

Mattel, Inc. & Ors. vs Mr. Jayant Agarwalla & Ors. on 17 September, 2008

Author: S.Ravindra Bhat

Bench: S. Ravindra Bhat

* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ IA No. 2352/2008 in CS(0 S) 344/2008

Reserved on: 29.05.2008

Pronounced on: 17.09.2008

MATTEL, INC. & ORS.

..... Plaintiffs

Through Mr. N.K. Kaul, Sr. Advocate with
Mr. Praveen Anand, Ms. Swathi Sukumar,
Mr. Dhruv Anand, Mr. Tarvinder Singh and
Ms. Anu Bagai, Advocates

Versus

MR. JAYANT AGARWALLA & ORS.

..... Defendants

Through Mr. Sushant Singh with Mr. Manav
Kumar, Advocates

CORAM:

Mr. Justice S. Ravindra Bhat

1.

Whether reporters of local papers may be allowed to see the judgment? YES

2. To be referred to the Reporter or not? YES

3. Whether the judgment should be reported YES in the Digest?

Mr. Justice S. Ravindra Bhat

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1. This order shall dispose off IA No. 2352/2008 preferred by the plaintiffs under Order XXXIX Rule 1&2 of the Code of Civil Procedure, 1908, seeking an ad interim injunction restraining the defendants from infringing the trademark and copyright of the plaintiffs in the board game called SCRABBLE.

2. The first plaintiff is a company incorporated in Delaware, United States. The second and third plaintiffs, incorporated in the United Kingdom and India respectively, are wholly owned subsidiaries of the first plaintiff. They aver to being leading manufacturers of toys, games and consumer products. Their best selling brands include ,Barbie□ ,Hot Wheels□ ,Matchbox□ ,Little People□ and a wide assortment of entertainment inspired toy lines.

3. One of the well-known products of the plaintiffs is the board game marketed and popularized by the name 'SCRABBLE' (hereafter referred to as 'the game'). This word-based game challenges the players to form words on a grid; points are scored by forming such words. It is averred that over 100 million sets of the game have been sold in approximately 29 different languages. They also manufacture and market board games with SCRABBLE formative marks, like the 'Junior Scrabble', the 'Rainbow Scrabble' etc. The game was invented in 1932 by one Mr. Alfred Mosher Butts and has been redesigned since then. The trademark SCRABBLE has been used since the year 1948. The plaintiffs aver being owners of the trademark SCRABBLE in all countries except the United State and Canada, where Hasbro Inc. owns it. The plaintiffs own two registrations in relation IA NO.2352/2008 IN CS (OS) 344/2008 Page 2 to the trademark SCRABBLE in India; No.850786 in Class 9 and No. 342431 in Class 28, from the year 1999 and 1978 respectively. It is averred that two related applications are pending registration. These marks have also been registered in number of other countries.

4. The plaintiffs state that the game is very popular in a number of countries and can be judged by the fact that the Oxford English Dictionary, Volume XIV, Second Edition, 1991 defines 'scrabble' as ,the proprietary name of game in which the players use tiles displaying individual letters to form words on a special board□ The plaint avers that world wide, several tournaments and competitions based on the game are conducted every year. Further, various computer and video game versions of the game have been released by the plaintiffs' licensees for various platforms including PC, Mac, Amiga, Playstation, Palm OS and mobile phones. In this respect the plaintiffs have given a list of their licensees for various platforms. They have also advertised and promoted the game extensively through the Internet and they maintain websites including www.scrabble.com and www.mattelscrabble.com. The plaintiffs claim that mark SCRABBLE has become a well-known trademark within the meaning of section 11(6) of the Trademarks Act, 1999. It is stated that the plaintiffs have made sales to the tune of Rs. 13 corers in India from the year 2003, and the expenditure on marketing and promotion amounted to approximately Rs. 51 lakhs.

5. The plaintiffs claim that every version of the game since the first in 1932 is an artistic work under section 2(c) of the Copyright Act, 1957 and IA NO.2352/2008 IN CS (OS) 344/2008 Page 3 the plaintiffs' works are entitled to protection in India by virtue of the International Copyright Order, 1991. The plaintiffs have filed a table depicting the flow of title in the copyrighted work, from the creators to the predecessors in interest of the plaintiffs and finally themselves. Following the

takeover of the second plaintiff by the first plaintiff in 1999, the game was redesigned and the latest version created. Apart from claiming the ownership in the artistic layout of the board, the plaintiffs also claim to be the owners of the copyright in the rules of the game, which according to them is a literary work under section 2 (o) of the Copyright Act, 1957.

6. The first and second defendants are brothers and partners in the third defendant, a firm engaged in providing IT solutions. The plaintiffs allege being appalled to find out that the defendants had launched an online version of their board game under the mark SCRABULOUS, as an application available through the popular networking website www.facebook.com. The online version was also promoted through the defendants' website www.scrabulous.com, www.scrabulous.info and www.scrabulous.org. Such unlawful adoption of deceptive and confusingly similar mark for the online version of the plaintiffs' game, it is claimed amounts to infringement under section 29 of the Trade Marks Act, 1999 and passing off. The intent to appropriate the goodwill of the plaintiffs' mark, it is stated, is evident from the fact that the third defendant's website advertises the launch of the Scrabulous as the ,best place to play Scrabble online for free□ The plaintiffs also state that consumer IA NO.2352/2008 IN CS (OS) 344/2008 Page 4 merchandise in the form of clocks, tableware etc were also launched under the mark Scrabulous.

