



2025:DHC:6128



* IN THE HIGH COURT OF DELHI AT NEW DELHI

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Reserved on: July 18, 2025
Pronounced on: July 28, 2025

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CS(COMM) 593/2021 & I.A. 36529/2024

FERRERO SPA & ORS

....Plaintiffs

Through: Mr. Pravin Anand, Ms. Vaishali R
Mittal and Mr. Shivang Sharma,
Advts.

Versus

M.B. ENTERPRISES

...Defendant

Through: None.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

Preface:

1. The plaintiffs, *vide* the present *lis* seek passing of a decree of permanent injunction for infringement of its trademark, passing off, delivery up and damages against the defendant in respect of its trademark 'NUTELLA' and **nutella**.

2. On 24.11.2021, this Court, after issuing summons of the suit to the defendant, granted an *ex parte ad interim injunction* in I.A. 15235/2021, an application under *Order XXXIX rules 1 & 2* of the Civil Procedure Code, 1908 (*CPC*), in favour of the plaintiffs and against the defendant.

3. Despite service, since the defendant neither entered appearance nor filed its written statement, the right of the defendant to file written



statement was closed and the defendant was also proceeded *ex parte vide* order dated 20.11.2023. Further vide the same order dated 20.11.2023, the interim order dated 24.11.2021 was also made absolute pending disposal of the present suit.


4. Under these circumstances, the plaintiffs have filed I.A. 36529/2024 under *Order VIII rule 10* of CPC for passing a summary judgment against the defendant.

Brief facts:

5. The plaintiffs are part of the world-renowned Ferrero Group, established in the year 1946 and currently one of the leading chocolate producers and confectionery companies in the world. The plaintiffs' products are sold across the globe in over 170 countries, either directly or through authorized distributors, under its popular brands/ trademarks namely FERRERO ROCHER, NUTELLA, TIC TAC, KINDER, KINDER JOY, KINDER BUENO, KINDER SCHOKO-BONS, CONFETTERIA RAFFAELLO, FERRERO RONDNOIR, and a host of other brands/ trademarks.

6. The plaintiffs first coined and adopted the mark 'NUTELLA' in the year 1964 and began using it for their novel hazelnut cocoa spread, popularly known for being a delectable and distinct sweetened hazelnut cocoa spread enriched in a thick creamy layer. In fact, the products under the trademark 'NUTELLA' of the plaintiffs are present in over 50 countries, across 5 continents and the plaintiffs run 31 production plants employing around 34,000 people.



7. The plaintiffs' came up with its iconic 'NUTELLA' jar , consisting of a unique colour combination and logo in the year 1964. The plaintiffs' hazelnut cocoa spread is, *inter alia*, sold in unique wide necked glass jars with a plastic white cap wherein, each jar has a label with the unique black and red colour coded word mark **nutella** along with an illustration of a slice of bread with the hazelnut cocoa spread, a knife dipped in hazelnut cocoa spread, a jar of milk, two hazelnuts, the unique yellow flowers and leaves.

8. While the plaintiffs' NUTELLA products have been made available in the Indian market by the plaintiff no.3 since at least 2009, it was available in India through myriad channels from much earlier. In fact, the plaintiffs' 'NUTELLA' completed 50 years of presence in the market in the year 2014.

9. For carrying on with its business activities, the plaintiffs have, upon application, been granted registration for the trademark 'NUTELLA' and its variations under Class(es) 3, 5, 7, 8 to 12, 14 to 16, 18, 20, 21, 24, 25 to 28, 30, 31, 34, 38, 39 and 43, the earliest registration dating back to the year 1975.

10. The defendant is trading as M/s. M.B. Enterprises and is *inter alia* engaged in the business of manufacturing, supplying, distributing and selling large quantities of counterfeit 'NUTELLA', i.e. hazelnut cocoa spread bearing an identical trademarks, labels, and trade dress to the plaintiffs.



Case of the plaintiffs:

11. Learned counsel for the plaintiffs submitted that the plaintiffs first learnt about the defendant when it received a letter from Dr. R.D. Munde Food Safety Officer under the Food & Drug Administration¹ on 29.10.2021, requesting the representatives of the plaintiff no.3 to appear before him on or before 29.10.2021 as earlier that month the FDA Department had, during a raid, found the defendant herein to be manufacturing hazelnut cocoa spread under the brand 'NUTELLA FERRERO' under unhygienic conditions at its premises situated at Gala No.16, Ekvira Laghu Udyog, Road No.25, Behind New Passport Office, Wagle Estate, Thane (W), Maharashtra-400604.

