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):

Well-known trademark means any trademark that is well-known in Malaysia and that belongs to a person who is (a) a national of a Convention country or (b) is domiciled, or has a real and effective industrial or commercial establishment, in a Convention country, whether or not that person carries on business, or has any goodwill, in Malaysia. (see: Section 4 of Malaysian Trademarks Act 2019).

In determining whether a trademark is well-known in Malaysia, the Registrar or the Court shall have regard to the following criteria:
(a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;
(b) the duration and extent, and geographical area of any use of the trademark;
(c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out;

(d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark; (e) the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and (f) the value associated with the trademark. (see: Regulation 5, Trademarks Regulations 2019)

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 Comments: Not infringement litigation per se, but our TM Act 2019 provides for the proprietor of a well-known trademark to seek injunctive relief to restrain the use in Malaysia, in the course of trade, or any trademark which, or an essential part of which, is identical or similar to the proprietor's trademark in relation to identical or similar goods or services; or in relation to any goods or services where the use would indicate a connection between those goods or services and the proprietor and is likely to damage the interests of the proprietor. (see: Section 76, Trademarks Act 2019)
	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:

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: record of successful enforcement of rights in the trademark, value associated with the trademark, number of registrations/application and the duration)

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) Evidence of unsolicited request from potential licensees, manufacturers, distributors, importers, retailers, consumers and other third parties;
(ii) applications/registration in numerous foreign countries;
(iii) proof of enforcement of rights against infringers in other countries;
(iv) participation in exhibitions or trade fairs (duration and extent)

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 (See: Sections 24(3) and 34(2)(c) of the TM Act 2019)
✓	A trademark likely to cause confusion with a trademark well-known in your country (See: Section 23(5) of the TM Act 2019)
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country (See: Section 23(5) of the TM Act 2019)
	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 (See: Section 24(3) and 34(2)(c) of the TM Act 2019)
✓	A trademark filed in bad faith (See: Section 17 of the TM Act 2019)

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 (see

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): (1) the use of the trademark in relation to the dissimilar goods or services would indicate a connection between those goods or services and the proprietor of the well-known trademark (2) there exists a likelihood of confusion on the part of the public because of such use; and (3) the interests of the proprietor of the well-known trademark are likely to be damaged by such use.

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 (if the well-known mark is registered or the claim is premised on passing off)
	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: Tokai Corporation v DKSH Malaysia Sdn Bhd [2016] MLJU 621
Case number: 24IP-45-11/2015
Date: 1 September 2016
Brief Summary (* Word limit: 200 words or less)**:**

The Plaintiff, a Japanese corporation, is one of the world's leading manufacturers, suppliers, distributors and exporters of disposable cigarette lighters, cigarette filters, smoking articles and apparatus. The Plaintiff had registered the trademark TOKAI all over the world except in Malaysia. The TOKAI trademark was registered in Malaysia by Tokai Cigarlite, a joint venture company between the Plaintiff and Texchem Corporation Bhd. Tokai Cigarlite was dissolve in 1999. The TOKAI trademark registered by Tokai Cigarlite was assigned to Fumakilla. Subsequently, the said trademark was assigned to Texchem Consumers, and finally, the trademark was assigned to the Defendant.

The Plaintiff commenced an action seeking a declaration that the assignment to the Defendant was a wrongful entry and that the Plaintiff is the legal and beneficial owner of the trademark. In the alternative, the Plaintiff sought a declaration that there has been no use in good faith by the Defendant and that the Registrar rectifies the Register by expunging the Defendant as the registered proprietor and entering and recording the Plaintiff in substitution as the registered proprietor, or alternatively expunging and removing the Registration from the Register. The Plaintiff was unsuccessful.

On the issue of whether the Plaintiff's "TOKAI" trademark is a well-known trademark, the Judge found that the Plaintiff failed to discharge the legal onus to prove that TOKAI was a well-known mark of the Plaintiff in Malaysia as the Plaintiff did not adduce documentary evidence to support the criteria for well-known trademark as set out in the TM Regulations.

Case 2:
Title: PIRELLI & C SpA v. CHIP HWA SDN BHD [2023] 5 MLRH 584
Case number: WA-22IP-73-11/2020
Date: 13 June 2023
Brief Summary (* Word limit: 200 words or less)**:**

The Plaintiff is the registered proprietor of 24 trademarks in Malaysia in Classes 7, 9, 10, 12,

14, 16, 17, 18, 20, 21, 24 and 28 consisting of the word “PIRELLI” or the stylised word Pirelli with an elongated letter P over the letters “irelli”.



The Defendant has a registered trademark in Class 25 consisting of the stylised word PIRELLI and a horse device.



The Plaintiff sought a declaration that its trademarks are 'well-known' and entitled to statutory protection; that the Defendant has committed passing off; that the Defendant's mark should be revoked for non-use and that the Defendant's mark should be invalidated for fraud, likelihood of confusion, or lack of distinctiveness.

The Plaintiff was unsuccessful in its case.

In so far as it relate to the declaration that the trademarks were “well-known”, the Judge found that the Plaintiff failed to provide evidence that its marks were well-known in Malaysia, particularly in relation to Class 25 goods (clothing, etc.) for which the Defendant's mark is registered, relying instead on evidence focused on other industries and insufficient proof of local recognition or sales.

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!