



2025:DHC:9625-DB



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IN THE HIGH COURT OF DELHI AT NEW DELHI

Judgment reserved on: 17.09.2025

Judgment pronounced on: 03.11.2025

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FAO (COMM) 253/2023

SUPARSHVA SWABS INDIA

.....Appellant

Through: Mr. Sudarshan Bansal, Mr. Shivang Bansal, Mr. Amit Chanchal Jha, Mr. Shivendra Pratap Singh and Mr. Devansh Mishra Advs.

Versus

AGN INTERNATIONAL & ORS.

.....Respondents

Through: Mr. Sandiv Kalia, Adv.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

HON'BLE MR. JUSTICE OM PRAKASH SHUKLA

JUDGMENT

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03.11.2025

OM PRAKASH SHUKLA, J.

INTRODUCTION

1. The appellant has preferred the present appeal under Section 13(1) of the Commercial Courts Act, 2015¹ read with Order XLIII Rule 1(r) and Section 151 of Code of Civil Procedure, 1908², challenging the impugned order dated 03.10.2023 passed by the learned District Judge of Commercial Court, South, Saket, New Delhi,

¹“CC Act”, hereinafter

²“CPC”, hereinafter



whereby the application filed by the appellant under Order XXXIX Rules 1 and 2 of the CPC seeking interim injunction was dismissed.

2. For the sake of convenience, the parties to the present appeal would be referred by the same status and name as they have been referred to as before the learned District Judge. Thus, the “appellant” would be addressed as “plaintiff” and the “respondent” would be referred as “defendant”.

3. The plaintiff, namely, Suparshva Swabs India, is a partnership firm engaged in the manufacture and trade of cotton buds and cotton balls since the year 1999. It claims to be the prior adopter and user of the trade mark/label “**TULIPS**” (word and device of a bud) in respect of its goods, having obtained multiple registrations of the said mark in various classes under the Trade Marks Act, 1999³. It is the case of the plaintiff that the mark has, by reason of extensive, continuous and exclusive use, acquired goodwill, reputation, distinctiveness and secondary meaning in India and overseas.

4. The defendants are engaged in the business of perfume and cosmetic products, specifically fragrances. They have adopted and are in use of the trademark “**AGN TULIP**”(impugned mark) in respect of their products. The plaintiff alleges that the impugned mark is identical and deceptively similar to its “**TULIPS**” mark and that it has been adopted dishonestly and fraudulently with the intent to ride upon the goodwill and reputation already established by the plaintiff.

³ “the Act”, hereinafter



5. Briefly stating the facts leading up to the present appeal, the plaintiff instituted the suit seeking, *inter alia*, a decree of permanent injunction restraining the defendants from using the mark “**TULIP**” or “**AGN TULIP**” in relation to perfumes, cosmetics and allied goods, on the grounds of trademark infringement and passing off. Alongside, the plaintiff filed an interlocutory application under Order XXXIX Rules 1 and 2 of CPC, seeking temporary injunction to restrain the defendants from using the impugned mark during the pendency of the suit.

6. By way of the impugned order dated 03.10.2023, the learned District Judge dismissed the plaintiff’s prayer for temporary injunction, holding that no *prima facie* case had been made out and that the balance of convenience was in favour of the defendants.

7. Aggrieved by the impugned order, the plaintiff prays through this present appeal the following reliefs:

- a) *“Quash/set aside the Impugned order dated 03.10.2023 passed by the Ld. District Judge, Commercial Court, South, Saket, New Delhi in CS (COMM) No. 370/2021 vide which the Ld. District Judge has dismissed the Appellant's application under Order 39 Rule 1 and 2 read with Section 151 CPC denying the interim injunction in favour of the Appellant;*
- b) *Pass interim injunction to restrain the Respondent from using the impugned trade mark TULIPS in respect of impugned goods; and*
- c) *Pass any such order and further orders, which this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case”*



PRELUDE TO THE DISPUTE

8. The plaintiff is in the business of manufacturing cotton buds and cotton balls since 1999 and has subsequently forayed into a wider range of products including cotton pads, wet wipes, and bathroom fragrances and related/allied/cognate goods that fall under the category of cosmetics and toiletries.

9. The plaintiff claims proprietorship over the trademark

“TULIPS”(word), its label  (TULIPS with the device of bud) and logo  (hereinafter referred to as “TULIPS” trademarks/labels) in respect of the aforesaid goods, having secured several registrations across Classes 3, 5, 6, 10, 16, and 21 under the Act, along with copyright registrations for its artistic labels and trade dress.

