

**MEMORIAL FOR SP SATHE NATIONAL MOOT
COURT COMPETITION**

IN THE HON'BLE HIGH COURT OF BOMBAY
AT BOMBAY

Jack Samuelson and Brightwalker Studio LtdPlaintiffs

Versus

Earl Grey and Edified Comics LtdDefendants

Written Submissions on behalf of the Defendants

Counsels for the Defendants

MEMORIAL FOR SP - 07

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LIST OF ABBREVIATIONS

1. AIR - All India Reporter
 2. Art - Article
 3. s - Section
 4. HC - High Court
 5. SC -Supreme Court
 6. SCC - Supreme Court Cases
 7. SCR - Supreme Court Reports
 8. P - Page
 9. Para - Paragraph
 10. TM Act - Trade Marks Act
 11. CPC - Civil Procedure Code
 12. BSL - Brightwalker Studio Ltd.
 13. ECL - Edified Comics Limited
 14. C.D.Cal - Central District of California
 15. S.D.N.Y - Southern District of New York
 16. F.S.R - Fleet Street Cases Cir. - Circuit
 17. PTC - Patents & Trade Marks Cases
 18. USPQ - United States Patent Quarterly
 19. All ER - All England Law Report
 20. Del - Delhi
 21. Mad - Madras
 22. F2d - Federal Reporter 2nd Series
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19. Gregory J Battersby and Charles W Grimes, *Trademark and Copyright Disputes: Litigation forms and analysis* (Aspen Publishers 2010)

4. TREATIES AND CONVENTIONS

1. Paris Convention For The Protection Of Industrial Property 1883
2. Berne Convention For The Protection Of Literary And Artistic Works 1886

STATEMENT OF JURISDICTION

The Respondent humbly submits this memorandum in response to the petition filed before this Honourable Court. The counter-claim invokes its jurisdiction under Section 134 of The Trade Marks Act, 1999, read along with Section 2(4) of the Code of Civil Procedure. It sets forth the facts and the laws on which the claims are based.

STATEMENT OF FACTS

1. The book series "*Ballad of Malice and Power*", a fantasy fiction is written by Jack Samuelson in which, he had conceived an entire fantasy land of kings, dragons and mystical creatures intertwined in a complex and addictive political drama and quest for ultimate power.
2. The series comprised of seven books. Printed and digitized versions of each were available for sale in the US, members of the European Union, Canada, China and the Indian Sub-Continent.
3. Brightwalker Studios Ltd. (BSL), a US based network and production company, in 2005 acquired an exclusive license to adapt the 'Ballad of Malice and Power' into a full-fledged television show called "Valar Dohaeris: The Beginning" (the Show). The first season released in 2009 and became the most watched show in television history. The show was released in India through an exclusive online paid portal named ZoomIn.
4. BSL produced and developed a spin-off series (a prelude to the show) called "Boromir the Conqueror" based on the life and conquests of Boromir Bohemia, a pivotal character in the plotline. BSL also commenced marketing and released a teaser-trailer in June 2015. The show was globally released on 9th February 2016.
5. Ms. Earl Grey published a comic strip with Boromir Bohemia as the protagonist in her blog *The Pickwick Papers* without prior authorization by Samuelson. She also assigned her IP rights to Edified Comics Ltd. (ECL), a commercial comic book publication company registered and based out of Mumbai (India).
6. ECL obtained in January 2015 a trademark in the word BOROMIR and in a pictorial representation of Boromir from the comic. ECL released goods with its logo and a pictorial representation of Boromir in February 2105.
7. BSL decided to produce a spin-off series with Boromir as the protagonist in February 2105 and went ahead to release the trailer in June 2015 and the series in February 2016.
8. ECL released the comic book "The Bohemian Rhapsody" on 16th August 2016 following which Jack Samuelson and BSL filed a suit in the High Court of Bombay against Earl Grey and ECL for misappropriation of the character Boromir.

9. The defendants retorted with against BSL for unlawful use of its trademark on the “Boromir the Conqueror.”

STATEMENT OF ISSUES

1. Whether the work of the Defendants is copied from the works of the Plaintiffs?
2. Whether the works of the Defendants are copyrightable?
3. Whether BSL through its series “Boromir the Conqueror” has made an unlawful use of the Registered Trade mark of ECL of the Word “Boromir”.
 - i. Whether the use of “Boromir” by BSL has constituted infringement of trade mark under Sec 29(2) of The Trade Marks Act 1999.
 - ii. Whether the use of “Boromir” by BSL has constituted infringement of trademark under Sec 29(4) The Trade Marks Act 1999.
 - iii. Whether there has been a dilution of Trade mark of the defendants?
4. Whether the defendants are entitled to any remedy. If so, the nature and quantum of the remedy.
 - i. Whether permanent injunction order be decreed against the petitioners.
 - ii. Whether the defendants are entitled to receive any damages.

