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TRINIDAD AND TOBAGO

IN THE HIGH COURT OF JUSTICE

No. 1927 of 1983

BETWEEN

COLUMBIA PICTURES  
INDUSTRIES INCORPORATED

PLAINTIFFS

AND

TALIB KHAN  
(TRADING AS "VIDEO SHACK")

DEFENDANT

Before the Honourable Mr. Justice  
George A. Edoe

IN CHAMBERS

Mr. Morgan for the plaintiffs.

Dr. Ramsahoye for the defendant.

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J U D G M E N T

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On 21st May, 1982, an interim injunction was granted restraining the defendant, his servants or agents "inter alia" from -

- (a) producing, renting, selling or by way of trade, offering or exposing for rental or sale or distributing video cassette recordings of the motion picture "Gandhi" which the plaintiffs contend was an infringement of their copyright.
- (b) printing, producing or exhibiting still photographs or publicity material of the said motion picture.
- (c) parting with possession, custody or control of any video cassette recordings, still photograph, poster or any publicity material.

/Included.....

*J.C.A. 1927/83 Columbia Pictures vs Talib Khan*

Included in the interim injunction is an "Anton Piller" order compelling the defendant "inter alia" to disclose forthwith the names and addresses of persons or companies who supplied him with the video cassette recordings and the dates, quantities and titles of the infringing copies of the film. It was further ordered that the defendant do permit the persons serving the order or anyone authorised by him to inspect and take copies of all invoices, books and documents in his possession or control and to remove into the plaintiffs' Solicitor's custody any of the said articles and documents which related to the video cassette recordings of the said film.

On an adjourned hearing of the summons which became returnable before me on the 14th June, 1983, Counsel for the plaintiffs sought to have the order extended until the trial of the action.

Counsel relies upon the Copyright Act, 1911 as establishing the plaintiffs' legal right in the copyright, specifically Section 1(1)(a) which states:-

"1. Copyright (1) Subject to the provisions of this Act, copyright shall subsist throughout the parts of His Majesty's dominions which this Act extends for the term hereinafter mentioned in every original literary, dramatic, musical and artistic work, if -

(a) in the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid."

It seems to me that this Act applies to Trinidad and Tobago by virtue of Section (1) of the Trinidad and Tobago Republic Act, 1976 and before 1956 to the Republic of India by the India (Consequential Provisions) Act, 1949. The effect, according to Counsel for the plaintiffs, is to make any work published for the first time within the Republic of India entitled to the protection of the Copyright Act 1911 in Trinidad and Tobago. By an affidavit sworn to by Julie Morgan on 31st May, 1983, in support of the application for the interim injunction, she deposes to the fact that the motion picture was first

/published.....

published on 30th November, 1982 at Vigyan Bhavan Cinema in New Delhi, Republic of India (See paragraph 2(d)).

The Act was extended to territories which formed part of the possessions of the Crown by Orders in Council and further extended by Acts of the U.K. Parliament when these territories became independent.

The plain intention of the Act is obvious. It was intended to protect copyright not only within the United Kingdom but to all territories coming within the possessions of the Crown and over which the Crown or the Parliament of the United Kingdom had jurisdiction. In my opinion, when these territories became independent and they adopted the Act, the Act only applied to publications in those territories which still formed part of the territories of the Crown. Since the Republic of India ceased to form part of the territories of the Crown in 1949, the Act by its application in Trinidad and Tobago does not extend to publications in the Republic of India made in the year 1982, since the Republic of India had ceased more than 33 years before to be part of the possessions of the Crown.

The Copyright Act, 1911, was repealed and replaced by the Copyright Act, 1956, which has been extended by Orders in Council to many of the former territories of the Crown but not to Trinidad and Tobago. So that it appears that the Copyright Act, 1911, still applies to Trinidad and Tobago. The Act of 1956 has been applied to many foreign countries, including the Republic of India, which are members of the Berne Copyright Union or parties to the Universal Copyright Convention by the Copyright (International Conventions) Order, 1972. (U.K.)

In my opinion, the plaintiffs have failed to prove that they have a legal right in the copyright which is a necessary pre-requisite to the bringing of an action for its infringement.

/Assuming.....



Assuming, however, that the plaintiffs are entitled to enforce the copyright in this Country, I turn now to a consideration of the merits of the application.

The facts upon which the interim order was made are contained in the affidavit of Julie Morgan sworn to on the 30th May, 1983.

By paragraphs 4 and 5 she deposes to the fact that a still photograph of the actor Ben Kingsley, who appeared in the motion picture "Gandhi", was reproduced in the form of handbills and these were widely distributed in Trinidad.