10. The plaintiff has further extended its rights and strength in its “TULIPS” trademarks/labels to another range of its goods under the trademark “HYGA BY TULIPS” and has made application for its registration under No. 2953418 in Classes 3,5,6,10,16 and 21.

11. The Defendant No. 1, *AGN International*, is a partnership of Defendant Nos. 2 and 3, engaged in the manufacture and trade of perfumes, perfumery spray, cosmetics, personal care products and related allied/cognate goods (impugned goods). The defendants



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adopted and are using the trademark “AGN TULIP” (impugned mark) with trademark registration No. 1922135 in Class 3 dated 15.02.2010, filed on a “proposed to be used” basis for perfume spray and is also associated with registered/pending work mark “AGN” with registration no.1513819.

12. The plaintiff states that it has been using the mark “TULIPS” since 1999 and has promoted its products through advertisements, endorsements, and sales in retail outlets as well as on E-commerce platforms, and claims to have acquired “goodwill and reputation” in India and abroad.

13. In June-July 2021, the plaintiff came across perfumes being sold under the mark “AGN TULIP” by the defendants in online and offline markets. Upon inquiry, it was found that the defendant’s registration dated 15.02.2010 was under Class 3 for perfumes.

14. Aggrieved thereby, the plaintiff filed a cancellation petition before the Registrar of Trade Marks on 03.07.2021, followed by institution of the suit CS (Comm) No. 370 of 2021 before the learned District Judge.

PROCEEDINGS BEFORE THE LEARNED DISTRICT JUDGE

15. The plaintiff filed a suit for permanent injunction restraining infringement, passing off; delivery up; rendition of accounts, etc.



under Sections 134 and 135 of the Act, along with an application under Order XXXIX Rule 1 and 2 of the CPC read with Section 151 of CPC, seeking, *inter alia*, a decree of interim injunction to restrain the defendants from using the trademark “**TULIP**” by itself or as part of the trademark “**AGN TULIP**” in relation to perfumes, perfumery spray, cosmetics, personal care products and related/allied/cognate goods across all modes and mediums including online modes, the internet, and through dealers and distributors.

16. The plaintiff’s contention, as set out in the plaint and interim application, is that it is a partnership firm engaged in the manufacture and trade of cotton buds and cotton balls since 1999. It is contended that the plaintiff had adopted and conceived the trademark and label “**TULIPS**” in 1999, consisting of the word mark and a stylised device of a bud, and has since then continuously, commercially, openly, extensively, exclusively and uninterruptedly used the said mark, thereby acquiring substantial goodwill and reputation in India and overseas.

17. The plaintiff relied on the fact that their trademark “**TULIPS**” and formative labels of the said mark are duly registered under the Act across several classes, including Classes 3, 5, 6, 10, 16 and 21. It was submitted that by virtue of these registrations, the plaintiff possesses the exclusive right to use and exploit the said marks and to prevent unauthorised use by third parties.



18. The plaintiff also placed reliance on copyright registrations granted in respect of the original artistic works forming part of the trademark labels, as well as pending applications, and asserted ownership of copyright therein. According to the plaintiff, the mark “**TULIPS**” has acquired significant goodwill and has attained secondary significance in the market. It was further contended that their mark is arbitrary, fanciful, rare, coined and/or invented, and therefore inherently is strong and distinctive. The plaintiff asserted that “**TULIPS**” has attained the status of a “well-known trademark” within the meaning of Section 2(1)(zg) and Section 11 of the Act.

19. It was further submitted that the plaintiff registered the domain name www.tulipshygiene.com in 2012 and has used the mark across various online platforms. The plaintiff also launched a product line under the trademark “**HYGA BY TULIPS**” thereby expanding its portfolio and digital presence.

20. The plaintiff alleged that the defendants dishonestly adopted the impugned mark “**AGN TULIP**” and that the same was identical or deceptively similar in every respect, with “**TULIP**” as the dominant part.

21. The plaintiff alleged that the defendants were using false descriptions to link their goods to the plaintiff’s source, and that the adoption of the impugned mark was *mala fide*, dishonest, and motivated by an intent to trade and ride upon the goodwill established by the plaintiff. It was further contended that the defendants’ actions



amounted to infringement of the plaintiff's registered trademarks, passing off, dilution of the plaintiff's mark, and violation of the plaintiff's common law rights.