7. Apart from adopting a deceptively mark, the defendants, it is alleged, have also infringed the plaintiffs' mark by using metatags, which are machine readable codes used by search engines to index sites. The defendants use the following metatags: scrabble online, play scrabble online, free scrabble online, play scrabulous live etc. The plaintiffs claim that these clearly amount to infringement and passing off, since the defendants, through such tags divert internet traffic away from the plaintiffs websites and mislead the public that their (defendants') products are associated with the plaintiffs. Similarly, the defendants also use hyperlinks to the plaintiffs' websites and rules for the scrabble game. Some of the hyperlinks used are: download scrabble free, play scrabble free, free online scrabble etc. The text of the hyperlinks independent of the content of the websites, it is claimed, is sufficient to constitute infringement.

8. The plaintiffs claim the defendants have admitted to their rights in the trademark SCRABBLE, when they addressed an email dated 15th January 2008 to the first plaintiff, enquiring whether they would licence the rights to their games. The plaintiffs have also detailed various sections of the defendants' websites where they have referred to the plaintiffs' game and the mark SCRABBLE. Some of them are:

(a) ,Basic of Scrabble□

(b) ,Rules of Scrabble□

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(c) ,Scrabulous is a registered trademark of J.W. Spear & Son PLC and Hasbro Inc. Any and all uses of the word

,Scrabulous□on these pages refers to this trademark. This web page in no way is an attempt to confuse the visitor that it is the web page of Mattel or Hasbro brand Scrabulous□They have also listed out instances where users of the social networking site 'Facebook' have referred to their mark and game, on the 'Scrabulous Wall', which is forum for comments on the scrabulous application. For example:

- a. "Play scrabble with me pizz□
- c. ,Anyone know how to invite mates onto scrabble□
- d. ,I' m really pleased with this version of Scrabble. Well designed. Good job□
- e. ,Awesome. I love Scrabble, thanks for making this application, You, rock.□
- f. ,scrabulous is the best online scrabble gaming site..l□

They state these evidence deceptive similarity and confusion in the minds of the public, between the two marks.

9. The plaintiffs also claim that defendants have infringed their copyright in the game board and the rules. By the use of red, pink, blue and light blue tiles, use of identical patterns of arrangement of coloured tiles and the use of a star pattern on the central square, the plaintiffs claim that the defendants have infringed their copyright in the game board which is an artistic work. Such infringing use of the plaintiffs' board game it is alleged cause grave and irreparable loss, since they were planning to launch their online version of the board game. Therefore, the plaintiffs IA NO.2352/2008 IN CS (OS) 344/2008 Page 6 seek an interim injunction restraining the defendants from infringing their rights in the trademark SCRABBLE, from infringing their copyright in the current game board, previously used game boards, rules and formats of the game.

10. The defendants in their written statement allege that the copyright claim in relation to the game board is not maintainable since the board, which is a three dimensional article is not copyrightable. Additionally, the shape and configuration of the board can be registered as a design, and therefore, monopoly over the copyright extinguished the moment more than 50 articles are produced and commercially sold under section 15(2) of the Copyright Act. The plaintiffs do not hold a valid design registration and therefore, they cannot claim copyright to that effect. Moreover, the defendants state that since the plaintiffs are not the registered owners of any copyright in the rules of the game, no injunction can be claimed in that regard too. The game board could have been protected as a design and the monopoly thereby granted would have lasted only for 15 years. They cannot now claim copyright over the board since that would result in guaranteeing a protection, which does not validly exist in law. It is averred that the said game cannot be treated as a literary work in any manner whatsoever under section 2 (o) of the Copyright Act.

11. The defendants state that the suit for infringement and passing off in relation to the mark SCRABBLE is not maintainable since the word is a generic/ publici juris term, which has become the description of the game and has become a non-distinctive mark, like Ludo, Carrom Board, Cricket, IA NO.2352/2008 IN CS (OS) 344/2008 Page 7 Table Tennis etc. It is claimed that several

hotels, schools, and casinos are employing the same terminology as a general term describing the game rather than to indicate any specific brand supporting their trademark. The defendants allege that the plaintiffs' claims in relation to ownership of the said trademarks are not backed by adequate documentary evidence. They deny that SCRABBLE has become a well-known mark since it has already become a distinctive mark, in relation to the plaintiffs' game and that various traders are using the word 'Scrabble' in respect of game boards in various countries.

12. The defendants further submit that the copyright claim is not sustainable since the patent claim for the game was applied for in 1948 and rejected by the Patents Office. The present claim they aver amounts to switching over of monopoly rights, which is not permissible in law. They also aver that the plaintiffs have suppressed material information from the Court by not disclosing that had caused a letter dated 5th July 2007 to be written to the defendants requesting them to cease and desist the operations in relating to the internet game Scrabulous. The defendants had thereafter, replied asking the plaintiffs to provide particulars of the rights owned by them. The plaintiffs replied restricting their request for cease and desist to United States and Canada only.

