

IN THE HIGH COURT OF DELHI AT NEW DELHI

Judgment delivered on: October 12, 2020

+ CS(COMM) 217/2020, I.As. 5109/2020, 6523/2020 & 6572/2020

DELHIVERY PRIVATE LIMITED

..... Plaintiff

Through: Mr. Neeraj Grover, Mr. Satish Kumar
and Mr. Mahir Malhotra, Advs.

versus

TREASURE VASE VENTURES PRIVATE LIMITED

..... Defendant

Through: Mr. Chander M. Lall, Sr. Adv. with
Mr. Vivek Dhokalia and Mr. Saurabh
Jain, Advs.

CORAM:


HON'BLE MR. JUSTICE V. KAMESWAR RAO

J U D G M E N T

V. KAMESWAR RAO, J

I.A. 5109/2020 (filed by plaintiff under Order XXXIX Rules 1 and 2 CPC) & I.A. 6523/2020 (by defendant under Order 39 Rule 4 r/w Section 151 CPC to vacate / set aside ex-parte order dated July 03, 2020)

1. By this order I shall decide I.A. 5109/2020 filed by the plaintiff under Order XXXIX Rule 1 & 2 and I.A. 6523/2020 under Order XXXIX Rule 4 ('O39 R4' for short) read with Section 151 of the Code of Civil Procedure, 1908 ('CPC' for short) filed by defendant.


2. The case of the plaintiff in the plaint is that, it has continuously and extensively used the trademark 'DELHIVERY'  since the year 2011 for its logistics, transportation, management, etc. The mark was coined and adopted by its promoter in the year 2008. The plaintiff has experienced exponential growth since the year 2011 and has completed 600 million orders to around 120 million households with 75 fulfillment centers and secondary hubs and delivers around 1 million packages per day. The sales figures of the plaintiff company had reached approximately Rs. 2796.86 Crores for the year ending 2019-2020 with a growth of over Rs.1000 Crores over the sales of the previous year.

3. The plaintiff company has received numerous awards and accreditations and has been time and again receiving foreign funding which has enabled the plaintiff to become a unicorn company and has widespread online and print media presence.

4. It is averred in the plaint that the plaintiff company has 27 registrations for the trademark 'DELHIVERY' / its variants in classes 35, 39 & 42 of the Trade Marks Act, 1999 ('TM Act' hereinafter) including a word mark registration of the trademark 'DELHIVERY'. Due to incessant use of the mark 'DELHIVERY' and its variants openly, continuously and extensively since 2011 throughout the country, the

said trademark 'DELHIVERY' has come to be associated and identified solely with the plaintiff company and has gained immense popularity amongst the general public in the services of concern. It is stated that due to such incessant use coupled with extensive publicity, the plaintiff's mark 'DELHIVERY' has acquired secondary significance, which is evident from the huge annual sales figures.

5. The plaintiff has time and again taken legal action against the infringers of its copyright and trademarks and has secured orders in their favour from this Court as well as other forums, including the NIXI against the use of deceptively similar domain names by third parties.

6. As per the plaint, the plaintiff stated that the cause of action arose for the first time in the third week of May, 2020 when one of the plaintiff's employees noticed the use of the impugned mark  on the boxed E-rickshaws at Chhatarpur and Dwarka.

SUBMISSIONS:

7. At the outset, Mr. Neeraj Grover learned counsel for the plaintiff stated that the defendants who prayed for vacation of the interim order took a stand in their O39 R4 application that there was no prior service of suit papers on the defendant, which is a ground to vacate the interim order. In this regard he has stated the following:-


- a) The Registry of this Court did not require the advance service to be made mandatorily by e-mail and listed the suit only after 3 clear days of the advance service by post, which was sent on two addresses on June 29, 2020 and such receipts were attached with paper-book. Therefore, the fact that no email could be sent to the defendant for advance service cannot be taken as a ground for seeking vacation of the injunction orders as there was no *mala fide* in not sending the papers by e-mail.
- b) The defendant was not on caveat under Section 148A CPC and did not have an inherent right to be heard in advance at the stage of hearing of the interim application.
- c) The CPC, TM Act, Commercial Courts Act, 2015, Delhi High Court (Original Side) Rules 2018, or even the Delhi High Court Video Conferencing Rules, 2020 do not mandate that a plaintiff in a commercial suit cannot seek *ad-interim ex-parte* orders without advance notice on the defendant.
- d) Even the Practice Directions dated June 13, 2020 issued by this Court do not contain any mandate that advance service must be made by email, rather clause 18.2 prescribes that a party may not be under an obligation to accept documents via email. Clause 19 mentions that email was not a secure medium of communication

and that Clause 15 provided for filing of caveats through e-filing mode as well.


e) He stated that insofar as applications seeking exemptions from serving the defendant in advance, Co-ordinate benches of this Court have been allowing such applications, as a matter of routine and placed reliance on the order passed in CS (COMM) 255/2020. He has also attached emails from the commercial District Courts in Delhi where they have been officially writing to the counsels who are requesting hearing, that they are not entitled to be heard at an *ex-parte* stage and would be heard only when the summons are issued to them.

8. Mr. Grover stated that upon filing of the written statement certain facts were co-related and it was revealed that the defendant company had been associated with the plaintiff earlier and in fact was already a vendor of the plaintiff company albeit under its original mark '*SMART-E Delivery Services*'. The defendant had first approached the plaintiff in September, 2019 for seeking work and had been in communication with the employees of the plaintiff company. The facts reveal that the defendant was in fact using a different mark and shifted over to a mark deceptively similar to that of the plaintiff. He stated that

the plaintiff had *bona fide*ly missed to add this information to their cause of action clause and to make it stronger and to show the dishonesty of the defendant, the plaintiff company has filed an application under Order VI Rule 17 CPC wherein the plaintiff has sought to bring all such facts on record.

9. Mr. Grover also stated that as per the facts on record, the defendant company was in discussion with the plaintiff to become its vendor since September, 2019 and was coordinating various business proposals. According to him while the defendant continued business discussions with the plaintiff, the former surreptitiously adopted the mark  for identical services in the month of February 2020 and filed a trademark application under No. 4453232 in class 39 on February 25, 2020 and claiming use since February 17, 2020 for identical services. He stated that as per its reply to the O39 R4 CPC application, it is clear that, the defendant continued to be associated with the plaintiff and executed a vendor agreement dated March 18, 2020 and also did a pilot project in the month of March & April 2020 and issued two invoices bearing a mark 'SMART-E delivery services' and hence avoided direct confrontation with the plaintiff for using the impugned mark.

10. According to him, the defendant in its written statement, in paragraphs 6 and 31(d) admitted that it is in the delivery business since 2019 albeit under the trademark '*SMART-E Delivery Services*'.

11. It is apparent that the defendant changed its mark to  in May, 2020 after having adopted the same in February, 2020 only to come as close as possible to the business of the plaintiff and to earn profits in an illegal manner. It was his argument that such shifting of mark shows the *mala fide* intentions of the defendant. In this regard he placed reliance on the following judgments:

- i. ***Madhuban Holiday INN vs. Holiday Inn 2002 SCC Online Del 864;***
- ii. ***Ishi Khosla vs. Anil Aggarwal & Anr 2007 SCC Online Del 126;***
- iii. ***Midas Hygiene vs. Sudhir Bhatia & Others (2004)3 SCC 90***

12. On the averment made by the defendant that the plaintiff had deliberately concealed information related to the prior association of the plaintiff and the defendant even when an employee of the defendant company in an email dated May 26, 2020 directed towards the plaintiff company used the impugned mark '*DELIVER-E*', Mr. Grover stated there was no willful suppression as the concealment, so alleged would

not prejudice the defendant, rather the fact would have made the plaintiff's cause of action stronger. The reason, this fact could not be mentioned has been dealt with in the plaintiff's Order VI Rule 17 application which he stated was a *bona fide* error due to prevailing circumstances. If this information were to be incorporated in the plaint, the plaintiff would have additionally pleaded dishonesty in adoption. According to him, the plaintiff company has nothing to gain from not pleading this. He also stated that cause of action for the plaintiff had arisen much prior to the email dated May 26, 2020, wherein defendant's employee mentioned '*Smart-e*' / '*Deliver-e*' while being introduced to a third party by the plaintiff's employee; he stated that the concerned employee of the plaintiff company filed an affidavit stating that the said email was written in his personal capacity. In support of his arguments, Mr. Grover placed reliance on the following judgments:

- i. ***Vijay Solvex Limited vs. Saurabh Agrotech Private Limited 2016 SCC online Del 5028;***
- ii. ***Ansul Industries vs. Shiva Tobacco Company 2007 SCC Online Del 74***

13. Mr. Grover also opposed the stand of the defendant in its application that the plaintiff cannot restrain the use of a descriptive mark '*DELIVER-E*'. It was not the case of the plaintiff, as argued by Mr. Grover that the trademark of the plaintiff company is a generic word

'delivery' and neither is the case of the defendant that they are using the generic mark 'delivery'. He argued that the plaintiff also does not claim any right over the word 'delivery' used in a generic sense and that the trademark 'DELHIVERY' is different from the generic word 'delivery'. The plaintiff does not intend to stop anyone from using a generic and dictionary word 'delivery' without claiming any trademark rights.

