APAA 2026, Hong Kong

Trademarks Committee – Special Topic

Challenges in Protecting Well-Known Marks Across Jurisdictions

NEW ZEALAND REPORT

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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**.**

New Zealand

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

Section 1: Definition

1. Does your country (**New Zealand**) 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" *is* not defined in the Trade Marks Act 2002, albeit it is used in ss 25(1)(c) and 89(1)(d)). Instead, the local courts have interpreted it. For example in *Daimler v Sany*, the High Court held the threshold is higher than the "sufficiently substantial reputation" required under s 17(1)(a). "Well known" is also not synonymous with "iconic". Iconic marks qualify, but the standard is lower than that. Courts apply a test similar to passing off's reputation element, requiring knowledge only within the relevant sector of the public. There have also been references to what a well known trade mark is in various cases (e.g. *Crocodile International Pte Ltd v Lacoste*) but no definitive definition has been applied. Instead, the courts have indicated it is largely a factual consideration and to be decided on a case-by-case basis.

See Daimler v Sany Group Co Limited [2014] NZHC 532 [21 March 2014] at [64] - [68]

See Crocodile International Pte Ltd v Lacoste [2017] NZSC 14 [21 February 2017]

2. Are there any laws or standards, other than trademark law, concerning the recognition of well-known trademarks?

✓	Unfair Competition Prevention Act – Fair Trading Act 1986, Passing Off
	Decisions of the Trial and Appeal Department of the Intellectual Property Office- No (IPONZ)
✓	Court Decisions
✓	Doctrines adopted by the courts

Notes

- IPONZ decisions that touch on it outside the context of a registration/opposition context;
- Any NZ court decisions where the concept of a name or mark being "well-known" has come up outside of trade mark law (i.e. defamation cases or cases involving celebrity names), and
- Any doctrines NZ courts have adopted or applied when assessing "well-known-ness" in those contexts.

In short, there is limited relevancy, noting where the issue was considered were in domain names being used as trade marks, and cases to do with a well-known defendant who did not want their name published.

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) A New Zealand court can make a declaration that a mark is "well known" under the Trade Marks Act 2002. Historically, New Zealand had a defensive trade mark registration system under the Trade Marks Act 1953, but this was abolished by the Trade Marks Act 2002, which instead introduced the concept of well-known marks (sometimes still referred to informally as "famous marks" in case law). IPONZ may raise an objection to registering a mark on the basis that it is well known, for example if someone tried to register ROLLS ROYCE for cars or STARBUCKS for coffee, IPONZ would likely object as a matter of common sense. In such scenarios, a party could base an opposition on being

	the owner of a well-known mark or defend a proceeding on the basis that its own mark is well-known. Where a mark was not registered by its true owner, invalidation can be sought on similar grounds (i.e. bad faith), and for the same reasons a party could also file trade mark infringement proceedings on the basis of well-known mark status.

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.)

Note: there is no formal registration systems for well-known trade marks in New Zealand. Hence, all responses in this section are N/A. However, we thought it would be useful to nevertheless provide some guidance in the context of enforcement only. In practice, a trade mark owner would have to have the trade mark declared as a well-known trade mark by the High Curt and use that to assist with enforcement against another mark based on your mark being well-known.

1. Is the identity between the trademark claimed to be well known and the trademark actually used strictly examined?

	Yes
✓	No

This question presupposes a system under which a trade mark can be formally registered or recorded as well known, so that the mark as used can be compared against the mark as registered for identity. New Zealand has no such registration system for well-known marks, so this question is not strictly applicable. There is no separate filing or register against which the identity of the mark as used would be assessed. Instead, well-known status is only ever assessed as part of enforcement, usually in relation to deception and misleading consumers so it is unlikely that a strict examination of the trade mark would be relevant.

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

✓	Yes
	No

Whether the trade mark is well known in New Zealand is usually evaluated in relation to the specific goods and services it used and/or the industry sector it is traded. However, legal protection can extend well beyond the goods and services it is used.

