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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 08.09.2026

PRONOUNCED ON : 15.10.2026

CORAM

THE HON'BLE DR.JUSTICE A.D.MARIA CLETE

CMA(TM) No. 4 of 2025

INEXO Cast Metal Solutions Pvt Ltd
Plot No.107, (Old no.166),
SIDCO Industrial Estate,
Ambattur, Chennai - 600 098.

..Petitioner(s)

Vs

1. Federal Express Corporation
   3620 Hacks Cross Road, Building B,
   3rd Floor, Memphis,
   Tennessee 38125, U.S.A.

2. Assistant Registrar of Trademark and GI
   Office of the Trade Mark Registry,
   Guindy, Chennai - 600 032.

..Respondent(s)

PRAYER - Appeal filed under Section 91 of the Trade Marks Act, 1999, to set aside the impugned order dated 21.10.2024 passed by the Respondent, refusing the registration of the trademark under No.1888861 in Class I and consequently direct the respondent to allow the mark to be registered and thereby render justice.

For Petitioner(s):	Mr.R.Sathish Kumar
For R1:	Ms. Elizabeth Seshadri
For R2:	Mr. S. Nelson (Central Govt. Standing Counsel)

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JUDGMENT

This Civil Miscellaneous Appeal has been preferred under Section 91 of the Trade Marks Act, 1999 (hereinafter referred to as "the Act"), challenging the order dated 21.10.2024 passed by the second respondent, the Assistant Registrar of Trade Marks, Chennai, allowing Opposition No.800164 filed by the first respondent and consequently refusing registration of the appellant's trade mark "FEDEXO" under Application No.1888861 in Class 1.

2. The appellant is engaged in the manufacture and sale of foundry materials, including exothermic sleeves, insulating sleeves, direct pour sleeves and coating agents. On 26.11.2009, it filed an application in Form TM-1 for registration of the word mark "FEDEXO" in Class 1 in respect of chemical products used in the foundry industry, foundry binding substances, moulding preparations and casting binders, claiming continuous use since 05.09.2007.

3. In the examination report dated 20.09.2010 the registry raised an objection under Section 11 of the Trade Marks Act, 1999, citing only the mark "FEDEX500" (Application No.896439 in Class 1) registered in the name of Advanced Biochemicals Limited for enzymes. In its reply dated 10.10.2010, the appellant contended that the cited mark was different and had not been renewed,

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reiterated its continuous and extensive use of FEDEXO since 05.09.2007, and relied upon its Director's affidavit of December 2009 claiming honest adoption in 2007 and furnishing sales figures from that date. On 20.11.2012, the Registry directed advertisement before acceptance under the proviso to Section 20(1), and the application was advertised in Trade Marks Journal No.1565 dated 03.12.2012.

4. The first respondent filed its notice of opposition dated 06.03.2013 on 14.03.2013, asserting use of the mark “FEDEX” in India since 1984 and ownership of registrations dated 06.08.1986 under Nos.458159 and 458162 in Classes 16 and 12 respectively, besides subsequent registrations in Classes 16 and 39. Claiming FEDEX to be a well-known trade mark under Sections 2(1)(zg), 11(6) and 11(7), it contended that FEDEXO was merely FEDEX with the addition of the letter “O”, that the appellant's claimed use was false, and that registration would take unfair advantage of and be detrimental to the distinctive character and reputation of FEDEX, attracting Section 11(2). It also invoked Sections 9(1)(a), 9(2)(a), 11(3)(a), 11(4), 11(10), 12, 18(1), 18(4), 28 and 29 of the Act.

5. In its counter statement dated 19.07.2013, the appellant maintained that FEDEXO was honestly adopted in 2007 and continuously used since

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05.09.2007. It disputed the well-known status of FEDEX, contended that the first respondent's rights were confined to its registered goods and services, and pointed out that none of the first respondent's marks had been cited in the examination report. It explained that FEDEXO was coined by combining the prefix “FED” with “EXO”, derived from its trading style “INEXO”. Claiming six years of honest concurrent use without confusion, it sought registration under Sections 12 and 18(1).

