



2025:DHC:2459



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

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Date of decision: 2nd April, 2025

+ C.O. (COMM.IPD-TM) 229/2023

**GLANBIA PERFORMANCE NUTRITION
LIMITED**

.....Petitioner

Through: Mr. Satvik Varma, Senior Advocate
with Ms. Sugandha Bhatia,
Mr. Shantanu Parmar and
Mr. Balram, Advocates

versus

HERCULES NUTRA PVT. LTD. & ANR.Respondents

Through: Mr. Nishant Mahtta and Mr. S.
Nithin, Advocates

CORAM:**HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present cancellation petition has been filed seeking removal of the trademark registration no.1763297 granted to the respondent no.1 for the



mark ' ' in class 5 from the register of trademarks.

2. Brief facts necessary for deciding the present petition are as follows:-

i. The petitioner, Glanbia Performance Nutrition Limited was incorporated under the laws of Ireland in January, 1948 and is affiliated with Glanbia Performance Nutrition (NA) Inc. and Glanbia



Performance (Manufacturing) Inc.

- ii. The Petitioner has been manufacturing various nutritional products, since 1986, under the mark “OPTIMUM NUTRITION”. The mark was later abbreviated as ‘ON’ with a swoosh arrow



device

- iii. The petitioner through its predecessors in title, established the



brand and other marks such as OPTIMUM, OPTIMUM NUTRITION, ON OPTIMUM NUTRITION and has been using the said marks for the last 35 years. Details of the registered marks of the petitioner in India are given in paragraph 11 (xi) of the petition and are set out below:-

Trade Mark	Reg. No.	Class
	1546416	5
	1578545	5
	3671391	5



- iv. The petitioner began the use of the mark globally in 1986.



v. The products of the petitioner were marketed and sold in India through distributors since the year 2000 and the products bearing the



trademark have been sold in India since 2003.

vi. The petitioner applied for the registration of the



mark on 3rd April, 2007 in class 5 claiming user since 1st February, 2003. The petitioner obtained the registration of the mark on 12th July, 2007.

vii. Subsequently, the petitioner has also applied for and been granted registrations for other device marks in India.

viii. It is stated that the petitioner has obtained registrations for its



trademark in various jurisdictions such as USA, Canada, Singapore and the like.

ix. The petitioner came across the respondent no.1 selling identical goods as that of the petitioner's, i.e. nutraceutical products through



www.amazon.in under the brand

x. Upon further investigation carried out by the petitioner, it came to light that the respondent No.1 has registered the impugned mark



in class 5 in respect of goods such as ayurvedic medicines and dietary food supplements. It was also discovered that the respondent no.1 is also operating a website bearing the domain name '<http://www.onnutrition.co.in>'.

xi. The petitioner served a cease-and-desist notice on the respondent no.1 on 19th May, 2022 which was replied to by the respondent no.1 refuting the allegations contained therein.

xii. Thus, the petitioner filed the present petition on 7th September, 2023.

3. Mr. Satvik Varma, senior counsel appearing on behalf of the petitioner submits that the petitioner is a prior adopter of the 'ON' mark and has been using the same globally since 1986. It is also stated that the said mark has been used in India since 2003.

4. It is stated that the respondent no.1 is using an identical mark in respect of identical products as that of the petitioner and the respondent no.1 has falsely claimed user of the impugned mark from 19th May, 2002 in its trademark application whereas as per the documents placed on record by the respondent no.1, the earliest use of the impugned mark by the respondent no.1 is from the year 2006.

5. Mr. Nishant Mahtta, counsel appearing on behalf of the respondent no.1 submits that the mark used by the respondent no.1 is dissimilar from the mark of the petitioner. It is further submitted that the respondent no.1 is a prior user of the impugned 'ON' device mark through its predecessor-in-title 'USA Drugs Pvt. Ltd.'. The said mark was subsequently assigned to the



respondent no.1 through an assignment deed dated 1st September, 2020. Therefore, it is wrong to state that a petitioner is a prior user of the ‘ON’ device mark.

6. I have heard counsel for the parties and examined the material on record.

7. It is an admitted position that the petitioner was granted registration of



the mark in class 5 w.e.f. 12th July, 2007, with a user claim of 1st February, 2003. Attention of the Court has been drawn to invoices from 15th September, 2000 till 21st April, 2003 (Document no.5, petitioner’s documents) issued by the petitioner to the petitioner’s Indian distributor ‘Neugen Nutrition Systems’. The invoice on page no.47 of the said document mentions a product bearing code 02342. Even though the said



invoice does not specifically mention the mark , however a reference to the catalogues advertising the petitioner’s products (page no.281, Document no.9, petitioner’s documents) shows the product bearing the code 02342, described as “100% natural whey protein 5 Lbs.” bearing



the petitioner's mark on the product. The same corresponds to the product code of the product sold by the petitioner to its Indian distributor as seen in the aforesaid invoices.