22. The plaintiff further submitted that the defendants' trademark **"AGN TULIP"** was registered under No.1922135 dated 15.02.2010 in Class 3 "proposed to be used" basis. The plaintiff immediately, after having come to know of the proposed infringement of goods, filed a cancellation petition before the Registrar of Trade Marks on 03.07.2021, seeking revocation, cancellation and removal of the registration on the ground that the registration was obtained by concealment of material facts.

23. According to the plaintiff, the impugned activities of the defendants have caused irreparable harm and loss to its business and reputation, which are incapable of being quantified in monetary terms.

24. On the contrary, the contentions of the defendant are that they are registered proprietors and users of the trademark, **"AGN TULIP,"** duly registered under No.1922135 in Class 3, supported by registration, renewal certificates, copyright NOC, and extracts from the Register of Copyrights.

25. The defendants denied any similarity or likelihood of confusion between their mark and that of the plaintiff, and disputed allegations of infringement or passing off.



26. The defendants further submitted that no cause of action arises in favour of the plaintiff, as they have failed to establish a *prima facie* case, and that the balance of convenience lies in their favour. They accordingly sought dismissal of the suit and preferred an application seeking interim injunction.

IMPUGNED ORDER

27. The learned District Judge undertook a detailed analysis under the Act. Upon consideration of the pleadings, documents, and submissions, the Court applied the settled triad of tests; namely the existence of a *prima facie* case, the balance of convenience, and the likelihood of irreparable loss or injury.

28. The learned District Judge first addressed the proprietary character of the mark “TULIP” when used in relation to perfumes. It was observed that the expression “TULIP” is, in essence, generic in relation to fragrances, perfumes, and allied goods, as the association of scent with flowers is ordinary and descriptive. Reliance was placed upon the decision in *Nestle’s Products (India) Ltd. v. P. Thankaraja*⁴, wherein it was held that granting registration to a generic term would make its owner a monopolist of ordinary vocabulary used by the traders. The Court also referred to *Jain Riceland (P) Ltd. v. Sagar Overseas*⁵, which reiterated that generic words cannot acquire distinctiveness. On this basis, the claim of the plaintiff to exclusive

⁴ 1977 SCC OnLine Mad 72

⁵ 2017 SCC OnLine Del 11305



rights over the word “**TULIP**” in the field of fragrances was rejected. The Court explicitly held that the defendants’ use of “**AGN TULIP**” in relation to perfumes did not violate the plaintiff’s mark, observing that the ultimate question before the Court was whether the defendants were infringing the plaintiff’s trademark, to which the learned District Judge stated: “The answer of which would be in negative.”

29. The Court further distinguished between the products of the two parties, finding that the plaintiff dealt in “medicinal and related goods,” while the defendants’ goods were “purely cosmetic,” namely perfumes. It was observed that a bare perusal of the products showed they were not similar in creation, appearance, colour, shape, or size, and therefore, unlikely to confuse customers. The finding that the products were “entirely different” significantly diluted the plaintiff’s claim.

30. The learned District Judge then addressed the concept of a “well-known mark”. It was held that for the plaintiff to obtain an injunction restraining the defendants’ from using “**AGN TULIP**” on ‘cognate and allied products’, namely perfumes, it was required to establish that its mark “**TULIP**” had acquired such goodwill and reputation, that when the name “**TULIP**” is taken before the customer, it immediately brings to mind the plaintiff as the manufacturer or seller of goods under such name. The learned District Judge explicitly referred to the statutory definition of “well-known trademark” defined under Section 2(1)(zg) of the Act. Drawing a contrast with the decision in *Mahindra & Mahindra Paper Mills Ltd.*



v. Mahindra & Mahindra Ltd⁶, wherein the Court had recognised that the name “Mahindra & Mahindra” immediately evoked the automobile manufacturer in the public mind, regardless of the goods or services in question, the learned Judge observed that the expression “**TULIP**,” by contrast, does not evoke the plaintiff’s goods, but instead brought hotels to mind, being associated with a programme of the Ministry of Housing and Urban Affairs. On this basis, it was held that the plaintiff could not claim the protection accorded to well-known marks.

31. Furthermore, the learned District Judge also took note of the registration dates, noting that although the plaintiff claimed prior use since 1999, the plaintiff's first trademark registration in Class 3 (cosmetics) was dated 10.11.2010 (Registration no. 2051819), whereas the defendants' registration for “**AGN TULIP**” in Class 3 was dated 15.02.2010 (Registration. no 1922135). Therefore, the defendants were found to be a “prior registered owner” of trademark “**AGN TULIP**” under Class 3.