14. He argued that the defendant cannot claim on one hand that the trademark 'DELHIVERY' of the plaintiff is 'descriptive' and on the other hand file an application for registration of the impugned mark 'DELIVER-E' with the Registrar of Trademarks No. 4453232 in class 39. Mr. Grover placed reliance on the documents filed along with the plaint to state that in the reply filed by the defendant to the examination report of its trademark application, it has claimed the impugned mark in the following manner:

"It is hereby submitted that the applicant is adopted the trademark "DELIVERE (Device)" a invented word in a very artistic manner in respect of Service namely..."

Mr. Grover placed reliance on the following judgments in this regard:

- i. ***Automatic Electric Limited vs. R.K. Dhawan &Anr 1999 SCC Online Del 27;***
- ii. ***Indian Hotels Company Limited vs. Jiva Institute of Vedic Science & Culture 2008 (37) PTC 468 (Del);***

iii. *Anil Verma vs. RK Jewellers SK Group 2019 SCC Online Del 8252*;

iv. *Telecare India Private Limited vs. Asus Technology Private Limited & Ors 2019 SCC Online Del 8739*.

15. He stated, without prejudice, at best the trademark of the plaintiff can be termed as '*Suggestive*', however according to him this Court in various proceedings have protected the statutory rights of the suggestive trademarks particularly when the adoption by the defendant is dishonest. In this regard he relied on the judgment in the case of *Anil Verma (supra)*.

16. It is his submission that plaintiff in its reply to Examination report has contended that the trademark '*DELHIVERY*' / its variants are structurally and phonetically dissimilar to the cited marks '*delivery*' / '*delivery with love and care*' / '*deliverymojo*', etc. He stated, the plaintiff does not claim any right against the word '*delivery*' whereas, to the contrary, the defendant had issued the invoices mentioning the mark '*Smart-E delivery services*' in March & April to the plaintiff and deliberately switched its mark and adopted a deceptive impugned mark whilst the defendant was a vendor with the plaintiff. He stated the defendant adopted '*DELIVER-E*' as a trademark and not as a descriptor. He also stated that the plaintiff in its reply to the said examination report has also mentioned that the plaintiff reserves its right to challenge the

legality of mark cited in the examination report on grounds available under law to the plaintiff. He placed reliance on the following judgments to state that it is a settled position of law that the reply to the examination report cannot be read against the plaintiff after the mark is registered:

- i. *Telecare India Private Limited (supra);*
- ii. *H & M Hennes & Mauritz AB &Anr. vs. HM Megabrand Pvt. Ltd. &Ors. 2018 SCC Online Del 9369.*

17. On the issue, that the trademark of the plaintiff 'DELHIVERY' is descriptive of its services, such as delivery of goods, transportation etc. and as such not liable to be protected, as it is hit by Section 9 of the TM Act, he stated that this issue ought not to be considered at this stage, in view of the statutory protection granted in favour of the plaintiff on the registered mark 'DELHIVERY' and its variants. He placed reliance on Section 31 of the TM Act to state that registration is '*prima-facie evidence of the validity thereof*'. Further, defendant cannot contend invalidity of the registration of the plaintiff's registered trademark especially in absence of any cancellation petition. He also stated that the plaintiff's mark is not descriptive, contrary to the stand taken by the defendant, as the plaintiff has conjugated the words 'DELHI' and

‘VERY’ which according to him is inherently distinctive conjunction and not an appropriation of a dictionary word.

18. In response to the stand of defendant that numerous third party entities are using the mark ‘*delivery*’ in prior point in time and using the marks like ‘*Delivery with Love and Care*’, ‘*Deliver Man*’, etc., Mr. Grover states that the plaintiff does not intend to stop the use of these marks and also, word ‘*delivery*’ in a generic sense and further, the said contention of the defendant is untenable in light of the following judgments of this Court:

- i. *H & M Hennes & Mauritz AB &Anr. (supra);*
- ii. *Telecare India Private Limited (supra);*
- iii. *Pankaj Goel vs. M/s Dabur India Ltd. FAO (OS) 82/2008 dated July 4, 2008 .*

19. On the stand of the defendant that it is only dealing with corporate clients such as ‘*FLIPKART*’ and ‘*MILKBASKET*’ and there are no individual clients of the defendant and hence there is no scope for confusion, Mr. Grover, argued that plaintiff is also dealing with corporate clients like ‘*FLIPKART*’. According to him, the defendant is providing identical services, to identical clients of the plaintiff and that there is scope for confusion and deception as even the corporate clients may associate the use of the impugned mark by the defendant as an

incidental or subsidiary mark of the plaintiff. On this issue, he referred to a judgment of a Coordinate bench of this Court in *South India Beverages vs. General Mills Marketing Inc. 2014 SCC Online Del 1953*.

20. The issue, whether the plaintiff has not filed any document or proof of any actual confusion amongst the buyers between the mark of the plaintiff and the impugned mark of the defendant, was countered by Mr. Grover by stating that the proof of actual damage is not required in cases of infringement. If there is likelihood of confusion, then injunction must follow. In this regard, he relied on the following judgments:

- i. *Century Traders vs. Roshan Lal Duggar 1977 SCC Online Del 50*;
- ii. *Laxmikant Patel vs. Chetanbhai Shah &Ors. (2002) 3 SCC 65*.

21. On the issue of whether the plaintiff has acquiesced to the use of the impugned mark by the defendant, as according to the defendant one employee of the plaintiff company, Harsh Bhatti wrote an email to an employee of the defendant company, in which the employee of the plaintiff has used mark 'DELIVERE-E', Mr. Grover's submissions are the following:

- a) The mail was sent on May 26, 2020 by Harsh Bhatti to another employee of the defendant (who himself was an erstwhile employee of the plaintiff) as a mere introduction to another company called E-Trio in his personal capacity.
- b) Such an email was beyond the scope of duties of the said employee, who has also filed an affidavit in support of such contention.
- c) The email is dated May 26, 2020 whereas the plaintiff has pleaded that the cause of action first arose in the third week of May, 2020 when the E-rickshaws of the defendant were seen by the employee of the plaintiff and hence such an email cannot in any manner be termed as acquiescence. Reliance was placed on a judgment of a Coordinate bench of this Court in the case of ***Hindustan Pencils vs. India Stationary Products Company 1989 SCC Online Del 34.***
- d) Reliance was also placed on the judgment of a Coordinate bench of this Court in ***Advance Magazine Publishers Inc. vs. Bombay Rayon Fashions Limited & Others 2017 SCC Online Del 10064,*** to argue that a mini trial is not appropriate at the stage of grant of interim injunction. He seeks the continuance of the interim order.

22. Mr. Chander M. Lall, learned Senior Counsel assisted by Mr. Vivek Dhokalia, Advocate appear on behalf of the defendant company. He has argued that there was deliberate non-disclosure of material facts and material defaults. A primary objection taken by Mr. Lall was that the plaintiff had not effected an advance service by email as required by the procedure uploaded on the website of this Court, at the time of filing the suit. The circular requires that all filings be done through the High Court e-filing web portal only, and mandates compulsory advance service by email to be made by plaintiffs to all defendants/respondents, irrespective of whether it is the Union of India / Delhi Government or Private party. It was his submission that despite the knowledge of this procedure, the plaintiff deliberately and in bad faith avoided advance service on the defendant by email and the plaintiff got the advantage of an *ex-parte* hearing and injunction.

23. He countered the explanation given by Mr. Grover that he did not have the email address of the defendant as false, as the plaintiff specifically mentioned the defendant's email address in the plaint as well as in documents. According to Mr. Lall, the plaintiff used the same email ID to comply with the requirement of Order XXXIX Rule 3 CPC after the July 03, 2020 order was passed. He argued that reliance placed on the order passed in District Court pursuant to a specific exemption

application filed by the plaintiff therein, is misplaced since the plaintiff has not filed any such exemption application seeking leave of Court and further the practice of other Courts cannot serve as a precedent from the mandatory nature of requirement of advance service by email.

24. Mr. Lall elaborated on the e-filing procedure to state that it would have been impossible for the plaintiff to not know the information regarding the advance service by email since plaintiff at the time of e-filing through the e-filing web portal, would have received an email and SMS with a link and upon clicking the link a document would have opened, which clearly mentions that advance service has to be made as per email, and a proof of advance service also must be attached.

