



# PITFALLS OF ORDINARY DICTIONARY WORDS ADOPTED AS BRANDS

## **REGISTERED TRADEMARKS ENJOY STATUTORY PROTECTION AGAINST INFRINGEMENT**

A Trademark is a name, logo or symbol associated with goods or services of a company or individual. It can contain words, letters, numerals, symbols, or any of its combination. A registered proprietor is statutorily entitled to bring an action against infringement of his rights by any other proprietors from misusing the Trademark.

### **CAUTION WHILE ADOPTING THE TRADEMARK:**

While adopting the Trademark the proprietor must keep in mind that the Trademark is not just word or name that is commonly used by people. For example, a cycle manufacturer should not adopt a trademark "the cycle." Registration of such marks will be objected to under Section 9 of the Trademarks Act, 1999. A trademark must be capable of distinguishing the goods of its proprietor from same or similar goods of others. Therefore, it may be a word that does not have any ordinary dictionary meaning and describing the nature of goods. In some cases, such trademarks may be allowed to be registered after they acquire distinctiveness after prolonged use in the course of trade. In short, the word or words chosen to function as a brand or trademark should be distinctive and should not be descriptive.

### **RECENT DECISION OF DELHI HIGH COURT**

Recently, the Hon'ble High Court of New Delhi in **Institute of Directors Vs Worlddevcorp Technology and Business Solutions Pvt Ltd., and Others [2023 SCC OnLine Del 7841]** while rejecting the injunction in favour of the Plaintiff held as follows: -

*"28. It is well settled that words of ordinary English usage cannot be monopolized. Else, the entire English language would be appropriated by a few, which can obviously not be permitted. There is, therefore, in Section 9(1)(a), an absolute proscription to registration of marks which are inherently lacking in distinctiveness, in that they are incapable of distinguishing the goods or services of one person from those of another. Words of common English usage fall within this category. It is only if the mark has attained secondary significance, by dint of continuous usage and is entitled, therefore, to the benefit of proviso to Section 9(1), that such a mark can be registered. Otherwise, words of common English usage, even when put together to form a phrase of common English usage, cannot be registered. No monopoly can be claimed by the registrant of such a mark.*

*32. Obtaining of a registration in respect of a mark which consists of common English words is fraught with the possibility of its own adverse sequelae. While obtaining registration of such a mark, the registrant has to be conscious that, the mark being a combination of ordinary English words, and, in fact, as in the present case, being a mark*



*as non-distinctive as “Institute of Directors”, there is every possibility of a similar mark being used by another person. Commonly used words, or a non-distinctive combination of commonly used words, cannot be monopolized by any one person, so as to disentitle the rest of the world to the use thereof.*

**33.** *For all these reasons, therefore, the plaintiff’s claim to exclusivity over the words “Institute of Directors” and, therefore, the prayer for a restraint against the defendants’ using the words “Directors Institute” cannot, prima facie, sustain.*

Another interesting aspect of the case was the defendants found that at the time of registration the plaintiff has submitted an affidavit stating clearly that they are registration for the whole of representation contained in their mark and they disclaim any exclusive right over general words contained in the representation. The High Court held as follows:

**34.** *Additionally, I am in agreement with Mr. Yashpal Singh that, in keeping with the requirement of fair disclosure, which is an indispensable prerequisite to any entitlement to equitable relief, it was incumbent on the plaintiff to place the aforesaid reply dated 8 December 2014, as tendered to the Trade Marks Registry, on record. This, additionally, is a ground which operates to disentitle the plaintiff to equitable relief in the present application.”*

In the case of “Institute of Directors”, considering non-distinctiveness of the words comprised in their Trademark, which were common English Words, despite registration of the trademark, the Hon’ble Delhi High Court declined to grant any “**interim**” protection against a defendant who has used “Director’s Institute” as their trademark.

**Conclusion:**

It is important for a person who desires to adopt a trademark which contains common or descriptive words to be aware of the difficulty in getting registration to be able to enjoying statutory protection conferred upon registered proprietors under the Trademarks Act, 1999.

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