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

+ **CS(COMM) 126/2024**
OIKOS S.P.A

..... Plaintiff

Through: Mr. Rahul Tyagi, Ms. Pratiksha Dwivedi and Ms. Nikita C.,
Advocates.

versus

OIKOS INDIA PVT LTD & ANR.

..... Defendants

Through: Mr. Aditya Madan and Ms. Roopa Dayal, Advocates for D-1 & 2.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

ORDER

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09.02.2024

I.A. 3137/2024(seeking exemption from filing court fees)

1. Mr. Rahul Tyagi, counsel for Plaintiff, states that the Plaintiff has inadvertently transferred the sum of INR 2,46,424/-, payable towards court fee, to the account of e-stamp portal instead of e-court fee portal. Consequently, the Registry has instructed them to approach the SCHIL Office with the request to refund the said amount. Mr. Madan states that they have already applied for the refund, and undertakes to deposit the court fee within two weeks from today.

2. The aforementioned statement is taken on record and shall be binding on the Plaintiff. Accordingly, the application is disposed of.



I.A. 3135/2024(seeking exemption)

3. Exemption is granted, subject to all just exceptions.
4. Plaintiff shall file legible and clearer copies of exempted documents, compliant with practice rules, before the next date of hearing.
5. Disposed of.

I.A. 3134/2024(seeking leave to file additional documents)

6. This is an application seeking leave to file additional documents under the Commercial Courts Act, 2015.
7. If Plaintiff wishes to file additional documents at a later stage, they shall do so strictly as per the provisions of the said Act.
8. Disposed of.

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9. Let the plaint be registered as a suit.
10. Issue summons. Mr. Aditya Madan, Advocate, appears on advance service and accepts summons on behalf of Defendants. He confirms receipt of the suit paper-book and waives the requirement for Registry to issue formal summons. Written statement(s) shall be filed within 30 days from today. Along with the written statement(s), the Defendants shall also file affidavit(s) of admission/denial of the documents of the Plaintiff, without which the written statement(s) shall not be taken on record.
11. Liberty is given to the Plaintiff to file replication(s) within 15 days of the receipt of the written statement(s). Along with the replication(s), if any, filed by the Plaintiff, affidavit(s) of admission/denial of documents of the Defendants, be filed by the Plaintiff, without which the replication(s) shall



not be taken on record. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.

12. List before the Joint Registrar for completion of pleadings and marking of exhibits on 15th April, 2024. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.

13. List before Court for framing of issues thereafter.

I.A. 3133/2024(under Order XXXIX Rules 1 and 2 of CPC for interim injunctions) & I.A. 3136/2024(under Order XXVI Rule 9 of CPC for appointment of Local Commissioner)

14. Issue notice. Mr. Aditya Madan, Advocate, accepts notice on behalf of Defendants.

15. Mr. Rahul Tyagi, counsel for Plaintiff, has set out the following facts and contentions:

15.1. Plaintiff is the proprietor of the trademark 'OIKOS', registered bearing No. 2630564 in Class 99. Further, Plaintiff has also registered its name 'OIKOS' in the country of Italy, and is the sole, exclusive and legitimate owner of the mark.

15.2. Plaintiff has been supplying its goods, including paints and wall textures, through several distributors in India. Defendant No. 1 was appointed as one such distributor and authorized to market and sell the Plaintiff's products in India. The longstanding business relationship between the Plaintiff and Defendant No. 1 operated on the basis of a mutual oral understanding between them, and until the year 2022, Plaintiff would supply its goods in accordance with the orders received from the Defendants.

15.3. On 1st February, 2023, Plaintiff entered into a formal agreement with



one M/s Sirca Paints India Limited and consequently terminated their business relationships with all erstwhile distributors operating in India, including Defendant No. 1. They notified the distributors of the same *via* email with instructions to cease marketing goods and/or utilising the Plaintiff's name. However, despite the same, Plaintiff received information that the Defendants were continuing to use the mark/ name 'OIKOS', which was identical to the Plaintiff's registered trademark.

15.4. Accordingly, on 19th October, 2023, Plaintiff issued a communication to Defendant No. 2/ Mr. Deepak P. Gupta, authorised person of Defendant No. 1, directing them to stop utilising the Plaintiff's brand name in any manner and also to remove any mention/ use/ association with the Plaintiff's mark 'OIKOS' from its websites/ social media accounts/ product listing. A copy of the said e-mail communication has been handed over to the counsel for Defendants and also shown to the Court. The same is directed to be filed through e-filing counter.

