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 (* Word limit: 100 words or less, if possible):<br>The term 'well-known' is not expressly used in the statutory text of the Trademark Act; rather, the phrase 'widely recognized among consumers' is employed. The specific meaning thereof is defined in the Examination Guidelines. |

**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?<br><br>If the answer is yes, please identify the name of such specific system below: ( e.g., Defensive mark registration)<br>Comments:<br>- "Defensive Trademark Registration System" (Application required)<br>This system allows the registrant of a well-known mark to extend registration-based protection to dissimilar goods/services, where the mark's high level of fame makes consumer confusion likely.<br>The examination for registration includes the assessment of "well-known" status by the JPO.<br><br>*Additional reference information:<br>- "Well-Known and Famous Trademark Search" tool (JPO J-PlatPat database) (https://www.j-platpat.inpit.go.jp/t0400)<br>A database compiled ex officio by the JPO, covering defensive trademark registrations and trademarks decided well-known/famous in past opposition/appeal/trial decisions of the JPO's Appeal/Trial Board and judgements of the courts. The JPO examiners utilize it in their examinations. The database is open to the public and available to users. |

**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:<br>(i) Number of followers of SNS if they are related to the goods/services<br>(ii) The fact that the JPO granted registration of defensive trademark<br>(iii) The fact that a trademark was determined to be well-known/famous in opposition/appeal/trial decisions or court judgments (Examination Guidelines)<br>*Note: The information (ii) and (iii) are available in the "Well-Known and Famous Trademark Search" in the JPO's open database - See Section 1. 3 |

**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):
- The fact that a trademark was recognized as well-known/famous in a foreign jurisdiction through decisions/judgements of the foreign IP Offices or the foreign courts.

*Additional reference information:
- "Foreign Well-Known Trademark Information" (Examination Manual 42.119.01)
This covers trademark lists provided by foreign governments or equivalent public entities, such as those of Germany, France, Italy, China, and South Korea, which identify trademarks which are well known in their respective jurisdictions. In principle, JPO examiners presume the listed trademarks to be well-known in those jurisdictions during examination. The lists may not be publicly available to users.

**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, seemingly 70-80% |
| | 2) In the case of products for specialized markets (such as aircraft parts) | -N/A, preferably over 60% |
| | 3) In the case of services | -N/A, seemingly 70-80% |
| 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 |
| ✓ | 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 |

**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<br>→ If there is any specific trial, please indicate:<br>- "Cancellation Trial Under Article 53-2"<br>This trial system allows to cancel unauthorized trademark registrations on the ground of "filing without justifiable reasons". It aims to strengthen protection for foreign brand owners by enabling them upon request to cancel registrations improperly filed by their current or former agents or representatives. |
| ✓ | 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: )<br>*Additional reference information:<br>- Advantage granted to well-known trademark owners in assessing trademark similarity (Examination Guidelines)<br>When a third party's applied-for trademark incorporates a well-known mark in its entirety, the owner of that well-known trademark enjoys the following advantages in similarity assessment:<br><br>[The Examination Guideline]<br>In principle, a trademark that combines another person's widely recognized trademark with other characters or figures is determined to be similar to that mark. This applies even if the visual structure appears seamlessly integrated as a whole or a conceptual connection exists. However, this does not apply if |

| | |
|---|---|
| | the other person's trademark definitely forms part of a dictionary-defined word.<br>*Examples of Trademark Similarity Assessment<br>- Similar Trademarks<br>Marks: "PAOLOGUCCI" vs. "GUCCI"<br>Designated Goods: Bags<br>- Dissimilar Trademarks<br>Marks: "TOSHIHIKO" vs. "IHI"<br>Designated Goods: Metalworking machinery |

**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:)<br>From the Example Categories of the Examination Guidelines<br><br>1. Presumption of Unfair Purpose (Article 4(1)(xix)):<br>Presumed to be filed for unfair purposes if satisfying requirements (i) and (ii):<br>(i) Identity or high similarity to a trademark well known in one or more foreign jurisdictions, or widely recognized nationwide in Japan; and<br>(ii) Well-known trademark consists of a coined word or is highly distinctive.<br><br>2. Case Example from the Examination Guidelines (Article 4(1)(xix)):<br>Preemptive filing aimed at blocking a foreign trademark owner from entering the Japanese market by exploiting its unregistered status in Japan.<br><br>3. Case Example from the Examination Guidelines (Article 4(1)(vii)):<br>Trademark filing that offends a foreign nation or its citizens, or violates international good faith. |

**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):<br>Articles 4(1)(xv), (xix), and (vii) of the Trademark Act serve to protect the rights of well-known trademark owner. Since the similarity of goods/services is not a statutory prerequisite under these provisions, they can encompass dissimilar goods/services, provided that a relevant connection between the respective goods/services is established. |

**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:<br>-Free-riding (taking unfair advantage of goodwill and reputation associated with the well-known trademark) |

**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: )<br>Criminal punishment under the Trademark Act and the Unfair Competition Prevention Act |

**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: "Manhattan Portage" Case**

**Case number:** Tokyo High Court Judgment, H14 (Gyo-Ke) 593

**Date:** November 20, 2003

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

- Issue:

  Whether preemptive filing of the unregistered, foreign well-known trademark "Manhattan Portage" violates public order and morals under Article 4(1)(vii) of the Trademark Act.