6. In support of the opposition, the first respondent filed the affidavit of Mr.Lester A. Bishop in December 2013, along with Annexures A to O, tracing its business from 1973 and use of FEDEX since 1984, including in India. The documents comprised Indian and foreign registrations, annual reports, website extracts from www.fedex.com and www.fedex.in, created in 1991 and 2005 respectively, advertising and sponsorship materials, and foreign decisions protecting FEDEX. The affidavit disclosed worldwide revenue of US$35.5 billion in 2009. It further stated that the first respondent had initiated rectification proceedings against FEDEX500 (No.896439 in Class 1), resulting in its removal from the Register.

7. The appellant, in turn, filed the affidavit, dated 20.02.2014, with Exhibits A to F. Significantly, in paragraphs 4 and 5, he admitted that the appellant had

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originally adopted and used the mark “FEDEX” in 2007 for foundry chemicals, deriving “FED” from feeder materials and “EX” from exothermic sleeves. He further stated that, following an objection dated 04.11.2009 from M/s. Foseco International Limited, proprietor of the registered mark “FEEDEX” in Class 1, the appellant agreed to change FEDEX to FEDEXO by incorporating “EXO” from its trading style INEXO CAST METAL SOLUTIONS PVT. LTD. The change was communicated on 28.11.2009 and accepted by Foseco on 21.12.2009; He also attributed the mark to the appellant's other marks INEXO, FEDIN, FEDPAD and FEDPOUR, claiming extensive marketing under FEDEXO since 2007.

8. The correspondence produced as Exhibits C, E and F establishes that Foseco, by letter dated 04.11.2009, asserted its registration of “FEEDEX” under No.155812 dated 07.10.1952 in Class 1 and objected to the appellant's sale of exothermic sleeves under “FedEx 55 (XP)” and “FedEx 55”, while referring to its earlier use of “INEXO”. In its reply dated 28.11.2009, the appellant, tracing its business to the partnership firm INEXO FEED INDUSTRIES constituted on 21.08.1989, explained that “FED” was derived from feeder materials and “EX” from exothermic sleeves. While asserting independent rights in FEDEX, it undertook, without prejudice, to amend the mark to FEDEXO and discontinue FEDEX for foundry consumables within 180 days. A revised trademark sheet

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bearing FEDEXO was enclosed. Foseco accepted this undertaking by letter dated 21.12.2009.

9. The appellant also produced a Chartered Accountant's certificate attributing turnover to FEDEXO from Rs.9,58,83,146 in 2007–08 to Rs.17,35,82,623 in 2012–13. However, the invoices up to March 2010 described the products as “FEDEX 55” or “FEDEX 50”, and not FEDEXO. The invoice dated 24.05.2008 showed FEDEX 55 alongside FEDIN 59 and INEXO ZIRCOAT 212, while the invoice dated 05.11.2009, issued immediately after Foseco's objection, continued to bear FEDEX 55. The earliest invoice containing FEDEXO was dated 13.05.2010, which listed both “FEDEX 55” and “FEDEXO 55”. In its reply evidence of April 2014, the first respondent pointed out that the earliest FEDEX invoice was dated 31.10.2007, whereas FEDEXO appeared only in May 2010, and questioned the correctness of the Chartered Accountant's certificate attributing turnover to FEDEXO from 2007.

10. The opposition was heard on 10.07.2024. The first respondent filed written submissions dated 25.07.2024, and the appellant filed its submissions on 26.07.2024, reiterating honest adoption and use of FEDEXO since 05.09.2007, describing it as a combination of its trading style and other marks, and relying upon the judgment of **Nandhini Deluxe v. Karnataka Co-operative Milk**

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Producers Federation Ltd. ***reported in*** **(2018) 9 SCC 183** and Section 12 of the Act.

