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

Definition of well-known mark.

Comments: No. Indonesian trademark law does not specifically define a "well-known mark." However, well-known marks are recognized as grounds for refusing trademark applications. Article 21(1)(b) of Law No. 20 of 2016 (as amended) provides for refusal where an applied-for mark is substantially or entirely similar to another party's well-known mark for similar goods or services. Article 36 of Minister of Law Regulation No. 5 of 2026 further provides criteria for determining well-known status, including public recognition, sales and profits, market share, geographical extent and duration of use, promotional activities and investment, foreign registrations, enforcement history, reputation, and associated brand value.

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

	Unfair Competition Prevention Act
	Decisions of the Trial and Appeal Department of the Intellectual Property Office
✓	Court Decisions
	Doctrines adopted by the courts
	Comments: Yes. In addition to the Trademark Law and its implementing regulations, the recognition and protection of well-known marks in Indonesia have also been developed through court decisions, particularly decisions concerning trademark cancellation and bad-faith applications. Indonesia does not have a separate Unfair Competition Prevention Act specifically governing the recognition of well-known trademarks.

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: Indonesia does not have a separate system under which a trademark owner may formally apply for recognition or registration of a mark as a well-known mark. Well-known status is determined on a case-by-case basis in the context of relevant trademark proceedings, based on the applicable statutory criteria and supporting evidence.

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
✓	No

	Comments: There is no express strict-identity test in the provisions cited above. However, the evidence relied on should relate to the mark whose well-known status is claimed. The absence of an express test should not be understood as making differences between the claimed mark and the mark actually used irrelevant.

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

✓	Yes
	No

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 (Indonesia)
	It is sufficient to be well-known ONLY in the brand owner's home country, while not in the target jurisdiction
	Comments: Foreign use and registrations can be relevant evidence under Article 36.

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?
✓	Only regionally (in a specific region or more where the goods/services are provided)?
✓	Via the Internet, even if it is not necessarily known nationwide?
	Comments: Indonesian law does not expressly require a well-known mark to be recognized nationwide. The assessment focuses, among other factors, on the degree of knowledge or recognition of the mark among the public in the relevant business sector and the geographical extent of its use. Accordingly, regional recognition or recognition obtained through online use may be relevant, although such recognition is assessed together with the other statutory criteria under Article 36. The selections above indicate potential eligibility, not that regional recognition or Internet exposure alone is sufficient to establish well-known status in Indonesia.

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)?
✓	Only the relevant consumers of the specific goods or services?
	Only the relevant consumers, even if the goods or services are provided exclusively via the Internet?
	Comments: Indonesian law does not require recognition by the public at large.

	The relevant consideration is the degree of knowledge or recognition of the mark among the public in the relevant business sector. For services supplied exclusively online, the relevant question remains recognition among the relevant public in Indonesia; online availability alone does not establish that recognition.

6. What factors are considered in order for a trademark to be recognized as a well-known trademark?

✓	Period of use
✓	Area of use
✓	Sales amount
✓	Advertising and promotional expenses
	Person or entity that conducted the advertising and promotion
✓	Relevant consumers
✓	Market share
	Number of stores
	Awards received
	Number of posts on social media by third parties
	Results of recognition surveys conducted through questionnaires
	Number of visits to the website of the holder of the well-known trademark
	Others: Profits derived from use of the mark (Article 36(b)); trademark registrations or applications in other countries (Article 36(g)); successful trademark enforcement, particularly recognition as a well-known mark by competent authorities (Article 36(h)); and the value associated with the mark due to its reputation and the quality assurance of the relevant goods and/or services (Article 36(i)). The selections above identify the expressly stated statutory factors. They do not mean that other listed materials, such as surveys, awards, store numbers, third-party posts or website traffic, are necessarily irrelevant. Such materials may support the assessment of public recognition or other statutory factors, depending on their content and connection to Indonesia.

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
✓	Access records to cross-border e-commerce sites
✓	Purchase records from cross-border e-commerce sites
	Number of inbound travelers
	Number of travelers from your country to the country where the well-known trademark exists
	Comments: Such evidence may be relevant to the degree of knowledge or recognition of the mark among the relevant public, although these matters are

	not expressly listed as separate criteria under Article 36 of Minister of Law Regulation No. 5 of 2026. Mere accessibility of a foreign website is less informative than evidence of actual access, purchases or engagement by consumers in Indonesia.

