

HOUSE MARKS

Praneet Singh Davar



Of P. S. Davar & Co.

Patent & Trademark Attorneys

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The Indian Judiciary

- In India, the judiciary has been the guardian of Democracy since Independence in 1947.
- This guardianship has transcended to the enforcement of Intellectual Property Rights, particularly for trademarks and especially more so since the opening of the Indian economy in the 1990's.

Indian Trade Marks Act, 1999

Unlike some jurisdictions, like the US, the Indian Trade Marks Act, 1999 makes **NO SEPARATE / EXPLICIT REFERENCE TO OR ANY PROVISION** relating to House Marks.

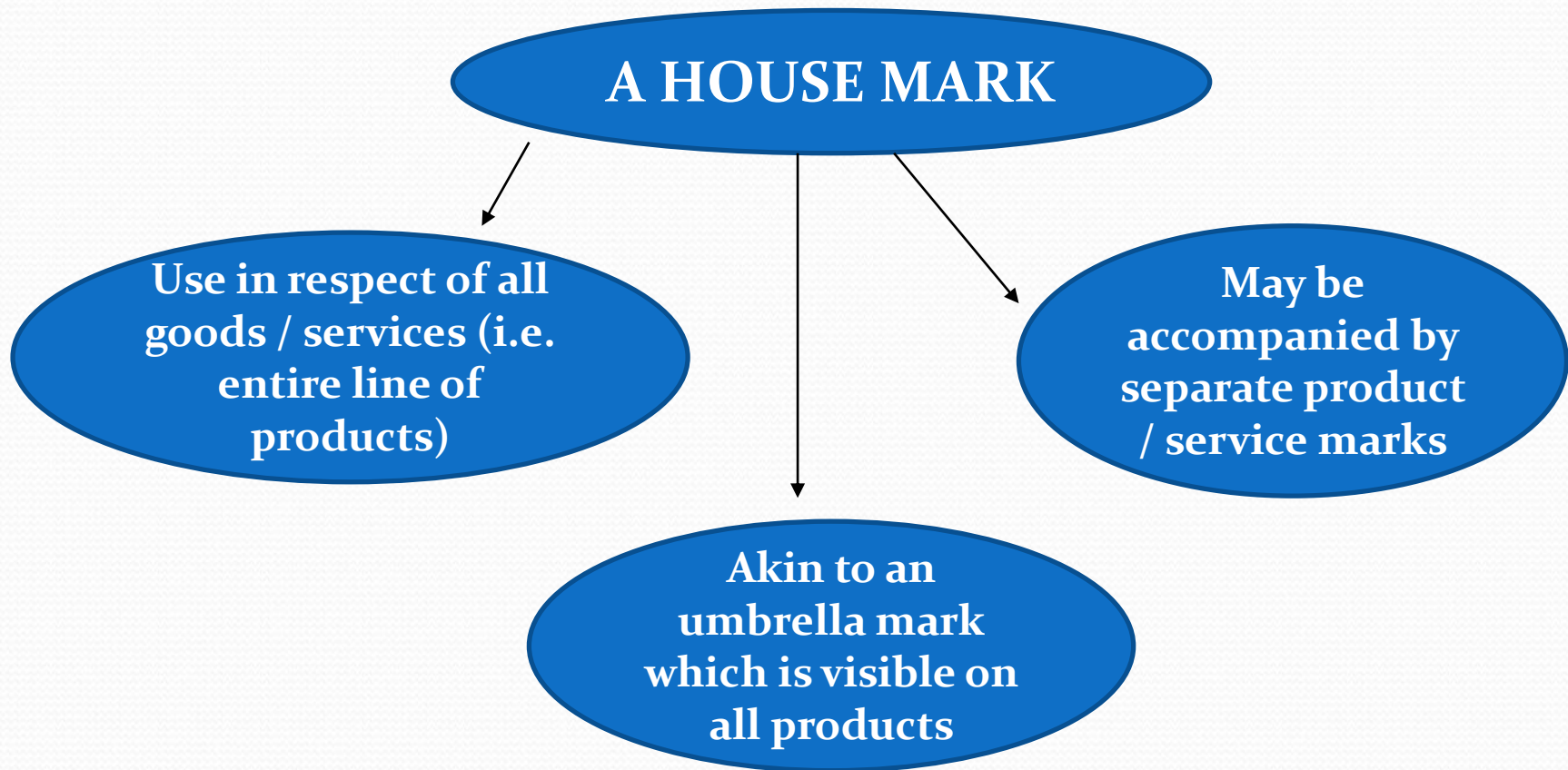
Under the Indian Trade Marks Act, 1999 the following categories of trademarks are recognized:

- **Word marks;**
- **Three dimension marks;**
- **Sound marks;**
- **Shape marks;**
- **Device marks;**
- **Colour marks;**
- **Collective marks;**
- **Certification marks; and**

AND
Well-Known
Trademarks!

