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): A mark that is commonly recognized by relevant consumers or businesses in the same field. The legal provision is Article 31 of "Enforcement Rules of the Trademark Act" in Taiwan: "The term "well-known" as prescribed in the Act refers to the circumstance where there is objective proof of a sign capable of being commonly recognized by the relevant enterprises or consumers."

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? No. If the answer is yes, please identify the name of such specific system below: (e.g., Defensive mark registration) Comments: In Taiwan, there is NO specific system which an applicant can formally apply for well-known status. For the trademark case pending before the court, the court may determine that a particular trademark is a well-known trademark.

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: Documents relating to relevant determination made by an administrative or judicial authority in Taiwan, such as opposition decisions, invalidation decisions, administrative appeal decisions, or court decisions.

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):
Materials showing that the trademark is ranked by any credible domestic newspaper or magazine as one of the world's top brands or one of Taiwan's top brands, consumer satisfaction surveys of the goods bearing the trademark, or relevant discussions in Chinese on the Internet and Internet users' evaluation.

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.

✓ Article 30-I-11	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
✓ Article 30-I-11	A trademark likely to cause confusion with a trademark well-known in your country
✓ Article 30-I-11	A trademark likely to cause confusion with a trademark well-known both in your country and in a foreign country
✓ Article 30-I-(12)	A trademark likely to cause confusion with a trademark well-known only in a foreign country
✓ Article 30-I-(11)	A trademark filed with an unfair purpose that would harm the interest of the owner of the well-known trademark
✓ Article 30-I-(12)	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: ( )
✓	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
✓ Trademarks may still be deemed well-known in Taiwan even without local use, provided there is evidence proving that the reputation established through its extensive use abroad has extended to Taiwan.	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 Taiwan's Trademark Act protects trademarks based on prior use, thus provide the use-evidence in Taiwan or in worldwide earlier than the filing date of the third party's trademark application date in Taiwan is useful.

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 Being aware of the existence of the earlier used trademark due to contractual, regional, or business connections.

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 owner of a well-known trademark can rely on protection that may cross over to dissimilar goods and or services by asserting that use on or with dissimilar goods or services of a mark that is identical or similar to the well-known trademark is likely to dilute the distinctiveness or reputation of the mark, even where no likelihood of consumer confusion exists due to such use.

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

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

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

2. What legal remedies are available?

✓	Injunction
✓	Claim for damages
✓	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:** Administrative Judgment of the Intellectual Property and Commercial Court **Case number:** Case No. 43 (Year 2022) **Date:**31 January 2023 **Brief Summary** (* Word limit: 200 words or less)**:** Swedish fashion watch brand DW (Daniel Wellington) successfully file the opposition against DW registration which registered under a Taiwanese individual's name for used with watches. The Swedish brand asserts that it had used DW mark on watches in Taiwan prior to the filing date of Taiwanese individual's application and has submitted advertising and marketing materials from Taiwan to substantiate this prior use. The court also found that the Swedish company had registered the trademark in the United States prior to the trademark application in Taiwan. Furthermore, the court noted that after the Taiwanese individual obtained the DW trademark registration, he used the name "Dream Wellington" thereby demonstrating that the individual was aware of the Swedish company's prior use of the DW trademark and that his own application was filed in bad faith.
Case 2:

Title: Administrative Judgment of the Intellectual Property and Commercial Court
Case number: Case No. 30 (2025)
Date: 8 June 2026
Brief Summary (* Word limit: 200 words or less)**:**

ZEGNA, a famous Italian menswear brand, filed an opposition against Hong Kong company's "ZEGNA" registration used with the *generators, motors, elevators* in Taiwan.

ZEGNA argued that its mark is well-known and that the Hong Kong company's registration of "ZEGNA" mark with the machinery-related products risked diluting the distinctiveness of the ZEGNA trademark; therefore, the registration of the contested mark should be revoked.

The court held that the Italian brand had changed its name from "ERMENEGILDO ZEGNA" to "ZEGNA" only in December 2021—a timing close to the Hong Kong company's trademark application date thus there was no indication of an intent to create an association between the Hong Kong company's trademark and Italian menswear brand.