8. In recognizing the well-known status of a trademark, is use on the following tools or platforms considered as evidence?

✓	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
	Comments: Indonesian law does not specifically identify these platforms or forms of evidence. However, Article 36 of Minister of Law Regulation No. 5 of 2026 provides that the intensity of promotion of the mark, including the investment made for such promotion, is relevant in determining well-known status. Third-party influencer posts may also be relevant where they provide reliable evidence of recognition among the relevant public in Indonesia, even if they are not advertising commissioned by the trademark owner.

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

In addition to the evidence identified in Questions 6–8, potentially useful materials include independent Indonesian press coverage, references to the mark in Indonesian trade publications, and evidence from local travel agents or other relevant intermediaries showing familiarity with the foreign brand. The value of such evidence depends on whether it demonstrates recognition among the relevant public in Indonesia at the relevant date.

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)

YES	1) In the case of consumer goods	-- % N/A
	2) In the case of products for specialized markets (such as aircraft parts)	-- % N/A
	3) In the case of services	-- % N/A
~~NO~~		

Comments: Under the Elucidation of Article 21(1)(b) of the Trademark Law, the Commercial Court may order an independent survey if the available evidence is insufficient

to determine whether a mark is well-known. No specific recognition-rate threshold is prescribed. The "Yes" response refers to this statutory possibility; it should not be read as confirming that consumer surveys are routinely used or that a particular recognition percentage is generally accepted in practice.

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
	No

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
✓	A trademark likely to cause confusion with a trademark well-known in your country
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country
	A trademark likely to cause confusion with a trademark well-known only in a foreign country
	A trademark filed with an unfair purpose that would harm the interest of the owner of the well-known trademark
✓	A trademark filed in bad faith

Comments: The confusion-related selections refer to the applicable statutory grounds concerning similarity to a well-known mark; they are not intended to identify a separate, unrestricted confusion-based ground. An unfair purpose may be relevant where the circumstances establish bad faith.

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)
✓	Opposition
	Cancellation trial → If there is any specific trial, please indicate: ( )
✓	Invalidation trial

✓	Lawsuit

Comments: "Invalidation trial" and "Lawsuit" refer here to a court action seeking cancellation of the registration before the Commercial Court, rather than two separate remedies. The unchecked "Cancellation trial" option is not intended to suggest that judicial cancellation is unavailable.

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
✓	No

Comments: Not generally for similar goods or services. However, an unregistered owner seeking cancellation must address the requirement to file its own Indonesian trademark application before bringing the action. For refusal based on a well-known mark covering dissimilar goods or services, the registration and written-opposition requirements discussed in Question 8 must also be considered. Refusal during examination and post-registration cancellation should be distinguished.

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
✓	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
✓	Proof of the third party's bad faith
✓	Past business relationship
✓	Proof that the third party knew that the trademark was well-known abroad
	Others: Evidence of imitation or copying of the mark and other circumstances demonstrating the applicant's bad faith.

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
✓	Prior proposal of an agency agreement or other cooperative relationship

✓	Imitating the design of the goods or packaging
✓	Requesting a high price to sell the application/registration
✓	Others (example: Evidence showing the applicant's prior knowledge of the mark and circumstances indicating an intention to imitate, take advantage of, or otherwise unfairly appropriate the mark.)

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

Comments: A trademark application may be refused, or a registration may be cancelled, based on similarity to another party's well-known mark even for dissimilar goods or services. For refusal, the well-known mark must be registered and its owner must file a written opposition supported by sufficient evidence. These refusal requirements should not, without further analysis, be treated as establishing the requirements for a post-registration cancellation action. A separate bad-faith ground should also be considered where supported by the evidence.

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
✓	A well-known trademark registered in your country
	Acts of unfair competition
	Passing off
	Dilution
✓	Tort under civil law
	Others (please specify: Bad-faith trademark application/registration)

Comments: The availability of each basis depends on its statutory conditions. A bad-faith application or registration is relevant primarily to a challenge against that application or registration; it does not, by itself, establish entitlement to every remedy against use.

