Delhi High Court Affirms Trademark Protection for Iconic Film Title 'SHOLAY', Imposes ₹25 Lakh Costs

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In a significant ruling reinforcing SHOLAY trademark protection, the Delhi High Court held that the title of the iconic film *'SHOLAY'* cannot be regarded as devoid of legal protection and restrained a US-based company and others from misappropriating the mark, imposing costs of ₹25 lakh.

"Certain films cross the boundaries of just being ordinary words and the title of the film 'SHOLAY' is one of them. Titles and films are capable of being recognised under trademark law and in India 'SHOLAY' would be a classic example of such a case," said the Delhi High Court while restraining a US-based company, its Hyderabad-based sister concern and their directors from misappropriating the mark "SHOLAY" and slapping a cost of Rs 25L on them.

"The word 'SHOLAY', is the title of an iconic film, and consequently, as a mark having been associated with the film, produced and now vesting in the Plaintiffs (Sholay Media Entertainment Pvt Ltd and Sippy Films Pvt Ltd, cannot be held to be devoid of protection," said Justice Pratibha M Singh while deciding a suit instituted by the plaintiffs through Anand and Anand.

The plaintiffs had sued US-based company Sholay.com Pvt Ltd, another company named Netangle.com Pvt Ltd and its three directors besides three other controlling entities of domain name 'Sholay.com'. The defendants were publishing a magazine using the mark/name Sholay and had put on sale various merchandise, using scenes and names from the movie 'SHOLAY'.

Brief About SHOLAY trademark protection Case:

Team Anand and Anand comprising advocates Pravin Anand, Dhruv Anand, Udita M Patro and Sampurna Sanyal informed the court that upon coming across a magazine titled "IT-Information Technology" released in December 2000, plaintiffs learnt that the defendants had registered the domain name 'www.sholay.com'. The magazine was accompanied by a free compact disk containing the advertisement of the website. An article published in the magazine made assertions that the biggest Bollywood blockbuster has hit the internet while also claiming that "'SHOLAY.com' is a comprehensive site that offers much more than its Bollywood alias did".

The Defendants sought to create an entertainment portal offering various services such as chat, e-greetings, countdowns, horoscopes kid zone, classifieds, matrimonial, and grocery store. The website covered various subjects ranging from politics to cricket, finance to shopping, news updates, and

bulletins from Bollywood.

The Plaintiffs shared with court instances where the infringement of mark 'SHOLAY' by the defendants had caused confusion in the minds of users globally.

It is to be noted that the defendant had filed a trademark registration application in the name of a company called sholay.com in year 1999 for the mark 'SHOLAY' with the United States Patent and Trademark Office (USPTO).

In India, the trademark application, was filed by DefendantNetangle.com Pvt. Ltd. The Regional Director, Southern Region, Registrar of Companies, Chennai, in its order dated 20th December, 2000 directed the defendants to delete the word 'Sholay' from its existing name after objection raised by the plaintiff. The defendant moved a writ before the Madras High Court which set aside the order of the Registrar solely on the ground of violation of principles of natural justice.

While deciding the instant suit, Justice Pratibha M Singh noted that the Defendants were also using a similar logo, colour scheme, and device and offering Ganpati silver coins, sweets and savouries from Indian Mithai shops, DVDs of the movie 'SHOLAY' on their website. The word 'SHOLAY' was also being used as a metatag by the Defendants on their web pages.

The defendants also tried to misappropriate the rights of the plaintiff in 'SHOLAY' by registering it as a series of domain names like sholay.com, sholaynews.com, sholaychat.com etc. They were even offering various online services like 'Sholay Matrimony', 'Sholay Jobs', 'Sholay e-messages' etc.

Holding their adoption of mark 'SHOLAY' to be dishonest, the court restrained "the defendants, their directors, partners, proprietor and anyone acting for and on their behalf from using the name 'SHOLAY' in respect of any goods and services and also from using the domain name 'Sholay.com' and making any reference to the movie 'SHOLAY' or using any images or clippings from the said movie, as also from selling merchandise using the name SHOLAY or any images from the film".

It also barred them from using the mark or its variation on the Internet while directing the concerned domain names registrars to transfer the infringing domain names to the Plaintiffs, within one week of the receipt of the present order.

Click here to read/ download the order

KEY CONTACTS



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