ARGUMENTS ADVANCED

I. THE WORKS OF THE DEFENDANTS ARE NOT COPIED FROM THOSE OF THE PLAINTIFFS.

(I) The alleged similarities are not substantial parts of the Plaintiffs' works.

¶ (1) As per the rule laid down in *Dorsey v. Old Surety Life Ins. Co*¹, copyright in a work is infringed by taking a substantial part from it. The following are the parts of the Defendants' work that are alleged to be in similarity with that of the Plaintiff: 1) a fictional land, 2) the character Boromir who is not alive, 3) kings, dragons and mystical creatures, 4) political theme with quest for power. These above mentioned parts are necessarily not substantial parts of the works by Plaintiffs. On the other hand, these are trivial details that are highly unsubstantial. They do not satisfy the conditions laid down in *Ladbroke v. William Hill*², *Daily Calendar Supplying Bureau, Sivakasi v. United Concern*³, *Hanfstaengl v. Bains & Co*⁴. Hence, the Defendants' work is not copied from the Plaintiffs.

(II) The alleged similarities are not copyrightable by the Plaintiffs.

¶ (2) The alleged similarities are limited to a fictional character who finds little mention, a political theme, and an idea of a fantasy land with kings, mystic creatures and dragons; and are not protected by copyrights.

1. Fictional characters are not copyrightable

¶ (3) A Fictional character (in this case Boromir) is a word portrait and the physical appearance and the characterization reside in the mind of the reader. Such imagination is brought about by reading about the character through the pages of a book. The character, therefore, is not apparent for the reader.^{5 6} A fictional character has three identifiable and

¹ [1938] 98 F.2d 872 (10th Cir.)

² [1964] 1 WLR. 273

³ [1964] AIR 381 (Mad)

⁴ [1895] AC 20, 25.

⁵ SKD Biswas, "Copyrightability of characters"[2004] JIPR 148,149

⁶ *Universal City Studios v. Kamar Industries* [1982] CCH 25

legally significant components: its name, its physical or visual appearance, and its physical attributes and personality traits or characterization.⁷

The character Boromir fails the two tests for determining whether a character is protected by copyright outside the work it appears.

Distinctively Delineated test:

¶ (4) This test was originated in the famous case of *Nichols v. Universal Pictures Corp.*⁸ A character can be protected outside the work it appears only if it is well developed. The Learned Judge who propounded this test held that “*It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for making them too distinctly*”

¶ (5) A character needs to be fully expressed to be protected by copyright law. The characters which have held to be protected by courts are central characters such as Tarzan⁹ which are central to the work they appear in.

¶ (6) In the case of *Anderson v. Stallone*¹⁰, it is stated that when a character is identified with specific character traits ranging from his speaking mannerisms to his physical characteristics, copyright protection is required to be granted to such characters.

¶ (7) The character Boromir was dead in the Television series and the book. The other characters merely spoke about Boromir in certain parts of the book. The only thing that was expressed about the character was that Boromir was the greatest conqueror and that he was the last person to ride a fully grown dragon. Even in the series, the character was never visually represented; The degree of protection a character can receive is next to nothing in cases where the character is not visually represented.

Story being Told Test:

¶ (8) This test was originated in *Warner Bros Pictures v. Columbia Broadcasting System*¹¹
¹²wherein the Court held that no character was protectable under copyright law unless the

⁷ Feldman David, “Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection”, California Law Review 690

⁸ [1930] 45 F.2d 119 (2d Cir.)

⁹ Edgar Rice Borroughs, Inc v. MGM, Inc.,[1962] 23 cal. Rptr. 14

¹⁰ [1989] 11 USPQ 2d 1161

¹¹[1954] 106 USPQ 103

¹²V.T.Thomas v. Malayala Manorama [1989] AIR 49 (Ker)

character was extremely well-delineated as to constitute, ‘the story being told’ rather than merely being a chess man in the game of telling the story.’

