APAA 2026, Hong Kong

Trademarks Committee – Special Topic

Challenges in Protecting Well-Known Marks Across Jurisdictions

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I. Background of Discussion

With the advancement of a borderless society, we have entered an era in which goods, people, and services circulate seamlessly across national borders. In this environment, establishing robust mechanisms for protecting well-known trademarks within the Asia-Oceania region has become a critical priority. We will discuss with members from 21 jurisdictions how to address the legal and practical challenges involved in protecting trademarks that enjoy significant recognition in their home countries but have not yet established a sufficient reputation in destination countries.

The rapid spread of information through social media has dramatically accelerated the recognition of product and service labels, making it impossible for trademark registration to keep pace. Furthermore, registering trademarks in every country and region where the information spreads is simply not feasible. On the other hand, businesses cannot allow unrelated third parties to freely use the brand names of businesses they have cultivated domestically. This paper examines how to address these issues at present.

II. Questions

Please answer the questions below. You can either check the box using ✓ or insert your answers in blue.

Part A: General Overview of the Concept and Framework of "Well-Known Marks"

Section 1: Definition

1. Does your country have a definition of a well-known trademark? If yes, please write it down below along with the legal provisions.

	Yes
✓	No – The status of a well-known trade mark is with regard to its use and consequent reputation in Australia, with spillover use from overseas affecting the reputation of the trade mark in the Australian market. However, within that framework, the Act and its explanatory resources provide pointers as to what may be considered "well-known".

Definition of well-known mark (* Word limit: 100 words or less, if possible):
No express definition, but following the TRIPS Agreement[1], well-known registered trade marks are recognized in sub-section (ss.) 120(3) of the Trade Marks Act ("the Act")[2]. Ss. 120(4) provides guidance on how to decide if a trade mark is well known in Australia. It takes into account the extent to which the trade mark is known within (not the public at large but) the relevant sector of the public. According to WIPO[3], consideration of the relevant sector might include:

i. the actual or potential consumers of the goods or service;
ii. trade channels; and
iii. the interaction and overlap between different industries, e.g. travel, fashion and entertainment.

Note: Section 60 provides for opposition based on the reputation of a preceding trade mark the use of which would likely lead to deception or confusion.

[1] Agreement on Trade-Related Aspects of Intellectual Property Rights

[2] Australian Trade Marks Act 1995

[3] World Intellectual Property Organisation, Geneva, *Joint Recommendation Concerning Provisions on the Protection of Well Known Marks* (2000).

2. Are there any laws or standards, other than trademark law, concerning the recognition of well-known trademarks?

✓	Competition and Consumer Act 2010 (Cth) and its Schedule 2 the Australian Consumer Law (ACL) - the owner of a well-known mark can sue for a breach of Section 18 re misleading and deceptive conduct, but entirely based on reputation in Australia
	Decisions of the Trial and Appeal Department of the Intellectual Property Office
✓	Court Decisions - Taylor v Killer Queen LLC [190 IPR268} ("The Katy Perry case" reputation in specific market sector (e.g. entertainment) may not overlap with registered goods (e.g. clothing)
	Doctrines adopted by the courts

3. In what types of procedures or situations is well-known status recognized?

	Examination of applications
	Oppositions
	Non-use cancellation trials
	Invalidation trials
✓	Infringement litigation
✓	Is there a specific system under which an applicant can formally apply for well-known status, or where a court or statutory authority can *suo motu* declare a mark as well-known? If the answer is yes, please identify the name of such specific system below: (e.g., Defensive mark registration) Comments: Australian Trade Marks Act 1995 Section 185 provides for a defensive registration of a trade mark in respect of a second group of goods and/or services that the owner does not use IF, due to the extent of use on a first group of registered goods or services, it is likely that its use on second group would be likely to be taken to indicate a connection between the registered owner and the second group.

Section 2: Assessment on Well-Known Trademarks

Please provide the factors considered when recognizing a well-known trademark
(To answer the questions below, please do not strictly consider the different levels of well-known status applied. If your answers differ depending on the distinct levels of recognition in your jurisdiction, please base your responses on the lowest level that can be recognized. For instance, in some jurisdictions, a mark may be recognized as well-known even if its reputation is limited to a specific region of a foreign country.)

