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

Pursuant to section 2(1) of the Trade Marks Act 1998 ("**TMA**"), a "well known trade mark" means –

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who (i) is a national of a Convention country; or (ii) is domiciled in, 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 Singapore.

Pursuant to section 2(7) of the Trade Marks Act, whether a trade mark is well known in Singapore, it is relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
(b) the duration, extent and geographical area of —
(i) any use of the trade mark; or
(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
(e) any value associated with the trade mark.

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: There is no formal administrative application or registry process which allows one to proactively apply for a "well-known" status for a trade mark.

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: Other factors include: 1. Any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognized, and the duration of such registration or application; 2. any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory; and 3. any value associated with the trade 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
✓	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.

N/A

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 Relevant Legal Provisions under the TMA • Office action or Opposition under ss 8(4); and • Invalidation under s 23(3)(a)(iii) read with ss 8(4).
✓	A trademark likely to cause confusion with a trademark well-known in your country Relevant Legal Provisions under the TMA • Same as the above.
✓	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country

	Relevant Legal Provisions under the TMA • Same as the above. Additional Comments: As long as the trademark being applied for is, amongst other additional requirements/elements, likely to cause confusion with a trademark that is well-known in Singapore, whether the mark also causes confusion abroad is unhelpful as to whether registration should be refused or invalidated in Singapore.
	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 Relevant Legal Provisions under the TMA • Office action or Opposition under ss 8(4)(a) and (b)(i); and • Invalidation under s 23(3)(a)(iii) read with ss 8(4)(a) and (b)(i).
✓	A trademark filed in bad faith Relevant Legal Provisions under the TMA • Office action or Opposition: s 7(6); and • Invalidation: s 23(1) read with s 7(6).

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: N.A.
✓	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

In the context of well known marks, under s 8(4)of the TMA (and s 23(3)(a)(iii) for invalidation), there is no requirement for similar goods and/or services.

Separately, applications made in bad faith under s 7(6) of the TMA will be refused registration regardless of any similarity or dissimilarity of goods/services.

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?
Comment: For the purposes of this question, it is assumed that the well-known trademark is registered in Singapore. If the well-known trademark is unregistered, the only legal remedy available to the proprietor of such a trademark is an injunction (see sections 55(2)-(4) of the TMA).

✓	Injunction
✓	Claim for damages
	Measures to restore business reputation (e.g. apology advertisement)
✓	Customs border measures
	Others (please specify: Account of profits for infringement of a registered trade mark (s 31(2)(c) TMA; statutory damages in relation to use of a counterfeit trade mark (ss 31(2)(d) and 31(5) TMA).

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: If the trademark is held to be well-known in Singapore, use is not necessary to obtain the legal protections below (to the extent that such protections are available at law). However, if the trademark is not used, it is usually hard to establish that it is well-known.

	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 Comments: The requirement for a well-known trademark to obtain protection under s 55(1) of the TMA is that it must be well-known in Singapore. Therefore, a mark being well-known abroad may assist with the issue/requirement of being well-known in Singapore; however, the crucial point is that it must be shown how the well-known status of the mark in question abroad translates or leads to the unregistered mark being well-known in Singapore. If this cannot be demonstrated, the mark which is well-known abroad, whether registered or unregistered, will not obtain protection in

	Singapore.
✓	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: *Shenzhen Meixixi Catering Management Co., Ltd v Heetea Pte. Ltd.* [2021] SGIPOS 12

Case number: [2021] SGIPOS 12
Date: 1 November 2021
Brief Summary:

The Applicant, Shenzhen Meixixi Catering Management Co., Ltd, operates a tea chain founded in China in 2012 as ROYALTEA, which rebranded as HEYTEA 喜茶 in 2016 and grew rapidly in China. It registered HEYTEA in Singapore in Class 43 in January 2017 (the "**Applicant's Earlier Mark**"). The Registered Proprietor, Heetea Pte. Ltd., a Singapore company, registered HEYTEA in Class 30 for tea-based beverages (the "**Registered Mark**") on 12 May 2017 (the "**Relevant Date**"). The Applicant sought to invalidate the Registered Mark on, amongst others, the basis that the Applicant's Earlier Mark was well known under s 23(3)(a)(iii) read with s 8(4)(b)(i) of the Trade Marks Act 1998 (the "**Well-known Mark Ground**").

The Well-known Mark Ground failed because the Applicant's evidence did not establish that HEYTEA was recognised by any relevant sector of the Singapore public as at the Relevant Date. Evidence after the Relevant Date, namely the Applicant's sales and promotional expenditure, was not taken into account for the purposes of assessment. The remaining evidence went to the brand's popularity in China and online. The Registrar, however, held that neither this nor evidence of Singaporeans visiting the Applicant's outlets in China showed exposure of the relevant Singapore public to HEYTEA at the Relevant Date.