32. Assessing the element of balance of convenience, the learned District Judge held that since the plaintiff was not engaged in the manufacture or sale of perfumes, no direct loss was demonstrated. Any detriment was likely to be monetary which may be quantified and duly compensated. Relying upon the ratio of the Hon’ble Supreme Court in **Wander Ltd. v Antox (India) Pvt. Ltd⁷**, it was held that the

⁶ (2002) 2 SCC 147

⁷ 1990 Supp SCC 727



Court, while deciding an interim application, ought to weigh the rival contentions of both parties, wherein the protection sought by the plaintiff ought to be balanced against the corresponding need of the defendant to be protected from being restrained in exercising their legal rights.

33. Be that as it may, *vide* the impugned order dated 03.10.2023, the learned District Judge dismissed the plaintiff's application for interim injunction. The learned District Judge held that the plaintiff had failed to establish a *prima facie* case since, the word "TULIP", though may not be a generic term for its products, is a generic term for the product of defendants which are fragrances. "TULIP" being a flower can be associated with fragrances and thus, it becomes a generic term for the defendant's products. The plaintiff thus **cannot be granted monopoly** on "TULIP" in so far as perfumes are concerned, noting that a businessman cannot register a name for a non-generic product and then assert the right to stop its use for products where the name is generic.

SUBMISSIONS OF THE PARTIES

APPELLANT/PLAINTIFF'S CONTENTIONS

34. Mr. Bansal, learned Counsel for the plaintiff challenged the impugned order dated 03.10.2023, contending that the learned District Judge committed errors in dismissing the application for interim injunction under Order XXXIX Rules 1 and 2 of CPC. It is contended that the plaintiff has been the prior adopter and user of the mark "TULIPS" since 1999, in respect of cotton buds and thereafter



extended to other cognate products. It was urged that the earliest registration was dated 06.11.2000 in Class 5, with multiple registrations across classes including Class 3, whereas the defendants adopted the deceptively similar mark “**AGN TULIP**” only in 2010 on a “proposed to be used” basis.

35. According to Mr. Bansal, the first limb of challenge is that the learned District Court exceeded its jurisdiction by making *suo motu* findings unsupported by any pleadings or evidence. In paragraph 17 of the impugned order, the Court speculated that “**TULIP**” brings hotels to mind and referred a government program, although neither party had advanced this argument. Learned Counsel further submitted that these observations were speculative, contrary to Order XIV Rule 2 of CPC, amounting to judicial overreach, particularly when the defendants’ defence in the written statement was limited to evasive denials and the assertion of statutory registration.

36. Mr. Bansal contended that learned District Judge erred in holding “**TULIP**” to be generic for perfumes in paragraph 14 of the impugned order against which the learned Counsel contended that the defendants themselves have registered “**AGN TULIP**” as a trademark, thereby claiming distinctiveness, and are now estopped from contending otherwise. It was urged that the finding regarding the generic nature of the mark was made without any pleading or supporting evidence from the defendants. The plaintiff emphasised that the defendants’ manner of use of the mark “**TULIP**” in a



dominant font and “AGN” in a small, subordinate font shows that the word/mark is employed in the trademark sense and not descriptively.

37. Further on the question of prior use, the learned Counsel contended that the learned District Court misapplied established principles by holding that ‘prior date of registration prevails over prior use’. Mr. Bansal highlights that the Class 3 registration dated 10.11.2010 carries a user claim of 10.02.2004, whereas the defendants’ registration dated 15.02.2010 was filed on a “proposed to be used” basis. Reliance was placed on Section 34 of the Act and the decision in *S. Syed Mohideen v. P. Sulochana Bai*⁸ to submit that “prior use prevails over registration”.

38. The learned Counsel for the plaintiff contends that the learned District Court misclassified its goods as medicinal, and that products such as cotton buds, wet wipes, tissues and cleansing milk fall squarely in Class 3 (cosmetics) and share the same trade channels as perfumes. According to the learned Counsel, the learned Trial Court has failed to apply the allied and cognate goods test, overlooking that cosmetic and fragrance products are sold through identical outlets such as supermarkets, pharmacies, beauty shops and online platforms, hence, there exists high likelihood of consumer confusion and deception. Learned Counsel emphasised that in the defendants’ trade dress, “TULIP” is the dominant element, with “AGN” appearing only in small font, which is likely to lead consumers to believe that the

⁸ 7 (2016) 2 SCC 683



defendants' perfumes originate from, or are connected with, the plaintiff.

