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):

Article 4.20 of the IP Law defines a well-known mark as "a mark widely known by the **relevant section of the public** within the territory of Vietnam". Article 75 sets out eight main criteria for assessing well-known status, of which some or all may be applied. IPRs in a well-known mark are established on the basis of use, without any registration procedure (Article 6.3(a)).

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 |
| ✓ | Enforcement and litigation actions against trademark infringement |
| | 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?<br>If the answer is yes, please identify the name of such specific system below: ( e.g., Defensive mark registration)<br>Comments:<br>No. Vietnam has no independent procedure by which an owner may apply for a recognition of well-known status, and no authority may declare a mark well-known suo motu. Recognition is made case-by-case, incidentally, within a specific proceeding. Under Article 6.2 of Decree 65/2023, the owner must prove its rights by the evidence specified in Article 91.5(c) of that Decree, namely materials addressing the Article 75 criteria together with an explanation of the process of use by which the mark became well-known.<br>Pursuant to Article 88.3 of Circular No. 10/2026/TT-BKHCN, as amended and supplemented by Circular No. 20/2026/TT-BKHCN in 2026 (consolidated text No. 06/VBHN-BKHCN), where the recognition of a mark as well-known results in (i) a decision addressing infringement of rights in that well-known mark pursuant to Article 129.1(d) of the IP Law, or (ii) a decision refusing protection to another mark pursuant to Article 74.2(i) of the IP Law, the well-known mark shall be recorded in the List of Well-Known Marks maintained by the IP Vietnam.<br>Up to date, only IP Vietnam and IP Court (Regional Court No. 1 in HCMC and Regional Court No. 2 in Hanoi) have authority and are entitled to issue the decision on recognition of well-known 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? *(relevant section of public got to know)* |

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:<br>Article 75 of the IP Law also lists: the widespread reputation of the goods or services bearing the mark (Art. 75.5); the number of countries in which the mark is protected (Art. 75.6); the number of countries recognizing the mark as well-known (Art. 75.7); and the assignment price, licensing price or capital-contribution value of the mark (Art. 75.8). Article 75 permits some or all of the eight criteria to be selected. |

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.

Evidence of the kinds listed in Questions 7 and 8 is admissible in practice, but its evidentiary weight is difficult to quantify and there is no fixed threshold. Materials showing actual commercial contact with Vietnamese consumers carry appreciably more weight than raw traffic or follower figures: Vietnamese-language content and advertising, sales or shipment records into Vietnam, coverage in Vietnamese media, and long continuous use abroad coupled with protection and well-known recognition in a substantial number of countries

| |
|---|
| (Art. 75.6 and 75.7 of the IP Law). |

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 ✓ | There is no official requirement for consumer surveys and no prescribed recognition rate. In practice, the survey outcome of the accredited institutions with sufficient sample size of the survey and the methodology of survey is rational, the survey output could play important roles for the determination of well-known status. | |

**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<br>Article 74.2(i) of the IP Law prevents a sign identical or confusingly similar to a mark considered well-known before the filing date, for identical or similar goods or services, and also for dissimilar goods or services where use of the sign may affect the distinctiveness of the well-known mark or where registration is made to take advantage of its reputation. Bad-faith filing is a separate ground of invalidation |

| | |
|---|---|
| | under Article 96.1(a). Article 4.20 requires the mark to be known within the territory of Vietnam, so reputation only in a foreign country is not a sufficient basis. |

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<br>→ If there is any specific trial, please indicate:<br>Termination of validity under Article 95.1(d) of the IP Law, where the registered mark has not been used for five consecutive years. This is not a ground directed at bad faith as such, but in practice it is the principal route for removing a dormant preemptive registration. |
| ✓ | 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: The factors listed above may be considered when establishing bad faith in a trademark application. No single factor is sufficient on its own, and all relevant circumstances should be assessed collectively, in accordance with Article 112.3 of Circular 10/2026/TT-BKHCN) |

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)<br>Also effective: evidence that the number of marks filed exceeds the applicant's normal business capacity and that there is no evidence of a genuine intention to use them (Article 112.3(a) of Circular 10/2026); and evidence that the mark was well known in other countries at the filing date (Article 112.3(b)). Under Article 112.3 no single item suffices. Bad faith under Article 96.1(a) of the IP Law requires an objective element - at the filing date the mark was confusingly similar to a mark recognized by relevant consumers in Vietnam as indicating the commercial origin of identical or similar goods or services, or to a mark well known in other countries - together with a purpose element: exploiting that reputation for gain, reselling or licensing the registration or the right to register back to the owner, blocking market entry so as to restrict competition, or other acts contrary to honest commercial practices. The listed items are probative of the purpose element; they do not establish bad faith on their own. |