13. The defendants claim to be lawfully operating their websites and that there have been no attempt to misappropriate any traffic. It is claimed that that the metatags used are in relation to their product Scrabulous and not Scrabble. Using the word scrabble in coding was a method of IA NO.2352/2008 IN CS (OS) 344/2008 Page 8 describing the game and was not intended to indicate any brand. They also deny that their website contains hyperlinks to various unauthorized infringing websites. Since the word scrabble is in the public domain, any such use cannot be infringement of the plaintiffs' rights. It is also pointed out that the plaintiffs do not have any version of their game online, and therefore, there is no question of diverting Internet traffic.

14. Mr. Neeraj Kishan Kaul, learned senior counsel, urged that the defendants' use of the word-mark ,Scrabulus□ is a brazen attempt to misappropriate the plaintiffs' goodwill and reputation in the registered trademark SCRABBLE. Being a registered trademark owner, the plaintiffs can legitimately complain that the defendants' use of the mark, in respect of the same game, which too has been blatantly copied, without as much as an effort to even make any distinction, amounts to infringement under Section 29 of the Trademarks Act, 1999. Reliance was placed on Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical Laboratories, AIR 1965 SC 980, to say that in an action for infringement, like the present case, where the similarity between the Plaintiff's and Defendants mark is so close, either visually, phonetically or otherwise and the Court reaches a conclusion that there is an imitation, no further evidence is required to establish that the Plaintiff's rights are violated. It was also argued that applying the tests indicated in Amritdhara Pharmacy v. Satya Deo Gupta, AIR 1963 SC 449, and Heinz Italia v. Dabur India (2007) 6 SCC 1, the only conclusion is that the court should take note of the similarities, rather than consider the minute dissimilarities, when adjudging the question of IA NO.2352/2008 IN CS (OS) 344/2008 Page 9 deceptive resemblance of the rival marks. Considerable emphasis was placed on the fact, that well known dictionaries describe SRABBLE as a proprietary game, which establishes that the word mark has acquired a strong distinctive secondary meaning, which the defendants are dishonestly seeking to appropriate. According to counsel, the defendants' dishonesty is a strong factor to guide the court into enjoining their continued use of the mark; reliance was placed on the judgment of this court in

Info Edge India Pvt.ltd. Vs. Shailesh Gupta and Anr. 2002 (24) PTC 355 in this context.

15. The plaintiffs also contend that there is no question of the word SCRABBLE becoming publici juris, since the mark is at once descriptive, as well as distinctive. Counsel relied on Godfrey Philips India Ltd., -vs- Girnar Food & Beverages (P) Ltd 2005 (4) SCC 457 to say that a descriptive trademark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source.

16. Learned counsel submitted that copyright in the board, which comprises of a unique grid consisting of diagonally criss-crossed coloured boxes, the tiles with their value, the rules of the game, combined together, as well as individually, is with the plaintiffs. Their cynical commercial exploitation by the defendants, whose SCRABULOUS is a slavish imitation of the plaintiffs game, amounts to infringement of copyright, which, unless enjoined, would cause incalculable harm to the plaintiffs' commercial interests.

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17. Mr. Sushant Singh, counsel for the defendant, submitted that there is no question in any trademark in the word SCRABBLE, which is generic, and has become publici juris. He supports this contention by relying on SBL LTD. v. Himalaya Drug Co, 1997 (17) PTC (DB) and Roche & Co. v. G. Manner & Co, AIR 1970 SC 2062; to say that no one can claim an exclusive right to a generic term and the customer will not consider the common feature and would pay more attention to the descriptive features. Learned counsel relied on the meaning of the expression ,scrabble□in ,the FREE ONLINE DICTIONARY□ it defines the term to mean ,aimless drawing□and ,a board game in which words are formed from letters in patterns similar to a cross word puzzle□ The dictionary also says that used as a verb ,Scrabble□means ,feel searchingly□

18. It was next urged that the plaintiffs cannot seek enforcement of the trademark SCRABBLE, because of Section 36 of the Trademarks Act, which reads as follows:

,36. Saving for words used as name or description or an article or substance or service.- (1) The registration of a trade mark shall not be deemed to have become in valid by reason only of any use after the date of the registration of any word or words which the trade mark contains or of which it consists as the name or description of an article or substance or service.

Provided that, if it is proved either -

(a) that there is well known and established use of the said word as the name or description of the article or substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) in relation to goods or services certified by the proprietor, or

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(b) that the article or substance was formerly manufactured under a patent that a period of two years or more after the cesser of the patent has elapsed and that the said word is the only practicable name or description of the article or substance. The provisions of sub- section (2) shall apply. (2) Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then,-

(a) for the purpose of any proceeding under section 57 if the trade mark consist solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, or of the services or of any services of the same description, or of the services or of any services of the same description, as the case requires, shall be deemed to be an entry wrongly remaining on the register.

