

## VIRGIN Has Been Recognized as a Well-Known Mark in Nepal

On June 12, 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 Virgin Enterprises Limited (“Virgin”), a member company of the Virgin Group, registered in England and Wales recognizing its “VIRGIN” mark to be a well-known mark in Nepal and further ruled that the “VIRGIN” mark shouldn’t be registered in other’s name who seeks to register the mark in bad faith. The written text of the decision has been released recently.

Virgin had registered “VIRGIN” mark in Nepal in class 9 and 38. Virgin Mobile Pvt. Ltd. (“Virgin Mobile”), a company incorporated in Nepal filed an application at the DOI seeking to register “VIRGIN (and logo)” mark in class 35. Virgin opposed Virgin Mobile’s application claiming that its trademark “VIRGIN” is a well-known mark globally as well as in Nepal and the registration of the “VIRGIN (and logo)” mark as requested by Virgin Mobile in bad faith will lead to confusion among the public.

Accepting Virgin’s claims and rejecting Virgin Mobile’s application for registration of “VIRGIN (and logo)” mark, the DOI made following determination:

- “VIRGIN” mark has been registered and used by Virgin in Nepal and other countries and thus is a well-known mark which belongs to Virgin.

- The mark in question, “VIRGIN (and logo)” doesn’t seem to be original creation of Virgin Mobile.
- Virgin Mobile filed the application in bad faith seeking registration of “VIRGIN (and logo)” mark deceptively.
- Allowing registration of “VIRGIN (and logo)” mark to Virgin Mobile shall adversely affect the goodwill of Virgin 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 registered, should be dismissed afterwards reciting Article 6<sup>bis</sup>(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.

Virgin was represented by Pradhan & Associates at the DOI.

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