2. What legal remedies are available?

✓	Injunction
✓	Claim for damages
	Measures to restore business reputation (e.g. apology advertisement)
✓	Customs border measures
	Others (please specify: Cancellation/invalidation of the conflicting trademark registration)

Comments: The listed remedies are not necessarily available on the same conditions or to every unregistered well-known-mark owner. Infringement relief, cancellation and customs measures involve distinct requirements. The customs selection remains subject to confirmation of the applicable registration, recordation and applicant-eligibility requirements.

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

No	Injunction
No	Claim for damages
No	Customs border measures
N/A / not specifically provided	Apology advertisement (or other measures to restore business reputation)
	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
✓	A well-known trademark registered in your country
	Acts of unfair competition
	Passing off
	Dilution
	Tort under civil law
	Well-known or famous status overseas
✓	Assertion of the other party's bad faith
	Actual confusion as to source in the market
	Others (please specify:)

Comments: Overseas reputation may support evidence of well-known status or bad faith, but is not presented here as an independent cause of action. Reliance on well-known-mark protection requires the necessary recognition in Indonesia. Where the mark is registered in Indonesia, registered rights should be distinguished from protection dependent on well-known status.

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.

Illustrative example only: The following case concerns a foreign brand owner challenging a local registration. It is not presented as a verified example of a mark having only limited recognition in Indonesia at the relevant date.

Case 1:

Title: Starbucks Corporation v PT Sumatra Tobacco Trading Company
Case number: 51/Pdt.Sus-Merek/2021/PN Niaga Jkt.Pst; 836 K/Pdt.Sus-HKI/2022; 48 PK/Pdt.Sus-HKI/2023
Date: 23 December 2021; 18 May 2022; 18 October 2023
Brief Summary:
At first instance, the Central Jakarta Commercial Court dismissed Starbucks' claim. On cassation, however, the Supreme Court granted Starbucks' appeal in Decision No. 836 K/Pdt.Sus-HKI/2022. The dispute was concluded when the Supreme Court dismissed PT Sumatra Tobacco Trading Company's judicial-review application in Decision No. 48 PK/Pdt.Sus-HKI/2023. Accordingly, the outcome was in Starbucks' favour. The case illustrates that a conflicting local registration may ultimately be invalidated in favour of a foreign brand owner, but it should not be described as establishing that foreign reputation alone is sufficient or that Starbucks had only limited recognition in Indonesia at the relevant filing date.

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 for "provision of hotel accommodation" in Class 43.

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

In reality, however, only a very small number of people in Japan 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 is approximately 20 per year.

Under these circumstances, X, a famous chef in Japan who has no relationship with Hotel "APAA," obtained a trademark registration in Japan 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, and the restaurant is successful.

Upon learning of this, Hotel "APAA" in Monaco hurriedly filed a trademark application in Japan 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 trademark 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 Trademark Act?

✓	Yes
	No

Comments: Yes. Hotel APAA may bring a trademark invalidation action before the Commercial Court. Because it is domiciled abroad, the action would be filed with the Central Jakarta Commercial Court. As an unregistered owner, it must first have filed its own Indonesian application; the facts indicate that it has done so. Expiry of the opposition period does not bar invalidation. The ordinary limitation period is five years from registration, but a bad-faith claim is not time-barred.

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 (Japan), and filed for identical or similar goods or services*
✓	A trademark likely to cause confusion with a trademark well-known **both** in the country (Japan) and abroad*
	A trademark likely to cause confusion with a trademark well-known **only abroad**
✓	A trademark filed for an improper purpose that harms the interest of the owner of the well-known trademark
✓	A trademark filed in bad faith
	Prior use

*Notes: The first two selections are conditional alternatives, not conclusions that APAA is already well known in Indonesia on the stated facts.

Comments: The primary ground is bad faith under Article 21(3) of the Indonesian Trademark Law, which requires refusal of a trademark application filed in bad faith. This ground may be supported by X's prior stay and resulting knowledge of the APAA mark, provided the stay preceded X's filing. Knowledge alone is insufficient; Hotel APAA should prove copying, dishonest intent, claims of affiliation, or other circumstances explaining X's adoption of APAA. Article 21(1)(b), which prohibits registration of a mark that is substantially or entirely similar to another party's well-known mark for similar goods or services, may be pleaded alternatively

only if the hotel can establish relevant recognition in Indonesia before X's filing. Fame only in Monaco or Europe and prior foreign use are not independent grounds.