1. Is the identity between the trademark claimed to be well known and the trademark actually used strictly examined?

✓	Yes the allegedly infringing trade mark must be substantially identical with, or deceptively similar to, the registered trade mark
	No

2. Is whether a trademark is well known determined in relation to the goods or services for which the trademark is used?

	Yes
✓	Not necessarily – if the interests of the registered owner would be adversely affected by infringing use on unrelated goods or services (not of the same description as the same species or not closely related to the other species). However, one must take into account the extent to which the trade mark is known within the relevant sector of the public.

3. In which country or region must a trademark be well known in order to be protected as a well-known trademark?

✓	It must be well-known in that target jurisdiction (your country)
	It is sufficient to be well-known ONLY in the brand owner's home country, while not in the target jurisdiction
	It is sufficient to be well-known ONLY in any third country

4. Regarding the geographical scope, is a trademark eligible for protection (during prosecution or enforcement) as a well-known trademark if it is recognized as below? Please check all that apply.

✓	Nationwide across the jurisdiction? Definitely
✓	Only regionally (in a specific region or more where the goods/services are provided)? Conceivably, where the trade mark's reputation meant its unauthorised use in the region indicated a connection to the registered owner.
✓	Via the Internet, even if it is not necessarily known nationwide? Conceivably, where the trade mark's reputation meant its use by an unauthorised third party on the internet erroneously indicated a connection to the registered owner.

5. Regarding the relevant consumers required for well-known status, is it sufficient for protection if the trademark is recognized by: (Please select one or check all that apply)

✓	All consumers (the general public)? It is not necessary that the trade mark be known by all consumers
✓	Only the relevant consumers of the specific goods or services? Sub-section 120(4) provides)? Ss. 120(4) only requires that the relevant sector of the public know the trade mark
	Only the relevant consumers, even if the goods or services are provided exclusively via the Internet? Yes, if the customer demographic which qualifies as the relevant sector uses the internet.

6. What factors are considered in order for a trademark to be recognized as a well-known trademark?
Ss. 41(3)-(4) (capable of distinguishing), s. 60 (acquired a reputation and likely to deceive or cause confusion), ss120(4) (extent well-known by relevant sector)

✓	Period of use
✓	Area of use
✓	Sales amount
✓	Advertising and promotional expenses
	Person or entity that conducted the advertising and promotion – it may not be rot relevant as to who expended the marketing dollars as such use is on behalf of the owner
✓	Relevant consumers - Ss. 120(4) – relevant sector of the public
✓	Market share
✓	Number of stores Assuming this affects extent that TM is well known
✓	Awards received
✓	Number of posts on social media by third parties Assuming this affects extent that TM is well known
✓	Results of recognition surveys conducted through questionnaires
✓	Number of visits to the website of the holder of the well-known trademark Assuming this affects extent that TM is well-known

7. In proving that a foreign trademark is well known among consumers in your country, are the following matters useful?

✓	Possibility of access and access records to the website of the overseas trademark holder or user Only if properly presented in evidentiary form
✓	Access records to cross-border e-commerce sites Ditto
✓	Purchase records from cross-border e-commerce sites Ditto
✓	Number of inbound travelers (ss. 120) If travellers belong to the relevant sector of the public. S60 if relevant to trade mark's acquired reputation
	Number of travelers from your country to the country where the well-known trademark exists Yes, if we assume that they return with newfound knowledge of the trade mark

8. In recognizing the well-known status of a trademark, is use on the following tools or platforms considered as evidence? Yes, all of these may be used to build the case that the trade mark is known to the relevant sector

✓	SNS platforms (Instagram, TikTok, YouTube, X, etc.)
✓	Online advertising
✓	Posts by third-party influencers who are not users of the trademark for which well-known status is claimed

9. Please describe any evidence or factors, other than those specified in Questions 6 through 8 above, useful in demonstrating that a trademark is well-known abroad, despite not being well-known in your jurisdiction, nonetheless possesses a certain degree of recognition in your jurisdiction.

(* Word limit: 100 words or less, if possible):
Any evidence that indicates acquired reputation through spillover, such as international and industry magazines and publications, whether online or physical, that create a connection between the registered owner and the unrelated goods or services.

