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

\+ RFA(OS)(COMM) 1/2026 & CM APPL. 331/2026

MR. ABHIMANYU PRAKASH & ORS. .....Appellants

Through: Mr. Samrat Nigam, Sr. Adv. with Mr. Akshay Srivastava, Ms. Krati Tiwari and Ms. Arpita Khanna, Advs.

versus

FERRERO S.P.A & ORS. .....Respondents

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

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT(ORAL)

% 06.01.2026

C.HARI SHANKAR, J.

1. This appeal assails judgment dated 19 November 2025 and order dated 8 December 2025 passed by a learned Single Judge of this Court in CS (Comm) 65/2023, to a limited extent.

2. We have heard Mr. Samrat Nigam, learned Senior Counsel for the appellants and Mr. Pravin Anand, learned Counsel for the respondents, at some length.

3. The proceedings emanate from a suit instituted by the respondents against the appellants seeking a decree of a permanent injunction, restraining the appellants from infringing the respondents'

registered trademarks.

4. Paras 2 and 3 of the impugned judgment dated 19 November 2025 set out the dispute in conspectus:

> "2. Plaintiffs have filed the present suit seeking a decree of permanent injunction restraining the Defendants from, inter alia, infringing the Plaintiffs' registered trademarks, including
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> ['NUTELLA glass jars'] 'NUTELLA/
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> ' and distinctive labels associated with the mark 'NUTELLA', passing off counterfeit goods under the identical mark along with other ancillary reliefs and for damages and costs.
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> 3. The facts which have come on record reveal that Defendant Nos. 1 to 3 are manufacturers and sellers of empty NUTELLA glass jars which is a near identical copy of the original Nutella jar. Defendant Nos. 1 to 3 state that the impugned NUTELLA glass jars manufactured by them is referred to as Nutella jar in their industry and the said Defendants were offering these glass jars on their website as NUTELLA glass jars. Defendant No. 4 admits offering the impugned NUTELLA glass jars for sale on its own website and third-party e-commerce websites as NUTELLA glass jars."

5. We need not enter into the niceties of the dispute, as the learned Single Judge ultimately deemed it appropriate to summarily decree the suit in terms of Order XIII-A of the Code of Civil Procedure,1908. While doing so, the learned Single Judge has noted, in paras 15 to 18 of the order dated 19 November 2025, as under:

> **"**15. The Plaintiffs are the registered proprietors of NUTELLA trademarks *including NUTELLA jar* across various territories around the world and have obtained registration under various Classes. The products of the Plaintiffs under the distinctive and

proprietary NUTELLA, 
trademarks and brand NUTELLA are made available for sale throughout India in different sizes, i.e. 180 ml, 350 ml and 750 ml.

16. Defendant Nos. 1, 2 and 3 are manufacturers and sellers of empty glass jars in 180 ml, 350 ml and 650 ml sizes which are deceptively similar to the Plaintiffs' Nutella jar  . The Defendants were manufacturing the said impugned NUTELLA glass jar without any authorisation from the Plaintiffs, and offering the product for sale through their respective websites and online platforms.

17. In these facts, when the Plaintiffs filed the present suit, vide order dated 06.02.2023, as also modified on 08.02.2023, Coordinate Bench of this Court granted an ex-parte ad-interim injunction restraining the Defendants from dealing with the impugned 'NUTELLA glass jars'. *Vide order dated 06.02.2023, the Court also appointed three Local Commissioners to inventorize and seize infringing material found at the premises of Defendant Nos. 1 to 3."*

18. *The said injunction order dated 06.02.2023 was not contested and in fact Defendants consented to its confirmation on 12.08.2025. As noted above, the injunction order was made absolute on 12.08.2025."*

(Emphasis supplied)

6. The learned Single Judge has ultimately awarded costs and has further directed, apropos the seized jars, as under:

"39. In addition, *since the impugned 3,05,916 jars seized from location 18 and 09 jars seized from location 29 have been held to be infringing*, Defendant Nos. 1 to 3 shall handover all these seized jars to the Plaintiff within two (2) weeks. The Plaintiff will be at liberty to use these glass jars as it deems fit for its own use. In case, the Plaintiff does not wish to use the jars for its own products for retail selling, it may consider using these jars for filling up its

products and donating to NGOs who feed the poor, as a part of its CSR ['Corporate Social Responsibility'] initiative. The value of the seized jars has been assessed by the Plaintiff as Rs. 62.84 lakhs and this handover of inventory results in losses to the Defendant Nos. 1 to 3 as well will act as deterrent against the Defendant Nos. 1 to 3. The Defendants will destroy all the other packaging material found and seized at the aforesaid premises, during the local commission, in the presence of the representative of the Plaintiff within four (4) weeks."