THERE IS NO DEFINITION OR REFERENCE TO HOUSE MARKS

WHAT ARE HOUSE MARKS?



Since the Indian statute does not define or use the term “House Mark”, there is no straight jacket formula or clear definition to identify a house mark or to distinguish house marks from other trademarks.

EXAMPLES

INDIAN HOUSE MARKS

With the growth and expansion of the Indian economy, Indian business houses have started increasingly adopting House marks

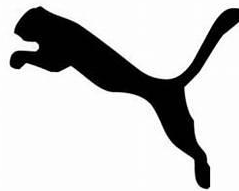


PROMINENT HOUSE MARKS OF FOREIGN ORIGIN IN INDIA

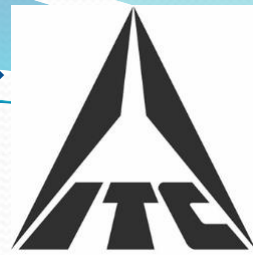


OFTEN HOUSE MARKS ALSO CORRESPOND TO THE TRADING NAMES OF THE BUSINESS HOUSES

HOUSE MARKS NEED NOT ALWAYS CORRESPOND TO THE TRADING NAMES OF ENTITIES .. **SUCH AS** **DEVICE MARKS**



HOUSE MARK



Enduring Value

PRODUCT MARKS



Atta, Ghee, Salt, Spices,
Ready To Eat Meals &
Instant Mixes



Gluten Free Flour



Atta



Salt



Biscuits, Cookies & Cakes



Dark Fantasy Coffee Fills



Dark Fantasy Choco Fills



Mom's Magic Rich Butter



Potato Chips & Finger
Snacks



Potato Chips Salted



Mad Angles Tomato Madness



Bingo! Tedhe Medhe

PRODUCT MARKS OF ITC

mint-o

Confectionery



Mint-o GOL Orange Chew



Ultra mintz



Mint-o Fresh Max



Instant Noodles & Pasta



Yippee! Noodles



Tricolor Pasta



Sunfeast Pasta Cheese



Ready To Eat Gourmet Cuisine, Masala Mixes, Chutneys & Conserves



Ready to Dine - Daily Treats



Ready to Dine - Gourmet Delight



Conserves



Juices & Beverages



Watermelon



100% Pomegranate



Mixed Fruit

PRODUCT MARKS OF ITC

CANDYMAN

Confectionery



Choco double Eclair's



Toffichoo



Cofitino

FABELLE
Cognate
CHOCOLATES

Luxury Chocolate



SUNBEAN

Gourmet Coffee



Nicamalai



Panagiri



Sunbean Beaten Caffe

**ITC
MASTER
CHEF**

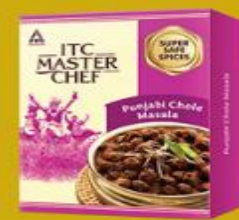
Blended Spices & Frozen Prawns



Prawns
















South Indian Spices



Super Safe Spices

PRODUCT MARKS OF ITC

<p>INTRODUCING</p>  <p>SAFE AND NUTRITIOUS</p> <p>FRUITS & VEGETABLES</p> <p>Potatoes</p>	 <p>Baby Potatoes</p>	 <p>French Fry Potatoes</p>	 <p>Naturally Low Sugar Potatoes</p>
<p>ESSENZA DI WILLS</p> <p>YOUR ESSENCE. YOUR SOUL.</p> <p>Fine Fragrances, Deodorants, Hair and Body Shampoos & Bathing Bars</p>	 <p>INIZIO</p>	 <p>AQUA</p>	 <p>MIKKEL</p>
<p>Vivel</p> <p>Soaps & Body Wash</p>	 <p>Vivel Cool Mint</p>	 <p>Vivel Mixed Fruit Cream</p>	 <p>Vivel Green Tea</p>
<p>ENGAGE</p> <p>Colognes, Deodorants & Perfume Sprays</p>	 <p>Engage ON+ Breezy Flip</p>	 <p>Engage ON+ Forest Flip</p>	 <p>Engage ON+ Musky Flip</p>

HOUSE MARK



PRODUCT MARKS FOR DIFFERENT PRODUCT LINES

For Business		For Consumer	
Appliances		Food and Grocery	
Furniture		Locks	

Home and Personal Care		Security	
Properties		Others	



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REGISTRATION PROCESS - INDIA

