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:
A well-known trademark is one that has acquired such a reputation that it has become generally known to all those – producers, traders or potential consumers – who are most closely associated with the product and is recognized as such. Sometimes, this reputation reaches such a level that the product which the trademark is intended to distinguish comes to be generically referred to by the trademark, regardless of its origin or producer.

Article 214 (Grounds for refusal of registration) of the Industrial Property Code (DL 97/99/M): 1. Registration of the trademark shall be refused if: (…)
b) An essential part of the trademark constitutes a reproduction, imitation or translation of another that is well-known in Macao, if applied to identical or similar products or services and with which it can be confused, or if those products could establish a connection with the proprietor of the well-known trademark;
c) The trademark, although meant for products or services with no connection, constitutes a reproduction, imitation or translation of a previous trademark that enjoys prestige in Macao,

| |
|---|
| and whenever the use of the subsequent trademark tries to derive improper advantage or prestige from the distinctive character the trademark or could harm such character or prestige. |

**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>No<br>If the answer is yes, please identify the name of such specific system below: ( e.g., Defensive mark registration)<br>Comments: |

**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:<br>(Please specify, if any: A trademark may be recognized to have acquired well known status provided that it has achieved a certain degree of recognition or general awareness among producers, traders, or consumers who are most closely associated with the product to which the trademark relates; it is |

| | |
|---|---|
| | sufficient that the trademark has become particularly well-known among the group of people commonly referred to as the "relevant public.") |

**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.

| |
|---|
| Awareness of the popularity and quality of a product originating from another territory should not be limited to Macau residents, but to the entire audience that comes here, not to mention the millions of visitors to Macau—including the percentage of tourists from abroad—and, as is evident, a portion of Macau's residents who visit that region and who will undoubtedly be aware of the success, quality, and impact of that brand. |

**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 |
| | 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.** Thro\\\\ugh 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>( ) |
| | 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: ) |

**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: ) |

**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): |

**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: ) |

**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:** ***ARTFEM***
**Case number: 860/2023**
**Date: 01/02/2024**
**Brief Summary:**
To assess whether a trademark is well-known, one may refer to the criteria set out in the Joint Recommendation of the Assembly of the Paris Union and the General Assembly of WIPO –

| |
|---|
| Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, Geneva, 2000, namely:<br>a) – The degree of recognition of the trademark amongst the relevant public;<br>b) – The duration, extent and geographical scope of the trademark's use;<br>c) – The duration, extent and geographical scope of the trademark's promotion, including advertising and the display at trade fairs and exhibitions of the goods and/or services to which the trademark applies;<br>d) – The duration and geographical scope of any registrations and/or applications for registration of the trademark, insofar as they reflect the use or recognition of the trademark.<br>Having regard to the established facts which support the view that the trademark is a well-known trademark in Macau and further considering that the trademark now registered is capable of creating the risk of consumer association regarding the commercial origin of the goods, this constitutes unfair competition under Article 159 of the Commercial Code, that is to say, any act likely to create confusion with the business or products of competitors. |
| **Case 2:**<br>**Title: a well-known and prestigious brand**<br>**Case number: 305/2010**<br>**Date: 06/03/2014**<br>**Brief Summary**:<br>- For a trademark to be classified as well-known and prestigious, it must have achieved a certain level of recognition amongst the public. Furthermore, it must also have an image of above-average quality; in other words, it must have a good name or reputation.<br>- Indeed, in order to satisfy the relevant requirements, the burden of asserting and proving the constituent facts lies with the trademark proprietor.<br>- As the trademark has not been previously registered in Macau and the trademark's renown and prestige have not been proven, the appeal must be dismissed. |

**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): |

**IV. Ideas for Next Special Topic**

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

Thank you for your kind cooperation!