¶ (9) Applying the same standard, the court refused to grant copyright protection to the character ‘Regan’ in the movie *Exorcist* because the story was not subordinated to the character of Regan¹³

¶ (10) The Character Boromir is not part of the central plot at all. The series “Ballad of Malice and Power” is a fantasy political drama and the central plot line features characters which are in a quest for power. The Character Boromir is dead and he does not contribute much to the plot; the character is a mere Chess piece in the story being told.

2. Ideas, themes and plots are not copyrightable

¶ (11) In accordance with the Calcutta High Court’s decision on *Barbara Taylor Bradford v. Sahara Media Entertainment Ltd.*¹⁴, , thus, curbing future creativity. The Court further observed that where a person copied a plot consciously or the law protects originality of expression and not the originality of central idea. The Court further held that law must protect the originality of work so the authors can reap the benefits but it should not become over protective unconsciously, he must also weave into the plot sufficient creations of his own imaginations and literary skill to make his work his own.

¶ (12) A foundational element of copyright law is that it does not grant the author of a literary work protection on ideas and facts¹⁵ and also idea is not a subject-matter of copyright.¹⁶

In accordance with the principle laid down in *Donoghue v. Allied Newspapers Ltd.*¹⁷, once the ideas have been expressed in the form of literary work, it is the form of expression which is the subject of protection, not the ideas, which themselves may be freely extracted from the work and absorbed and used by others to produce their own works so long as the form of expression of the copyright work is also not taken.¹⁸ This idea has been reinforced by various

¹³ Warner Bros v. Film ventures International, 403 F Supp. 522 1975 (C.D. Cal)

¹⁴ [2004] (28) PTC 474(Cal)DB

¹⁵ Baker v Seldon, 25 L Ed 841: 101 US 99 [1879]

¹⁶ *Twentieth Century for Film Corporation v Sohail Makali Entertainment Pvt. Ltd. & Another*, 2010 (44) PTC 647 (Bom) [651]

¹⁷ [1937] 3 All. E.R. 503

¹⁸ *ibid*

succeeding decisions in *Hollinrake v. Truswell*¹⁹, *Harman Pictures N. V. v. Osborne*²⁰, *R.G.Anand v. Deluxe Films*²¹, , *Time Warner Entertainment Company v. RPG Netcom*²².

The ruling in *Kenrick v Lawrence & Co*²³ held that:

“...or the idea may have been expressed in such a trivial fashion that the expression does not form a substantial part of the work as a whole. The most usual type of case is where the expression of the idea may merit protection but the defendant has not appropriated the author’s skill and labour in giving form to that expression.”

¶ (13) Copyright subsists in expressions, not in ideas. In Twentieth century of *Film Corporation v. Sohail Maklai Entertainment Pvt. Ltd. & Another*, the Bombay High Court stated that an idea, which was available in the world, could not be a monopoly of anyone. The Delhi Court was of the same view in *Time Warner Entertainment Company v. RPG Netcom*²⁴ where the Court stated that “the objective of copyright is not to create any legal or intellectual property rights in the idea but in the final object of the work which is created as a result of the effort made to give a ‘physical’ shape to an idea.

¶ (14) In *R.G. Anand v. Delux Films*,²⁵ the Supreme Court laid down the following propositions after careful consideration and elucidation of the various authorities and the case law on the issue of infringement of copyright:

There can be no copyright in an idea, subject matter, themes, plots or historical or legendary facts and violation of the copyright in such cases is, confined to the form, manner and arrangement and expression of the idea by the author of the copyrighted work.

¶ (15) Where the same idea is being developed in a different manner, it is manifest the source being common, similarities are bound to occur. In such a case, the courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant’s work is nothing but a literal imitation of the copyrighted work with some variations here and there, it would amount to violation of the copyright. In other words, in order to be actionable, the copy must be

¹⁹ [1894] Ch. 420

²⁰ [1967] 1 WLR 723

²¹ [1978] SC 1613

²² [2007] Del PTC 668

²³[1890] 25 Q.B.D. 99

²⁴ [2007] 34 PTC 668 (Del) DB

²⁵ [1978] AIR 1613 (SC)

substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.

