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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 08.09.2026
PRONOUNCED ON : 15.10.2026

CORAM:

THE HONOURABLE DR. JUSTICE A.D. MARIA CLETE

C.M.A. (T.M.) No. 5 of 2026
and
C.M.P. No. 1615 of 2026

Exponent Energy Private Limited,
Represented by its Director
Arun Vinayak Srinivasan,
Formerly having its office at No.76/2,
Site No.16, Khatha No.69, Singasandra Village,
Bengaluru (Bangalore) Urban,
Bengaluru,
Karnataka 560 068.

Presently having its office at
Sy.No.114 and 115,
Kammasandra Village, Attibele Hobli,
Anekal Taluk, Electronics City,
Bangalore, Bangalore South,
Karnataka, India -560 100.

..Appellant(s)

Vs

The Registrar of Trademarks,
Trademarks Registry,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai -600 032,
Tamil Nadu.

..Respondent(s)

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PRAYER: (a) To allow the present Civil Miscellaneous Appeal and set aside the order dated 25 July 2025, passed by the Assistant Registrar of Trade Marks, Geographical Indication and Copyright acting on behalf of the Respondent, in respect of Trademark Application No.5432621 in Class 42 and consequently, to direct the Respondent to accept for advertisement Application No.5432621 seeking registration of the word mark Exponent in Class 42 in the name of the Appellant (b) the costs of these proceedings be awarded to the Appellant and (c) To grant such further or other reliefs as this Honble Court may deem fit and proper in the circumstances of the case and in the interest of justice and equity.

For Petitioner(s): Mr.R.Sathish Kumar for M/s. Manish Saurastri, Anshul Saurastri, Minesh Andharia, Janhvi Chadha, Jay Shah, Preeta Panthaki,

For Respondent(s): Mr.K. Gangadaran, CGC

JUDGMENT

The present appeal has been preferred challenging the order dated 25.07.2025 passed by the Assistant Registrar of Trade Marks, refusing registration of the appellant's word mark "EXPONENT" under Application No.5432621 in Class 42, on the ground that the mark is phonetically similar to two earlier marks and that the services covered by those marks are similar, thereby giving rise to a likelihood of confusion under Section 11(1) of the Trade Marks Act, 1999 (hereinafter referred to as "the Act").

2. The appellant is a private limited company incorporated on 20.10.2020 and is engaged in the business of electric vehicle battery packs, charging

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equipment and related technological services. On 02.05.2022, it filed Application No.5432621 seeking registration of the word mark "EXPONENT" in Class 42, claiming use from 08.04.2021, in respect of scientific and technological services, research and design, industrial analysis and research, industrial design and vehicle design services.

3. The Trade Marks Registry issued an Examination Report dated 20.07.2022 raising an objection under Section 11(1) of the Act, citing two earlier marks, namely, (i) "EXPONENT", bearing Application No.3595698, in the name of Exponent, Inc., USA, covering engineering and scientific research and consultancy services, the status whereof is shown in the search report as "Protection Granted"; and (ii) "EXPONENTIAL TECHNOLOGIES GROUP", bearing Application No.5382808, in the name of Mouser Electronics, Inc., USA, covering electronic component design, testing and allied technological services, the status whereof is shown in the same report as "Objected".

4. The appellant submitted its reply dated 28.09.2022 along with an affidavit of use, contending that the rival marks, when compared as a whole, are distinguishable and that the services offered by the appellant are different from

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those covered by the cited marks. The appellant also relied upon its claimed prior use and special circumstances warranting registration.

5. Thereafter, show-cause hearings were held on 05.03.2024, 04.06.2024, 14.11.2024 and 05.02.2025. In its written submissions dated 07.06.2024, the appellant reiterated its objections and requested waiver of the objection, registration in association with its earlier registered marks under Section 16(1) of the Act, consideration under Section 12 of the Act, and advertisement before acceptance under the proviso to Section 20 of the Act. The appellant also relied upon its existing registrations in Class 42. According to the appellant, during the hearing on 05.02.2025, it offered to amend the specification of services to remove any overlap with the cited marks. It is, however, to be noted that no written application for amendment was filed before the Registrar, and that no proposed wording of a restricted specification has been placed on record either before the Registrar or before this Court.