The registration was nonetheless invalidated on other grounds under the Trade Marks Act 1998.

Case 2:
Title: *CrossFit, LLC v Play Distribution Pte Ltd* [2024] SGIPOS 4
Case number: [2024] SGIPOS 4
Date: 27 May 2024
Brief Summary:

The Applicant, CrossFit, LLC, is a US fitness company with a worldwide network of CROSSFIT-branded affiliate gyms, established since 2001, and owns CROSSFIT registrations in Singapore (the "**Applicant's Earlier Mark**"). The Registered Proprietor, Play Distribution Pte Ltd, is incorporated in Singapore but operates mainly from Sweden. It sells training socks and apparel, and has sponsored events organised by the Applicant's affiliates.

It registered a stylised CROSSFEET mark in Class 25 (the "**Registered Mark**") on 10 June 2019 (the "**Relevant Date**"). The Applicant sought to invalidate the Registered Mark on, amongst others, the basis that the Applicant's Earlier Mark was well known under s 23(3)(a)(iii) read with ss 8(4)(b)(i) and 8(4)(b)(ii) of the Trade Marks Act 1998 (the "**Well-known Mark Grounds**").

The Applicant relied on its Singapore affiliate gyms, social media following, media and academic coverage, and foreign registrations. This evidence largely went to the brand's global scale, including affiliate figures as at 2022. The Registrar however held that it did not show the extent to which the relevant Singapore public recognised CROSSFIT at the Relevant Date. Accordingly, the Well-known Mark Grounds failed.

The application for invalidation was dismissed on all other grounds.

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.

Comments:

Hotel APAA can apply to declare X's registration invalid on the following grounds.

Ground 1: APAA is an earlier well-known trade mark (s 23(3)(a)(iii) read with s 8(4)(b)(i), Trade Marks Act 1998)

Hotel APAA can argue that APAA is well known in Singapore at the date of X's application, and so qualifies as an "earlier trade mark" even though it is unregistered and not used in Singapore (s 2(1)).

Hotel APAA's reputation and fame in Monaco is not, by itself, sufficient. It counts only to the extent it has produced recognition in Singapore (s 2(7); *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 at [112]–[113]).

Hotel APAA needs to at least show that APAA is well known to a relevant sector of the Singapore public. It would likely define that sector as Singapore consumers of luxury European hotel accommodation, together with the luxury travel trade. Recognition within a narrow, affluent clientele has been held sufficient for an ultra-luxury resort with no business in Singapore (*Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216.

Hotel APAA can further argue that X's use of APAA for identical hotel services, and for food and beverage services closely associated with hotels, indicates a connection with Hotel APAA, and that such use damages its interests.

Risk: Recognition must be proved as at X's filing date. Online presence and visits abroad have not, by themselves, been accepted as exposure of the relevant Singapore public (*Shenzhen Meixixi Catering Management Co., Ltd v Heetea Pte. Ltd.* [2021] SGIPOS 12 at [63]–[65]; *CrossFit, LLC v Play Distribution Pte Ltd* [2024] SGIPOS 4). The limited number of Singapore guests (in this

case, 20) would likely need to be supplemented by evidence showing recognition within the relevant sector of the Singapore public.

Ground 2: Bad faith (s 23(1) read with s 7(6) of the TMA)
Hotel APAA would argue that X applied in bad faith under the "combined" test: what X knew, judged by the standards of reasonable and experienced persons in the trade (*Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203). X had stayed at Hotel APAA three years before filing and therefore had prior knowledge of the hotel and its mark.

He had no connection with the hotel, and still registered the identical mark for its core service, hotel accommodation, which he does not provide. Such actions could constitute pre-emptive appropriation that falls short of acceptable commercial behaviour.

This ground allows a successful applicant to invalidate all or part of the goods and services registered under the mark. In this case, the prospects for the removal of the "provision of hotel accommodation" specification under X's registered mark would be higher as compared to the prospects of removal/invalidation of the "providing food and beverages" specification since Hotel APAA does not provide such services. Ultimately, whether all or part of X's mark is invalidated would turn on the court's findings with regard to bad faith.

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

Comment: Yes, but only in the limited sense that online reservations and advertising directed at Singapore consumers may constitute relevant evidence of promotion and exposure in Singapore. Such accessibility and limited bookings are unlikely to, without more, establish that the mark is well known in Singapore.

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:)

N/A

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!