10. Is there a practice of using consumer surveys (questionnaires) when proving well-known status? If yes, what approximate recognition rate is required for a trademark to be recognized as well-known? (approximate percentage or range typically accepted in practice, if any / write "N/A" if determined case-by-case) Survey evidence is permitted, but not well-received. IP Australia and Australian courts have shown a sceptical approach. They tend to favour “judicial common sense” and objective data. Such data includes financial records, including sales figures, marketing spend and social media figures. In any case, surveys must avoid leading questions, sample the correct demographic, and prevent respondent priming or brand contamination.

YES	1) In the case of consumer goods	-- % Not specified
	2) In the case of products for specialized markets (such as aircraft parts)	-- % Not specified
	3) In the case of services	-- % Not specified
NO		

Part B: Protection of "Well-Known Marks" by Preventing or Extinguishing Third Party's Registration

1. Are there any provisions in the Trademark Act under which an unregistered well-known trademark can prevent, invalidate or cancel another party's trademark registration?

✓	Yes 1. Non-use removal action under Section 92; 2. Rectification of the Register under Section 88: (1) on available opposition grounds: (a) Standard examination grounds for objection (s.57): s.41 Lack of distinctiveness; s.42(a) Prohibited/protected signs (s42(a)); s.42(b) Scandalous or contrary to law (s42(b)); s.43 Inherently likely to deceive or cause confusion (s.43); s.44 Substantially identical to, or deceptively similar with (s.44); (b) Specific opposition grounds: s.58 Not the owner; note goods/services must at least be the "same kind of thing" or essentially the same[4] s.58A Earlier continuous use of similar trade mark on similar goods or services compared to existing Section 44 trade mark; s.59 **No intention to use**, authorise or assign (e.g. squatting); s.60 **Prior mark with a reputation** in Australia. s.61 False geographical indication; s.62(b) Acceptance obtained based on evidence or representations that were false in material particulars.[5] s62A **Application made in bad faith** (e.g. hijacking foreign brand) (2) Rectification grounds exclusive to Court proceedings: s.88(2)(b) Fraud or false misrepresentation; s.88(2)(c) Post-registration likely to deceive or cause confusion but note: s.89 Fault cannot lie with owner; 3. s.87 Trade mark becomes generic or is only way to describe expired patented product with reference to ss. 24 & 25.
	No

[4] Glittery Craft Limited v Xiang Chen [2026] ATMO 8 (13 January 2026) para. 17; and Colorado Group Limited v Strandbags Group Pty Limited [2007] FCAFC 184, [89]

[5] Caporaso Pty Ltd v Mercato Centrale Australia Pty Ltd [2024] FCAFC 156

2. If your answer to Question 1 above is YES, what types of a third party's trademark applications/registrations can be prevented from being registered or eliminated? Please select all that apply from the following, and if possible, indicate the relevant legal provisions.

✓	A trademark identical or similar to an unregistered trademark that is well-known in your country, filed or registered for identical or similar designated goods or services - Challenging an Australian application/registration where foreign TM is unregistered but similar and well-known in Australia. Potentially s.88(1), based on: s.58 (not the owner), s.58A (earlier continuous use), s59 (no intention to use), s.60 (Prior mark with reputation in AU), and s.62A (Application made in bad faith). Also, possibly s.88(2)(b) (fraud or misrepresentation), and s88(2)(c) post-registration likely deception or confusion. Note that s.44 ground is not available for an unapplied for/unregistered mark
✓	A trademark likely to cause confusion with a trademark well-known in your country - Challenging an Australian application/registration likely to cause confusion in light of a trade mark that is well-known in Australia. As above
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country - Challenging an Australian application/registration likely to cause confusion in light of a trade mark that is well-known in both countries. May depend on first use in Australia to determine the owner in Australia, for e.g. s.88(1), based on: s.58 (not the owner), s.58A (earlier continuous use), s.60 (Prior mark with reputation in AU). Although less likely if the AU brand is independently established (e.g. Katie Perry case), the following may be options: s.62A (Application made in bad faith), s.88(2)(b) (fraud or misrepresentation) and s88(2)(c) post-registration likely deception or confusion (but note that it cannot be the owner's fault).
✓	A trademark likely to cause confusion with a trademark well-known only in a foreign country – Challenging an Australian application/registration likely to cause confusion in light of a trade mark that is only well-known in a foreign country and not well-known in Australia Relevant are first use ownership and evidence of any spill-over of reputation. Provisions as above, but note, all but ss.62A and ss88(2)(c) require use in Australia.
✓	A trademark filed with an unfair purpose that would harm the interest of the owner of the well-known trademark Challenging an Australian application/registration filed with and unfair purpose. s.88(1), based on: s.58 (not the owner), s.58A (earlier continuous use), s59 (no intention to use), s.60 (Prior mark with reputation in AU), and s.62A (Application made in bad faith). s.88(2)(b) (fraud or misrepresentation), and s88(2)(c) post-registration likely deception or confusion.
✓	A trademark filed in bad faith Ditto