By paragraph 6 she deposes to the fact that on page 26 of a copy of the edition of the "Bomb" newspaper of the 6th May, 1983, a facsimile of that photograph was reproduced under which appeared the words -

"THE VIDEO SHACK  
Curepe Junction (near Bata) telephone 663-1727  
We are the biggest  
We have the best  
GANDHI IS HERE  
Check your tapes before you leave you must be satisfied."

By paragraph 7, she deposes to the fact that on Thursday 26th May, she visited the defendant's premises and was there informed by one Mrs. Khan that she (Mrs. Khan) was in charge of running the video club and that she had 50 tape recordings of the motion picture "Gandhi" but that they were all unavailable as they had been rented out previous to her visit.

In determining whether the injunction should continue, I take the following matters into consideration:-

1. The Copyright Act, 1911 protects original works of a literary, dramatic, musical or artistic character. The plaintiffs have not shown in what category the film "Gandhi" falls or whether it falls into any of these categories at all. In Nordish Films Co. Ltd. v. Ondan (1917 - 1923) Mac G. Cop. Cas. 337, it was held that the film in that case did not satisfy the definition of a dramatic work. So it is obvious that Counsel's first duty is to satisfy the Court, if he relies upon the 1911 /Act as.....

Act as he has done, that the film "Gandhi" falls within one of these categories.

2. Cinematograph films did not fall within the definition of "original, literary, dramatic, musical or artistic work" until the Copyright Act, 1956. Most of the provisions of the 1911 Act were re-enacted, however, in the 1956 Act which extended the subject matter of copyright to cinematograph films for the first time (see Section 13). I have already indicated that the 1956 Act does not apply to Trinidad and Tobago. I do not agree with Counsel for the plaintiffs that in the Nordish Films Case (supra), the film itself was considered as falling within the definition. Rather it was the work depicted in the film itself which was questioned as falling within the definition.
3. As to the facts contained in the affidavit, there is no evidence that the photograph which appeared at the top of the advertisement formed part of it or whether it was placed by the newspaper itself to embellish the advertisement.
4. There is no evidence that the video cassettes contained reproductions of the film "Gandhi" of which the plaintiffs claim the copyright. The plaintiffs appear to have relied on the hearsay evidence of Mrs. Khan. They came to this conclusion on the very slender evidence that she had informed the deponent that she had 50 tape recordings of the motion picture "Gandhi". Even in a "passing off" case, it would have been necessary to determine what was contained in the video cassette recordings.
5. As to the "Anton Piller" order, this was granted on the same facts as deposed to in Julie Morgan's affidavit. In Anton Piller K.G. v. Manufacturing Processes Ltd. (1976) 1 A.E.R. 779 at p. 784, the case from which the name of the order has been derived, in describing the powers of the Court to grant the order, Ormrod L.J. states:-

"The proposed order is at the extremity of this court's powers. Such orders, therefore, will rarely be made, and only when there is no alternative way of ensuring that justice is done to the plaintiff.

There are three essential pre-conditions for the making of such an order in my judgment. First, there must be an extremely strong 'prima facie' case. Secondly, the damage, potential /or actual.....



"or actual, must be very serious for the plaintiff. Thirdly, there must be clear evidence that the defendants have in their possession incriminating documents or things, and that there is a real possibility that they may destroy such material before any application 'inter parties' can be made.

The form of the order makes it plain that the court is not ordering or granting anything equivalent to a search warrant."

In my opinion, the plaintiffs have failed to satisfy this Court of the necessary pre-conditions to justify the order. There is no "prima facie" case made out. What has been established on very dubious evidence is that the defendant has 50 video cassette recordings of a film "Gandhi". There is no evidence that he has pirated the film, reproduced it on video cassettes and circulated them far and wide so as seriously to damage the plaintiffs. Thirdly, there is no evidence that the defendant has video cassettes or any other material which purportedly may incriminate him and that there is a real possibility that he may destroy them.

It is evident from the authorities cited in the matter that the principles enunciated in "Anton Piller" were applied to the facts of those cases.

From what I have stated, I am of the opinion that the plaintiffs have not shown that there is a serious issue to be tried at the trial of this action. It is not necessary for me, therefore, to go on to consider what would follow if I had found otherwise, i.e. whether damages are an adequate remedy or to determine where the balance of convenience lies. See American Cyanamid Co. v. Ethicon Ltd. (1975) 1 A.E.R. 504.

The injunction granted herein, including the "Anton Piller" order is discharged. The plaintiffs will pay the defendant's costs to be taxed certified fit for Counsel.

Dated this 29th day of June, 1983.

George A. Edoe,  
Judge.