

**IN THE HIGH COURT OF DELHI AT NEW DELHI.**  
(ORDINARY ORIGINAL CIVIL JURISDICTION)

C.S. (OS) No. \_\_\_\_/2007.

*Association of Past Producers*

... Plaintiff.

v.

*Producer A*

... Defendant.

**CLUBBED WITH**

**BEFORE THE REGISTRAR OF PATENTS PATENT OFFICE, NEW DELHI**

Notice of Opposition to the Application for Registration of Patent  
[Section 25 of the Indian Patent Act, 1970.]

In the matter of patent application no. \_\_\_\_ for the registration of the  
patent in the name of **Producer A.**

**AND**

In the matter of opposition thereto filed by the **Association of Past Producers.**

WRITTEN SUBMISSION ON BEHALF OF THE PLAINTIFF/ OPPONENT,

COUNSELS FOR THE PLAINTIFF/OPPONENT.

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#### **STATUTES**

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2. [The] Patents Act, 1977.
3. [The] Trade Marks Act, 1999.
4. 35 U.S.C.A. § 101 (The United States Patent Act).

## STATEMENT OF JURISDICTION

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The Opponent has approached this Hon'ble Patents Office under Section 25 of the Indian Patents Act, 1970. The Applicant humbly submits to the same.

The Plaintiff has approached this Hon'ble Court under Section 134(2) the Trademarks Act, 1999, Section 62(2) of the Copyrights Act, 1950 and Section 20 of the Code of Civil Procedure, 1908. The Defendant humbly submits to the same.

## STATEMENT OF FACTS

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**BACKGROUND:** Producer A, the defendant, had engaged a team of researchers, to examine the possible parameters contributing to the success of fifty pre-determined blockbusters. The movies had been selected by the Producer from a collection of several hundred blockbusters. The parameters to be studied included movie theme, music, lyrics, dialogues, lead and supporting actors, characters, technical finesse etc.

1. In the process of identifying the concerned parameters, the research team acquired and analyzed data such as interviews of producers and directors, study of newspaper articles, prior and post release notes and a poll of movie lovers across generations. Consequently, the team created a list of 'success factors'.
2. The success factors relevant to modern day film making were regrouped and evolved in the form of a 'success formula'. The Producer has filed a patent application for the success formula, calling it the 'bollywood lingo'.
3. Subsequently, based on the 'success formula', the producer developed a protocol having dynamic database alongwith pre-defined steps to reach the 'success formula' so as to predict the success rate of any movie. Producer A claimed that the protocol could predict a movie's success with reasonable certainty.
4. Producer A then approached a selection of past successful playback singers and lyricists and asked them to compose and sing songs for his movie, taking inspiration from the past hit songs, lyrics and themes of successful movies. At the same time, he instructed them to adapt the lyrics and songs according to the new movie's requirements, using modern instruments and special effects.
5. The title of Producer A's movie was the amalgamation of titles of three past superhit movies. He has applied for a trademark for the same.
6. Also, Producer A selected the best actors from the past and cast them together for the first time in his movie. The screen names of these actor's were same as those of the characters in the past fifty blockbusters. While promoting the movie, the actors constantly referred to the characters of the past. The dialogues of the movie also appeared to be similar to the dialogues of the past hit movies, though they were found to emanate from an effective use of thesaurus.
7. This new movie based on the 'success formula' was an instant hit. The audience was struck by nostalgia watching the movie, being reminded of the past hit movies.
8. An association of past producers, comprising the producers of the past hit movies filed a suit against Producer A seeking injunction and damages for infringement of trademark rights on the movie titles and copyright over the essential theme of the movie and arrangement of characters. They have also challenged the patent for the 'success formula' on the grounds of obviousness *inter alia*.
9. Producer A has filed a counter claim against the producers' association for defamation, claiming damages for the negative publicity and the dip in box-office collections of his movie.

## ISSUES RAISED

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1. WHETHER THE SUCCESS FORMULA IS PATENTABLE?
2. WHETHER DEFENDANT HAS INFRINGED THE COPYRIGHT OVER THE CINEMATOGRAPH FILMS?
3. WHETHER DEFENDANT HAS INFRINGED THE UNDERLYING COPYRIGHTS IN THE FILMS?
4. WHETHER THE TITLE OF MOVIES AND SCREEN NAMES OF ACTORS ARE ENTITLED TO TRADEMARK PROTECTION?
5. WHETHER THE DEFENDANT HAS INFRINGED THE TRADE MARKS OF THE PLAINTIFFS?
6. WHETHER THE PLAINTIFF IS LIABLE FOR THE TORT OF DEFAMATION?

## SUMMARY OF ARGUMENTS

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### **1. WHETHER THE SUCCESS FORMULA IS PATENTABLE?**

#### **A. THE SUCCESS FORMULA FALLS WITHIN THE EXCLUSIONS PRESENT IN SECTION 3 OF THE ACT?**

It is humbly submitted that the claimed process falls within the exceptions of business methods and algorithms. *Arguendo*, a business method and algorithms can be granted a patent, if process involves a technical contribution and satisfies the other criteria for patentability. In the instant case, the claimed process does not involve any technical contribution for the purposes of algorithms and business method, hence, it is unpatentable.

#### **B. THE SUCCESS FORMULA IS NOT NOVEL.**

Sections 2(1)(j) and 25 (1)(d) of the Patents Act, 1970 require that an invention, to be granted a patent, must be novel. Anticipation may be by public knowledge, use or publication. In the instant case the claim process is one, which has been known and used for ages by ordinarily skilled producers to determine the probability of success of their movies. Defendant has merely reduced this publicly known method to a material form. Hence, the claimed process is anticipated by prior art and is therefore not novel.

