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

Date of Decision:- 12th July, 2023.

\+ **C.A.(COMM.IPD-TM) 37/2021**

ROOPAK'S PIK AND PAY ..... Appellant

Through: Mr. Purvesh Buttan, Advocate (M: 9818208200).

versus

THE REGISTRAR OF TRADEMARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates (M: 9810788606).

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

2. The present appeal has been filed by the Appellant- Roopak's Pik-N-Pay under Section 91(1) of the Trade Marks Act, 1999 challenging the impugned order dated 30th August, 2019 passed by the Respondent No. 1- the Registrar of Trade Marks (*'the Registrar'*) by which the Appellant's trade mark application No. 2807794 in Class 35 (*hereinafter, 'the application'*) has been rejected. The details of the application are as under:-

Number	**Date**	**Mark**	**Goods in Class 35**
2807794	12/09/2014	ROOPAK'S PIK-N-PAY	Advertising, Business Management, Business administration, office functions, display, exhibition, trading and marketing services in relation to preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and, milk products, dairy products, dry fruits, popcorns, edible oils, ghee, pickles and fats,, coffee, tea,

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			cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice, atta, maida, sooji, besan, rice, namkeens, biscuits, maize, noodles, pizza, rusk, corn flakes, Mineral water, aerated water, non-alcholic drinks, fruit drinks, fruit juices, syrups and other preparations for making beverages.

3. The present appeal was originally filed before the Intellectual Property Appellate Board ('IPAB') in 2020, and thereafter was transferred to this Court 2021 upon the abolition of the IPAB.

4. The grounds for rejecting the application are the presence of other similar marks cited by the Respondent No. 1 in the Search Report dated 11th July 2016 with the name ROOPAK and/or ROOPAK STORES. The Search Report is as follows:

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8/22/2016 Examination Report

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

INTELLECTUAL PROPERTY INDIA

LOCATION:
SECTION: EXM
REPORT: EXM007

WORD MARK SEARCH REPORT
APPLICATION NUMBER: 2807794
Class : ---
TRADEMARK: 'Roopak"s PIK-N-PAY (LABEL)'

USER : GPS
PAGE:1
DATE: 11/07/2016

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							
765049	29	R O O P A K	9998	SATPAL GULATI	A - 6/ 9, AJMAL KHAN ROAD, KAROL BAGH, DELHI - 110 005.	Registered	
APPLICATION DATE 30/07/1997 12:00:00							
GOODS/SERVICE DRY FRUITS, OILS, JAMS, PICKLES, POTATOCHIPS.							
826366	29	ROOPAK	1346	KISHAN CHAND GARG	PREM PURI, NEAR POST OFFICE, DHANKUR, DISTT. GAUTUM BUDH NAGAR. [U.P.]	Abandoned	
APPLICATION DATE 06/11/1998 14:56:13							
GOODS/SERVICE MANUFACTURING AND TRADING EDIBLE OILS LIKE VANASPATI GHEE, MUSTARD OIL, GROUND NUT OIL, REFIND OIL AND COCONUT OIL.							
1129843	29	ROOPAK SINCE -1958	1324	ROOPAK OVERSEAS PVT. LTD,	ROOPAK BUILDING, 6/9 AJMAL KHAN ROAD, KAROL BAGH, NEW DELHI - 110 005.	Registered	
APPLICATION DATE 29/08/2002 13:06:32							
GOODS/SERVICE ALMOUND GROUND ALBUMEN AND ALGINATES FOR FOODS BEANS. BACONS SAUSAGES, B OVILLION, BUTTER AND BUTTER CREAM IN ALL FORMS CASEIN FOR FOOD CAVIR, CHIPS COCOA, CORN ALL FORMS CASEIN CRYSTALLIZED FRUITS DATES EGGS IN ALL FORMS OILS EDIBLE FATS. FATTY SUBSTANCES FOR THE MANUFACTURE OF EDIBLE FATS,FISH IN ALL FORMS, FRUIT CHIPS FRUIT JELLIES FREZEN AND FROSTED FRUITS GELATINES GHEKING AND GRAVIES MEAT CHICKEN ETC. JAMS. JUICES KEFIR KUMYS LARD LENTILS PRESERRVED MAIZE OIL MARGARINE, MEAT IN ALL FOR							
1150653	29	ROOPAK(LABLE)	9999	ROOPAK STORES PVT. LTD.	6/9, AJMAL KHAN ROAD, KAROL BAGH, NEW DELHI - 110 005.	Registered	
APPLICATION DATE 14/11/2002 13:53:00							
GOODS/SERVICE DRY FRUITS, OILS JAMS, PICKLES, POTATOCHIPS, NAMKINS, SAUSAGES, PREPARATION FOR MAKING SOUPS, JUICES AND YOUGURT.							
1150657	29	ROOPAK(LABEL)	9999	ROOPAK STORES PVT. LTD.	6/9, AJMAL KHAN ROAD, KAROL BAGH, NEW DELHI - 110 005.	Registered	
APPLICATION DATE 14/11/2002 13:53:00							
GOODS/SERVICE DRY FRUITS, OILS, JAMS, PICKLES, POTATOCHIPS, NAMKINS, SAUSAGES, PREPARATION FOR MAKING SOUPS, JUICES AND YOUGURT.							
765048	30	R O O P A K	1332	SATPAL GULATI	A - 6/ 9, AJMAL KHAN ROAD, KAROL BAGH, DELHI - 110 005.	Registered	
APPLICATION DATE 30/07/1997 12:00:00							
GOODS/SERVICE SPICES, BEVERAGES, BISCUITS CONFECTIONERY, CORN CURRY POWDER, GINGER , MAIZE, NOODLES, PEPPER, RICE, TOMATO SAUCE, TEA & VINEGARS.							
2807793	35	Roopak"s (LABEL)		DEEPAK GULATI	6/9, AJMAL KHAN ROAD, KAROL BAGH,	Marked for Exam	

