

Famous and Well-Known Marks

Practitioner's Toolkit

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Introduction and Summary

In order to help practitioners to better deal with the issues relating to the famous and well-known marks around the world, the sub-committees of the Famous and Well-Known Marks Committee (Canada, East Asia, Europe & Central Asia, Latin America, MEASA and U.S.) have completed evidence toolkits for their respective region. Considering the differences between the practice of each jurisdiction and region, the completed toolkits may be referred by practitioners as initial guideline for dealing with issues relating to famous and well-known marks, which commonly arise around the world.

Except for the evidence toolkit prepared by Europe & Central Asia sub-committee, all evidence toolkits follow the format of having 1) “Overview Questions,” 2) “Types of Evidence” and 3) “Authentication & Relevance of Evidence” parts.

Meanwhile, the Europe & Central Asia toolkit has a slightly different format of having 1) “Types of Evidence,” 2) “Relevant Factors” and 3) “Authentication” parts along with an explanatory introduction about their toolkit and how it should be interpreted (please see the “Evidence Checklist” part). In this connection, it should be noted that the Europe & Central Asia sub-committee had to deal with “well-known marks,” “marks with reputation” and “famous marks” in respect to their jurisdictions.

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Canada

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1. *Does your country have specific recognition/protection for Well-Known Marks?*

No. At this time, Canada has no legislation specifically directed to the protection of famous or well-known trade-marks, nor have the Courts or Opposition Board drawn a clear line to differentiate between the two.

The *Trade-marks Act* itself provides no definition of what constitutes a well-known trade-mark, although the extent to which a trade-mark has become known is recognized as a factor for determining confusion between trade-marks. Proof of recognition by the relevant sector of the public is required in order to establish that a trade-mark has become well known or famous. However, whether the fame of mark will transcend product lines is a question of fact that depends upon all surrounding circumstances. The owner bears the onus of proving fame.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Samples of the manner in which the trade-mark is applied to wares
Identify the channels of trade normally related to the ware associated with the trade-mark.

For example, if applicable, identify retail outlets through which the wares/services associated with the trade-mark are offered to the public or the manner in which the final consumer or any intermediate purchaser would otherwise acquire the wares.

Additional affidavits may also be submitted from advertising agencies, distributors, wholesalers, retailers and users who can attest as to the recognition of the mark in association with the wares or services. These affidavits should relate to the form of use, extent of use, length of use, and territory of use of the mark applied for in relation to the wares or services set out in the application.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No. See response to Question 1.

Additionally, Canada does not recognize trade-mark dilution *per se*, but has a similar concept under the *Trade-marks Act* of “depreciation of goodwill.” One of the elements of this cause of action is that the claimant’s registered mark is “sufficiently well known to have significant goodwill.” The types of evidence that will be relevant in proving that a mark is well-known for the purpose of a depreciation of goodwill claim are the same as the types of evidence relevant to registration/opposition/cancellation proceedings.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts
Canada	<p>Approximate sales figures (annual if possible) with respect to the use of the trade-mark in Canada.</p> <p>Figures should extend back in time as far as possible.</p> <p>For information dated some time ago, a rough estimate is acceptable.</p> <p>The extent of use may be stated in terms of units, dollar volume of sales, or percentage of the market for the wares or services performed, sold, leased or hired in association with the mark.</p> <p>The evidence may refer to the mode of distribution, the number of distributors, and the number of outlets in which the wares/services are provided.</p>	<p>Advertising expenditures (annual if possible) for at least the previous five years.</p> <p>As for the manner and extent of advertising, the affidavits should indicate the number of ads and dollar volume for each type of media (such as television, radio, Internet, print media, outdoor media, etc.).</p> <p>Indicate source of circulation figures/spillover advertising broadcasting.</p> <p>Owner's advertising agency should provide details of spillover of foreign ads into Canada together with examples of spillover advertising from other countries.</p> <p>Information attesting to the geographical area covered by the advertisements is essential.</p> <p>Information on promotional efforts such as national advertising campaigns, incentive programs, consumer programs, prizing programs, events held or aired in Canada in which the owner was involved as organizer, sponsor or participant should be included.</p>	<p>Sample invoices showing sales from each year should be provided.</p> <p>Also specimen labels, packaging, hang tags, stickers or photographs of the wares bearing the trade-mark, point-of-sale displays and the like.</p>	<p>Samples of advertising or promotional literature or catalogues.</p> <p>With respect to advertisements which have appeared in newspapers, magazines and other such media, the name and date of the relevant publication for each advertisement should be provided together with circulation figures in Canada or elsewhere.</p>

Online & Other Adverts	Owner's Website	3P Website	Industrial Awards
<p>Materials under "TV/Printed Adverts" column that are accessible online can include the number of visits from Canada.</p>	<p>Indicate whether the company has an on-line presence and the number of visits/hits per year</p>	<p>Wiki or Google search results etc. are relevant.</p>	<p>Explain prestige of awards or recognition.</p>
Foreign Certificates	Successful Enforcement	Survey Evidence	
<p>Evidence of use and registration in different countries to show it has become famous/well known around the world.</p>	<p>Local and foreign including raids, customs, Court actions, etc.</p>	<p>Market surveys to demonstrate brand awareness. Identify the target market as well as supporting market statistics</p> <p>Surveys: If a market survey is to be used as evidence, in order to be worthwhile, it must be carried out by a person who can file an affidavit which attests to the fact that this person is an expert in designing, organizing, implementing and interpreting survey results. A qualified surveyor will set out the strategy and statistical basis of the survey and will explain the form of the questions asked and the manner in which the survey is conducted.</p> <p>All the results of the survey must be reported — both negative and positive — and the interpretation of the results fully explained.</p> <p>The survey results should be in addition to the master affidavit filed by the applicant or a knowledgeable officer of the company.</p> <p>The Courts have expressed reservations concerning survey evidence, so currently; surveys are not really favored in Canada.</p>	

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence
Canada	<p>The date when the trade-mark was first used in Canada. Information as to whether the use has been continuous or interrupted.</p> <p>Evidence needs to be dated. Relevant dates should be set out in the affidavit of evidence.</p>	<p>At least in theory, the weaker the mark the more evidence will be needed to show FW status.</p>	<p>Local evidence of use and fame is necessary.</p> <p>Evidence of use and registration in different countries will be considered.</p>	<p>Website address and date the evidence was retrieved should be set out in the affidavit or on the website printout.</p>
Foreign Evidence		Foreign FW Recognition	Brand Value	Translation
<p>Local evidence of use and fame is necessary.</p> <p>Evidence of use and registration in different countries will be considered.</p>	<p>Evidence of foreign FW recognition will be considered.</p>	<p>Independent auditor's report or brand rating is relevant.</p>	<p>If any evidence is in another language, a translation into English should be provided.</p>	

Photocopies	Notarization	Legalization
<p>Preferably certified copies.</p>	<p>Affidavits of evidence should be sworn and statutory declarations should comply with the requirements for Statutory Declarations in section 41 of the Canada Evidence Act.</p> <p>Exhibits should be identified and the usual identification made of each exhibit together with the signature of the notary or commissioner taking the affidavit or receiving the statutory declaration.</p>	<p>Not required unless required by owner's or signatory's home jurisdiction or corporate regulations</p>

Australia

Contributors: Tim O'Callaghan (Piper Alderman)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes.

Section 120 of the *Trade Marks Act 1995* (Cth)

(3) A person infringes a registered trade mark if:

- (a) the trade mark is well known in Australia; and
- (b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:
 - (i) goods (**unrelated goods**) that are not of the same description as that of the goods in respect of which the trade mark is registered (**registered goods**) or are not closely related to services in respect of which the trade mark is registered (**registered services**); or
 - (ii) services (**unrelated services**) that are not of the same description as that of the registered services or are not closely related to registered goods; and
- (c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and
- (d) for that reason, the interest of the registered owner are likely to be adversely affected.

(4) In deciding, for the purposes of paragraph (3)(a), whether a trade mark is **well known in Australia**, one must take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Relevant types of evidence include sales figures and invoices to demonstrate the substantiality of the sales of goods bearing the mark, and hence that the mark can be inferred to be well known.

Advertising figures can be useful to demonstrate a high level of use of the trade mark on the relevant market. Indirect advertising could also assist. Alongside this, online and other adverts such as media articles or industrial awards can be of benefit.

Website hits and a 3P website can be relevant and useful but the 3P website is less persuasive. Survey evidence can be useful but there are strict requirements for the admissibility of this evidence.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts		
Australia: Tim O'Callaghan	<p>Include figures with enough detail to demonstrate a substantial volume of sales and, hence, that the mark is widely known. Where possible, provide statistics on the origin of purchasers (if this is known). Provide a breakdown of the cost per unit and the number of units sold.</p>	<p>Include figures for the purposes of demonstrating a high level of advertisement. The quantum and duration is not necessarily determinative. The purpose is to show the potential impact of the advertising. In other words, very high volume, saturation marketing over a short period of time could be as effective as low level marketing over 20 years. Indirect advertising (e.g. sponsorship / brand names and logos appearing around sporting arenas / social media reach from overseas can assist in establishing reputation.</p>	<p>Should be included to substantiate sales figures. A representative sample would suffice where there is high volume.</p>	<p>Advertising is key to establishing that the mark is well known. As much detail as possible should be included on the extent of advertising, the average number of viewers, etc.</p>		
Online & Other Adverts	Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
<p>Provide as much detail as possible about all advertising media, with samples, photographs or other images as support. Consider indirect advertising</p>	<p>Useful if accompanied by data on the number of unique visits and the origin of those visits.</p>	<p>Relevant, but less persuasive.</p>	<p>Useful to include as part of the overall body of evidence to build a picture of status within the relevant sector.</p>	<p>Limited relevance, but worth submitted to build an overall picture of the mark's fame.</p>	<p>Of some relevance if carried out in Australia. Overseas enforcement is not very persuasive.</p>	<p>Can be useful if the results conclusively support your argument, however, introducing survey evidence is strictly controlled. The Federal Court has issued a</p>

(e.g. sponsorships) and social media reach from overseas.

practice note which requires the party seeking to rely on a survey to notify the other party and set out details of the purpose, methodology and questions to be followed in the survey. The parties are expected to agree on the content of the survey before it is conducted. Even then, it is still up to the trial judge to determine whether or not the survey is admissible and the extent to which it carries any weight.

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence
Australia David Moore	The length of use is only one indicator that a mark is well known. So include statistics going back as far as the client has records.	The less distinctive the mark, the greater the burden of establishing that it is well known in connection with the brand owner (and not well known in another context).	The most relevant evidence will be from Australia, ideally across all states and territories. However, the question of whether a mark is well known is linked to the relevant market sector which may not be a nationwide sector.	Social media reach into Australia from overseas sites, webcasts of sponsored events, other elements that may be transmitted via the Internet. Hearsay objections can be overcome using Evidence Act exceptions.
Foreign Evidence	Foreign FW Recognition	Brand Value	Translation	
Limited relevance. Would need to be introduced in an affidavit sworn by someone with direct knowledge of the evidence.	Limited relevance. Would need to be introduced in an affidavit sworn by someone with direct knowledge of the evidence.	Useful to include. Would need to be submitted in affidavit form by a qualified person who can establish themselves as an “expert” witness and be cross examined on methodology and conclusions.	Any material in a language other than English would need to be translated.	
Photocopies	Notarization	Legalization		
Admissible whether the original is not available and whether exhibited to a sworn affidavit.	No.	No.		



Cambodia

Contributors: Tom Treutler (Tilleke & Gibbins)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, Cambodia has specific protection for Well-Known Marks.

However, there is no procedure for issuance of Certificate of Recognition for Well-Known Marks. Cambodia is a member of Paris Convention, so the Article 6bis of Paris Convention for Well-Known Marks can be also applied in Cambodia.

Although there is no specific article for detailed protection for Well-known Marks, the protection of Well-Known Marks is mentioned or found in some articles of the trademark law relating to infringements. For example, according to the Sub-Decree on the implementation of the law concerning marks of Cambodia, a registered mark shall be removed from the Register when the registered trademark owner adds sign(s)/label(s) which is/are identical with or similar to well-known signs/label previously used by a prior-rights owner and they cause confusion to the public.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Please Refer to Chart.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, a definition of Famous Marks is not found in trademark laws of Cambodia. In general, Famous Marks are understood as Well-known Marks.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Survey Evidence
Cambodia Darani Vachanavuttivong/ Pattarapond Duangkaewwutthikrai, Tilleke & Gibbins - Thailand	Annual worldwide sales figures and annual local sales figures for at least 5 years	Annual worldwide expenditure figures and annual local expenditure figures for at least 5 years	Sample copies of invoices of sales of products bearing the mark; sample copies of bills of lading are relevant.	Showing as many products as possible	Not required, but recommend
Online & Other Adverts	Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement
Trade fairs, fashion shows, distributors and stores list are relevant.	Relevant, no special requirements	Wiki or Google search results etc. are relevant.	Explain prestige of awards or recognition.	List of worldwide trademark registration is required. Owner's home country certificate is preferable.	Local and foreign including raids, customs, Court actions, etc.