- **No separate registration** process for House marks.
- Registration process same as for all other trademarks.
- **Statutory requirements:**
 - Must be **inherently distinctive** in nature; should **NOT be descriptive** or indicate the kind, quality, intended purpose or value of underlying goods / services;
 - Should be distinct from other trademarks on Register i.e. should not be same / similar to existing trademarks.
 - Should not be of such nature as to deceive the public or cause confusion;
 - Should not hurt religious susceptibilities of citizens of India;
 - Should not be prohibited under the provisions of the Emblems and Names (Prevention of Improper Use) Act, 1950.
- In India, unless there are some pertinent objections raised, a trademark / a **house mark can now proceed to registration within 8-10 months.**

USE REQUIREMENTS / NON-USE CANCELLATION

- Use requirements of house marks are the **same as for other trademarks**.
- **Use is NOT mandatory** to file a trademark / house mark application in India or to obtain a trademark / house mark registration.
- However, once a trademark / house mark proceeds to registration and there has been **no *bonafide use* for a continuous period of 5 years**, such trademark is **vulnerable to cancellation proceedings**.
- The conditions for non-use cancellation for house marks is same as for other trademarks.

MARKING REQUIREMENTS

- There are **No Mandatory Marking Requirements** under the Trademarks Act, 1999.
- Unlike the Indian Patents Act 1970 where the product must be marked with the Patent No., to claim damages, there is no such corresponding requirement, in the Trade Marks Act, 1999.
- The use of ® is recommended once the mark proceeds to registration as it is a **Deterrent**, however, such marking is **Not Mandatory**.

Rules of Protection & Enforcement

- Although House marks find no explicit reference in the Trade Marks Act, 1999 they **are enforceable, just like any other trademark.**
- Enforcement of House marks is **often more stringent** since most of such marks are **reputed trademarks.**
- House marks are entitled to stringent **Statutory** and **Common Law Protection** because they are:
 - **Extensively registered;**
 - **More visible;**
 - **Extensively used** on all products;
 - **Extensively promoted;**

INCONSISTENCIES?

A POSITIVE INCONSISTENCY!

Although Statute does not specifically refer to or define house marks,

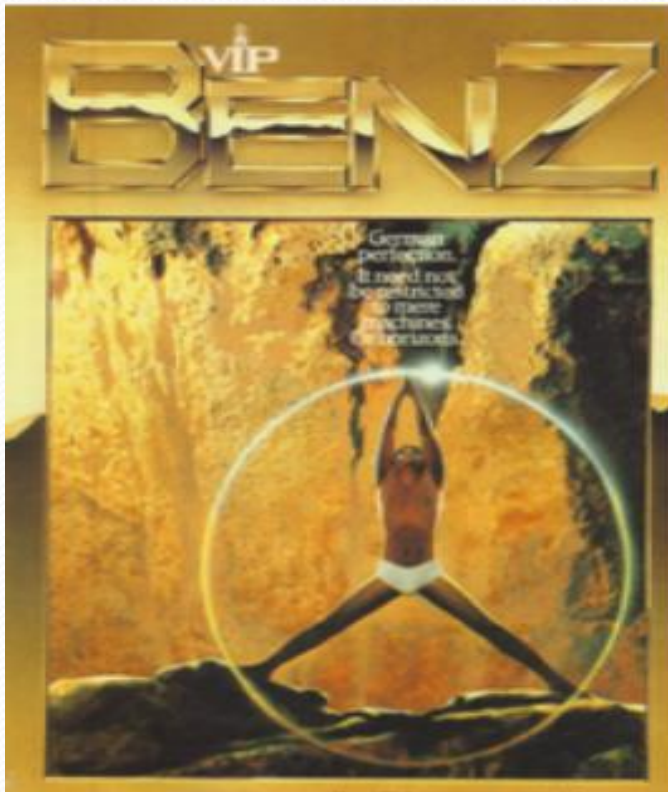
- **Stronger Protection** is afforded to House marks as they are usually marks of **repute / well-known marks**
- Tend to be **more prolifically registered, used, promoted and advertised** as compared to ordinary trademarks.
- Although House marks have seen effective enforcement and stringent protection, judicial precedents **do not always use the term “House marks” as the statute does not use such terminology.**

PROTECTION OF HOUSE MARK OR PRODUCT MARK? OR BOTH?

- Business entities **ought to protect both house marks as well as product marks vigilantly.**
- HOWEVER, as **house marks are umbrella marks which are used on all product / service lines, the ramifications of their dilution, infringement and passing off are much more significant and cut across product /service lines.**
- Accordingly, **house marks should be protected and defended in the most diligent manner possible.** This has been recognised in India where the Courts are often stricter when house marks (which are generally marks of repute) are violated.

