Hitchcock’s Psycho).

observes, “One who really loves texts must wish from time to time to love (at least) two together.”<sup>66</sup> If artists are only allowed to copy non-substantial parts of existing works, there is no way of creating a love-hate relationship with the texts.

---

<sup>66</sup> GERARD GENETTE, *PALIMPSESTS: LITERATURE IN THE SECOND DEGREE* (1997).