11. After considering the application for registration, the notice of opposition, the counter statement, the affidavits and documentary evidence filed by both parties, and the oral and written submissions of the respective counsel, the second respondent, Assistant Registrar of Trade Marks, passed the impugned order dated 21.10.2024. As regards the appellant's claim of continuous use of FEDEXO since 05.09.2007, the Assistant Registrar relied upon the appellant's reply, referred to in the order as dated 28.11.2011, wherein the appellant had stated that, without prejudice to its rights, it had modified the mark "FEDEX" to "FEDEXO" to conduct its business peacefully. On that basis, the Assistant Registrar held that the appellant could not claim use of FEDEXO from 05.09.2007. He further noted that FEDEX was included in the Registry's list of well-known trade marks and, observed that use of a well-known mark even in relation to dissimilar goods could damage its reputation. Accordingly, holding that FEDEXO was deceptively similar to the well-known mark FEDEX, the Assistant Registrar allowed Opposition No.800164, refused registration of the appellant's mark under Application No.1888861 in Class 1, and directed the parties to bear their respective costs.

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12. Aggrieved by the impugned order, the appellant has preferred the present appeal contending that the marks FEDEX and FEDEXO are phonetically, visually and commercially distinct, and that FEDEXO must be considered as a whole. It is submitted that the appellant manufactures specialised foundry materials, whereas the first respondent provides transport services, and that there is no similarity in the goods, consumers or trade channels. The appellant further contends that the Assistant Registrar erred in relying solely upon the inclusion of FEDEX in the list of well-known trade marks, without examining whether its reputation extended to the appellant's industrial market or whether the cumulative requirements of Section 11(2) of the Act were satisfied. According to the appellant, FEDEX was independently coined in 2007 and subsequently modified in good faith to FEDEXO in 2009. It is further contended that there has been no instance of confusion or infringement proceedings for over twelve years. Significantly, the appellant states that FEDEXO was adopted in 2009, with the suffix "EXO" derived from "Exothermic Sleeves".

13. The first respondent, in its counter affidavit contends that FEDEX is a prior adopted, used and registered trade mark, recognised as a well-known mark at Serial No.246 of the Registry's list. It is submitted that FEDEXO is deceptively similar to FEDEX, differing only by the addition of the letter "O",

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and that well-known marks enjoy protection across classes under Sections 2(1)(zg), 11(10) and 29(4) of the Act. The first respondent disputes the appellant's claim of use since 2007, pointing out that its own documents establish prior use of FEDEX and subsequent modification to FEDEXO only after Foseco's objection in 2009. It further characterises the explanation that "FED" was derived from "feeder" as an afterthought and contends that proof of actual confusion is unnecessary. Alleging suppression of its evidence and written submissions before the Registry, which it has produced along with the counter affidavit, the first respondent seeks dismissal of the appeal with costs.

14. Learned counsel for the appellant, submitted that the trade mark "FEDEXO" was honestly coined from the expressions "feeder material" and "exothermic sleeves", relating to the appellant's products, and that this explanation had been specifically pleaded before the Registry. The learned counsel contended that the appellant had been using the mark since 2007 and, following an objection raised by Foseco, a third party, in 2009, modified "FEDEX" to "FEDEXO" by adding the letter "O" to carry on its business peacefully. The relevant correspondence and invoices were produced by the appellant itself, and hence there was no suppression of material facts. The learned counsel further submitted that the examination report cited only a mark in Class 1 and not any well-known mark, and that the parties operated in

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entirely different fields, with distinct goods, purchasers and trade channels. It was submitted that the opposition rested principally on Sections 11(8) and 11(10), without establishing the cumulative requirements of Section 11(2) of the Act. The learned counsel contended that FEDEX was recognised as a well-known mark only in February 2024 and that such subsequent recognition could not retrospectively affect the appellant's bona fide adoption in 2007 or 2009. It was further submitted that the impugned order relied solely upon the inclusion of FEDEX in the list of well-known marks, without examining due cause, unfair advantage or detriment, and failed to appreciate the appellant's evidence. The erroneous reference to the letter dated 28.11.2009 as dated 28.11.2011, and its treatment as a reply to the first respondent instead of Foseco, demonstrated non-application of mind. Placing reliance on ***Paragon Polymer Products Pvt. Ltd. v. Sumar Chand Nahar and another reported in 2025 SCC OnLine Mad 3899***, particularly paragraph 15, wherein this Court observed that "No mark is born as a well known mark" and that "for an advantage earned today, credit cannot be given to it yesterday", learned counsel contended that the first respondent could not succeed merely on the basis of the subsequent recognition of FEDEX as a well-known trade mark.