(Emphasis supplied)

7. We may also reproduce, in this context, paras 30 to 37 of the order dated 19 November 2025, thus:

"30. The Defendant Nos. 1 to 3 have not filed any evidence with their written statement to substantiate their plea that the empty glass jars are generically referred to as Nutella jars in the manufacturing industry *and that Defendant Nos. 1 to 3 bonafide manufactured the said impugned NUTELLA glass jar without knowledge of the Plaintiff's proprietary rights in the shape of the glass jar.*

31. *This Court therefore finds no merit m the submission of the Defendant Nos. 1 to 3 that they are the first-time innocent infringer. Keeping in view the scale of operations of the Defendant Nos. 1 to 3 and especially their reference to the glass jars as NUTELLA jars on their website also shows that they are conscious about the goodwill and reputation of the Plaintiff's registered shape mark for the glass jar.*

32. The Plaintiff has pleaded that its Nutella products have been available in the Indian market since 2009 and keeping in view the considerable market presence of the Plaintiffs ' products in India, the submission of the Defendant Nos. 1 to 3 that they were unaware about the Plaintiffs ' proprietary rights in the shape mark for the jar fails to persuade this Court. The Defendant Nos. 1 to 3 's submission that there are other manufacturers in the industry who manufacture identical infringing jars would not justify the Defendants infringing actions. In these facts, *this Court finds that the Defendant Nos. 1 to 3 are first-time knowing infringers.*

33. The Plaintiff has contended that the seized goods (empty glass jars) from location no. 2 bear an embossing (E20 O A) and counterfeit products seized in CS(COMM) 43/2021 and CS(COMM) 917/2022 also had the same embossing (E20 O A). However, this pleading by itself is not sufficient to connect the

Defendant Nos. 1 to 3 herein with the defendants of the other suits. The Plaintiff, in this suit, has not placed on record any further documents to show that Defendant Nos. 1 to 3 were involved in the sale of the finished counterfeit products sold in the impugned glass jars along with the defendants of the other suits. Defendant Nos. 1 to 3 have stated that this embossing (E20 O A) was done at the instance of its customer. Plaintiff has elected not to pursue the said customer in these proceedings. In these facts this Court is unable to draw any further adverse inference against Defendant Nos. 1 to 3.

34. This Court finds no material on record to bold that Defendant Nos. 1 to 3 have colluded with third parties to sell counterfeit products of NUTELLA. There is also no iota of evidence in this suit with respect to any sale of counterfeit finished products by Defendant Nos. 1 to 3. Therefore, the claim of the Plaintiff in its written note for damages for Rs. 53.3 crores on an imaginary value of finished counterfeit products of Rs. 533.10 crores is not tenable. In any event, no such pleading was made in the application.

35. The undisputed reports of the Local Commissioners and the documents filed by the Defendant Nos. 1 to 3 itself provide a reasonable basis to make an assessment for the average turnover of the empty glass jars which the said Defendant Nos. 1 to 3 had from October 20207 till February 2023. And, by applying the Rule 20 of the IPD Rules, an assessment of the profit margin can be made.

36. The contention of the Defendant Nos. 1 to 3 that they are first-time innocent infringers in terms of the ***Koninlijke Philips***[1] (supra) judgment, appears not to be true to this Court, instead this Court in view of the said judgement finds that the Defendant Nos. 1 to 3 are first-time knowing infringer.

37. There is no other known case of infringement shown by the Plaintiffs against the Defendant Nos. 1 to 3. The Defendant Nos. 1 to 3 have also elected to consent to the decree of permanent injunction and not compelled the Plaintiffs to go through trial. Keeping in view all these facts, this Court is of the considered opinion that Defendant Nos. 1 to 3 are liable to be injuncted permanently, to pay partial legal costs to the Plaintiff as well as the permanent seizure of the inventory of impugned goods made by the Local Commissioners to handover to the Plaintiff, in terms of the aforesaid judgment ***Koninlijke Philips*** (supra). Therefore, this Court is not undertaking an assessment of the turnover value of the empty glass jars manufactured by the Defendants between October 2020 and February 2023."

