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 (* Word limit: 100 words or less, if possible):

The Intellectual Property Code does not provide a specific definition of what a "well-known" mark is. However, Section 123.1(e) of the Code provides that in assessing whether a mark is well-known, consideration should be given to the knowledge of the relevant sector of the public, including recognition in the world and in the Philippines gained through the mark's promotion.

A rough definition was provided in IPOPHL Memorandum Circular No. 2025-009 or the Rules and Regulations for the Declaration and Creation of the Register of Well-Known Marks ("2025 Regulations on Well-Known Marks"). Particularly, Rule 2(f) of the 2025 Regulations provide that a "Well-Known Mark" means a mark declared by the competent authority to be well-known based on the criteria laid down in the IP Code, Supreme Court issuances, and these Regulations.

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? If the answer is yes, please identify the name of such specific system below: (e.g., Defensive mark registration) Comments: As mentioned above, the Intellectual Property Office of the Philippines (IPOPHL) released in April 2025, the 2025 Regulations on Well-Known Marks".

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) Additional Comment: The Philippine IP Code provides that it has to be well-known in the Philippines **and** worldwide.
	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: The following criteria or any combination thereof may be taken into account in determining whether a mark is well-known, **but letters (a), (b), (c), and (d) must be included:** a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies; c) the degree of the inherent or acquired distinction of the mark; d) the quality, image, or reputation acquired by the mark; e) the extent to which the mark has been registered in the world; f) the exclusivity of registration attained by the mark in the world; g) the extent to which the mark has been used in the world; h) the exclusivity of use attained by the mark in the world; i) the commercial value attributed to the mark in the world; j) the record of successful protection of the rights over the mark; k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark, if any; and, l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that their mark is a well-known mark

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 Additional Comment: According to jurisprudence, these may be in the form of a website page displaying: (a) a local contact phone number; (b) a specific reference that is available to local customers; (c) a specific local webpage, whether domestic language and currency is used and/or if domestic payment methods are accepted.
	Posts by third-party influencers who are not users of the trademark for which well-known status is claimed Additional Comment: It is not influencers, but more on the personality promoting the trademark and their reach in social media.

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):

Please refer to "Question (6) – Others"

The following criteria or any combination thereof may be taken into account in determining whether a mark is well-known, **but letters (a), (b) , (c), and (d) must be included:**

a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
c) the degree of the inherent or acquired distinction of the mark;
d) the quality, image, or reputation acquired by the mark;
e) the extent to which the mark has been registered in the world;
f) the exclusivity of registration attained by the mark in the world;
g) the extent to which the mark has been used in the world;
h) the exclusivity of use attained by the mark in the world;
i) the commercial value attributed to the mark in the world;
j) the record of successful protection of the rights over the mark;
k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark, if any; and,
l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that their mark is a well-known mark

	As you may note from above, the Philippines require certain criteria/evidence to be submitted in evaluating whether a mark may be declared as well-known.

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		

Additional Comment: While consumer surveys are not *per se* required, they are highly recommended to be submitted to prove the following factors:

a. the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
b. the degree of the inherent or acquired distinction of the mark; and
c. the quality, image, or reputation acquired by the mark

It is noted from the above answer that these factors are **required to be established** to declare a mark well-known.

Part B: Protection of "Well-Known Marks" by Preventing or Extinguishing Third Party's Registration

1. Are there any provisions in the Trademark Act under which an unregistered well-known trademark can prevent, invalidate or cancel another party's trademark registration?

✓	Yes
	No

2. If your answer to Question 1 above is YES, what types of a third party's trademark applications/registrations can be prevented from being registered or eliminated? Please select all that apply from the following, and if possible, indicate the relevant legal provisions.

✓	A trademark identical or similar to an unregistered trademark that is well-known in your country, filed or registered for identical or similar designated goods or services
✓	A trademark likely to cause confusion with a trademark well-known in your country
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country
	A trademark likely to cause confusion with a trademark well-known only in a foreign country

✓	A trademark filed with an unfair purpose that would harm the interest of the owner of the well-known trademark
✓	A trademark filed in bad faith

3. Through what mechanisms can a third party's preemptive filing, misappropriated filing, filing by a former agent, bad-faith filing, etc. be prevented from being registered or removed after registration?

✓	Examiners' *ex officio* rejection (Office Action)
✓	Third Party Observation
✓	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:) Section 123.1 (a) of the Philippine IP Code provides that a mark may not be registered if it **falsely suggests** a connect with an institution or person. This ground may be raised both during *ex officio* examinations and/or opposition/cancellation proceedings. This ground is different from bad faith

	and/or prior knowledge of the mark. Further, Section 169 of the IP Code also prohibits any act which leads to the **false designation of origin of the goods or service**. The IP Code provides for a remedy in case the use of mark in connection with any goods and/or services is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. The prohibition also extends to commercial advertising or promotion which misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities.

