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DELHIVERY decision: phonetically generic marks cannot be protected

India - [Khaitan & Co](#)

- Delhivery alleged that the defendant infringed the registered mark DELHIVERY by using the mark DELIVER-E for similar services
- The court found that both marks were derived from the generic term 'delivery', which referred to the services at issue
- Delhivery had failed to show secondary meaning

In [Delhivery Private Limited v Treasure Vase Ventures Private Limited](#) (CS(COMM) 217 of 2020), the Delhi High Court has held that the mark DELHIVERY was phonetically generic and refused to enforce Delhivery Private Limited's trademark registration.

Background

Plaintiff Delhivery alleged that the defendant infringed the registered trademark DELHIVERY (depicted below on the left) by using the mark DELIVER-E (depicted below on the right).




The court had previously granted an *ex parte* interlocutory injunction against the defendant's use of DELIVER-E. An application was filed by the defendant to vacate the *ex parte* interlocutory injunction.

The plaintiff argued as follows:

- The mark DELHIVERY was coined in 2008 and had been used continuously and extensively since 2011 for logistics and transport management services.
- It owned 27 registrations for various representations of DELHIVERY.
- The suit was not an attempt to monopolise the descriptive term 'delivery'.
- DELHIVERY was a coined mark or, at best, suggestive.
- The plaintiff relied on extensive sales and recognitions/awards to contend that the mark had acquired secondary meaning.
- It had successfully enforced its rights in the past.
- The defendant's adoption of its mark was dishonest, since the defendant was aware of the plaintiff's mark through previous business interactions and had changed its mark from SMART-E to DELIVER-E only to free-ride on the plaintiff's reputation and goodwill.

The defendant argued as follows:

- The plaintiff had alleged before the registry that DELHIVERY was distinct from other marks consisting of the generic term 'delivery'; therefore, it was estopped from arguing that DELIVER-E was similar to its mark.
- The way in which the marks were represented was different and not deceptively similar.
- There was no possibility of confusion since the corporate name/trade name of the defendant did not contain the mark DELIVER-E and consumers were able to differentiate between the parties.
- The plaintiff was indirectly seeking to monopolise the descriptive term 'delivery'.
- The adoption of the mark was honest since DELIVER-E was an extension of, and had been inspired by, the mark SMART-E, used since 2014.
- The defendant's mark signified 'delivery using electric vehicles for passengers and last-mile goods delivery'.

Decision

The court vacated the *ex parte* interlocutory injunction on the following grounds:

- Both marks were derived from the generic term 'delivery', which referred to the services at issue, and either introduced an additional letter or substituted a letter.
- The plaintiff's position before the registry was contrary to that in the present suit and gave away the fact that both marks were derived from the term 'delivery'.
- The plaintiff had failed to show secondary meaning. High sales and expenses were not sufficient per se. There was no evidence demonstrating that consumers associated the mark with a single source of origin.
- Registration does not confer absolute rights, but is subject to other provisions, including that descriptive words must be kept available to all traders and cannot be monopolised.
- A suggestive mark is neither descriptive nor truly fanciful, but requires consumers to use imagination, thought and perception to reach a conclusion as to the nature of the goods. DELHIVERY is phonetically similar to the English word 'delivery' and will immediately be connected to delivery services. Therefore, it is not suggestive.
- Several registrations for marks containing the term 'delivery' co-exist on the mark. Since the manner/style of representation of the parties' marks was different, they could co-exist too. In addition, consumers could differentiate the source of the services through the parties' trade names.

Comment

The decision once again exposes the dangers inherent in the adoption of descriptive marks, including those that are misspellings of descriptive terms. Registrations for such marks are weak. The decision further highlights that a registration is not an absolute right, and serves as a reminder of the difference between descriptive and suggestive marks. It also reinforces that pleadings and evidence of consumer recognition of a single source is an essential requirement to show secondary meaning. Although the decision was passed at an interlocutory stage and expressed *prima facie* views, the plaintiff would have to meet a similar threshold at trial.

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