#### **C. THE SUCCESS FORMULA DOES NOT SATISFY THE REQUIREMENT OF INVENTIVE STEP.**

Sections 2(1)(j) and 25(1)(e) of the Indian Patent Act, 1970 render a process unpatentable if having regard to the prior art references, the claimed invention *obviously* and *clearly* lacks an *inventive step*. In the instant case, the claimed process does not satisfy the criteria of technical advance. Nor does it satisfy the test of non obviousness. Hence, the claimed process *clearly* and *obviously* does not involve an inventive step and is entitled to a patent.

### **2. WHETHER DEFENDANT HAS INFRINGED THE COPYRIGHT OVER THE CINEMATOGRAPH FILMS?**

The copyright in a cinematograph film is deemed to be infringed when a whole or a substantial part of the film has been copied. In the instant case, the essential or substantial elements of the films were copied. *First*, the dialogues in the infringing film are almost identical to those in the past films. *Second*, the characters of the past movies have been copied. *Third*, the songs of the movies have also been copied. In fact, the lyrics and performances are identical; only the music has been cosmetically altered. Hence, since these elements have been copied, and these are substantial parts of the movies concerned, the copyright of the past producers over their cinematograph films have been infringed.

### **3. WHETHER DEFENDANT HAS INFRINGED THE UNDERLYING COPYRIGHTS IN THE FILMS?**

It is submitted that the literary, musical and dramatic copyrights in the past films, owned by the association of past producers have been infringed. The standard practice in the film industry is to commission out the making of the underlying works. Even if underlying works aren't commissioned out, in standard practice in the industry is that the producers of the films will enter into irrevocable exclusive licenses with the authors of these works. Hence, either ways, the producers will be the owners/assignees/exclusive licensees of the underlying works. The plaintiff therefore has locus standi to file the instant suit.

In the instant case, the copyright over the underlying literary, musical and dramatic works in the lyrics of the songs, the titles of the films and the music in the songs have been infringed. The various underlying dramatic elements in the films, which are entitled to protection as dramatic works by themselves, such as the characters, songs and dialogues have also been substantially copied. *Lastly*, the underlying audio-visual work in the film, which is entitled to be protected as a dramatic work has been substantially infringed.

### **4. WHETHER THE TITLE AND SCREEN NAMES ARE ENTITLED TO TRADEMARK PROTECTION?**

The title of a single literary work can be trade-marked as long as a secondary meaning to the said title is proved. The same is applicable to screen names, as long as they satisfy the requirements of a trade-mark i.e. the ability to be depicted graphically and to distinguish one good or service from another. The latter is depicted by the acquisition of a secondary meaning.

### **5. WHETHER THE DEFENDANT HAS INFRINGED THE TRADE MARKS OF THE PLAINTIFF?**

In order to infringe another trade mark, the infringing mark should be deceptively similar to the trade mark, with respect to the goods and services identified by the latter. Further, if the infringing mark is similar to the trade mark and is used to identify goods similar or identical to those identified by the trade mark, causing confusion as to the origin of the goods or services, infringement is said to occur. In this case, the plaintiff's movie titles and screen names have acquired secondary meaning and are easily recognized by the masses. Hence any use of these titles, independently or in combination with other titles would lead to confusion as to the origin of the defendant's movie. The defendant has also tried to pass off the title of his movie as that of the plaintiff. The plaintiff is entitled to injunction and damages, general and punitive against the defendant for infringement of its copyrights and trade mark rights as well as for passing off.

### **6. WHETHER THE PLAINTIFF IS LIABLE FOR THE TORT OF DEFAMATION?**

In the instant case, the plaintiff has not made any defamatory statement as their statements are honest and true. Further, any pleading and evidence in a suit are protected by absolute privilege, and law-suits can not be barred owing to the nature of the statements. Malicious prosecution can not be resorted unless the suit is decided in favour of the defendant. In any case, the defendant has not suffered any actual damages and is hence not entitled to the same.



## ARGUMENTS ADVANCED

### **1. WHETHER THE SUCCESS FORMULA IS PATENTABLE?**

#### **A. THE SUCCESS FORMULA FALLS WITHIN THE EXCLUSIONS PRESENT IN S. 3 OF THE ACT**

It is submitted that the success formula developed by the defendant is not an invention for the purposes of the Patents Act, 1970. S. 2(1)(j) of the Act defines invention as a new product or process involving an inventive step and capable of industrial application.<sup>1</sup> S. 3 of the Act however, makes some exclusions from the category of inventions. It is submitted that the present invention falls within the business methods **(A)** and algorithm **(B)** exclusions.

#### **(I). WHETHER THE SUCCESS FORMULA IS A BUSINESS METHOD**

S. 3(k) of the Patents Act, 1970, excludes business methods from the ambit of inventions. A business method is a method for performing either data processing or calculation operations, using an apparatus or method that is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.<sup>2</sup> Methods of bookkeeping, tax collection et al. are instances of business methods as per the draft manual released by the Indian Patent Office.<sup>3</sup> The claimed process is a business method which can't be granted a patent under any circumstance **(i)**, *Arguendo*, the claimed process is a business method *per se* and is therefore unpatentable **(ii)**.

#### **(i) A business method cannot be granted a patent under any circumstance.**

Under S. 3(k) of the Patents Act, 1970, a business method is, without any qualification, excluded from the ambit of an invention. S. 3(k) of the Patents (Amendment) Ordinance, 2004, which was a precursor to the amendments to the Act, clearly provided that business methods were not patentable under any circumstance.<sup>4</sup>

It is submitted that the primary business of a producer in the movie industry is to calculate the probability of success of a movie before investing in it. The success formula merely simplifies this process. The formula is therefore nothing more than a management tool which can be used successfully for data processing and subsequent calculation operations. Thus, the process is a business method, and as such is unpatentable.

