



IPAB Intellectual Property Appellate Board
balancing ip-protection

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ORA/63/2020/TM/MUM

WEDNESDAY, THIS THE 30TH DAY OF DECEMBER, 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE MS.LAKSHMIDEVI SOMANATH
HON'BLE SHRI. MAKYAM VIJAY KUMAR**

**CHAIRMAN
TECHNICAL MEMBER (TRADEMARKS)
TECHNICAL MEMBER (TRADEMARKS)**

AMPM FASHIONS PRIVATE LIMITED

A-18 T/F Friends Colony East
South Delhi-110065, India

...Applicant/Appellant

(Represented by: Mr. Neeraj Grover, Mr. Himanshu Deora & Mr. Raghav Vig.)

Versus

1. AMPM Designs

Partnership firm of Mr.Akash Metha and Ms.Poonam Metha
204, Sky Vista, Viman Nagar,
Pune-411014, Maharashtra

... Respondent No.1

2. THE REGISTRAR OF TRADE MARKS

TRADE MARKS REGISTRY,
BOUDHIK SAMPADA BHAVAN
ANTOP HILL, S.M.ROAD, MUMBAI-400037

... Respondent No.2

(Represented by: Mr.Rajat Sehgal)

ORDER

HON'BLE SHRI. MAKYAM VIJAY KUMAR, TECHNICAL MEMBER (TRADEMARKS) :

1. The Rectification Application is filed under Section 57 of Trademark Act, 1999 for Removal of the word mark "AMPM DESIGNS" ("impugned mark") under Application No. 4165852 ("impugned Registration") in class 42 registered in favour of the Respondent No. 1. Details of the impugned registration-

Date of Application: 03/05/2019

Use claim- Proposed to be used

Sealing date for the registration certificate: 03/03/2020

2. By this order, we propose to decide the said prayer.

THE CASE OF THE APPLICANT

3. That the Applicant in the year 2002 Mr. Ankur Modi and Ms. Priyanka Modi started their fashion designing venture. Petitioner' brand AM:PM reflects their ideology, i.e. the brand provides clothing solutions,

accessories and related products for contemporary women. The Applicant also provides services such as fashioning designing, retailing of the clothing items and accessories, tailoring services, etc., under the mark AM:PM. In the year 2005, the Applicant has started the Applicant Company i.e., AMPM Fashions Private Limited.

4. The Petitioner honestly adopted the distinctive trademark AMPM in the year 2002. Since then Petitioner has adopted various trademarks thereby creating a family of AMPM Marks, inter alia, AM:PM, am:pm,



5. The Applicant has secured various trademark registrations for its AMPM Marks in India, with the earliest registration for the word mark “am:pm” is dated 14/5/2009 with a use claim of 01/01/2002. Details of the registrations and applications provided under the tables below:-

TRADEMARK REGISTRATIONS

S. No	Trademark	Reg. No.	Cl.	Appl. Date	User Detail
1.	am:pm	1817859	25	14/5/2009	01/01/2002
2.		2357180	25	2/7/2012	01/12/2005
3.		2357181	23	2/7/2012	01/12/2005
4.		2357182	24	2/7/2012	01/12/2005
5.		2357183	26	2/7/2012	01/12/2005
6.	T W E L V E AM:PM	3249579	25	03/5/2016	Proposed to be used
7.	T W E L V E AM:PM	3318987	18	26/7/2016	Proposed to be used
8.		3887494	18	13/7/2018	01/04/2016

OTHER RELEVANT TRADEMARK APPLICATIONS OF THE APPLICANT

S. No	Trademark	App. No.	Cl	Appl. Date	User Detail
1.		3500631	25	03/3/2017	Proposed to be used
2.		3887492	3	13/07/2018	01/04/2016

3.		3887493	14	13/07/2018	01/04/2016
4.		3887496	35	13/07/2018	01/04/2016
5.	AMPM	4575593	14	18/07/2020	05/11/2015
6.	AMPM	4575594	18	18/07/2020	05/11/2015
7.	AMPM	4575595	24	18/07/2020	01/12/2005
8.	AMPM	4575598	25	18/07/2020	01/01/2002
9.	AMPM	4575596	35	18/07/2020	01/12/2005
10.	AMPM	4575597	42	18/07/2020	01/01/2002