39. Mr. Bansal points out that the balance of convenience was incorrectly assessed as the learned District Court failed to appreciate the reputation and goodwill of the plaintiff built over a period of 24 years and the same cannot be compensated by way of damages. On the contrary, the defendants, being new entrants, would suffer no irreparable harm if restrained from using a mark deceptively similar to that of the plaintiff.

40. Mr. Bansal also challenged the finding of the Court as the injunctive relief could not be granted because “**TULIPS**” is not a “well-known mark”. Learned Counsel submitted that this reasoning is contrary to Section 29(2)(a) and (b) of the Act, which grants protection to any registered proprietors to prevent likelihood of confusion or association wherein a similar mark is used for similar goods, irrespective of “well-known” status; it was further added that this protection applies equally to passing off actions concerning cognate and allied goods. The plaintiff further contended that the learned District Judge erred in its finding with regard to the “well-known status” of the mark, and that such reasoning disregards the statutory factors prescribed under Section 11(6) of the Act; the factors in the present case include duration and extent of use by the plaintiff since 1999 i.e., for over 24 years, its geographical reach extends to 16 countries, substantial sales figures of Rs. 45,18,19,720/-, advertising expenditure of Rs. 15,66,853/- in the year 2018-2019, and widespread



public recognition evidenced through invoices, awards, market reviews and media coverage including CNN reports citing production of 5 million swabs per week by the plaintiff during the COVID-19 pandemic.

41. On the principle of passing off, it was contended that even in the absence of registration in perfumes, the reputation and goodwill in association with “**TULIPS**” warranted protection against use by the defendants for allied goods. Reliance was placed on *Mahindra & Mahindra*(supra), for the principle that consumer association, not product identity, governs likelihood of confusion.

42. The plaintiff also relied on the judgment of the Hon’ble Supreme Court in *Laxmikant V. Patel v. Chetanbhat Shah &Anr.*,⁹to submit that the law does not permit anyone to carry on his business in such a manner that would persuade the customers or clients to believe that the goods or services belonging to someone else are his or are associated with his business.

43. It was submitted that the abovementioned principle squarely applied to the present dispute since the defendants’ use of the impugned mark “**AGN TULIP**” seeks to appropriate the plaintiff’s established goodwill in “**TULIPS**” built since 1999, thereby misleading consumers and diverting the plaintiff’s reputation to themselves. Thereafter, the learned Counsel for the plaintiff placed reliance on *Wipro Enterprises Pvt. Ltd. v. Himalaya Wellness Co. &*

⁹ (2002) 3 SCC 65



*Ors*¹⁰, where the Court endorsed *McCarthy*'s "related goods or services" rule. It was further argued that although the defendants' impugned goods were perfumes and the plaintiff's goods were cotton buds, wipes, and tissues, both categories shared the same trade channels, often placed on the same shelves, and target overlapping consumers. Accordingly, they qualify as allied and cognate goods in the minds of the public, thereby creating a substantial likelihood of confusion.

44. Thus, it was contended by Mr. Bansal, the learned Counsel for the plaintiff that the impugned order be set aside and that an injunction be granted restraining the defendants from using the mark "AGN TULIP" or any other mark deceptively similar to the plaintiff's registered mark "TULIPS".

RESPONDENT/DEFENDANT'S CONTENTION

45. Per contra, Mr. Sandiv Kalia, learned Counsel for the defendant contended that "TULIP" is a generic word being the name of a flower, and hence, is incapable of exclusive appropriation. It was further contended that in the fragrance industry, products are often named after flowers, e.g., Rose, Lily, Sandalwood, and Tulip etc., each describing its natural scent. Therefore, no single trader can monopolise such ordinary and general vocabulary. A company that uses a generic expression does not thereby obtain the right to prevent others from using the same word, particularly when the defendants'

¹⁰ 2024 SCC OnLine Del 6859



product itself is a fragrance of Tulip. Reliance was placed on the principle that descriptive or generic terms are not registrable as trademarks and cannot be enforced by way of injunction.

