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IN THE HIGH COURT OF DELHI AT NEW DELHI***Date of Decision:- 12th July, 2023.***

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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,



			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-alcoholic drinks, fruit drinks, fruit juices, syrups and other preparations for making beverages.
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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:



Environ Biol Fish

INTELLECTUAL
PROPERTY INDEX

LINCOLN : CEMEX
 PROJECT
 DATE: 11/27/2019

TH00118	229	KODHAR, SURESH	SATRAJ GULATI	A-673, AJMAL KHAN ROAD, KAROL BAGH, DELHI-110 006.	Registered
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026355	20	RECORDS	1345	HIGHMAN EDWARD LEONARD
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COOPERATIVE MANUFACTURING AND TRADING UNIONS LIKE VANASPATHI GHEE, MUSTARD OIL, GROUND NUT OIL, PEANUT OIL AND COCONUT OIL.

KIDPAX BUILDING, NW Registered
AJMAL KHAN ROAD,
KAROL BAGH, NEW
DELHI - 110 005.

[illegible]

215, AJMAL KHAN Registered
ROAD, KAROL BAGH,
NEW DELHI - 110 006

600 D&S SERVICE DRY FRUITS, OILS, JAMS, PICKLES, POTATO CHIPS, NANKINS, SAUSAGES, PREPARATION FOR MAKING SOUPS, JUICES AND YOGURT

MR. AJMAL KHAN Registered
 ROAD, KAROL BAGH,
 NEW DELHI - 110 005.

CONCENTRATED DRY POLISH, CILK, JAMM, PICKLING, POTASSIUMS, NANNING, SAUNDERS, PROPAGATION, FIRM

YOUNG 24 R G D P A K 1212 SATPAL GULATI

A - 62, AJMAL KHAN
ROAD, KAROL BAGH,
DELHI - 110 005.

9000SERVICES SPICES, BEVERAGES, BISCUITS CONFECTIONERY, CORN CURRY POWDER, GINGER, MAIZE, MULLING, PEPPER, RICE, TOMATO SAUCE, TEA & VINEGARS.

DIFFERENTIALS

R. ALI, MD **Marshall Ross**
DOB: 08/01/1958 **MD**

https://doi.org/10.1002/eqm2.1400

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



‘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.”



7. Mr. Harish Vaidyanathan Shankar, Id. 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