15.5. No response has been received to the said e-mail, however, Defendants are still using the Plaintiff's trademarks and logo on their social media accounts and while marketing their products. Further, Defendants are also operating a website called www.oikosindia.com, through which they are misdirecting consumers by promoting/ selling their products using the Plaintiff's mark. In such circumstances, Plaintiff has filed the instant application seeking interim protections.

16. These contentions are strongly controverted by Mr. Madan, who has submitted as follows:

16.1. At the outset, he points out that the Plaintiff has made a false statement at Paragraph No. 7 of the plaint regarding ownership of the



aforementioned trademark 'OIKOS'. While Plaintiff is a company named 'OIKOS S.P.A.', the registration certificate for the trademark 'OIKOS' is in the name of 'OIKOS S.R.L; the Plaintiff has not presented any authority/assignment in their favour permitting them to use the said mark.

16.2. Further, Plaintiff has concealed material facts from this Court by claiming that there was only an oral arrangement between the parties. In fact, there was a written agreement executed on 15th July, 2003 [**“Written Agreement”**]. A copy thereof has been handed over to the counsel for Plaintiff and also shown to the Court. The same is directed to be filed through e-filing counter.

16.3. As per Clause 4.2 of the Written Agreement, even in case the Plaintiff withdraws their permission to use their marks, the Defendants would still be allowed to sell the existing stock of material. The products being sold by the Defendants is from the stock available with them from material already supplied by the Plaintiff. Thus, since the Defendants are not independently manufacturing any products using the Plaintiff's mark, all sales are being effected strictly in accordance with the terms of the Written Agreement.

16.4. Therefore, irrespective of the objections raised today, in light of the fact that the business relationship between the parties has come to an end, Defendants would still be allowed a period of ninety days to dispose of their existing stock. Thereafter, they are willing to also close the operation of the website which is impugned in the present suit, and accordingly, the matter may be resolved.

17. When confronted with the aforenoted objections, Mr. Tyagi clarifies that the Plaintiff is a part of the OIKOS S.R.L group of companies. However, he states that he will take instructions on these aspects to ascertain



whether there has been any mistake on the Plaintiff's part in drafting the plaint.

18. What emerges from the stand taken by Mr. Madan is that the Defendants are inclined to resolving the present dispute. However, Mr. Tyagi expresses apprehension that Defendant is independently manufacturing their products which are being sold using the Plaintiff's mark. Accordingly, he presses for appointment of a Local Commissioner to verify whether the sale of goods by the Defendant is being done from the supplies made by the Plaintiff.

19. In view of the above, the following directions are issued:

19.1. Ms. Elisha Sinha, Advocate [Contact No. +91 9899150774], is appointed as Local Commissioner, who is directed to visit the Defendant's premises and report as to whether the packaging of the products using the brand name 'OIKOS' is being done by the Defendants from the material supplied by Plaintiff or not.

19.2. The Local Commissioner shall visit the premises of Defendants at:

*No. 140, First Floor, Unit 3, Tribhuvan Complex,
Ishwarnagar, Mathura Road, New Delhi – 110065, India.*

19.3. Local Commissioner, along with a representative of Plaintiff and their counsel, shall be permitted to enter upon the premises of Defendants mentioned above and/or any other location/ premises that may be identified during the course of commission. Local Commissioner shall conduct a search at the premises and inventorise any material bearing the Plaintiff's trademark 'OIKOS'.



19.4. Local Commissioner shall also be permitted to make copies of the books of accounts including ledgers, cash registers, stock registers, invoices, books, etc. insofar as they pertain to the infringing products.

19.5. Local Commissioner shall be permitted to undertake/arrange for photography/ videography of the execution of the commission. Both the parties shall render full assistance to the Local Commissioner for carrying out the aforementioned directions.

19.6. In case any of the premises are found locked, Local Commissioner shall be permitted to break open the lock(s). To ensure an unhindered and effective execution of this Order, the SHO of the local police station is directed to render all assistance and protection to Local Commissioner, if and when sought.

19.7. The fee of the Local Commissioner, to be borne by the Plaintiffs, is fixed as INR 1,10,000/-. Plaintiffs shall also bear expenses for travel and lodging of the Local Commissioner and other miscellaneous out-of-pocket expenses for execution of the commission. Fee of the Local Commissioner shall be paid in advance by Plaintiff.

19.8. The commission shall be executed and report shall be filed within one week from today.

20. With the aforementioned directions, I.A. 3136/2024 is disposed of.

21. List before the Court on 23rd February, 2024.

22. *Dasti* under the signatures of Court Master.

SANJEEV NARULA, J

FEBRUARY 9, 2024

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