25. He submitted that the plaintiff in addition to this also deliberately withheld the tracking report / delivery report of the Speed Post. The mandate of the Registry is for the delivery report to be produced to prove such service and a mere filing of a receipt showing dispatch is not sufficient.

26. Mr. Lall contested the submission of Mr. Grover that the plaintiff had effected service on June 29, 2020 by speed post, on the objections raised by the Registry. It is evident that the Registry *inter-alia* sought the tracking / delivery report from the plaintiff, which was not provided. The report available online, which if referred to, would

reveal that the service was in fact effected only via speed post on July 15, 2020 much after July 03, 2020, the date when the interim order was passed.

27. Mr. Lall had also argued that no proof of advance service has been placed on record despite the opportunity to do so, given to the counsel by this Court during the hearing of August 04, 2020; instead the plaintiff is now trying to escape blame by putting it on the Registry and blaming the defendant that it did not file a Caveat.

28. It was the case of Mr. Lall that *ex-parte* relief is an extraordinary relief in urgent matters and that no overwhelming urgency has been shown in the present case, as suit itself was filed 45 days from the pleaded cause of action.

29. It was the submission of Mr. Lall that the plaintiff acquiesced to the use of the mark by the defendant and hence should not be entitled to an injunction. He stated that the plaintiff deliberately failed to disclose the email dated May 26, 2020 exchanged between the parties wherein, the employee of the plaintiff company specifically refers to the mark '*DELIVER-E*'.

30. He also submitted that defendant has extensively used the trademark '*SMART-E*' since the year 2014 to the knowledge of the plaintiff and by concealing this information, the plaintiff withheld the

fact that the mark 'DELIVER-E' was inspired by the use of the mark 'SMART-E' belonging to the defendant itself with unique stylization, colour scheme, and the distinctive 'E' device. He stated that defendant's distinctive business proposition is the use of electric vehicles for its passenger and last mile goods delivery services, and the 'E' device connotes this proposition.

31. He argued that the attempt of the plaintiff in the plaint is to state, that the defendant just started to use the mark 'DELIVER-E' including the distinctive 'E' device without any prior business / use, is false. He stated that as per the record, the plaintiff was aware of the use of 'SMART-E' including the 'E' device and it was actually in negotiations since September 2019 with the defendant to provide last-mile goods delivery services to the plaintiff for the purpose of which two pilot projects had admittedly been done by the defendant in March and April 2020.

32. As per Mr. Lall, non-disclosure of several third-party registrations / applications for marks with the word 'DELIVER' / 'DELIVERY' is fatal. The plaintiff by not putting this information was able to create an impression that it is the only party in the field using the descriptive word 'DELHIVERY' as a trademark and to *prima-facie* claim that it had exclusive rights to the said descriptive word.

33. He stated that the plaintiff deliberately concealed from this Court that while seeking registration of its mark '*DELHIVERY*' several third party marks were cited by the Trademark Registry as being similar to the mark of the plaintiff. The response given by the plaintiff to each of the marks cited by the Trademark Registry was that the rival marks are to be compared as a whole and that the cited marks are totally dissimilar. Some of these cited marks were:



S.No.	Mark	Number
1.	Deliver with Love and Care	1563717
2	Delivering Trust	2004840
3.	Delivery 2 All (Device)	2480222
4.	Deliver (Device)	2737927
5.	Delivering Happiness	2206806
6.	Delivering Maharashtra	2751315
7.	Delivering Joy	1256687
8.	Delivery one	1400176

34. It was the submission of Mr. Lall that the effect of the said stand taken by the plaintiff before the Trademark Registry is that the plaintiff has accepted its own mark '*DELHIVERY*' and the other '*DELIVER*'

formative marks cited by the Trademark Registry are visually and phonetically different, and its assertion now that it has exclusive right to the dictionary word 'DELIVERY' / 'DELIVER' itself is contrary to its position before the Trademark Registry and it is completely untenable. This non-disclosure, Mr. Lall contended of material admission made by plaintiff before the Trademark Registry gave the plaintiff an advantage to successfully argue that the impugned mark 'DELIVER-E' was 'deceptively similar' to its mark 'DELHIVERY' as alleged in the plaint, and thereby obtained the unfair advantage of an ex-parte ad-interim injunctive order against the defendant, which is liable to be vacated in view of this non-disclosure. In this regard he has placed reliance on a judgment of the Supreme Court in the case **Ramjas Foundation &Anr. vs. Union of India &Ors. (2010) 14 SCC 38.**

35. In substance Mr. Lall's arguments are that plaintiff did not disclose the following, at the time they pressed for interim orders:

- I. The advance service upon the defendant by email was necessary and mandated, which the plaintiff bypassed;
- II. That the plaintiff withheld the tracking report / delivery report of Speed Post;
- III. The email dated May 26, 2020 by an employee of the plaintiff using the defendant's mark amounts to acquiescence;

IV. That the defendant extensively used the mark  and that the mark  is inspired by the former and among other features also bears the distinctive 'E' device;

V. The Non-disclosure of several third-party registrants of the mark with the word 'deliver' / 'delivery'.

36. Mr. Lall argued on merits, wherein he contended that the allegation in the plaint is that the impugned mark is 'deceptively similar' (i.e. phonetically and structurally similar) to the plaintiff's mark and that the unaware customers are bound to be confused / deceived and that the impugned mark has been dishonestly adopted is misconceived as there is no similarity between the two rival marks and that there is no likelihood of confusion. In this regard, he relied on section 2(h) of the TM Act wherein 'deceptive similarity' has been defined to contend two parameters need to be fulfilled before the marks are held to be 'deceptively similar', (1) there must be such close resemblance between them; (2) that it is likely to lead to confusion. He has, in support of his submission of no deceptive similarity, placed reliance on the judgments of *Kaviraj Durga Datt Sharma AIR 1965 SC 980* and *SBL vs. Himalaya Drug Co AIR 1998 DEL 126*.

37. He stated that when such a comparison is done taking into account the aforesaid standard it can be clearly seen that there is no similarity between marks of the parties, let alone deceptive similarity. He relied on the chart below, to show that the marks are dissimilar.

Plaintiff's Mark	Defendant's mark
	
	
DELHIVERY	DELIVER-E
	
	
	
	

He also stated that there is no visual or structural similarity between these marks and as far as phonetic similarity is concerned, the plaintiff's mark has two syllables 'DELHI' and 'VERY' which are well known

English words and the whole mark is pronounced as 'DELHI'- 'VERY'. Whereas, the defendant's mark consists of two syllables 'DELIVER' and 'E' and the whole mark is pronounced 'DELIVER-E'. According to him, while the underlying word in both the marks is the dictionary word 'delivery' the pronunciation of each is different. It was his submission that both the marks also give out a completely different meaning. One relates to the capital city of India combined with the word 'VERY' and the other relates to delivery of services through E-vehicles only. Given the dissimilarity between the rival marks the very first parameter required by section 2(h) of the TM Act is not satisfied and therefore, there would be no question of infringement or passing off. He placed reliance on the judgment in the case of *Amritdhara Pharmacy vs. Satya Deo Gupta AIR 1963 SC 449*.

38. Mr. Lall also elaborated on the law/principles laid down by the Courts in order to determine 'Confusion' which itself is the second parameter for determination whether the marks are deceptively similar:-

- a) The class of customers is to be considered, who usually deal with such goods and services in *SBL vs. Himalaya Drug Co (Supra)* it was held that the likelihood of a person usually dealing with the one, being misled to accept the other, if offered to him would be enough.

- b) A Customer is to be considered as a person of average intelligence and imperfect recollection. *Amritdhara (Supra)* wherein it was held that, whether two marks give rise to confusion or similarity, the issue would have to be approached from the view of a man of average intelligence and imperfect recollection and not unusually stupid, idiots or fools.
- c) Regard must be placed on practical and ordinary probabilities and not hypothetical possibilities as applied to the circumstances of an individual case as held in *SBL vs. Himalaya Drug Co (Supra)*
- d) The public tends to pay more attention to the other features of the respective marks and to distinguish between them by those features as was held in the case of *SBL vs. Himalaya Drug Co (Supra)*.

39. Mr. Lall argued assuming without admitting, that if there is some phonetic similarity, even then the second ingredient of deceptive similarity as required by section 2 (h) of the TM Act i.e. 'confusion' is not satisfied at all. The reason for this, he points out in the defendant's O39 R4 application, is that all the customers of the defendant are 100% corporate customers only who are aware about business and are provided with services only after contracts are signed by each of the

parties under their respective business names. Even the pilot project of the plaintiff was done by the defendant only after signing a contract. In other words, the defendant does not have any customers who could get confused; since it does business only with corporate clients and the defendant has not felt any need to advertise its goods and delivery business. Mr. Lall referred to the principles as laid down by the Courts to say that the matter is to be seen '*practically*' which goes to show that the question of any confusion does not reasonably arise.