(b) for the purpose of any other legal proceedings relating to the trade mark,-

(i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark, or

(ii) if the trade mark contains such words and other matters, all such right of the proprietor to the use of such words, in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same description, as the case requires, shall be deemed to have ceased on the date on which the use mentioned in clause (a) of the proviso to sub-section (1) first became well known and established or at the expiration of the period of two years mentioned in clause (b) of the said proviso. □

19. Learned counsel next urged that the plaintiffs' copyright claim is unfounded and incapable of enforcement. He urged that the plaintiffs' documents reveal that a patent claim was made earlier. Now, the plaintiffs cannot seek a wider protection in copyright law, for a much larger period of time. It was argued that the Copyright Act is meant to provide protection to expression of ideas through artistic or literary works, but not designs, particularly of those articles which are mass produced. Counsel IA NO.2352/2008 IN CS (OS) 344/2008 Page 12 submitted that Parliamentary intention was that whenever any artistic work can be commercially exploited by the owner, it should be excluded from protection of the Act, and correspondingly protection can be granted under the Designs Act. Counsel submitted that whenever the intention of putting a work to industrial use arises, protection under Copyright Act ceases. He relied on the judgment of this court, reported as Mircrofibres Inc.

-vs- Girdhar & Co 2006 (32) PTC 157 (Del). He also relied on Section 15(2) of the Designs Act, in support of this argument.

20. The above narrative would indicate that the plaintiffs' claims fall under two categories; firstly, copyright over the game board and the rules of the game, and secondly, claims of infringement of

trademark and passing off. The Court shall examine the copyright claims first.

21. An essential element of copyright law is that it does not grant the author of a literary work protection on ideas and facts. (Baker v. Seldon, 101 US 99 [1879], Nichols v. Universal Pictures Corp., 45 F.2d (2d Cir. 1930), RG Anand v. M/s Delux Films, (1978) 4 SCC 118) It is only the creative expression of such ideas and facts that is rewarded by law, by conferring a privilege to exclusively exploit such expression for a limited time. Law does not protect every such expression. The issue in Baker was whether the defendant's publication of a book on 'book-keeping' articulating a similar manner of book keeping as was done in the plaintiff's book amounted to infringement. Severing the expression of the idea of book keeping from the very science of book keeping the Court held as follows:

IA NO.2352/2008 IN CS (OS) 344/2008 Page 13 ,On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them. But as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright. The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright. The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.

The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters- patent, not of copyright.□

22. In the realm of copyright law the doctrine of merger postulates that where the idea and expression are inextricably connected, it would not be possible to distinguish between two. In other words, the expression should be such that it is the idea, and vice-versa, resulting in an inseparable ,merger□of the two. Applying this doctrine courts have refused to protect (through copyright) the expression of an idea, which can be expressed only in a very limited manner, because doing so would confer monopoly on the idea itself. The decision in Herbert Rosenthal Jewelry Corporation v. Kalpakian, 446 F.2d 738(1971) is illustrative in this regard. The plaintiffs there sued the defendants asking them to refrain from manufacturing bee shaped jewel IA NO.2352/2008 IN CS (OS) 344/2008 Page 14 pins. The Court held that the jewel shaped bee pin was an idea that anyone was free to copy, the expression of which could be possible only in a few ways; therefore, no copyright could subsist in it. In Nichols, Judge Learned Hand spoke about the famous ,abstractions□test which the courts must follow, when confronted with the idea/expression dichotomy:

,Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about,

and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ideas, to which, apart from their expression, his property is never extended. *Holmes v. Hurst*, 174 U.S. 82, 86, 19 S. Ct. 606, 43 L. Ed. 904; *Guthrie v. Curlett*, 36 F.(2d) 694 (C.C.A. 2).

23. The case of *Allen v. Academic Games League of Am.*, 89 F.3d 614 (9th Cir. 1996) is worth noticing at this stage. The plaintiff in that case contended that the rule books published by the defendants to play the games developed by the him, violated his copyright over the tournament rulebooks developed by him. The court rejected the plaintiffs claim and held that:

„A copyright only protects a particular expression of an idea and not the idea itself *Mazer v. Stein*, 347 U.S. 201, 218 (1954). Thus, ideas contained in a copyrighted work may be freely used so long as the copyrighted expression is not wholly appropriated. This is often the case with factual works where an idea contained in an expression cannot be communicated in a wide variety of ways. *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984), cert. denied, 469 U.S. 1037 (1984). Consequently, the notions of idea and expression may merge from such "stock"

IA NO.2352/2008 IN CS (OS) 344/2008 Page 15 concepts that even verbatim reproduction of a factual work may not constitute infringement. Accord See *v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983); *Sid & Marty Krofft Television Productions, Inc. v.*

McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977); *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987).

