TH-TM Special Topic

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):

Section 8 (10) of the Thai Trademark Act B.E. 2534 (1991) provides a protection for a well-known mark as it prohibits the registration of any trademark that is identical or confusingly similar to a well-known mark. However, it does not give a precise definition for a well-known mark.

Pursuant to this Section, the Ministerial Notification regarding Rules on Determination of Well-Known Marks is enacted to provide that the following criteria should be used to determine whether a mark is well-known:

1. The mark has been used on goods or services by way of distribution, or has been used, advertised, or used by other means in the usual manner and in good faith;
2. The mark has been widely used, whether in Thailand or abroad, in the usual manner and in good faith to the extent that it is well known among the general public or those in the relevant industry in Thailand;

Based on the above criteria, it can be implied that a well-known mark is a mark which has been widely used in good faith in any manner to the extent that it has become well-known among the general or relevant public in Thailand.

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:

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 Remark: The Trademark Office usually requires the evidence to show the mark in exactly the same form.
	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 Remark: According to the Notification of the Ministry of Commerce Re: Criteria for Determining Well-Known Marks, dated 21 September B.E. 2547 (2004) ("**Notification**"), whether a trademark is well known is assessed in relation to the goods or services for which the trademark is used. However, Section 8(10) of the Thai Trademark Act provides protection for well-known marks in relation to all goods and services that any identical or confusingly similar mark shall be prohibited from registration.

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? Remark: According to the Notification, there is no specific geographical scope prescribed for recognition of a well-known trademark. However, the mark must be recognized among the general public or the relevant public in Thailand.

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? Remark: According to the Notification, it is sufficient that the trademark is well known among either the general public or the relevant public in Thailand.

6. What factors are considered in order for a trademark to be recognized as a well-known trademark?

✓	Period of use

	Remark: In the Trademark Board's Decision No. 96/2564, the Board considered, among other factors, that the  trademark had been registered for more than 24 years prior to the applied-for mark and had been widely used, and advertised to the extent that it has became well known to the public.
✓	Area of use Remark: In the Specialized Court of Appeal's Judgment No. 98/2568 concerning the "NIVEA" & "นีเวีย" (NIVEA in Thai) mark ("NIVEA Case"), the Court held that sales and advertising of the goods across all regions of Thailand demonstrated that the mark was recognized or accepted by the public.
✓	Sales amount Remark: In "NIVEA Case" above, the Court also held that the very high sale volumes and revenues correspondingly reflected the mark's popularity and a large number of purchasers in Thailand.
✓	Advertising and promotional expenses Remark: In Trademark Board's Decision No. 86/2566, the Board recognized advertising and promotional expenses of several billion Baht in Thailand over 33 years as one factor in consideration of public recognition of the mark.
	Person or entity that conducted the advertising and promotion
✓	Relevant consumers
✓	Market share
✓	Number of stores Remark: In the Supreme Court's Judgment No. 6396/2533, the Court considered that the trademark "CHANEL" had been registered for various goods and services in Thailand and had been extensively used, advertised and sold through printed media and department stores both in Thailand and abroad. These circumstances supported the finding that CHANEL perfume products had long been widely recognized and well known in Thailand and abroad.
✓	Awards received Note: In "NIVEA Case", the Court accepted brand rankings and awards as part of the evidence of public recognition of the marks.
✓	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:) - Length of time for which the mark had previously been registered before the disputed mark - Prior court decisions recognizing the same mark as being well-known - Number of authorized distributors/licensees both in Thailand and other countries Participation in numerous domestic and international exhibitions/trade fairs/events

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 Remark: According to the Notification, evidence is not limited to any specific form. Hence, the number of Thai travelers should be helpful to demonstrate that the trademark is well known among the general public or the relevant public in Thailand.

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 Remark: The Notification does not restrict the means by which a trademark may be used or advertised, provided that the mark is recognized among the general public or the relevant public in Thailand.

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):
No particular type of evidence or channel is decisive. Any evidence may be relevant provided that it demonstrates a certain degree of recognition among the general public or the relevant public in Thailand.

Actual instances of trademark counterfeiting and imitation in Thailand may serve as useful evidence supporting the fact that a trademark that is well-known abroad has acquired a sufficient degree of recognition among the relevant sector of the public in Thailand. For example, instances where local third parties have attempted to capitalize on the mark's reputation by counterfeiting or imitating the mark and using it on their own products for sale may help demonstrate that the mark has gained recognition in the Thai market.

