
(2002) 07 BOM CK 0074
In the Bombay High Court
Case No : Misc. Petition No. 40 of 1995

I.T.C. Limited

APPELLANT

Vs

GTC Industries Ltd. and Another

RESPONDENT

Date of Decision : 04-07-2002

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 9(1), 9(4)

Citation : (2003) 1 BomCR 317 : (2003) 1 BOMLR 136 : (2002) 4 MhLj 441

Hon'ble Judges : S.A. Bobde, J

Bench : Single Bench

Advocate : Ravi Kadam, Rahul Chitnis, Nimish Kothare, P.P. Paul and Santosh Bhide, instructed by Nanu Hormasjee and Co, for the Appellant; M.R. Nair, for the Respondent

Final Decision : Allowed

Judgement

S.A. Bobde, J.—This petition challenges the order dated 20th December 1994 by which the Assistant Registrar of Trade Marks has dismissed the petitioners opposition and allowed the registration of the trade mark "GUTSY" to the respondents in respect of the Cigarettes, tobacco, safety matches and smokers articles, in Class 34.

2. On 5th September, 1985 the respondent No. 1 applied for the registration of the trade mark "GUTSY". On 1st December 1990 an advertisement was published. On 7th January 1991 the petitioner filed its opposition inter alia on the following ground that the trade mark "GUTSY" is not registrable as it is neither distinctive nor capable of distinguishing and, therefore, does not satisfy the requirement of registrability as laid down by the Act. They further contended that the trade mark is a laudatory expression and there is nothing inherently distinctive in it nor is it capable of distinguishing the goods in respect of which it is proposed to be used from the other goods in the same class. The respondent No. 1 therefore objected to the registration of the trade mark under part "A" or Part "B" of the Register. There were other objections also. What is mainly

agitated before me are the objections mainly concerned with those mentioned above. There is no dispute that originally the respondent No.1 applied for the registration of the trade mark in Part "A". However, in pursuance to a personal hearing the application was ordered to be advertised as accepted in Part "B". Therefore, the question before the Registrar was whether the trade mark should be registered in part "B".

3. There is also no dispute about the fact that the trade mark "GUTSY" has not been used before for the purpose of trading in cigarettes and the other articles mentioned above.

4. Evidence was led by the opponents who filed affidavits of their employees,

5. The main evidence relied upon by the petitioners was the meaning of the word "GUTSY" from several dictionaries. The dictionaries relied upon are :

(1) A New Dictionary of American Slang;

(2) The Concise Oxford Dictionary of Current English;

(3) Webster's Third New International Dictionary of the English Language; and

(4) Encyclopedia Britannica, Inc.

Suffice it to say that all dictionaries concur as to the essential meaning of the word as being brave and courageous. In addition, the petitioners relied on an advertisement of MRF Tyres as an example of the way the word "GUTSY" is used. In that advertisement the word "GUTSY" is employed in the following sentence:

"Anand roared to victory in the prestigious 15-lap Grand Prix in a fiery and gutsy exhibition of formula car racing."

After hearing the parties, the Registrar rejected the opposition inter alia on the ground that the word "GUTSY" is an American Slang word as apparent from the dictionary of American Slang and that there is no evidence before him to such that the word "GUTSY" is known in the sense in which it appears in the dictionary of American Slang to the people in India who are likely to use the trade mark. The learned Registrar appears to have referred to the word "GUTSY" in the aforesaid advertisement and declined to go into it at all on the ground that the advertisement had nothing to do with any vendible commodity or goods or merchandise. It is obvious that the Registrar has lost sight of the purpose of the advertisement filed by the petitioners which was to point out the manner in which the word is employed in a sentence.

6. The question before me is whether the Registrar has rightly granted registration to the trade mark "GUTSY" in Part B of the Register?

7. The Registrar seems to have decided the question; on the ground that the word "GUTSY" had no direct reference to the character or quality of the goods. The Registrar referred to earlier occasions when the words "FANTASY", "JUBILEE", "LEGEND", "IMAGE", "SALUTE" etc. were registered. In the result, the

Registrar came to the conclusion that the mark applied for has no direct reference to the character or quality of the particular goods. Peculiarly the Registrar has observed that the petitioners have not produced an iota of evidence to show that the word "GUTSY" is being used as a descriptive or laudatory term on or in relation to cigarettes in India. It is difficult to see the nature of evidence expected by the Registrar on whether a term is being used as a laudatory term or not.

8. As stated earlier the Registrar granted the registration in part "B" of the Register. The provision which governs registration in part "B" of the Register is Section 9(4) which reads as follows:

"(4). A trade mark shall not be registered in Part B of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive, or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration."