46. The learned Counsel contended that they have lawfully adopted the trademark “**AGN TULIP**”, which is a registered mark bearing No. 1922135 in Class 3, which was lawfully obtained and renewed in accordance with law. The mark is used in conjunction with their house mark “**AGN**” in relation to perfumes with a distinctive packaging i.e., bottles shaped like a tulip flower. It was contended that the defendants are entitled to describe their fragrance as “**AGN TULIP**”, just as traders may describe “*Chavanprash*” under different brands (e.g., Dabur, Baidyanath, Patanjali), without any one enjoying monopoly over the generic word.

47. It was further contended that the goods of the parties are altogether distinct and dissimilar. The plaintiff is engaged in cotton buds and related products, whereas the defendants deal solely in perfumes. The products differ in their creation, nature, appearance, colour, shape, and size. Reliance was placed on paragraph 21 of the impugned order where the learned District Judge observed that the plaintiff’s goods were in the category of ear buds and the defendants’ in perfumes, thereby negating any likelihood of confusion. It was further contended that a consumer seeking perfumes will not mistake the defendants’ goods for those of the plaintiff, who has never been in the perfume trade.



48. It was argued that no *prima facie* case or balance of convenience existed in favour of the plaintiff. Further, it was contended that since the plaintiff is not in the perfume business, there was no irreparable injury, and any alleged loss was purely speculative and at best monetary. Conversely, restraining the defendants would unjustly impair their legitimate and registered trade.

49. It was further pointed out that the plaintiff itself sought a stay under Section 124 of the Act by filing a cancellation petition against the defendants' registration. Further, the learned District Court stayed the suit of the plaintiff *sine die*. In such circumstances, it was argued that the plaintiff cannot simultaneously seek an injunction as doing so would offend the principle that "what cannot be done directly cannot be permitted to be done indirectly". On this basis, the suit was alleged to be frivolous and vexatious in nature.

50. In substance, it was urged that the defendants were carrying on a legitimate business using a registered trademark duly recognised by the Trade Marks Registry and the Copyright Office. The plaintiff has no enforceable right over the generic word "TULIP" in respect of fragrances, no *prima facie* case has been established, and the balance of convenience lies firmly in favour of the defendants. Accordingly, the appeal is liable to be dismissed.

ANALYSIS AND FINDINGS

51. The Court has considered the rival submissions advanced on



behalf of the plaintiff and the defendants, the pleadings on record, the documents annexed, and the impugned order dated 03.10.2023 passed by the learned District Judge.

52. At its core, the present appeal turns upon the application of settled principles of trademark law to determine whether the plaintiff has established sufficient goodwill and prior use pertaining to the mark **“TULIPS”** to restrain the defendants from using the mark **“AGN TULIP,”** and whether the findings of the learned District Judge on generic nature of the mark, similarity of goods, and balance of convenience are sustainable in law.

53. In this background, the matter assumes significance beyond the individual parties, since it involves the broader question of whether a trader, by prior adoption and sustained use, can obtain protection for a floral word mark across allied and cognate goods, notwithstanding claims of genericness. This Court is mindful that trademark law is intended not merely to protect the proprietary interests of registered users, but equally to safeguard consumers against deception and confusion, thereby preserving honesty and fair play in the market.

54. Thus, the issues for consideration in this appeal may be limited and confined to the following core questions:

- i. Whether the plaintiff has established goodwill and prior user rights in the mark **“TULIPS”**, extending across “allied and



cognate goods”, sufficient to sustain an action in passing off against the defendants?

- ii. Whether the defendants’ use of the mark “**AGN TULIP**”, particularly with the emphasis on the word “**TULIP**” is likely to result in confusion, deception, or dilution of the plaintiff’s goodwill?
- iii. Whether the findings of the learned District Judge on the generic nature of “**TULIP**”, the dissimilarity of goods, and the absence of well-known status are legally sustainable?

55. At the outset, it is necessary to note that both the plaintiff and the defendants are registered proprietors of marks containing the expression “**TULIP**”. The plaintiff holds multiple registrations dating back to 06.11.2000 in Class 5, followed by subsequent registrations including in Class 3 dated 10.11.2010 with a user claim of 10.02.2004. The defendants are the registered proprietors of Trade Mark No. 1922135 dated 15.02.2010 in Class 3, obtained on a “proposed to be used” basis.