12. Learned counsel submitted that the FDA officials informed the plaintiffs that during the raid, the Department seized 9,53,400 units of counterfeit 'NUTELLA' and about 4,00,000 units of packaging material including labels, bottles and lids of 'NUTELLA' from the premises of the defendant herein.

13. Learned counsel also submitted that the plaintiffs are the prior adopters and registered proprietors of the 'NUTELLA' trademarks. Hence, they are entitled to exclusively use the said trademarks in relation to the goods for which the said registrations have been secured. He submitted that the defendant is using a trademark, packaging and trade dress which is identical to the plaintiffs' genuine 'NUTELLA' trademark, with the aim to deceive the ordinary members of public into purchasing the counterfeit

¹hereinafter referred to as '**FDA**'



products under the false impression that the same is genuine and originating from the plaintiffs.

14. Learned counsel further submitted that the defendant's action of manufacturing, supplying, distributing and selling low-quality, fake and spurious 'NUTELLA' is patently dishonest and illegal, and is aimed at taking unfair advantage of the plaintiffs' goodwill and reputation associated with the said 'NUTELLA' trademarks. Further, the aforesaid does not only significantly dilute and tarnish the plaintiffs' trademark but, being an edible item, also poses a major health risk to the consumers.

15. Learned counsel then prayed for declaration of 'NUTELLA' trademark as well-known. He submitted that ever since the first jar of the 'NUTELLA' left the plaintiffs' factory on 20.04.1964, due to its unique and distinctive name, packaging and taste, it is widely recognized as a household name, is extremely popular among consumers across countries, age groups and segments, and exclusively associated with the plaintiffs.

16. Learned counsel further submitted that the plaintiffs take great measures to consistently ensure high quality and taste of 'NUTELLA', which practice has played a major role in creating and maintaining enviable popularity and demand of 'NUTELLA' in markets across the world, and has led to the acquisition of immense distinctiveness, due to which, consumers and members of the trade associate 'NUTELLA' solely and exclusively with the plaintiffs' hazelnut chocolate spread delicacy.

17. Learned counsel further submitted that the plaintiffs' trademarks

'NUTELLA'/ **nutella**



and trade dress are well recognized



in India and globally due to its long-standing use, extensive marketing, and unique trade dress. In fact, the plaintiffs 'NUTELLA' completed 50 years of presence in the Indian market in the year 2014.

18. Learned counsel then submitted that the plaintiffs have spent considerable amount of money in advertising and promoting the 'NUTELLA' hazelnut spread in India. Further, the goodwill and reputation can also be ascertained from the advertisement/ promotional expenditure incurred as also the annual sales figures recorded against the plaintiffs' 'NUTELLA' products, both of which run into crores of rupees.

19. Learned counsel for the plaintiffs submitted that the plaintiffs' 'NUTELLA' trademarks have been declared as well-known by the World Intellectual Property Organization², as is evident from the numerous orders passed by the said Organization. Additionally, the International Trademark Association³ has also declared the plaintiffs' trademark 'NUTELLA' as well-known which is evident from the list of well-known marks published by the said Association.

20. In view of the foregoing submissions, learned counsel for the plaintiffs seek the trademark 'NUTELLA' to be declared as a well-known trademark under *Section 2(zg)*⁴ of the Trade Marks Act, 1999⁵.

Analysis and Findings:

²hereinafter referred to as '**WIPO**'

³hereinafter referred to as '**INTA**'


⁴**Section 2(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.





⁵hereinafter referred to as '**the Act**'



21. This Court has heard the submissions advanced by the learned counsel for the plaintiffs and gone through the pleadings as also perused the documents on record.

22. Before delving into the facts of the present case, as per records, since the defendant despite being duly served, has not filed any response to the averments raised by the plaintiffs and have already been proceeded *ex parte*, the averments made by the plaintiffs herein being without any response/ denial, are deemed admitted as true and correct.

23. As per records, the plaintiffs are the registered proprietors of the trademark 'NUTELLA'/  and its variations under various Class(es) 3, 5, 7, 8 to 12, 14 to 16, 18, 20, 21, 24, 25 to 28, 30, 31, 34, 38, 39 and 43, the earliest registration dating back to the year 1975. The details are as under:-

S.NO	Trademark	Application No.	Class	Application Date	Status
1.	NUTELLA (Word Mark)	302453	30	28.01.1975	Registered
2.		681335	30	25.09.1995	Registered
3.		1927433	30	25.02.2010	Pending
4.		2365389	30, 43	18.07.2012	Registered
5.		3015008	43	22.07.2015	Registered