15. Per contra, learned counsel for the first respondent, submitted that a well-known trade mark enjoys protection beyond the goods and classes for which it

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is registered, and that Section 11(2) of the Trade Marks Act, 1999, seeks to prevent dilution of its distinctive character and reputation, irrespective of actual confusion. In support, the learned counsel relied upon ***Daimler Benz Aktiengesellschaft v. Hybo Hindustan reported in 1993 SCC OnLine Del 605; Honda Motors Co. Ltd. v. Charanjit Singh reported in 2002 SCC OnLine Del 1332; Ford Motor Co. v. C.R. Borman reported in 2008 SCC OnLine Del 1211; Sony Kabushiki Kaisha v. Mahaluxmi Textile Mills reported in 2009 SCC OnLine Cal 531; and Haldiram India Pvt. Ltd. v. Berachah Sales Corporation reported in 2024 SCC OnLine Del 2265***. The learned counsel contended that, once FEDEX was recognised as a well-known mark, Sections 11(8) and 11(10) obligated the Registrar to protect it and consider the appellant's bad faith. It was submitted that the well-known status is acquired through reputation and not created by its inclusion in the Registry's list, and Explanation (b) to Section 11 requires consideration of the date of the subsequent application. Reliance was placed on **Lego Juris A/S v. Gurumukh Singh reported in 2024 SCC OnLine Mad 4858**; **Columbia Pictures Industries Inc. v. Registrar of Trade Marks, C.A.(COMM.IPD-TM) No.44 of 2025**; and **Industria de Diseno Textil S.A. v. Registrar of Trade Marks, C.A.(COMM.IPD-TM) No.52 of 2024**, the latter two decided by the Delhi High Court on 06.07.2026.

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16. Learned counsel further submitted that the evidence filed in 2013 established the reputation of FEDEX even before 2009, including Indian registrations dating back to 1986, foreign decisions from 1991 to 2007, Asian consumer awards from 2004 based on surveys covering India, and substantial worldwide revenue. The learned counsel distinguished **Paragon Polymer Products Pvt. Ltd. v. Sumar Chand Nahar** ***reported in*** **2025 SCC OnLine Mad 3899**, on the ground that it concerned a dictionary word, honestly used since 1986 by a proprietor holding its own registration, and did not determine when the rival mark had acquired well-known status. It was submitted that the appellant's own documents established bad faith, since it initially sold products under “INEXO 57”, subsequently adopted “FEDEX 55”, and applied for registration of FEDEXO on 26.11.2009 claiming use since 05.09.2007, although FEDEXO was introduced only through its reply dated 28.11.2009 to Foseco's objection. No invoice disclosed use of FEDEXO before 13.05.2010, while the Chartered Accountant's certificate attributed turnover to FEDEXO for earlier years without supporting invoices. The appellant had also furnished inconsistent explanations for “EXO”, deriving it alternatively from its trading style and “exothermic sleeves”. Of its four marks containing “FED”, only FEDEX reproduced the first respondent's mark in its entirety. The learned counsel emphasised that the statutory requirement was use without due cause, and that mere honesty was insufficient. The judgment of **Nandhini Deluxe v. Karnataka Co-operative Milk Producers Federation Ltd.** ***reported in*** **(2018)**

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9 SCC 183 was also distinguished, as concerning a common word which was not a well-known mark.

17. Learned counsel further contended that the objection regarding the date of recognition of FEDEX as a well-known mark was raised neither before the Registrar nor in the memorandum of appeal, and that the errors concerning the date and addressee of the letter were merely clerical. The learned counsel also submitted that the appellant had failed to produce the first respondent's evidence before this Court. As regards the absence of infringement proceedings, she pointed out that the opposition had remained pending since 2013, constituting an available statutory remedy, and that the appellant continued using the mark at its own risk. The learned counsel accordingly prayed for dismissal of the appeal.