40. Mr. Lall stated that it must be noted that; (i) both the marks are an adaption of the descriptive word '*delivery*'; (ii) that both the parties are engaged in providing delivery services (although, the defendant is engaged in last mile connectivity); (iii) and that plaintiff has combined two commonly used words whereas, the defendant uses the word '*Deliver-E*' with the '*E*' device to indicate use of electric vehicles. In this regard, he elaborated on the principles as laid down by the Courts in case of descriptive marks:

A. No monopoly can be taken in ordinary dictionary words which are used as '*marks*' and are descriptive of the business. In other words, no exclusive ownership can be granted to any one person of these descriptive words and that these cannot be '*misappropriated*' by anyone and that they are open for use to

all traders in the relevant trade. In this regard he placed reliance on the following case laws:

- i. ***Superon Schweisstechnik India Ltd vs. Modi Hitech India Ltd [Order dated April 02, 2018 in CS(COMM) No. 750/2018];***
- ii. ***Cadila Healthcare vs. Gujarat Cooperative Milk Marketing Federation Ltd. and Ors. 2009(41) PTC 336 (Del);***
- iii. ***Marico Limited vs. Agro Tech Foods 174 (2010) DLT 279;***
- iv. ***Bharat Biotech International Ltd. vs. Optival Health Solutions Pvt. Ltd. 2020 SCC Online Del 852.***

B. Even the registration of a descriptive word does not bar others in the same trade from using it because the rights granted pursuant to the registration are as per Section 28 of the TM Act, subject to the other provisions of the TM Act, reliance was placed on *Marico (supra)*. These 'other provisions' to which a registration is subject to are:

- i. Sections 9(b), 30(2) and 35 of the TM Act which, respectively provide that if the registered mark is inherently descriptive of the nature of the goods i.e. if it shows the kind or intended purpose or is a *bona fide* description of character or quality of goods, then the registered proprietor cannot have exclusive right to use

such mark and he cannot stop others from using the same;

ii. As per *SBL vs. Himalaya Drug Co. (Supra)* he stated, Sections 36(1) and 36(2)(b) of the TM Act which, provides that if subsequently after registration, the mark becomes descriptive of the goods in question then the exclusive rights of the registered proprietor pursuant to registration, cease and the mark becomes, open to use by all persons engaged in the trade.

C. As per *Cadila (supra)* he stated even if there is some evidence of secondary meaning attached to descriptive marks, it cannot preclude other traders in the same business from using the word as a trademark.

D. As per *Marico (supra)* it was submitted by merely tweaking or modifying an ordinary descriptive word and calling it a coined mark, a proprietor cannot get exclusive rights therein. Allowing a proprietor to get exclusive rights by tweaking will lead to a grave and absurd situation and such a position cannot be countenanced and must be put down with a heavy hand. Mr. Lall stated that the plaintiff in the instant case is guilty of

tweaking / modifying the word '*delivery*' just by adding the alphabet '*H*' to the word.

E. As per *Marico (supra)* and *Cadila (supra)* he stated, when a person decides to use a mark, there is some inherent risk of confusion, but no cause of action arises because by adopting such a word as a trademark or a part thereof, the person implicitly agrees to live with a certain risk of confusion.


41. Mr. Lall argued that, as the word '*delivery*' lends itself to another meaning except its ordinary lexical one, it being descriptive, no monopoly can be granted therein in relation to the '*delivery*' business. He argued that the plaintiff's mark is descriptive of the delivery business, the mark is common to delivery trade as is evident from the evidence of such third party use and third party registrations filed by the defendant. These facts he stated were admittedly known to the plaintiff in view of its own online searches but were concealed.

42. According to him, it was for this reason that even the Trademark Registry did not cite the plaintiff's mark as conflicting while examining the third party '*delivery*' formative marks; because '*DELHI*' '*VERY*' mark of the plaintiff is so close to the descriptive word '*delivery*' the registration of '*DELHIVERY*' by plaintiff will not restrict third party use of marks which are similar to the descriptive word '*delivery*' or

'*deliver*'. In this regard he placed reliance on the judgment of the US Supreme Court in the case of *US PTO vs. Booking.com*.

43. Mr. Lall argued that if the injunction granted is not set aside, it would amount to giving the plaintiff exclusive monopoly over a dictionary word '*delivery*' which is descriptive of the goods delivery business and all such words derived from the dictionary. This would have the effect that only the plaintiff would be allowed to have trademarks derived from this descriptive word which is impermissible.

44. It was the case of the defendant, that in light of the law discussed above, the exclusive rights of the plaintiff are limited to the mark '*DELHIVERY*' only as registered by it; which it was argued would also become clearly evident from the response to the examination reports of the plaintiff to the Trademark Registry and it cannot now seek to expand the monopoly by seeking orders to restrain the use of the dictionary word '*deliver*' in other forms by others such as defendant. In this regard, he placed reliance on a judgment of the Bombay High Court in the case of *People Interactive (India) Pvt. Ltd. vs. Vivek Pahwa & Ors. 2016 (68) PTC 225 (Bom)*. He argues that this argument would also be applicable to the defendant, and the defendant does not claim any right over the word '*deliver*' and its rights shall be limited to the stylized

mark  as applied which, as he reiterates is completely distinct from the mark of the plaintiff.

45. Mr. Lall distinguished the cases as cited by the plaintiff on the following basis:

- a. The case of *Madhuban Holiday INN (supra)* would have no relevance to the facts of the present case for the reason that the Court had held that, 'Holiday Inn' had been coined by the respondent and is descriptive of the business of the respondent (therein) only. The finding was on the argument that 'Holiday Inn' was an ungrammatical combination of two words which had not previously been associated together. The court relied on the McCain International case where the terms 'Oven Chips' were also held to be distinctive on the same logic. It was argued that there was no parity to the current case as 'DELHIVERY' is purely a descriptive word and cannot be termed as a coined word like 'Holiday Inn' in that case the defendant had used the exact trademark 'HOLIDAY INN' with a prefix 'Madhuban'.
- b. The case of *Ishi Khosla (supra)* was relied on wherein it was held that the concept of 'Whole Foods' used by the plaintiff (therein) is different from the meaning of the term 'Whole Foods' as per the English dictionary and that in that case the



defendant had also used identical words '*Whole Foods*'. According to him, this case is also not relevant to the case at hand. He argued that both the marks of the plaintiff and the defendant consist of two syllables i.e. '*DELHI*'- '*VERY*' and '*DELIVER*'- '*E*' respectively. Hence phonetically also there is a lot of difference.

- c. Even the judgment in *Ansul Industries (supra)* also would have no relevance to the present proceedings as the Court held in paragraph 53 of the said decision that the word '*Panchhi*' is not related to tobacco and is not descriptive in the tobacco industry. It was argued that even if the word '*delivery*' is to be given exclusivity as asserted by the plaintiff, then the plaintiff would not be the first registrant and there are several registrants of a mark in which '*delivery*' is the most prominent part.
- d. It was argued that the case of *H & M Hennes & Mauritz AB (supra)* wherein, the Court had held that none of the similar marks on the register of Trademarks were in a business even remotely associated with the business of the plaintiff (therein) and therefore it was held that there was no estoppel against the plaintiff (therein). However, in the present case there are several

third party registrants of 'DELIVER' / 'DELIVERY' marks on the Register of Trademarks.


- e. *Telecare India Private Limited (supra)* would also have no applicability here, as the mark in issue there was 'ZEN' which was not a descriptive word. In the present case, the plaintiff made a categorical statement before the Registrar of Trademarks that its mark 'DELHIVERY' is different from 'DELIVERY' and therefore the plaintiff cannot now take a stand that 'DELHI'- 'VERY' and 'DELIVER' - 'E' are similar.
- f. In the case of *Anil Verma (supra)* the test for suggestiveness and descriptiveness of marks was set out as the '*the degree of Imagination test*' and the '*need of competitors test*' have to be applied in facts of each case in order to adjudicate as to whether a particular mark describes the quality or characteristics of the product or service or is merely suggestive of the products or services offered. He argued that in the present case, the term 'DELIVERY' is completely descriptive of delivery services can be gauged from the assertions in the plaint itself, the plaintiff describes its services as '*Delivery Fulfillment services*' and in paragraph 2 its services are described as '*delivery operations service provider*'.

g. In the case of *Pankaj Goel (supra)* the expression 'MOLA' which was common in the rival marks and third party marks was not a descriptive expression and it was held that the use of 'MOLA' by third parties would have to be established by evidence. In the present case, according to Mr. Lall, 'deliver' is a completely descriptive word in relation to delivery services.