[1] **Koninlijke Philips and Ors. v. Amazestore and Ors. 2019 SCC OnLine Del 8198**

8. The appellants, thereafter, moved IA 30639/2025 seeking modification of the aforenoted judgment dated 19 November 2025.

9. The said application stands decided by order dated 8 December 2025, which is also subject matter of challenge before us. In the said order, the learned Single Judge has recorded the statement of the learned Counsel for the appellants that they had no objection to payment of legal costs as directed by the learned Single Judge. However, apropos the direction to release the seized jars to the respondents, the appellants sought to contend that the jars were ordinary glass jars which could be used for several other purposes such as packing of honey, jams, pickles etc which would not, in any way, prejudice the respondents.

10. This submission has apparently not found favour with the learned Single Judge, who did not choose to modify her earlier judgment.

11. Accordingly, by order dated 8 December 2025, the learned Single Judge has dismissed IA 30639/2025.

12. The appellants are in appeal before us against the aforesaid orders.

13. Mr. Pravin Anand has fairly undertaken that, in case the jars are released to the respondents, they would destroy the jars in accordance

with Section 135(1)[2] of the Trade Marks Act and do not intend to put them to any commercial purpose.

14. Mr. Nigam, however, submits that there is no positive finding in the judgment dated 19 November 2025 to the extent that the jars in question were infringing jars. In fact, he has placed reliance on paras 33 and 34 to contend that the learned Single Judge has found the appellants not to be infringers. In such circumstances, he submits that there is no justification in releasing the seized jars to the respondents especially as the appellants had categorically stated that they were willing to use the jars for other purposes such as packing of honey, pickles etc. He submits that destroying the jars would serve no public purpose whatsoever.

15. We are unable to agree with Mr. Nigam in his contention that there is no finding in the judgment dated 19 November 2025 to the effect that the jars which were seized by the local Commissioner were infringing jars. In fact, the paragraphs from the judgment dated 19 November 2025, extracted *supra*, not only hold that the jars were infringing but also treat the appellants as knowing infringers.

16. These findings, in our view, are not open to contest any further by the appellants in view of their themselves having taken a stand before the learned Single Judge in IA 30639/2025 that they were contesting the earlier judgment dated 19 November 2025 only to the

[2] **135. Relief in suits for infringement or for passing off**. –
(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

extent it directed release of the seized jars to the respondents. The findings in the judgement dated 19 November 2025 have, therefore, attained finality.

17. Once the jars are held to be infringing, the sequitur which follows from Section 28(1)[3] read with Section 135(1) of the Trade Marks Act is inexorable. We have noted that, even in the opening paragraphs of the judgment dated 19 November 2025, the respondents were asserting their right in the bottle itself as a registered trademark. The learned Single Judge has noted this contention.

18. Section 28(1) of the Trade Marks Act grants, to every proprietor of a registered trademark, two rights.

19. The first right is the right to exclusive use of the trademark for the goods or services in respect of which the mark is registered.

20. The second right is to obtain relief against infringement as provided in the Trade Marks Act. Section 135 of the Trade Marks Act deals with the reliefs available in cases of infringement and Section 135(1) includes, among the reliefs, delivery up of the infringing goods *to the plaintiff for the purposes of erasure or destruction.*

21. The respondents had, in prayer (vii) of the plaint, specifically prayed that the infringing goods be delivered up to them for the

[3] **28. Rights conferred by registration**. –
(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

purposes of destruction.

22. In that view of the matter, we do not find any merit in the appellants' contest to the direction of the learned Single Judge to release the seized jars to the respondents. However, we are of the view that, given the mandate of Section 135(1) of the Trade Marks Act, the bottles could have been directed to be handed over to the respondent only for the purposes of destruction, and not for being put to any other use.

23. On this aspect, Mr. Anand, as we have already noted, has fairly stated that the respondents would destroy the jars.

24. Accordingly, we modify the impugned orders to the limited extent that the jars, on being released to the respondents, would be destroyed by the respondents and would not be put by the respondents to any other use, commercial or otherwise.

25. The appellants would also be entitled to have a representative present when the destruction of the jars takes place. For this purpose, let the destruction of the jars take place on 17 January 2026 at 11 am.

26. The appeal stands disposed of in the aforesaid terms.

C. HARI SHANKAR, J

OM PRAKASH SHUKLA, J

JANUARY 6, 2026/AR