3. Through what mechanisms can a third party's preemptive filing, misappropriated filing, filing by a former agent, bad-faith filing, etc. be prevented from being registered or removed after registration?

✓	Examiners' *ex officio* rejection (Office Action)
✓	Third-Party-Observation (Information submission) Informal notice can be made under their general remit of Section 31
✓	Opposition
✓	Cancellation trial → If there is any specific trial, please indicate: Rectification based on: s.88(1), based on: s.58 (not the owner), s.58A (earlier continuous use), s59 (no intention to use), s.60 (Prior mark with reputation in AU), and s.62A (Application made in bad faith). s.88(2)(b) (fraud or misrepresentation), and s88(2)(c) post-registration likely deception or confusion.
	Invalidation trial As for cancellation trial
✓	Lawsuit In parallel one could add other actions based on: Common law passing off action requiring reputation and likelihood of damage; Misleading and deceptive conduct under Section 18 of the Australian Consumer Law (Schedule 2 of the Competition and Consumer Act 2010); Assuming Cease and Desist approach fails or pre-emptive action is warranted, initiate Federal Court action seeking injunction, damages or account of profits.

4. When preventing or invalidating/cancelling another party's trademark registration based on a well-known mark, is it a requirement that the well-known trademark **be registered** in your country?

	Yes
✓	Must well-known mark be registered? No, but may be helpful to show standing as a Person Aggrieved under s.88

5. When preventing or invalidating/cancelling another party's trademark registration based on a well-known mark, is it a requirement that the well-known trademark **be used** in your country?

✓	Yes If the basis is the likelihood of confusion, or first-to-use ownership
	No

6. In the case of a trademark that is well-known abroad but does not have a high degree of recognition in your country, are there any arguments or measures, other than the assertion of well-known status and submission of evidence described in Part A, Section 2, that would be useful for preventing or invalidating/cancelling a third party's trademark registration? For example, are the following arguments useful? Please select all that apply from the following.

✓	Actual confusion as to source – s.60 (deception or confusion), but still reliant on reputation in Australia; ACL s.18 (misleading and deceptive conduct)
✓	Proof of the third party's bad faith – s.62A Application made in bad faith
✓	Past business relationship – possibly s.62A or s. 58 (if Australian registered owner is not the first user[6]), or there are breached contractual obligations
✓	Proof that the third party knew that the trademark was well-known abroad possibly s.62A Application made in bad faith
	Others (example:)

7. If a third party filed the application in bad faith, what evidence is effective to prove such bad faith? For example, do the following apply? Please select all that apply from the following.

✓	Existence of past transactions
✓	Filing applications for many other parties' famous trademarks Pattern of hijacking behaviour – Glittery Garden case, para. 10[7]
✓	Prior proposal of an agency agreement or other cooperative relationship – breach of contract; s.62A Application made in bad faith: A prior business connection with and knowledge of the opponent by the applicant such that a person standing in the shoes of the applicant should have known that he should not have applied for a trade mark deceptively similar to that used by the opponent is sufficient for a finding of bad faith[8]
✓	Imitating the design of the goods or packaging – © matter – in determining a bad faith case, all surrounding circumstances are relevant; conduct designed to gain an unfair advantage can amount to bad faith[9]
✓	Requesting a high price to sell the application/registration
✓	Others (example: s. 62A Bad faith: Conduct that falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular area is sufficient. Bad faith does not require dishonesty [10]. Mere negligence, incompetence or a lack of prudence to reasonable and experienced standards would not, in themselves, suffice, as the concept of bad faith imports conduct which, irrespective of the form it takes, is of an unscrupulous, underhand or unconscientious character[11])

[6] Anchorage Capital Partners Pty Limited v ACPA Pty Ltd [2018] FCAFC 6, [48] – first user in Australia may secure ownership

[7] Glittery Craft Limited v Xiang Chen [2026] ATMO 8 (13 January 2026)

[8] Fry Consulting Pty Ltd v Sports Warehouse Inc (No 2) [2012] FCA 81 (Dodds-Streeton J)

[9] DC Comics v Cheqout Pty Ltd [2013] FCA 478 (22 May 2013)

[10] *Fry Consulting* (n 16), [156]

[11] Ibid [147]-[148] and [165]

8. If an application is filed or registered for dissimilar goods or services, can registration be prevented or invalidated/cancelled? Please describe any conditions.

