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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision: 22nd April, 2022

+ **CS (COMM) 563/2020 & I.A.16452/2021**

DHL INTERNATIONAL GMBH Plaintiff
Through: Mr. Pravin Anand, Mr. Shrawan Chopra, Mr. Vibhav Mithal and Mr. Achyut Tewari, Advocates.
(M:8604633567)

versus

DLH EXPRESS SERVICES PRIVATE LTD. Defendant
Through: Mr. Vishal Patel, Advocate.

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The Plaintiff - DHL International GmbH, a German company has filed the present suit seeking permanent injunction restraining infringement of trademark, trade dress, dilution and tarnishment, passing off, damages etc., against the Defendant - DLH Express Services Private Ltd.
3. The Plaintiff asserts rights in the trademark and name '*DHL*', which is used by it for logistic services. The Plaintiff company was set up in San Francisco in the year 1969. The Plaintiff has various associate and group companies across the world, including in Germany. The presence of the Plaintiff is in more than 220 countries and territories employing over 500 thousand persons, over 158400 supply chain employees, and around 14,000 warehouses around the world. It offers various services including parcel and international express service, freight transport, and supply chain



management services, as well as e-commerce logistics solutions. The total revenue of the Plaintiff's group companies was more than 63 billion Euros in 2019. The Plaintiff company is a subsidiary of Deutsche Post AG, which is part of the Deutsche Post DHL Group. The Plaintiff group is also the world's number one contract logistics provider through the DHL supply chain in more than 55 countries. In 2001, the Plaintiff incorporated DHL Worldwide Express Pvt. Ltd. (later known as DHL Express (India) Pvt. Ltd.) (*hereinafter "DHL India"*), which is stated to be the leading international air express service provider in India, since inception. DHL India has about 21,000 employees and over 50,000 customers with dedicated service centres in all major cities in India. While the plaintiff groups annual revenue was around 63.34 billion euros in 2019, DHL India's revenue in 2019 was around 3000 crores. The brand is also partnered through various sponsorships in sports, culture and arts events, by the DHL Partner program. It has been the official logistics provider for Formula One for many years and has partnered with various Fashion Weeks, Indian Super League, etc. and has sponsored the Economic Times Supply Chain Management Summit. Its services have also received numerous accolades including 'The World's Most Global Company', 'Global 500- The World's Most Valuable Brands', 'Superbrand', etc., right from 1998 till date.

4. The Plaintiff's mark DHL and distinctive logo and trade dress, which was initially adopted in 1969, has evolved over the years. The mark DHL derives its origin from three entrepreneurs who founded the company i.e. Adrian Dalsey, Larry Hillblom and Robert Lynn. Currently, it is used as 'DHL' in a stylized red font in a yellow background, with the letters 'D', 'H' and 'L' being displayed prominently and three straight red lines in a



stylized form on either side of 'D' and 'L'. The DHL logo is set out below:



5. The Plaintiff's mark is also used in various forms and variants as 'DHL SUPPLY CHAIN', 'DHL Express', 'DHL Global Forwarding', etc. The DHL mark and logo are also registered in India and in several countries of the world. The registration in India relates to classes 16, 36, 39, 28, 41 etc. The mark itself is registered in more than 180 countries including Japan, Australia, Germany, Italy, Singapore, USA, UK, etc. A voluminous list of all the registrations has been placed on record.
6. The Plaintiff has also undertaken various successful enforcement actions for its mark in India and abroad. The same is captured in the plaint as under:

"It is stated that while adjudicating upon two different domain name disputes, titled as DHL Operations B.V. v. Karel Salovsky, (Case No. D2006-0520) and DHL Operations B.V. v. Zhangyl (Case No. D2007-1653), the WIPO Arbitration and Mediation Center gave impetus to the fact that the trademark "DHL" is being extensively used by the complainant (predecessor in title and interest of the Plaintiff) therein, worldwide. Therefore, by virtue of such extensive use, the public has come to perceive the goods and services that are offered under the "DHL" trademark or its variants as emanating from or being endorsed by or affiliated with the Complainant therein. The WIPO Arbitration and Mediation Center acknowledged that,



owing to the strong presence of the complainant in the international transport and logistics industry, the "DHL" mark has acquired widespread recognition and goodwill. Further, it is pertinent to note that the WIPO Arbitration and Mediation Center, in the case of DHL Operations B.V. v. Ali Kazempour (Case No. D2004-1094), noted that the 'DHL' mark is in-fact "notorious all over the world". Accordingly, the WIPO Arbitration and Mediation Center confirmed, in the case of DHL International GmbH v. Richard Yaming (Case No. D2012-1081), the "worldwide notoriety" of the 'DHL' mark.

