APAA 2026, Hong Kong
Trademarks Committee – Special Topic
Challenges in Protecting Well-Known Marks Across Jurisdictions

INDEX

I. Background of Discussion

II. Questions

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

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

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

III. Discussion Based On Case Example

IV. Ideas for Next Special Topic

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 (* Word limit: 100 words or less, if possible): Sec 2(1)(zg): "well-known trademark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

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

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: India provides a specific statutory mechanism for the formal determination of a trademark as a "well-known trademark." Under Section 11(6) to 11(10) of the Trade Marks Act, 1999 read with Rule 124 of the Trade Marks Rules, 2017, the proprietor may apply to the Registrar of Trade Marks, by filing the appropriate form for determining a trademark as a well-known trademark, by submitting the prescribed fee and supporting evidence Suo motu determination of well-known status: There is no express provision under the Trademarks Act, 1999, empowering the Registrar or a court to initiate suo motu proceedings solely for declaring a mark as well-known. However, a court or the Registrar may determine a mark to be well-known in the course of proceedings before them, in accordance with Section 11(8) of the Act, without requiring a separate application for such determination.

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

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 (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?
✓	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?

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?

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: Please specify, if any: The previous instances of successful enforcement of the rights in that trademark.

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

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

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.

(* Word limit: 100 words or less, if possible):

i. References to the trademark in Indian newspapers, magazines, television, trade publications and other media
ii. Independent reviews, industry reports and publications evidencing recognition of trademark in India.
ii. Enquiries, requests or expressions of interest from Indian consumers or businesses concerning the branded goods/services
v. Evidence of Indian consumers purchasing or seeking to purchase the branded goods/services through overseas retailers or distributors
v. Participation by the trademark owner in international trade fairs, exhibitions or industry events attended by Indian consumers or businesses
vi. References or recognition by Indian industry bodies, trade associations or professional organizations
ii. Independent rankings, awards or industry recognition known or reported in India

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		

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 {Section 11(3)(a)}
✓	A trademark likely to cause confusion with a trademark well-known in your country {Section 11 (1), 11 (2), 11(10)(i)}
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country {Section 11(1), 11(2), 11(6)-(9)}
	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 {Section 11(10)(ii)}
✓	A trademark filed in bad faith {Section 11(10)(ii)}

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: (Rectification/cancellation under Section 47 and 57 of the Trade Marks Act,1999)
✓	Invalidation trial
✓	Lawsuit

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

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 (example: Prior use

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: False or misleading statements made to the Trade Marks Registry, false claims

	of use or fabricated evidence of use; copying of distinctive elements of the trademark owner's branding, get-up or trade dress; registration of corresponding or similar domain names/domain name squatting, evidence of knowledge of the trademark owner's rights before filing/dishonest adoption.)

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): Section 11(2) permits refusal where the earlier trademark is well known in India and the later mark is identical or similar and sought to be registered for dissimilar goods or services, provided use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark. For a registered earlier mark, Section 29(4) also provides protection against use in relation to dissimilar goods or services where the statutory conditions are satisfied. Section 57 of the Act also allows a person aggrieved to file for cancellation or vary registration and to rectify the register

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:

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: Account of profits, delivery-up/destruction of infringing material, recall/withdrawal of infringing goods, costs of proceedings

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
	Claim for damages
	Customs border measures
	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:)

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.

Case 1:
Title: Toyota Jidosha Kabushiki Kaisha v. M/s Prius Auto Industries Ltd. — Supreme Court of India

Case number: Civil Appeal Nos. 5375-5377 of 2017

Date: December 14, 2017

Brief Summary (* Word limit: 200 words or less)**:**

The Supreme Court considered whether Toyota could restrain Prius Auto Industries from using the mark "PRIUS" on the basis of passing off, despite Prius Auto having obtained registration and having used the mark in India since 2001. Toyota had adopted and used "Prius" internationally for its hybrid car from 1997, but the car was introduced in India only in 2009–2010. The Court affirmed the territoriality principle, holding that prior use and reputation of a mark abroad do not automatically confer rights in India. The claimant must establish that its

goodwill and reputation had spilled over into the Indian market before the defendant's adoption/use of the mark.

The Court found that Toyota had not produced sufficient evidence of substantial goodwill or reputation for "Prius" in India before April 2001. International advertisements, limited newspaper reports, internet information and other publicity were insufficient, particularly given the limited internet penetration in India at that time. The Court also reiterated that passing off is based on prior goodwill and is not defeated merely because the defendant is a registered proprietor.

Accordingly, Toyota's appeals were dismissed and the injunction against Prius Auto's use of "PRIUS" was not granted.

Case 2:
Title: Toyota Jidosha Kabushiki Kaisha v. Tech Square Engineering Pvt. Ltd. & Anr.

Case number: LPA 176/2023 & CM APPL. 11804/2023

Date: May 4, 2026

Brief Summary (* Word limit: 200 words or less)**:**

The Delhi High Court considered whether Toyota's mark "ALPHARD", which had been adopted and commercially used internationally well before the respondent's adoption in India, was entitled to protection in India on the basis of trans-border reputation and well-known trademark status. Toyota claimed adoption of ALPHARD dating back to 1986 and worldwide commercial use from 2002. The respondent adopted and registered the identical mark in India in 2015 on a "proposed to be used" basis for Classes 9, 12 and 27.

The Single Judge had dismissed Toyota's rectification petitions, holding that Toyota had failed to establish sufficient goodwill and reputation in India before the respondent's adoption.
On appeal, the Division Bench emphasized that formal commercial launch or direct sales by the proprietor in India are not indispensable for establishing trans-border reputation.

The Court held that Toyota had established spill over reputation and goodwill in India prior to the respondent's application and that ALPHARD was a well-known trademark at the relevant time. The respondent's adoption was found to be mala fide.

Accordingly, the Court allowed the appeal and ordered removal of the respondent's ALPHARD registrations in Classes 9, 12 and 27.

Case 3:
Title: Columbia Pictures Industries, Inc. v. Registrar of Trade Marks & Anr.

Case number: C.A.(COMM.IPD-TM) 44/2025

Date: July 6, 2026

Brief Summary:

The Delhi High Court held that prior formal recognition or declaration of a trademark as well-known is not a prerequisite for claiming protection under Section 11(2) of the Trade Marks Act, 1999. The Court clarified that the Registrar must independently assess claims of well-known status based on evidence and the factors prescribed under Sections 11(6) and 11(7), even where the competing goods fall in different classes. The Court further clarified that Rule 124 of the Trade Marks Rules, 2017 provides an independent mechanism for seeking formal recognition of well-known status before the Registrar and does not preclude determination of such status in opposition proceedings under Section 11(2) of the Act. Accordingly, the Court set aside the Registrar's rejection of Columbia Pictures' opposition to the mark "GHOST BUSTER" and remanded the matter for fresh consideration, including allegations of bad faith.

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

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

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

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

✓	Yes
	No

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

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

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, if any (* Word limit: 100 words or less, if possible):

The primary civil basis would be passing off, subject to establishing goodwill/reputation in Japan, misrepresentation and damage. X's prior stay at Hotel "APAA" is significant evidence of his knowledge of the mark and may support an allegation of dishonest adoption/bad faith. Mere well-known status in Monaco or other foreign jurisdictions would not, by itself, establish a claim in Japan. Any actual confusion in the Japanese market would provide additional support for the claim.

Thank you for your kind cooperation!