✓	Yes
	No

Any comments (* Word limit: 100 words or less, if possible):
There are many grounds that relate to the Applicant's character or the inherent nature of the trade mark:
1. Non-use removal action under Section 92;
2. Rectification of the Register under Section 88:
(1) on available opposition grounds:
(a) Standard examination grounds for objection (s.57):
s.41 Lack of distinctiveness;
s.42(a) Prohibited/protected signs (s42(a));
s.42(b) Scandalous or contrary to law (s42(b));
s.43 Inherently likely to deceive or cause confusion (s.43);
(b) Specific opposition grounds:
s.59 **No intention to use**, authorise or assign (e.g. squatting);
s.61 False geographical indication;
s.62(b) Acceptance obtained based on evidence or representations that were false in material particulars.
s62A **Application made in bad faith** (e.g. hijacking foreign brand)
(2) Rectification grounds exclusive to Court proceedings:
s.88(2)(b) Fraud or false misrepresentation;
s.88(2)(c) Post-registration likely to deceive or cause confusion but note:
s.89 Fault cannot lie with owner;
3. s.87 Trade mark becomes generic or is only way to describe expired patented product with reference to ss. 24 & 25.
4. As a result of a legal action, under Part 8, Div. 2, a Court order might be made to cancel based on:
(1) Common law passing off action requiring reputation and likelihood of damage;
(2) Misleading and deceptive conduct under Section 18 of the Australian Consumer Law (Schedule 2 of the Competition and Consumer Act 2010)

Part C: Enforcement Capabilities of "Well-Known Marks"

1. Which of the following can constitute a legal title or legal basis for asserting claims?

✓	Assertion of rights in a well-known trademark that is unregistered in your country – Well known status requires a reputation in Australia, though the trade mark may be unregistered by the overseas entity making the assertion ss. 58 (ownership), 60 (prior mark with a reputation), 88(2)(c) (post-registration, likely to deceive or cause confusion)).
✓	A well-known trademark registered in your country
✓	Acts of unfair competition
✓	Passing off
	Dilution – no explicit provisions – other avenues are passing off, ACL, etc.
	Tort under civil law – False assertion (e.g. counterfeit, illegal or defective) amounting to injurious falsehood; Interference with contractual relations (e.g. false claim of infringement made to distributors or stockists; Deceit - fraudulent misrepresentation (e.g false assertion that party holds a TM licence or assignment, leading to owner being coerced to assign rights away or stop using); Negligent misstatement (e.g. negligently incorrect FTO advice) Defamation (e.g. disparaging a small business or damaging its reputation)
	Others (please specify:)

2. What legal remedies are available?

✓	Injunction, including an interim injunction
✓	Claim for damages
	Measures to restore business reputation (e.g. apology advertisement) – would be by court order, but unlikely[12]
✓	Customs border measures – Part 13 of the Act
✓	Others (please specify: Account of profits instead of damages

[12] Nextra Australia Pty Limited v Fletcher [2014] FCA 399

3. In order to obtain the legal protection listed below, is it necessary for the well-known trademark to be used in your country?

✓	Injunction – to obtain an injunction, there needs to be an imminent or future threat to the rights or property of the complainant should the actions persist. If there is no use of the foreign mark in Australia, it would be difficult to show that there is a relevant right or property under threat. However, use is needed for actions based on ss. 58 (ownership), 60 (prior mark with reputation), 88(2)(c) (likely to deceive/cause confusion at time of claim). Use is not required for many grounds listed under Part C, para. 8 above.
✓	Claim for damages - Ditto
	Customs border measures – Use not required – could be based merely on a trade mark registration
✓	Apology advertisement (or other measures to restore business reputation) would be by court order, but unlikely[13]
	Others (please specify:)

4. In the case of a trademark that is well-known abroad but does not have a high degree of recognition in your country, which of the following can constitute a legal basis for asserting claims?