#### **(ii) Arguendo, a business method per se is unpatentable.**

*Arguendo*, a business method can be granted a patent only when the method is part of a process involving a technical contribution and it satisfies the other criteria for patentability.<sup>5</sup> The term *technical* generally refers to mechanical or industrial applications in any industry.<sup>6</sup> Technical contribution implies some technical advance on the prior art in the form of a new result.<sup>7</sup> Only those business methods which involve a sufficiently high degree of technical advance, such as operating a user interface,<sup>8</sup> or coordinating and controlling internal data,<sup>9</sup> have been granted patents.

In the instant case, the process merely articulates a set of calculations which have been used by producers for several years to determine the probability of success of their movies. Since the contribution lacks a technical character, it does not constitute an invention, and hence is not patentable.

#### **(II). WHETHER THE SUCCESS FORMULA IS AN ALGORITHM**

S. 3(k) of the Patents Act, 1970, excludes algorithms from the ambit of inventions. An algorithm is a mathematical formula, mathematical equation, or the like.<sup>10</sup> The claimed process is an algorithm and cannot be granted a patent **(i)**, *Arguendo*, the claimed process does not produce a useful, concrete and tangible result and is unpatentable **(ii)**.

#### **(i) An algorithm cannot be granted a patent**

Under S. 3(k) of the Patents Act, 1970, algorithms and processes containing algorithms are not inventions.<sup>11</sup> The proposed S. 3(k) in the Patents (Amendment) Ordinance, 2004 and the Patents (Amendment) Act, 2005, which were precursors to the amendments to the Act, provided that algorithms were not patentable under any circumstance.<sup>12</sup>

In the instant case, the claimed process is merely a set of mathematical calculations, or a mathematical equation, which uses external inputs to help the producer in calculating the probability of success of a

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<sup>2</sup> Class 705 of the U.S. Patent Classification System - Classification Definitions, available at <<http://www.uspto.gov/web/offices/ac/ido/oeip/taf/def/705.htm>> (visited on 15.07.07).

<sup>3</sup> Manual of Patent Practice and Procedure: Patent Office, India, available at <<http://ipindia.nic.in/ipr/patent/manual-2052005.pdf>> (visited on 10.07.07).

<sup>4</sup> M. Pillai et al., "Patent Procurement in India" available at <<http://www.ipoef.org/AM/Template.cfm?Section=Programs&Template=/CM/ContentDisplay.cfm&ContentID=15238>> (visited on 12.07.07).

<sup>5</sup> *Fujitsu Limited's Application*, [1996] R.P.C. 511; *VICOM/Computer related Inventions*, [1987] 2 E.P.O.R. 74.

<sup>6</sup> *The Oxford Thesaurus* (L. Urdang ed., Oxford: Clarendon Press, 1992) at 496.

<sup>7</sup> *VICOM/Computer related Inventions*, [1987] 2 E.P.O.R. 74.

<sup>8</sup> *Texas Instruments/Language understanding System*, [2000] E.P.O.R. 156

<sup>9</sup> *IBM/Data Processor Network*, [1990] E.P.O.R. 91.

<sup>10</sup> D.S. Chisum, *Chisum on Patents: Volume I* (New York: LexisNexus, 2000) at GI-1.

<sup>11</sup> *Parker v. Flook*, 437 U.S. 584 (1978, SC); *Gottschalk v. Benson*, 409 U.S. 63 (1972, SC).

<sup>12</sup> *Supra* note 4.

movie. The process is clearly an algorithm. Therefore, it is not an invention capable of being granted patent protection.

**(ii) *Arquendo*, an algorithm per se is unpatentable**

An algorithm can be granted a patent only when it is either a part of a process involving technical contribution, or it produces a useful, tangible and concrete result.<sup>13</sup> The term *technical* generally refers to mechanical or industrial applications.<sup>14</sup> Technical contribution is some technical advance on the prior art in the form of a new result.<sup>15</sup> Further, execution of a mathematical formula with given data, or a mental process that can be represented by a mathematical algorithm does not satisfy the test of producing a 'useful, tangible and concrete result'.<sup>16</sup>

In the instant case, the process only articulates a set of calculations which were anyway being used by producers earlier in determining the probability of success of their movies. Such contribution lacks technical character. The formula uses external inputs to calculate a result which was hitherto a mental process. The claimed process therefore does not produce a sufficiently useful, tangible and concrete result, so as to get patent protection.

**B. WHETHER THE SUCCESS FORMULA IS NOVEL?**

Ss. 2(1)(j) and 25 (1)(d) of the Patents Act, 1970 require an invention to be novel or not anticipated in light of the existing state of art,<sup>17</sup> that is, all matter *publicly known* or *used* in India before the priority date of the claim, and all matter *published* in India or elsewhere.<sup>18</sup> Further, the claim should not be the inevitable result of examination of a prior art reference by a person ordinarily skilled in the art.<sup>19</sup> A process is *publicly known* when it *forms a part of common knowledge* among the *public*, although not found in any book.<sup>20</sup> The term *public* is inclusive of persons who are engaged in the concerned field of invention<sup>21</sup>.

In the instant case the process has been known and used for ages by ordinarily skilled producers to determine the probability of success of their movies. The defendant has merely reduced this publicly known method to a material form. Hence, the claimed process is anticipated by prior art and is therefore not novel.

**C. WHETHER THE SUCCESS FORMULA SATISFIES THE REQUIREMENT OF INVENTIVE STEP**

The success formula does not satisfy the requirement of inventive step. Under Ss. 2(1)(j) and 25(1)(e) of the Patent Act, 1970 a process is unpatentable if having regard to the prior art references, it *obviously* and *clearly* lacks an *inventive step*. S. 2(1)(j) defines *inventive step* as a feature of an invention that involves a technical advance as compared to the existing knowledge or one that has economic significance and is also not obvious to a person skilled in the art. Mere economic significance without technical contribution has been considered insufficient for grant of a patent.<sup>22</sup> As submitted above, the process clearly does not contribute to the technical advance of existing knowledge.