6. The Applicant claimed that the Applicant's mark AMPM is qualified to be declared as well-known mark owing to the facts that it had undertaken widespread advertisements and thereby public and media recognition. It had extensive worldwide presence with its products being delivered in more than 170 countries around the world. Even in India it has extensively used through retailing out of 11 exclusive brand outlets, multiple designer boutiques in various cities such as New Delhi, Noida, Mumbai, Hyderabad, Bangalore, Goa, etc., and online stores. The Applicant's has huge sales turn overs. The Applicant also stated that it is popular amongst Indian celebrities thereby increasing the popularity of the Petitioner amongst the general public as well. Jacqueline Fernandez has recently become Petitioner's Brand Ambassador. Several Indian actresses like Priyanka Chopra, Kangana Ranaut, Alia Bhatt, Sonam Kapoor, Frieda Pinto, Kareena Kapoor, Madhuri Dixit, Karishma Kapoor, Kajol, Sonakshi Sinha, Dia Mirza, Shilpa Shetty, Sridevi, Lisa Ray, Neha Dhupia, Tabu, etc. have been associated with the AMPM brand in different ways such as customers, loyalists or enthusiasts. The Applicant also stated that it had undertaken and spent huge brand promotion activities. The Applicant has conducted and participated both national and international events/shows. The Applicant has also have its own website and internet presence through their website www.ampm.in which has been registered by them on 22nd December 2008 and as also its products available on all famous e-commerce platforms such as Amazon, Myntra, Nykaa, AZA, Carma, Ogaan. Further the Applicant has strong presence in social media such as Facebook, Instagram and Pinterest and has received various awards and recognitions for its products/services under the famous AMPM Marks.

7. The Applicant stated that around the last week of May 2020, the Applicant was informed about some pop-up advertisements on Instagram, which when clicked on, directed to the link-

https://www.instagram.com/ampm_designs/. The marks-  AMPM Designs/ ("impugned marks") shown on the Instagram page are identical and/ or deceptively similar to the Applicant's AMPM Marks. On further enquiry about the said marks, the Applicant found two trademark applications filed by the Respondent No.1 i.e., 4165858 and 4165852 for the device

 and the word mark AMPM Designs in class 42 respectively. The Applicant

has opposed the Application No. 4165858 for the mark  which was advertised in the TMJ No. 1928 dated 18/11/2019. The Applicant stated that the Respondent No. 1's impugned registration herein for the mark AMPM DESIGNS inadvertently did not come into their notice that was advertised in the TMJ No. 1923 dated 14.10.2019 and thus the Applicant could not timely file the

opposition against the said mark at that time. The Applicant stated that the said impugned registration has been issued/ sealed on 03/03/2020 and the Applicant has filed the present rectification application as soon as it became aware about the impugned registration.

8. The Applicant stated that the Respondent No.1 had opposed vide Opposition bearing no. 1058796 against Applicant's prior Appl. No. 3500631 in class 42 and in the said Opposition the Respondent No.1 claimed the marks of the Respondent No.1 and this Applicant are similar and thus usage of the same cause public confusion and that General public would assume nexus between the Applicant and Respondent and that the services are identical too. The Applicant submitted that in view of the submissions made by the Respondent No. 1 in the notice of opposition, it is an admitted position that the Applicant's AMPM Marks are identical with/ deceptively similar to the Respondent No. 1's impugned mark under the impugned registration and the services are identical or related thereto. Therefore, the limited question that remains before this Hon'ble Board is to adjudicate who is the prior adopter of the trademark AMPM. The Applicant had adopted the trademark AMPM back in the year 2002, while the impugned registration has been filed by the Respondent No.1 in the year 2019 on proposed to be used basis.

9. The Applicant's prior Appl. No. 3500631 was cited in the examination report of the impugned registration of the Respondent No.1. and the Respondent No. 1 in its response to the examination report took a categorical stand before the Ld. Registrar that the impugned mark was different from the mark of the Applicant. However, the Respondent No. 1 has thereafter filed a notice of opposition against the very same application of the Petitioner i.e. Appl. No. 3500631 relying upon the impugned registration.

10. The Applicant stated that the mark is dishonestly adopted by the Respondent No.1 to ride upon the repute of the Applicant. The Applicant submitted that Respondent No.2 Since have cited the Applicant's mark under Section 11 of Trademark Act, 1999 read with Rule 33 of the Trademark rules ought not to have accepted the same for Registration. Hence, the impugned registration is ex-facie illegal, invalid and obtained through fraud and misrepresentation.