46. It was Mr. Lall's argument that the defendant has been using the mark  since 2014 in relation to cost effective three-wheeler vehicles and said mark for passenger service has become widely recognised amongst customers in the last 6 years and the defendant now has fleet of over 1000 vehicles which ferry over 1 lac passengers every day. It was his submission that the defendant with a view to expand into last mile goods delivery / logistics / business, the defendant started pilot projects of business for a few potential clients in early 2019, using its three-wheeler electric vehicles, but without using any mark. Since the defendant started receiving a good response to such pilot projects, the defendant adopted and started using in February 2020 the mark  for its said goods delivery business using electric vehicles.

47. Insofar as the contention of Mr. Grover that the defendant was in the goods delivery business since 2019 under the mark 'SMART-E' and switched over in mid-February 2020 to impugned mark 'DELIVER-E'

after noticing the huge goodwill attached to the plaintiff's mark, pursuant to interactions with the plaintiff is concerned, he denied the same as there is no record filed to show that the defendant was in the goods delivery business in 2019 under 'SMART-E' mark. He stated that the defendant was carrying on the passenger service and it started the goods delivery business under the impugned mark only in February 2020. In other words, since the defendant never used the mark 'SMART-E' for its delivery business, the question of switching from 'SMART-E' to 'DELIVER-E' does not arise.

48. Mr. Lall while arguing that the adoption and use of the mark  for the reasons stated is completely honest and *bona fide* and the impugned mark i.e. 'DELIVER' with a distinctive suffix 'E' device was adopted because the word 'delivery' is descriptive of goods delivery business and appeared to be common to the delivery trade and hence not objectionable.

49. According to him, the plaintiff is trying to misappropriate exclusively for itself the descriptive word 'delivery' which shows *mala fide* and bad faith. He placed reliance on *Marico (supra)* along with *Godfrey Philips India vs. PTI Pvt. Ltd. CS (COMM) 851/2017, order dated December 12, 2017* to state that commercial morality principle is

not only applicable with respect to the defendant in a suit but is also equally applicable to the plaintiff.

50. Another argument advanced by Mr. Lall is that there is no evidence on record to support the argument of 'secondary meaning' made by the plaintiff. He stated that, the term secondary meaning has been explained by Courts to mean that the mark is only associated with the goods of the plaintiff and nobody else in the minds of the customers. In this regard he cited the judgment in the case of **Big Tree Entertainment vs. D. Sharma 2019 SCC online Del 6652** along with the judgment of the Supreme Court in the case of **Laxmikant V Patel vs. Chetanbhai Shah (supra)** wherein the Supreme Court held that it would be essential to the success of any claim for passing off based on use of given mark, that the plaintiff should be able to show that its mark has become by user, distinctive of plaintiff's goods so that the use by a third party in relation to similar / same goods would be understood by the public as meaning that the goods are that of the plaintiff. Additionally, he placed reliance on **Godfrey Philips India (supra)** to state that the plaintiff must first show exclusive co-relation of the trademark with the goods of the plaintiff i.e. the public associates the mark only and only with plaintiff's goods so that when the goods of the defendant are

purchased, the customer does so with the belief that they are buying the goods of the plaintiff.

51. He also took a stand that the suit is without a legal basis as the signatory has no power to institute the suit and sign pleadings. He stated that at page 5 of the plaintiff's documents, the signing power is limited to legal notices, authorization letters, termination notices, replies to legal notices only and that this issue is not a mere technical defect but rather, the plaintiff has been aware of this since July 30, 2020 when the defendant filed its written statement.

52. In his rejoinder arguments Mr. Grover reiterated the stand taken by the plaintiff in the pleadings made in the plaint as well as the averments made in the accompanying applications and differentiated the cases relied on by the defendant in the following manner:

- a) According to Mr. Grover the judgment in the case of ***Bharat Biotech International Ltd. (supra)*** can be distinguished from the facts of the present case on the grounds that (i) the defendant (therein) did not file any trademark application for the impugned mark and therefore was not covered by ***Automatic Electric (supra)***; (ii) that the word 'TCV' *per se* was not used by the plaintiff (therein) and (iii) the plaintiff in the said case did not

plead that the mark acquired any secondary significance in the
plaint, unlike in the instant case.

- b) The case of *Cadila (supra)* he stated could be distinguished on
the ground that the defendant (therein) claimed to use the mark
'*Sugar Free*' only in a descriptive sense and not as a trademark
as relied in *Automatic Electric (supra)*. It was his submission
that this Court did not set aside the injunction but only varied it
to allow the use of the mark '*sugar free*' to denote special
attribute of its products to be free from sugar and which was to
be used along with house mark '*AMUL*'. The use of '*sugar free*'
was allowed as a part of a sentence or a catchy legend.
- c) The case of *F. Hoffmann-La Roche & Co. Ltd vs. Geoffrey
Manners & Co. Pvt. Ltd (1969) 2 SCC 716* could be
differentiated as the Supreme Court held the mark '*Dropovit*' to
be an invented word. The case of *Micronix India vs. Mr. J.R.
Kapoor 2003 SCC Online Del 475* according to Mr. Grover,
would not be applicable to the present facts, as part of the mark
'*MICRO*' was held to be a descriptive term with the state of the
art technology and this case could also be differentiated on the
grounds that since the parties (therein) were partners in a firm
M/s. Micronix and was dissolved by way of a compromise deed

in which the registered trademark was taken in favour of the plaintiff (therein).

- d) He went on to argue that the case of *Marico (supra)* could also be differentiated as the defendant claimed to use the mark 'LOW-ABSORB' only in a descriptive sense and not as a trademark as held in *Automatic Electric (supra)*.
- e) *People Interactive (India) Pvt. Ltd. (supra)* as per Mr. Grover would not be applicable to the facts of the instant case as the Bombay High Court in that case considered the aspect whether the use of everyday words like 'Shaadi' could be monopolised or not.
- f) Mr. Grover stated that the case of *Kaviraj Durga Datt Sharma (supra)* would be distinguishable from the instant case as the Supreme Court had in paragraph 28 observed that; (i) there was a difference between infringement and passing off remedies; (ii) added material may be a defence in passing off but not in case of infringement and; (iii) if the mark of the defendant is visually and phonetically similar, then no further evidence would be required to show that the rights of plaintiff are violated.
- g) *Ramjas Foundation &Anr. (supra)* could also be distinguished according to him as the Supreme Court in paragraphs 30 and 31

held that notwithstanding the issue of concealment, it would be proper to deal with the issue in appeal on merits and the appeal was dealt with on merits.

h) It was his submission that the case of *US PTO (supra)* was also distinguishable as the Supreme Court of United States of America protected the website of booking.com and booking.com conceded to the fact that it was a weak and descriptive trademark, they also accepted that close variation is unlikely to infringe its mark; booking.com also conceded that it would not prevent competitors from using the word '*booking*' to describe its own services.

FINDINGS / CONCLUSIONS:

53. Having heard the learned counsel for the parties, the first issue that needs to be decided is whether the interim order dated July 03, 2020 needs to be vacated on the ground of non-service of the plaint on the defendant by the plaintiff through e-mail. The plea of Mr. Lall was that despite having the e-mail IDs, the plaint was not served on those e-mail IDs intentionally only to get advantage of an *ex-parte* interim order to the prejudice of the defendant.

54. There is no dispute that the plaint and documents were sent to the defendant through speed post on June 29, 2020 on the address with the

exact pin code as finds mention on the application of the defendant before the Registrar of Trademarks. It is seen that it is the practice with the Registry of this Court, that by drawing a presumption that a speed post reaches the addressee within three days, the matter is listed before the Court immediately thereafter.

55. After the matter was reserved for orders, I enquired from the concerned Registrar on the procedure followed by the Registry for listing a fresh matter. According to him, the Registry insists on one mode of service either speed post or e-mail. In this case, the speed post having been sent on June 29, 2020 the matter was listed before this Court on July 03, 2020. So, it follows that the service through e-mail was not a requirement and was also not insisted upon by the Registry as the advance service was effected through speed post on June 29, 2020.

56. It also cannot be said that not effecting advance service on the defendant was intentional to get advantage of an *ex-parte* hearing.

57. In view of my above conclusion, it is not necessary to go into the other submissions made by the counsel for the parties and also the judgments referred by them in support of their submissions.

58. Now, coming to the merits of the submissions, on the interim order dated July 03, 2020, the submission of Mr. Grover, was primarily that the mark '*DELHIVERY*' was coined in the year 2008 and the plaintiff

has been using it continuously and extensively since the year 2011 for its logistics and transport management. He highlighted the number of orders completed and the monies earned thereto in the year 2019-2020.