To determine non obviousness one has to examine the scope and content of the prior art, the differences between the prior art and the claims at issue and the level of ordinary skill in the concerned art, and consider whether such differences constitute an inventive step.<sup>23</sup> Considerations such as commercial success, long felt but unsolved needs, failure of others, etc are ancillary to the primary test of obviousness.<sup>24</sup> It is pertinent to note that, while referring to prior art in order to determine obviousness, moseiacing of the same from analogous fields is permissible.<sup>25</sup>

In the instant case, the prior art consists of successful movies produced in the past. For ages, ordinarily skilled producers have been guided by the unarticulated factors that made those films successful. The contribution merely articulate these factors. Such articulation, given the existing prior art references would have been obvious to an ordinarily skilled producer. Hence, there is no inventive step in the claim process.

**D. WHETHER PRODUCER A HAS INFRINGED THE COPYRIGHT OVER THE CINEMATOGRAPH FILMS?**

The defendant has infringed the copyright in the films as the essential themes and arrangement of characters of the past movies have been copied. S.14(1)(d) read with S. 2(d)(v) and S. 17 of the Copyright Act, 1957, states that the producer of a cinematograph film has the exclusive right to make a copy of the whole or substantial part of the film.<sup>26</sup> A copyright over a cinematograph film is deemed to be infringed when there is a literal/physical copying of the copyrighted work, or when there is substantial similarity between the infringing and the infringed works.<sup>27</sup> Substantial similarity involves two elements: *one*, that

<sup>13</sup> *State Street Bank v. Signature Financial Group*, 149 F.3d 1368.

<sup>14</sup> *Supra* note 6.

<sup>15</sup> *Supra* note 7.

<sup>16</sup> *Id.*

<sup>17</sup> *Supra* note 1.

<sup>18</sup> Sections 25 (b), (c) and (d) of the Indian Patents Act, 1970.

<sup>19</sup> *Bishwanath Prasad v. H. M. Industries*, A.I.R. 1982 S.C. 1444; *Merrell Dow Pharmaceuticals Inc. v. H.N. Norton & Ltd.*, [1996] R.P.C. 76. *SmithKline Beecham Plc's v. Apotex Europe Ltd.*, [2003] R.P.C. 6.

<sup>20</sup> P. Narayanan, *Patent Law* (4<sup>th</sup> edn., Kolkata: Eastern Law House, 2006) at 379.

<sup>21</sup> *Mosanto v. Coromondal*, A.I.R. 1986 S.C. 712.

<sup>22</sup> S. Basheer, "India's Tryst with TRIPS: The Patents (Amendment) Act, 2005" in Vol. 1 *IJLT* 22-23, 15 – 45 (2005).

<sup>23</sup> *Windsurfing International v. Tabur Marine*, [1985] R.P.C. 59.

<sup>24</sup> *Graham v. John Deere*, 383 U.S. 1; *KSR International Co., v. Teleflex Inc.*, 127 S.Ct. 1727.

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

<sup>26</sup> *Pepsi Co., Inc. v. Hindustan Coca Cola Ltd.*, 2003 (27) P.T.C. 305 (Del).

<sup>27</sup> *Francis Day & Hunter Ltd v. Bron*, [1963] 2 All E.R. 16; *Associated Industries Pvt. Ltd. v. M/s. Sharp Tools, Kalapatti*, A.I.R. 1991 Kant. 406.

objectively, there is a high degree of similarity between the two works, and *two*, that the similarities are substantial with respect to the infringed work.<sup>28</sup> Substantiality has to be determined qualitatively, not quantitatively.<sup>29</sup> A substantial use of the skill and labour involved in creating the original work amounts to a substantial reproduction of the material.<sup>30</sup> Hence, the part that is copied needs to be original; but needn't be copyrightable.<sup>31</sup> The test adopted here is the 'lay observer' test - if the ordinary man perceives the copying, then the part lifted can be said to form the crux of the original work.<sup>32</sup> In either case, causal connection between the two works will have to be established.<sup>33</sup> The causal link is presumed when substantial similarity is established.<sup>34</sup>

In the instant case, there has been substantial copying of the essential elements of the past films. *First*, the *dialogues* in the defendant's film are almost identical to those in the past films. Only cosmetic changes had been made to the dialogues through the use of a thesaurus.<sup>35</sup> *Second*, actors from the past movies were brought to play the same *characters* from the past movies. This can be inferred from the following facts-(a) the screen-names given to the characters were the same.<sup>36</sup> (b) the actors advertise with reference to the past characters. Characters constitute an essential element of a film and a literal copying, as in this case, violates the film's copyright. *Third*, the songs in the films have been copied as (a) the lyrics were identical, (b) the music was only cosmetically rearranged through the use of modern day instruments and special effects and (c) the singers were the same as those who sung the original songs.

The above instances of copying were substantial in nature. Given the fact that the infringing elements are the success factors based on which these films went on to become hits, it can safely be concluded that they are the essential elements or substantial parts of the underlying films. When the infringing movie was shown to the public, "nostalgic memories of the past [were] raised", thereby evidencing the substantiality of the copying. Furthermore, in the context of films, elements such as dialogue, character, etc are the expression of the idea or plot of the film<sup>37</sup> and as such, are substantial elements of any film. Hence, the defendant has infringed the copyright over the Cinematograph films.

## **2. WHETHER PRODUCER A HAS INFRINGED THE UNDERLYING COPYRIGHTS IN THE FILMS?**

It is submitted that the literary, musical and dramatic copyrights in the past films, owned by the association of past producers **(A)** have been infringed **(B)**.