11. The Applicant stated that the Respondent No.1 taking a defense now stating the services of the Applicant and Respondent No.1 are different and that under the impugned mark services of 'interior design and lighting solutions' and they are not manufacturing or supplying any goods under the impugned mark, whereas, the Applicant does not provide said services. However the Respondent No.1 have claimed in the Opposition Notice filed by them against this Applicant the services as similar which is contradictory statement by the Respondent No.1.

12. The Applicant further stated that it not only deals in various goods but also provides services including but not limited to- fashioning designing services, retailing services, tailoring services, etc., and law provides protection not just for goods and/ or services for which the mark has been registered but also for similar/ allied/ cognate goods and services.

13. The Applicant stated that both the Applicant and the Respondent No. 1 are engaged in producing creative designs and while the designs of the Applicant manifest themselves primarily on cloth, the

designs of the Respondent No. 1 are not only produced on the walls of a room but also décor which includes cloth.

14. The Applicant further stated that its natural zone of expansion and it is common practice for fashion designers to collaborate with architects or builders for interior decoration and designing. The Applicant in its Petition has already enumerated examples of fashion designers which have turned interior designers for certain projects. And thus the Applicant has the intention to expand into the field of interior designing/ decoration, which is evidenced by the fact that Applicant has applied for a registration in Class 42 back in the year 2017.

15. The Applicant submitted that it is a well-established judicial principle that by prior use of a mark on certain products and services, a trader obtains the right to preempt the mark not only for related products and services but also for those which reasonably can be assumed to emanate from the trader in the natural expansion of its business under the mark. The prior user acquires the right to preclude a subsequent user from using the mark if the effect would be to expose his reputation to the hazards of the newcomer's business practices. In addition, even if a trademark owner is merely contemplating expansion into a particular product or service line, a subsequent user nevertheless will be precluded from using the trademark if prospective purchasers would assume the product emanated from the prior user as a natural expansion of its business.

16. The Applicant submitted that its mark qualified for status of Well-Known mark and Applicant mark is prior and Registered mark it has reputation in India. Further stated that test of common filed is no more a valid test of comparison as held in the case of *Larsen and Toubro Limited Vs. LachmiNarain Trades and Ors. 2008(36)PTC 223(Del)*.

17. The Applicant submitted that claims of the mark differences by the Respondent cannot be sustained as Respondent No. 1's defense of difference in the marks is belied from the fact that the Respondent No. 1 itself has filed an opposition to the Petitioner's prior AMPM Mark claiming similarity/ identity of marks and likelihood of consumer confusion. Therefore, once the Respondent No. 1 has taken the stand that the two rival marks are identical and the services are identical/ similar, which are likely to cause confusion, it does not fit in the mouth of the Respondent No. 1 to plead that the marks and goods/ services are different. Respondent No. 1 is guilty of approbate and reprobate and relied on *Karam Kapahi and Ors. Vs. Lal Chand Public Charitable Trust and Ors., AIR 2010 SC 2077 (Para 61 to 69)*.

18. The Applicant stated that it is a settled position of law that while comparing two marks the overall similarity is required to be considered, including the similarity of the main idea and the similarity of their broad and salient features, rather than doing a microscopic examination and close scrutiny by placing the rival marks side by side and extracting their dissimilarities. The impugned registration has been filed for the impugned word mark- "AMPM DESIGNS". The Applicant's trademark AMPM is completely incorporated in the impugned mark. The prominent portion of the impugned marks is AMPM which is the famous trademark of the Applicant and is used by Applicant as a trademark as well as a part of its corporate name. There is nothing distinctive about the word "designs" and it is merely descriptive of the services being provided by the Respondent No. 1, i.e. interior designing. The word "designs" has no

trademark significance and hence has to be disregarded for the purpose of comparison of the rival marks as it is a settled law that while comparing the rival marks the prominent and distinctive features of the marks are required to be compared.

19. The Applicant submitted that the Whilst the terms AM & PM are terms relevant to time, they have no relevance to either clothing or designing services and hence, it is completely arbitrary for such services, just as Apple is for computers, etc.