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

Under s 25(1)(c) the mark has to be well known in New Zealand to be protected. For protection under the Fair Trading Act 1986, the mark does not have to be used in NZ. However, a trade mark does have to have sufficient reputation in New Zealand that use of the conflicting mark would be likely to mislead or confuse consumers (FTA) and for a claim in passing off there has to be actual use of the mark in New Zealand and sufficient "spill over reputation" however, this is a lower threshold of reputation than being "well known" in New Zealand.

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: In practice, there are many different factors which would be considered, and a combination of the above would be helpful in considering whether a trade

	mark can be considered "well known". However, what is considered will in practice be determined on a case by case basis. Some other factors that may be considered which are not listed above include, the value associated with the mark, the goods and services it is used (e.g. high-end luxury goods) and the extent to which the mark has been found to be well known in similar jurisdictions

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):
References to the mark in media (and, for overseas publications, their circulation in NZ); NZ subscriber numbers and revenue; app or service download numbers; partnerships with NZ brands; export figures and NZ retail outlet numbers; the esteem or image the mark enjoys; substantial advertising in foreign magazines circulated in NZ and aimed at relevant consumers; the nature and size of the relevant market; actual NZ advertising (not just catalogue references); the mark's presence in pop culture, including music and entertainment; and association with other well-known, internationally reputable brands; the number of paid monthly subscribers in New Zealand and revenue generated; the number of monthly downloads of an app or other service

Cases:
Stefanel Next Pty Ltd v Next Retail Ltd IPO T15/2006, 10 July 2006.
Lacoste v Crocodile International Pte Ltd HC Wellington CIV-2009-485-2536, 1 March 2011 [22]
Zoggs International Ltd v Sexwax Inc [2013] NZHC 1494
Martin Joseph Peter Myers v GSM (NZ Operations) Ltd [2008] NZIPOTM 35
São Paulo Alpargatas SA v But Fashion Solutions Comercio E Industria De Artigos EM Pele

Lda (High Court Wellington, CIV 2010-485-2473, 5 July 2011

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		

While there is no mandatory practice, consumer survey evidence has been used and considered in multiple New Zealand well-known trade mark and reputation disputes (e.g. *Lacoste v Crocodile International*, *Red Bull v Drink Red*, *Bed Bath 'N' Table*). In practice, if you are trying to get a court declaration that your mark is well known, you would most likely need a consumer survey to corroborate a claim of well-knownness.

No case distinguishes a different standard or percentage threshold for consumer goods versus specialised goods versus services; when assessing whether a mark is well known the different factors are assessed by reference to the relevant interested public for the particular goods or services, which can make the degree of persuasion needed vary with the size of that public, but this is not formalised into separate tests or thresholds.

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 – Trade Marks Act 2002, s 25(1)(c)
✓	A trademark likely to cause confusion with a trademark well-known in your country – Trade Marks Act 2002, s 17(1)(a) (likely to deceive or cause confusion) and 17(1)(b) (contrary to NZ law). Note these bring in Fair Trading Act, s 9
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country – Trade Marks Act 2002, s 25(1)(c)
✓	A trademark likely to cause confusion with a trademark well-known only in a foreign country - Trade Marks Act 2002, s 17(1)(a) and 17(1)(b); Fair Trading

	Act, s 9
✓	A trademark filed with an unfair purpose that would harm the interest of the owner of the well-known trademark - Trade Marks Act 2002, s 17(1)(b) and s 17(2); Fair Trading Act, s 9
✓	A trademark filed in bad faith - Trade Marks Act 2002, s 17(2)

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

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 (examples: proof of a lack of intention to use the mark in relation to the goods and services, proof of previous employment by owner of a similar mark, any conduct falling short of reasonable standards of commercial behaviour.)

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):

S 17(1)(a) – if the application is likely to deceive or cause confusion with the well-known mark

S 17(1)(b) – if the application would be contrary to New Zealand law or would otherwise be disentitled to protection in any court, for example it is in breach of the Fair Trading Act or Passing Off.

