

“HOLIDAY INN EXPRESS” and Related Marks Have Been Recognized as Well-Known Marks in Nepal

On July 10, 2023, the Department of Industry (“DOI”), which acts as the intellectual property office in Nepal, handed down a decision in favor of the opposition filed by Six Continents Hotels Inc. (“Six Continents”), registered in the United States of America, recognizing its “**HOLIDAY INN EXPRESS (word)**”, “**HOLIDAY INN EXPRESS (words with H logo)**”, “**HOLIDAY INN (words with H logo)**”, and “**H (logo)**” (collectively “HOLIDAY INN marks”) to be well-known marks in Nepal and further ruled that HOLIDAY INN marks shouldn’t be registered in other’s name who seeks to register these marks in bad faith. The written text of the decision has been released recently.

Six Continents is the parent company of InterContinental Hotels Group and owns the HOLIDAY INN marks in Nepal in class 43. Holiday Express Travels and Tours Pvt. Ltd. (“Holiday Express Nepal”), a company incorporated in Nepal, filed an application at the DOI seeking to register “**HOLIDAY EXPRESS TRAVELS AND TOURS (and logo)**” mark in class 35. Six Continents opposed Holiday Express Nepal’s application claiming that HOLIDAY INN marks are well-known marks globally as well as in Nepal and the registration of the proposed mark, in bad faith, will lead to confusion among the public.

Accepting Six Continents’ claims and rejecting Holiday Express Nepal’s application for registration of “**HOLIDAY EXPRESS TRAVELS AND TOURS (and logo)**” mark, the DOI made following determination:

- HOLIDAY INN marks have been registered and are used by Six Continents in Nepal and other countries and thus are well-known marks belonging to Six Continents.
- Holiday Express Nepal’s proposed mark does not seem to be its original creation and the application has been made in bad faith, seeking registration of the proposed mark deceptively.
- Allowing registration of “**HOLIDAY EXPRESS TRAVELS AND TOURS (and logo)**” mark to Holiday Express Nepal shall adversely affect the goodwill of Six Continents and therefore shall cause confusion among consumers.

The DOI, in reaching the above-mentioned conclusions, relied on the landmark ruling of the Supreme Court in *Kansai Nerolac Paints Limited v. Rukmani Chemical Industries Pvt. Ltd.* (N.K.P. 2077, 1621) that an application which is brought in bad faith should be rejected at the inception and even if it is filed, should be dismissed afterwards reciting Article 6^{bis}(3) of the Paris Convention for the Protection of Industrial Property.

Through the decision, the DOI has reiterated its established position that a well-known mark shall receive protection not only in the class in which it has been registered but also in other classes as well as in non-competing goods and services where the well-known mark does not have registration.

Six Continents was represented by Pradhan & Associates at the DOI.

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