### **A. THE PRODUCERS OWN THE LITERARY, DRAMATIC AND MUSICAL COPYRIGHTS IN THE PAST FILMS.**

#### **(I) The producers are the first owners of the Copyright.**

Films incorporate a wide range of individual creative contributions,<sup>38</sup> distinct from the final product. S.13(4) of the Copyright Act says that the copyright in the cinematograph film does not affect such further copyrights as there may be in the individual creative contributions embedded in the finished production.<sup>39</sup> S.17 provides that the author of a work shall be the owner of the copyright over it except when, *one*, the work is made by an employee in the course of his employment, and *two*, when a particular work is commissioned, the person who commissions the making of such work shall be the owner of the copyright over that work. In *Indian Performing Right Society Ltd. v. Eastern Indian Motion Pictures Association*<sup>40</sup>, it was held that even when the making of a *part* of the film is commissioned out, then the copyright over that part vests in the person who commissions such work i.e. the producer. In the film industry, it is standard practice to commission out the making of the underlying works.<sup>41</sup> This is especially true in the context of Bollywood where even the songs to be embedded in the film are commissioned to suit the specificities of a particular film.<sup>42</sup> In the absence of any facts to the contrary, it is presumed that this standard industry practice was followed which makes the producers the owners of the underlying copyrights.

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<sup>28</sup> *R.G. Anand v. Delux Films*, A.I.R. 1978 S.C. 1613, *Inglis v. Mayson*, (1983) 3 I.P.R. 588, at 605 (NZ).

<sup>29</sup> *Ladbroke v. William Hill*, [1964] 1 W.L.R. 273; *Nichols v. Universal Pictures*, 45 F.2d 119 (1930); *R.G. Anand v. Delux Films*, A.I.R. 1978 S.C. 1613.

<sup>30</sup> *Barbara Taylor Bradford v. Sahara Media Entertainment Limited*, 2004 (28) P.T.C. 474.

<sup>31</sup> *Id.*

<sup>32</sup> *R.G. Anand v. Delux Films*, A.I.R. 1978 S.C. 1613; *Super Cassettes Industries Ltd v. Chanda Cassettes Pvt Ltd*, 2006 (33) P.T.C. 398; *Daily Calendar Supplying Bureau, Sivakasi v. The United Concern*, MANU/TN/0256/1967.

<sup>33</sup> *R.G. Anand v. Delux Films*, A.I.R. 1978 S.C. 1613; *Associated Electronic & Electrical Industries (Bangalore) Pvt. Ltd. v. M/s. Sharp Tools, Kalapatti*, A.I.R. 1991 Kant. 406.

<sup>34</sup> *Barbara Taylor Bradford v. Sahara Media Entertainment Limited*, 2004 (28) P.T.C. 474.

<sup>35</sup> *R.G. Anand v. Delux Films*, A.I.R. 1978 S.C. 1613; *Pepsi Co., Inc. v. Hindustan Coca Cola Ltd.*, 2003 (27) P.T.C. 305.

<sup>36</sup> *Gordon v. Warner Bros*, 74 Cal. Rptr. 499 (1969); *Walt Disney v. Air Pirates*, 345 F.Supp 108 (1972).

<sup>37</sup> *Supra* note 35.

<sup>38</sup> This includes the script, acting, directing, camera work, sound recording, lighting, music, scenery, lyrics of the songs, and so forth.

<sup>39</sup> *Indian Performing Right Society Ltd. v. Eastern Indian Motion Pictures Association*, A.I.R. 1977 S.C. 1443.

<sup>40</sup> A.I.R. 1977 S.C. 1443. The Court relied on *Wallerstein v. Herbert*, (1867) 16 L.T. 453, to support their stance.

<sup>41</sup> Flint, Fitzpatrick and Thorne, *A User's Guide to Copyright* (6<sup>th</sup> edn., West Sussex: Tottel Publishing, 2006) at 393-394; W.Overbeck, *Major Principles of Media Law* (Belmont: Wadsworth Thompson, 2004) at 234-235; S. Burr et al., *Entertainment Law: Cases and Materials on Film, Television and Music* (St. Paul: Thompson West, 2004) at 2-3, 48-49; M.B. Nimmer et al., *Nimmer on Copyright Vol 5* (New York: Lexis Publishing, 2000) at 23-88 and 23-242.

<sup>42</sup> In Hollywood, the soundtrack of a movie usually consists of pre-existing songs to which the producers of the movies acquire non-exclusive licenses. *Id.* In Bollywood, on the other hand, a movie's selling point is often its songs and as such, most producers commission lyricists and composers to create new songs to be exclusively used in the movie.

**(II) Arguendo, the producers are the assignees of these copyrights.**

Even if the underlying works have been created independently of the movie and the producer wishes to incorporate them in his film, the customary practice is for the producer to take an irrevocable assignment of the underlying works used in the film.<sup>43</sup> This will be done either through an outright assignment (with a one-time final payment) or through an option-purchase agreement (where the producer takes an exclusive option to acquire the necessary rights from the owner within a specified period against the payment of a fee).<sup>44</sup> Given this standard practice, in the absence of any facts to the contrary, it is presumed that the producers are the assignees or exclusive licensees of the underlying rights, and the burden is on the defence to prove otherwise.

**B. These copyrights have been infringed by the defendant.**

S.14(1)(a) read with S.51(a)(i) of the Copyright Act, 1957, states that a copyright over a literary, dramatic or musical work is deemed to be infringed either when there is a literal copying of the copyrighted work or when the infringing work is substantially similar to the original work. In the instant case, there has been infringement of the copyright over the lyrics **(I)**, the musical work **(II)** the dramatic elements of the film **(III)** and the title of the film **(IV)**.

**(I) Literal infringement of the copyright over the lyrics of the songs.**

The lyrics of a song are entitled to copyright protection as they are literary works.<sup>45</sup> In the instant case, lyrics of the past songs have been copied verbatim. The fact-sheet clearly states that Producer A asked the lyricists to be inspired by the past songs and adapt them solely by the use of modern day instruments and special effects. Since he specifically asked for the music to be adapted to the exclusion of the lyrics, it follows that the lyrics of the present movie's songs were identical to those of the past songs.