18. No separate submissions were advanced on behalf of the second respondent, whose order is under appeal; However, defended the impugned order.

19. The following points arise for consideration:

(i) Whether the mark “FEDEXO” is identical with or similar to the mark

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"FEDEX".

(ii) Whether "FEDEX" had already become a well-known trade mark in India on 26.11.2009, the date on which the appellant applied for registration, and what effect its inclusion in the Registry's list of well-known marks in February 2024 has upon that question.

(iii) Whether the appellant had due cause to adopt and use "FEDEXO", whether it can claim honest concurrent use under Section 12 of the Act, and whether it acted in bad faith, which Section 11(10)(ii) of the Act requires to be taken into consideration.

(iv) Whether, though the goods and services of the two sides are different, the use of "FEDEXO" would take unfair advantage of, or be detrimental to, the distinctive character or reputation of "FEDEX", so as to attract Section 11(2) of the Act.

(v) Whether the remaining contentions of the parties, namely that no instance of confusion has been shown, that no suit for infringement has been filed, that the first respondent's mark was not cited in the examination report, that the mark "FEDEX500" stood on the Register in Class 1, and the first respondent's reliance on Section 29(4) of the Act, make any difference to the appellant's claim for registration.

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20. It is convenient first to set out the provisions that govern this case. Section 11(2) of the Act deals with a case where the rival marks are similar but the goods or services are not. It provides that such a mark shall not be registered if the earlier mark is a well-known trade mark in India, and if the use of the later mark, without due cause, would take unfair advantage of the earlier mark or would be detrimental to its distinctive character or its repute. These conditions are cumulative. It is therefore not enough to show that the earlier mark is well known. Sections 11(6) and 11(7) set out what is to be looked at in deciding whether a mark is well known, such as the extent to which it is known to the section of the public concerned, the duration and extent of its use and promotion, the registrations it holds and the record of its successful enforcement. Section 11(9) makes it clear that use or registration in India is not a condition for such recognition. Section 11(8) provides that once a mark is determined to be well known in at least one relevant section of the public in India, the Registrar shall take it to be a well-known mark. Section 11(10) requires the Registrar, while dealing with an application and an opposition to it, to protect a well-known mark against identical or similar marks, and to take into consideration bad faith on the part of either side. It is also settled that in an opposition the burden lies upon the applicant to satisfy the Registrar that his mark is entitled to registration.

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21. Coming to the impugned order, two shortcomings in it must be noticed. First, the Assistant Registrar proceeded on the footing that the appellant's letter was dated 28.11.2011 and that it was a reply to a legal notice issued by the first respondent. That letter is in truth dated 28.11.2009, and it was addressed not to the first respondent but to Foseco International Limited, a third party. Secondly, having noticed that FEDEX finds a place in the Registry's list of well-known marks, the Assistant Registrar went straight to his conclusion. He did not examine the evidence placed before him to see whether FEDEX had in fact acquired that reputation, nor did he record any finding on what Section 11(2) further requires, namely whether the use of FEDEXO would be without due cause, and whether it would take unfair advantage of FEDEX or be detrimental to its distinctive character or repute. These shortcomings, however, do not by themselves entitle the appellant to registration. The evidence is wholly documentary and is on record, and both sides have been heard at length. This Court has therefore gone into the entire record itself and has considered on their merits the points set out above.

Point No.(i):

22. The appellant contends that FEDEXO is phonetically and visually distinct from FEDEX and that the marks must be considered as a whole.

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However, FEDEXO incorporates the earlier registered mark FEDEX in its entirety, with the mere addition of the letter "O". The similarity between the word marks is apparent and requires no elaborate phonetic analysis. Significantly, the appellant's Managing Director himself described the modification as an "insignificant change". Applying the principles laid down in **Amritdhara Pharmacy v. Satya Deo Gupta** ***reported in*** **AIR 1963 SC 449**, the marks, when considered as a whole from the standpoint of a purchaser of average intelligence and imperfect recollection, are substantially similar. The additional letter does not sufficiently distinguish FEDEXO from FEDEX. Accordingly, Point No.(i) is answered against the appellant.