20. The Applicant submitted that the Respondent No. 1 claims to have adopted the impugned mark "AMPM" from the initials of its partners Mr. Akash Mehta and Mrs. Poonam Mehta as false as the same as afterthought. The timelines provided by the Respondent No. 1 with regard to the adoption of the impugned mark and thereafter, are not corroborated by the documents filed by the Respondent No. 1 and on the contrary the alleged documents present a different story, as provided herein below: a) The audited balance sheets for the years 2014-2015, 2015-2016 pertain to Mr. Akash Anil Mehta only and there is nothing to show that Ms. Poonam Lunawat Mehta was involved in the business of Respondent No. 1. b) Audited balance sheet filed for the year ending 31.03.2016 shows payment of INR 6,00,000/- to Poonam Mehta, as commission. This clearly shows that the claim that the Respondent No. 1 was established in 2014 is false. c) All the invoices till 2016 have email id 'akash@lightart.co.in'. Further, check on the internet has revealed that an entity 'Light Art' was also operating from the same premises i.e., No. 111, Jothi Venkatachalam Road, Vepery, Chennai – 600007, on which the Respondent No. 1 No. 1 has procured the registration from Central Board of Excise and Customs. d) The Respondent No. 1's conduct of adopting the initials of their names in the manner that it forms AMPM, cannot be termed as bonafide adoption. The fact that the Respondent No. 1 came up with the combination of their initials and that too, in the identical sequence, speaks volume about its malafide intention. It is clear that the Respondent No. 1 deliberately adopted such a mark, which can show some association/affiliations with the Applicant and/ or its AMPM Marks, to take the undue advantage and enrich unjustly by riding on the Applicant's enormous goodwill and reputation in the AMPM Marks. e) Moreover, the initials of its partner's names cannot be used to form the mark AMPM for the following reasons- Partnership Deed bears the name of the Respondent No. 1 No. 2 as 'Poonam Suresh Kumar' and "Poonam Sanjay Kumar", and GST certificate filed by the Respondent No. 1 reflects the name of Respondent No. 1 No. 2 as "POONAM". Relevant pages from Partnership deed and GST certificate and on various documents, the name of the Respondent No. 1 No. 1 is written as "Mr. Akash Anil Mehta".

21. The Applicant submitted that the defense of the Respondent No.1 that multiple third parties are using the similar mark and thus the mark is a generic mark has no defense to the Respondent No.1. A total of 30 third party applications/ registrations across all classes do not mean that the mark is diluted of which some of the applications mentioned by the Respondent No. 1 are currently under objection or have expired or some action has been taken by the Applicant.

22. The Applicant submitted that even otherwise, mere existence of the third party marks on the TM Register does not prove actual use in the market and the Respondent No. 1 has failed to show the extent of use of the concerned marks by such third parties in the market. It is a settled law that it is of little value for the Respondent No. 1 to point to third-party use in an effort to establish the weakness of a contested mark. The plea of common use must fail where use by other persons is not substantially established as held in the case of *Shri Pankaj Goel Vs. M/s. Dabur India Ltd.* 2008 (38) PTC 49- Para 23.

Moreover, the Hon'ble Board is called upon to decide disputes in between the parties which are before it. The contention that certain other parties are using the Applicant's AMPM Marks is a matter between the Applicant and the third party. It is not for the Respondent No. 1 to claim protection on that score. In any case, the Respondent No. 1 who has himself sought registration for the mark AMPM cannot take the defense that the mark is generic or common to trade. As held in the case of Automatic Electric Limited vs. RK Dhawan- Para 16 77 (1999) DLT 292.

23. The Applicant thus prayed for the removal of the impugned mark from the Registry.

RESPONDENT NO.1'S REPLY:

24. The Respondent No.1 appeared and filed its Counter Statement and denied all the allegations, contentions, statements, averments and claims of the Applicant and further stated that the Applicant is not only trying to strong arm Respondent No. 1 but is attempting to attain an unfair advantage and monopoly over all the classes under NICE classification. The claim of the Applicant is misplaced, malafide, misconceived and there is no case made out by the Applicant which would entitle them to seek any relief from this Ld. Board. Not only does the Applicant not provide any services in proximity to 'interior design and lighting solutions' but the Applicant provides no services at all. It is most pertinent to note that the Applicant has nothing to do with interior design services and is also not registered under the relevant Class 42 where Respondent No. 1's trademark is already registered and thus this Application is liable to be dismissed in limen.