6. However, by the impugned order dated 25.07.2025, the Assistant Registrar refused registration, holding that the applied mark was phonetically similar to the earlier marks and that the services covered were similar, resulting

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in a likelihood of confusion among the public. Aggrieved thereby, the appellant has preferred the present appeal.

7. Learned counsel for the appellant submitted that the impugned order is a non-speaking order, as it merely records the conclusion that the marks and services are similar, without examining the rival marks, the nature of services or the materials placed on record. It was contended that the statutory requirement under Section 18(5) of the Act to record reasons for refusal has not been complied with.

8. Learned counsel further submitted that the Assistant Registrar failed to appreciate that the two cited marks stand on different footings. While one is the word mark "EXPONENT", the other is "EXPONENTIAL TECHNOLOGIES GROUP", an expression of three words. The marks ought to have been compared as a whole, rather than merely on the basis of phonetic resemblance. Reliance was placed on **F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd., AIR 1970 SC 2062**, and **Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142**.

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9. Learned counsel further submitted that the appellant's services principally relate to electric vehicle batteries, charging infrastructure and associated technological services, whereas the cited marks cover specialised engineering, scientific consultancy and electronic component-related services. It was pointed out that the proprietor of the first cited mark is not present in India at all, being a company based in the United States of America, and that the description of its services is wholly different from that of the appellant. It was urged that the impugned order does not discloses that the authority applied her mind to any of these aspects such as the phonetic resemblance of the marks, the nature of the respective services; that the authority failed to undertake any proper comparison of the respective services before concluding that they were similar.

10. Learned counsel also contended that the documentary evidence establishing use of the mark from 08.04.2021, the appellant's existing registrations, and its requests under Sections 12, 18(4) and 20 of the Act were not considered. It was further urged that the subject mark ought to have been accepted in association with the appellant's earlier registered marks under Section 16(1) of the Act, and that this request was neither recorded nor decided. The appellant's offer to restrict the specification of services to avoid overlap with the cited marks was also ignored. It was further submitted that

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"EXPONENT" is an ordinary dictionary word over which no proprietor can claim a monopoly in unrelated fields. Thus, learned counsel prayed that the impugned order be set aside and the application be directed to be accepted for advertisement. In the alternative, learned counsel for the appellant also sought remand of the matter to the Registrar for fresh consideration in accordance with law.

11. The learned Central Government Counsel appearing for the respondent appeared to concede to the remand sought by the appellant side.

12. The following points arise for consideration:

(i) Whether the impugned order satisfies the requirement of recording reasons under Section 18(5) of the Act?

(ii) Whether a refusal under Section 11(1) of the Act can stand without dealing with Section 12, which that provision expressly saves?

(iii) Whether the Registrar has properly considered the appellant's requests under Sections 12, 18(4) and 20 of the Act?

(iv) Whether the appellant is entitled to a direction for acceptance and

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advertisement of the application or whether the matter requires remand for fresh consideration?

13. The principal contention of the appellant is that the impugned order is a non-speaking order and does not satisfy the requirements of Section 18(5) of the Act. The said provision reads as follows:

> *"In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision."*

14. Thus, Section 18(5) makes it mandatory for the Registrar to record the reasons for refusal and the materials relied upon in arriving at the decision. The requirement to record reasons is not an empty formality. It enables the applicant to understand the basis of refusal and facilitates effective appellate scrutiny. The question in every case is whether the order discloses an intelligible basis for the conclusion and deals with the material issues arising for determination.