Authentication and Relevance of Evidence

Country / Volunteer		Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	
Cambodia Darani Vachanavuttivong/ Pattarapond Duangkaewwutthikrai, Tilleke & Gibbins - Thailand		At least 5 years and must be pre-filing evidence.	At least theory, the weaker the mark the more evidence will be needed to show FW status.	Local evidence of use and fame is required.	Relevant, but printed evidence is more persuasive.	
Foreign Evidence	Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Local evidence is key. Can supplement with foreign evidence.	Not required, but recommend	World's most famous brands rating is preferable.	English translation is required.	Preferably certified copies	All evidence and documents should be incorporated in form of an Affidavit. The Affidavit needs to be notarized.	Not required by the Trademark Office, but it might be required if evidence submitted to the Court.



China

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1. Does your country have specific recognition/protection for Well-Known Marks?

Yes. The PRC Trademark Law explicitly protects well-known marks. The protection is available for both registered well-known marks and unregistered well-known marks.

Article 13 of the PRC Trademark Law

"The holder of a trademark well-known to the relevant public may apply for protection of a well-known mark in accordance with this Law if he considers his rights are infringed.

A trademark that constitutes a reproduction, an imitation, or a translation, liable to create confusion, of another's well-known trademark not registered in China and that is the subject of an application for registration for identical or similar goods shall be refused registration, and its use shall be prohibited.

A trademark that constitutes a reproduction, an imitation or a translation of another's well-known trademark registered in China and that is the subject of an application for registration for dissimilar goods or services shall be refused registration, and its use shall be prohibited, if the use of such trademark would confuse the public and possibly prejudice the interests of the registrant of the well-known trademark."

Well-known marks can be recognized in administrative and registration proceedings by the PRC Trademark Office (TMO), in administrative cases handled by the Administration of Industry and Commerce (AIC), in disputes by the PRC Trademark Review and Adjudication Board (TRAB), and in judicial proceedings by authorized People's Courts.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Content requirements

When recognizing a well-known trademark, the following factors shall be considered:

- a. the **degree of fame** of the trademark among the relevant public;
- b. the **length of continuous use** of the trademark, include materials evidencing the use of the mark and its registration history and scope;
- c. the **continuous length, degree and geographical scope of any publicity** for the trademark, including materials evidencing the method, geographical scope, variety of

- public media employed, and number of published advertisements in advertising and promotional activities;
- d. the **record of protection** of the trademark as a **well-known trademark**, including materials evidencing that the mark has previously been accorded protection as a well-known mark in China or other countries and regions; and
 - e. **other factors** associated with the trademark's being well-known, including materials evidencing the output, sales volume, sales revenue, pre-tax profits and sales territory during the most recent three years of the main goods for which the trademark is used.

Quality requirements

When submitting evidence for well-known mark recognition, brand owners should provide evidence that meet the following requirements:

- a. **Original**: to file and present original documents instead of copied documents
- b. **Concerning use in Mainland China**: to provide evidence showing the use and fame of the mark in Mainland China, not in foreign countries
- c. **Available before the filing date of the disputed marks**: the evidence should predate the application of the disputed marks.
- d. **Preferably from a non-interested third party**: evidence from the brand owner or an interested third party is of limited evidential force.
- e. According to the newest notice, 3 years after registration or 5 years of use is going to be a requirement for proving well-known marks, although in particular situations, this could be less restrictive.

The difficulty of preparing evidence that is acceptable to the PRC authorities is illustrated by the very small number of foreign marks recognized as well-known marks each year, as shown in the table below.

Timing of evidence can prove a mark was well-known prior to the date of evidence.

Issues Regarding the Recognition and Protection of Well-Known Trademarks

In disputes involving the opposition or cancellation of a mark under Art. 13(2) or 13(3) of the Trademark Law entering into effect on May 1, 2014 (the "Trademark Law"), the key criterion should be whether the cited mark achieved well-known trademark status prior to the application date of the disputed mark. Evidence submitted by the relevant party showing that the cited trademark was recognized as a well-known trademark after the application date of the disputed mark may be capable of proving that the cited mark had achieve well-known trademark status prior to the application date of the disputed mark, and such evidence should be admissible.

Numbers of Well-Known Marks Recognized in China (2004 – 2012) (Information Collated from Website of State Administration for Industry and Commerce

	Total recognition		AIC recognition in administration		TMO recognition in opposition		TRAB recognition	
	Chinese marks	Foreign marks	Chinese marks	Foreign marks	Chinese marks	Foreign marks	Chinese marks	Foreign marks
2004	121 (85%)	21 (15%)	112	4	1	14	8	3
2005	166 (94%)	11 (6%)	135	1	8	7	23	3
2006	171 (95%)	9 (5%)	140*	9*	7*	7*	31	0
2007	185 (93%)	13 (7%)	131	1	8	8	47	4
2008	210 (92%)	18 (8%)	132	4	22	11	56	3
2009	371 (95%)	19 (5%)	275	2	14	8	82	9
2010	669 (98%)	13 (2%)	509	1	25	7	135	5
2011	848 (97%)	26 (3%)	635	4	47	5	166	17
2012	1285 (99%)	13 (1%)	902	0	61	5	322	8

The correct data for the year 2007 should be listed as follows:

	Total Recognition		AIC Recognition in administration		TMO Recognition in opposition		TRAB Recognition	
	Chinese marks	Foreign marks	Chinese marks	Foreign marks	Chinese marks	Foreign marks	Chinese marks	Foreign marks
2007	184(93%)	13(7%)	129 (rather than 131)	1	8	8	47	4

**In 2006, the Trademark Office only published the total number of well-known marks recognized by the Office, without distinguishing between well-known marks recognized in AIC administrative proceedings and those recognized in TMO opposition proceedings.*

The above table only includes the numbers of well-known marks recognized by administrative authorities. In China, well-known marks can also be recognized judicially by authorized People's Courts. More than 300 marks received judicial recognition between 2001 and 2007. Since 2006, the Supreme People's Court in China has sought to establish a national system for recording, reviewing and publishing well-known marks recognized by People's Courts in various geographical regions. Currently, local courts are required to report to the Supreme People's Court of decisions in which a well-known recognition is made. However, the Supreme People's Court has not made available the records for public enquiries. Published examples of foreign marks that have been judicially recognized as well-known marks in China include in August 1987, TMO recognized, for the first time, a foreign well-known trade mark (PIZZA HUT). In 1989, it did so for the first Chinese well-known trade mark (Tong Ren Tang). "SAFEGUARD", "DUPONT" and "WAL-MART".

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

Yes, Interpretation by the SPC to read dilution into Article 13 of the TM Law.

Although Chinese courts have made reference to dilution in the past, a form of dilution has been formally recognized as being a part of Chinese trademark law only since the issuance of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law to the Trial of Cases of Civil Disputes over the Protection of Famous Trademarks, April 23, 2009. The Chinese concept of 'dilution' serves as a basis for refusing the registration of reproductions, imitations or translations of well-known trademarks.

Article 9: Where it is sufficient to the relevant general public be **confused** about the origin of the commodity with regard to the use of the famous trademark and the trademark against which the lawsuit is lodged or it is sufficient to make the relevant general public believe that

there exists a licensed use, relationship of affiliated enterprises or any other particular connection between the use of the famous trademark and the business operator of the trademark against which the lawsuit is lodged, this would fall within the circumstance of being “likely to cause confusion” as described in paragraph 1 of Article 13 of the Trademark Law.

Where it is sufficient to make the relevant general public believe that there is (1) a certain connection between the trademark against which the lawsuit is lodged and the famous trademark and (2) as a result the distinctiveness of the famous trademark is **diluted** and the market reputation of the famous trademark is degraded or the market reputation of the famous trademark is improperly utilized, this would fall within the circumstance as provided in paragraph 2 of Article 13 of the Trademark Law: “...misleads the general public and leads to possible damage to the interests of the registrant of that famous trademark”.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

The same evidence for demonstrating that a mark is famous, as well as evidence demonstrating the use of the mark by other party, is necessary. They need to show that the reputation of the mark is affected.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts	Owner's Website
China Chris Smith	Sales figures (output, sales volume, sales revenue, pre-tax profits and sales territory) of the main goods for which the mark is used	Advertising figures (duration, method, geographical extent, media type, expense, number)	Invoices and sales contracts	Advertising contracts and pictures of advertising materials	Copies of webpages with online ads, copies of magazines containing ads, photos of spot ads, signboards, etc.	History and use status of the trademark by the owner
3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence		
Rankings and market values assessed by non-interested third parties	Industrial certificates issued by national industrial association or administrative authorities	List of global registrations with copies of registration certificates	Protection as a well-known mark in China and other countries or regions	Surveys on publicity and market share issued by non-interested third parties		

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence	Foreign FW Recognition
China Chris Smith	Sales records, invoices and advertising records during the most recent three years Must predate the application of the disputed marks	Background of the creation of the trademark and its history, the originality of the trademark	Evidence in Mainland China receives more weight than foreign evidence	Of limited evidential value and viewed with suspicion	Of limited evidential value	Previously accorded protection as a well-known mark in foreign countries or regions
Brand Value	Translation	Photocopies	Notarization	Legalization		
Rankings and brand values assessed by non-interested third parties	All evidence in foreign language should be translated into Chinese	Original documents are preferred Financial reports should be stamped by local finance or tax department	Notarization is helpful for non-original evidence	Evidence produced outside China should be legalized		



Hong Kong

Contributors: Rebecca Lo (Rebecca Lo & Co), Ella Cheong (Ella Cheong (Hong Kong & Beijing)),
Shirley Kwok (King & Wood Mallesons LLP), Chris Smith (Baker & McKenzie)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes. Section 12(4) of the Trade Marks Ordinance (Cap.559) (relative grounds for refusal applies to examination and opposition and rectification proceedings) and section 18(4) (applies to infringement proceedings).

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Please Refer to Chart.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No specific recognition/protection for Famous Marks.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Hong Kong Patsy Lau (Updated by Rebecca Lo)	Annual sales figures for at least 5 years. (Evidence for a shorter period is acceptable if the evidence is overwhelmingly abundant.) Breakdown for each mark and at least each class of goods. For some cases it may be helpful to also include no. of units sold.	Annual sales figures for at least 5 years. (Evidence for a shorter period is acceptable if the evidence is overwhelmingly abundant.)	Sample copies from each year, and need to match product codes to products	Showing as many products as possible	Editorial features, trade fairs, fashion shows, distributors and stores list
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Need to supplement with domain name search to show date of first registration of domain name. Use date backed by Internet search.	Wiki or Google search results etc. are relevant.	Explain prestige of awards or recognition.	At least from owner's home country and some Commonwealth countries whose trademark laws are similar to Hong Kong. CTM registration also relevant.	Local and foreign enforcement including raids, customs seizure, Court actions, etc.	Useful in some cases but are usually subject to heavy scrutiny as with European decisions.

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Hong Kong Patsy Lau (Updated by Rebecca Lo)	At least 5 years (evidence for a shorter period is acceptable if the evidence is overwhelmingly abundant) and must be pre-filing evidence. Evidence needs to be dated, but for example © notice on printed ads or date stamp on photos will suffice.	At least in theory, the weaker the mark the more evidence will be needed to show FW status.	Local evidence of use and fame is necessary. No restriction on locality within Hong Kong but say store locations should be relevant to business nature.	Relevant but need to be pre-filing and relate to Hong Kong. Even chat-room evidence can be relevant but subject to challenge	Local evidence is key. Can supplement with foreign evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Recognition from Commonwealth jurisdictions are particularly persuasive, but for example if it is Chinese characters mark, then from China, Taiwan, etc. may be relevant too.	Such as say independent auditor's report or world's most famous brands rating etc.	At least relevant sections and English translation should be certified	Preferably certified copies, otherwise subject to challenge	Yes if signed outside of Hong Kong	Not required unless required by owner's or signatory's home jurisdiction or corporate regulations



Indonesia

Contributors: Adolf Panggabean (Hiswara Bunjamin & Tandjung)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes. Article 6(1)(a) of the Indonesian Trademark Law No. 15/2001 provides the protection for well-known marks covering similar goods, stating that

“An application for registration of a mark shall be refused by the Directorate General if the relevant mark has similarity in its essential part or in its entirety with a mark owned by another party for the same kind of goods and/or services.”