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 Philippine jurisprudence has defined the meaning of "bad faith" in trademark applications/registrations. The Philippine Supreme Court stated that "[b]ad faith means that the applicant or registrant has knowledge of prior creation, use and/or registration by another of an identical or similar trademark. In other words, it is copying and using somebody else's trademark. Fraud, on the other hand, may be committed by making false claims in connection with the trademark application and registration, particularly, on the issues of origin, ownership, and use of the trademark in question, among other things." It also clarified that the presence of bad faith is a **question of fact** which must be established by evidence. (Zulueta v. CYMA Greek Taverna Co., G.R. No. 205699, 23 January 2023) In past cases, and apart from the examples cited above, badges of bad faith include, using the domain name of the owner of the well-known mark.

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):

The following factors are considered:

1. Prior Philippine Trademark registration;
2. Well-known status (Philippines and abroad) and whether the mark is registered in the Philippines.
3. Use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark:
4. Interests of the owner of the registered mark are likely to be damaged by such use. (NOTE: **Registered** well-known marks are protected against dissimilar goods/services as long as the **connection between the marks** and likelihood of damage to the interests of the prior registrant are 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) NOTE: This is possible but through a settlement agreement rather than legal intervention.
✓	Customs border measures
	Others (please specify: (1) Search and Seizure Action (2) Administrative Visitation conducted by the IPOPHL's Enforcement Office

3. In order to obtain the legal protection listed below, is it necessary for the well-known trademark to be used in your country? Comment: It is not required, however, it will increase the chances of prevailing in the action.

	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: False designation of origin [Section 169 (a) of the IP Code] ; falsely suggesting a connection with persons, living or dead, institutions, beliefs [IP Code, Sec. 123.1])

5. If there are any case 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: *Fredco Manufacturing Corporation v. President and Fellows of Harvard College (Harvard University)*

Case number: G.R. No. 185917

Date: 01 June 2011

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

Fredco Manufacturing Corporation (Fredco) filed a Petition for Cancellation against the Respondents. Fredco alleged that the mark "Harvard" for t-shirts, polo shirts, sandos, briefs, jackets and slacks was first used in the Philippines on 2 January 1982 by New York Garments Manufacturing & Export Co., Inc. (New York Garments), a domestic corporation and Fredco's predecessor-in-interest. The trademark application for "Harvard" was issued its Certificate of Registration on 12 December 1988.

The Supreme Court denied Fredco's petition, stating Fredco's registration of the mark "Harvard" and its identification of origin as "Cambridge, Massachusetts" **falsely suggest** that Fredco or its goods are connected with Harvard University, which uses the same mark

"Harvard". Fredco's registration of the mark "Harvard" should not have been allowed. The Court ruled that "Harvard" is the trade name of the world-famous Harvard University, and it is also a trademark of Harvard University. Under Article 8 of the Paris Convention, as well as the Trademark Law, Harvard University is entitled to protection in the Philippines of its trade name "Harvard" even without registration of such trade name in the Philippines. "Harvard" is a well-known name and mark not only in the United States but also internationally, including the Philippines.

Case 2:
Title: ECOLE DE CUISINE MANILLE (CORDON BLEU OF THE PHILIPPINES), INC.
Case number: G.R. No. 185830,
Date: 05 June 2013
Brief Summary (* Word limit: 200 words or less)**:**

Cointreau filed a trademark application for the mark "LE CORDON BLEU & DEVICE". Petitioner Ecole filed an opposition, arguing it is the rightful owner of the subject mark, claiming that it was the first entity that used the same in the Philippines. Cointreau filed its answer claiming to be the true and lawful owner of the subject mark.

The Court pointed out that Ecole had no certificate of registration over the subject mark but only a pending application, and it was filed after Cointreau filed its application for specifications falling under different classes in 1990. Even if Ecole was the first to use the mark in the Philippines, it cannot be said to have validly appropriated the same.

At the time Ecole started using the subject mark, the same was already being used by Cointreau aboard, of which Ecole's directress was fully aware, being an alumna of the latter's culinary school in Paris, France. Ecole cannot claim ownership over the subject mark as Cointreau is the true and lawful owner. **The Court ruled that foreign marks which are not registered are still accorded protection** against infringement and/or unfair competition, in view of the foregoing obligations under the Paris Convention.

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** **Note:** To invoke this ground, it must be established that the well-known status

	abroad has “spilled over” in the jurisdiction where the action is filed (Philippines, in this case). Kindly note, however, that this theory has yet to be tested.
	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 **Note:** While the availability of the mark in the Philippines may be established for purposes of complying with the “use requirement” in the country, such small number bookings (standing alone) may not be sufficient to establish the well-known status of the mark as the Regulations require a higher form of evidence.

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?

Note: As long as the required criteria in the Regulations are established, however, the factual circumstances om the hypothetical case above appear to be lacking in such aspect. The most applicable ground would be to establish **bad faith through prior knowledge of the mark.**

✓	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* *depends on the evidence to be submitted because if the mark is not well-known in the Philippines but well-known abroad, the threshold to determine the well-known status abroad (to conclude that the reputation spilled over the Philippines) may be higher.
✓	Allegation of the other party's bad faith
✓	Actual confusion in the market
	Others (please specify: False designation of origin [Section 169 (a) of the IP Code] ; falsely suggesting a connection with persons, living or dead, institutions, beliefs [IP Code, Sec. 123.1])

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.

Registering designs and copyright as trademarks to obtain a "perpetual" registration.

Thank you for your kind cooperation!