**(II) Infringement of the copyright over the musical work.**

The musical work in songs is protected under the Copyright Act. In the instant case, the musical work, which is a part of the songs, was *adapted* on the express instructions of the defendant by the use of modern day instruments and special effects. Adaptation refers to the arrangement or transcription of a musical work. Arrangement covers situations where different instrumentation is used to play the musical work.<sup>46</sup> S.14(1)(a)(vi) provides that adaptation is an exclusive right of the copyright holder. Hence this copyright over the musical work has been infringed.

S.52(1)(j) provides for certain circumstances where a sound recording may be made of a literary dramatic or musical work. Such a recording is known in the music business as a version recording and *inter-alia* involves the singing of a well-known song by a lesser known singer, keeping intact the underlying musical and literary (lyrics) work.<sup>47</sup> In the instant case, the same playback singers who sang the original songs were used but the music was rearranged and special effects used. Hence the exception under S.52(1)(j) is inapplicable.

**(III) The underlying dramatic elements in the films have been infringed.**

**(i) There has been a copying of the dramatic expressions in the films.**

Although an idea is *per se* not entitled to copyright protection, an idea developed into a concept fledged with adequate details is capable of protection under the Copyright Act.<sup>48</sup> Songs and dialogues are also dramatic works entitled to protection. Characters are capable of being protected as dramatic works by themselves if the characters are so well-defined that they possess features that give them a degree of specificity that marks the character as one delineated so as to constitute more than an idea or stock character.<sup>49</sup>

In the instant case, as suggested above, the songs and the dialogues have been copied. Since the characters, which are ideas fledged with details, are success factors, it is reasonable to presume that they possess the characteristics requisite of a character to qualify as a dramatic work. Copying such characters thus infringes the dramatic copyright owned by the producers over the characters. Hence, the dramatic elements in the film have been infringed.

**(ii) There has been an infringement of the films' dramatic copyright.**

The film, as a whole, is capable of being copyrighted as a dramatic work. A dramatic work under S.2(h) of the Copyright Act excludes a cinematograph film from its ambit. The underlying audio-visual work in a cinematograph film, as distinct from its recording, can however be a dramatic work because: *First*, due to the narrow interpretation given to a cinematograph film under S.2(f) to mean any work of visual *recording* on any medium, the exclusion under S.2(h) does not cover the film as an audio-visual dramatic work separate from its recording. *Second*, the requirement under S.2(h) of a work needing to be fixed in writing

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<sup>43</sup> M.B.Nimmer on Copyright Vol 5 (New York: Lexis Publishing, 2000) at 23-88; Flint, Fitzpatrick and Thorne, *A User's Guide to Copyright* (6<sup>th</sup> edn., West Sussex: Tottel Publishing, 2006) at 393.

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

<sup>45</sup> *Sulamangalam R. Jayalakshmi v. Meta Musicals*, A.I.R. 2000 Mad. 454.

<sup>46</sup> *Wood v. Bossey*, (1868) LR 3 QB 223; *Redwood Music Ltd v. Chappell & Co Ltd*, (1982) R.P.C. 109.

<sup>47</sup> *Super Cassette Industries Limited v. Bathla Cassette Industries Private Limited*, 2003 (27) P.T.C. 280.

<sup>48</sup> *Anil Gupta and Anr. v. Kunal Das Gupta and Ors*, 2002 (25) P.T.C. 1; *Fateh Singh v. O.P. Singhal*, A.I.R. 1990 Raj. 8; *Zee Telefilms Ltd v. Sundial Communications Private Limited*, 2003 (27) P.T.C. 457.

<sup>49</sup> *Tyburn Productions Ltd v. Conan Doyle*, [1990] 1 All E.R. 909; *Lewys v. O'Neill*, 49 F. 2d 603; *Walt Disney v. Air Pirates*, 581 F. 2d 751 (9<sup>th</sup> Cir. 1978).

or otherwise is also satisfied as a film is fixed as a recording. *Third*, the Berne Convention, 1911, to which India is a party, under Article 2(1), requires the protection of the film as a dramatic work. One of the canons of statutory construction is that if there is ambiguity regarding the meaning of a statutory provision, it should be construed in the same sense as that of the convention if the words of the statute are reasonably capable of bearing that meaning.<sup>50</sup> Hence, the film, as a whole, and as distinguished from its recording, is a dramatic work under S.2(h).<sup>51</sup>

Applying the principle of infringement of a dramatic work as discussed above, it has already been established that the characters, songs and screen-play of Producer A's film bear a high degree of similarity to those in the past films; and that these elements are the substantial elements of the films. Hence, there has been an infringement.

#### **(IV) The title constitutes an infringement of copyright.**

As regards the title of movies, while they usually are not protected as literary works, exceptions may be made in cases where they are so elaborate that sufficient skill and labour must have been involved in its invention so that it may qualify as an original work.<sup>52</sup> Since the defendant made his movie based on the factors that made the past movies successful, it may be presumed that the three titles he combined were sufficiently original in order to merit a literary copyright. Hence, the infringing title constitutes a literal infringement of the separate copyrights over the three titles.

#### **6. WHETHER THE TITLE AND SCREEN NAMES CAN BE TRADE-MARKED?**

Titles of single literary works can be trade-marked if acquisition of secondary meaning is shown.<sup>53</sup> Secondary meaning is proved by factors like the length and continuity of use, the extent of advertising, promotion, sales figures et al.<sup>54</sup> A trade mark is a mark that can be depicted graphically. It is used to distinguish goods or services of one origin from another.<sup>55</sup> The screen names can be trade-marked if they have acquired distinctiveness or a secondary meaning, with respect to the characters.<sup>56</sup>

In the instant case, the screen names in the plaintiff's movies have gained wide recognition and popularity due to the success of the movies and their intensive advertising. The repetition of the screen names in another movie, and its promotion using the said screen names, would lead audience to associate the characters in the defendant's movie with those in the plaintiff's movie, thereby attributing the same origin to the defendant's movie. Therefore, titles of a single literary works and screen names can be trade marked.