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	-- %
	2) In the case of products for specialized markets (such as aircraft parts)	-- %
	3) In the case of services	-- %
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 Remark: Under Section 8(10) of the Thai Trademark Act, a well-known mark regardless of whether it has been registered in Thailand shall block subsequent identical or confusingly similar marks in relation to any goods or services.
	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 (Information submission)
✓	Opposition
✓	Cancellation trial → If there is any specific trial, please indicate: Remark: Cancellation may be sought by filing a cancellation petition with the

	Trademark Board on the following grounds: (1) the registered mark is identical with or confusingly similar to a well-known mark; and (2) the application was filed in bad faith, which is regarded as contrary to public policy. The owner of a well-known mark may file a cancellation lawsuit with the Court seeking cancellation on the grounds of better title by virtue of its prior extensive use.
	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 Remark: According to the Notification, it is not required that the well-known trademark be used in Thailand. The mark may be used in Thailand or abroad, provided that it is well known among the general public or the relevant public in Thailand.

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 Remark: This argument requires a prior trademark registration in Thailand.
✓	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):
A mark that is identical with or confusingly similar to a well-known mark is not registrable for any goods or services, regardless of whether they are in the same class as those of the well-known mark (the Supreme Court's Judgment No. 6113/2555, "Watson"). The same applies to applications filed in bad faith.

Part C: Enforcement Capabilities of "Well-Known Marks"

1. Which of the following can constitute a legal title or legal basis for asserting claims?

✓	Assertion of rights in a well-known trademark that is unregistered in your country
	A well-known trademark registered in your country
	Acts of unfair competition
✓	Passing off
	Dilution
✓	Tort under civil law
	Others (please specify:)

2. What legal remedies are available?

✓	Injunction
✓	Claim for damages
	Measures to restore business reputation (e.g. apology advertisement)
	Customs border measures
	Others (please specify:)

3. In order to obtain the legal protection listed below, is it necessary for the well-known trademark to be used in your country?

✓	Injunction
✓	Claim for damages
	Customs border measures
	Apology advertisement (or other measures to restore business reputation)
	Others (please specify:)

4. In the case of a trademark that is well-known abroad but does not have a high degree of recognition in your country, which of the following can constitute a legal basis for asserting claims?

✓	Assertion of rights in a well-known trademark that is unregistered in your country
	A well-known trademark registered in your country
	Acts of unfair competition
✓	Passing off
	Dilution
✓	Tort under civil law
	Well-known or famous status overseas
✓	Assertion of the other party's bad faith
	Actual confusion as to source in the market
	Others (please specify:)

5. If there are any cases involving a trademark that is well known abroad but does not have a high degree of recognition in your country, where a third party registered the trademark first and the matter was disputed in an opposition, trial or appeal, infringement litigation, or similar proceeding, please briefly introduce one or two examples.

Case 1:
Title:
Case number:
Date:
Brief Summary (* Word limit: 200 words or less)**:**

Case 1:

Title: Cancellation of Trademark Registration No. Kor413851 for "MIUI"
Case number: Decision of the Court of Appeal for Specialized Case No. 5195/2566
Date: 27 September 2023
Brief Summary:

The Plaintiff filed an application for registration of trademark "MIUI" in Class 9 (Application No. 170123533). However, the subject application was refused for registration due to its similarity to the Defendant's prior registered trademark "MIUI" in Class 9 (Registration No. Kor413851) being filed on September 4, 2014.

Having reviewed the evidence submitted by the Plaintiff, the Court found that the Plaintiff has obtained the trademark registration for **"MIUI"** since 2012. Moreover, the Plaintiff has first used the subject trademark in China and Thailand in 2010 and 2013 respectively. Considering the fact that the Plaintiff has widely used the trademark **"MIUI"** both in foreign countries and Thailand by distributing and advertising the goods bearing the subject trademark before the Defendant, the Plaintiff's trademark **"MIUI"** is regarded as having acquired its well-known reputation among the general public worldwide including Thailand. In addition, it did not appear that the Defendant had used the trademark **"MIUI"** in good faith prior the Plaintiff.

For this reason, the Court upheld the decision of the Central Intellectual Property and International Trade Court (the Court of First Instance) by ruling that the Plaintiff has a better right in the trademark **"MIUI"** than the Defendant, and that ordered the cancellation of the Defendant's Trademark Registration No. Kor413851 for "MIUI".

Case 2:
Title:
Case number:
Date:
Brief Summary (* Word limit: 200 words or less)**:**

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"

已註解 [RK1]: คดีนี้ใกล้เคียงที่สุดเท่าที่หาได้แต่ก็ไม่ตรงกับคำถามทั้งหมดนะคะ เผื่อเป็นประโยชน์ค่ะ

已註解 [NT1R2]: Ok ครับ

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):
Given that only approximately 20 guests from Thailand stay at Hotel APAA and a very small number of people in Thailand are aware of Hotel "APAA" in Monaco, it may be difficult to establish that the mark is recognized among the relevant Thai public and qualified as being well known in Thailand. However, X's prior knowledge of Hotel "APAA" and subsequent registration and use of the identical mark may support arguments based on bad faith. The hotel may also consider a passing-off action under Section 46 of the Thai Trademark Act.

IV. Ideas for Next Special Topic

TH-TM Special Topic

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

N/A

Thank you for your kind cooperation!