	Assertion of rights in a well-known trademark that is unregistered in your country – Need to be able to show reputation in Australia for well-known unregistered foreign mark. Other grounds may include non-use removal, etc.
✓	A well-known trademark registered in your country
✓	Acts of unfair competition
	Passing off – Not without reputation in Australia
	Dilution – No
	Tort under civil law – see Part C, para. 1 above
	Well-known or famous status overseas– Not without reputation in Australia
✓	Assertion of the other party's bad faith
	Actual confusion as to source in the market– Requires spillover reputation into Australia
	Others (please specify:)

5. If there are any cases involving a trademark that is well known abroad but does not have a high degree of recognition in your country, where a third party registered the trademark first and the matter was disputed in an opposition, trial or appeal, infringement litigation, or similar proceeding, please briefly introduce one or two examples.

[13] Ibid

Case 1: Foreign Trade Mark Owner must have Prior Use on Relevant goods/services

Title: Taylor v Killer Queen LLC [2026] HCA 5; **Case number:** [S49/2025]; **Date:** 11 March 2026;

Brief Summary: In 2001, pop star Katy Perry ("Hudson"/"Killer Co.", "Singer") adopted that stage name. A Sydney clothing designer Katie Perry ("Taylor", "Designer") allowed a 2007 application for KATIE PERRY & logo to lapse. On 29 September 2008 ("the priority date"), the Designer filed the relevant trade mark application for KATIE PERRY clothing in Class 25. She asserted that she was not aware of the pop star until after the 2008 application was filed when she heard some of her songs. Around 2009, they were in dispute. The Singer belatedly opposed the Designer's application and issued letters of demand, and a Coexitence Agreement proposed by the Singer was not agreed to by the Designer.

For over 10 years, no major development occurred until 2019 when, funded by Litigation Capital Management, the Designer sued the Singer for trade mark infringement. The Designer initially won at trial. The Singer then won on appeal in the Federal Court.

However, Taylor succeeded in a 3-2 appeal to the High Court. The main ground (which was s. 60 based on prior reputation in Australia for registered goods) failed as there was no evidence of any sales by the Singer on branded clothing before the 2008 priority date. Despite the court accepting that Hudson now had a massive reputation in Australia, the Singer also failed on s. 88(2)(c) (that the use of the Designer's mark was now likely to deceive or cause confusion), because this situation arose through no fault of the Designer (s. 89 exception).

Case 2a: Bad faith is tested at the Time of Application and requires Convincing Proof

Title: Fry Consulting v Sports Warehouse Inc (No 2) [2012] FCA 81; (2012) 201 FCR 565

Case number: VID 912 of 2009; **Date:** 13 February 2012; **Brief Summary:**

This is a major Australian decision relating to bad faith. A dispute arose between 2004 – 2010 between long-established US company, Sports Warehouse Inc. ("Sports"), and a then recently emerged Australian company, Fry Consulting Pty Ltd ("Fry"). They were competing for the rights to the trade mark, TENNIS WAREHOUSE, in relation to retailing of goods in Class 35.

Fry sought a trade mark TENNIS WAREHOUSE AUSTRALIA & tennis ball logo 

: which is now registered (No. AU 1153714).

Sports Warehouse opposed under the bad faith provision of s.62A. The onus is on the opponent to show that bad faith existed at the time that the application was filed.

Cogent (convincing) proof is required. This is because the character of the applicant is impugned.

2 years prior to its application, Fry was open with Sports in asking for proof of Sports' entitlement to TENNIS WAREHOUSE. Sports promised to provide the proof but failed to do so. If the application had been filed at that time and without informing Sports, her Honour, Justice Dodds-Streeton, considered that Fry's application may well have been in bad faith.

It would have been considered exploitative and designed to acquire a springboard or advantage for his fledgling business and would not have accorded with proper or ordinary commercial standards.

However, because Fry waited 2 years for the proof and to file the application, it avoided a finding of bad faith.