25. The Respondent No.1 submitted that the Applicant has suppressed material information from this Board in that several other third parties under various other classes have registered mark AMPM and the mark is been extensively used by businesses in the County and thus not entitled for any reliefs by the Applicant. The Applicant had co-existed with such several marks in the market for years and is being used in different fields and trades by their respective owners.

26. The Respondent No.1 submitted that the term "AM" "PM" signifies and represents time, and is generic in nature. Nobody can claim an exclusive right of any word, abbreviation or acronym which has become public juris. Moreover, the Applicant has not coined the word AMPM and the same does not belong to the Applicant. That the mark of the Applicant includes the suffix which are names of the parties. Therefore, the Applicant can never have an exclusive right and/or protection with respect to the term "AMPM".

27. The Respondent No.1 further submitted that there is a civil suit also filed by the Applicant being CS. (COMM) No. 272 of 2020 before the Hon'ble high Court of Delhi, seeking "declaration, permanent injunction restraining infringement of trademarks and passing off mandatory injunction against domain name, delivery up, damages an rendition of accounts". The pleadings are complete in the said Suit, the Hon'ble High Court has heard the Applicant at length on several dates and no Order of injunction has been granted in favour of the Applicant; the Respondent No.1 started its arguments and has been part-heard in the said civil suit and sub-judiced before the Hon'ble Delhi High Court.

28. The Respondent No.1 stated that Respondent No. 1 is headed and operated by its two partners, Mr. Akash Mehta ('AM') and Mrs. Poonam Mehta ('PM'), who got married on 09.12.2012. The Partnership is an exclusive interior design firm based in Pune, Maharashtra. As is evident from the

initials of the aforementioned partners, the terms 'AM' and 'PM' were brought together to form 'AMPM', so as to capture and conceptualize their partnership. Respondent No. 1 provides premier and luxury services for interior designing and lighting solutions for spaces. In view of the above it is humbly stated that Respondent No. 1 honestly coined and created the novel and distinctive trademark AMPM.

29. The Respondent No.1 submitted that initially, Respondent No. 1 was founded as a proprietorship firm, in the year 2014 by AM. Thereafter, PM joined AM. Respondent No. 1 has been using its brand name since 2014 and has attained distinctiveness and led to rise in its goodwill amongst its customers. To support its claim of usage of the mark the Respondent No.1 relied on the email from Kotak Mahindra Bank on 30-01-2014 referring the Respondent No.1's AM proprietorship firm. A Certificate issued on 18.06.2014 by the Central Board of Excise and Customs (CBEC) in recognition of registration of the partnership with the Central Excise Department and Income tax returns filed by AM as the proprietor of Respondent No. 1 from the year 2014 to 2017 confirm usage of Respondent No. 1's trademark since the year 2014.

30. The Respondent No.1 submitted that in the year 2017, the AM and PM registered Respondent No. 1 as a partnership. Hence, the AM and PM transformed the proprietorship into an exclusive partnership based in Pune, Maharashtra. Clause 4 for the aforesaid Deed of Partnership categorically states that the nature of business of the partnership is, "...making Interior and Lighting Design and sale of that design...". Hence, making it crystal clear that the AM and PM always intended to render services in this specific niche area of 'interior and lighting design'. Further the Permanent Account Number Card (PAN) of Respondent No. 1 dated 25.01.2017, and the Goods and Services Tax (GST) Registration Certificate of Respondent No. 1 dated 02.08.2017, and the Micro Small & Medium Enterprise (MSME) Registration Certificate of Respondent No. 1 with date of commencement as 25.01.2017, seconds the fact that Respondent No. 1 as a partnership bonafide commenced in January 2017.

31. The Respondent No.1 stated that it had invested huge amounts of capital in marketing and advertisements over the years and provided the list of amounts spent from 2017 till 2020 on Facebook promotions etc., in a tabular format. The said advertisements, goodwill from the exceptional work and referrals from existing clients of the Respondent No.1 have led the growth of the Respondent No.1

32. The Respondent No. 1 submitted that it's presence and spotlight for its flawless services are evident from the numerous testimonials and exceptionally positive feedback received from Respondent No. 1's satisfied clients. Respondent No. 1 is heavily celebrated on social media websites. With followers running into thousands, it is no coincidence that Respondent No. 1 is popular and actively approached by its future customers and enthusiasts. Testimonials and feedbacks from the websites and social media handles of Respondent No. 1 makes the aforesaid evident which includes Instagram, AMPM Website of the Respondent No.1, Google Reviews and Facebook.