56. The position of law where both parties are registered proprietors has been very clearly explained by the Hon’ble Supreme Court in **S. Syed Mohideen**(supra), wherein it was held that an action for infringement would not lie *inter se* between two registered proprietors. Further, the Court clarified that the action of passing off is the only common law remedy that is available to the prior user even against another registered proprietor since the essence of passing off lies in protection of goodwill and prevention of misrepresentation. The same



was also recently reaffirmed by this Court in ***Vaidya Rishi India Health Pvt. Ltd. &Anr. v. Suresh Dutt Parashar &Ors.***¹¹

57. It is in this backdrop that the present appeal must be tested purely on the anvil of passing off. The ingredients of passing off are well settled and laid down in ***Laxmikant V. Patel*** (supra), where the Hon'ble Supreme Court held that the tort of passing off is directed against a person who is "persuading customers to believe that his goods are those of another" and that the claimant must establish (i) goodwill or reputation in the mark; (ii) misrepresentation; and (iii) likelihood of damage. Goodwill is the *sine qua non* i.e. without goodwill there can be no deception. This Court therefore confines its enquiry to these three elements.

58. The abovementioned principle was further crystallised by the Hon'ble Apex Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***¹², where the Court underscored that goodwill is not presumed from global reputation but it must be established in the Indian market at the material time and that a passing off action succeeds only where the relevant section of the Indian consumers associate the mark in question with the claimant's goods, and in absence of such goodwill, protection cannot be extended.

59. Applying these principles in the present case, it becomes necessary to examine the registration of both the parties. The fact that

¹¹2025 SCC OnLine Del 6147

¹²(2018) 73 PTC 1 SC



the defendants' registration predates the plaintiff's registration date, but not its user claim, imposes a burden on the plaintiff to demonstrate that it had acquired goodwill and reputation in "TULIPS" prior to 15.02.2010, sufficient to maintain a passing off action. The materials placed on record by the plaintiff relate to the use of the mark "TULIPS" in connection with cotton buds and allied hygiene products. The plaintiff placed reliance on invoices from 2010, turnover of Rs. 24 crores in 2009-10, advertisement material, sales figures of Rs. 45 crores with promotional expenditure of Rs. 15 lakhs in 2018-19, as well as awards and press reports including recognition during the COVID-19 pandemic. While this evidence may establish use of the mark "TULIPS" in relation to cotton buds and allied hygiene products, the critical question is whether such goodwill extended to the goods which are cognate to the defendants' perfumes in Class 3 prior to 15.02.2010.

60. The law requires that goodwill be established in the specific line of trade relevant to the dispute. In *T.V. Venugopal v. Ushodaya Enterprises Ltd*¹³, it was held that even where a mark may be descriptive or generic in its origin, protection may still be afforded if it has acquired a "secondary meaning" uniquely identifying the proprietor's goods. In that case, the word "Eenadu", though meaning "today" in Telugu, had acquired distinctiveness through extensive use for newspapers, thereby restraining others from using it for allied goods such as incense sticks.

¹³ (2011) 4 SCC 85



61. Contradictorily, in the present case, the word “**TULIP**” has not been shown to have acquired such secondary meaning prior to 2010 in relation to perfumes or fragrances. The plaintiff’s principal use was in relation to cotton buds, tissues and swabs. Though such products may be sold through overlapping trade channels within Class 3, the plaintiff has failed to demonstrate consumer association of the word “**TULIPS**” with perfumes or fragrances prior to the defendants’ adoption in 2010. In the absence of such proof, the goodwill required to sustain a passing off action remains unfulfilled.

62. The principle that prior user prevails over registration, as held in *Syed Mohideen* (supra) presupposes that prior user has in fact established reputation in the relevant field of trade. In the present case, no cogent evidence has been led to show that by 2010 consumers identify “**TULIPS**” with cosmetics or fragrances. Thus, the claim of the plaintiff cannot extend to restraining the defendants’ use of “**AGN TULIP**” in respect of perfumes.

63. The submission of the learned Counsel that the products of the plaintiff and the defendants are retailed through overlapping or the same trade channels such as pharmacies or supermarkets does not, by itself, establish that the reputation of the mark had travelled into the field of perfumery. The fact that goods may be displayed within the same outlet or even on the same shelf does not automatically extend goodwill across distinct product categories. The law requires a demonstration that, in the perception of the consuming public, the mark had acquired a “secondary meaning” in relation to cosmetics or



fragrances prior to 2010. In the absence of such evidence, the claim of goodwill cannot be said to extend beyond the narrow class of hygiene products in which the plaintiff was demonstrably engaged.