8. Attention of the Court has also been drawn to the archived website of the petitioner’s distributor through the Wayback Machine to evidence the



petitioner's products bearing the  mark were launched in India on or around 9th December, 2003.

9. Attention of the Court has also been drawn to a copy of the analytics data of the petitioner's website (page no.125, Document no.7, petitioner's documents) 'www.optimumnutrition.com' to evidence that a large number of people from India have been accessing the petitioner's website from 2007 till 2021.

10. The petitioner has also placed on record documents evidencing the extensive advertising and promotional activities of its products bearing the



 mark through print and social media. The petitioner has



also been actively promoting its products bearing the  mark in the Indian markets by sponsoring events and collaborating with well-known entities and celebrities. (Documents no.10 and 11, petitioner's documents).



11. Considering the lengthy and extensive use of the  mark, the petitioner has acquired immense goodwill and reputation for the



 mark in India.



12. It is also an admitted position that the earliest invoices placed on record on behalf of the respondent no.1 are of the year 2006. Pertinently, there is only one invoice for the year 2006 and few more invoices ranging from 2009-2015 and 2020-2023 (page no.57, document no.14, respondent no.1's documents). There is no document to show use from 2007-2008 and 2016-2019. Further, none of the invoices filed by the respondent no.1 depict the impugned mark, nor has the respondent no.1 provided any catalogue to evidence the products mentioned in the invoices. Additionally, the invoice dated 7th August, 2006 has been issued by one 'Canadian Corp.' to the petitioner no.1's predecessor-in-title and the said invoice lacks material specifications such as V.A.T. details, batch numbers and manufacturing dates. Therefore, the documents filed by the respondent no.1 in support of its prior user do not inspire confidence.

13. The F.S.S.A.I. license dated 16th July, 2020 and the Quality Control Certificate dated 18th November, 2023 indicate that the respondent no.1's products could only have been sold after the said licenses were obtained. Therefore, it is clear that the petitioner is a prior user of the 'ON' device mark.

14. At this stage, it may be relevant to compare the two marks:-

Petitioner's Mark	Respondent's Mark
	

15. A perusal of the marks would show that not only does the respondent no.1 use the mark 'ON' it has also copied the swoosh arrow appearing on



the petitioner's mark. Counsel for the respondent no.1 submits that the symbol adopted by the respondent is not swoosh but a ring around the word 'ON'. I am unable to agree. It is evident from the comparison above that the swoosh arrow adopted by the Respondent no.1 is deceptively similar to the swoosh arrow adopted by the petitioner. Additionally, the word 'ON' forms the most dominant portion of the respondent no.1's mark and the words 'NUTRITION' and 'GOLD' are used in a much smaller font size. In my considered opinion, the respondent no.1 has blatantly copied the petitioner's mark so as to come close to the same.

16. Further, no plausible explanation has been given by the respondent no.1 for the adoption of the impugned mark 'ON' for identical goods as that of the petitioner. The explanation provided by the respondent no.1 that 'ON' is an abbreviation for the 'organism with nutrients' was not stated in the respondent no.1's reply to the cease-and-desist notice and therefore, the same is clearly an afterthought.

17. The presence of an identical mark of the respondent in respect of the identical product would be prejudicial to the public interest and it would create confusion in the market. Not only is the trademark of the respondent no.1 confusingly/deceptively similar to the petitioner's prior adopted,



registered trademark 'ON', but the nature of the goods of the petitioner and the respondent no.1 are identical, i.e. nutritional supplements such as whey protein.

18. In view of the discussion above, it is clear that the impugned trademark has been adopted by the respondent no.1 dishonestly to trade



upon the established goodwill and reputation of the petitioner and to project itself to be associated with the petitioner. Therefore, the continuation of the impugned registration on the Register of Trade Marks is in contravention of the provisions of Sections 11 and 18 of the Act and is liable to be cancelled under Section 57 of the Act.

19. Accordingly, the present petition is allowed and the Trade Marks



Registry is directed to remove the impugned mark 'ON NUTRITION Gold', bearing no.1763297 in class 5 in the name of the respondent no.1 from the Register of Trade Marks.

20. The Registry is directed to supply a copy of the present order to the Trade Marks Registry, at e-mail: 'llc-ipo@gov.in', for compliance.

AMIT BANSAL, J

APRIL 2, 2025

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