33. The Respondent No. 1 submitted that it's success beyond happy and satisfied clients is reflected in the progressively increasing revenues accrued by Respondent No. 1 over the years. The revenue generation has multiplied manifolds due to the popularity and demand for the services of Respondent No. 1.

34. The Respondent No.1 also submitted that it has created its own name, good will and space in the industry and received several awards and appreciation for its services.

35. The Respondent No.1 in the year 2019 filed Applications for registration of the trademark ‘AMPM DESIGNS’ as a word and as a logo. Following which the Trademark Marks Registry Mumbai issued a Certificate of Registration of the trademark ‘AMPM DESIGNS’ word on 03.03.2020 vide Trademark No.4165852. The Petitioner did not oppose to the registration of Respondent No.’s trademark and hence has forgiven the right to object to its registration. Thereafter the Applicant raised a malafide Opposition to the registration of the trademark ‘AMPM DESIGNS’ logo after it was successfully advertised in the trademarks journal. In their notice of opposition, the Applicant has not adduced any evidence to show that they provide any services and have further reaffirmed that they only deal in the production and sale of goods. Hence, Applicant’s Opposition is in spite and to strong arm Respondent No. 1 to gain unfair advantage across all the classes. The claim of the Applicant is untenable and illegal.

36. The Respondent stated that the Applicant is specifically a manufacturer of fashions goods and seller of those goods. The Applicant’s recognition and trademarks are all in the discourse of fashion wearable “goods”. The Applicant has registered its mark in classes belonging to goods only. Hence, making it crystal clear that the Applicant does not provide services, especially any services in niche of ‘interior design and lighting solutions.’ Therefore, to claim a monopoly on any goods or services that do not form part of an entity’s trade is against the well settled and jurisprudence of trademark law. It is specifically stated that the marks of the Applicant are not a well-known marks.

37. The Respondent No.1 stated that Applicant has repeatedly admitted that it does not provide architecture, interior designing or lighting solution services. Be as it may, in July 2020, the Applicant filed an Application for registration of trademark under Class 42, with a claim that the Applicant is now planning to expand into services under Class 42. Thus the applicant is attempting to take unfair advantage of the Respondent No.1 goodwill associated in the services of interior design and that Respondent No.1 is reserving its rights to take appropriate action against the Applicant.

38. The Respondent No.1 stated that admittedly the Petitioner’s line of business and Respondent No. 1’s line of business is completely different. The customer base is also totally different and even a customer of average intellect will be able to make out the difference. There is no likelihood of any confusion and there is no likelihood of Respondent No. 1 taking any advantage of purported goodwill of the Petitioner in the market. The Petitioner and Respondent No. 1 have co-existed since the very beginning.

39. The Respondent No.1 claimed that the marks of the Applicant and Respondent No.1 has visual difference and provided the following comparison table of the said marks.

Respondent No. 1’s trademark	Petitioner’s applied word mark
	



40. The Respondent No.1 also submitted various third parties registered the mark AMPM and illustrative images of using the mark AMPM. Also there exist several companies which have AMPM in the company name and are registered under Indian Companies Act and thus the claims of the Applicant that its mark AMPM is well known are inconceivable and thus the Respondent No.1 seeks dismissal of the Application.

41. The Respondent No.1 also submitted para-wise reply to the Rectification Application and denied each of the averments of the Applicant. The Respondent No.1 particularly denied that the mark AMPM is coined by the Applicant and stated that the mark AMPM denotes day and night ideology. Further the Respondent No.1 stated that the mark of the Petitioner is always associated with the goods manufactured and sold, especially wearable fashion products and no services whatsoever was involved.

42. The Respondent No.1 also stated that the earliest active trademark for AMPM on the Trademark Registry belongs to one Atlantic Richfield Company under application Nos. 540205, 540204, 540203 and 540215 under classes 16,29,30 and 32 with application date as 19/11/1990 and thus the Applicant cannot be proprietor of the mark.

43. The Respondent No.1 further stated that the use of the mark AMPM by them is prior in point of time for 'interior design and lighting solutions.' And the fact that the Applicant does not provide any services and its registrations are limited to sale of goods the Application No. 3500631 dated 03.03.2017 of the Applicant is liable to be dismissed and is not maintainable in law. The Respondent No.1 also submitted that the Applicant has no common law right of the mark for the said services. The Respondent No.1 denied that the Applicant has any sales, services or advertisement related to the services under class 42. All the claims made by the Applicant pertain to the goods under class 25 and not for any services including the sales and promotional expenses exhibited by the Applicant. Also celebrity endorsements are related to the goods that the applicant is selling and not related to the services that impugned mark under this Application in question.