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):<br>Yes. Article 74.2(i) of the IP Law operates in three bands: band 1 covers confusion for identical or similar goods or services; band 2 and 3 extend protection to dissimilar goods or services, where use of the sign may affect the distinctiveness of the well-known mark, or where the registration is made to take advantage of its reputation. Article 78.4(c) of Circular 10/2026 requires that consumers be liable to believe a connection exists with the owner, and that there be a real capacity to diminish distinctiveness or harm reputation. Well-known status before the filing date must be established first; the applicable branch is identified only afterwards. | |

**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: )<br>Vietnam does not recognize passing off, which is a common-law tort with no equivalent cause of action in Vietnamese law. Its function is performed by unfair competition under Article 130.1(a) of the IP Law and general non-contractual liability under Article 584 of the Civil Code. |

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: )<br>• Administrative sanctions for infringement of industrial property rights under Decree 99/2013, as amended, most recently by Decree 186/2026/ND-CP of 26 May 2026. Article 202 of the IP Law additionally provides for destruction or non-commercial distribution of infringing goods and for removal, hiding or disabling of access to infringing online content.<br>• Criminal prosecution against the counterfeit trademark under Article 226, Vietnam Penal Code. |

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: )<br>The most important factor is the practical use of the trademark in Vietnam market or at least targeting to Vietnam customers.<br>Vietnam does not recognize passing off, which is a common-law tort with no equivalent cause of action in Vietnamese law. Its function is performed by unfair competition under Article 130.1(a) of the IP Law and general non-contractual liability under Article 584 of the Civil Code. |

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:** CHILDLIFE (request to invalidate the registration of KIDLIFE)

**Case number:** Decision No. 2442/QD-SHTT of the Intellectual Property Office of Vietnam

**Date:** 06 May 2019

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

The later mark KIDLIFE was filed in Vietnam on 10 July 2007. The owner of CHILDLIFE, which held registrations abroad predating that date, sought invalidation on the grounds that CHILDLIFE was a well-known mark. The request was refused. Evidence of sales, promotion and distribution in Vietnam dated mainly from 2008, after the filing date of the later mark, and the foreign registrations did not of themselves show that the Vietnamese public knew the mark or that it had reached well-known status in Vietnam before 10 July 2007. The IP Vietnam did not find that CHILDLIFE was not well known. It found that the evidence did not prove well-known status in Vietnam before 10 July 2007. Foreign reputation supports such a claim but does not prove it. The owner must link it to the Vietnamese public by importation or distribution, promotion aimed at Vietnamese consumers, media available in Vietnam, or recognition data. The date decided the case. The IP Vietnam did not compare the signs, and did

| |
|---|
| not consider what the applicant knew or whether it intended to exploit the reputation. |
| **Case 2:**<br>**Title:** BONPOINT (request to invalidate a later registration)<br>**Case number:** Decision No. 2380/QD-SHTT of the Intellectual Property Office of Vietnam<br>**Date:** 15 May 2019<br>**Brief Summary** (* Word limit: 200 words or less)**:**<br>The later sign reproduced the word BONPOINT in full with additional device, for goods in the fashion and children's products sector including cosmetics. The owner of BONPOINT (not yet filed a trademark registration in Vietnam), a mark used and registered abroad, sought invalidation relying on several groups of facts: the history and scope of its use, its business activity and registrations in a number of countries, the degree of recognition of the mark, the copying character of the later sign, and the later applicant's lack of good faith. Invalidation was granted on more than one ground. The case illustrates the route most likely to succeed where a mark is well known abroad but its recognition in Vietnam is uncertain: each fact must be attached to the ground it supports, and copying is probative of the later applicant's knowledge of the earlier mark without by itself establishing that the Vietnamese public recognized it, or that it had attained well-known status in Vietnam. Because the outcome rested on a combination of grounds, the decision should not be treated as fixing the evidential threshold for well-known status alone. |
| **Case 3:**<br>**Title:** Opposition Against the "FACETEM" Trademark: Overseas Reputation, Limited Recognition in Vietnam, and Prior Third-Party Registration<br>**Case number:** PĐ4-2024-01221 (Application No.: 4-2023-57047)<br>**Date:** 04/12/2024 (opposition filing date)<br>**Brief Summary** (* Word limit: 200 words or less)**:**<br>CG BIO Co., Ltd. (South Korea) opposed Ma Thanh Cong's application for the "FACETEM" trademark in Vietnam, relying on the mark's reputation in South Korea and other foreign markets and alleging likelihood of confusion, bad faith, and unfair competition. The evidence included online materials, export records, participation in international trade fairs, promotional materials in Vietnam, foreign trademark registrations, and the applicant's history of filing multiple trademark applications.<br>On 22 September 2025, IP Vietnam rejected the opposition, finding insufficient evidence that FACETEM had been widely used and recognized in Vietnam before the filing date of the opposed application. However, the decision did not address the issue of whether FACETEM qualified as a well-known mark in South Korea and other countries. The evidence, including the applicant's multiple filings of marks identical or similar to those owned by other parties, was also insufficient to establish bad faith or an intention to engage in unfair competition.<br>This case illustrates the difficulties of relying solely on a mark's overseas reputation without sufficient evidence of its recognition as a well-known mark in foreign jurisdictions or of its prior commercial use and consumer recognition in Vietnam. |