This doctrine of merger is particularly applicable with respect to games "since they consist of abstract rules and play ideas." *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F.Supp. 125, 148 (D.N.J. 1982); see also *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 300 n.1. (9th Cir. 1979). A similar logic has been applied to rules of a contest where most subsequent expressions of an idea of a rule are likely to appear similar to the words of a related rule. See *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967); *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 1188-89 (2nd Cir. 1975). Here, Allen has not shown that it is possible to distinguish the expression of the rules of his game manuals from the idea of the rules themselves. Thus, the doctrine of merger applies and although Allen may be entitled to copyright protection for the physical form of his games, he is not afforded protection for the premises or ideas underlying those games. To hold otherwise would give Allen a monopoly on such commonplace ideas as a simple rule on how youngsters should play their games. (emphasis supplied)

24. The doctrine of merger was also applied in *Atari Inc v. North American Philips Consumer Electronics Corp*, 672 F.2d 607, (1982 US App. LEXIS 21341) to deny wider protection to elements

in the video games. The US Court of Appeals (Seventh Circuit), speaking through a panel of three judges, said:

„...copyright protection does not extend to games as such. Chamberlin -vs- Uris Sales Corp, 150 F.2d. 512 (2d. Cir. 1945); see also Anti-Monopoly, Inc. -vs- General Mills Fun Group 611 F. 2d. 296, 300 n. 1 (9th Cir.

1979) . . . □

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The above formulation is not meant to foreclose copyright protection to all games; indeed, there can be certain distinctive elements, or patterns, innovated or created by its author, which, though intrinsic to the game, can claim independent copyright protection.

25. In India, in relation to games, rules and schemes (for playing) are not protectable under the Patents Act, 1970; they are not deemed inventions under the Act. Section 3 of the Patents Act, provides as follows:

.3. WHAT ARE NOT INVENTIONS.

The following are not inventions within the meaning of this Act,-

XXXXXXXX XXXXXXXXXX XXXXXXXXXX

(m) a mere scheme or rule or method of performing mental act or method of playing game;... □ An untenable patent claim- as rules of a game are- cannot transmigrate into a wider, longer lasting copyrightable expression. Such rules, in the absence of clear segregation of the expression from the idea, cannot be granted copyright protection. The expression, in this case is the idea itself.

26. The plaintiffs' claim to copyright is in respect of the three game- boards, with the diagonal criss-cross design with placement of the double word, triple word, double and triple letter values, as well as rules of the game. Every literary or artistic work, to be afforded protection, should be ,original □ under the Act. The content of what is 'original' has undergone considerable change from the previously applicable ,sweat of the brow' doctrine spelt out in University of London Press (supra) to the 'modicum of IA NO.2352/2008 IN CS (OS) 344/2008 Page 17 creativity' standard put forth in Fiest Publication Inc. Vs. Rural Telephone Service, 199 US 340 (1991). Our Supreme Court has also signified a shift; in Eastern Book Company v. DB Modak 2008 (1) SCC 1, following the approach of the Canadian Supreme Court in CCH Canadian Ltd., Vs. Law Society of Upper Canada (2004) SCC 13, it rejected the sweat of the brow doctrine, (which conferred copyright on works merely because time, energy, skill and labour was expended, that is, originality of skill and labour), and held that the work must be original ,in the sense that by virtue of selection, co- ordination or arrangement of pre-existing data contained in the work, a work somewhat different in character is produced by the

author□ Our Supreme Court noticed that the two positions i.e. the sweat of the brow on the one hand, and ,modicum of creativity□were extreme; it preferred a higher threshold than the doctrine of ,sweat of the brow□yet, not as high as ,modicum of creativity□ Thus, our law too has recognized the shift, and mandates that not every effort or industry, or expending of skill, results in copyrightable work, but only those which create works that are somewhat different in character, involve some intellectual effort, and involve a certain degree of creativity. This standard of originality, is now applicable in respect of the plaintiffs' claim to copyright in various aspects of the game.

27. So far as the collocation of lines on the game board are concerned; the diagonal colour scheme with values for words, and the combination thereof, the element of modicum of creativity has not been shown, to measure up to the test of ,originality□ post Eastern Book Company. Even otherwise, the creative expression, if any is minimalistic not to warrant IA NO.2352/2008 IN CS (OS) 344/2008 Page 18 copyright protection. Furthermore, and most importantly, the application of the doctrine of merger would mean that the colour scheme on such a board can be expressed only in a limited number of ways; if the plaintiffs' arrangement were to be avoided, it is not known whether the idea of such a word game could be played at all. Similarly, the reasoning in Allen and Atari, as far as copyrightability of rules of a game are concerned apply squarely, in this case. This doctrine of merger is applicable with respect to games as (according to those decisions) ,they consist of abstract rules and play ideas." By way of illustration, the arrangement of colours, values on the board, the collocation of lines, value for individual alphabetical tiles, etc have no intrinsic meaning, but for the rules. If these rules- which form the only method of expressing the underlying idea are to be subject to copyright, the idea in the game would be given monopoly: a result not intended by the lawmakers, who only wanted expression of ideas to be protected. Thus, this court concludes, prima facie, that the copyright claim of the plaintiff cannot be granted.

28. As far as the defendants' arguments on the question of the copyright protection in this case, not being available due to provisions of Section 15 of the Act, and provisions of the Designs Act are concerned, it would be appropriate to set out the observations in Microfibres (supra):

,In India, we have special legislations governing the protection of different nature of rights. Insofar as the industrial designs are concerned, the protection is provided under the Designs Act, 2000, which came into force from May, 2001 and repealed the earlier Designs Act, 1911. An important and relevant aspect is that both under the old Act and the new Act, fabric designs on textile goods have been classified as proper subject matter of IA NO.2352/2008 IN CS (OS) 344/2008 Page 19 design protection by inclusion as a specific class in the Rules framed under the Acts. In the Designs Act of 1911, Classes 13 and 14 of the Fourth Schedule of the Rules dealt with printed or woven designs of textile goods other than checks and stripes and checks and stripes respectively. Such protection is now provided under Class 5 of the new Design Rules of 2001.