#### **7. WHETHER THE DEFENDANT HAS INFRINGED THE TRADE MARKS OF THE PLAINTIFF.**

Under S. 29(1) of the Indian Trademarks Act, 1999, an infringement occurs when the infringing mark is deceptively similar to the trade mark and is used in the course of trade with respect to goods and services represented by the trade mark, in such a way as to be mistaken for the trade mark.<sup>57</sup> A deceptively similar mark is one which is 'likely to deceive' or create confusion. 'Likely to deceive' refers to the ability of a mark to ascribe an erroneous origin to the goods or services in question.<sup>58</sup>

Under S. 29(2)(b) use of marks similar to the trade-mark, to identify services similar or identical to the ones represented by the trade mark, thereby leading to confusion as to the origins of the services, amounts to an infringement.<sup>59</sup> The test for deception or confusion is that of an ordinary man with imperfect recollection, who mistakes the services to be that of the plaintiff.<sup>60</sup>

The defendant's title amalgamates the titles of the plaintiff's hit movies which have over the years enjoyed wide recognition, and have acquired a secondary meaning. Thus, whoever beholds the title will instinctively be reminded of the plaintiff's movies. The viewers shall be misled or deceived as to the producer of the movie, easily associating the title with the plaintiff's movies.

S. 27(2) permits passing-off actions simultaneously with actions for trade mark infringement, thereby recognizing the common law rights of unregistered trade-mark owner to initiate civil action.<sup>61</sup> The classic trinity of passing off action under common law comprises a) existence of a goodwill or reputation with respect to the services, including the get-up of the services, that are recognised by the public, b) misrepresentation as to the ownership of the services being offered, and c) ensuing damage suffered or likely to be suffered owing to misrepresentation.<sup>62</sup> Goodwill refers to existence of business or customer base

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<sup>50</sup> *Super Cassette Industries v. Entertainment Network*, 2004 (29) P.T.C. 8 (Del); *Kubic Dariusz v. Union of India*, A.I.R. 1990 S.C. 605, at 615; *The Jade*, [1976] 1 All E.R. 920, at 924.

<sup>51</sup> *Norowzian v. Arks Ltd*, [2000] F.S.R. 363.

<sup>52</sup> *Exxon Corporation v. Exxon Insurance Ltd*, [1982] Ch. 119; *Francis Day & Hunter Ltd v. Twentieth Century Fox Film Corp*, [1940] A.C. 112; *Weldon v. Dicks*, [1878] Ch. 247; *Pepsi Co. v. Hindustan Coca Cola Ltd.*, 2003 (27) P.T.C. 305.

<sup>53</sup> *International Film Service Co. v. Associated Producers Inc.*, 273 F. 585 (D.N.Y. 1921).

<sup>54</sup> *Cowles Magazines & Broadcasting, Inc. v. Elysium, Inc.*, 255 Cal. App. 2d 731.

<sup>55</sup> S. 2(1)(zb).

<sup>56</sup> R. Stone, 'Titles, Character Names and Catch-Phrases in the Film and Television Industry: Protection under the Trade Marks Act, 1994 and Alternative Registration Systems' in Vol. 8(2) *Ent.L.R.* 34-46 (1997).

<sup>57</sup> *Abbey Sports Co. v. Priest Bros.*, (1936) 53 RPC 300; *S.M. Dyechem v. Cadbury (India) Ltd.*, (2000) 5 SCC 573.

<sup>58</sup> *Jellinek's Application*, (1946) 63 R.P.C. 59.

<sup>59</sup> *Glaxo Group Ltd. v. Dowelhurst Ltd.*, F.S.R. (2000) 529.

<sup>60</sup> *Reed Executive PLC v. Reed Business Information Ltd.*, (2003) R.P.C. 12; *Torrent Pharmaceuticals Ltd. v. The Wellcome Foundation Ltd.*, (Guj.) 2001 (2) CTMR 158.

<sup>61</sup> *Law of Trade Marks & Geographical Indications* (K.C. Kailasan, R. Vedaraman et. all. eds., 2<sup>nd</sup> edn., Nagpur: Wadhwa & Co., 2005) at 337.

<sup>62</sup> *Reckitt & Colman Products Ltd. v. Borden Inc.*, [1990] R.P.C. 341.

for the plaintiff's services<sup>63</sup> and the benefit of the good name, reputation and connection of a business<sup>64</sup>. The test for misrepresentation is the same as that for deceptively similarity under trade mark infringement.<sup>65</sup> The trademark should have acquired a reputation or secondary meaning among a relevant class of persons such that it will result in confusion or deception as to the origin of the services.<sup>66</sup> 'Imitation of get-up' or general appearance also amounts to misrepresentation.<sup>67</sup>

The plaintiff's association comprises of well-known producers who enjoy considerable goodwill in the film industry and among the audiences. However, the defendant by amalgamating the titles of the plaintiff's superhit movies has given the impression that it is the plaintiff's movie, to attract a greater audience. Further, he has also copied the lyrics, music, dialogues, characters and the theme of the movies (imitation of get-up) which have copyright<sup>68</sup> and trademark protection<sup>69</sup>, to cash in on the popularity of the plaintiff's movies. In fact, most of the viewers succumbed to nostalgic memories on watching the defendant's movie. This misrepresentation has adversely affected the reputation of the plaintiff as ace-producer, its professional relationships with members of the industry and cinemagoers. Therefore, the defendant is guilty of passing off.

#### **8. WHETHER THE PLAINTIFF IS LIABLE FOR THE TORT OF DEFAMATION.**

In order to establish defamation a) a defamatory statement should be made and b) it should be published.<sup>70</sup> A defamatory statement is one which spoils or damages the reputation of a person, exposes him to contempt or ridicule or tends to injure him in his profession or trade, or causes him to be shunned or avoided by<sup>71</sup> an ordinary, reasonable man, having the intelligence, knowledge, education, experience and prejudices of the average man in the class of people to which the statement is published.<sup>72</sup> Truth is however a well recognized defence to defamation.<sup>73</sup> In the instant case, the plaintiff's statements were justified and not baseless.