9. It was not necessary for the Registrar to consider the objection u/s 9(1)(d) which provides for the conditions for registration of a trade mark in part A of the Register. Section 9(1)(d) reads as follows :

"(1)

(a)

(b)

(c)

(d) One or more words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;"

10. Mr. Kadam, learned counsel for the petitioners confined his submission to the registrability of the trade mark in Part B of the Register. He, accordingly, submitted that the trade mark is not distinctive nor is it capable of distinguishing the goods in question i.e. cigarettes and other articles with which the respondent No. 1 is connected in the course of trade from the goods with which the respondent has no such connection. It is settled that this is a requirement of the registrability of the trade mark with part B of the Register.

11. Sub-section (4) which is in the form of negative injunction states that a trade mark shall not be registered unless the trade mark in relation to the goods in respect of which it is proposed to be registered is : (a) distinctive or (b) is not distinctive but is capable of distinguishing goods with which the proprietor of the trade mark is connected from goods in case of which no such connection subsists.

12. The Act itself gives the meaning of the word "distinctive". Sub-section (3) reads as follows :--

"9(3). For the purpose of this Act, the expression "distinctive" in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration."

13. The only question therefore is whether the trade mark "GUTSY" is either adapted to distinguish the goods for which its registration is sought or whether it is capable of distinguishing the goods from similar goods of other manufacturers, to depart from the language of the statute.

14. At the outset, it may be stated that the question whether a trade mark is adapted to distinguish goods would in the scheme of the Act arise where the trade mark is found to be not capable of registration under Clauses (a) to (d) of subsection (1) of Section 9. Where it is found that it is not possible to register the trade mark under Clauses (a) to (d) of Sub-section (1) of Section 9, a proprietor of the trade mark may seek to have it registered on the ground that it is distinctive in relation to the goods in question since the trade mark has been adapted to distinguishing the goods of the proprietor in question from similar goods of other manufacturers or traders. Therefore, what is essential to see is whether there is anything in the word "GUTSY" from which it can be inferred that it has been adapted to distinguish goods i.e. the respondent No. 1's goods in question from similar goods of the other manufacturers.

15. All the dictionaries make it clear that it is a commonly used word which intends to connote someone who is brave and courageous or when used as adjective, to describe say a "Performance" which had the quality of courage or bravery. I see nothing in that word from which it might be said that it has been adapted to distinguish the respondent No. 1's cigarettes and other articles from the cigarettes and other articles manufactured by others.

16. Mr. Kadam, learned counsel for the petitioners, relied on a judgment of the English Court of Appeal in the matter of an application by Joseph Crosfield & Sons Ltd., reported in 1909 (26) R.P.C. 837. That was a case where the word "Perfection" was sought to be registered as a trade mark for common soap. The Registrar of Trade Marks refused to register "Perfection" as a trade mark. Joseph Crosfield & Sons Ltd., therefore, appealed to the Court. While dismissing the Appeal, the Court of Appeal made observations which are directly relevant here having regard to the fact that the word was a common word in the English language. The Court of Appeal observed as follows :

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the

future from access to the enclosure.

Further, it is apparent that no word can be registered unless it is distinctive that is to say, is "adapted to distinguish" the goods of the proprietor from the goods of other persons. There are some words which are incapable of being so "adapted" such as "good", "best", and "superfine." They cannot have a secondary meaning as indicating only the goods of the applicant. There are other words which are capable of being so "adapted," and as to such words the tribunal may be guided by evidence as to the extent to which use has rendered the word distinctive. It is easy to apply this paragraph to geographical words, and it is possible to suggest words having, direct reference to character or quality which might be brought within it. But an ordinary laudatory epithet ought to be open to all the word, and is not, in my opinion, capable of being registered. It may be that within a particular area the applicant might succeed in a passing-off action against a trader who used the epithet without sufficiently distinguishing his goods from the goods of the applicant. But that would not justify the Court in giving the applicant a monopoly throughout the United Kingdom in the use of a laudatory epithet. Whether in any particular case the word is or is not something more than a laudatory epithet is for the tribunal to decide. If it is open to doubt, the tribunal may direct the application to proceed. If, however, the tribunal is satisfied that the word is purely laudatory, the application ought not to be allowed to proceed, and if the application has been allowed to proceed it ought to be refused at the second stage."