Case 2b: Title: DC Comics v Cheqout Pty Ltd [2013] FCA 478; **Case number:** NSD 1145 of 2012; **Date:** 22 May 2013; **Brief Summary:**

"Superman Workout" was opposed by DC Comics. On appeal to the Federal Court, DC Comics successfully relied on its reputation in the common law mark "Superman". Her honour, Justice Bennett, followed the Fry Consulting case but distinguished on the facts, namely Fry's conduct in the 2 years preceding its application. The test for bad faith references the standards of acceptable commercial behaviour observed by reasonable, experienced people. An applicant's mental state is also relevant. That is, what are their intentions.

The applicant chose to use a triangular shield device and the colours red, white and blue, to strengthen the association with the Superman character.

Case 3: s. 120(3) Infringement involves completely unrelated goods/services to registration
Title: Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd [2023] HCA 8
Case Nos.: S79/2022 and S80/2022; Date: 15 March 2023; Brief Summary:
The High Court made obiter comments on s. 120(3), their Honours noting:
1. S.120(3) is provided to prevent dilution of famous brands' distinctiveness and commercial value;
2. S. 120(3) explicitly referenced reputation which implied that consideration of reputation may be excluded from consideration under s. 120(1) regarding deceptively similarity;
3. ss. 120(3) (well known), s. 24 (generic), 60 (reputation) and 185 (defensive mark) all require examinations of reputation and s. 120(3) only concerned trade marks for completely unrelated goods and/or services.

III. Discussion based on "Case Example"

We would like to discuss a hypothetical case with all of you. Based on the following hypothetical scenario, please consider and answer the questions that follow.

Part A. Case Example: Hotel APAA in Monaco, well known in Monaco and Europe

Hotel "APAA," located in the Principality of Monaco, is a well-known hotel in Monaco. However, the hotel has not opened any establishment in Japan. Hotel "APAA" has not obtained a trademark registration in ~~Japan~~ Australia for "provision of hotel accommodation" in Class 43.

However, in order to attract tourists from ~~Japan~~ Australia to stay at its hotel in Monaco, Hotel "APAA" allows accommodation reservations to be made online from ~~Japan~~Australia. It also advertises on Instagram and TikTok, and such advertisements are accessible to consumers in ~~Japan~~Australia.

In reality, however, only a very small number of people in ~~Japan~~Australia are aware of Hotel "APAA" in Monaco, and it is known only among a very limited segment of affluent consumers. The number of guests from ~~Japan~~ Australia is approximately 20 per year.

Under these circumstances, X, a famous chef in ~~Japan~~ Australia who has no relationship with Hotel "APAA," obtained a trademark registration in ~~Japan~~ Australia for "APAA" in Class 43, not only for "provision of hotel accommodation," but also for "providing food and beverages." X had stayed at Hotel "APAA" in Monaco three years earlier. X uses "APAA" as the name of his own restaurant in ~~Osaka~~Brisbane, and the restaurant is successful.

Upon learning of this, Hotel "APAA" in Monaco hurriedly filed a trademark application in ~~Japan~~ Australia in Class 43, designating "provision of hotel accommodation" and "providing food and beverages" as the designated services. However, the application was refused on the ground that it was identical to the trade mark registration owned by X.

Hotel "APAA" is now considering seeking cancellation of X's trademark registration by asserting that "APAA" is a well-known trademark in Monaco in connection with "provision of hotel accommodation" in Class 43.

If you were acting as counsel for Hotel "APAA," on what grounds would you seek to cancel X's trademark registration?

Please note that the opposition period has already expired.

Part B. Questions

Please answer the following questions under the laws and practice of your own jurisdiction, assuming the same factual circumstances occurred in your country (replacing Japan/Osaka with your country/city).

1. Is it possible to initiate an invalidation or cancellation trial against X's registration under the Trade Mmarks Act?

✓	Yes – under s. 88, Hotel "APAA" as a person aggrieved can apply to the Federal Court for rectification of the register by cancelling/amending the registration
	No

2. If your answer to Question 1 is YES, what grounds for invalidation or cancellation may be considered?

✓	A trademark identical or similar to an unregistered trademark well known in the country (JapanAustralia), and filed for identical or similar goods or services – Yes, s. 44 provides grounds where a substantially identical with, or deceptively similar to, a trade mark is being sought by the rectification applicant
✓	A trademark likely to cause confusion with a trademark well-known **both** in the country (JapanAustralia) and abroad - Yes, ss. 60 - Prior mark with a well-known status in Australia in the relevant sector would suggest that there is a likelihood of confusion
	A trademark likely to cause confusion with a trademark well-known **only abroad** – without use in Australia, explore other grounds like non-use (s. 92), bad faith (s. 62A), etc.
	A trademark filed for an improper purpose that harms the interest of the owner of the well-known trademark – sounds like "bad faith" - not in accordance with proper or ordinary commercial standards
✓	A trademark filed in bad faith
✓	Prior use – also must be continuous to establish the chain of prior use conferring earlier ownership