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

	Yes
✓	No

Comments: Not necessarily. Online reservations, advertisements accessible in Indonesia, and approximately 20 Indonesian guests per year are relevant evidence of Indonesian-facing promotion and customer contact, but do not automatically establish trademark use in Indonesia or well-known status. Whether these activities constitute trademark use in Indonesia is a separate question from whether they establish sufficient recognition for well-known status. The assessment should consider Indonesian reach before X's filing, the size of the relevant luxury-travel market, actual bookings, travel-agent evidence, and independent publicity.

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

✓	Yes
	No

Comments: Yes. The food-and-beverage services may also be challenged, particularly on bad-faith grounds. The fact that hotel and restaurant services are both in Class 43 does not by itsel f establish similarity; their nature, purpose, complementarity, consumers, trade channels, and l ikely commercial origin must be assessed.

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), and filed for identical or similar goods or services
✓	A trademark likely to cause confusion with a trademark well-known **both** in the country (Japan) and abroad
	A trademark likely to cause confusion with a trademark well-known **only abroad**
✓	A trademark filed for an improper purpose that harms the interest of the owner of the well-known trademark
✓	A trademark filed in bad faith
	Prior use

Comments: Bad faith and improper purpose are the principal grounds if the evidence shows that X's appropriation extended to restaurant services. If hotel accommodation and restaurant services are similar on the facts and APAA was already well known in Indonesia, Article 21(1)(b) may also apply. If the services are dissimilar, reliance on the well-known-mark provisions is less straightforward because Hotel APAA does not appear to own a registered mark, while the opposition period has already expired. Under Minister of Law Regulation No. 5 of 2026, refusal based on a well-known mark for dissimilar services requires, among other things, a registered

well-known mark and a written opposition by its owner. Those requirements concern refusal during examination and should be distinguished from the grounds and requirements for cancellation after registration. Expiry of the opposition period does not, by itself, bar a cancellation action. Prior foreign use, foreign registrations, and international reputation may support a well-known-mark claim, but do not by themselves create independent priority rights in Indonesia.

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
	No

Comments: Potentially yes, but Indonesian law does not recognise passing off as an independent common-law cause of action. In other words, Hotel APAA cannot succeed merely by labelling X's conduct as passing off; it must base its claim on a recognised statutory or civil-law cause of action and prove the elements required under that basis. Hotel APAA may consider an unlawful act claim under Article 1365 of the Indonesian Civil Code or, if the statutory conditions are met, a claim under Article 83(2) of the Trademark Law. The present facts do not yet prove misrepresentation, actionable loss, or sufficient Indonesian reputation, and the strategy must address X's existing registration rather than assume that allegations of unfair competition override it.

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

	Passing off
	Dilution
✓	Fraudulent conduct under civil law
	Well-known status abroad
✓	Allegation of the other party's bad faith
✓	Actual confusion in the market
	Others (please specify:)

Comments:
A potential legal basis is an unlawful-act claim under Article 1365 of the Indonesian Civil Code, subject to proof of unlawful conduct, fault, loss and causation. Bad faith and actual confusion may support the claim but are not independent causes of action or substitutes for proving those elements. The stated facts do not establish actual confusion.
X's existing registration must also be addressed. A bad-faith invalidation action, as discussed in Questions 2 and 5, should therefore be considered alongside any claim against X's use.

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.

Indonesia: Bad-Faith Trademark Filings and Procedural Safeguards in a First-to-File System

A comparative discussion on the evidence required to prove dishonest appropriation, including

repeat filings, prior commercial relationships, former agents or distributors, copying, and demands to sell registrations. The topic could also examine limitation periods, treatment of conflicting pending applications, registry and court procedures, and remedies that enable genuine brand owners—particularly SMEs and foreign businesses entering Indonesia - to address pre-emptive filings efficiently without weakening the legitimate rights of good-faith first filers.

Thank you for your kind cooperation!