Furthermore, the court found that the marketing materials submitted by the Italian brand were limited in sale amount, duration, and scope which did not prove their mark enjoy a particularly strong reputation and a high degree of fame. Thus, use of the ZEGNA mark with the machinery-related products would not dilute the distinctiveness or reputation of the well-known ZEGNA menswear brand.

III. Discussion based on "Case Example"

We would like to discuss a hypothetical case with all of you. Based on the following hypothetical scenario, please consider and answer the questions that follow.

Part A. Case Example: Hotel APAA in Monaco, well known in Monaco and Europe

Hotel "APAA," located in the Principality of Monaco, is a well-known hotel in Monaco. However, the hotel has not opened any establishment in Japan. Hotel "APAA" has not obtained a trademark registration in Japan for "provision of hotel accommodation" in Class 43.

However, in order to attract tourists from Japan to stay at its hotel in Monaco, Hotel "APAA" allows accommodation reservations to be made online from Japan. It also advertises on Instagram and TikTok, and such advertisements are accessible to consumers in Japan.

In reality, however, only a very small number of people in Japan are aware of Hotel "APAA" in Monaco, and it is known only among a very limited segment of affluent consumers. The number of guests from Japan is approximately 20 per year.

Under these circumstances, X, a famous chef in Japan who has no relationship with Hotel "APAA," obtained a trademark registration in Japan for "APAA" in Class 43, not only for "provision of hotel accommodation," but also for "providing food and beverages." X had stayed at

Hotel “APAA” in Monaco three years earlier. X uses “APAA” as the name of his own restaurant in Osaka, and the restaurant is successful.

Upon learning of this, Hotel “APAA” in Monaco hurriedly filed a trademark application in Japan in Class 43, designating “provision of hotel accommodation” and “providing food and beverages” as the designated services. However, the application was refused on the ground that it was identical to the trademark registration owned by X.

Hotel “APAA” is now considering seeking cancellation of X’s trademark registration by asserting that “APAA” is a well-known trademark in Monaco in connection with “provision of hotel accommodation” in Class 43.

If you were acting as counsel for Hotel “APAA,” on what grounds would you seek to cancel X’s trademark registration?

Please note that the opposition period has already expired.

Part B. Questions

Please answer the following questions under the laws and practice of your own jurisdiction, assuming the same factual circumstances occurred in your country (replacing Japan/Osaka with your country/city).

1. Is it possible to initiate an invalidation or cancellation trial against X’s registration under the Trademark Act?

✓	Yes
	No

2. If your answer to Question 1 is YES, what grounds for invalidation or cancellation may be considered?

	A trademark identical or similar to an unregistered trademark well known in the country (Japan), and filed for identical or similar goods or services
	A trademark likely to cause confusion with a trademark well-known **both** in the country (Japan) and abroad
	A trademark likely to cause confusion with a trademark well-known **only abroad**
	A trademark filed for an improper purpose that harms the interest of the owner of the well-known trademark
	A trademark filed in bad faith
✓	Prior use As Hotel “APAA” was already a well-known hotel in Monaco and X had stayed there three years earlier, an invalidation action against the trademark registration can be brought based on the following provision of Taiwan's Trademark Law: Article 30: A trademark application shall be rejected if the proposed

	trademark: 30(12) is identical or similar to another person's **earlier used trademark** and to be applied for goods or services identical with or similar to those for which the earlier used trademark is applied, where the applicant with the intent to imitate the earlier used trademark, **being aware of the existence of the earlier used trademark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trademark**, files the application for registration, unless the proprietor of the said earlier used trademark consents to the application. To successfully invalidate the registration in Taiwan under this provision, we must provide evidence of "APAA" being used prior to the trademark's filing date, alongside proof of X's prior stay at the hotel.

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 Pursuant to Article 30(1)(12) of the Taiwan Trademark Act, we may argue that APAA is the prior used mark in respect of hotel services, and that the designated services of X's registration—namely, 'providing food and beverages' is related services due to overlap in target consumers and trade channels.

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):

For this case, we suggest claim X's trademark registration is identical or similar to Hotel "APAA"'s earlier used trademark and to be applied for goods or services identical with or similar to the earlier used trademark is applied, where the applicant being aware of the existence of the earlier used trademark due to contractual, regional, or business connections.

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.

Prior Trademark Use in Good Faith

Thank you for your kind cooperation!