59. Mr. Grover's submission was that the mark '*DELHIVERY*' is a combination of two words '*DELHI*' and '*VERY*'. According to him, it is neither a generic word nor a descriptive word but a coined word and the registration has to be seen as a *prima-facie* evidence of its validity.

60. On the other hand, Mr. Lall stated that the defendant's trademark '*DELIVER-E*' comprises of the dictionary word '*deliver*', which is accompanied by a suffix '*E*'.

61. It is a conceded position that the plaintiff has registrations in the mark '*DELHIVERY*' and its variants, whereas the defendant does not have registration in the mark '*DELIVER-E*'. No doubt, registration of a mark in favour of the plaintiff confers rights as per Section 28 of the TM Act, however, the rights of a registered trademark holder are not absolute, inasmuch as both Sections 28 and 29 are subject to exceptions carved out to infringement of trademark.

62. It is also a settled law that a mark can either be phonetically or visually similar and has to be seen disjunctively and not conjunctively. It is also a settled law that whether two marks are deceptively similar, has to be seen from the perspective of an unwary purchaser of average

intelligence and imperfect recollection (Re: *AIR 1963 SC 449 Amrit Dhara Pharmacy vs. Satyadeo Gupta*).

63. Having said that, the attempt of Mr. Grover is to read the term / mark 'DELHIVERY' by separating them as 'DELHI' and 'VERY'. In other words, the mark 'DELHIVERY' is different from the generic word 'delivery' and the plaintiff does not intend to stop anyone from using the word 'delivery' in a generic sense.

64. According to Mr. Grover, there is no justification for the defendant to adopt and use the impugned mark 'DELIVER-E' or any other mark, which is identical or deceptively similar to the registered mark of the plaintiff, 'DELHIVERY' in respect of identical or related services.

65. The above submissions of Mr. Grover are contradictory and not appealing. This I say so, being a coined mark 'DELHI' 'VERY' and not the generic word 'delivery', there can't be any comparison with the mark 'DELIVER-E' as the origin of the marks are different. But the fact, Mr. Grover's submission is that the mark 'DELIVER-E' is deceptively similar to the plaintiff's mark 'DELHIVERY' it becomes clear that the attempt of Mr. Grover is to relate the plaintiff's mark to the generic word 'delivery', which is a simple English dictionary word meaning of which is '*the act of taking goods, letters etc to the people they have been sent*'. In fact, the services so offered, are for delivery of goods ordered by consumers from

e-commerce websites, so the mark signifies such services. Further, the mark 'DELHIVERY' if pronounced in a routine manner shall mean 'delivery' and being a generic word, cannot be registered as a trademark.

66. The attempt of the plaintiff is to tweak the word in the English language, which is clearly impermissible. Similar is the position with regard to the mark 'DELIVER-E' coined by the defendant, which also if pronounced in a routine manner means 'delivery'. In fact, Mr. Lall concedes to the fact that the underlying word in both the marks is the dictionary word 'delivery'. The plea that the pronunciation is different cannot be accepted. The plaintiff and defendant had only added / substituted one alphabet each to their marks to contend that the pronunciation is different. The plaintiff has added the alphabet 'H' in the word 'delivery' and the defendant has replaced the alphabet 'Y' with 'E'. In any case, the marks phonetically are the generic English word 'delivery'. The position of law is well settled that a generic word cannot be registered, that is, a generic word cannot be appropriated by one party to the exclusion of others. It is rightly stated by a Coordinate bench of this Court in *Parveen Kumar Jain vs. Rajan Seth and Ors.* 2019 SCC Online 8499 if the registrations are wrongly granted when applied for in respect of a completely generic expression, the Court cannot ignore the generic nature of marks and confer monopoly on the same in favour of any party.

In this regard, I may note the position of law laid down by this Court in

SBL vs. Himalaya Drug Co (Supra):

“19.1... that 'LIV' is an abbreviation of liver. This abbreviation has been used in over 100 registrations as a constituent of the name under which the products relating to treatment associated with liver in the field of medicinal and pharmaceutical preparations - Homoeopathic and Ayurvedic are being marketed. The work 'LIV' is, therefore, generic and common to trade as describing the medicines associated with the treatment of liver. It has become public juris. In the field of medicines and pharmaceuticals, it is common practice that the drugs are named either by the name of the organ which it treats or by the principal ingredients or the name of the ailment. This enables a doctor to associate a particular trade name with the organ, ingredient or ailment, thereby reducing chances of error. No trader can therefore restrain another trader from using the description of the organ, ingredients or ailment. The learned counsel has cited a host of authorities in support of his submission that a word or its abbreviation having become public juris ceases to be subject matter of proprietorship, also ceases to be source of deception or confusion for the person likely to deal with such goods would ignore the public juris and go distinguishing the products by the prefixes and/or suffixes.

(Emphasis supplied)

67. The High Court of Bombay in the judgement in the case of

People Interactive (India) Pvt. Ltd. (supra) had held as under:

“11..... Miller Brewing Company v. G. Heileman Brewing Company Inc. and noted the 'spectrum' of degrees of distinctiveness: (1) generic or commonly descriptive; (2) merely descriptive; (3) suggestive; (4) arbitrary or fanciful. Generic or commonly descriptive words - examples such as 'necktie', 'plastic', 'soda', 'perfect', 'best', 'No.1' come to mind - are used to name or describe the goods in question. These can never become trade marks on their own. They never acquire distinctiveness or a secondary meaning. They do not tell one man's goods from another's. They do not indicate origin. An expression in the

second category, a merely descriptive term, is often used to describe some particular characteristic or ingredient: 'airtight', perhaps. Ordinarily, even these are not registrable unless they have acquired a secondary meaning and refer exclusively to one particular trader's goods.....

12. The degree of distinctiveness, and, therefore, the possibility of registration as a trade mark, is inversely proportional to the degree of obviousness: the more obvious the word, the less the degree of distinctiveness and the chances of its registration. I use the word 'obvious' here to mean not 'evident' but commonplace.

13. Words in everyday language, words of the common tongue are not to be allowed to be monopolized. Expressions that find themselves at the lower end of this four-position fretboard cannot easily be shifted higher up the scale. To make that ascent, it will not do to misspell the word. That, it is settled, is of no aid to the applicant. Indchemie discusses this aspect of the law.

19. The claim in the plaint is, thus, for exclusivity over 'shaadi'. But this falls within the first Indchemie/Miller Brewing class of generic or commonly descriptive words. This is the lowest end of the distinctiveness spectrum; and, absent other proof, it is entirely immobilized, incapable of moving anywhere further up that scale. Shaadi is nothing but generic: it refers to marriage, not bicycles, pressure cookers or potato chips. I think it is wholly incorrect to take a generic or commonly descriptive expression as part of a mark, and then, by this process of deconstruction, lift the generic expression out of the mark, claim that it is 'prominent' or 'essential' or 'leading', and then lay claim to an exclusivity it could never have had if used on its own. This seems to me to be a roundabout way of trying to achieve that which is impossible to begin with.....

(Emphasis supplied)

68. I have in the judgement of ***Bharat Biotech International Ltd.***

(*supra*) made the following observations:

“61. Having noted the position of law and drawing inference from the above mentioned judgments, in the case in hand the main mark of the plaintiff is 'TYPBAR-TCV' with 'TCV' being generic abbreviation/acronym of 'Typhoid Conjugate Vaccine' which is not a coined word and being common to trade as such, needs to be excluded for comparison with 'ZYVAC' of the defendant. On such exclusion what remains is 'TYPBAR' of plaintiff and 'ZYVAC' of defendant No. 2. These are the essential features of the marks of the parties and not 'TCV'. From the comparison of these two marks, there is no deceptive similarity between the two and as such there is no reasonable probability for confusion between the words either visually or phonetically. That apart, the reliance placed by Mr. Sapra on Cadila Healthcare Limited v. Dabur India Limited, (1997) 17 PTC 417, wherein it is held that where suffix is common, the earlier portion of the word is natural, necessary and in fact, the actual mark of distinction is justified.

(Emphasis supplied)

69. A Coordinate Bench of this Court in the judgement of **Parveen Kumar Jain (Supra)** has held as follows:

“8. The Court today is considering the question of whether any interim relief is liable to be granted in favour of the Plaintiff. There is no doubt that the Plaintiff does have registrations for the marks 'CHUR CHUR NAAN' and „AMRITSARI CHUR CHUR NAAN“. The registrations thus confer exclusive rights as per Section 28 of the Act. However, the rights of a registered trademark holder are not absolute inasmuch as both Section 28 & 29 are subject to the exceptions carved out to infringement of registered trademarks. Under section 35 of the Act if there is bona fide description of the character or the quality of the goods or services, there cannot be infringement of a registered trademark.