64. Furthermore, the legislative intent is also to be kept in mind which is to provide protection for a certain period of time for commercial exploitation.

Thus, nature of protection is quite different for an artistic work under the Copyright Act which is for the lifetime of the author / creator + 60 years. This is not so in the case of commercial exploitation as under the Designs Act and the Patent Act the period is much lesser. In the present case, the configuration was made only with the object of putting it to industrial / commercial use.

65. The exclusion of an 'artistic work' as defined in Section 2(c) of the Copyright Act from the definition of 'design' under Section 2(d) of the Designs Act, 2000 is only meant to exclude the nature of artistic works like painting of M.F. Hussain. It is, thus, the paintings, sculptors and such works of art which are sought to be specifically excluded from the new Act.

66. The observations of the learned Single Judge in M/s. S.S. Sarna Inc's case (supra) succinctly set out the concept behind excluding certain designs from protection under the Copyright Act which was to avoid any hindrance being caused to the manufacturer of sale and industrial articles. Thus, the intention of the Legislature has been expressed as one to protect any artistic work which has to be commercially exploited by the owner of the copyright by not providing the protection under the Copyright Act, but under the earlier the Designs Act, 1911. A similar view was also expressed by another learned Single Judge of this Court in Samsonite Corporation's case (supra). To this extent, I see no difference between the intent under the old Act and the new Act. A perusal of the Statement of Objects and Reasons for introduction of the new Act, the handouts issued by the Design Office and the registrations made of textile fabrics both under the old Act and the new Act leave little manner of doubt that the protection for such configurations, designs or works (by whichever name it may be called) is provided under IA NO.2352/2008 IN CS (OS) 344/2008 Page 20 the Designs Act. It is, thus, apparently clear that in the context of the Indian Law, it is the Design Act of 1911 or 2000, which would give protection to the plaintiff and not the Copyright Act. The application of mind and skill is not being denied nor the fact that the defendants have copied the same, but that would still not amount to the works in question being labeled as 'artistic work' within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act. Issue No. 1 is answered accordingly.□

29. The objective of Copyright law is to protect the original literary, dramatic, musical and artistic works, cinematograph films, sound recordings, broadcasting rights and/or performers' rights. The object of Design Law, on the other hand, is protection of the features of shape, configuration, pattern, ornamentation, or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms by industrial process or means, whether manual, mechanical or chemical, separate or combined which in the finished appeal to and/are judged solely by the eye, but does not include any trade mark or property mark or artistic work. ,Copyright□is defined in Section 2 (c) of the Designs Act to mean exclusive right to apply a ,design□to any article in any class in which design is registered. ,Copyright□in Section 14 of the Copyright Act is defined to mean an exclusive right to authorize the doing of any of the acts as prescribed therein. Section 15 of The Copyright Act precludes the subsistence of Copyright in the Design which is registered or is capable of being registered as a ,design□under The Designs Act, 1911

30. Section 47 (2) (c) - of the Designs Act, 2000 enables the Central Government, for the purposes of classification of articles, (to facilitate registration under Section 6 of the Designs Act, 2000) to

frame rules.

IA NO.2352/2008 IN CS (OS) 344/2008 Page 21 Pursuant to this, the Designs Rules, 2001 were framed; Rule 10 prescribes that classification, for the purposes of registration of various articles shall be according to the Third Schedule (to the Rules). The third schedule, by Class 21, Entry 21-01 deals with GAMES AND TOYS and by Entry 21-03, deals with OTHER AMUSEMENT AND ENTERTAINMENT ARTICLES. These prima facie cover all games and amusement articles as well as toys. Designs in respect of various articles of games and other amusement articles, including game boards, therefore, can, prima facie, be registered.

31. Section 15 of the Copyright Act mandates that copyright subsists under the Copyright Act in any design, which is registered under the Designs Act, 1911 and in respect of designs capable of registration under the Designs Act, 1911, the copyright shall cease as long as any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the owner of the copyright or his licensee. It cannot be disputed here that reproduction of the multicoloured game board has occurred more than 50 times, as also the alphabetical tiles. It is not also in dispute that there is no registration which has taken place under the Designs Act, 1911 (or under the Designs Act, 2000). In these circumstances, the defendants' objection that copyright cannot be claimed, is prima facie merited. For this reason too, it is held that the plaintiffs' copyright claims cannot be granted, at this stage.

II The Trademark claim

32. The object of trademark law is to prevent an injury to the goodwill and reputation of the enterprise which owns the trademark; as well as ensuring that consumers are not misled as to the product, services or their IA NO.2352/2008 IN CS (OS) 344/2008 Page 22 sources. Marks help buyers to identify their source, and assure them of the constancy of quality from a particular producer. The essence of a trade mark has always been that it is ,a badge of origin□(Ref Scandecor Developments AB v Scandecor Marketing AB 4 April 2001, UKHL 21 of 2001). It indicates trade source: a connection in the course of trade between the goods and the proprietor of the mark. Trademarks are thus, a valuable medium of advertisement, vital for marketing of products. If the consumers understand the trademark in the context of its source, the manufacturer is inseparably associated with it. The drawback here could be that trademarks are misused if they serve to limit competition in the manufacture and sales of a product.