S 17(2) – if the application is made in bad faith

S 25(1)(c) – if the application would be taken as indicating a connection in the course of trade between those goods and services in the application and those of the owner of a well-known mark in New Zealand, and would be likely to prejudice the owner of the well-known mark.

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) The Trade Marks Act provides the High Court with very wide discretion to grant remedies based on what the court thinks is fit and would protect the owner of the trade mark. In theory, such an order could be made by the High Court.
	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: Under s 108 the Court may order the erasure, removal, or obliteration of the offending sign from any infringing goods, material, or object in the possession, custody, or control of the infringer. If this is not reasonably practicable, the Court may order the destruction of the infringing goods, material, or objects. Notably, if the infringing goods are counterfeit, the Court must, unless there are exceptional circumstances, order their destruction or delivery to someone who will destroy them. Additionally, s 154 empowers the court in proceedings for infringement involving counterfeit goods or goods bearing infringing signs, to order the goods be destroyed, forfeited, or otherwise dealt with as the court thinks fit)

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: Planet Fitness Ltd v PFIP International, LLC
Title: *Planet Fitness Ltd v PFIP International, LLC* [2024] NZHC 2745
Case number: CIV-2024-485-000213
Date: 25 September 2024
Brief Summary (* Word limit: 200 words or less)**:**

Planet Fitness Ltd, a New Zealand company, applied in 2019 to register PLANET FITNESS, a mark not yet registered in New Zealand. PFIP International, LLC, the international (US-based, "principally located in the northern hemisphere") operator of the global Planet Fitness gym chain, opposed on the basis of its international use and reputation (referred to as a "one of the most well-known gym brands in North America" at [85]). The New Zealand applicant was the "first registrant," and the dispute was over whether the overseas brand's reputation reached a sufficient (not necessarily high) threshold in New Zealand to block it: the Commissioner found the respondent did not claim actual use in New Zealand but relied on its global reputation, and that only a "not insignificant" (not high) level of New Zealand awareness, principally derived from website visit analytics, was sufficient to meet the s 17(1)(a) threshold. The High Court agreed the opposition succeeded on that modest threshold, and separately allowed PFIP's cross-appeal finding the New Zealand applicant's registration was made in bad faith, intended to block the overseas competitor's entry into the New Zealand market rather than for genuine use.

Case 2:
Title: *Comité International Olympique v Tempting Brands Netherlands B.V.* [2019] NZHC 2476
Case number: CIV-2019-485-177
Date: 30 September 2019
Brief Summary (* Word limit: 200 words or less)**:**

The International Olympic Committee (IOC) appealed an Assistant Commissioner decision rejecting its opposition and granting Tempting Brands Netherlands B.V. (TBN), a Dutch brand-creation company, registration of PIERRE DE COUBERTIN in New Zealand, TBN having priority from a 22 June 2015 Benelux filing. IOC's use of the mark was essentially overseas, merchandise at its Lausanne Olympic Museum, a medal awarded to All Black Tana Umaga, and use by foreign National Olympic Committees, and it had never registered or used the mark in New Zealand, arguing instead that New Zealanders would have gained awareness through this overseas exposure. The Assistant Commissioner found insufficient New Zealand market awareness to meet the s 17(1)(a) reputation threshold, since the usual evidence (local sales, advertising spend, promotional uptake) was absent. The High Court agreed on appeal, holding that overseas publications and events did not establish the requisite New Zealand awareness. IOC's claims under passing off and bad faith also failed for lack of evidence of New Zealand goodwill or improper exploitation.

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.

Applying the above to a New Zealand context the following grounds could be pursued:

Hotel APPA would seek a declaration of invalidity to invalidate X's registration under s 73(1) of the Trade Marks Act 2002, on the basis that Hotel APAA is an aggrieved person and that the registration was not registrable at the time of registration, on the following grounds:

1. Under s 17(1)(a), the registration of "APAA" by X is likely to deceive or cause confusion, given Hotel APAA's prior reputation in the mark, the niche market channel (high end affluent travelers), and the proof of guests from Japan.
2. Under s 17(1)(b), the registration is contrary to law, including as being likely to mislead or confuse consumers in breach of s 9 of the Fair Trading Act 1986, and as amounting to the tort of passing off.