Point No.(ii):

23. The appellant's principal contention is that FEDEX was recognised as a well-known trade mark only in February 2024, whereas its application was filed on 26.11.2009. However, the date of formal recognition does not necessarily determine when a mark acquired the requisite reputation. Explanation (b) to Section 11 requires consideration of whether the earlier mark was entitled to protection as a well-known mark on the relevant date. In **Lego Juris A/S v. Gurumukh Singh** ***reported in*** **2024 SCC OnLine Mad 4858**, this Court distinguished between the prospective operation of a formal declaration and the earlier acquisition of reputation established by evidence. Similarly, **Paragon Polymer Products Pvt. Ltd. v. Sumar Chand Nahar** ***reported in*** **2025 SCC**

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OnLine Mad 3899, holds that subsequent recognition cannot retrospectively defeat the rights of an honest prior user. Thus, the material question is whether FEDEX had acquired the requisite reputation when the appellant applied for registration.

24. The first respondent's evidence establishes use of FEDEX internationally and in India since 1984, Indian registrations dating back to 1986, extensive advertising and promotion, recognition through the Reader's Digest Asia Trusted Brands awards from 2004 based on surveys including India, substantial worldwide turnover, and protection through decisions of foreign authorities between 1991 and 2007. These materials, considered in the light of Sections 11(6), 11(7) and 11(9), sufficiently establish that FEDEX had acquired the character of a well-known trade mark in India even before 26.11.2009. Its subsequent inclusion at Serial No.246 of the Registry's list in February 2024 records that status and is not the sole foundation for the present finding. Further, when the opposition was decided in October 2024, Sections 11(8) and 11(10) required the Registrar to recognise and protect the mark as well known. This does not involve giving retrospective effect to the declaration. The decision in Paragon Polymer is distinguishable, since honest prior use of FEDEXO has not been established in the present case. Accordingly, Point No.(ii) is answered in favour of the first respondent.

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Point No.(iii):

25. The appellant contends that FEDEXO was honestly coined from "feeder materials" and "exothermic sleeves" and that its adoption was independent of the first respondent's mark. The materials disclose that the appellant had used other marks containing the prefix "FED", including FEDIN, FEDPAD and FEDPOUR, in connection with its foundry products. However, its own documents establish that it initially used "FEDEX" and modified the mark to "FEDEXO" only after receiving Foseco's objection dated 04.11.2009. The reply dated 28.11.2009 expressly records the modification. The explanation for "EXO" is also inconsistent, having been attributed alternatively to the appellant's trading style INEXO and to exothermic sleeves. The explanation offered for adopting FEDEX does not satisfactorily establish due cause for retaining that mark in its entirety with the addition of a single letter.

26. More significantly, the appellant claimed continuous use of FEDEXO from 05.09.2007 in its application dated 26.11.2009, although the correspondence establishes that FEDEXO was introduced only in November 2009. The invoices up to March 2010 describe the products as "FEDEX 55" or "FEDEX 50", and the earliest invoice mentioning FEDEXO is dated 13.05.2010. Nevertheless, the appellant repeated its claim of use since 2007 in its affidavits, counter statement, written submissions and Chartered Accountant's certificate, which attributed turnover to FEDEXO even for earlier

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years. These discrepancies remain unexplained. The admission in paragraph 7 of the memorandum of appeal that FEDEXO was adopted in 2009 further contradicts the original claim. Such material misstatements concerning the date of adoption and use, made despite knowledge of the relevant facts, constitute circumstances indicative of bad faith under Section 11(10)(ii).

27. The appellant has neither established use of FEDEXO since 2007 nor satisfactorily explained its adoption. Consequently, the plea of honest concurrent use under Section 12 and the claim of due cause cannot be sustained. Accordingly, Point No.(iii) is answered.