10. it is the common practice in the trade for food outlets to use names such „Chandni Chowk Ke Mashoor, Dilli Ke Mashoor, Delhi Walo Ki Mashoor” etc., The same are very common to the trade and are used by a large number of parties as is evident from the entries from third party websites which are placed on record. Thus, there cannot be any monopoly on the terms 'CHUR CHUR NAAN' and 'AMRITSARI CHUR CHUR NAAN' as the same are generic.

12. The said expressions, at a later stage, could even be disclaimed as they are so generic. Moreover, both in Jiva Institute (supra) and Automatic Electric (supra) the argument of the Defendants therein was that the marks were descriptive. In the present case, the issue is that the expressions are completely generic. If registrations are wrongly granted or applied for in respect of completely generic expressions, the Court cannot ignore the generic nature of the marks and confer monopoly on the same in favour of any party.”

(Emphasis supplied)

70. I may at this stage also refer to and reproduce the following observation of the Division Bench of this Court in *Marico (supra)* wherein, this Court has deprecated the attempt, to tweak a generic word to gain, monopoly in a trademark:

“15...We will now examine the issue whether the expressions "LOSORB" or "LO-SORB" have achieved a secondary meaning even if "LOW-ABSORB" may not have. On this aspect one immediately feels that it is an aspect of concern with respect to the claim of the plaintiff that if partly tweaked descriptive words and expressions of English language are claimed to be coined words, the same would result in a grave and absurd situation because a non-tweaked word being a completely descriptive word will in fact be deceptively similar to the tweaked descriptive English language word or expression of which

registration is obtained. Meaning thereby that because of success in getting registered a minor modification of a descriptive word or expression of the English language, a person who gets registration can prevent a purely descriptive use of a normal word or expression as found in English language dictionary on the ground that it would be identical with or deceptively similar to a registered trademark- a position which is found in the present case. Such a position, in our opinion, cannot at all be countenanced and must be struck down with a heavy hand.

(Emphasis supplied)

71. I may also at this stage, deal with the submission of Mr. Grover that the defendant, itself having applied for registration of mark 'DELIVER-E' with the Registrar of Trademark, cannot plead that the mark 'DELHIVERY' is a descriptive word. The plea of Mr. Grover, looks appealing on a first blush but on a deeper consideration, when I have held the mark 'DELHIVERY' being phonetically the generic word 'delivery', cannot be registered, this plea of Mr. Grover is liable to be rejected.

72. Mr. Grover has in support of his submission relied upon the judgment of this Court in *Automatic Electric (supra)* and *Indian Hotels Company Limited (supra)*, but I find that in a recent judgment in the case of *Parveen Kumar Jain (supra)* a Coordinate Bench of this Court has by referring to the aforesaid judgments in paragraph 12, stated as under:

"12. The said expressions, at a later stage, could even be disclaimed as they are so generic. Moreover, both in *Jiva Institute (supra)* and *Automatic Electric (supra)* the argument of

the Defendants therein was that the marks were descriptive. In the present case, the issue is that the expressions are completely generic. If registrations are wrongly granted or applied for in respect of completely generic expressions, the Court cannot ignore the generic nature of the marks and confer monopoly on the same in favour of any party.”

(Emphasis supplied)

73. I am in agreement with the aforesaid conclusion of the Court. The said conclusion clearly applies to this case in view of my conclusion that the mark ‘DELHIVERY’ is phonetically a generic word. In substance, the conclusion is that there is no estoppel against law, unless a generic word is held to be distinctive, which in any case is a matter of trial. It is a settled law that at this stage the court shall not conduct a mini trial as held in the judgment of this Court in the case of *Advance Magazine Publishers Inc (supra)*. The submission of Mr. Grover that the mark ‘DELHIVERY’ has achieved distinctiveness as the plaintiff has been using the mark ‘DELHIVERY’ since 2011 and has high sale figures; I am afraid, these two aspects are not conclusive to hold that the mark has attained distinctiveness. In this regard, it is appropriate to reproduce the following paragraph of the judgment of the Bombay High Court in the case of *People Interactive (India) Pvt. Ltd. (supra)*:

18. Exclusivity claims based on secondary meaning acquisition must be established by cogent material. References to sales and promotional expenses may be used to establish the acquisition of reputation and goodwill, i.e., to show the popularity of a mark.

Mere use and statements of sales and expenses do not, of their own, establish the acquisition of a secondary meaning. That proof is always required of goods or services in the second category, 'merely descriptive' expressions; for these are not ordinarily registrable without such proof. That proof must be directed to establishing that the 'merely descriptive' expression in question is now firmly established in the public imagination with the claimant and its goods and services. High sales and expenses will not do; the claimant must show from carefully neutralized market surveys, etc., that this is indeed how the public perceives the mark - not as a mere description, but a pointed reference to the origin, viz., the claimant. Use itself does not establish distinctiveness. The extent to which a mark has lost its primary meaning and the extent to which it has acquired a secondary one are conclusions to be drawn from evidence. That evidence, showing the displacement of the primary meaning by the secondary meaning, must be of the members of the public as well, not merely those specially placed to attest to its uniqueness.

74. Even the plea of Mr. Grover of passing off being committed by the defendant, is not appealing. *Mccarthy on Trademark and Unfair Competition Vol. 2, 3rd Edition in para 12.5(2)* stated that in order to obtain some form of relief on a passing off claim, the user of the generic term must prove some false or confusing usage by the newcomer above and beyond the mere use of the generic name. That apart as held in many judgments, the plaintiff in a passing off action should prove three things which are described as a classical trinity, they are: -

- 1) that there was goodwill or reputation attached to the goods or to the services which the plaintiff supplied, in the mind of the purchasing public by association with the plaintiff's identifying get up;

- 2) that there was a misrepresentation to the public likely to lead the people to believe the goods offered by the defendants were the goods of the plaintiff;
- 3) that the plaintiff was suffering or plaintiff is suffering or is likely to suffer by reason of the erroneous belief on account of the misrepresentation of the defendants.

The goodwill / reputation / misrepresentation / damage / suffering, being a finding of fact, have to be proved in trial. The only plea of Mr. Grover, by stating that the plaintiff is using the mark 'DELHIVERY' since 2011 and that it has high sales figures are not conclusive of goodwill / reputation. Further, the plea that the defendant has adopted mark 'DELIVER-E', to divert the business of the plaintiff to itself as such *mala fide* is concerned, the submission of Mr. Lall was that the defendant has extensively used the trademark 'SMART-E' since the year 2014 to the knowledge of the plaintiff for the passenger transport service; which inspired the mark 'DELIVER-E' (with distinctive 'E') for last mile delivery service, unlike the services of the plaintiff. That apart, he relied upon an email dated May 26, 2020, of the plaintiff Company's employee, wherein reference has been made to the mark 'DELIVER-E' to contend there is knowledge and no misrepresentation. I may state here, that on the email dated May 26, 2020, Mr. Grover had relied upon an affidavit filed by the employee to

contend, that the said email was sent in his personal capacity. In any case, the aforesaid aspect has to be proved in trial as well. That apart, I also note, the mark of the defendant is structurally / visually at variance with the mark of the plaintiff, inasmuch as the alphabet 'H' has been added by the plaintiff between the alphabets 'L' and 'I' and the alphabet 'Y' has been substituted with the alphabet 'E' by the defendant. The marks of the

plaintiff are , , , ,  &

DELHIVERY

whereas the mark of the defendant is



A comparison clearly shows that there is no similarity between the marks as some variant marks 'DELHIVERY' are with stylized 'D', one mark is accompanied by the words 'SMALL WORLD' at the bottom in red colour. Whereas the mark of the defendant is written in green colour with an 'E' device positioned in a slant manner. Additionally, it is the conceded case of the parties that the clientele of both the parties are companies which surely can differentiate between the marks of the plaintiff and defendant. The defendant admits that it has only long-term contractual agreements with companies, who are well informed about market realities and further that the contract signed by the defendant and / or by its subsidiary TVV Electric Fleet Pvt. Ltd. are not done under the name of 'DELIVER-E'. It is

a settled position of law that a class of persons to whom services are rendered would be a relevant consideration to assess whether the marks are deceptively similar. In this regard, I may refer to the judgment of *Cadila (supra)* wherein it was held as follows:

“12. In support of the contention of the appellant that even if it is assumed that the mark 'Sugar Free' is descriptive, it nevertheless has attained distinctiveness as it has been associated with the business of the appellant for a considerable period of time and, therefore, any adoption of a similar mark by the respondent establishes dishonest intention of the respondent, the learned Senior Counsel has relied upon the cases of Info Edge (India) Pvt. Ltd., Societe Des Products NESTLE S.A, Essel Packaging and Caterpillar Inc. (supra). In our view, before ascertaining whether the expression 'Sugar Free' has acquired a secondary meaning and assumed distinctiveness what has to be borne in mind is the specialized nature of the appellant's product. Being essentially a sweetener, the popularity of the sugar free range of product will have to be necessarily ascertained to be popular amongst the specific or limited class of consumers. 'Sugar Free' is an item consumed by the elite class of consumers who are aware of the utility of such products or by those who by virtue of their affluence acquire weight related problems such as obesity, diabetes, high cholesterol. The learned Single Judge has also rightly in our view found that the popularity of the appellant's product is restricted to such kind of consumers only. The reach of the appellant's sweetener would largely be confined to such elite consumers. Thus, the factum of the specialized nature of the appellant's product vis-à-vis its specific reach, in fact, leads to the conclusion that the expression 'Sugar Free' cannot be held to have acquired such distinctiveness qua the food products in general which may bar its user at least in a descriptive sense by any other competitors in the field of food products. Besides the above factors such an elite class of customers is well informed and is unlikely to be misled into believing the defendant's to be that of the plaintiff/appellant.”

