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

Date of decision: 29th July, 2022

+ **CS(COMM) 429/2021 & I.A. 11653/2021, 15732/2021**

THEOS FOOD PVT. LTD. & ORS. Plaintiffs

Through: Mr. Jayant Mehta, Sr. Advocate with
Mr. Kapil Wadhwa, Ms. Surya
Rajattan and Mr. Abhishek Tiwari,
Mr. Srikar, Advocates.
(M:9891929028) along with Plaintiff
No.3 - Mr. Gaurav Wadhwa and
Plaintiff No.4 - Mr. Vikram Narula.

versus

THEOBROMA FOODS PVT. LTD. Defendant

Through: Mr. Rahul Vidhani and Mr. Manoj
Menda, Advocates. (M:9811545888)
along with Ms. Kamal Messman.

**CORAM:
JUSTICE PRATHIBA M. SINGH**

Prathiba M. Singh(Oral)

1. The dispute, in the present case, relates to two marks being 'THEOBROMA' and 'THEOS'/'THEO'S' used in respect of bakery related products, patisseries, confectionery etc. The competing entities are the Plaintiff Nos.1 and 2 being 'THEOS FOOD PVT. LTD.' as also 'THEOS PATISSERIE & CHOCOLATARIE' (*hereinafter*, 'Theos'), which are based out of Delhi and Noida, and the Defendant being 'THEOBROMA FOODS PVT. LTD.' (*hereinafter*, 'Theobroma'), which is based out of Mumbai, Maharashtra.

2. There are two proceedings pending between the parties. The said two proceedings are as under:

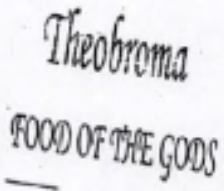
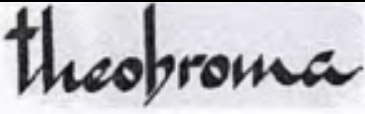

- i. **Commercial IP Suit No.342 of 2016** titled “**Theobroma Foods Pvt. Ltd. v. Mr. Karan Narula and Ors.**” pending before the Bombay High Court;
- ii. Present suit being **CS(COMM) 429/2021** titled “**Theos Food Pvt. Ltd. & Ors. v. Theobroma Foods Pvt. Ltd.**”

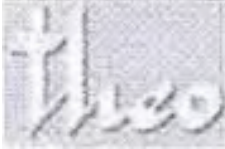
3. In the suit being **Commercial IP Suit No.342 of 2016** filed by Theobroma before the Bombay High Court, an injunction has been sought, restraining Theos from using the marks ‘THEOBROMA’, ‘Theobroma’, ‘theobroma’, ‘theo’, ‘Theo’, ‘Theo’s’, ‘Theos’ and various other variants and derivatives thereof, as also, any other mark which is identical or deceptively similar to Theobroma’s marks. No interim relief was granted in the said suit. The said suit is pending.

4. In the present suit before this Court, Theos seeks permanent injunction restraining Theobroma from infringing the trademark ‘THEOS’, ‘THEO’S’ and ‘THEO’S PATISSERIE & CHOCOLATARIE’, passing off, unfair competition, dilution, blurring, damages, rendition of accounts, and delivery up, and other reliefs. The case of Theos is that Theobroma is using the mark ‘THEOS’ as a prefix to the names of various food items being sold in the outlets of Theobroma.


5. A perusal of the court record in the present suit, as also, the amended Complaint filed before the Bombay High Court shows that Theobroma claims to be a leading name in the business of manufacturing and selling gourmet foods, including bakery and confectionary products and beverages including, *inter alia*, cakes, brownies, desserts, pastries, and chocolates.

Theobroma also claims to be the prior adopter and user of the impugned marks. In the year 2004, Theobroma opened its first retail outlet/café next to Cusrow Baug at the iconic Colaba Causeway, Mumbai, under the mark and name ‘THEOBROMA Food of the Gods’. Since then, over the years, Theobroma’s trademarks, are stated to have acquired immense goodwill and reputation and Theobroma is stated to have become a household name. It has expanded all across India, with a total of 81 retail outlets/café’s at Mumbai, New Delhi, Pune, Noida, Bengaluru, amongst others. As set out in the Written Statement, Theobroma has obtained several trademark registrations in respect of the mark ‘THEOBROMA’ and its variants, some of which are set out below:

| S.No. | Trademark | App/Reg. No. | Status | Class |
|-------|--|--------------|------------|-------|
| 1. | THEOBROMA | 1315545 | Registered | 30 |
| 2. |  | 1520677 | Registered | 30 |
| 3. |  | 2291823 | Registered | 30 |
| 4. |  | 2301544 | Registered | 30 |

| | | | | |
|----|---|---------|---|----|
| 5. | THEOS | 2325888 | Opposed by Plaintiff No.4 -Mr. Karan Narula | 43 |
| 6. |  | 3503532 | Registered | 29 |