http://164.100.176.37/eregister/examreport.aspx?APPLICATION_NUMBER=WFlaW1xdKS8nLi4wK1hZWltcXQ==

5. Ld. Counsel for the Appellant, Mr. Puvesh Buttan submits that all the marks cited in the above Search Report belong to his family comprising of his father-Mr. Satpal Gulati and other family members. Further, there have been disputes between the Appellant and his other family in relation to the mark 'ROOPAK' resulting in a suit ***CS(COMM) 741/2017*** titled ***Roopak Stores Pvt. Ltd. v. Roopaks Pik-N-Pay.***

6. In the said suit, an application for interim injunction was filed by

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'Roopak Stores Pvt. Ltd' in which Mr. Satpal Gulati is a director. This Court vide order dated 25th March, 2019 and 17th July 2019 observed that the Appellant herein shall be permitted to use the mark 'ROOPAK'S PIK N PAY' and ROOPAK'S and no other variants. The relevant portion of the said order is set out below:-

> *"8. As noted above, the defendants have placed on record invoices which show user of the label ROOPAK'S which relate back to the year 1994. They have also pointed out to the reply filed before the Trade Mark Registry. The defendants had filed an application for registration of the mark ROOPAK'S PIK N PAY, objections were filed by the plaintiffs. In the reply to the objections, a plea has been taken by the defendants that they had annual sales figures under the mark ROOPAK'S in 1993-94 of Rs. 23.63 lakhs, in 1994-95 Rs.54.42 lakhs and so on. Prima facie, it appears that the defendants have been using the mark ROOPAK'S since 1993-94.*
> *9. In my opinion, at this stage, after a prima facie user of the trade mark ROOPAK'S PIK N PAY and mark ROOPAK'S for 25 years,* ***it is not possible for the court to injunct the defendants from using the trade mark/name ROOPAK'S PIK N PAY or using the label ROOPAK'S****.*
> *12.* ***I restrain the defendants to use any variants of the mark ROOPAK'S PIK N PAY or ROOPAK'S.*** *The defendants will also file their annual accounts in court including accounts since the year 1993-94 regarding the use of the mark ROOPAK'S within a period of six weeks. It is also ordered that the trial be expedited. Parties will share the cost of the appointment of the Local Commissioner to expedite the trial."*

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7. Mr. Harish Vaidyanathan Shankar, ld. CGSC submits that this order may not have been placed before the Respondent No. 1.

8. A perusal of the Examination Report dated 17th August 2016 and the Search Report dated 11th July 2016 it appears that save for one, all the other marks cited against the Appellant's mark belong to 'ROOPAK STORES PVT. LTD', its sister concerns or the family members of the Appellant. There is no cited mark belonging to any third-party mark in the Examination Report. The only third-party mark cited has already been abandoned.

9. In view thereof, the Appellant's mark deserves to proceed for advertisement in the Trade Marks Journal published by the Respondent No.1. Accordingly, the impugned order is set aside.

10. Let the Appellant's application bearing no. 2807794 in Class: 35 in the name of Appellant-ROOPAK'S PIK-N-PAY be accepted and be advertised in the Trade Marks Journal.

11. It is, however, made clear that observations in this order shall not bind any opposition proceedings, if filed, against the Appellant's application for grant of a trade mark.

12. The appeal is allowed in the above terms. It is made clear that if there are already objections filed by any party against other trademark applications of the Appellant, the present order would not apply to those proceedings.

PRATHIBA M. SINGH
JUDGE

JULY 12, 2023/*mr/dn*

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