II. THE WORKS OF THE DEFENDANTS ARE COPYRIGHTABLE.

I. The works of the Defendants are original.

¶ (16) According to **Sec. 13** of the **Copyright Act 1957**, which states that, copyright subsists of the following works:

- (a) *Original literary, dramatic, musical and artistic works*
- (b) *Cinematograph films*
- (c) *Sound recordings.*

¶ (17) The scope of the word ‘originality’ can be interpreted in many ways but according to *Camlin Private Limited v. National Pencil Industries*²⁶ copyright subsists in an original literary work but the Copyright Act is not concerned with the originality of ideas but with the expression of thought in print or writing. But that expression of thought must come from the author itself²⁷ i.e., the expression need not be in an original form but the expression should not be copied from another work.²⁸

¶ (18) Additionally it was held in the *MacMillan v. Cooper*²⁹ and *Rupendra Kashyap v. Jivan Publishing House*³⁰, that a work may be original if the author has applied his skill or labour, even though he has drawn on knowledge common to himself and others or he has used already existing material.

¶ (19) Therefore a work is original if it satisfies the following criteria:

- a) Expression of thought in print or writing must be the authors’ own work and should not be copied from another work.
- b) The author should have applies his skill and labour, even though he has drawn on knowledge common to himself and others or he has used already existing material.

Ms.Grey sketched Boromir a face and body, installed a mind and granted him his very own storyline. So she has expressed her unique thought on Boromir in writing. She

²⁶ [2002] 24 PTC 349 (Del)DB

²⁷ *Designers Guild Ltd. v. Russell Williams (Textile) Ltd.* [2001] FSR 11

²⁸ *University of London Press Ltd. V. University Tutorial Press Ltd;* [1916] 2 (Ch D) 601

²⁹ AIR [1924] PC 75

³⁰ [1996] Del PTC 439

then employed her own imagination to create a plotline, new characters and anew world altogether all in intricate detail using her skill and labor. Therefore, Ms. Grey's character Boromir is an original character. Therefore, under Section 13 of the Copyright Act, the work is original and copyrightable.

II. Copyright by equity

¶ (20) Common law principles provide copyrights to the author for his labour invested irrespective of novelty. The Berne Convention and TRIPs resonate with this principle. Originality is not expressed to be a requirement for protection under the Berne Convention or TRIPs. The concept behind the Berne Convention is, however, to accord protection to authors in respect of their intellectual creations. This implies that the product so created is the result of the individual's own intellectual efforts, and, therefore in this sense is original to him

Therefore, the works of the Defendants merit copyright protection under Section 13 of the Copyright Act.

COUNTERCLAIM

III. ECL HAS TRADEMARK OVER THE WORD 'BOROMIR' AND IN PICTORIAL REPRESENTATION OF BOROMIR BOHEMIA FROM THE COMIC.

¶ (21) ECL obtained trademark in India on the word "Boromir" and also in the pictorial representation of Boromir Bohemia from the comic on 4th January 2015. All the procedures were duly followed. The application for trademark was made in accordance of Section 18 of the Trademark Act which was later on accepted after going through all the grounds of refusal under Section 23 of the said act. As the application the trademark has been accepted it can be said that either (i) the application has not been opposed and the time for notice of opposition has expired or (ii) the application has been opposed and the opposition has been decided in favour of the applicant. By the virtue of Section 23, the registration of the mark relates back to the date of the application and the statutory mark after registration is conferred on the registered proprietor from the date of application. Therefore exclusivity in the mark on registration is granted with effect from the date of application for registration. And according to Section 25 of the said act the duration for the registered trademark is for 10 years but maybe renewed from time to time.

IV. BSL HAS INFRINGED THE TRADE MARK RIGHTS OF ECL

¶ (22) The basic requirements for an infringement of trade mark as given in section 29:

- i. Registered Trademark used by a person other than the registered proprietor by a person
- ii. The use by such person must be in course of his trade
- iii. There should be a mark identical to the trade mark in a trade of similar goods and services
- iv. The mark used should be able to cause confusion in the minds of public.

I. The registered trade mark is being used by a person other than the registered proprietor³¹

¶ (23) The registered proprietor of the trade mark ‘Boromir’ is ECL, but the same was used by BSL in the teaser-trailer of their spin-off series ‘Boromir the Conqueror’ which was released in June 2015 and later on in the series itself in February 2016.

The entire spin-off series is based only on trade mark and also uses it as the title name of the series i.e. ‘*Boromir, the Conqueror*’, this is blatant infringement of the trade mark.

II. The use by such person must be in the course of trade

¶ (24) The BSL used the trade mark for marketing its teaser-trailer in June 2015 and also used it in releasing the spin-off series in February 2016 with the trade mark in the title as well as in the series, which was completely based on it. Without doubt the use of the trade mark was in the course of trade.