- Background (Filing Process):

  The Defendant approached the Plaintiff, a U.S. brand owner, for an exclusive Japanese distribution deal, learning that the Plaintiff's well-known trademark was unregistered in Japan. Following the negotiation breakdown, the Defendant preemptively applied for the almost-identical logo trademark in bad faith. Upon registration, the Defendant asserted trademark infringement against the Plaintiff and its Japanese distributors, seeking to exclude them from the Japanese market for unfair gain. The Plaintiff then filed an invalidation trial.

- JPO Appeal Board Trial Decision:

  Dismissed the Plaintiff's invalidation request by relying on the first-to-file principle.

- Tokyo High Court Judgement:

  Overturned the JPO decision, finding bad-faith intent to free-ride on the Plaintiff's goodwill. The court invalidated the mark under public order provisions, rejecting the misuse of the first-to-file rule.

- Significance:

  A landmark precedent establishing standards to protect unregistered foreign well-known trademarks against bad-faith preemptive filings.

[Defendant's Applied Mark]




[Plaintiff's Well-known Mark]






**Case 2:**
**Title: "Alphacool" Case**
**Case number:** IP High Court Judgment, R8 (Gyo-Ke) 10008
**Date:** July 27, 2026
**Brief Summary** (* Word limit: 200 words or less)**:**

- Issue:
  Whether preemptive filing of unregistered, foreign well-known trademark "Alphacool" violates public order and morals under Article 4(1)(vii) of the Trademark Act.
- Background (Filing Process):
  The Plaintiff registered the mark "Alphacool", a globally well-known brand for computer cooling devices of the Defendant (Alphacool International GmbH, a German company) that is recognized to a certain extent in Japan. Within mere two months after publication, the Plaintiff sent a cease-and-desist letter to the Defendant's Japanese distributor. The Defendant then filed an invalidation trial.
- Decision and Judgement
  Both the JPO Appeal Board and the IP High Court decided to invalidate the trademark registration under Article 4(1)(vii), finding that the Plaintiff's preemptive filing was an improper act violating public order. The court based its ruling on the following facts:
  (i) Plaintiff was aware of the brand "Alphacool" recognized abroad.
  (ii) Over five years, Plaintiff filed as many as 80 trademarks identical with or similar to well-known foreign brands like "dyson," "roomba," and "xiaomi", triggering 9 oppositions and 7 invalidation trials.
- Takeaway:
  Mass-filing of trademarks identical with or similar to foreign well-known trademarks within a short period, and promptly seeking to enforce cease-and-desist claims against the true brand owner upon registration, was deemed a bad-faith application. This constitutes a typical case of a public order violation under Article 4(1)(vii).

[Defendant's Applied Mark]

Alphacool (in standard characters)

[Plaintiff's Well-known Mark]

Cited mark 1: ACOOL

Cited mark 2: alphacool

Cited mark 3: ALPHACOOL

**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):
- Given that Hotel APAA has not registered its trademark in Japan, they need to seek remedies under the Unfair Competition Prevention Act (UCPA).
- To seek an injunction against X's use in Japan under Article 2(1)(i) of UCPA, the hotel name of "APAA" must be recognized as well-known among Japanese consumers
- Under judicial precedents, "well-knownness" required for Article 2(1)(i) does not demand nationwide recognition, but it does require recognition across a certain regional area in Japan.
- In terms of statutory interpretation, establishing well-knownness does not require existence of actual business activities in Japan; it is sufficient if the mark's reputation abroad reaches Japanese consumers.
- However, in this specific case, it is highly likely that the mark has not gained sufficient recognition for evaluating well-knownness among Japanese consumers, leading it difficult to obtain an injunction against X's use based on the UCPA.

**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.

- Distinctiveness of slogan
- Trademark infringement litigation
- Opposition & invalidation system of trademark
- Measures to accelerate examination of the Office
- Similarity between goods/services (including similarity between products and retail/wholesale services thereof)
- Similarity between device marks
- Examination of distinctiveness of the terms in foreign languages contained in the applied mark (Foreign equivalent)

Thank you for your kind cooperation!