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6.		2710083 [24389-D/2013]	30	18.11.2013	Protected
7.	NUTELLA BREADY	2408938	30	10.10.2012	Registered
8.		3270379	30	20.08.2015	Protected
9.		2808613	30	15.09.2014	Registered
10.		3536605	30	19.01.2017	Protected
11.		3932752	30	01.08.2018	Protected
12.		3939121	30	16.02.2018	Protected
13.		3602034	3,5,7,8, 9,11,12, 14,15,16 18,20,21 24,25,26 27,28,31 34,38,39 43	04.11.2016	Protected



24. When the FDA conducted a raid at the premises of the defendant situated at Gala No.16, Ekvira Laghu Udyog, Road No.25, Behind New Passport Office, Wagle Estate, Thane (W), Maharashtra-400604 and seized large quantities of counterfeit 'NUTELLA'/ **nutella**, labels, empty jars, etc. from the premises belonging to the defendant, the plaintiffs for the first time discovered that the defendant is engaged in the business of manufacturing and packaging of counterfeit 'NUTELLA'/ **nutella**, i.e. hazelnut cocoa spread bearing an identical trademark and trade dress as that of the plaintiffs. It is so shocking that the defendant was using the identical name, identical packaging, identical labels, identical trade dress without any authorisation/ permission/ consent of the plaintiffs. This clearly shows the *mala fide* intent of the defendant as it was/ is guilty of using the registered trademarks of the plaintiff and clandestinely carrying on manufacturing/ offering/ selling/ marketing the impugned products with an intent to somehow reflect that it was the plaintiffs and/ or connected with them in some manner as also to ride upon the well-established goodwill and reputation of the plaintiffs.

25. Under such circumstances, more so, whence the plaintiffs are the registered proprietors of the trademarks 'NUTELLA'/ **nutella** and its variants, and the defendant is not only clearly infringing but also passing off the same, the plaintiffs are well and truly entitled for the reliefs under *Section 28* of the Act.

26. In fact, the acts of the defendant raises alarming bells as the product involved herein are edible items, which are consumed by all sections of



the society, especially, children. Since the counterfeit products of the defendant under the very same trademark of the plaintiffs 'NUTELLA'/ **nutella** are available in the open market, without any checks and balances with ease, the same needs to be regulated as it can be harmful for human consumption. If not stopped, the same can cause serious public harm. This can also result in dilution of the long-standing reputation and goodwill of the plaintiffs.

27. This Court while dealing with edible items for human consumption, owes a duty of exercising a greater degree of care, caution as also to apply a more stringent test to avoid any possibility/ likelihood of confusion between different edible products amongst the general public. The aspect of due diligence and circumspection is necessary as any deceptive similarity and confusion between trademarks for products involving consumables could have dangerous implications and cause detriment to the public at large. Reliance is placed upon *Cadila Health Care Limited Vs Cadila Pharmaceuticals*⁶ wherein, although the issue involved was *qua* pharmaceutical products, however, extending the same analogy to trademarks/ products involving food items/ consumables, this Court has to tread with utmost care and caution. The same has also been observed by a co-ordinate Bench of this Court *vide* order dated 26.09.2023 in CS(COMM) 587/2022 titled *Dominos IP Holder LLC vs. MS Domnick Pizza* wherein it has been held that "... ..where the marks in question pertain to food items, or eateries where food items are dispensed and

⁶(2001) 5 SCC 73



served, a somewhat higher degree of care and caution is expected to be observed.”.


28. All the above clearly reflects the *mala fide* intent of the defendant as it was clearly guilty of using the registered trademarks of the plaintiffs and clandestinely carrying on its business of manufacturing/ offering/ selling impugned products with an intent to ride upon the well-established goodwill and reputation of the plaintiffs. Further, the defendant never appeared despite being duly served and also never filed its written statement also speaks volumes of its conduct and raises a suspicion over it.

29. As such, if the defendant is allowed to continue under such circumstances, it is likely to result in causing utter confusion, lead to deception and cause damage amongst the members of the public at large as also to the long well-established goodwill and reputation of the plaintiffs as well. This is particularly since the defendant is operating/ dealing in the same trade channels, with an identical customer base.

30. Accordingly, the defendant, its partners, proprietors, sister-concerns, affiliates, franchisees, officers, servants, agents, distributors, stockists, representatives, licensees and anyone acting for or on their behalf directly or indirectly, as the case may be, are permanently restrained from manufacturing, packaging, supplying, distributing, selling, offering for sale, advertising, and dealing in any manner whatsoever with counterfeit ‘NUTELLA’ or any product not emanating from the plaintiffs or their authorised distributors and bearing the trademark ‘NUTELLA’,



, or any other mark, trade dress identical or similar to the plaintiffs 'NUTELLA' trademarks thereby amounting to infringement of the plaintiffs' trademarks and passing off.