Further, filing of a suit cannot be barred on the basis of the nature of allegations as that would violate the freedom to set law into motion. Also, a case for malicious prosecution is possible only if the suit is decided in the defendant's favour.<sup>74</sup> It balances the right to set law into motion with the necessity to check false accusations against the innocent. Defamation deals only with the latter.<sup>75</sup>

#### **10. WHETHER THE DEFENDANT IS ENTITLED TO DAMAGES FOR DEFAMATION.**

Injury to reputation is not a pecuniary loss and so no special damages can be awarded.<sup>76</sup> For general damages, general loss such as a decline in business<sup>77</sup>, needn't be pleaded. But for special damages, particular instances of loss must be pleaded.<sup>78</sup> The plaintiff is not liable for damages, general or special, as the statements made by it are true.

Any business loss suffered by the defendant was in the normal course of business, and not due to the law-suit. The plaintiff was entitled to file the same. Further, there has been no loss of specific nature, and so the defendant is not entitled to special damages. Hence, the defendant should not be granted any damages, general or special.

#### **9. WHETHER THE PLAINTIFF CAN CLAIM INJUNCTION AND DAMAGES AGAINST THE DEFENDANT.**

Injunction and damages may be granted for infringement of trademark and copyright, as well as for passing off.<sup>79</sup> Damages claimed should be equivalent to the profits lost by the plaintiff owing to diversion of his business and gains to the defendant.<sup>80</sup> Damages for loss of business reputation<sup>81</sup> and goodwill<sup>82</sup> are recoverable. Punitive damages are awarded in cases of flagrant infringement in order to deter infringers, especially where the infringements are malafide and dishonest.<sup>83</sup>

In the instant case, the plaintiff has established a case of copyright and trademark infringement. Hence it is entitled to an injunction against the defendant. Further, it has suffered loss of the profit it would have made had it assigned or granted license for the use of its trademarks and copyrights. The plaintiff is entitled to punitive damages since the act of the defendant was malafide and dishonest. Thus, the plaintiff is entitled to injunction and punitive damages.

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<sup>63</sup> *Anheuser-Busch Inc. v. Budejovicky Budvar Narodini Podnik*, [1984] F.S.R. 413 CA.

<sup>64</sup> *IRC v. Muller & Co.'s Margarine Ltd.*, [1907] AC 217.

<sup>65</sup> *Cadila Healthcare v. Cadila Pharma*, (2001) 5 SCC 73; *Saville Perfumery v. June Perfect Ltd.*, (1941) 58 R.P.C. 147.

<sup>66</sup> *Reckitt & Colman Products Ltd. v. Borden Inc.*, Suzy [1990] R.P.C. 341.

<sup>67</sup> *Kerly's Law of Trade Marks and Trade Names* (D. Kitchin, et al. eds., 14<sup>th</sup> edn., London: Sweet & Maxwell, 2005) at 508.

<sup>68</sup> *The Modern Law of Copyright and Designs* (Vol. 2, 3<sup>rd</sup> edn., H. Laddie et al., London: Butterworths, 2000) at 1728.

<sup>69</sup> The 'Ram Gopal Verma ki Sholay' case, unreported, 16<sup>th</sup> July, 2007.

<sup>70</sup> *Hay v. Aswini Kumar*, AIR 1958 Cal. 269.

<sup>71</sup> *Mitha Rustomji v. Nusserwanji*, AIR 1941 Bom. 278; *Capital and Counties Bank v. Henty*, [1882] 7 AC 741.

<sup>72</sup> *Indian Express Newspapers (Bom) Pvt Ltd v. Jagmohan*, AIR 1985 Bom. 229.

<sup>73</sup> *M'Pherson v. Daniels*, (1829) 10 B & C 272.

<sup>74</sup> *Osumanyawa v. Nana Sirofi*, AIR 1930 PC 260.

<sup>75</sup> *Winfield & Jolowicz on Tort* (W.V.H. Rogers ed., 16<sup>th</sup> edn., London: Sweet & Maxwell, 2002) at 685.

<sup>76</sup> *H.V. McGregor, McGregor on Damages*, (17<sup>th</sup> edn., London: Sweet & Maxwell, 2003) at 1415.

<sup>77</sup> *Harrison v. Pearce*, (1859) 32 L.T. (o.s.) 298; *Bluck v. Lovering*, (1885) 1 T.L.R. 497.

<sup>78</sup> *Bluck v. Lovering*, (1885) 1 T.L.R. 497.

<sup>79</sup> See Ss. 27 and 135 of the Trademarks Act, 1999 and S. 55(1) of the Copyright Act, 1957.

<sup>80</sup> *Reddaway v. Bentham Hemp Spinning Co.*, [1892] 2 QB 639.

<sup>81</sup> *Treasure Cot Co. Ltd. v. Hamlet Bros.*, (1950) 67 R.P.C. 89.

<sup>82</sup> *Aktiebolaget Manus v. R J Fullwood and Bland Ltd.*, (1954) 71 R.P.C. 243.

<sup>83</sup> *Time Incorporated v. Lokesh Srivastava & Anr.*, 2005 (30) PTC 3 Del.

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**PRAYER**

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Wherefore in the light of the issues raised, arguments advanced and authorities cited, it is humbly prayed that this Hon'ble Court may be pleased to:

- Uphold the opposition over the grant of the patent over the claimed process;
- Decree the suit as pertains to the trademark and copyright violation in favout of the Plaintiff;
- Order payment of damages and an injunction for trademark and copyright violation and passing off.

And order any other relief that this Hon'ble Court may deem fit in the interests of justice, equity and good conscience.

ALL OF WHICH IS HUMBLY PRAYED,

COUNSEL FOR THE PLAINTIFF/OPPONENT