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Government of India
TRADE MARKS REGISTRY
Boudhik Sampada Bhavan, S.M. Road, Antop Hill,
Mumbai-400 037, India.

NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION OF AN INTERNATIONAL REGISTRATION DESIGNATING INDIA

Rule 17(1) of the Common Regulations

I.	Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA
II.	Number of the international registration: 1310831 (Reference IRDI No allotted to this international registration by the TMR India)... 3995557	
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed): LUMINAL AGENCY FZ LLC	
IV.	Provisional refusal based on an opposition The following person(s) have filed opposition to protection of the trademark in India- 1. SURINDER MALIK, E-12, CONNAUGHT PLACE, NEW DELHI 110001	
V.	Provisional refusal for all the goods and/or services	
VI.	Grounds for refusal [(where applicable, see item VII)]: The Grounds are mentioned as per the Notice(es) of Opposition attached herewith	
VII.	Information relating to an earlier mark As mentioned in Notice(es) of Opposition attached herewith, if any.	
VIII.	Corresponding essential provisions of the applicable law [(see text under XII)]: Section 21 of Trade Marks Act 1999 and Rules 47, 48, 49, 50, 51, 52, 53, 54, 55 and 56 Sections 9, 11, 12, 13, 14 of Trade Marks Act 1999 and Rules 47, 48, 49, 50, 51, 52, 53, 54, 55 and 56	
IX.	Information relating to subsequent procedure:	
	(i)	If the holder of the International Registration wants to protect his trademark in India he/she, on receipt of the Provisional Refusal based on Opposition must submit a Counter Statement on form TM-6/TM-O through a registered trademark agent/advocate having address in India. The said Counter Statement must be submitted along with the scanned copy of the Statement of Case signed by the holder and the Power of Attorney in favor of the agent/attorney.
	(ii)	Time limit for response or for a request to file Counter Statement against the provisional refusal: <i>Two month</i> from the date of receipt of provisional refusal by the holder of international registration.
	(iii)	Authority to which such request for review or appeal should be made: The response to the provisional refusal in the form of the Counter Statement must be submitted before the Registrar of Trade Marks, International Registration Division, Trade Marks Registry, Mumbai. The Counter Statement including the scanned copy of the Statement of Case and the Power of Attorney must be submitted online through the gateway <i>comprehensive e-filing services for trademarks</i> .
(iv)	Indications concerning the appointment of a representative: The response to the provisional refusal must be submitted through an Indian agent or a representative. The said agent may be a trademark agent registered with the Indian Trade Marks Registry office or an Advocate within the meaning of Indian Advocates Act, 1961. Such agent/attorney must be engaged by the holder through a Power of Attorney on form TM-48 executed in the favor of the said trademark agent/advocate.	
X.	Date of the notification of provisional refusal: 13/03/2019	
XI.	Signature or official seal of the Office making the notification: FOR REGISTRAR OF TRADEMARK DIPMALA P MATHAPATI Designation: SENIOR EXAMINER Mumbai	

XII.	Corresponding essential provisions of the applicable law:
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*** end of the report ***

Receipt No.: 2164338
Date: 07/03/2019
Amount: Rs.2700/-
Ref No: A-3995557 Form
No: 975810

FORM TM-O
THE TRADE MARKS ACT, 1999

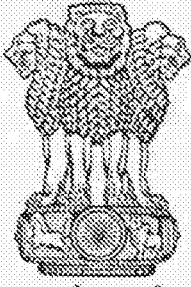
**Notice of Opposition / Application for Rectification of the Register by cancelling or varying registration of a trade mark / Counter statement / Request to refuse or invalidate a trade mark under Section 25(a),(b) of Geographical Indication of Goods (Regulation and Protection)
under the Trade Marks Act**

REQUEST	NOTICE OF OPPOSITION
FEE	2700
APPLICANT OR REGISTERED PROPRIETOR/OPPONENT/THIRD PARTY MAKING THE APPLICATNION/REQUEST	
Opponent Name	SURINDER MALIK
Treading As	
Address	E-12, CONNAUGHT PLACE, NEW DELHI 110001
Service Address	1/B, Street No.4, East Guru Angad Nagar, Delhi- 110092
Mobile No	7834897828
Email address	lexfonsip@gmail.com
AGENT OF THE APPLICANT OR REGISTERED PROPRIETOR/OPPONMENT/THIRD PARTY AS THE CASE MAY BE(if any)	
Agent Name	LEX FONS
Address	1/B STREET NO -4 EAST GURU ANGAD NAGAR DELHI 110092
Mobile No	7834897828
Nature of the Agent	Advocate
Registration No	11192
REQUEST OPPOSITION/APPLICATION IN THE MATTER OF	
DETAILS OF APPLICATION NUMBER	3995557
CLASS	14
REQUEST	NOTICE OF OPPOSITION
GROUND OF OPPOSITION	Grounds of opposition are attached separately
Date	07-03-2019 02:02 PM