33. The genericness doctrine in trademark law is a method evolved to inhibit anti-competitive use of trademarks. In Anti-Monopoly, the genericness doctrine was described as follows:

„At its simplest, the doctrine states that when a trademark primarily denotes a product, not the product's producer, the trademark is lost. As we have stated, "one competitor will not be permitted to impoverish the language of commerce by preventing his fellows from fairly describing their own goods." Bada Co. v. Montgomery Ward & Co., 426 F.2d 8, 11 (9th Cir.), Cert. denied, 400 U.S. 916, 91 S.Ct. 174, 27 L.Ed.2d 155 (1970). Thus, the Lanham Act, enacted in 1947, provides for

the cancellation of a trademark if "at any time (it) becomes the common descriptive name of an article or substance." 15 U.S.C. § 1064(c). Further, "no incontestable right shall be acquired in a mark which is the common descriptive name of any article or substance, patented or otherwise." 15 U.S.C. § 1065(4). Courts equate "common descriptive name," as used in the statute, with the IA NO.2352/2008 IN CS (OS) 344/2008 Page 23 shorthand expression "generic term." See, e. g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

....One way courts have analyzed genericness is to ask whether a term "has come to be understood as referring . . . to the genus of which the particular product . . . is a species." *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, supra, 537 F.2d at 9. The distinction is between a broad classifying term the genus and a specific sub-classifier the species. As a hypothetical example, suppose several manufacturers produce game equipment for playing chess. Chessco's chess game is called EN PASSANT. When a consumer has available in his vocabulary the broad classifier "chess," but instead asks for EN PASSANT, we can infer that the consumer wants the "species" of chess equipment produced by Chessco. The consumer may have innumerable reasons for desiring EN PASSANT chess equipment: E. g., price, style, durability, consistency of quality, goodwill engendered by a catchy commercial jingle, or simply a liking for the sound of the trademark. But these desired characteristics are all source-particular, in that they correlate with a given producer, Chessco. The consumer thus uses the term EN PASSANT exactly as a trademark should be used to enable him to recognize and ask for a particular producer's chess equipment. Moreover, Chess Co benefits precisely as a producer should from a trademark: it reaps profits from consumer goodwill both as to quality of its goods and attractiveness of its advertising associated with its unique personality in the marketplace. It is important to recognize that the species term EN PASSANT subcategorizes only as to source. For trademark genericness purposes, it is the source-denoting function of EN PASSANT which causes us to call EN PASSANT a species instead of a genus.

A genus, in contrast to a species, is a product category including essentially interchangeable goods made by unique producers. To the extent the goods within the genus differ, their distinguishing characteristics are primarily source-particular, E. g., price, quality, and advertising jingle. When, in the consumers' minds, the IA NO.2352/2008 IN CS (OS) 344/2008 Page 24 characteristics which distinguish a particular product are no longer primarily source-particular, that product becomes its own genus, and its name becomes a generic name. See *Dixie Rose Nursery v. Coe*, 76 U.S.App.D.C. 371, 372, 131 F.2d 446, 447 (D.C.Cir.), Cert. denied, 318 U.S. 782, 63 S.Ct. 856, 87 L.Ed. 1149 (1942). See also *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir.), Cert. denied, 299 U.S. 601, 57 S.Ct. 194, 81 L.Ed. 443 (1936), 304 U.S. 575, 58 S.Ct. 1047, 82 L.Ed. 1539 (1938); *Bayer Co. v.*

United Drug Co., 272 F. 505 (S.D.N.Y.1921).□

34. The US Supreme Court, in Wal-Mart Stores, Inc. -Vs-. Samara Brothers, Inc. (99-150) 529 U.S. 205 (2000), considered differing nature of trademarks, and the stage when a mark could be said to become ,distinctive□as to be afforded protection:

,In evaluating the distinctiveness of a mark under §2 (and therefore, by analogy, under §43(a)), courts have held that a mark can be distinctive in one of two ways. First, a mark is inherently distinctive if ,*its+ intrinsic nature serves to identify a particular source.□Ibid. In the context of word marks, courts have applied the now-classic test originally formulated by Judge Friendly, in which word marks that are ,arbitrary□(,Camel□cigarettes), ,fanciful□(,Kodak□film), or ,suggestive□(,Tide□laundry detergent) are held to be inherently distinctive. See Abercrombie & Fitch Co.

v. Hunting World, Inc., 537 F.2d 4, 10--11 (CA2 1976).

Second, a mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, ,in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.□Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851, n. 11 (1982).*1□IA NO.2352/2008 IN CS (OS) 344/2008 Page 25

35. In this case, the defendant's contention about genericness of the word mark SCRABBLE is not entirely without any basis. Each time courts are confronted with the issue of determining whether general words used as marks are source specific, the nature of the product, the degree of resemblance it bears with the word mark, the length of time used, are guiding, though not the only factors to be considered. Though courts would be slow in conferring a monopoly over common words, yet if a mark is shown to conjure up strong associations with the product or services, there should be no hesitation in affording protection. Midas Hygene is an authority on the point that there cannot be a blanket policy against inferring that generic words cannot acquire distinctiveness.