III. There should be a mark identical to the trade mark in a trade of similar goods and services

¶ (25) For our case we shall focus on 29(2)(i) that is where the mark is identical and the goods or services are similar. In the case *Consitex S.A v. Kamini Jain*³² the court held that section 29(2) recognizes the concept of likelihood of association, the consumer is likely to believe or associate the goods of the defendant with that of the plaintiffs. Here BSL had used the trademark of ECL in the name of the TV series “Boromir the conqueror” which is identical to the trade mark of ECL. There is also a similarity in the goods or services traded. In the case *Balkrishna Hatcheries v. Nandos International Ltd. and Another*³³ to find out if the goods or service were similar the following tests and Factors were applied:

- a. Respective uses of the goods or service and both the TV series and comics come under the head of Entertainment under the definition of Services in Sec 2(z)
- b. Respective Users of the good or service. It is to be taken under this that the users of both the comics and TV series are that part of the public interested in knowing the story of Boromir.

³¹The Trade Marks Act, 1999, s 29

³² [2011] 47 PTC 337 (Del)

³³ [2007] 35 PTC 295 (Bom)

Arguendo, Even if the goods were not of a similar nature according to Sec 29(4) of The Trade Marks Act 1999 there has been an infringement of trade mark.

¶(26) Sec 29(4) is as follows: A registered trademark 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.

The section explains a case where there is a trade mark infringement in case of a use of a registered trade mark in dissimilar goods or services and it has a reputation. In the case *Neo Milk Products Private Limited v. Neo Foods Private Limited*³⁴ it was held that even though what was sold were goods that were dissimilar it was likely that the similarity in trade mark is likely to dilute the distinctive character of the registered mark and there is no need to check whether it would cause deception or confusion on the part of the public. In the case *Skol Breweries v. Unisafe Technologies*³⁵ it was held the following “the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark”. If we divide this definition then we can establish that there has been an infringement of copyright under the said section. In the case *Bloomberg Finance LP v. Prafull Saklecha & Others*³⁶ it was held that the word or between the distinctive character and repute meant that it was inserted to apply to a situation where the mark may not be distinctive character but yet may have a reputation.

¶ (27) In the case *Blue Hill Logistics Private Ltd. v. Ashok Leyland Ltd.*,³⁷ the word reputation was assessed on the basis of several factors such as,

- a. Publicity that preceded and succeeded the launch. In this case the facts are clear that the ECL had started to manufacture and sell various merchandise to

³⁴ [2014] 59 PTC DB (Del)

³⁵ [2010] 44 PTC 209 (Del)

³⁶ [2013] 56 PTC 243 (Del)

³⁷ [2011] 48 PTC 546 (Mad)

monetize the prevailing popularity³⁸. And the publicity that succeeded to the release is also mentioned in the facts of the case which stated that the comic series generated an overwhelming response³⁹.

- b. The turnover and the impact that the mark has created in the general public enabling them to associate the mark with the product. Here it is to be stated that in the case *Ashok Leyland Limited v. Blue Hill Logistics Pvt. Ltd.*,⁴⁰ it was held that although turnover might be an indicator of success it is not a determinative factor of goodwill and reputation. Since the facts are silent on the turnover obtained the second condition is fulfilled that the mark has enabled the people to associate it to the product as the product had an overwhelming global response so much that it was expected to break the previous best selling comic series and the subject of this comic series was such that the mark would be associated with ECL.

I. IV. The mark used should be able to cause confusion in the minds of public

¶ (28) In the case *Parle Products (P) Ltd. v. J.P. and Co.*,⁴¹ it was held that it was enough to show that the overall impression of the mark in the minds of the general public would be taken into consideration and by not just a mere comparison of the dissimilarities. Here the general impression on the public was spoken about. The comic series of Earl Grey preceded the TV series and according to the facts of the case her version of BOROMIR's conquests was the "Bohemian Rhapsody" and the agreement with ECL was signed in the year 2014 itself whereas the TV series started the year 2015 before the official release of the comics by ECL. Keeping this in mind the similarity in the good or service may lead the public to believe that the TV series was related to comic series by Earl Grey which may later on affect the actual comic book release. In the case *M/s Biofarma v. Sanjay Medical Stores*⁴² the court laid down a number of factors for determining deceptive similarity, one of the factors were the class of purchasers who were likely to buy the good and their degree of intelligence and care they exercised in purchasing the commodity, if we take this the class of purchasers here were