Digitally Signed By

VIKAS KHERA

for LEX FONS
[Attorney]



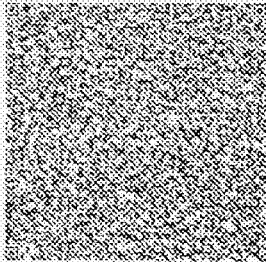
सत्यमेव जयते

INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

e-Stamp

Certificate No. : IN-DL25231805716271N
Certificate Issued Date : 07-Jul-2015 01:39 PM
Account Reference : IMPACC (IV)/ d747903/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL7479034768485C292214N
Purchased by : SURINDER MALIK
Description of Document : Article 48(c) Power of attorney - GPA
Property Description : E-12, CONNAUGHT PLACE, NEW DELHI-110001
Consideration Price (Rs.) : 0
(Zero)
First Party : SURINDER MALIK
Second Party : LEXFONS
Stamp Duty Paid By : SURINDER MALIK
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



Please write or type below this line.....

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shoestamp.com". Any discrepancy in the details on this Certificate and as available on this website renders it invalid.
2. The onus of checking the legitimacy is on the users of the certificate.
3. In case of any discrepancy please inform the Competent Authority.


FORM TM-48
THE TRADE MARKS ACT, 1999
FORM OF AUTHORISATION OF AN AGENT
(Section 145; Rule 21)

I, Surinder Malik, having address E-12, Connaught Place, New Delhi - 110001, do hereby appoint and authorise Mr. Vikas Khara Advocate of M/s LEX FONS, 1/B, Street No.4, East Guru Angad Nagar, Delhi - 110092 to act, appear and plead as our agents in all the Trade Marks Registry and further authorise him to sign, file, verify the applications, notice of oppositions, counter statements, evidences or other applications, replies, objection or affidavits or other documents and also attend hearings as may be deemed necessary and proper for the prosecution of cases in all its stages. I further authorise him to appoint and instruct any other legal practitioner authorizing him to exercise the power and authorities hereby conferred upon the advocate whenever he may think fit to do so and to sign the power of attorney on my/our behalf.


We hereby revoke all previous authorizations, if any, in respect of the proceedings and I also ratify the act done by the present Attorney.

We request that all notices requisitions and communications relating thereto may be sent to such agent at the address mentioned above.

Dated this 24th day of July, 2015.


Signature *Surinder Malik*
Surinder Malik

Accepted


Vikas Khara
Advocate

To,
The Registrar of Trade Marks
The Office of the Trade Marks Registry

TM-O

THE TRADE MARKS ACT, 1999

Fee Rs: 2,700/-

Attorney's Code No.: 11192

Proprietor's Code No.:

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION OF A
TRADE MARK

[SECTION 21(1) RULE 42]

IN THE MATTER OF application no. 3995557 in Class 14 dated 27.09.2018 in the name of Luminial Agency FZ LLC, having office at Dubai Design District, Building 5, A205 Dubai.

AND

IN THE MATTER OF opposition thereto entered by Surinder Malik at E-12, Connaught Place, New Delhi- 110001.

I, Surinder Malik, (which expression includes its predecessors in business, interest and/or title, affiliate, licensee, permitted user etc.)(hereinafter referred to as 'the Opponent') having its office at E-12, Connaught Place, New Delhi- 110001, the Opponent above named hereby give notice of its intention to oppose registration of the trade mark **DI MILANO** advertised under number 3995557 in Class 14 in Trade mark Journal No. 1877 dated 26.11.2018.

Grounds of opposition are as follow:-

1. The Opponent (which expression includes its predecessors in business, interest and/or title) is engaged in the business of manufacturing and marketing of inter alia Leather bags, Wallets, Belts, Readymade garments,

Leather Linings and other products related thereof (hereinafter may be referred to as "the said goods") and have been carrying on their business inter alia under the name and style of M/s Da Milano at E-12, Connaught Place, New Delhi- 110001.

