

### *Scrabble loses copyright claim but wins trademark*

*Mattel Inc v. Jayant Agarwala* decided by the High Court of Delhi raised dual issues of copyright and trademark rights of the plaintiff.

Mattel Inc., the plaintiff in this case, is a leading manufacturer of toys, games and consumer products. It owns the trademark "SCRABBLE" under which it has been selling the well-known word-based board game. The game was invented in 1932 and the trademark was adopted in 1948 and had been in use since then. The plaintiff owned two registrations for the mark SCRABBLE in India in classes 9 and 28 from 1999 and 1978 respectively. The plaintiff's game was so popular that the Oxford English Dictionary defined 'scrabble' as the 'proprietary name of a game in which the players use tiles displaying individual letters to form words on a special board'.

The first and second defendants were brothers and partners in the third defendant, a firm engaged in providing IT solutions. The genesis of the suit was the launch by the defendants of an online version of the plaintiff's board game under the mark SCRABULOUS as an application available through the popular networking website [www.facebook.com](http://www.facebook.com). This on-line version was also promoted through the defendants' websites [www.scrabulous.com](http://www.scrabulous.com), [www.scrabulous.info](http://www.scrabulous.info) and [www.scrabulous.org](http://www.scrabulous.org).

The allegation of the plaintiff in the suit was two fold: first, that the defendants' aforesaid activities amounted to infringement of the plaintiff's trademarks as well as passing off and, secondly, that the defendants had infringed its copyright in the game board and the rules.

In their defense against the trademark claim, defendants contended that the word 'SCRABBLE' was a generic term that it had become the description of the game and was a non-distinctive mark. As regards the copyright claim, the defendants alleged that the copyright in relation to the game board was not maintainable since the board, which was a three dimensional article was not copyrightable. Further, they alleged that the shape and configuration of the board can be registered as a design, and, therefore, under Section 15(2) of the Copyright Act, 1957, the monopoly over the copyright in the said design was extinguished the moment more than fifty copies of the same were produced commercially. As regards the rules of the game, the defendants alleged that since there is no copyright registration no injunction could be claimed.

The court first addressed the copyright query whether the plaintiff's claim to copyright in respect of the game boards with the diagonal crisscross design and the placement of double word, triple word double and triple letter values as well

as rules of the game was a valid claim. In arriving at a conclusion, the court relied upon the ruling of the Supreme Court in *Eastern Book Company v. D B Modak* [(2008) 1 SCC 1], which rejected the 'sweat of the brow' doctrine and held that the work must be original "in the sense that by virtue of selection, coordination or arrangement of pre-existing data contained in the work, a work, somewhat different in character is produced by the author". Accordingly, the court found that not every effort or industry or expending of skill, results in copyrightable work, but only those which create works that were somewhat different in character, involving some intellectual effort and involve a certain degree of creativity could be protected and that this standard of originality, was now applicable in respect of the plaintiff's claim to copyright in various aspects of the game.

Further, the court applied the doctrine of merger which postulated that where the idea and expression were inextricably connected, it would not be possible to distinguish between the two. Applying this test, courts have refused to protect the expression of an idea which could be expressed only in a very limited manner, thereby conferring monopoly over ideas. By applying the said doctrine to this case, the court held that the color scheme on the game board of the plaintiff could be expressed only in a limited number of ways and if the plaintiff's arrangement were to be avoided, it is not known whether the idea of such a word game could be played at all. Relying on the decisions of American courts in *Allen v. Academic Games League of Am* [89 F.3d614] and *Atrai Inc v. North American Philips Consumer Electronics Corporation* [672 F.2d 607], the court held that copyrightability of a game was hit by the doctrine of merger as games consisted of abstract rules and play ideas over which no monopoly must be conferred. If the rules of the game, which formed the only method of expressing the underlying idea were to be subjected to copyright, the idea in the game would be given monopoly, a result unintended by lawmakers, who only wanted the expression of ideas to be protected. Accordingly, the High Court of Delhi found that, *prima facie*, the copyright claim of the plaintiff should fall to the ground.

As regards the trademark claim in the mark 'SCRABBLE', the court found that it was not *per se* descriptive of the word game, unlike MONOPOLY or CROSSWORD. Court observed that while evaluating the competing claims of the defendants and the plaintiff, it could not be unmindful of the fact that language was an evolving and organic system, which assimilated all kinds of usage, customs and convenient descriptions of objects, processes, systems, places and persons. It pointed out that etymological adventurism by the court should not lead to loss of distinctiveness of a mark which was a part of the popular lore. Further, the court found that the defendants' mark SCRABULOUS is too close,

phonetically and semantically to plaintiff's mark SCRABBLE. Accordingly, the defendant was enjoined from using the infringing mark SCRABULOUS.

The decision in respect of the adverse copyright finding is currently under appeal before a Division Bench of the High Court of Delhi.