44. The Respondent No.1 further stated that Respondent No.1 had registered the domain name www.ampm-designs.com and is present on internet since at least the year 2014 that it is extremely popular among public for the services they are rendering. The Respondent No.1 also stated that it has substantial and considerable presence and popularity in its social media platforms.

45. The Respondent No.1 stated that the Applicant's claims that it had posted in the blogs of the Applicant during lock down this year on Courses related to Interior Designing does not entitle them for the proprietorship in the mark and provide right to object the Respondent No.1 legitimate business.

46. The Respondent No.1 stated that the Applicant mark has not been conferred the well-known status to claims rights in all classifications of goods and services and it is incorrect to suggest that the mark AMPM is connected only with the Applicant Company and thus the Respondent No.1 denies that the mark AMPM is well-known and belongs to the Applicant alone.

47. The Respondent No.1 stated that when the Applicant marks have registered despite the several other existing with prior usage and Registrations, there should not be any objection for the Registration of the Respondent No.1 mark as well.

48. The Respondent No.1 stated that it is incorrect statement by Applicant that it got aware about the Respondent No.1 only in May 2020; since the Respondent No.1 is actively doing business since 2014.

49. The Respondent No.1 further narrated the marks are not similar and they can be distinguishable and has lot of differences. Further the Respondent No.1 reiterated that the prefix AMPM in AMPM DESIGNS mark of Respondent No. 1 signifies the delivery of world class services of its partners, namely "Akash Mehta" and "Poonam Mehta."

50. The Respondent No.1 stated that the Applicant in its own submissions has admitted that it has not attained any loss and exfacie claims that it might attain loss in future. The fact is that Respondent No.1 is in business since the year 2014. If after so many years of co-existence, there has been no losses attained by the Applicant, then how is it expecting it now. The Applicant failed to elaborate and substantiate and hence, it is incorrect and denied that Applicant is likely to be put in any loss, in business or in reputation. Also, any question of unfair advantage on the part of the Respondent No. 1 who has no association with any goods, especially fashion goods, cannot arise.

51. The Respondent No.1 stated that the prayer of the Applicant that the registered trademark of Respondent No. 1 should be rectified, cancelled and removed from the Register of Trade Mark is malafide, without any merit and deserves no consideration. The prayer of the Applicant that the records relating to the registered trademark of Respondent No. 1 be called in, is not required and futile exercise. The Applicant is not entitled to any relief whatsoever. The Applicant stands meritless before this Id. Board and thus the present Rectification Application needs to be dismissed.

52. The Respondent No.1 also stated that a Civil Suit bearing No. C.S. (COMM) No. 272 of 2020 filed by the Applicant herein, is being adjudicated upon before the Hon'ble High Court of Delhi, wherein the registered trademark no. 4165852 in class 42 is a subject matter of the proceedings.

FINDINGS OF THIS BOARD

53. We have gone through the submissions of the both the counsels and material placed on the record. It is admitted position that the Applicant is prior adopted and using the mark AMPM; however the contention of the Respondent No.1 is that the said adoption and usage is with regards to the Fashion wearable goods and not related to any services related to interior designing and lighting services.

54. The averments of the Respondent No.1 that are marks are dissimilar in the present proceedings contradicts its own statements made in the Opposition notice filed by it against the Applicant's Trademark Application in class 42 and thus on the question of similarity in the marks this Board concludes that the marks are similar and it is settled law that when comparing the marks the overall similarity needs to be considered. Further the contradictory statements by the Respondent No.1 in that while replying to the examination report of the Respondent No.1

Trademark Application it claimed the same marks are dissimilar and upon obtaining Registration, it filed an Opposition to the Applicant's mark claiming it to be similar. This sought of arguments are not appreciated and Respondent No.1 cannot take different stands convenient to it in respective proceedings.

55. The Respondent No.1 further statements that the mark AMPM is generic and has been using by several other traders goes against the Respondent No.1, since the present application is moved to remove the mark of the Respondent No.1 from the Register. It is not entitled to claims any rights when several third parties using the said mark.