Equally, on a European level, the Second Board of Appeal of the European Union Intellectual Property Office, in the Decision of 7 March 2012 (Case R 2227/2010-2) relied on the fame and reputation of 'DHL' through its advertising in the media and its presence in all parts of the world."

7. The grievance in the present case is that the Defendant is using the mark DLH for its courier services. The Plaintiff acquired the knowledge of the Defendant sometime in January, 2020 when it came across the Defendant's mark 'DLH Express Services Pvt. Ltd.,' with Application bearing no.3147906 in class 39 dated 31st December, 2015. The said mark is depicted as under:



8. In response to the said application, in the Examination Report dated 9th August, 2016, the Plaintiff's marks were cited by the Trademarks



Registry. The said marks were as under:

S. No.	TM Application No.	Class	Proprietor	Trademark
1.	1270337	39	Plaintiff	
2.	1270339	39	Plaintiff	
3.	1365211	16,36,39	Plaintiff	DHL

9. The Defendant replied to the cited marks wherein it claimed to be distinguishable from the Plaintiff's. The claim of user was April, 2015 by the Defendant, on the ground that the mark is visually and phonetically different. The Plaintiff opposed the said mark and the same is currently stated to be pending. The case of the Plaintiff is that the marks and logos adopted by the Defendant are almost identical to the DHL mark and logo. The colour combination is also identical. Writing style and all the features of the DHL mark are being used by the Defendant. The Defendant is also using the email address dlhmarketing1@gmail.com. Thus, an investigation which was carried out at the premises of the Defendant being Shop Nos. 7 to 9 and 12, Jasdeep Complex, R.K. Road, Industrial Area-A, Ludhiana - 141001, Punjab, which also revealed that while the Defendant was using 'DLH', in



the full company name and on different platforms including websites and hoardings, the actual mark of the Plaintiff was also being used by the Defendant in its premises. The case of the Plaintiff is that the mark is almost identical, services are identical and the trade channels are also identical. Thus, the use of the mark DLH by the Defendant would severely impinge upon the Plaintiff's right severally.

10. Mr. Anand, Id. Counsel appearing for the Plaintiff, submits that a search conducted on Google would also show that when the name of the Defendant is added on the search bar, the Plaintiff's search results show up. Thus, it shows that there is hardly any difference between the Plaintiff and the Defendant's marks. Accordingly, a decree is sought to be passed in terms of the prayer clause for injunction. A decree for declaration is also prayed by the Plaintiff, in the following terms:

"d) An order declaring the Plaintiff's registered trademark "DHL" as well-known mark, along with the a direction to the Registrar of Trademarks to notify the mark "DHL" on the Register of well-known marks;"

11. The present matter was listed on 22nd December, 2020, on which date the Court had granted an ex-parte ad interim injunction restraining the Defendant from using the impugned trademark and logo or any trademarks or logos, which are similar to that of the Plaintiff. The same reads as under:

"10. Till the next date of hearing, the defendant, its directors, principal officers, agents, distributors, and employees are restrained from using the impugned trademark/trade logo or any other trademark/trade logo which is deceptively similar to the plaintiffs trademark/trade logo.

10.1 Furthermore, the defendant is also restrained from using a domain name/email address which



alludes to a trademark/trade logo that is identical to or deceptively similar to the plaintiffs trademark/trade logo.”

12. This injunction is continuing till date.

13. Mr. Vishal Patel, Id. Counsel appearing for the Defendant, submits that the Defendant has already changed its name from DLH Express Services Pvt. Ltd. to M/s. Dogra's Cargo Express Private Limited with effect from 29th January, 2021. He further submits that the Defendant No.1 was actually collecting the courier packets from customers and was availing of authorized channel business partners of the Plaintiff for dispatching the goods/packets. He further submits that the Defendants do not intend to use the mark DHL, DLH or the logo for the services provided by it.

14. Heard and perused the record. A perusal of the documents on record shows that the mark DHL enjoys enormous goodwill and reputation owing to extensive use almost in all the countries of the globe. The courier services of the Plaintiff are especially popular in the international courier and logistics space. The Plaintiff is one of the biggest freight companies in the world with huge turnover. The mark DHL having been adopted from the initials of the names of the founders is an extremely distinctive and arbitrary/inventive mark. It would be entitled to the highest protection. The Plaintiff's logo is also a distinctive logo, which is easily recognizable. The Defendant has copied the name DHL as also the logo. The two representations are set out below:



Plaintiff's Mark	Defendant's Mark
	

15. A perusal of the above two representations leaves no matter of doubt as to the fact that the use of the mark DLH would be violative of the Plaintiff's statutory and common law rights. The admission/denial in this matter has been completed and a large number of the documents stand admitted and have been exhibited. A list of the exhibited documents is set out below:

Exhibits	Documents
Exhibits P1 to P13	The documents related to the registrations of the Plaintiff's mark
Exhibits P14&15	Extracts from the JustDial and Indiamart websites of the Defendant's use of the mark
Extract P16	Screenshot of the Google search of DLH Express Services Pvt. Ltd.
Exhibits P17 to P27	Various international registrations with the DLH mark
Exhibit P28	Documents relating to the assignment of the mark are also admitted in Exhibit P-28
Exhibits P29 to P32	Defendant's trademark record for the mark DLH and the opposition filed thereto.
Exhibits P34	The printouts from the websites of the Defendant related to the registrations with the Corporate Affairs Ministry



Exhibit P35	Extracts from Zaubacorp of the details of the Defendant company.
Exhibit P36 to P40	WIPO decision recognizing the right of the Plaintiff in the mark DHL
Exhibit P41	List of international trademark registrations for mark DHL
Exhibit P43	Data relating to Deutsche Post DHL Group
Exhibit P44	Printouts from the Plaintiff's website
Exhibit P45 & P46 P47	Financial records of the Plaintiff
Exhibit P49 to P52	Various promotional and other activities undertaken by the Plaintiff

16. On behalf of the Defendant, the document showing change of the name is not disputed and is accordingly exhibited as Exhibit D1.

17. The application **I.A.16452/2021** in the present case seeks summary judgment and declaration of the Plaintiff's mark as well-known. The prayers in the application read as under:

"22. In light of the above facts and circumstances it is humbly prayed that this Hon'ble Court may be pleased to pass:

a. A decree of permanent injunction, damages etc. as prayed for in paragraph 49 of the plaint; and

b. An order declaring the Plaintiff's registered trademark "DHL" as well-known mark, along with the a direction to the Registrar of Trademarks to notify the mark "DHL" on the Register of well-known marks; and

c. A decree against the Defendant in favour of the Plaintiff granting the costs incurred by the Plaintiff in the present suit; and,

Pass any further order as this Hon'ble Court may deem fit and proper under the facts and circumstances of the case may also be passed in favour of the Plaintiff and against the Defendant."



18. Reply is stated to have been filed yesterday. In so far as the prayer for summary judgment is concerned, as per the Commercial Courts Act, 2015 read with the Delhi High Court (Original Side) Rules, 2018 (*hereinafter* “*Original Side Rules*”) and Rule 27 of the Delhi High Court Intellectual Property Rights Division Rules, 2022 (*hereinafter* “*IPD Rules*”), summary judgment can be passed under Order XIII A, if the Defendant has no real prospect of succeeding in the matter. In fact, even the filing of application for the same would not be required in terms of Rule 27. Rule 27 of the IPD Rules read as under:

“27. Summary Adjudication

In cases before the IPD, the Court may pass summary judgment, without the requirement of filing a specific application seeking summary judgment on principles akin to those contained in Order XIII A, Code of Civil Procedure, 1908 as applicable to commercial suits under the Commercial Courts Act, 2015.”

19. Practice Direction 9(h) of the Original Side Rules, pursuant to Section 18 of the Commercial Courts Act, reads as under:

“9. In the case of commercial disputes, the Court may, inter-alia, pass orders as it may think fit for the speedy disposal of the suit or narrowing the controversy between the parties, including:-

...

h) conduct a Case Management hearing under Order XV-A of the Code and as part of the said case management hearing –

...

ii. explore the possibility of deciding the dispute by a summary judgment, without a specific application for the said purpose, on the basis of pleadings dispensing with the trial of the suit on the questions of law or of facts on which the parties are not at issue;”



20. The reply of the Defendant to the application seeking summary judgment is not on record in the present case. Be that as it may, a perusal of the competing marks and logos shows that the marks are almost identical to the Plaintiff's mark and logo has also been copied. The services for which the Defendant is using this mark are identical. There is clearly no defence that the Defendant has taken, except the fact that the Defendant is, in fact, using various channels of the Plaintiff from 2013. The fact that the Defendant may be using the authorized channels would not give any permission to them to use the Plaintiff's mark and logo.

21. Considering the fact that the Defendant has already changed the name DLH and the use of the impugned mark has also been stopped, this is a fit case for grant of permanent injunction in favour of the Plaintiff, by way of summary judgment.

22. Accordingly, the suit is decreed in terms of the paragraphs 61(a) to 61(c).

23. The Defendant is also directed to withdraw its application for the mark 'DLH Express Services Pvt. Ltd.,' with Application bearing no.3147906, if not already withdrawn. A letter to this effect shall be sent to the Trademark Registry, which shall pass appropriate orders for abandonment within four weeks of the receipt of the letter.

24. In so far as the prayer for declaration seeking recognition as a "well-known mark" is concerned, Section 2(zg) of the Trademarks Act defines a well-known mark as under:

(zg) "well known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such



mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

25. Section 11(2) of the Trademarks Act provides protection to well-known trademarks, in the following terms:

"Section 11.