6. On the other hand, Theos is engaged in the business of providing restaurant services, sale of bakery and confectionary items, and the production, preparation and sale of varied food products. As per the Complaint, Theos operates a chain of bakeries/restaurants/cafés/lounges under the mark ‘THEOS’/‘THEO’S’ in the Delhi-NCR region. Theos has a wide variety of products on its menu such as chocolates, cookies, a wide selection of desserts and cheesecakes, hot/cold beverages among other milk and non-milk-based products. It is submitted that the mark ‘THEOS’/‘THEO’S’ was coined and adopted in the year 2008. Since then, Theos is stated to have used the mark continuously and uninterruptedly in respect of bakery related products in Class 30 and restaurant services in Class 43, and its marks are stated to have garnered valuable goodwill and reputation. The details of Theos’s trademark registrations/applications, as set out in the Complaint, is tabulated below:

| S.No. | Trademark | App/Reg. No. | Status | Class |
|-------|---|--------------|----------------------------|-------|
| 1. | THEO'S PATISSERIE & CHOCOLATERIE | 1755398 | Registered | 30 |
| 2. |  | 3294501 | Registered | 43 |
| 3. | THEOS (Wordmark) | 4061919 | Opposed by Theobroma | 30 |

7. On the last date of hearing i.e., 8th July, 2022, submissions were heard on behalf of both the parties. Thereafter, it was observed that considering the extent of the business and commercial activities of both the parties, an amicable resolution of the disputes between the parties ought to be explored. Accordingly, the parties were directed to be personally present on the next date.

8. Today, Theos is represented before this Court by Mr. Gaurav Wadhwa and Mr. Vikram Narula, the directors/partners of Theos. Ms. Kamal Messman, the Founder-Director of Theobroma is also present before this Court. Both parties are duly represented by their respective counsels,

including counsels from Mumbai.

9. This Court has interacted with the parties, as also, Id. Counsels for the parties. Various proposals were discussed in the pre-lunch session. The matter has been taken up post-lunch. The parties have broadly agreed to settle their disputes, in the following terms:

- i. Theos recognises and acknowledges Theobroma as the owner and proprietor of the mark 'THEOBROMA'. Theos has also agreed not to use the mark or name 'THEOBROMA' in any manner whatsoever, either in respect of any products of its manufacture, or sale, or any other services.
- ii. Though, Theobroma had initially objected to the use of the mark 'THEOS'/'THEO'S' by Theos, however, in view of the amicable resolution today, Theobroma no longer objects to the use of the mark 'THEOS'/'THEO'S' in respect of its goods and services, as also, as part of its trading style/name 'Theos Food Pvt. Ltd.' and 'Theos Patisserie & Chocolaterie', so long as Theos restricts its business activities to the Delhi-NCR region.
- iii. Insofar as the use of the mark/name 'THEOS'/'THEO'S' in the physical menu cards and signages of Theobroma, as also, on online menu cards and social media of Theobroma is concerned, Theobroma shall restrict such use of the mark 'THEOS'/'THEO'S' only for the following five food items offered by it, along with variants being egg/without egg and sized i.e., pastry slice, per kg. size thereof:

- 1. Theos Dutch Truffle Cake**

2. *Theos Chocolate Mousse Cup*

3. *Theos Mava Cake*

4. *Theos Dense Loaf*

5. *Theos Quiche*

- iv. The said usage of the mark, as set out in (iii) above, shall only be in the menu cards used at the physical outlets of Theobroma, and shall not extend to online menu cards of Theobroma.
- v. Theos shall also not make any online sales outside Delhi-NCR region under the mark/name 'THEOS'/'THEO'S'. If it intends to extend its commercial activities outside the Delhi-NCR region, either in physical or in online mode, the same shall be done under a mark/name which is neither identical nor deceptively similar to 'THEOBROMA'. Theos, however, is free to use a prefix or a suffix along with 'THEOS'/'THEO'S' for such expansion, so long as the totality of the mark/name which is used for such expansion is not identically or deceptively similar or does not create confusion with 'THEOBROMA'.
- v. Theobroma shall continue to retain all its trademark registrations for 'THEOBROMA' and its registered variants and derivatives, including 'THEOS' and 'THEO', and shall also be entitled to protect and take all enforcement-related steps and opposition-related actions to safeguard its rights in these names and marks.
- vi. Theos shall be free to register its own mark

- 'THEOS'/'THEO'S' as a word mark or in any logo form thereof, and use the same only in respect of goods and services offered in the Delhi-NCR region. The applications or registrations of the said marks by Theos shall be geographically restricted to the Delhi-NCR region.
- vii. Neither party shall oppose each other's marks or object to the same, in any manner, so long as the same are in compliance with the terms of this settlement.
 - viii. If Theos receives any requests for online supply or deliveries outside the Delhi-NCR region, the same shall be serviced under a different mark and name, as set out in (v) above. The said mark/name shall not be identical or deceptively similar to 'THEOBROMA'.
 - viii. Theobroma is free to expand its outlets under the mark/name 'THEOBROMA' across the country. However, Theos shall be restrained to the Delhi-NCR region, insofar as its goods and services provided under the mark/name 'THEOS'/'THEO'S' is concerned.
 - ix. There are various disputes pending between the parties before the Registrar of Trademarks, apart from the aforementioned two suits, as also, other cancellation petitions, etc. All the disputes between the parties would stand resolved, in the above terms.
 - x. Parties have agreed to abide by the terms of settlement which have been dictated by the Court today and set out hereinabove.

10. Ld. Counsels for the parties submit that they wish to file a comprehensive joint application under Order XXIII Rule 3 CPC, setting out the settlement terms elaborately. Let the said application be filed, within two weeks.

11. List on 24th August, 2022, for receipt of the settlement application.

12. This is a part-heard matter.

PRATHIBA M. SINGH
JUDGE

JULY 29, 2022

dj/ad

HIGH COURT OF DELHI



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