56. The Respondent No.1 claims of usage of the mark and co-existing since at least 2014 cannot be correct as the Application for the said Registration of the mark AMPM DESIGNS under impugned Registration vide Application No.4165852 is filed on 03/05/2019 with a proposed to be use claim and hence the Respondent cannot now lay a claim of prior usage.

57. The Respondent No.1 averments related to pendency of Civil Suit bearing No. C.S. (COMM) No. 272 of 2020 filed by the Applicant herein and that is being adjudicated upon before the Hon'ble High Court of Delhi, wherein the registered trademark no. 4165852 in class 42 is a subject matter of the proceedings is concerned the Apex Court in its various decisions held that it is a settled law that the issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court and hence the same will be dealt by this Board.

58. The Delhi High Court in the case of *Ozone Spa Pvt. Ltd. Vs. Ozone Club 2010 (42) TPC 469 (Delhi)* and more particularly para 28, which is reproduced below: "28. The other objection raised by the defendant is that "Ozone" is a generic name and no one can have exclusive rights over the same and the plaintiff is also not the proprietor of the mark Ozone?. The said argument is a self defeating argument. Firstly, the mark "Ozone" is a registered trade mark in favour of the plaintiff and secondly the defendant himself has applied for registration of the trade mark "Ozone" in class 41 in relation to the services as that of the plaintiff. It does not lie in the mouth of the defendant to contend now that the mark is a generic mark, in fact the defendant is debarred from raising such a plea in view of his own conduct. The said contention is totally misconceived. In the case of *Automatic Electric Limited v. R.K. Dhawan and Anr.* 1999 (19) PTC 81 in para 16, the learned Single Judge of this Court has observed that the defendant had got their trade mark "DIMMER DOT" registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression. User of the word "DIMMER" by others cannot be a defence available to the defendants, if it could be shown that the same is being used in violation of the statutory right of the plaintiff." Similarly in the present case the Respondent No.1 submitting that the mark is generic cannot be accepted as the Applicant has Registration to the mark and further the Respondent No.1 itself obtained the

Registration of the said mark. As laid down by the Honourable Delhi High Court it is self-defeating statement by the Respondent No.1.

59. The Delhi High Court further held in the case of *M/S Shree Rajmoti Industries vs M/S Shri Vishwaprabha Food Products Private Limited in CS(COMM) 397/2018 and I.A. 10672/2014 (for stay)* on 27 September, 2018 that “the nature of the products being as they are i.e. edible oil and water on the one hand and rice on the other, they are articles of human consumption and thus constitute similar or cognate/allied goods. Under these circumstances, the Plaintiff is entitled to a decree for permanent injunction as prayed.” Applying the similar principle to the present Rectification Application the goods/services Fashion Designing and Interior Designing both pertain to creative art work are considered to be cognate/allied goods/services.

60. It is admitted position that the Applicant had prior adopted the mark for his fashion wearable goods and had invested huge amounts in sales and promotion of the same both in India and international along with endorsement of celebrities. Since the services of Interior Designing and Fashion Designing are allied and cognate and due to extensive presence of the Applicant in national and international arena, it is likely that confusion would arise if any similar marks are adopted and used by others for such services.

61. This Board is not concerned about the opposition proceedings between the parties before the Respondent No.2 which can be decided by the Respondent no.2 independently without the influence of the present order. This Board further is not dwelling into the injunction of usage of the mark by either party which is ceased with Hon’ble Delhi High Court.

62. The limited adjudication that this Board handling is the validity of the Registration of the Respondent No.1. In view of the submissions and arguments advanced by the parties it is admitted position by both the parties that the Applicant has prior adopted and used the mark, both the marks are similar, the goods and services are allied and/or cognate to each other and thus the Application No. 4165852 in class 42 has been wrongly accepted by the Respondent No.2.

63. In order to maintain purity of the register, trademark bearing registered No. 4165852 in class 42 is ordered to be removed from the Register forthwith. The Respondent no 2 shall remove the entry immediately from the record of the Register of Trademarks.

64. Copy of order is to be served to Respondent no 2 for compliance.

65. There shall be no orders as to the Costs.

-SD/-

(Ms. Lakshmidevi Somanath)
Technical Member (Trademarks)

-SD/-

(Shri. Makyam Vijay Kumar)
Technical Member (Trademarks)

-SD/-

(Shri Justice Manmohan Singh)
Chairman

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