Further, Article 6(2) of the Indonesian Trademark Law No. 15/2001 states that such a provision is applicable against dissimilar goods provided that it fulfills certain conditions that will be further regulated by Government regulation.

This government regulation has not yet been issued, leaving a large gap in protection for well-known marks covering dissimilar goods (as evidenced by the recent BABY DIOR case decided by the Supreme Court against Christian Dior). While these provisions can technically be cited during the registration process, they will be of little persuasive value when up against conflicting prior registrations, as Indonesia is a first-to-file jurisdiction.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

The proper preparation of sufficient evidence is crucial for trademark disputes in Indonesia, especially in the litigation context (e.g., cancellation proceeding). In order to establish that a mark is well-known, the Elucidation to Article 6(1)(b) identifies the followings inputs to make such a determination:

- Knowledge or recognition of the mark in the relevant sector of the public;
- Vigorous promotion;
- Worldwide investment;
- Foreign trademark registrations; and
- Market survey.

Of the above inputs, it could be said that foreign trademark registrations and evidence of commercial use, either inside or outside Indonesia (bullet points 2 and 3) have been found by decision-makers to be the most persuasive in establishing that a mark is well-known.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No. Currently, there are no provisions in the Indonesian Trademark Law that provide protection for famous marks under the dilution doctrine. This has created another gap in protection for famous marks in Indonesia.

While it may theoretically be possible to use the unfair business competition provisions found in the Civil Code (Article 1365) and Criminal Code (Article 382bis) as a stop-gap in the enforcement/litigation context, in practice these provisions are not suitable to support actions for trademark dilution. In the prosecution context, the Trademark Office may refuse registration of a mark if it appears to be similar in its essential part or in its entirety to a famous mark previously registered in Indonesia.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Not Applicable.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts	Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Indonesia	Yes	Yes	Yes	Yes	Yes	Yes	Yes	Yes	Yes	Yes	Yes

Authentication & Relevance of Data

Country / Volunteer	Dates	Inherent Strength of Mark		Geographical Coverage	Internet Evidence	Foreign Evidence	Foreign FW Recognition
Indonesia	Prior to the date of the application.	Is not considered very relevant by decision-makers. Instead, greater emphasis is placed upon evidence of commercial use and/or foreign registration certificates.		Evidence of use in Indonesia or foreign countries is acceptable.	Yes	Yes	Yes
Brand Value	Translation	Photocopies	Notarization	Legalization			
Yes	Yes, all evidence must be translated into Indonesian. For litigation, must be certified translation.	Yes, but needs to be notarized and/or legalized for litigation.	Yes for litigation; No for prosecution/registration.	It is not required but it would be more convincing if it is legalized (for litigation).			



Laos

Contributors: Tom Treutler (Tilleke & Gibbins)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

According to Article No. 16 of the Law on Intellectual Property of Laos, a trademark shall be deemed well-known when it meets all the following requirements:

1. the trademark is widely recognized by the relevant sector within the territory of the Lao PDR, as indicating the goods or services of the proprietor of the mark that is claimed to be a well-known mark;
2. the trademark is not contrary to the requirements for registrability in the Lao PDR;
3. In considering whether a mark is a well-known mark, any reasonable evidence may be taken into account, including evidence of such facts as are mentioned below:
 - 3.1 the relevant sector of the public recognize the trademark by way of trade, use of the trademark on or in connection with goods or services or through advertising;
 - 3.2 the products, goods, services are widely circulated bearing the trademark within the territory;
 - 3.3 the volume of goods sold or services provided;
 - 3.4 regular and continuous period of use of the trademark;
 - 3.5 goodwill associated with use of the trademark with the goods or services based on such factors as good quality, service, or their popularity;
 - 3.6 domestic consumers certify and widely recognize the reputation of the trademark;
 - 3.7 high value of investment in the trademark.

A well-known trademark, whether is registered or not, shall be protected in accordance with laws and regulations.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Please Refer to Chart.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, a definition of Famous Marks is not found in trademark laws of Laos. In general, Famous Marks are understood as Well-known Marks.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

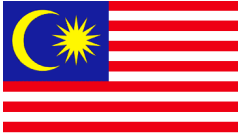
Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Laos Darani Vachanavuttivong/ Pattarapond Duangkaewwutthikrai, Tilleke & Gibbins - Thailand	Annual worldwide sales figures and annual local sales figures for a long period of times.	Annual worldwide expenditure figures and annual local expenditure figures for a long period of times	Sample copies of invoices of sales of products bearing the mark; sample copies of bills of lading are relevant.	Showing as many products as possible.	Trade fairs, fashion shows, distributors and stores list are relevant.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Relevant, no special requirements	Wiki or Google search results etc. are relevant.	Explain prestige of awards or recognition.	List of worldwide trademark registration. Owner's home country certificate is preferable.	Local and foreign including raids, customs, Court actions, etc.	Not required, but recommend.

Authentication & Relevance

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Laos Darani Vachanavuttivong/ Pattarapond Duangkaewwutthikrai, Tilleke & Gibbins	N/A	N/A	Local evidence of use and fame is required.	Not required, but recommend.	Local evidence is key. Can supplement with foreign evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Not required, but recommend.	World's most famous brands rating is	English and/or Lao translation is required.	Preferably certified copies.	Not required, but recommend that all evidence and documents should be incorporated in form	Not required.



Malaysia

Contributions: Candice Kwok (Marks & Clerk Singapore LLP)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes. Well-known trademarks are protected under Section 70B of the Malaysian Trade Marks Act, 1976. The proprietor of a trade mark which is entitled to protection under the Article 6bis of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark is entitled to restrain by injunction the unauthorized use in Malaysia in the course of trade of the trade mark which is identical with or nearly resembles the proprietor's mark, in respect of the same goods or services, where the use is likely to deceive or cause confusion.

However, it shall not affect the continuation of any bona fide use of a trade mark begun before the commencement of this Act. (i.e. 1st December 1997) A well-known mark is well-known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia. The Registry may refuse registration of a trade mark if it is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Regulation 13B of the Trade Marks Regulations 1997 provides some criteria to be taken into account in determining whether a mark is qualified as a well-known trade mark, as follows:

- (a) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- (b) the duration, extent and geographical area of any use of the mark;
- (c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services which the mark applies;
- (d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;
- (e) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well-known by competent authorities;
- (f) the value associated with the mark.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Malaysia	Yes	Yes	Yes	Yes	Yes
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes	Yes	Yes	Yes (those from countries of a similar legal background, i.e., Commonwealth countries tend to be more persuasive.)	Yes	It may be accepted either by the Registry or Court provided established criteria regarding survey evidence are met. The Examiner and the Court has discretion whether to accept the survey evidence although that discretion has to be exercised judiciously.

Authentication & Relevance

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Malaysia	The earlier the use evidence establishing fame, the better.	Not directly relevant. Mark may have high inherent distinctiveness but it still needs to be shown that it is famous and well-known in so far as the local public is concerned. Although a highly distinctive may make it more easily recognizable.	Relevant. The wider the recognition within the country and outside, the better.	Yes	Yes. Although evidence of use and fame in Malaysia remain primary, usage or fame outside Malaysia acts only as supporting evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Relevant as supporting evidence. Local recognition is primary.	Yes	Yes. Certified English translation is required.	Yes.	For Registry proceedings, a statutory declaration or affidavit affirmed before a commissioner for oaths or notary public is acceptable. For court proceedings, affirmation may be before the commissioner for oaths or a consular officer of the Malaysian Embassy.	No.



Myanmar

Contributors: Tom Treutler (Tilleke & Gibbins)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

No.

Currently there is no trademark law in Myanmar. However, there is established interim protection for a trademark in place, allowing you to file an application to record a Declaration of Ownership of a Trademark. When you record a Declaration of Ownership, your trademark will be protected for three years from the registration date.

After you have completed the recordation of the Declaration of Ownership, it is an established practice for an applicant to publish a Trademark Cautionary Notice in a local newspaper every three years. It is not compulsory for you to publish a Cautionary Notice, but it can be very helpful to remind the public that you own the trademark and to ward off any possible passing-off or infringement of your mark.

It is important to understand that the recordation of a Declaration of Ownership of a Trademark and the publication of a Cautionary Notice in a local newspaper have different objectives. The Declaration of Ownership serves as a practice to ensure that your rights remain unquestionable in the case of any future court litigation, while the publication of a Cautionary Notice is an important deterrent which serves as a warning against potential infringement.

The Myanmar government is in the process of reviewing and revising the 11th draft of Myanmar's inaugural Trademarks and Service Marks Law in preparation for its implementation. There is a great deal of anticipation that the Law will be passed in June or July 2014, and may become effective soon thereafter. Previously, the Law was expected to come into effect by the end of 2013, but it has been delayed. The 11th draft of the law was expected to be published in Myanmar newspapers for public comment in March 2014. However, it has been delayed again.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

As detailed above, there is no Well-Known trademark system in Myanmar. Therefore, the necessary evidence for proving it cannot be provided at present. However, the legal system of Myanmar is common law; therefore, the actual use of a trademark in Myanmar is very important.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, as in our responses in Nos. 1 and 2, there is no trademark law in Myanmar yet.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

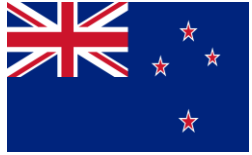
Not Applicable.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$		Invoices	TV / Printed Adverts	Online & Other Adverts
Myanmar Darani Vachanavuttivong/ Yuwadee Theangarm, Tilleke & Gibbins – Myanmar	Annual sales figures/ no. of units sold (if relevant) for as long a period as possible, only in Myanmar.	Annual advertising figures for as long a period as possible in Myanmar.		Sample copies from each year that show the use and sales in Myanmar.	All media material from TV, articles, press, magazines that has been advertised in Myanmar.	Radio, websites and social media, editorial features, points of sale, samples, sponsorship, events such as trade fairs and fashion shows, distributors and stores lists that happen in Myanmar.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence	
This website is necessary to show that solely the owner has distributed this trademark in Myanmar.	Google/ search engine search results can be useful. Any website is useful if it shows that this trademark is used, sold and distributed in Myanmar.	If there are any, they will help support.	The registration of Declaration of Ownership of Trademark is important than other countries.	If any, it will help support.	If any, it will help support.	

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
<p>Myanmar</p> <p>Darani Vachanavuttivong/ Yuwadee Theangarm, Tilleke & Gibbins – Myanmar</p>	<p>Relevant date will be:</p> <ul style="list-style-type: none"> • the filing date of a similar mark; • the use of the mark; or • the date of the alleged infringement <p>All dates should be from Myanmar.</p>	Not specific	Ideally, evidence should show use throughout Myanmar.	It can be used, but the use should be in Myanmar.	It can be used for supporting the mark. However, the important documents should be from Myanmar.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Useful, but will need to show a localized reputation in Myanmar.	Useful.	Documents may be filed in English or Burmese. If in any other language, a verified English translation is required.	Acceptable.	Required for the Power of Attorney and some official documents.	Required for the Power of Attorney and some official documents.



New Zealand

Contributors: Christopher Young (Minter Ellison Rudd Watts)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes, there are a range of provisions in the Trade Marks Act 2002 to prevent registration of well-known marks including:

- section 17, which prevents registration of a trade mark or any part of a trade mark:
 - the use of which would be likely to deceive or cause confusion; or
 - the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court (such as if it were misleading or deceptive to consumers in breach of the Fair Trading Act 1986); or
 - if the application is made in bad faith.
- section 25(1)(a), which prevents registration of a trade mark in respect of any goods or services if it is identical to a trade mark belonging to a different owner and that is registered in respect of the same goods or services or goods or services that are similar to those goods and services, and its use is likely to deceive or confuse;
- section 25(1)(b), which prevents registration of a trade mark in respect of any goods or services if it is similar to a trade mark that belongs to a different owner and that is registered in respect of the same or similar goods or services and its use is likely to deceive;
- section 25(1)(c), which prevents registration of a mark similar or identical to a well-known mark if use of the mark applied for would be likely to prejudice the interests of the owner of the well-known mark. If the respective goods or services are not identical or similar, that use must be taken as indicating a connection in the course of trade between those goods or services and the owner of the well-known mark.

There is also other provision relating to civil proceedings for infringement of marks including Well-Known Marks:

section 89, which provides that infringement of a registered trade mark occurs if the person does not have the right to use the registered trade mark and uses in the course of trade a sign that is identical to the registered mark in relation to any goods or services for which it is registered in respect of; or uses a sign that is identical with the registered mark in relation to any goods or services that are similar to any goods or services in respect of which the trade mark is registered if that use would be likely to deceive or confuse; or uses a sign that is similar to the registered trade mark in relation to any goods or services that are similar to any goods or services in respect of which the mark is registered, where that use would be likely to deceive or confuse.