3. Given that online reservations are available for JapaneseAustralian customers and a small number of JapaneseAustralian tourists stay at the hotel, can it be said that Hotel "APAA" is using the trademark "APAA" in AustraliaJapan to establish well-known status in JapanAustralia?

✓	Yes – technically – keeping in mind s. 120 concerns infringement, not the establishment of registrable rights, ss. 120(4) states: "one must take account of the extent to which the trade mark is known within the **relevant sector** of the public, whether as a result of the promotion of the trade mark or for any other reason." Since there is no guideline as to the numerical size of the "relevant sector", it is possible that only a small number of consumers may populate this group
	No

4. Is it also possible to invalidate or cancel X's trade mark registration with regard to the services "providing food and beverages"?

✓/2	Yes – s.120(3) provides that the scope of goods or services covered by a well-known mark under this provision can extend to correspondingly unrelated services or goods that are not of the same description. If there was a finding of infringement, then it may be open to the court to make an order for the Registrar to cancel an affected registration owned by the infringer
✓/2	No – without the establishment of well-known status under s.120(3), and relying on s.60 (reputation acquired in Australia through significant prior and continuous use on the listed services), the circumstances would not support a rectification action.

5. If your answer to Question 4 is YES, what grounds for invalidation or cancellation may be considered?

✓	A trademark identical or similar to an unregistered trademark well known in the country (~~Japan~~Australia), and filed for identical or similar goods or services – s. 60 (reputation acquired in Australia through significant prior and continuous use on the identical services or the same kind of services (virtually the same))
✓	A trademark likely to cause confusion with a trademark well-known **both** in the country (~~Japan~~Australia) and abroad – s. 60 provides the most relevant ground with regard to confusion, but services must be the same, which is not the case in relation to "providing food and beverages " in the example in Item 4 above. A section 120(3)-(4) finding of infringement may lead to the securement of a court order under s. 88 for rectification of the Register Along similar lines to s. 120(3)-(4) as an indirect way to obtain rectification, s. 185 (defensive marks) provides for registration of a defensive trade mark where a substantial reputation can be shown that use on other goods or services would indicate a connection to the owner.
	A trademark likely to cause confusion with a trademark well-known **only abroad** – No, if there is no reputation in Australia
✓	A trademark filed for an improper purpose that harms the interest of the owner of the well-known trademark – Yes, if bad faith can be established – s. 62A
✓	A trademark filed in bad faith – s. 62A
	Prior use – s. 60 (reputation and prior and continuous use on the same services)

6. Is it possible to claim an act of unfair competition against X's use of the "APAA" mark for his restaurant in Osaka?

✓	Yes – s. 18 of ACL on the basis on misleading and deceptive conduct
	No

7. If your answer to Question 6 is YES, what legal grounds may be considered?

✓	Passing off – reputation and goodwill, misappropriation likely leading to damages
	Dilution – no explicit provisions – other avenues are passing off, ACL, etc.
✓	Fraudulent conduct under civil law
	Well-known status abroad
✓	Allegation of the other party's bad faith
✓	Actual confusion in the market – passing off, ACL, etc.
	Others (please specify: see below list of available bases for civil actions)

Comments, if any (* Word limit: 100 words or less, if possible):
Tort of passing off – must show reputation, misappropriation and that action has/likely to damage
False assertion (e.g. counterfeit, illegal or defective) amounting to injurious falsehood;
Interference with contractual relations (e.g. false claim of infringement made to distributors or stockists;
Deceit - fraudulent misrepresentation (e.g false assertion that party holds a TM licence or assignment, leadsing to owner being coerced to assign rights away or stop using);
Negligent misstatement (e.g. negligently incorrect FTO advice)
Defamation (e.g. disparaging a small business or damaging its reputation)

IV. Ideas for Next Special Topic

Please provide some ideas (at least one for each country) for the 2027 Special Topic that you would like to discuss.

Thank you for your kind cooperation!