(Emphasis supplied)

75. Moreover, my attention was drawn by Mr. Lall to the number of registrations / applications made by third parties for marks, with 'delivery' like, DELIVERY WITH LOVE & CARE, DELIVERY, DELIVERY IN MINUTES, DELIVERY BEYOND BOUNDARIES, DELIVERYAAN LOGISTICS COMPANY, DELIVERY MAN, DELIVERY BABA, COMMITTED TO DELIVER, DELIVERY JOY, DELIVERY MANTRA, DELIVERYMOJO, DELIVERY HAPPINESS PLATFORM, DELIVERY HAPPINESS SCORE, DELIVERY ONE, DELIVERY PLUS, DELIVERY JUNCTION, DELIVERY CORNER, DELIVERYMART.IN, DELIVERYJET, DELIVERING YOUR PROMISES TO THE WORLD AVT LOGISTICS, DELIVERING TRUST, DELIVERY2ALL.COM, DELIVERING HAPPINESS GLOBALLY, DELIVERING A MILLION SMILES, DELIVER, DELIVERING DREAMS AND DESTINATIONS, DELIVERING JOY, DELIVERING SOLUTIONS YOU TRUST, DELIVERING THE GIFT OF SIGHT, DELIVERING CHANGE FOUNDATION, DELIVERING MAHARASHTRA, DELIVERING THE ESSENTIALS OF LIFE, DELIVERING FUTURE DYNAMICS..... FOR BETTER HUMAN LIFE, DELIVERING YOUR VISION, DELIVERING INNOVATION, DELIVERYCLOUD. These marks though in different classes, including

in class 39 which is also one of the classes in which the marks of the plaintiff are registered, would clearly suggest that in the presence of so many marks with 'delivery', the marks of plaintiff/defendant can co-exist in the market without causing deception and / or confusion. Further, the plaintiff in replies to the examination reports on some of the aforesaid marks (with 'delivery') has stated that 'DELHIVERY' is visually and phonetically different. In this regard Mr. Grover, had relied upon the judgement of this Court in *H & M Hennes & Mauritz AB & Anr. (Supra)* to contend that merely the plaintiff at the stage of seeking registration took such a stand, cannot stop the plaintiff from exercising its statutory rights. Though such a proposition cannot be disputed but the same shall not be applicable in view of my conclusion above in the facts of this case that the mark 'DELHIVERY' is a phonetically generic word and cannot be registered so as to seek benefit of statutory rights. So, it follows, there cannot be any claim of passing off. The reliance placed by Mr. Grover on the judgment of this Court in *South India Beverages (supra)* has no applicability in the facts of this case.

76. The submission of Mr. Grover, that the proof of actual damage is not required, by relying on the judgments in *Century Traders (supra)* and *Laxmikant Patel (supra)* is misplaced in these facts. Similarly, the judgments in the cases of *Madhuban Holiday INN (supra)*, *Ishi Khosla*

(*supra*) and *Midas Hygiene (supra)* relied by Mr. Grover in support of his submission of *mala fide* adoption of the mark by defendant are also not applicable in these facts.

77. The plea of Mr. Grover that the mark 'DELHIVERY' is a suggestive mark, which has been protected by this Court in various judgments is also not appealing. In fact, the judgment relied upon by Mr. Grover himself in the case of *Telecare India Private Limited (supra)* clearly holds suggestive marks to be those marks which are neither exactly descriptive on one hand nor truly fanciful on the other. It is also held that a term is suggestive if it requires imagination, thought, perception to reach a conclusion as to the nature of the goods. The relevant portion is reproduced as under:

“30. The category of suggestive marks refers to those marks which are neither exactly descriptive on the one hand, nor truly fanciful on the other. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. If a term is suggestive, it is entitled to registration without proof of secondary meaning. For instance, as pointed out in Abercrombie & Fitch Co. (supra) the word “Ideal” when used for hair brushes, is in no sense indicative or descriptive of the qualities or characteristics or merits of a brush. It is therefore not descriptive. However, the word “Ideal” for hairbrushes does suggest that the product meets the very highest ideal mental conception of what a hair brush should be and is therefore suggestive.”

78. Similarly, a coordinate bench of this Court in the case of *Bata India Limited vs. Chawla Boot House and Anr.* 2019 SCC Online Del 8147 held as under:

“30. 'POWER', could at best be termed as a 'SUGGESTIVE' mark for footwear, which would make it an inherently distinctive mark. In the context of footwear, it would at best be considered as a laudatory epithet. It is not immediately connectable to footwear. Even if one applies the competitors' need test, Defendant No.2 has not shown a single footwear product using the word 'POWER'. Though, some pending applications have been shown, it is a well-known fact that mere filing of applications or registering marks does not create any goodwill and also does not imply any use of the mark. The Plaintiff has been taking action against the marks which it considers conflicting to its interest, vigilantly.”

By applying the aforesaid position of law, to the facts I say, the mark which is phonetically similar to the English word 'delivery' do not require any imagination, thought and perception, more so for delivery services. Similarly, in *Bata India Limited (supra)* this Court held 'POWER' could at best be termed as a suggestive mark as the same is not immediately connectable to footwear, but a laudatory epithet and such suggestive marks are held to be inherently distinctive marks. Whereas, in the case in hand, the mark 'DELHIVERY' is immediately connectable to the delivery services and cannot be termed as a suggestive mark.

79. The reliance placed by Mr. Grover on the judgment of this Court in the case of *Anil Verma (supra)* is concerned, the same has no

applicability in the facts of this case, inasmuch as the Court was concerned with the marks 'Cash for Gold' and 'Gold Buyers' which were held to be suggestive in the following manner:

“26. The expressions Cash for Gold and Gold Buyers do not describe the entire gamut of services offered by the Plaintiff. As stated above, the Plaintiff carries out a wide range of business from its stores including the sale/purchases of gold, diamonds, silver, antique, watches etc. Some portion of the business could be buying of gold from the customers in return for money. Even the word 'cash' does not denote what is understood in the actual sense by the Plaintiff, as the payment upon purchase of various commodities is made through the banking channels, demand draft or even by cheques. Thus, Cash for Gold could be suggestive of some part of the business of the Plaintiff but does not describe fully the complete range of services offered by the Plaintiff. The Defendants have not placed on record any independent market survey or evidence, which suggests that the term Cash for Gold is perceived as a descriptive expression. Even the term Gold Buyers cannot be held to be descriptive at the prima facie stage, by applying the Degree of Imagination test as, though the Plaintiff may be buying gold from customers, but it also is involved in buying various other commodities apart from gold. Moreover, in respect of the marks 'CASH FOR GOLD' and 'GOLD BUYERS', as is evident from the various other third party user documents which have been placed on record by the Defendants, there are several alternative ways in which third parties have referred to identical businesses. Such alternative marks/names used are 'CASH 4 GOLD', 'GOLD BUYERS', 'SELL YOUR GOLD' 'CASH EXCHANGE', 'GOLD EXCHANGE', 'MONEY FOR GOLD', 'MONEY 4 GOLD', 'SELL GOLD', 'POST GOLD FOR CASH', 'EZY CASH GOLD', 'GOLD-BUYER', 'WE BUY GOLD', etc.”

80. In view of my above discussion, the prayer made by the defendant in the application being I.A.6523/2020 under Order XXXIX Rule 4 needs to be allowed and the interim injunction granted by this

Court vide order dated July 03, 2020 needs to be vacated. Accordingly, I.A.6523/2020 is allowed and disposed of and I.A.5109/2020 under Order XXXIX Rules 1 & 2 is dismissed. It is stated that the aforesaid is a *prima-facie* view and is not an expression on the merits of the suit.

I.A. 6572/2020

Dismissed as infructuous.

CS(COMM) 217/2020

List on 12th November, 2020 before Joint Registrar for further proceedings.

V. KAMESWAR RAO, J

OCTOBER 12, 2020/jg

भारत्यमेव जयते