Additionally, section 89(1)(d) and section 94 which provide that:

(1) A person infringes a registered trade mark if the person does not have the right to use the registered trade mark and uses in the course of trade a sign—...

*(d) identical with or similar to the registered trade mark in relation to any goods or services that are not similar to the goods or services in respect of which the trade mark is registered **where the trade mark is well known in New Zealand** and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.*

section 94, which provides that a registered trade mark (which would include a Well-Known Mark) is not infringed by the use of the registered trade mark for the purposes of comparative advertising, but such use must not be dishonest, without due cause, take unfair advantage of, or be detrimental to the distinctive character or the repute of the trade mark.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Evidence will need to establish that the mark is “*well-known in New Zealand* whether through advertising or otherwise”. Generally, evidence falls into two categories:

- use of and reputation in the mark in New Zealand (sales and advertising expenditure, examples of use etc.); and/or
- “spillover reputation” i.e. that the mark is widely known in other countries and, because of the strength of reputation in those countries, the mark is known in the relevant market in New Zealand – typically we would obtain statistics from New Zealand government sources to try to support and substantiate the “spillover reputation” argument e.g. the number of travellers between New Zealand and relevant countries, advertisements in foreign publications and circulation statistics for New Zealand, use over the Internet and “hits” from New Zealand, declarations from third parties. Recent decisions indicate a high threshold is needed for the quality of this type of evidence to be considered appropriate.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes: “Famous” marks would be protected by the same provisions as protect well known marks – see our responses to questions 1 and 2 above.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
New Zealand Christopher Young	Annual sales figures/ no. of units sold (if relevant) for as long a period as possible. Breakdown per mark and product/ service if possible. Percentage of market share also useful.	Annual advertising figures for as long a period as possible. Breakdown per mark and product/ service if possible. Extend to less direct forms of advertising including sponsorship	Sample copies from each year, match product codes to products, over full range	Useful to show as many products and forms of advertising (e.g. products and packaging, magazines, articles, catalogues, posters etc.) as possible and over a number of years and wide geographical spread.	Radio, websites and social media, editorial features, point of sale, samples, sponsorship, events such as trade fairs and fashion shows, distributors and stores list. Also provide circulation statistics and distribution information.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Useful. Also provide whose information (date domain name registered), and number of website "hits" from New Zealand and in total. Consider historic searches. If foreign owner, evidence of orders from NZ customers or intention to gain sales from New Zealand (e.g. NZ\$ option, delivery to NZ possible etc.) including sales through website if possible	Google/ search engine search results can be useful. NZ retailer sites if mark owner is manufacturer/wholesaler Sponsorship	Explain prestige of awards or recognition. Useful if focused on the New Zealand market.	At least from owner's home country and Commonwealth countries.	Local and foreign including raids, customs, Court actions, etc.	Very useful but will be subject to scrutiny. Surveys must be carefully designed to ensure admissibility and weight.

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
New Zealand Christopher Young	<p>Relevant date will be:</p> <ul style="list-style-type: none"> the filing date of a similar mark; or the date of the alleged infringement <p>Exhibits should be dated.</p>	<p>Relevant in infringement proceedings where there is a requirement to show the infringing use is detrimental to the distinctive character of the well-known mark. Whether the owner has taken care not to dilute the mark may also be considered.</p>	<p>Ideally, evidence should show use throughout New Zealand</p>	<p>Reputation elsewhere will not be of particular assistance unless it can show a localized reputation in New Zealand. Generally supplying evidence of statistical information on immigration/ tourist numbers etc. may be required, and evidence linking how this group would be aware of the brand.</p>	<p>Reputation elsewhere will not be of particular assistance unless it can show a localized reputation in New Zealand. Generally supplying evidence of statistical information on immigration/ tourist numbers etc. may be required, and evidence linking how this group would be aware of the brand.</p>
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
<p>Useful but will need to show a localized reputation in New Zealand. Generally supplying evidence of statistical information on immigration/ tourist numbers etc. may be required, and evidence linking how this group would be aware of the brand.</p>	<p>Useful.</p>	<p>Documents may be filed in English or Maori. If in any other language, a verified English translation is required.</p>	<p>Acceptable.</p>	<p>Not required.</p> <p>Note though evidence needs to be provided in the form of an affidavit or statutory declaration sworn by the witness before an appropriately qualified person.</p>	<p>Not required.</p> <p>Note though evidence needs to be provided in the form of an affidavit or statutory declaration sworn by the witness before an appropriately qualified person.</p>



Philippines

Contributors: Neptali Bulilan (Sapalo Velez Bundang & Bulilan)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes. Well-known trademarks are recognized in the Philippines, following Section 123.1(e) and Section 123.1(f) of R.A. 8293 of the Intellectual Property Code (1998). While both marks are protected, a line is drawn between well-known marks which are not registered in the Philippines, and those which were duly registered. If registered, the exclusive right of the owner of a well-known mark extends to goods which are dissimilar to those by which the mark was registered. This is established by determining whether or not the use of the mark would indicate a connection between the owner of the mark and the dissimilar goods, and whether the interests of the owner of the mark would likely be damaged.

On the other hand, a well-known mark which is not registered in the Philippines is likewise protected, but shall not extend to unlike goods with respect to which the mark was originally registered.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

In general, Section 123.1(e) provides that the determination of well-known mark is based on the consideration of competent authority, taking into account the knowledge of the relevant sector of the public, including knowledge in the Philippines as a result of promotion. Rule 100(c) of Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers define competent authority as the Court, the Director General, the Director of the Bureau of Legal Affairs, or any administrative agency or office vested with quasi-judicial or judicial jurisdiction to hear and adjudicate any action to enforce the rights to a mark.

Specifically, Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers provide for determinants to verify if a mark is well-known, namely:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;

- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and,
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes. While R.A. 8293 (1998) does not explicitly define trademark dilution, the doctrine is impliedly recognized, following Sec. 147.1 - 147.2 and Section 168, and case law, which defined trademark dilution as: “the lessening of the capacity of a famous mark to identify and distinguish goods and services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception (Levi Strauss & Co. v. Clinton Apparelle, Inc., G.R. No. 138900, September 20, 2005).

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed	Online & Other	Owner's Website	3P Website	Industrial Awards
Philippines	Yes	Yes	Yes	Yes	Yes	Yes	Yes	Yes
Foreign Certificates		Successful Enforcement			Survey Evidence			
Yes (in relation to exclusivity of registration and use, and commercial value)	Yes			While the Rules are silent, following the Joint Recommendation adopted by WIPO in relation to Sec. 3 of the IP Code, the same is still possible.				

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Philippines	Relevant, especially when priority right is claimed	Relevant, as the extent of use, commercial value and reputation of the mark are determinant to consider if a mark is well-known	Relevant, as geographic area of use and promotion are determinants to consider if a mark is well-known.	Yes, in relation to advertising	Yes, but requires authentication of Philippine Consul having jurisdiction over the country where they are obtained.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Relevant as supporting evidence. Local recognition is primary	Yes	Yes. Requires certified English translation	Yes, if identified by a relevant person in his affidavit	Yes.	Yes.

Singapore

Contributors: Angeline Raj (Singapore Management University), Francine Tan (Francine Tan Law Corporation)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes. Singapore's Trade Marks Act has specific provisions for the protection of well-known marks. A "well known mark" is defined as "any registered trade mark that is well known in Singapore; or any unregistered trade mark that is well known in Singapore that belongs to a person who (i) is a national of a Convention country or (ii) is domiciled in, or has a real or effective industrial or commercial establishment in, a Convention country". A "Convention country" is a country or territory that is party to the Paris Convention or a member of the WTO.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

The categories of evidence set out in the table below are (except as qualified therein) generally admissible and considered relevant. The Trade Marks Act also provides some guidance as to what would be relevant in determining whether a mark is well known in Singapore (enumerated below). It is to be noted that the Singapore courts have stated explicitly that the fact that the owner of a mark operates a website, in and of itself, would not be relevant or sufficient to establish a well-known status.

Generally speaking, the more evidence is provided and the more the owner is able to show and substantiate the claim that its mark has been extensively used, publicized and widely recognized, the more persuasive it would be.

The Trade Marks Act makes a distinction between marks which are "well known in Singapore" and marks which are "well known to the public at large" in Singapore. With regard to the former, the Act provides that the following matters may be relevant in determining whether a mark is well known in Singapore:

(a) The degree to which the trade mark is known to or recognized by any relevant sector of the public in Singapore;

(b) The duration, extent and geographical area of

(i) any use of the mark;

(ii) any promotion of the trade mark (e.g. advertising, publicity, presentations at any fairs or exhibitions of the goods/services;

(iii) any registration or application for the registration of the trade mark in any country/territory in which the mark is used or recognized, and the duration of such registration or application;

(iv) any successful enforcement of any right in the trade mark in any country/territory, and the extent to which the trade mark was recognized as well known by the competent authorities of that country/territory; and

(v) any value associated with the trade mark.

Where it is determined that the mark is well known to any relevant sector of the public in Singapore [which is defined as including (a) all actual consumers and potential consumers in Singapore of the goods/services to which the mark is applied;

(b) all persons in Singapore involved in the distribution of the goods/services to which the mark is applied;

(c) all businesses and companies in Singapore dealing in the goods or services to which the mark is applied], the mark would be “deemed to be well known in Singapore”. This is what is commonly referred to as “niche fame” well-known marks.

For such niche fame well-known marks, the registration of a later mark would not be permitted if (i) use of the later mark would indicate a connection between those goods/services and the proprietor of the earlier well-known mark, and (ii) is likely to damage the interests of the proprietor of the earlier well-known mark.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes. The Trade Marks Act provides for protection against the dilution of the distinctive character of marks which are “well known to the public at large in Singapore” by the use of a later mark which would cause such dilution in an unfair manner or which would take unfair advantage of the distinctive character of the earlier well known mark. In certain circumstances, injunctive relief against the use of a later identical or similar mark in Singapore may be sought.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

See comments above and below.

In the case of an opposition filed by Seiko Holdings Kabushiki Kaisha against an application filed by Choice Fortune Holdings Limited, the Principal Assistant Registrar considered whether the SEIKO marks had “[entered] the consciousness of the general public in Singapore”.

The survey evidence submitted showed that the SEIKO mark had a recognition rate of 72% among the survey respondents. It was held that given this significant percentage, the significant sales and advertising figures and the extensive reach of the SEIKO marks, the mark SEIKO was well known to such a high degree and recognized by most sectors of the public as to be well known to the public at large in Singapore. (Decision issued on 16 April 2014.)

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other
Singapore Francine Tan	Sales figures pertaining to Singapore and elsewhere. There is no prescribed minimum in terms of number of years of prior use. Evidence of high brand valuation, extensive brand recognition/ high market share rankings. Number of sales outlets/offices and locations worldwide.	Advertising expenditure figures for each year pertaining to Singapore.	Copies of invoices reflecting sales/provision of services and advertising expenditure.	As much as is available -print advertising and in other media.	As much as is available.
Owner’s Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Considered to be weak evidence in and of itself unless it can be shown e.g. that the high number of “hits” or enquiries/ sales via the website emanate from Singapore customers.	Prominence on search engine results is relevant.	Publicity of these in Singapore and materials showing e.g. online discussion forums in Singapore are relevant to establish recognition of the mark by the general public in Singapore or by the relevant sector in Singapore.	Relevant (per the Trade Marks Act).	Relevant (per the Trade Marks Act).	Useful but these come under close scrutiny by the courts.

Authenticate and Relevant Evidence

Refer to Types of Evidence



South Korea

Contributors: FirstLaw P. C. (co-ordinated by Leonora Hoicka, IBM Corporation)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes.

Well-known marks are protected by the Korean Trademark Act (TMA) and Unfair Competition Prevention Act (UCPA) in Korea.

Under the Trademark Act, the owner of a well-known mark in Korea can prevent another party from registering an identical or similar mark in relation to identical or similar goods and/or services (Art. 7(1)9 of TMA). In case of a mark that is not famous in Korea and is only widely recognized in a foreign country, the owner of such mark can also prevent another party from registering in Korea an identical or similar mark in relation to the goods that have close economic relations with the goods and/or services of its prior used mark by proving the wide recognition of the mark in one foreign country and the bad faith of the applicant (Art. 7(1)12 of TMA).