3. Under s 17(2), the application was made in bad faith, given X had stayed at Hotel APAA in Monaco three years before filing and used an identical mark for a closely related service.
4. Under s 25(1)(c), on the basis that "APAA" is well known in New Zealand in connection with "provision of hotel accommodation," and X's use of an identical mark for the same and related services would be taken as indicating a trade connection with Hotel APAA and would be likely to prejudice Hotel APAA's interests.

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

A foreign business does not have to have a physical presence in New Zealand to establish reputation or goodwill here. The bar for well-known-ness under s 25(1)(c) is higher than mere awareness under s 17(1)(a) and can be established through advertising "or otherwise". The degree of reputation required has been held to be similar to that required for passing off: in *Daimler v Sany Group Co Ltd* [2014] NZHC 532, the High Court held that the "well known" threshold under s 25(1)(c) is higher than the "sufficiently substantial reputation" required under s 17(1)(a), a finding the Court of Appeal affirmed in *Daimler AG v Sany Group Co Ltd* [2015] NZCA 418.

Here, the hotel's reputation and goodwill is confined to a very small, niche segment of affluent travellers (around 20 Japanese guests a year), rather than being widespread and well established among the New Zealand public generally. The relevant question is whether a niche market changes the analysis: in *Sexwax Inc v Zoggs International Ltd* [2014] NZCA 311, the Court of Appeal accepted that the nature of the goods or services and the relevant market affect the inquiry, so that for niche or specialised markets, reputation among a smaller, targeted group of consumers can suffice. However, that authority goes to the lower s 17(1)(a) threshold. Section 25(1)(c) "well known" status demands more: given the very low guest numbers and narrow channel here, the hotel is unlikely to clear that higher bar, even allowing for a niche-market readjustment of the relevant public.

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

✓	Yes
	No

Yes it is likely, because under s9 of the FTA no person shall in trade engage in conduct that is misleading or deceptive or likely to mislead or deceive.

The registration could also be invalidated under s 17(1)(b) (contrary to law) if the evidence shows that the services are similar enough to mislead customers in New Zealand. It is relevant that providing and food and beverages is typically the suite of services offered by a hotel (i.e. bar and restaurant and services as well as the provision of room service).

Potentially the guests, as a small niche market, could be misled into thinking that the APAA Hotel is providing food and beverage services in New Zealand, especially if X's restaurant services are high end and connected to a restaurant. In *Sexwax Inc v Zoggs International Ltd* the court held that the nature of the goods or services and the relevant market may affect the inquiry. For niche or specialised markets, reputation among a smaller, targeted group can suffice.

Additionally, there could also be a valid argument of bad faith under s 17(2) based on X's visit to the APAA hotel.

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):

Well-known status of a trade mark abroad, by itself, is not a free-standing legal basis for a claim in New Zealand. The case law is consistent that mere foreign reputation, without a sufficient New Zealand footprint or nexus, is not enough. For example, in *Red Bull New Zealand Ltd V Drink Red Ltd* [2016] NZCA 373 intentional exploitation of a well known trade mark overseas strengthened an FTA/passing-off claim, but the underlying cause of action still required NZ-based reputation or goodwill.

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.

Extension of trade marks rights to personal/image rights: with the globalization of professional sports (e.g. NFL) and the increasing reliance on personal/image rights of athletes in a sport to generate revenue for the sports leagues, the professional associations and the athletes themselves (e.g. Ronaldo and Messi for football, Tiger Woods for golf, Michael Jordan for basketball and Aryton Senna for Formula 1), should trade mark rights be extended to provided special rights for athletes? Note the same can apply to singers, actors and celebrities.

Indigenous trade mark rights: What, if any, trade mark laws/special protections/considerations are available in your country to protect indigenous persons trade mark rights, especially when those rights may be attributable to an indefinite group rather than a legally recognised legal entity.

Thank you for your kind cooperation!