15. In the present case, the Assistant Registrar has merely stated that the applied mark is phonetically similar to the earlier marks bearing Nos.3595698

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and 5382808 and that the services are similar, resulting in a likelihood of confusion. No separate comparison of the two cited marks has been undertaken. While the first cited mark is "EXPONENT", the second is "EXPONENTIAL TECHNOLOGIES GROUP", an expression of three words. The impugned order does not explain how the rival marks, considered as a whole, are deceptively similar. As against the first cited mark, the question is, in truth, not one of phonetic similarity at all, the word applied for being identical to the word comprising that mark; and as against the second, the comparison called for is with an expression of three words. A single finding of phonetic similarity covering both citations indicates that the comparison was not in fact undertaken.

16. Similarly, the impugned order does not identify the particular services covered by the appellant's application that allegedly overlap with those of the cited marks. Whether the respective services are similar and whether their use under the rival marks is likely to cause confusion require examination with reference to their actual specifications, all of which were before the Hearing Officer in the Registry's own search report. No such exercise is reflected in the impugned order.

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17. Further, the Registry's search report indicated that Application No.5382808, relating to "EXPONENTIAL TECHNOLOGIES GROUP", was under objection. The impugned order does not discuss the status of the said application or its relevance to the objection under Section 11(1) of the Act, which the Registrar shall verify and address afresh, the status of a cited mark being material to whether it constitutes an earlier trade mark within the meaning of the Explanation to Section 11 of the Act.

18. Though the appellant had filed a reply to the Examination Report, an affidavit of use and written submissions, besides participating in several hearings, the impugned order merely records that the appellant's authorised agent appeared and advanced arguments. It neither identifies the submissions made nor discusses the documentary evidence relied upon. Brevity by itself does not invalidate an order; however, the reasons must disclose the basis of the decision. The impugned order, therefore, fails to satisfy the requirement under Section 18(5) of the Act.

19. There is a further and more fundamental infirmity. Section 11(1) of the Act opens with the words "Save as provided in section 12". Section 12 is

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therefore not a matter which the Registrar is at liberty to consider or to pass over; it is an exception written into the opening words of the very provision under which this application was refused. Section 12 reads as follows:

> *"In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose."*

The appellant invoked Section 12 in its reply dated 28.09.2022 and again in its written submissions dated 07.06.2024. The impugned order does not refer to Section 12 at all. A refusal under Section 11(1) which leaves wholly undecided the exception that the sub-section itself saves is incomplete on the face of the statute. It is also to be noticed that the opinion contemplated by Section 12 is, in terms, the opinion of the Registrar.

20. The appellant had also sought consideration under Sections 12, 18(4) and 20 of the Act. The proviso to Section 20 enables advertisement before acceptance in circumstances contemplated under that provision, and extends in terms to a trade mark to which sub-sections (1) and (2) of Section 11 apply, that

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is to say, to the very situation obtaining here. As was observed in the course of the hearing, where the objection is a relative one and the proprietors of the cited marks are not before the Registrar, advertisement before acceptance is a course deserving of consideration, since it enables those said to be prejudiced to come forward and oppose the registration if they are in truth aggrieved. The appellant had further offered to restrict its specification of services under Section 18(4) to remove the alleged overlap with the cited marks. These requests have not been considered in the impugned order. Though the Registrar is not bound to accept them, they ought to have been examined and decided by recording reasons.

21. However, the appellant's reliance on Section 16(1) of the Act is misconceived. The said provision deals with registration of associated trade marks and does not confer an automatic right to registration merely because the applicant holds other registrations. Association under that provision regulates the consequences of registration, principally in relation to assignment and transmission, so that marks resembling one another in the hands of the same proprietor do not pass into different hands. It is not a gateway to registration, and it cannot answer an objection founded upon the rights of a different proprietor. Likewise, the appellant's existing Class 42 registrations bearing Nos.5545839 and 5545844 do not, by themselves, establish its entitlement to

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registration of the present word mark. Those two marks are, moreover, composite marks comprising the words "epack" and "epump" with the addition "by exponent", and not the word "EXPONENT" standing by itself. Each application must be examined independently on its own merits.