Further, if a mark is famous in Korea and an applied-for mark is highly likely to cause confusion with respect to the source of the goods, such applied-for mark can be rejected according to Art. 7(1)10 of TMA. When a trademark that is liable to mislead or deceive consumers on the quality of the goods or source of the goods, such mark can be rejected pursuant to Art. 7(1)11 of TMA.

Under the UCPA, the owner of a well-known mark in Korea can prevent another party from using an identical or similar mark when consumer confusion is likely even though such well-known mark is not registered.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Please Refer to Chart.

The most important evidence to establish the well-known/famous status of a mark is financial data (i.e. materials showing market share, sales volumes and advertising expenditures for products bearing the mark, receipts/notes of confirmation from advertising agencies, annual financial reports, etc.)

The categories of evidence in the below table are all generally acceptable and are helpful in demonstrating that a mark is well-known in/or outside of Korea. Other useful evidences are press releases relating to products bearing the mark, newspaper and magazines articles, and prior decisions recognizing the well-known status of the mark.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes. An act of damaging the distinctiveness or reputation attached to another person's sign by using a sign identical or similar to another person's name, trade name, trademark, container or package of goods or any other sign widely known in the Republic of Korea as an indication of goods or commerce, or by selling, distributing, importing or exporting goods with such sign is defined as an unfair competitive act under Article 2(i)(c) of the UCPA.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

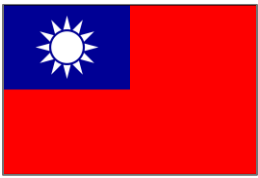
Please refer to the chart below. The most important evidence to establish the well-known/famous status of a mark is financial data.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
South Korea Young-June Yang	Annual sales revenues, annual sales units, market shares and/or sales ranking for the goods or services using the mark	Annual advertisement expenditures for goods or services using the mark Advertising materials promoting products bearing the mark (such as copies of newspapers, magazines or other kinds of publications - the title and date of the publication must appear on the submitted materials)	Not necessary	Helpful	Helpful - Including mentioning of well-known/famous trademark in newspaper and magazine's articles
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Helpful History, size and locations of the company using the mark, brand history and/or materials showing uses of the mark	Search results of Wikipedia, Google or any websites that may be relevant in showing the well-known/famous status of the mark	Korea or international Necessary to explain the prestige of the award or its reputation	Helpful	Favorable court decisions recognizing the fame/well-known status of the mark	Not necessary but helpful if submitted

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
South Korea Young-June Yang	Evidence should preferably cover period of 3 to 5 years prior to relevant date.	Yes. However, distinctiveness is not an issue if descriptive mark acquired secondary meaning.	National fame/well-known status	Yes.	Yes, for preventing another party from registering an identical or similar mark in Korea. Bad faith must also be demonstrated in such cases.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Yes, for preventing another party from registering an identical or similar mark in Korea. Bad faith must also be demonstrated in such cases.	Yes. Brand valuation or ranking information from independent auditors or recognized brand rating institutes	Evidence written in foreign languages needs to be translated into Korean. However, summary translation is acceptable.	Yes. No need to be certified.	No. However, declaration or affidavit must be notarized.	No.



Taiwan

Contributors: Laura Wen-yu Young (Wang and Wang, LLP)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Famous and well-known marks are synonymous in Taiwan. Taiwan's Trademark Act expressly protects well-known trademarks.

A determination of whether a trademark is well-known is reviewed from the perspective of the relevant Taiwanese consumers and is made on a case-by-case basis by the Taiwan Intellectual Property Office (TIPO), the courts, the Fair Trade Commission, or the Taiwan Network Information Center (TWNIC).

Taiwan does not maintain a separate register of well-known marks, but the TIPO has published a list of marks that have been deemed to be well-known in individual cases decided by these entities that is referenced in determining whether a mark is well-known. For a mark on this list, the amount of evidence required to establish that it is well-known is generally lower than for other marks.

Under the Trademark Act, there are three specific types of protection explicitly extended to well-known trademarks:

- a) the right to prevent another from registering a similar mark that creates a likelihood of confusion or a likelihood of diluting the distinctiveness or reputation of a well-known mark registered or unregistered in Taiwan;
- b) the right to prevent another from using a similar mark that creates a likelihood of confusion or dilutes the distinctiveness or reputation of a well-known mark registered in Taiwan; and
- c) the right to prevent another from using the distinctive elements of a famous/well-known mark as the company name, trade name, domain name or other indication of source if such use creates a likelihood of confusion or dilutes the distinctiveness or reputation of a well-known mark registered in Taiwan.

To raise the claims of infringement or dilution of the well-known mark as provided in the Trademark Act, the well-known trademark must be registered in Taiwan.

There is redress under the Fair Trade Act trade dress protections for unregistered well-known marks.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

The categories of evidence in the table below are all generally admissible and are helpful in establishing that a mark is well-known in Taiwan. The authorities typically take into account multiple categories of evidence – no single category is usually determinative. Generally, the more evidence provided, and the earlier the dates of such materials, the more persuasive they are. The authorities will usually not consider undated evidence.

The most persuasive types of evidence are prior decisions by the TIPO or Taiwan courts recognizing the fame of a mark, mass media advertisements, sales and market share data, listing in a famous trademark registry, market survey results, and foreign registration certificates, generally in that order. Evidence of fame within Taiwan carries more weight than evidence from other jurisdictions.

In an opposition, information on prior communications between the owner of the famous mark and the registrant of the opposed mark can be helpful to show bad faith on the part of the registrant.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes. Taiwan's Trademark Act provides protection for famous marks under a dilution doctrine as noted above.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Taiwan Peter Dernbach Joyce Ho, Laura Wen-yu Young	Sales figures for products bearing the mark, market evaluation and value, sales ranking, distribution documents, import/export documents. Materials relating to locations of sale, trade channels for the products.	Figures on advertising expenditures for each year in Taiwan. Specific data on ad size and volume; materials such as applications for placing ads, invoices from ad agencies, copies of ads.	Copies of invoices for sales of products bearing the mark.	Records of TV / radio commercials and print ads on public transport, billboards, store signboards.	Acceptable. Also useful is Online presence, such as Facebook "likes" and website "visits".
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Materials showing when the trademark was created and showing continual use of the trademark, such as in a company description or history. Foreign webpages will need to establish that visitors are from Taiwan, such as by showing IP addresses of visitors.	Search engine results such as from Google, Baidu, or Yahoo are relevant.	Relevant certificates or survey reports provided by credible entities. Publications showing the mark highly ranked by credible domestic or foreign newspaper or magazines, consumer satisfaction surveys, and/or relevant online discussions and evaluations in Chinese. Evidence of public display of marked products exhibited at domestic or foreign trade shows or exhibitions.	List of worldwide registrations, supported by photocopies of registration certificates.	Favorable decisions on fame issued by administrative or judicial authorities, such as opposition decisions, invalidation decisions, administrative appeal decisions, or court decisions. Local rulings carry more weight than foreign.	Can be useful, but subject to strong scrutiny. Credibility of surveying organization is a factor.

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Taiwan Peter Dernbach Joyce Ho, Laura Wen-yu Young	Evidence (including photos) must be dated and pre-date a filing.	Less inherently distinctive marks will likely require more evidence to establish fame.	Local evidence is much more persuasive.	Relevant. Must predate a filing. Blog and chat room discussions also relevant.	Can be relevant. Usually supplemental to local evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Recognition from foreign countries can be relevant, but it is usually required that such foreign FW Recognition is accessible by the relevant consumers in Taiwan.	Rankings by credible and independent domestic or foreign auditors, newspapers or magazines showing the mark is a leading brand, consumer satisfaction surveys.	It is recommended that at least relevant part be translated into Chinese.	Un-certified copies usually acceptable.	Usually not required. Sometimes helpful for copies of non-physical evidence such as online advertisements that could be removed.	Not required.



Thailand

Contributors: Tom Treutler (Tilleke & Gibbins)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes. The Trademark Act B.E. 2534 (1991), as amended by the Trademark Act (No. 2) B.E. 2543 (2000):

Section 8 states “A trademark which possesses or consists of any of the following particulars, shall not be registrable...

(10.) A mark which, according to criteria prescribed by the Minister, is identical or very similar to a well-known trademark so that it confuses or deceives the public as to the proprietor or the origin of the goods bearing the mark, regardless of whether or not the trademark has been registered;”

Section 61 states “Any interested person or the Registrar may request the Board to cancel the registration of a trademark if it appears that when filed, the trademark was:

1. ...
2. Forbidden for registration under Section 8;
3. ...
4. ...”

According to the Department of Intellectual Property (DIP)’s regulation concerning the recordation of well-known marks, to be recordable, a well-known mark must meet the following criteria:

- a trademark, service mark, certification mark, collective mark, or any other mark that is used on items other than goods or services;
- a registered or unregistered mark;
- the same mark for which recordation is sought;
- a mark that 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 continuously to the present;
- a mark that has been widely used in the usual manner and in good faith, in Thailand or abroad, such that it is well-known to the general public or those in the relevant industry in Thailand;
- a mark that has been used such that its reputation for quality is highly accepted among consumers; and
- a mark that is used by its trademark owner or his authorized representative or licensee, either locally or abroad.

Please note, however, that the Board of Well-Known Marks has been considering whether to amend the rules and/or regulations in regard to the recordation of well-known

marks. However, there is no clear evidence as to when such amendments will take place, nor is there any indication as to what, in particular, would be amended.

While the Thai Trademark Office is accepting applications for recordation of well-known marks, the examination has, in fact, been suspended for a few years. We assume that this is due to the fact that no conclusion regarding the amendment of the rules/regulations concerning recordation of well-known marks has been reached.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Please Refer to the Chart.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No. However, the stipulations discussed in (1) should provide protection for Famous Marks under a dilution doctrine to a certain extent.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

N/A.

Type of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Thailand/ 'Darani Vachanavuttivong/ Kittiphan Khattiwiriyaphinyo,	N/A	N/A	N/A	N/A	N/A
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
N/A	N/A	N/A	N/A	N/A	N/A

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Thailand/ Darani Vachanavuttivong/ Kittiphan Khattiwiriyaphinyo,	N/A	N/A	N/A	N/A	N/A
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
N/A	N/A	N/A	N/A	N/A	N/A



Vietnam

Contributors: Tom Treutler (Tilleke & Gibbins)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes: Article 4.20 of the Law on Intellectual Property (IP Law) provides that: *A well-known mark* means a mark widely known by consumers throughout the Vietnamese territory.

Article 6.3 of the IP Law recognizes that
...for a well-known mark, industrial property rights shall be established on the basis of use process, not subject to any registration procedures.

Article 75 of the IP Law - Criteria for evaluation of well-known marks

The following criteria shall be taken into account when a mark is considered well-known:

1. The number of involved consumers who have been aware of the mark through purchase or use of goods or services bearing the mark or through advertising;
2. Territorial area in which goods or services bearing the mark are circulated;
3. Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
4. Duration of continuous use of the mark;
5. Wide reputation of goods or services bearing the mark;
6. Number of countries protecting the mark;
7. Number of countries recognizing the mark as a well-known mark;
8. Assignment price, licensing price, or investment capital contribution value of the mark.

Article 130.1.d of the IP Law provides protection for well-known trademark against unfair competition.

Registering or possessing the right to use or using domain names identical with, or confusingly similar to, protected trade names or marks of others, or geographical indications without having the right to use, for the purpose of possessing domain names, benefiting from or prejudicing reputation and popularity of respective marks, trade names or geographical indications.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

As mentioned in Article 75, the following evidence is necessary to prove that a mark is well-known:

1. The number of involved consumers who have been aware of the mark through purchase or use of goods or services bearing the mark or through advertising;
2. Territorial area in which goods or services bearing the mark are circulated;
3. Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
4. Duration of continuous use of the mark;
5. Wide reputation of goods or services bearing the mark;
6. Number of countries protecting the mark;
7. Number of countries recognizing the mark as a well-known mark;

Assignment price, licensing price, or investment capital contribution value of the mark

In practice, evidence will need to establish that the mark is well-known in Vietnam through use and advertising. Generally, evidence should show use and reputation of the mark in Vietnam (use in foreign countries are important, but not decisive factor), and if the case involves a disputed mark, the evidence of use should predate the application of such mark.

Evidence should be included in an affidavit signed by trademark owner's representative and certified by a Notary Public. "Spillover reputation", i.e. that the mark is widely known in other countries and, because of the strength of reputation in those countries, the mark is known in the relevant market in Vietnam –e.g. the number of travellers between Vietnam and relevant countries, advertisements in foreign publications and circulation statistics for Vietnam, use over the Internet and "hits" from Vietnam, declarations from third parties, may be used as additional evidence.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

In Vietnam, the law does not specifically mention Famous Marks. Well-known marks in Vietnam can be protected from dilution.