Leading Judicial Enforcements

- The Mercedes Benz and three point star are used by Daimler Benz Aktiegesellschaft as house marks on all its vehicles , and accordingly, the Indian Courts took a strict view when such house marks of repute were diluted by use in relation to underwear !



The mark Benz and the three point star were being used by the Defendant for underwear!

DAIMLER BENZ AKTIEGESELLSCHAFT VS. HYBO HINDUSTAN

AIR 1994 Delhi 239

- The Hon'ble Delhi High Court while deciding the case in favour of Daimler Benz Aktiegesellschaft held that:

“There are marks which are different from other marks. There are names which are different from other names. There are names and marks which have become household words. The name “Benz” as applied to a car, has a unique place in the world.”

.....

“In my view, the Trade Mark law is not intended to protect a person who deliberately sets out to take the benefit of somebody else's reputation with reference to goods, especially so when the reputation extends world wide.”

DEFENDANT INJUNCTED. GOODS ORDERED FOR DESTRUCTION /NON USE.

HONDA MOTOR CO., LTD. VS. CHARANJIT SINGH AND ORS.
101 (2002) DLT 359, 2003 (26) PTC 1 Del

The House mark **HONDA** of Honda Motor Co., Ltd., was adopted from the founder's name, Mr. Soichiro **Honda** as early as in the 1940's.

The mark HONDA was being used by the defendant for pressure cookers.

Justice Agarwal of the Hon'ble Delhi High Court held that:

“I have no hesitation in taking a prima facie view that the Defendant's have adopted the mark Honda deliberately with an intention of creating a subtle association between the activities and those of the Plaintiff”

INTERIM INJUNCTION WAS GRANTED.

HAMDARD NATIONAL FOUNDATION Vs. ABDUL JALIL IA 7385/2004 IN CS(OS) 1240/2004

- Hamdard is an entity dealing in manufacture and sale of ayurvedic and herbal products dating back to the early 1900's. All goods of Hamdard contained the house mark Hamdard and an eye design.
- The defendant started use of Hamdard and an eye design in respect of rice. Granting relief to the plaintiff, the Hon'ble Delhi High Court held that:

“On an overall consideration of all factors, the court is of the opinion that the balance of convenience in this case lies in granting the ad interim injunction. The defendant took a calculated risk in using the HAMDARD word and eye mark; indeed its use of the eye mark points to an attempt to “free ride” on the plaintiff’s reputation. Unless enjoined, the plaintiff would continue to suffer commercially.”

INTERIM INJUNCTION WAS GRANTED.

***TATA SONS LTD. Vs MANOJ DODIA & ORS.
CS(OS) No. 264/2008
and
TATA SONS LTD. Vs MR. MD. JAWED & ANR.
CS(OS) No. 232/2009***

- Tata Sons Ltd. is a premier industrial house established in India since 1917. The trademark and trading name TATA was derived from its founder Mr. Jamsetji Nusserwanji Tata's name.
- Tata Sons Ltd. is known for its high quality products and services all sold/ rendered under the various trademarks which contain TATA as a house mark.
- The defendant – Manoj Dodia started dealing in weighing scales and springing balances under the mark A-ONE TATA and Md. Jawed started working under the name and style of TATA Points.

- While granting relief to TATA Sons Ltd. in the matter, the Hon'ble Delhi High Court observed that:

“The promotion and building of a trademark particularly a mark which is used in relation to a variety of goods /services, requires considerable efforts, skill and expenses. The brands are not built in a day, it takes years to establish a brand in the market.....”

.....The companies which invest heavily in brand building and back them up with quality products are bound to suffer not only in reputation but also in financial terms, on account of diminution in the value, if the brands are not given adequate protection by the Courts by awarding punitive damages against infringers.....”

“More and more foreign companies are entering our markets, with latest products. They would be discouraged to enter our country to introduce newer products and make substantial investments here, if the Courts do not grant adequate protection to their intellectual property rights such as patents, trademarks and copyrights...”

WHEN TO USE HOUSE MARK, PRODUCTS MARK, BOTH / STANDALONE

- Generally **House marks are used in conjunction with product marks** as they are more reputed and act as identifiers of the business houses which have earned trust and goodwill of consumers over decades.
- **Often registration of product marks becomes easier when they are prefixed with the house mark.** (Example HONDA Power, HONDA Genuine Parts, HONDA City, Levi's 501 etc.) as it adds an element of distinctiveness to the marks.



Thank You!

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