36. The defendant raises the issue that under Section 36, the court should refuse protection to the plaintiffs' word mark, since the game can be described only as SCRABBLE. Prima facie, the argument appears powerful; the defendant cites the authority of Coca-Cola Co. v. Pepsi-Cola Co. (1942), 2 D.L.R. 657 (P.C.) where Coke sued Pepsi for violating its trade-mark. The courts ruled that ,Cola□was simply a descriptive word identifying a type of beverage, and that the ,distinguishing feature□of the Coca-Cola trade-mark was the word ,Coca.□And because the distinguishing feature was not borrowed, there was no likelihood that the average person would get those trade-marks confused. This contention is somewhat supported by the decision reported as J.P. Kapoor v. Micronix India, 1994 Suppl. (3) SCC 215, where the Supreme Court observed that the word, ,micro□being descriptive of micro technology used for production IA NO.2352/2008 IN CS (OS) 344/2008 Page 26 of electronic items of daily use, could not be claimed exclusivity. Here, the word ,scrabble□by the defendant's showing, based on the ,Free Online Dictionary□is to:

"1. To scrape or grope about frenetically with the hands.

2. To struggle by or as if by scraping or groping.

3. To climb with scrambling, disorderly haste; clamber.

4. To make hasty, disordered markings; scribble. v.tr.

1. To make or obtain by scraping together hastily.

2. To scribble on or over.

n.

1. The act or an instance of scrabbling.

2. A scribble; a doodle. □([http://www.thefreedictionary.com/s crabble](http://www.thefreedictionary.com/s+crabble) visited on 15-9-08, at 23-17 hrs)

37. The above facts show that 'SCRABBLE' is not per se descriptive of the word game, unlike, say MONOPOLY or CROSSWORD, which are close to the genus. No doubt, its extensive use and popularity has resulted in the word being used to describe the game. But that is precisely what the plaintiffs contend, in support of their argument about distinctiveness of the mark. In evaluation of these competing claims, the court cannot be unmindful of the fact that language is an evolving and organic system, which assimilates all kinds of usage, customs and convenient descriptions of objects, processes, systems, places and persons. The journey begun by a word with one meaning, might well end up with an entirely different one, the original meaning obscured in course of time. Etymological adventurism by the court should not lead to loss of distinctiveness of a IA NO.2352/2008 IN CS (OS) 344/2008 Page 27 mark which is part of the popular lore. The plaintiffs have shown that SCRABBLE, according to the Oxford Dictionary is a proprietary word game. They have also produced other supporting evidence of its extensive use, as word mark for the game. These, the registration which they undeniably hold, in respect of the mark, their claim of sales in India to the extent of Rs. 13 crores, (of the game) and their averment to having spent Rs. 51 lakhs in advertisement, prima facie entitles it to protection; denial, of interim injunction at this stage would result in irreparable injury, and the danger of genericness of the mark, with consequent loss of distinctiveness.

38. The defendants' mark, SCRABULOUS is too close, phonetically and semantically to the plaintiffs' mark, to be an original inventive term. They have not furnished any explanation, why they hit upon this term, for a word game. Besides, the hyperlinks, which they provide in their websites, to the plaintiffs' websites, evidences that SCRABBLE inspired them to coin their mark. Indeed, the tenor and nature of their argument was that SCRABBLE is generic, incapable of protection, and their variant SCRABULOUS thus cannot be enjoined. Besides, the material produced by the plaintiffs, in the form of users' comments, culled out from various 'blog' archived articles, as well as

from 'Facebook' and the defendants' ,Scrabulous Wall□reveal that the users played the game scrabulous, on the basis of web search for 'online scrabble'. All these are prima facie proof of deceptive similarity and confusion amounting to infringement.

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39. The court is also of the opinion that unless appropriately injuncted, from continuing to use SCRABULOUS or any other trademark deceptively or confusingly similar to the plaintiffs' the defendants would continue these acts of infringement, and divert internet traffic to their websites, causing considerable commercial loss to the plaintiffs. The balance of convenience too lies in favour of the plaintiffs for grant of temporary injunction, because, the defendants have not shown how their use is bona fide, or how they would be prejudiced. On the other hand, the denial of relief would cause harm and injury to the plaintiffs.

40. In view of the above discussion, the defendants, their partners, agents, or any business associates, etc are hereby restrained from infringing the plaintiffs' registered trademark in SCRABBLE; they shall not use the name SCRABULOUS, or any other mark deceptively or confusingly similar to SCRABBLE, in any manner, including by using it as part of domain name, or other use such as hyperlinking, metatagging, advertisement, or any other such form of use, till disposal of the suit. IA No. 2352/2008 is allowed in these terms. No costs.

CS(OS) 344/2008 List on 10.02.2009 before the Joint Registrar for admission/denial of documents.

DATE: 17th September, 2008

S. RAVINDRA BHAT, J

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