Article 74.2 (i) provides that "Signs identical with or confusingly similar to another person's mark recognized as a well-known mark which has been registered for goods or services which are identical with or similar to those bearing such well-known mark, or for dissimilar goods or services if the use of such mark may affect the distinctiveness of

the well-known mark or the mark registration is aimed at taking advantage of the reputation of the well-known mark” is considered not distinctive and registrable.

Article 129 provides that “using signs identical with, or similar to, well-known marks, or signs in the form of translations or transcriptions of well-known marks for any goods or services, including those not identical with, dissimilar or unrelated to goods or services on the lists of those bearing well-known marks, if such use is likely to cause confusion as to the origin of the goods or services or misleading impression as to the relationship between users of such signs and well-known mark owners” is an act of infringement.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Please refer to answer for “well-known” marks.

Types of Evidence:

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Vietnam/ Thomas Joseph Treutler/ Nguyen Thi Mai Linh/ Nguyen Hoai Anh, Tilleke & Gibbins – Vietnam	Annual sales figures/ no. of units sold for as long a period as possible, normally for five years. Percentage of market share also	Annual advertising figures (including sponsorship) for as long a period as possible, normally for five years.	Sample copies from each year, showing the mark. Invoices are persuasive to show use.	Useful to show use of the mark (advertising is considered as “use” in Vietnam).	Radio, websites and social media, events such as trade fairs and fashion shows, sale contracts, purchase orders, distributors and stores list, etc. may also be used as evidence of use.
Owner’s Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
In practice, to be persuasive evidence, the website should be designated for Vietnamese consumers (for example, should be accessible by Vietnamese consumers, presented and functioned in Vietnamese language).	Google/ search engine search results can be useful.	Can be useful to demonstrate the reputation of the mark.	Can be useful to demonstrate the reputation of the mark.	While not popular, successful enforcement of rights in the mark and the extent to which the mark is recognized as well-known by competent authorities can be useful evidence.	Survey is rarely used in Vietnam, maybe because of the doubt of its objective, due to the lack of an independent entity to scrutiny how the survey is designed.

Authentication and Relevant Information

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Vietnam/ Thomas Joseph Treutler/ Nguyen Thi Mai Linh/ Nguyen Hoai Anh, Tilleke & Gibbins – Vietnam	<p>Relevant date will be:</p> <ul style="list-style-type: none"> the filing date of a similar mark; or the date of the alleged infringement <p>Exhibits should be dated.</p>	May be relevant to show bad faith in adopting the mark by a third party.	Ideally, evidence should show use throughout Vietnam.	Can be relevant of the website is designated for Vietnamese consumers, e.g. presented in Vietnamese language.	Reputation elsewhere will not be of particular assistance unless it can show a localized reputation in Vietnam. Generally supplying evidence of statistical information on immigration/ tourist numbers etc. may be required, and evidence linking how this group would be aware of the brand.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Useful to show reputation of the mark worldwide.	Useful.	Documents may be produced in English and a verified Vietnamese translation is required.	Acceptable.	Generally, all evidence should be provided in the form of an Affidavit executed by the trademark owner and notarized by a Public Notary.	Not required.

Europe and Central Asia

The Europe and Central Asia Toolkit can be found in the attached link:

Famous & Well-Known Marks Practitioner's Toolkit for EUROPE & CENTRAL ASIA

[Link to the Europe and Central Asia Toolkit](#)

Latin America

Argentina

Contributions: María Luisa Santa María (G. Breuer)

1. Does your country have specific recognition/protection for Well-Known Marks?

No, well-known trademarks are not specifically considered under Argentine Trademark Law. However, Section 24 b) of Argentine Trademark Law indirectly protects well-known marks by stating that a registered trademark may be declared null and void if, at the time of filing, the applicant knew or should have known that it belonged to a third party. Well-known marks are also afforded special protection pursuant to the provisions of Article 6bis of the Paris Convention and Sections 16(2) and 16(3) of the TRIPS Agreement.

Accordingly, our courts have granted protection to well-known trademarks, even against non-competing goods or services, on the basis of the abovementioned provisions as well as on civil law principle of good faith (Article 953 of the Civil Code) and the dilution doctrine.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

In principle, notoriety of a trademark is a fact readily available to the general public, or at least, to the majority of local consumers, which therefore requires no specific evidence. This is the particular case of those marks enjoying paradigmatic notoriety that does not need to be proved. With the exception of such archetypal well-known marks, notoriety must be proved by different means, such as those mentioned in the attached charts. Sales and advertising figures as well as revenue and market share information have been considered particularly persuasive evidence in some cases.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No, there are no specific provisions for the protection of Famous Marks under a Dilution doctrine. Neither have our courts addressed the existence of famous marks as a special category that would deserve a particular scope of protection.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Not applicable. Please Refer to 3) above.

Types of Evidence:

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Argentina / María Luisa Santa María (G. Breuer)	<p>Recommended.</p> <p>Annual sales figures for at least 5 years.</p> <p>For some cases, it may be helpful to also include no. of units sold.</p> <p>Reliable data on market share position is also recommended.</p>	<p>Recommended.</p> <p>Annual advertising expenses for at least 5 years.</p>	<p>Recommended.</p> <p>Sample copies from each year, which need to match bar code with product.</p>	<p>Recommended.</p> <p>Specimens must include the date in which the TV and printed adverts took place and show as many products as possible.</p>	<p>Recommended.</p> <p>Adverts in editorial features, trade fairs, fashion shows, etc. must include the date in which the adverts took place.</p>
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
<p>Recommended. Evidence from owner's website may be useful in some cases. It is convenient that a Notary Public certifies the content of the web page. It is also advisable to supplement this evidence with domain name search to show registration particulars of domain name, including date of first registration. Extracts from the wayback machine showing use through time may be useful.</p>	<p>Recommended.</p> <p>Wikipedia, Google or other search engine results showing well-known status of a mark could be useful, particularly if results obtained refer to Argentina.</p>	<p>Recommended.</p> <p>The prestige of awards or recognition must be explained. Relevance of this sort of evidence will depend on the characteristics of the award.</p>	<p>Recommended.</p> <p>Foreign certificates from at least owner's home country and other relevant markets, such as the US, EU and South American countries are relevant.</p>	<p>Not necessary.</p> <p>Successful local enforcement actions, including raids, court actions, etc. are not particularly relevant and would only be used as additional evidence.</p>	<p>Recommended.</p> <p>Useful in some cases but are subject to scrutiny.</p>

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Argentina / María Luisa Santa María (G. Breuer)	At least 5 years and must be pre-filing evidence. Evidence needs to be dated, for example, a notice on printed ads or date stamp on photos will suffice.	In principle, paradigmatic trademarks readily regarded as well-known by local consumers will be afforded such protection by local courts without specific evidence. Otherwise, the weaker the mark the more evidence will be needed to show well-known status.	Evidence of notoriety in Argentina is necessary.	Could be useful particularly if it refers to Argentina. It is advisable that a Notary Public certifies the content of the web page.	Local evidence is key. Foreign evidence is not relevant per se, though it may be introduced as additional evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Recognition of well-known status in other jurisdictions is not relevant or particularly persuasive. Notoriety must exist in Argentina.	Independent auditor's report or world's most famous brands ratings, etc. could be useful but not conclusive.	Documents in foreign languages must be translated into Spanish. Translation must be certified.	Preferably certified true copies, otherwise subject to challenge	Yes, if signed outside of Argentina	Foreign documents must be legalized by Apostille or before the Argentinean Consulate. Affidavits with collection of evidence have no evidential value.



Bolivia

Contributors: Octavio Alvarez (DAK Intellectual Property)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes, Andean Community Decision No. 486 recognizes/protects Well-Known trademarks. If possible, please mention the specific articles of law applicable to the case. (ARTICLES 224 to 236 and others mention this type of trademarks.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Decision 486 establishes the following:

Article 228.- In order to determine whether a distinctive sign is well-known, due account shall be taken of the following criteria among others:

- a) the extent to which it is known in the relevant sector of the public in any Member Country;
- b) the age of the distinctive sign and the size of the geographical area where it is used in and outside any Member Country;
- c) the age and the size of the geographical area where the distinctive sign is promoted, in or outside any Member Country, including its advertising and presentation at fairs, exhibitions, or other events in connection with the goods or services, the establishment, or the activity to which it is applied;
- d) the value of all investments made in promoting the distinctive sign or the establishment, activity, goods or services to which it is applied;
- e) figures for the sales and income of the owner, both at the international level and in the Member Country where protection is being sought, in respect of the distinctive sign whose well-known character is alleged;
- f) the extent of the inherent or acquired distinctiveness of the sign;
- g) the book value of the sign as a corporate asset;
- h) the volume of orders from persons interested in obtaining a franchise or license to the sign in a specific territory; or,
- i) the existence of significant manufacturing, purchasing, or storage activities by the owner of the sign in the Member Country where protection is being sought;
- j) the international trade-related aspects; or,
- k) the existence or age of any registration or application for registration of the distinctive sign in the Member Country concerned or in any other country.

Article 229.- The well-known nature of a sign shall not be denied solely because:

- a) it is not registered or in the process of being registered in the Member Country concerned or in any other country;
- b) it has not been nor is it being used to distinguish goods or services or to identify activities or businesses in the Member Country concerned; or,
- c) it is not well-known abroad.

Article 230.- The following, among others, shall be considered pertinent sectors of reference for purposes of determining whether a sign is well-known:

- a) the real or potential consumers of the type of goods and services to which the sign shall be applied;
 - b) the persons involved in the channels of distribution or marketing of the kinds of goods or services to which the sign shall be applied; or,
 - c) the commercial circles operating in lines of business connected with the kind of establishment, activity, goods, or services to which the sign applies.
- It shall be sufficient, for the purpose of recognizing the well-known character of a sign, for it to be known within any of the sectors referred in the previous paragraphs.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No, there is no specific description of this case in the Law. (Andean Law does not differentiate both types because FM are not contemplated in the Decision 486).

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
BOLIVIA / Octavio Álvarez (DAK Intellectual Property)	YES	YES	YES	YES	YES
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
YES	YES	YES	YES	YES	YES

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Bolivia / Octavio Álvarez (DAK Intellectual Property)	No precise dates are required by Law, but in all cases more proofs are always better	Accepted among others proofs	As much as possible (Bolivia or any other country of the Andean Community)	Accepted among others	Accepted among others
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Accepted among others If possible, please provide further details For example a certificate issued by the TM office of a foreign country indicating that the trademark is a FM	Accepted among others If possible, please provide further details Audit reports indicating this information	All proof must be translated to Spanish	Simple photocopies are not accepted. Certified copies? Yes, in Bolivia all documents needs to be legalized by the Bolivian Consulate	Not required If the documents are legalized by the Bolivian Consulate then they will be useful, independent if it is notarized or not.	All documents coming from outside Bolivia must be legalized by the Bolivian Consulate



Brazil

Contributors: Liz Starling (Kasznar Leonardos Intellectual Property), Guilherme Abrantes (Bhering Advogados)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes – but there are two distinct types according to Brazilian Trademark Law No. 9,279:

“HIGHLY RENOWNED TRADEMARKS

Article 125 - A trademark registered in Brazil that is considered highly renowned shall be assured special protection in all fields of activity.”

And

“WELL-KNOWN TRADEMARKS

Article 126 - A trademark that is well known in its field of activity pursuant to the provisions of Article 6bis (I) of the Paris Convention for the Protection of Industrial Property shall enjoy special protection, irrespective of whether or not it has been previously applied for or registered in Brazil.

Paragraph 1 - The protection provided in this article shall apply equally to service marks

Paragraph 2 - The INPI may reject ex-officio an application to register a mark that reproduces or imitates, either wholly or in part, a well-known trademark.”

According to the Brazilian Trademark Office and case law, highly renowned or the well-known status must be achieved in Brazil.

Recognition of highly renowned status of trademarks in Brazil follows the rules set forth by BPTO’s Resolution No. 107/2013 that entered into force on March 9, 2014.

Recognition of well-known status of trademarks in Brazil is examined on a case-by-case basis, according to the evidence produced.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Prior use in Brazil is not a requisite for the recognition of well-known status of a mark under article 6bis of the Paris Convention (which derogates the principle of territorial protection).

The mark must have become well-known in Brazil before the first use/filing by the other party. Evidence may comprise publications in international media ads, articles, brochures, with large circulation in Brazil, participation in local fairs, sponsorships, in Brazil; figures like worldwide sales of goods/services under the mark in different countries; worldwide expenditures on

advertisements in different countries; copies of trademark registrations obtained worldwide, etc...are important elements of proof.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No. Brazil does not recognize dilution in IP Law. On the other hand, depending on the particulars of the case, the Brazilian Courts may consider the risk of dilution in their decisions involving violation of famous marks, such as well-known trademarks.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Evidence acceptable to show Highly Renowned status of trademarks is set forth by Resolution 107/2013 and discussed in the attached chart.