³⁸ P. 3&4 para XI of Moot Problem

³⁹ P. 4&5 para XIV of Moot Problem

⁴⁰ [2011] 46 PTC 535 (Mad)

⁴¹ [1972] 1 SCC 618 (SC)

⁴² [1997] 17 PTC 355 (Del)

similar as the common ground of interest was the conquests of BOROMIR and hence it is likely to produce a more similar fan base. In a few cases: *Corn Products Refining Co. v Shangrila Food Products Ltd.*,⁴³ *Amritdhara Pharmacy Vs Satya Deo Gupta*,⁴⁴ *Anglo Dutch Paint, Colour and Varnish Works Pvt Ltd. V.India Training House*⁴⁵ it was seen that the court checked similarity not just by gauging the confusion created, but also by applying the Doctrine of Fading memory i.e. from the point of view of a man of average intelligence having imperfect recollection. Using this doctrine, it can be said that a man with average intelligence, although might be aware of the original sources of both the comic and TV series as being different, but might over the time, start associating both.

¶ (29) There are many cases where the court held that the defendants were in clearly liable for infringement of the trade mark and granted either permanent injunction or restrained the infringers from further use of the trade mark. Some of those cases are stated here:

1. *Dr. Reddy's Laboratories Limited vs Manu Kosuri And Another*,⁴⁶ the court granted permanent injunction from registering a domain name or operating any business on the internet and elsewhere under the domain name which is identical and similar to the plaintiff's trademark 'DR. REDDY'S'. And the defendants were also ordered to pay the cost of the suit to the plaintiff and other profits that they made as a result of using the challenged domain name.
2. In the case of *Horlicks Limited And Ors. vs Kartick Sadhukan*,⁴⁷ the court restrained the defendant from manufacturing and selling toffees or other related goods under the trademark HORLIKS or under any other name that is similar in expression to the plaintiff's trademark HORLICKS. Further the court barred reproduction, printing or publishing of any label which was a mere reproduction or imitation of the HORLICKS label, thereby protecting the latter's trademark to the label.
3. In the case of *Ellora Industries vs Banarsi Das Goela And Others*,⁴⁸ the Additional District Judge granted the relief of permanent injunction to the plaintiffs, thereby restraining the defendants from using the challenged trademark. When appealed in the Delhi High Court, the learned judge of the High Court dismissed the appeal and reaffirmed the decree for injunction passed by the lower court.

⁴³ [1960] AIR 142 (SC)

⁴⁴ [1963] AIR 449 (SC)

⁴⁵ [1977] AIR 41 (Del)

⁴⁶ [2001] 58 DRJ 241 (Del)

⁴⁷ [2002] 25 PTC 126 (Del)

⁴⁸ [1980] AIR 254 (Del)

4. In *Jolen Inc. v. Doctor & Company*⁴⁹, he held that the act of the defendant in copying the trademark and the contents of the plaintiff's carton was deliberate and done in order to make profits using the good will of the latter. A permanent injunction was granted in favour of the plaintiff, thereby restraining the defendant from selling his products under the trademark 'JOLEN'.
5. In *Playboy Enterprises v. Bharat Malik & Another*⁵⁰, the judge granted a permanent injunction in favour of the plaintiffs and restricted the defendants from printing and publishing their magazines under the name PLAYBOY or any other name similar to that of the plaintiff.

¶ (30) From the cases cited above and taking into account the clear violation of **Sec 29(a), 29(2)(c), 29(3), 29(4)(c), 29(5) and 29(6)(d)** it is evident beyond doubt that the BSL had blatantly infringed the trade mark of the ECL on 'BOROMIR' by not only releasing the spin-off series with the title '*Boromir the Conqueror*', but also by using him as the protagonist and basing the entire show on the character 'Boromir'.