...

(2) A trade mark which—

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered, if or to the extent, the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark."

26. Rule 124 of the Trademark Rules, 2017, provides for declaration of well-known status by way of an application, without the requirement for any proceedings or rectification. Pertinently Section 11(6) lays down the factors to be considered for declaration of a mark as a 'well-known mark'. Section 11(6) reads as under:

"(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in



the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.”

27. On the recognition of “famous marks”, J. McCarthy in **5 McCarthy on Trademarks and Unfair Competition**, §29:62 has observed as under:

“Although the basis of the modern treaties and domestic laws providing protection for famous and well-known marks is derived from the Paris Convention, the scope of protection afforded to famous marks is different in each country. Article 6 bis the Paris Convention is the cornerstone of international protection of famous works.

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First, NAFTA extends protection to service marks. Second, in determining whether or not a mark is famous, the standard used is how well the mark is known in the relevant sector of the public, not necessarily the general public. Thus, knowledge of the famous or well-known mark can be the result of actual use or promotion of the trademark only in a particular segment of trade.



Like NAFTA, the GATT TRIPs agreement extends protection to both goods and service marks even if the mark has not been registered in a member country. Also like NAFTA, the mark need only be famous in a relevant segment of the public. The special provisions of TRIPs Art. 16(3) apply to give protection beyond that of the Paris Convention. The famous marks rule applies even if the goods or services to which the allegedly infringing mark is being applied are not similar to the goods or services for which the famous marks has become well-known. This is subject to three conditions: (1) the famous mark must be registered; (2) there must be such a connection between the respective goods or services that confusion is likely; and (3) it must be likely that the interest of the owner of the registered trademark will be damaged by such infringing use.”

28. In **NR Dongre v. Whirlpool Corporation & Anr., AIR 1995 Delhi 300**, a Division Bench of this Court observed as under:

“From the aforesaid facts including the extensive advertisements of the goods of the First respondent & its Trade mark 'WHIRLPOOL' and the legal position ad interim hitherto we are prima facie of the opinion that the trade mark 'WHIRLPOOL' has acquired reputation and goodwill in this country and the same has become associated in the minds of the public or potential buyers with the goods of the first respondent. Even advertisement of trade mark without existence of goods in the market is also to be considered as use of the trade mark. It is also not necessary however that the association of plaintiffs mark with his goods should be known all over the country or to every person in the area where it is known best. (See: Fandler & Co, Ltd. vs. O & G. Rushton (1903) 20 Rpc 477) Besides the facts prima facie demonstrable that the first respondent was prior user of the trade mark 'WHIRLPOOL' as it was using the same since 1941, while the appellants



themselves claim the adoption thereof from 1986.”

29. This decision was affirmed by the Supreme Court. Thereafter, a 1d. Single Judge of this Court in ***Tata Sons Ltd. v. Manoj Dodia, 2011 (46) PTC 244 (Del)***, elaborated upon the principles for declaration of a mark as well known. The same reads as under:

“5. A well known trademark is a mark which is widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademark needs to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well. The relevant general public in the case of a well known trademark would mean consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trademark.

6. The doctrine of dilution, which has recently gained momentous, particularly in respect of well known trademarks emphasises that use of a well known mark even in respect of goods or services, which are not



similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well known trademark enjoys by reducing or diluting the trademark's power to indicate the source of goods or services.

7. Another reason for growing acceptance of trans-border reputation is that a person using a well known trademark even in respect of goods or services which are not similar tries to take unfair advantage of the trans-border reputation which that brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers. When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an unfair competition.”

30. These principles have been reiterated by Courts thereafter, most recently in ***Dharampal Satyapal Sons Private Limited v. Akshay Singhal and Ors.***, [CS (COMM) 129/2019, decided on 17th October, 2019].

31. In light of this settled legal position on the recognition of well-known marks and owing to the extensive evidence placed on record showing the global use of the mark DHL and continued use of the mark DHL in India as also the registrations and the independent third party write-ups and articles, and enforcement actions which are placed on record, this Court unhesitatingly holds the mark DHL to be a well-known mark, especially in the field of logistics, freight transport, courier services, international money etc. The remaining reliefs are not pressed for. No further orders are called for in this matter.

32. The suit is decreed in the above terms. Decree sheet be drawn up



accordingly. All applications are disposed of.

33. Copy of today's order be supplied to the Trademark Registry (Address: Trademarks Registry, New Delhi, Boudhik Sampada Bhawan, Plot No. 32, Sector 14, Dwarka, New Delhi-110078; Email: cgofficemh@nic.in, hodel.tmr@nic.in), as also through Mr. Harish V. Shankar, Ld. CGSC.

**PRATHIBA M. SINGH
JUDGE**

APRIL 22, 2022/dk/ms