Types of Evidence: For marks to be declared of High Renown

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Brazil Liz Starling (Kasznar Leonardos Intellectual Property) / Guilherme Abrantes (Bhering Advogados)	Product sales volumes or service revenues in the last 5 (five years).	Should be significant depending on the item identified by the mark, and should cover last five years.	Invoices must show quantity, date and the respective mark.	Advertising should be in Brazil (or abroad, but with less probative value) and should demonstrate geographic and temporal extension of advertising in magazines, programs or newspapers.	Websites must show hits from Brazil, emails from Brazil or sales to Brazil. Evidence from abroad is also admitted but with less probative value
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Need to supplement with domain name search to show date of first registration of domain name.	Wikipedia is extremely useful as it is often used by the Examiners themselves. Google and other search engine results are also relevant when limited to Brazil.	May count only as supplementary evidence. Preferably in Brazil	May count only as supplementary evidence	Favorable decisions against attempts to take unfair advantage of the famous status of the brand in different business segments may show the degree of exclusivity and uniqueness of the brand.	Very useful indeed, particularly if the survey shows that the mark is easily recognized by a large proportion of Brazilians. Spontaneous and prompt knowledge and recognition of the mark by consumers; potential users; and public of other market segments, due to its tradition/quality and connection to goods / services to which the mark applies.

Authentication & Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Brazil Liz Starling (Kasznar Leonardos Intellectual Property) / Guilherme Abrantes (Bhering Advogados)	Ideally within the last five years.	May count only as supplementary evidence	Local evidence of use and fame is necessary.	Should be limited to Brazil	Local evidence is key. Evidence outside Brazil may count only as supplementary evidence
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
May count only as supplementary evidence.	Independent auditor's report or world's most famous brands rating, would be important if the report is about Brazil and NOT world value of brand.	All evidence must be submitted in Portuguese or will not be considered. Sworn translation is not required.	Certified copies are not required.	Not required.	Not required.



Costa Rica

Contributors: Mauricio Bonilla (ADVICE Legal Studio)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes, Costa Rican Law protects Well-Known marks without registration. This protection applies in case of opposition, cancellations and judicial actions.

Costa Rican law recognizes the Well-Known marks in connection with: (i) Article 6 bis of the Paris Convention; (ii) the articles 8 e), 44 and 45 of the Law of Marks and Others Distinctive Signs, No. 7978; and, (iii) article 22 6) of the Regulations of the Law of Marks and others Distinctive Signs (Decreto No.30233-J).

According to Costa Rican Law the criteria for determining whether a mark is Well-Known, among others, is the following:

- a) The extent of its knowledge in the relevant sector of the public, for the products or services for which it was granted.
- b) The intensity and scope of dissemination and advertising or promotion given to the mark.
- c) For how long the mark has been protected and used.
- d) Analysis of the production and marketing of products bearing the mark.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

Costa Rica accepts all kind of evidence, but to be accepted it should prove that the mark is Well-Known in Costa Rica, according to Paris Convention.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No, the Dilution doctrine is not developed in Costa Rica, per se. However, it could be used for an opposition or litigation proceeding arguing that the trademark could lose distinctiveness or reputation. Famous Marks are not specifically protected in Costa Rica, but they could be treated Well-Known Marks.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Famous Marks are not specifically protected in Costa Rica, but they could be treated as Well-Known Marks. As a consequence, the evidence requested in case of opposition or judicial action will be the same as for Well-Known Marks.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Costa Rica	Recommended	Recommended	Recommended	Recommended	Recommended
Mauricio Bonilla (ADVICE Legal Studio)	<p>Annual sales figures. It is particularly persuasive if the mark is sold in Costa Rica.</p> <p>In some cases it may be helpful to also include number of units sold.</p>	<p>Annual advertising figures. The advertising should show the knowledge of the mark in the territory.</p>	<p>Sample copies from each year.</p>	<p>The advertis should show as many products as possible. Advertising material is particularly persuasive if the product is advertised in the US, Central America and Mexico.</p>	<p>Editorial features, trade fairs, fashion shows, distributors and stores lists may be persuasive in combination with other TV or printed adverts, which are persuasive for local judges.</p>
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Recommended , as it helps to understand how the mark is used, where it comes from and the company behind it.	<p>Recommended</p> <p>In particular, Wikipedia, Google and other search engines search results.</p>	<p>Recommended</p> <p>It is persuasive, since the awards could show the recognition achieved by the mark in the territory and abroad.</p>	<p>Recommended</p> <p>In particular registrations in the owner's home country, Central American USA, Mexico, Colombia and other Latin American countries,</p>	<p>Not relevant, except if it is local evidence.</p>	<p>Not a typical means of evidence but it may be persuasive in view of the scope of the survey.</p>

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Costa Rica Mauricio Bonilla (ADVICE Legal Studio)	At least 5 preceding years from the relevant filing/first use date of younger mark. Evidence needs to be dated, but for example © notice on printed ads or date stamp on photos will be helpful.	At least in theory, the weaker of the mark the more evidence will be needed to show FW status.	Local evidence of use and fame is necessary. Foreign evidence is accepted if it has an effect inside the territory.	It would be helpful but not relevant and it needs to be complemented with other evidence.	Legalized
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Foreign FW recognition is not accepted.	It is useful, in particular marketing reports, expert analysis or brand rankings.	All documents must be translated into Spanish.	Not accepted.	Required for local and foreign documents.	Foreign documents must be legalized with Apostille or with the Costa Rican Consulate An affidavit may be accepted but usually not persuasive.



Dominican Republic

Contributors: Wallis Pons (Biaggi & Messina)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes, based on:

- Article 6bis of Paris Convention for the Protection of Industrial Property.
- Article 16.2 and Article 16.3 of the TRIPS Agreement.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

The Trademark Office issued a Resolution in the case “FLUIMICIL VS. FLUMAZIL14” stating that well known trademarks require evidence to establish their notoriety.

In the same case it was stated that any evidence provided must be related to the Dominican Republic. The Dominican PTO declared

“In the case at hand, while evaluating the evidence provided by the appellant in order to prove the notoriety of their trademark, it is our opinion that even though they do not lack evidential value, by themselves they are insufficient to prove that we are dealing with a well-known trademark in the Dominican Republic, given that the notoriety must be demonstrated in the country where it is alleged to exist.”

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

Yes, based on:

- Article 70 j) and Article 74 d) from the Law No. 20-00 on Industrial Property. (Dominican Republic)

The Dominican PTO cited in the case PRESIDENTE VS. AGUA PRESIDENTE, that trademarks are protected against dilution. They state that the broader protection they have serves to maintain the distinctiveness of the trademark against similar or even dissimilar trademarks that pretend to obtain protection by the use of confusion or association with the mark. The protection extends to markets with no relation to the products/services protected by the trademark.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

In the case “FLUIMICIL VS. FLUMAZIL14”, the Dominican PTO stated that famous trademarks do not require any kind of evidence to establish their notoriety, given that there is no doubt of their reputation and requiring proof would go against the principle of procedural economy.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Dominican Republic / Wallis Pons (Biaggi & Messina)	Taken into account by examiner.	Taken into account by examiner.	Taken into account by examiner	Taken into account by examiner	Taken into account by examiner
Owner’s Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Accepted	Accepted	Taken into account by examiner.	Taken into account by examiner	Accepted	Taken into account by examiner, as long as is conducted in the Dominican Republic

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Dominican Republic/ Wallis Pons (Biaggi & Messina)		Accepted	Accepted	Accepted	It needs to be proven locally.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
It needs to be proven locally.	Taken into account	Needs to be provided, but not by judicial interpreter	Accepted	Not required	Not required



Ecuador

Contributors: Rodrigo Bermeo-Andrade (Bermeo & Bermeo Law Firm)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes, Well-Known marks are protected under the Andean Community Law (Decision 486) and the Intellectual Property Law of Ecuador. Article 224 of the Andean Decision states that:

“a well-known mark is one that is recognized as such by the relevant sector of any Member Country, independently of the way or means that the mark became well known.”

Article 197 of the Ecuadorian IP law, in concordance with Article 228 of the Andean Decision set out the factors to determine if a mark is well-known as follows:

“Article 228.- For determining the character of well-known or otherwise of a distinctive sign, among others, the following factors shall be taken into account:

- a) the extent of knowledge thereof among the members of the relevant sector in any Member Country;*
- b) the duration, scope and geographical extension of its utilization in any Member Country;*
- c) the duration, geographical scope and extension of its promotion within or outside any Member Country, including advertising in fairs, exhibitions or other events, with respect to the products or services, of the establishment or of the activity towards which it applies;*
- d) the value of the investment in promoting the establishment, activity, product or service to which it applies;*
- e) the figures on sales and income of the proprietor enterprise in what refers to the sign whose character of well-known or famous is alleged, both at the international level, as well as in the Member Country where protection is sought;*
- f) the degree of distinctiveness inherent to or acquired by the sign;*
- g) the book value of the sign as an entrepreneurial asset;*
- h) the volume of the orders from persons interested in obtaining a franchise or a license on the sign in a specific territory; or,*
- i) the existence of significant manufacturing activities, purchases or storage by the proprietor of the sign in the Member Country where protection is sought;*
- j) aspects of international trade; or*
- k) the existence and length in time of the enforceability of any registration or application for registration of the distinctive sign in the Member Country or abroad”.*

Famous marks in Ecuador are protected only by the local law. Article 198 of the Ecuadorian IP Law states that: *“to determine if a mark is famous (highly renown) the mark has to meet the same factors as above, but it has to be known by the general public.”*

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

The IP Office accepts and reviews evidence mentioned in all categories of table below. There are no “levels” of persuasiveness of the evidence. Several combinations have been used successfully.

If the IP Office of the country of origin or use has recognized the notoriety of a mark, a certified copy of said recognition should be enough according to Section 6 bis of the Paris Convention. However, the IP Office in Ecuador also requests proof of notoriety in our country so filing an affidavit with evidence on the mentioned categories is recommended in order to avoid any risk.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes, Both the Andean Community Law and the Ecuadorian IP Law protect Famous Marks against dilution when the commercial value or the distinctiveness of the marks may be limited by a third party’s application or use. Article 136(h) of the Andean Decision states that a mark may not be registered if its use may harm a third party’s rights in particular when the mark is: “a total or partial reproduction, imitation, translation, transliteration or transcription of a well-known mark, whatever the goods or services the mark intends to protect if such use is likely to cause confusion or association with the third party; an unfair use of the mark’s prestige, or the dilution of its distinctive ability or commercial or advertising value.

Regarding famous marks, article 196(d) of the Ecuadorian IP Law goes beyond the assessment of the likelihood of confusion and awards a broader protection even if the new mark is filed to protect unrelated goods or services.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
ECUADOR / Rodrigo Bermeo-Andrade (Bermeo & Bermeo Law Firm)	Recommended. Annual sales figures for at least 3 - 5 years. The evidence with most probative value is an external auditor's report (legalized) Any evidence produced by the trademark owner will not be considered as relevant as third parties' reports since it is an interested party.	Recommended. Annual advertising figures for at least 3 - 5 years The evidence with most probative value is a report issued by the advertising company (legalized) Any evidence produced by the trademark owner will not be considered as relevant as third parties' reports since it is an interested party.	Recommended, The evidence with most probative value is an affidavit granted by an external auditor (legalized), supported by the invoices. Any evidence produced by the trademark owner will not be considered as relevant as third parties' reports since it is an interested party.	Recommended. Must include the date in which the TV and printed adverts took place.	Recommended. Must include the date in which the adverts took place
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Recommended. It is advisable that a Notary Public certifies the web page's content.	Recommended. In particular, Google search results	Recommended. Including the award's descriptions	Recommended At least from the Country Members of the Andean Community. A certified copy of the trademarks registrations, by each IP Office are sufficient, no legalization is required.	Recommended. Local and foreign successful enforcement including raids, customs, Court actions, etc.	Recommended. Legalized

Authenticate and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
ECUADOR Rodrigo Bermeo-Andrade (Bermeo & Bermeo Law Firm)	Contemporary to the proceedings and/or the relevant filing/first use date of younger mark	May be supported by surveys or any other means.	Local and/or foreign use IP Office is highly analyzing evidence of the mark known in the country.	Mark is protected “regardless of the way or means it became known” Internet evidence may be notarized and legalized.	Legalized
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
A certified copy by the corresponding IP Office is sufficient, no legalization is required.	The evidence with most probative value is an external auditor’s report (legalized) Any evidence produced by the trademark owner will not be considered as relevant as third parties’ reports since it is an interested party.	All documents must be translated into Spanish. The translation has to be notarized or legalized.	Not acceptable.	Required for local documents.	Foreign documents must be legalized by Apostille or before the Ecuadorian Consulate An affidavit with a collection of all the different categories of evidence is accepted as a means to file the evidence.