2. The Opponent has given license to Da Milano Leathers Pvt. Ltd. to use the trademark DA MILANO in India. Therefore, the use of trademark by Da Milano Leathers Pvt. Ltd. may be considered the use of the mark DA MILANO by the Opponent.
3. The Opponent markets their products under the distinctive trade mark DA MILANO.
4. The Opponent honestly adopted the trade mark DA MILANO (hereinafter may be referred to as "*the said trade mark*") in the year 1989 and since then the trade mark DA MILANO has been used continuously, uninterruptedly, extensively and commercially by the Opponent in the course of aforementioned trade and business. The said trade mark has thus become distinctive of the source and trade origin of goods manufactured and marketed by the Opponent exclusively and none else.
5. Over the years, the Opponent has developed considerable expertise and technology specialization in its field. Its products marketed and sold under the trade mark DA MILANO are manufactured as per international standards and quality specifications. Thus, customers associate products bearing the trademark DA MILANO with the technological prowess and manufacturing specialization of the Opponent.
6. The Opponent's sales under the trade mark/ service mark DA MILANO has increased consistently due to considerable investment in brand building, advertisement, promotional campaign and marketing expenses besides the efforts of the management in building long term customer relationship. DA MILANO family has celebrated over sixty years of uninterrupted work from leather tanning industry to today's premium, high end leather accessories and

home furnishing brand. Achieving this system from the fact that the Opponent promotes prized craftsmanship, an obsession for experienced handiwork and the best of resources to create the Opponent preferred signature styles. Only the finest leather painstakingly processed and the most premium fittings are used to achieve and the desired result by the Opponent. As a result of which the Opponent proudly endorse their products with a life time warranty.

7. Classic elegance and enduring sophistication have always been the basis of the signature DA MILANO style, supported with state of the art technology and creativity. Be it Handbags, Portfolio bags, Travel bags, Wallets or accessories, the Opponent's iconic style defines luxury of the highest quality. The Opponent products are exported to different countries and showcased at leading department stores. The Opponent products are also sold in Dubai and Nepal.
8. In the domestic market, presently the Opponent operates 44 company owned and self-operated exclusive showrooms and has presence in 15 cities and also at IGI International & Domestic Airport, Terminal 3, Delhi, Mumbai Domestic Airport, Ahmadabad International Airport & Kolkata Airport.
9. The Opponent is also planning to open more showrooms in other parts of the country. That DA MILANO is an award winning, iconic premium brand, uniquely positioned as a leading Indian Player. The brand is known for its exquisite craftsmanship and immaculate styling. New collections are launched every season by a team of designers. The Opponent's trademark DA MILANO is counted amongst the country's most successful mid-level retail brands.
10. The Opponent has received several accolades/awards, from the industry, in the last 6 years for its unmatched quality products and services rendered. The Opponent has received inter alia Images Retail Awards for the year 2011, 2012, 2013, 2014 and 2015 continuously from India Retail Forum, Star Retailer

Awards 2012, Inorbit Malad-best fashion Accessories, InorbitCyberbad, 2011 etc.

11. The Opponent's products under the trademark are also available on leading e-commerce portal such as www.amazon.com, www.jabong.com, www.myntra.com etc. It is submitted that the Opponent's sales under the trademark **DA MILANO** has consistently been increased over the past several years due to considerable investment in the brand building, advertisement, promotional campaigns and marketing expenses besides the efforts of the management in building long term customers relationship. The Opponent is a firm of repute which manufactures products of unmatched quality and international standards. The goods of the Opponent under the trademark **DA MILANO** has acquired enviable goodwill and reputation throughout India, owing to extensive commercial use and advertisements through various mediums including newspapers, magazines, hoardings, sales promotional material at huge financial expenses. The Opponent has also sponsored many conferences/meets. The trademark **DA MILANO** of the Opponent enjoys colossal goodwill and reputation in respect of its aforesaid goods. The public has come to associate the Opponent's products manufactured and marketed under **DA MILANO** exclusively with the Opponent and none else.
12. The Opponent also maintains a website with a name www.damilano.com which gives the full details about the Opponent's registered and famous trademark **DA MILANO**. It is noteworthy to mention that the Opponent's **DA MILANO** in addition to being advertised and promoted directly by the Opponent, is also additionally indirectly showcased and promoted by the various major e-commerce portals who sells **DA MILANO** products on their websites, thus increasing the awareness about **DA MILANO**. Moreover, in this day of instant communication and internet being available to consumer and the member of the trade and public at large, services offered and promoted by the Opponent receive instant attention and popularity in India.

Also, a lot travelling across the country spread the reputation of the Opponent's DA MILANO by way of word of mouth. Therefore, the goods/services of Opponent under the trade mark DA MILANO are extremely popular in India. Moreover, the Opponent has its presence in all the metro cities of India.