## 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<br>Article 96.1(a) of the IP Law: a protection title is invalidated in its entirety where the applicant filed the trademark application in bad faith. On the stated facts X had stayed at the hotel three years before filing and so knew of the mark. However, prior knowledge of the mark alone is insufficient to establish bad faith. It is also necessary to examine the applicant's motives and purpose in filing the application, in accordance with the relevant guidance under Article 112.3(b) of The Circular No. 10/2026/TT-BKHCN.<br>The well-known grounds under Article 74.2(i) of the IP Law are not available, because Article 4.20 requires the mark to be widely known by the relevant section of the public within the territory of Vietnam, and prior use abroad is not of itself a ground. |
| ✓ | Prior use (considering the right to trade name) |

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<br>The mark is well-known abroad and has been used/ targeted to customers. The applicant/ owner of the Japanese trademark had known the trademark and practically experienced the services rendered under such trademark. |
| ✓ | Prior use if the right toward trade name is established. |

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):

Article 130.1(a) of the IP Law requires use of a commercial indication that causes confusion as to the business entity or the commercial origin of goods or services. On the stated facts the hotel is known only to a very limited segment of consumers in Vietnam, so confusion could not presently be established. Article 130.1(c) is inapplicable because X is neither representative nor agent of the mark owner.

## 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.

### 1. Trademark Squatting and Bad-Faith Trademark Applications: Evolving Legal Standards and Cross-Jurisdictional Practices

Vietnam applies the first-to-file principle. Article 96.1(a) of the IP Law provides a basis for invalidating a protection title where the trademark application was filed in bad faith. Article 112.3 of Circular No. 10/2026/TT-BKHCN, effective from 1 April 2026, specifies two independent circumstances constituting bad-faith registration:

(i) filing a large number of marks identical or confusingly similar to marks used by others in Vietnam for identical or similar goods or services, where the filings exceed the applicant's

ordinary business capacity and there is no evidence of genuine intent to use the marks in business; or

(ii) filing a mark identical or confusingly similar to a mark that, at the filing date, is recognized by relevant consumers in Vietnam as indicating the commercial origin of another party's identical or similar goods or services, or to a mark well-known in other countries, with the purpose of exploiting its reputation for profit, reselling or licensing the mark, transferring the registration right, obstructing market entry to restrict competition, or engaging in other acts contrary to fair commercial practices.

These provisions raise important questions concerning the interpretation of "large number," "ordinary business capacity" and "genuine intent to use," as well as the evidence required to establish consumer recognition in Vietnam and the applicant's improper purpose. The alternative grounds also warrant discussion of their respective evidentiary thresholds, particularly where the earlier mark is well-known abroad but has limited commercial presence in Vietnam.

An APAA comparative discussion could examine how member jurisdictions address trademark squatting, including the relevance of prior knowledge, business relationships, reputation abroad, filing patterns and intent to use; the allocation of the burden of proof; and the effectiveness of opposition and invalidation procedures. Members could share relevant legislation and judicial or administrative decisions to identify practical approaches to preventing and remedying bad-faith trademark filings across jurisdictions.

**2. Mortgage of IP Rights for Loan Purposes**

Vietnam's amended IP Law recognizes intellectual property rights as assets that can be commercially exploited, while the legal framework governing secured transactions provides the broader basis for using eligible assets as collateral for loans. Decree No. 100/2026/ND-CP, which amended Decree No. 65/2023/ND-CP, also introduced provisions concerning the management and commercialization of intellectual property rights, including the preparation of internal inventories of IP rights that do not yet qualify for recognition as assets in accounting records.

However, the practical use of intellectual property rights as collateral remains subject to questions concerning valuation, registration and enforceability against third parties. Other challenges include determining the appropriate value of trademarks, patents and industrial designs; obtaining consent for jointly owned rights; maintaining the validity of registered rights during the loan term; and realizing the collateral if the borrower defaults. The interaction between IP legislation and the law governing secured transactions also requires further clarification, particularly regarding the rights of secured creditors to exploit, assign or otherwise dispose of the relevant IP assets.

An APAA comparative discussion would be valuable in examining how different jurisdictions address these issues, including their legal requirements for creating and registering security interests, valuation methods, priority among competing creditors and enforcement mechanisms. Members could share relevant legislation, financing transactions and judicial or administrative decisions to identify practical approaches to facilitating IP-backed lending, particularly for startups and small and medium-sized enterprises.

Thank you for your kind cooperation!