31. Qua prayers (viii) and (ix) of the plaint relating to damages and costs, considering that the institution of the present suit is *per se* based on the *mala fide* acts of the defendant, who as per the plaint, have been manufacturing, packaging and selling counterfeit 'NUTELLA', i.e. hazelnut cocoa spread bearing an identical trademarks, labels, and trade dress to that of the plaintiffs, the same has resulted in the plaintiffs encountering unwarranted litigation leading to it not only suffering damages on that account as also incurring financial expenditure and actual cost(s). Not only that, the value of quantities of counterfeit 'NUTELLA'/ , labels, empty jars, etc. found at the time of the raid conducted by the FDA at the premises of the defendant, on a conservative estimate made by the plaintiffs, as per the MRP of their own similar products is reaching upto Rs.38,29,60,000/- (*Thirty Eight Crores Twenty Nine Lacs Sixty Thousand Only*).

32. As such, taking the aforesaid into consideration and taking a lenient view, in the considered opinion of this Court, the plaintiff is cumulatively entitled to a sum of Rs.30,00,000/- (*Thirty Lacs Only*) towards damages of the present proceedings. However, considering the factual matrix involved, the defendant is also burdened with costs and special costs of Rs.2,00,000/- (*Rupees Two Lacs Only*) payable to Delhi High Court Bar



Association Lawyers Social Security and Welfare Fund [A/C 155530100009730; IFSC UCBA0001553] within *six weeks* from today.

33. Accordingly, the present suit is allowed and a summary judgment is passed in favour of the plaintiffs and against the defendant in terms of the aforesaid.

34. The Registry is directed to draw up decree sheet accordingly.

35. Coming to the plaintiffs' prayer for declaration of their trademarks

'NUTELLA'/ **nutella** as a '*well-known trademark*', as per the provisions of *Section 2(zg)* and *Section 11(6)*⁷ of the Act, the said trademarks 'NUTELLA'/ **nutella** of the plaintiffs have to be such that they have become so well-known to a substantial segment of the public that its use on other goods or services is likely to indicate a connection between those goods or services and the person using the mark in relation to the first-mentioned goods or services. In order to ascertain such declaration, the factors that need to be considered *inter alia* are knowledge or recognition obtained by way of promotion of the said trademark, duration, extent and geographical area of use of the said

⁷*Section 11(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;
- 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



trademark and record of successful enforcement of the rights vested in the said trademark.

36. As per records before this Court, the plaintiffs have been continuously and uninterruptedly using the said mark(s) 'NUTELLA'/ **nutella** since and from 1946 and have valid and subsisting registration thereof from the year 1975. In fact, the plaintiffs' trademark 'NUTELLA' completed 50 years of its presence in the Indian market in the year 2014. Thus, by virtue of its long-standing use, extensive marketing, and unique trade dress, 'NUTELLA'/ **nutella** has become synonymous to a thick creamy hazelnut cocoa spread. So much so, the trademark 'NUTELLA'/ **nutella** has been advertised by the plaintiffs all across India *qua* which the plaintiffs have spent Rs.3 Crore, Rs.7 Crore and Rs.16 Crores from the financial years 2020-21, 2021-22 and 2022-23 respectively as also had gross sales figures of Rs.233 Crores, Rs.145 Crores and Rs.106 Crores for the financial years 2020-21, 2021-22 and 2022-23 respectively.

37. This leaves no shadow of doubt that plaintiffs are well established in the markets all across the globe and are not mere fly by night operators. Their registered trademarks 'NUTELLA'/ **nutella** and its variants are recognised all across the globe, including but not limited to India. The plaintiffs have been able to cross the threshold of their registered trademarks 'NUTELLA'/ **nutella** being declared as 'well-known trademark' as per Section 2(zg) of the Act. The said registered trademarks



‘NUTELLA’/ **nutella** of the plaintiffs have already been declared as ‘*well-known trademark*’ by the World Intellectual Property Organization and the International Trademark Association.

38. In view of the aforesaid, this Court has no hesitation in declaring the trademarks ‘NUTELLA’/ **nutella** of the plaintiffs as ‘*well-known trademark*’ respectively under *Section 2(zg)* of the Act.

39. Accordingly, the present suit is decreed in the aforesaid terms and is disposed of alongwith pending application.

SAURABH BANERJEE, J.

JULY 28, 2025