13. In order to get statutory right and to protect its trademark from misappropriation, dilution and misuse, the Opponent has applied for registration of the mark DA MILANO in classes 03, 06, 09, 14, 18, 25 and 35 under the provisions of The Trade Mark Act, 1999 (*hereinafter may be referred to as "the Act"*) the detail whereof are enumerated herein below: -

S. NO.	TRADEMARK	APPLICATION /REGISTRATION NO	CLASS	STATUS	TMJ NO.
1	DA MILANO	586903	18	Registered	1232
2	DA MILANO (LABEL)	586904	25	Registered	1266
3	DAMILANO (LABEL)	981287	18	Registered	1302-3
4	DA MILANO	3460709	26	Registered	1785-0
5	DA MILANO	3003307	03	Registered	1809
6	DA MILANO	3003308	09	Registered	1809
7	DA MILANO	3003309	14	Registered	1809
8	DA MILANO	2062596	35	Registered	1816-0
9	DA MILANO	1318280	35	Pending	1328-4
10	DA MILANO	1384752	25	Pending	1350
11	DA MILANO (LABEL)	981288	25	Pending	1302-3
12	DA MILANO	3460708	06	Registered	1824
13	THE MILANO	953285	25	Pending	Suppl.
14	MILANO	953287	18	Registered	1302
15	MILANO	953288	25	Pending	-

The above mentioned registered trademarks are valid and subsisting and the marks which are pending will be registered after due process of law.

14. The trade Mark **DA MILANO** represents a powerful brand known to many millions of customers in India. The Opponent has used the trade mark **DA MILANO** continuously and uninterruptedly since the date of its adoption. The customers, public member of the trade have become accustomed to the high quality of goods under the trade mark **DA MILANO** that emanate from the Opponent. The Opponent is the proprietor of the mark **DA MILANO** and other **MILANO** suffix marks. The trade mark **DA MILANO** on account of long, extensive and uninterrupted use connotes and denotes the source and origin of goods bearing said mark as originating from the Opponent and no one else in India in respect of said goods. The Opponent has honestly adopted the trade mark **DA MILANO** and has used the same continuously commercially, openly, and without interruption from any corner thereupon due to massive and continuous use since the date of adoption and by virtue of registration under the Act, the trademark **DA MILANO** has lost its primary significance if any, and has attained the secondary significance in respect of the said business and related business.
15. The Opponent has been diligent in protecting its intellectual property rights and has taken steps to protect its distinctive, well known, registered and famous trade mark **DA MILANO**. Over a period of time, the trade mark **DA MILANO** has come about to acquire formidable goodwill and reputation amongst member of the public and the consumer at large and constitutes a valuable intellectual property of the Opponent, the right wherein is owned and zealously guarded by the Opponent against misuse, abuse, misappropriation and misrepresentation.

16. On account of registration, extensive promotional activities and uninterrupted use, the trade mark DA MILANO has become distinctive of the goods and business of the Opponent. The trade mark DA MILANO of the Opponent is a "well-known trade mark" as envisaged under the provisions of section 2 (1) (zg) of the act and is entitled to maximum protection against all kinds of misuse and misappropriation by any manufacturer, trade or person irrespective of the class or the goods for which the mark is registered or used by the Opponent.

17. The applicant with malafide intention to trade upon the valuable goodwill and reputation enjoyed by the Opponent in its well-known, famous and registered trade mark DA MILANO has filed the present application for registration of a deceptively similar trade mark D1 MILANO (hereinafter referred to as "*the impugned mark*") in identical class and in respect of identical and cognate and allied goods. The applicant with malafide intent has deliberately adopted the mark which is deceptively similar to the Opponent's well-known trade mark, only with intent to confuse the customers and public at large. The malafide intention of the applicant is apparent from the fact that the applicant has copied the entire mark and has just deleted the alphabet A and has added 1 in the Opponent's mark DA MILANO to make the impugned mark D1 MILANO deceptively similar to the Opponent's mark. The malafide intention of the applicant is further demonstrated from the fact that the applicant has adopted the impugned mark in respect of identical and allied goods to that of the Opponent. The consumer and traders would invariably come to conclusion that the rival mark belongs to the Opponent or has some strong or subtle connection therewith. Thus, a malafide intention on the applicant's part is writ large in that the adoption of a deceptively similar mark by the applicant was actuated solely with a view to misappropriate and trade upon the established goodwill and reputation which has accrued to the Opponent's trade mark DA MILANO.