V. THERE HAS BEEN A DILUTION OF THE TRADE MARK.

¶ (31) In the case *Ashok Leyland Limited v. Blue Hills Logistics Pvt. Ltd.*,⁵¹ it was held that dilution is a type of violation which may not cause the likelihood of confusion, blurs the distinctiveness or tarnishes the image of the plaintiff's mark. In the case *Caterpillar Inc. v. Mehtab Ahmed and others*⁵² it was held that the general presumption underlying the doctrine of dilution is that the customers start associating the mark with the good and a use of the trade mark other than the registered used will dilute this link between the mark and the good. As given in the facts of the case, Boromir as a central character was featured in the comic series of Earl Grey and the word had attained a distinctiveness due to such a portrayal and the general association of the mark would be with the comic series as the comic series first featured Boromir and his Conquests and the TV series was only subsequent to this. It is also given in the facts that the online comic series was a huge hit and the subsequent release by

⁴⁹[2002] 25 PTC 29 (Del)

⁵⁰[2001] 21 PTC 328 (Del)

⁵¹[2011] 46 PTC 535 (Mad)

⁵²[2002] 25 PTC 438 (Del)

ECL has also gained a global response⁵³. In such a case the general association of the mark with the good or service will be diluted if BSL is allowed to use the Trade Mark.

VI. THE DEFENDANTS ARE ENTITLED TO PREVENTIVE RELIEF

¶ (32) The courts in India have long recognized the need for the preventive relief to protect rights and property. As laid down in Section 38 (3) (b) (c) (d) of the Specific Relief Act, 1963 and in *Raman Hosiery Factory v. J.K. Synthetics Ltd.*⁵⁴ and *Gramophone Company of India Ltd. v. Shanti Films Corporation*,⁵⁵ a perpetual injunction can be granted-

1. To prevent the breach of an obligation existing in favour of the defendant, whether express or by implication, or when the defendant invades or threatens to invade the plaintiffs' rights to, or the enjoyment of property, inter alia, where invasion is such that compensation in money would not afford adequate relief; or
2. Where there exists no standard for ascertaining the actual damage caused or likely to be caused by the invasion; or
3. Where the injunction is necessary to prevent multiplicity of judicial proceedings.

¶ (33) As held in *R.M.Subbiah v. Shankaran Nair*⁵⁶, *Performing Rights Society Ltd. v. Indian Morning Post Restaurant*⁵⁷, *The Himalayan Drug Company v. Sumit*⁵⁸, *Music Broadcast Pvt. Ltd. v. Phonographic Performance Ltd.*,⁵⁹ the plaintiffs are entitled to a relief of perpetual injunction.

¶ (34) From the facts of the case at hand, it is seen that the plaintiffs have infringed the copyrights of the defendants, an intangible right whose valuation is not necessarily possible. Moreover, every other work of the plaintiff in the future with respect to Boromir shall be an infringing work and the defendants would be forced to initiate multiple judicial proceeding to recover damages from each sale if an injunction is not granted. Therefore, the defendants are entitled to a preventive relief.

⁵³ P. 4&5 para XIV of Moot Problem

⁵⁴ [1974] AIR Del 207 (Del)

⁵⁵ [1997] AIR Cal 63 (Cal)

⁵⁶ [1979] AIR Mad 56 (Mad)

⁵⁷ [1939] AIR Bom 347 (Bom)

⁵⁸ [2006] 126 DLT 23

⁵⁹ [2004] 29 PTC 282 (Bom)

VII. THE DEFENDANTS ARE ENTITLED TO DAMAGES

¶ (35) In addition to the preventive relief, the plaintiffs are entitled to receive damages under Section 40 of the Specific relief Act and Section 135 of Copyright Act, as held in held in *M/S. Hindustan Pencils Pvt. Ltd. vs M/S. India Stationery Products*⁶⁰, *Bajaj Auto Ltd. v. TVS Motor Company.*⁶¹, *R.K.Malik & Anr v. Kiran Pal & Ors*⁶².

Since, the work of the plaintiffs violated the trade mark rights of the defendant; all the profits obtained from the TV Show should be awarded as damages along with a pecuniary damage of Rs. 1, 00, 00,000.

⁶⁰ [1990] AIR Del 19 (Del)

⁶¹ [2008] ILLJ 726 (Mad)

⁶² [2009] 3 TAC 1 (SC)

PRAYER

In light of the issues raised, arguments advanced and authorities cited, respondents most humbly request this Honourable High Court to adjudge and declare that:

1. That the Defendants have not misappropriated the character Boromir.
2. That the acts of Plaintiffs constitutes to Infringement of the trademark on the word Boromir according to Section 29(4) and Section 29(8) of the Trade Marks Act 1999 and therefore pass an injunction on the further use of the Trade Mark of the Defendants.

And pass any other order it may deem fit in the interest of justice, equity and good conscience.

COUNSELS FOR THE DEFENDANTS