22. Insofar as the appellant's request for direct acceptance and advertisement is concerned, the power to accept, conditionally accept or refuse an application under Section 18(4) of the Act is vested in the Registrar. Though the impugned order suffers from legal infirmity, this Court is not inclined to direct acceptance of the application, as the similarity of the marks, the nature of services and the likelihood of confusion require examination on merits. It is relevant in this connection to notice that the word applied for is identical to the word comprising the first cited mark, and that the specification applied for, namely "Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; Vehicle design services", is widely drawn. A trade mark is registered for the specification applied for and not for the business as it happens to be carried on; the appellant's present concentration upon electric vehicle batteries and charging equipment does not, of itself, confine the broader specification which it has sought. The objection under Section 11(1) cannot therefore be said to be

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untenable on the face of it, and it would not be appropriate for this Court to direct acceptance.

23. The appellant's evidence of use also requires consideration. Though use is claimed from 08.04.2021, the earliest invoice relied upon, dated 08.04.2021, relates to the supply of machined components, being Tax Invoice No.0041/2021-22 of M/s. BR Hi Tech CNC, Hosur, wherein the appellant is shown as the bill-to and ship-to party. It is therefore an invoice raised upon the appellant in respect of its own inward purchases, and not an invoice raised by the appellant for any service rendered by it. Whether the materials establish use of the mark in relation to the services for which registration is sought, as distinguished from goods or other business activities, is a matter for the Registrar to examine.

24. It may be said that a remand would serve no useful purpose, the whole of the material being already on record. The principle that an appellate forum ought not to remand a matter as a matter of course, and should decide finally where the record permits it to do so, is well settled. That principle has, however, no application here. It presupposes a decision below which the appellate forum

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can examine and test. In the present case no opinion was formed under Section 12 at all, no ruling was given upon the proviso to Section 20, and the documentary evidence of user was never appraised. The remand now directed is not for the purpose of obtaining a fuller statement of reasons upon matters already decided; it is to have statutory discretions exercised, for the first time, by the authority in whom the Act has vested them. Further, the appellant's offer to restrict its specification remains unsupported by any proposed wording on record, and that offer cannot be evaluated, whether by this Court or by the Registrar, until such wording is placed on file.

25. Thus, this Court finds that the impugned order is liable to be set aside for failure to record adequate reasons and consider the appellant's statutory requests. However, since the merits of the application require examination by the Registrar, the appropriate course is to remit the matter for fresh consideration after affording an opportunity of hearing to the appellant.

26. In the result, the impugned order dated 25.07.2025 is set aside. The matter is remanded to the Registrar of Trade Marks, Chennai, for fresh consideration after affording an opportunity of hearing to the appellant, on not

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less than two weeks' notice to its address for service. The appellant may, before such hearing, file the exact wording of the restricted list of services on which it wishes to rely. The Registrar shall deal with each of the two cited marks separately; shall compare the rival marks and the respective lists of services; shall verify the present status of the cited marks; shall consider the documents filed to prove use; and shall decide, by express findings and with reasons, the appellant's requests under Section 12, Section 18(4) and the proviso to Section 20 of the Act. The order shall be passed within three months from the date of the first hearing. All questions on merits are left open, and the observations in the foregoing paragraphs shall not bind the Registrar. C.M.A.(T.M.) No.5 of 2026 is accordingly disposed of, and consequently, C.M.P.No.1615 of 2026 is closed. There shall be no order as to costs.

15-10-2026

AY

Speaking Order / Non-speaking Order
Index: Yes /No
Neutral Citation: Yes / No

To

The Registrar of Trademarks,
Trademarks Registry,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai -600 032, Tamil Nadu.

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DR.A.D.MARIA CLETE, J

AY

PRE-DELIVERY ORDER MADE IN
C.M.A. (T.M.) No. 5 of 2026
and
C.M.P. No. 1615 of 2026

15-10-2026

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