Point No.(iv):

28. The appellant's application in Class 1 covers chemical products used in the foundry industry, foundry binding substances, moulding preparations and casting binders, whereas the first respondent's registrations include goods in Classes 12 and 16 and services in Class 39, principally associated with transport and courier operations. The respective goods and services are therefore dissimilar, and the parties operate in different commercial fields. However, the appellant's present concentration on specialised foundry materials does not, by itself, restrict the broader specification for which registration has been sought. The comparison must be made with reference to the goods and services covered by the respective applications and registrations, and not merely the nature of the

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parties' existing business activities. Such dissimilarity, far from excluding Section 11(2), is a circumstance expressly contemplated by that provision, which extends protection to well-known marks beyond their registered goods or services.

29. The further question is whether use of FEDEXO without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of FEDEX. Although the respective goods and services are different, the later mark substantially incorporates the distinctive and well-known mark FEDEX. Having regard to the reputation acquired by FEDEX, the circumstances surrounding the appellant's adoption of FEDEXO, and the absence of a satisfactory explanation constituting due cause, its use would derive an unfair advantage from the reputation of the earlier mark and weaken its distinctive association with the first respondent. The fact that the appellant's products are purchased by specialised industrial consumers through different trade channels does not, by itself, exclude such unfair advantage or detriment. Accordingly, the requirements of Section 11(2) stand satisfied, and Point No. (iv) is answered against the appellant.

Point No.(v):

30. The appellant's contention that no instance of actual confusion has been established and that no infringement proceedings have been initiated for several

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years is equally untenable. Proof of actual confusion is not indispensable even where likelihood of confusion is the relevant statutory test. More importantly, under Section 11(2), actual confusion or likelihood thereof is not an essential requirement; the provision independently protects well-known marks against unfair advantage and detriment to their distinctive character or reputation. The first respondent had initiated opposition proceedings in 2013, and its failure to institute a separate infringement suit does not confer any right upon the appellant to secure registration. Further, the omission of FEDEX from the examination report does not preclude the first respondent from opposing registration under Section 11(5). The cited mark FEDEX500, stated to have been removed from the Register, does not advance the appellant's case.

31. The reliance placed on Section 29(4), relating to infringement, does not directly arise in this appeal concerning registration. Likewise, objections not forming part of the original notice of opposition need not be adjudicated. In view of the findings already recorded, none of the remaining contentions warrants interference with the refusal of registration. Point No.(v) is answered accordingly.

32. In view of the foregoing discussion, this Court finds that, notwithstanding the factual errors and inadequacy of reasoning in the impugned order, the refusal of registration is sustainable on the materials available.

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FEDEXO is similar to FEDEX, which had acquired the status of a well-known trade mark in India before the appellant's application. The appellant has failed to establish due cause or honest concurrent use, and the circumstances disclose that registration and use of FEDEXO would take unfair advantage of, and be detrimental to, the distinctive character of FEDEX within the meaning of Section 11(2). The appellant's incorrect representations concerning the date of adoption and use are also relevant under Section 11(10)(ii). Accordingly, no ground is made out to interfere with the refusal of registration.

33. In the result, the Civil Miscellaneous Appeal is **dismissed**, confirming the order dated 21.10.2024 passed by the second respondent in Opposition No.800164, refusing registration of the trade mark "FEDEXO" under Application No.1888861 in Class 1, for the reasons stated in this judgment. The erroneous reference in the impugned order to the letter dated 28.11.2011 shall be read as referring to the appellant's letter dated 28.11.2009 addressed to Foseco International Limited. The findings herein are confined to the appellant's entitlement to registration and shall not determine any independent question of infringement or passing off. There shall be no order as to costs.

15-10-2026

Index: Yes/No
Speaking/Non-speaking order
Neutral Citation: Yes/No
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DR.A.D.MARIA CLETE J.

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To

1. Federal Express Corporation
   3620 Hacks Cross Road, Building B,
   3rd Floor, Memphis,
   Tennessee 38125, U.S.A.

2. Assistant Registrar of Trademark and GI
   Office of the Trade Mark Registry,
   Guindy, Chennai - 600 032.

PRE-DELIVERY JUDGMENT IN

CMA(TM) No. 4 of 2025

15-10-2026

https://www.mhc.tn.gov.in/judis (Uploaded on: 15/10/2026 07:38:00 pm)