18. It is submitted that the Opponent's trade mark **DA MILANO** is a well-known trade mark amongst the public. The said mark of the Opponent has carved a niche for itself in the line of its goods and is not only inherently distinctive but also capable of distinguishing the goods of the Opponent from others. The impugned mark of the applicant being phonetically, visually and structurally similar to the Opponent's well-known mark lacks inherent distinctiveness and is not capable of distinguishing the applicant's goods from those of the Opponent. The registration of the impugned mark is, thus, liable to be refused within the provisions of Section 9(2) (a) read with Section 2 (h) of the Act as it is deceiving the public and causing confusion.

19. The adoption of the impugned mark as applied for, on goods of identical and related descriptions, having common trading channels, is likely to cause confusion and/or deception about the source and origin of the goods. It is pertinent to note that confusion and/or deception is inevitable since the applicant's impugned mark is a blatant copy of the Opponent's well-known and famous trade mark. The confusion would also arise on account of presumption that may be drawn about a franchise arrangement, nexus or trade connection between the goods and business of the applicant and those of the Opponent. The registration of the impugned mark is thus, liable to be dismissed as it is in violation of Section 11(1) of the Act and also Section 11(2) of the Act.

20. The adoption by the applicant of the impugned mark in relation to goods for which registration is sought is deliberate, in bad faith, mala fide, dishonest and solely calculated to misrepresent the origin of goods and misappropriate the goodwill and reputation attached with the trade mark **DA MILANO** of the Opponent. There cannot possibly be any justification on the part of the applicant to adopt a similar mark, except to earn illicit gains and to pass off the applicant's goods and/or business as and for those of the Opponent. Thus, the application is liable to be dismissed in order to protect public interest.

21. The Opponent submits here that the registration of the impugned trade mark **D1 MILANO** would be in violation of the provisions of the Act in as much as it is likely to mislead the public as regards the trade source from which the goods pertaining to the impugned mark emanate and the likelihood of association as contemplated under Section 2 (1) (i) (IV) (a) of the Act for false trade description. Hence, the impugned mark **D1 MILANO** is liable to be refused registration by the learned Registrar in the public interest.
22. The adoption by the applicant of the impugned mark in Class 14 is mala fide, in bad faith and solely motivated to trade upon the goodwill and reputation enjoyed by the Opponent in its well-known trade mark **DA MILANO**. The Applicant is called upon to prove its bona fide intention in adoption of the impugned mark. The Applicant cannot, therefore, claim itself to be a bona fide, honest proprietor of the impugned mark within the provisions of Section 12 of the Act and therefore cannot take the shelter under the said section being dishonest and there is no other circumstance which may permit the Applicant to use the impugned mark which is a blatant copy of the Opponent's mark **DA MILANO**.
23. Under the above circumstances, it is submitted that the registration of the impugned mark would be contrary to the provisions of Section 2 (1) (i) (IV) (a), Section 9(2), Section 11(1), Section 11(2) and Section 11(3) of the Act and therefore the Learned Registrar is requested to exercise its discretion, empowered under Section 18(4), against the grant of registration and refuse the Application No. 3995557 in Class 14, in order to maintain the purity of the Register of Trade Marks. Further, the trademark has been filed on a proposed to be used basis, therefore the applicant will not suffer any harm or injury if the registration for the same is denied. However, if the impugned mark is registered then great loss and injury will be caused to the Opponent in terms of money and reputation. Further, the consumer will also be deceived about the origin of goods. The Applicant ought to be barred from the claim of "honest" or "concurrent use".

24. Under the above circumstances it is prayed that the impugned Application No. 3995557 in Class 14 may please be refused/abandoned, present opposition be allowed and costs of proceedings be awarded to the Opponent.

All communications in relation to these proceedings may be addressed to the following address in India:

LEXFONS
Intellectual Property Attorney
1/B, Street No. 4, East Guru Angad Nagar, Delhi - 110092
E-mail: info@lexfons.com, lexfonsip@gmail.com
Contact: 011-49058450, +91 - 7834897828

Dated this 7th day of March, 2019.


Vikas Kherra
For, Lexfons
Advocates for Opponent

To,
The Registrar of Trade Marks
The Office of the Trade Marks Registry, Mumbai.

VERIFICATION:

I, Vikas Khera, the attorney duly appointed by the Opponent herein to file opposition, do hereby verify that the contents of paragraph nos. 1 to 13 are true as per the information received from the records of the Opponent and believed to be correct and nothing material or relevant is concealed therefrom, and the contents of paragraph nos. 17 to 23 are submissions and objections raised on behalf of the Opponent and the same are true and correct. The contents of the last paragraph are a prayer to this Hon'ble Tribunal.

Verified at New Delhi on this 7th day of March, 2019.


Vikas Khera
Advocate

TMO:DMO:VK:VS