17. In conclusion, while considering whether the word "Perfection" should be allowed to be used as a trade mark for soap, the learned Judge observed as follows:

"The name they have selected is the ordinary laudatory term "Perfection". Speaking only for myself I am not much impressed by; the argument that such a word ought not to be allowed to become a Trade Mark because a more perfect method of making soap might deceive the public. The use of inordinate laudation of his goods by a trader is too deeply rooted, and too ineradicable not to be well known to all the public, and I do not believe that any person buying soap would suppose that it was perfection merely because the maker calls it so. But to my mind this tells against the Applicants. It shows that the word is one that probably, and I might almost say naturally, would be used by others in the description of their soap. To me there is not much difference in this respect between the noun "Perfection" and the adjective "perfect." Therefore I think we ought not to allow it to become a Trade Mark. I regret to have so to decide because I feel that there has grown up a vast trade round the word which cannot be protected by the agency of the Trade Marks Act, but must be defended, so far as it can, by other and less efficient methods. But it is the consequence of the Applicants having been so unwise as to choose a mere laudatory word for their brand. Had the word been less objectionable in its nature the case that has been proved before us would have influenced me greatly, for it shows, to my mind,

that throughout about half of England the past user of the word has identified it in the eyes of the public with the goods of the Applicants."

18. I have no doubt in my mind that the word "GUTSY" in relation to the cigarettes and the other articles in respect of which it is sought to be registered needs to be viewed in the same manner as the word "Perfection" was viewed by the English Court in the above case. There is nothing esoteric or exotic about the word. It is a word that is fairly commonly used by people in India, and has also found its way in the vocabulary of people when they are not speaking English.

19. Mr. Kadam, the learned counsel for the petitioners, further relied on the case reported in 32 R.P.C.15, where the Registrar, the registration for the word "Classic" in relation to Christmas cards has been refused. The court held that the word "Classic" was incapable of being treated as "adapted to distinguish" or of acquiring a secondary meaning.

20. In line with the above decision, I am of the view that the word "GUTSY" is primarily a laudatory adjective which is however incapable of being adapted to distinguish the goods in question, being a common word in the English language and a word commonly used in India. In fact the word is so common that it would be contrary to the law to confer a statutory right to its use to a single manufacturer and confer on him all consequential rights such as : preventing others from using the common word.

21. Mr. Nair, learned counsel for the respondent No. 1 relied on two decisions of this Court. Firstly, he relied upon a judgment in the case of Hindustan Petroleum Corporation Ltd vs. The Registrar of Trade Marks, reported in 1982 PTC 45 wherein this Court set aside the order of the Registrar who has refused registration of the word "SEETUL" for lubricants. While doing so this Court observed that it cannot be said that the word "SEETUL" has a direct reference to the character or quality of the goods and, therefore, allowed the registration. These observations were made by this Court in the context of the registrability of the trade mark in part A of the Register and in view of Section 9(1)(d) which prohibits a direct reference to the character or quality of goods. The present case arises from registration in Part B of the Register. The other case relied upon by Mr. Nair is Central Camera Co. Private Ltd. vs. The Registrar of Trade Marks, reported in (1980) 1 PLR 1 where the Registrar has refused to Register the trade mark "SOLAR" in respect of the photographic apparatus, studio lights, projectors, photographic enlargers etc. In Appeal, this Court held that the word "SOLAR" cannot be said to be barred by Section 9(1)(d) since it does not bear a direct reference to the character or quality of the goods of which registration was sought. I am of view that reliance on the aforesaid two decisions in the present case is misplaced since the trade mark in question in this case has been granted registration under part B. The bar to grant the registration on the ground that a word in the trade mark contains direct reference to the character or quality of goods occurs only in relation to trade marks for which registration is sought under part A of the Register.

22. Mr. Nair further contended that the trade mark "GUTSY" is inherently capable of distinguishing the goods in question i.e. cigarettes and other articles and in any case capable of distinguishing the goods in question manufactured by respondent No. 1 from similar goods manufactured by others. It is not possible to discern anything in the word "GUTSY" which makes it inherently distinctive or capable of distinguishing the goods in respect of which its registration is sought from similar goods manufactured by others. As observed earlier, the word "GUTSY" is a common word and it would not be permissible to allow the respondent No. 1 to "enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure." As observed by the English Court in the "Perfection" there are some words which are incapable of being adapted to distinguish such as "good", "Best" and "Superfine". In my view, "GUTSY" is just one other such laudatory adjective. It is, therefore, not capable of being considered as having been adapted to distinguish or capable of distinguishing. It may be observed that normally a mark is said to be capable of distinguishing when it has been used as such and proven to have been capable of distinguishing of the goods of the proprietor from the goods of other persons. Though that is not only the test or a prerequisite. In this case, admittedly, the mark has not been used before in respect of the goods in question. So that aspect of the matter cannot be considered.

23. In the result, the present petition is allowed. The order dated 20th December 1994 at Exhibit "G" is set aside. This petition is also allowed in terms of prayer (b). There shall be no order as to costs.

Parties may be provided with ordinary copy of this order duly authenticated by the Associate of this Court on payment of usual copying charges.

P.S. to give ordinary copy of this order to the concerned parties.