64. While the plaintiff is correct that the defendants themselves claimed distinctiveness while registering “**AGN TULIP**”, however, the inquiry in passing off is not about formal estoppel but about actual reputation. In the absence of compelling evidence that “**TULIPS**” had acquired secondary meaning in relation to perfumes prior to 2010, the plaintiff cannot dislodge the descriptive association.

65. Now this Court proceeds to examine the plaintiff’s contention that its mark “**TULIPS**” ought to be treated as a “well-known trademark” within the meaning of the Trade Marks Act, 1999. Section 11(6) of the Act mandates that, in determining whether a trademark is well-known, regard shall be made to, *inter alia*: (i) the knowledge or recognition of the mark in the relevant section of the public; (ii) the duration, extent and geographical area of its use; (iii) the duration, extent and geographical area of its promotion, including advertising and publicity; (iv) the duration and geographical area of any registration or application reflecting its use or recognition; and (v) the record of successful enforcement of rights in that trademark, in particular judicial or administrative recognition of the mark as “well-known”. The standard is exacting, for the grant of such status elevates the protection of the mark beyond the confines of the goods for which it is registered.



66. As per the materials on record submitted by the plaintiff, the same merely indicates reputation in a definite segment of cotton buds and allied hygiene products. Apparently, the knowledge or recognition of the mark remains largely confined to consumers of those products and has not been shown to extend beyond limited markets such as cosmetics or fragrance; and there is no evidence of the mark being judicially or administratively recognised as “well-known”.

67. The Hon’ble Supreme Court in *Mahindra & Mahindra Paper Mills Ltd.* (supra), observed that the mention of “Mahindra” immediately evokes the automobile manufacturer, irrespective of the product. The evidence here does not show that “TULIPS” has acquired such universal recognition. The goodwill is appreciable but remains tethered to a specific class of products. Consequently, while the plaintiff enjoys statutory protection as a registered proprietor and may assert rights against confusing similarity within its class of goods, the claim to well-known status under Section 11(6) read with Section 29(4) of the Act cannot be sustained. The plaintiff is entitled to the protection of its registrations and is also entitled to assert rights under the doctrine of passing off where confusion or deception can be shown. However, the attempt to extend those rights on the footing of a “well-known mark”, transcending classes and product categories such as Class 3 and cosmetics and fragrances in the present dispute, is unsupported by the material on record. Thus, the learned District Judge was correct in concluding that the mark is not a “well-known mark” within the meaning of Section 2(1)(zg).



68. It must also be borne in mind that the findings of the learned District Judge that “**TULIP**” is generic for perfumes was based on the reasoning that flowers are a natural source of fragrances. Though this reasoning may have been couched in broad terms, the essential point remains that when the plaintiff had not ventured into perfumes prior to 2010, no monopoly over a floral expression in relation to fragrances could be presumed. As was observed in *Syed Mohideen* (supra) that the rights of a prior user are not absolute but must be established in relation to the relevant trade.

69. Thus, this Court is of the view that while the plaintiff has demonstrated user of the mark “**TULIPS**” since 1999 in relation to cotton buds and related products, it has not established goodwill extending to perfumes prior to the defendants’ registration in 2010. Nor has the plaintiff shown that its mark qualifies as a “well-known mark” under Section 11(6) of the Act. In the absence of such proof, the essential ingredients of passing off, namely, goodwill and likelihood of deception in the relevant line of trade, are not satisfied.

CONCLUSION

70. In light of the foregoing discussion, this Court finds that no action for infringement can lie between two registered proprietors, and the plaintiff’s case must therefore rest on the common law remedy of passing off. The plaintiff has, however, failed to demonstrate that its goodwill in the mark “**TULIPS**”, though established in respect of cotton buds and allied products, extended to perfumes prior to 2010 so as to restrain the defendants registered use of “**AGN TULIP**”. The



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materials placed on record are insufficient to sustain the claim that the plaintiff's reputation had spilled over into the field of fragrances, nor can the mark be regarded as a "well-known mark" within the meaning of Section 11(6) of the Act.

71. Accordingly, the appeal fails on merits. The impugned order dated 03.10.2023 dismissing the plaintiff's application under Order XXXIX Rules 1 and 2 of CPC is upheld.

72. The appeal is dismissed, with no order as to costs. Pending application(s), if any, stand disposed of.

OM PRAKASH SHUKLA, J.

C.HARI SHANKAR, J.

NOVEMBER 3, 2025/RJD