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):

Sri Lanka law does not contain a detailed statutory definition of a "well-known mark". However, protection is afforded under Section 104(1)(d) of the Intellectual Property Act No. 36 of 2003, which prohibits the registration of a mark that reproduces, imitates, translates, or transcribes a mark or trade name considered well-known in Sri Lanka and likely to mislead the public.

Intellectual Property Act No. 36 of 2003

The principal legislation governing Trademarks in Sri Lanka is the Intellectual Property Act No. 36 of 2003. The Act recognizes Trademark rights and incorporates protections for well-known marks consistent with international standards.

Section 104 of the Act prevents registration of a mark that;

- Reproduces, imitates, or resembles a well-known mark.
- Is likely to mislead the public.
- Creates a false connection with the owner of the well-known mark.
- May damage the interests of the owner of the well-known mark, even in relation to dissimilar goods and services.

Protection may also extend to dissimilar goods or services where use would indicate a connection with the owner and damage its interests. Sri Lanka follows the principles embodied in Article 6b is of the Paris Convention and the TRIPS Agreement.

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

While Sri Lanka does not have a separate Unfair Competition Prevention Act, protection is available through the unfair competition provisions contained in the Section 160 of the Intellectual Property Act No. 36 of 2003.

Judicial decisions and administrative practices of the National Intellectual Property Office (NIPO) also influence recognition of well-known marks.

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: There is no separate statutory mechanism through which a mark can be formally declared "well-known" independently of a dispute or registration proceeding. Recognition is generally determined case-by-case by the Director General of National Intellectual Property Office of Sri Lanka or the courts.

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

The mark relied upon should substantially correspond to the mark actually used and promoted.

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

✓	Yes
	No

Recognition is assessed in relation to the goods or services with which the mark is associated.

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 (Sri Lanka)
	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

However, foreign reputation may be relevant evidence in determining local recognition.

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?

Ceylon Cinnamon is an internationally recognized registered protected Geographical Indication (GI)

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: International Trademark registrations, Media Coverage, Evidence of enforcement in other jurisdictions, Reputation among Sri Lankan consumers traveling abroad.)

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):

Relevant evidence may include international rankings, press coverage accessible in Sri Lanka, awards, participation in international trade fairs, availability of services to Sri Lankan consumers through online platforms, international customer reviews, foreign registrations, licensing activities, bookings originating from Sri Lanka, and evidence showing that local traders were aware of the foreign mark before adopting an identical or similar mark. Such evidence may help establish that the mark has acquired at least some recognition among Sri Lankan consumers despite limited local commercial activity.

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

Section 104 provides protection to well-known marks irrespective of registration.

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

Relevant provisions : Section 104(1)(b), (c), (d), (e) and (f) of the Intellectual Property Act No. 36 of 2003.

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

Specific mechanism: Application for nullity under Section 134 where registration should not have been granted under Section 104.

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

A well-known mark may be protected even without local registration.

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

Although actual commercial use is powerful evidence, modern online exposure and recognition among Sri Lankan consumers may also be considered.

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: Unfair competition, evidence of deliberate copying)

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: Knowledge of international reputation, intentional copying of branding elements, absence of legitimate explanation for 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 104 (1) (d) permits refusal, cancellation, or invalidation of registrations for dissimilar goods or services where the mark is well known, use would suggest a connection with the owner of the well-known mark, and such use is likely to damage the owner's interests. Protection therefore extends beyond identical goods where the requisite reputation, connection, and likelihood of harm can be 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:)

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: Use or sufficient recognition in Sri Lanka is generally important to establish entitlement to relief)

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: Use or sufficient recognition in Sri Lanka is generally important to establish entitlement to relief)

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: Registered rights (if available)

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: DD IP Holder LLC (Dunkin' Donuts) V. Sri Lankan Bakery Entrepreneur
Case number: (Colombo HC/Civil/26/2014/IP)
Date: August 2020
Brief Summary (* Word limit: 200 words or less)**:**

The Commercial High Court dismissed an infringement and unfair competition action filed by Dunkin' Donuts against a local bakery using the "Munchkin"/ "Munchkins" mark for bakery item.
The court ruled that foreign brand reputation is insufficient in Sri Lanka: a foreign brand must prove that its unregistered mark is WELL-KNOWN to a substantial sector of the local purchasing public in Sri Lanka at the time the local defendant enter the market.

After inquiry the court granted an interim injunction in favor of the defendant. Meanwhile the Plaintiff informed the court to withdraw the proceedings. The court proceeded to give judgement in favor of our client confirming her exclusive rights to the mark.

Case 2:
Title: Viacom International Inc. V. The Maharaja Organization Ltd & Director General of Intellectual Property
Case number: (SC/CHC/APEAL/28/2003)
Date: June 2021
Brief Summary (* Word limit: 200 words or less)**:**

Viacom International Inc. (owner of the international "MTV" brand) challenged the registration of the "MTV Music Television" mark by The Maharaja Organization Ltd. in Sri Lanka

The dominant element of the two marks- MTV- is literally, phonetically and visually similar such as to cause confusion 46 in the mind of the public and trade circles *inter alia* as to the source of the services offered under each mark in that it could create the erroneous impression that the 1st Respondent's services are the services of the Appellant or vice versa or that there is a connection between the 1st Respondent and the Appellant in terms of services whereas they are in fact competitors.

The Supreme Court allowed the appeal and set aside the Commercial High Court judgment. It ruled that the dominant element "MTV" was identical or confusingly similar, creating public and trade confusion as well as unfair competition.

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 jurisdictio n, assuming the same factual circumstances occurred in your country (replacing Sri Lanka / Colombo 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

A nullity under Section 134 and reliance on Section 104 would be available.

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 (Sri Lanka), and filed for identical or similar goods or services
✓	A trademark likely to cause confusion with a trademark well-known **both** in the country (Sri Lanka) 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

Online reservations accessible from Sri Lanka, targeted advertising, and actual bookings by Sri Lankan consumers would support an argument that the mark is used and known in Sri Lanka, although the level of recognition may be modest.

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):

Although Hotel APAA's recognition in Sri Lanka appears limited, evidence that the hotel marketed directly to Sri Lankan consumers, accepted reservations from Sri Lanka, and had actual Sri Lankan guests could help establish a protectable reputation. X's prior stay at the Monaco hotel strongly supports an inference of bad faith and knowledge of the mark. Combined with Section 104 protections, unfair competition principles, and passing off remedies, Hotel APAA would have a reasonable basis to seek invalidation of the registration and restrain continued use of the mark in Sri Lanka.

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.

Protection of Trademarks in the Digital Marketplace: AI- Generated Branding, Social Media Influencers, Virtual Goods, Metaverse Use, and Cross-Border Enforcement Challenges."

Thank you for your kind cooperation!