El Salvador

Contributors: José Fidel Melara (Melara & Asociados)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, the Law of El Salvador protects Well-Known and famous Marks with and without registration. Protection is afforded in case of registration, opposition, cancellation and judicial actions and the marks must be Well-Known in El Salvador (well Known trademarks).

Articles 5 and 9 d) and e) of the Law of Marks and Other Distinctive Signs.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

El Salvador accepts all kind of evidence, but to be accepted it must prove that the mark is Well Known in El Salvador and not outside the territory, according to Paris Convention and local legislation.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, the Dilution doctrine is not developed in El Salvador, per se. However, it could be used in an opposition or litigation proceeding arguing that the trademark could lose distinctiveness or reputation. Famous Marks are specifically protected in El Salvador.

There is no specific article, but practitioners use the Article 8 c).

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
EL SALVADOR José Fidel Melara (Melara & Asociados)	Annual sales figures. It is persuasive if the mark is sold in El Salvador, but even more so if it's in several different countries.	Annual advertising figures. It is useful, but the advertising should show the knowledge of the mark in the territory.	Sample copies from each year	Showing as many products as possible. This is persuasive, when the product is advertised in tv, magazines, internet or other publications in the US, Central America, Mexico region.	Editorial features, trade fairs, fashion shows, distributors and stores list. This is helpful and contributes to other TV or printed adverts, which are persuasive for the judges.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
This is useful and helps to understand how the mark is used, where it comes from and the company behind	Wikipedia or Google search results etc. are useful	It is persuasive, since the award could show any kind of recognition by the trademark	Not Useful	Not mandatory	Not Useful

Authentication and Relevant Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
EL SALVADOR José Fidel Melara (Melara & Asociados)	If possible, please provide information on this issue	At least in theory, the weaker of mark the more evidence will be needed to show FW status.	Local evidence of use and fame is necessary	Not relevant	Not relevant
Foreign FW Recognition	Brand Value	Translation	photocopies	Notarization	Legalization
Not relevant	It is useful Marketing Report, Expert Analysis or world's most famous brands rating etc.	All documents shall be translated into Spanish	Certified copies	<p>Yes if signed outside of El Salvador Documents issued by National Authority or by Public Notary are admitted as evidence.</p> <p>Any document issued by Foreign Authority must be duly notarized and, after notarization, the Consul must legalize it. Those documents could be admitted as evidence.</p> <p>Foreign Affidavits or notarized declarations are accepted as a part of the whole evidence. However, they would be helpful but not relevant nor persuasive.</p>	Foreign FW Recognition



Guatemala

Contributors: Karina Calderon (Comte & Font/ IP Legalsa)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, Guatemalan Law protects Well-Known Marks without the need of registration. Protection is afforded in case of opposition and judicial actions. If possible, please mention the specific articles of law applicable to the case.

Guatemalan law recognizes the Well-Known marks in connection with Art 6 *bis* of the Paris Convention and Art 16 of the TRIPS Agreement. Article 21 c) of the Industrial Property Law provides protection to the Well-Known marks, even if it is not registered at the country.

Also, the article 35 a) of the Industrial Property Law allows the owner of a Well-Known mark to oppose the registration of a mark, which is in conflict with the well-known mark.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Guatemala accepts all kind of evidence, but to be accepted it must prove that the mark is Well-Known in Guatemala and not outside the territory, according to Paris Convention.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, the Dilution doctrine is not developed in Guatemala, per se. However, it could be used in an opposition or litigation proceeding arguing that the trademark could lose distinctiveness or reputation. Famous Marks are not specifically protected in Guatemala, but they could be treated as Well-Known Marks.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Guatemala / Karina Calderón (COMTE & FONT / IP Legalsa)	<p>Annual sales figures. It is persuasive if the mark is sold in Guatemala, but even more so if it's in several different countries.</p> <p>For some cases it may be helpful to also include no. of units sold, or countries where the product is sold</p>	<p>Annual advertising figures. It is useful, but the advertising should show the knowledge of the mark in the territory.</p>	Sample copies from each year.	<p>Showing as many products as possible. This is persuasive, when the product is advertised in tv, magazines, Internet or other publications in the US, Central America, Mexico region.</p>	<p>Editorial features, trade fairs, fashion shows, distributors and stores list. This is helpful and it also contributes to other TV or printed adverts which are persuasive for local judges.</p>
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
This is useful and helps to understand how the mark is used, where it comes from and the company behind it.	Wikipedia or Google search results etc. are useful.	It is persuasive, since the awards could show the recognition achieved by the mark in the territory and abroad.	At least from owner's home country. It is helpful in oppositions and legal actions to show the scope of protection.	Not particularly used, only if it's local evidence, but it's not mandatory	Not particularly useful.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Guatemala / Karina Calderón (COMTE & FONT / IP Legalsa)	At least 5 years and must be pre-filing evidence. Evidence needs to be dated, but for example © notice on printed ads or date stamp on photos will be helpful.	At least in theory, the weaker the mark the more evidence will be needed to show FW status.	Local evidence of use and fame is necessary.	It would be helpful but not relevant and it needs to be complemented with other evidence,	Local evidence is key. Foreign evidence is accepted but only if it has an effect inside the territory.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Foreign FW recognition is not accepted.	It is useful. Marketing Report, Expert Analysis or world's most famous brands rating etc.	All documents must be translated into Spanish language for oppositions or judicial actions	Preferably certified and notarized copies. Otherwise subject to challenge	Yes if signed outside of Guatemala Documents issued by National Authority or by Public Notary are admitted as evidence. Any document issued by Foreign Authority must be duly notarized and, after notarization, the Guatemalan Consul must legalize it. Those documents could be admitted as evidence. Foreign Affidavits or notarized declarations are accepted as a part of the whole evidence. However, they would be helpful but not relevant nor persuasive.	Yes, it needs to be duly legalized by the Guatemalan Consul. Apostille is not accepted.



Honduras

Contributors: Alfredo Vargas (Melara & Asociados)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, the Honduran Intellectual Property Law does recognize Well-Known Marks but certain factors have to be considered first in order for a mark to be categorized as “Well-Known”:

- a) The degree of knowledge of the mark between the members of the relevant sector, duration, extent and geographical scope of use of the sign within the country;
- b) The duration, extent and geographical scope of the advertisement of the mark within the country;
- c) The advertising and presentation at fairs, exhibitions and other events, the establishment, activity, goods or services to which the mark is applied;
- d) The existence and age of any registration or application for registration of the mark in the country;
- e) Actions in defense of the mark, and in particular any decision taken by the national authority which would have recognized visibility of the mark; and,
- f) The value of any investment made to promote the distinctive mark or promote the establishment, activity, goods or services to which the mark is applied.

The protection for Well-Known Marks is regulated by the Industrial Property Law, as follows:

Article 134 states that Well-Known Marks must be protected against non-authorized use.

Article 135 states all the conditions required to treat a trade or service mark as a Well-Known Mark.

Article 136 includes the dispositions about the sectors in which a mark must be considered as a Well-Known Mark.

Article 137 allows the owner of a Well-Known Mark to take any legal action to prevent illegal use of said mark.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

The Honduran Trademark Registration Office accepts all types of evidence, but the evidence that the Registration Office finds most relevant is all evidence that proves that the Trademark is well known within Honduran territory.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No. The Honduran Intellectual Property Law does not specifically mention Famous Marks but the Registration Office treats “Famous Marks” as “Well-Known Marks”. The dilution doctrine is used only in trademark litigation when arguing that the prestige and good reputation of the trademark would be negatively affected.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Please Refer to Chart.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Honduras/ Alfredo Vargas (Melara & Asociados)	Sales figures are helpful and relevant when referring to products or services sold within Honduran territory. This type of evidence is especially persuasive when presenting figures that reflect constant sales throughout a period of years.	Advertising sales figures are useful only if they actually reflect the knowledge of the mark within Honduran territory.	Invoices can be used but are not particularly persuasive.	Printed and TV Adverts are useful when the service/product is advertised in several different types of media. Also, tv, radio, magazines, newspaper advertisements for the same product/service from the rest of the Central American countries are also useful.	Any other online advertisements that reflect publicity for the product/service within Honduras is especially persuasive. Online adverts for other central American countries are also useful.
Owner’s Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Very useful as the website usually contains information about the company and the history behind the product/service.	Any 3p website that contains information of the product/service related to the mark is useful.	Industrial Awards can be mentioned but are not particularly persuasive.	Foreign certificates are generally useful. Preferably certificate from the country of origin.	It is persuasive only if it is an enforcement made in Honduras with a similar mark.	It can be presented but it is not considered useful.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of	Geographical Coverage	Internet Evidence	Foreign Evidence
Honduras/ Alfredo Vargas (Melara & Asociados)	Evidence must contain dates. Existing documents used as evidence are more effective the older they are, generally more than 5 years.	If a mark is widely well-known, the registrar will need less amount of evidence to prove that it is well-known. If a mark is well-known but only in a certain sector, then the registrar will need more evidence.	The geographical coverage of the evidence must be within Honduran territory to prove it is well-known.	It is illustrative only; it is considered complementary to any other evidence. Notarization Yes it is necessary if signed in another country. Documents issued by National Authority or by Public Notary are admitted as evidence. Any document issued by Foreign Authority must be duly notarized and legalized or apostilled. Those documents could be admitted as evidence. Foreign Affidavits or notarized declarations are accepted as a part of the whole evidence. However, they would be helpful but not relevant nor persuasive.	It is illustrative only; it is considered complementary to any other evidence.
Foreign FW Recognition	Brand Value	Translation	Photocopies		Legalization
Foreign FW recognition is not allowed.	It is useful, especially if it shows the level of investment involved in brand-building and its current value.	Translation of the evidence is necessary. The Registration Office only accepts documents translated to Spanish.	Photocopies are allowed but for them to have any legal effect, they have to be notarized. Would it be correct to say that simple photocopies are not allowed and that certified copies are required?		Necessary for foreign documents to have any legal effect in Honduras. Apostille is usually used.



Mexico

Contributors: Victor M. Adames (Becerril, Coca & Becerril, S.C.)/ Luis Pavel Garcia (Costinica & Asociados)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes.

Mexico recognizes both figures “Famous Trademarks” and “Well Known Trademarks” differentiating them due the amount of people who are aware of the trademark. Accordingly, a trademark shall be considered:

“Well known”: when a given sector of the public or of the Mexican business circles is aware of the trademark as a result of business activities conducted in Mexico or abroad by a person who uses the trademark in connection with his goods or services, or as a result of the promotion or advertising thereof;

Or

“Famous”: when the most of Mexican consumers are aware of the trademark.

Famous And Well Known Trademarks are figures regulated by CHAPTER II bis of the Mexican Intellectual Property Law (MIPL).

The recognition of the condition of fame or well-known of a trademark can be reached by estimation or declaratory of the MPTO. Article 98bis and subsections XV and XV bis of the Mexican Intellectual Property Law entitle the Mexican MPTO to:

- a. Issue a declaratory of notoriety or fame for a trademark registration; or
- b. Issue an administrative decision estimating a trademark famous or well-known.

“ARTICLE 98 bis. For the purposes of its estimation or declaration by the Institute, a trademark shall...”

“ARTICLE 90. The following may not be registered as trademarks:

I...

XV. Names, figures or three-dimensional shapes identical or similar to a trademark that **the Institute considers or has declared** well known in Mexico, to be applied to any product or service.

XV bis. Names, figures or three-dimensional shapes, identical or confusingly similar to a trademark **the Institute considers or has declared** famous under the terms of Chapter II bis, to be applied to any product or service.”

Regardless whether a mark is registered or not, whether has been declared famous/well-known or not, and/or whether has been used or not in Mexico; MPTO is entitled to estimate it famous or well-known based only on examiner’s own criteria and prior knowledge in order to avoid a famous or well-known mark could be harmed.

“ARTICLE 90. The following may not be registered as trademarks:

I...

XV. Names, figures or three-dimensional shapes identical or similar to a trademark that **the Institute considers or has declared** well known in Mexico, to be applied to any product or service.

XV bis. Names, figures or three-dimensional shapes, identical or confusingly similar to a trademark **the Institute considers or has declared** famous under the terms of Chapter II bis, to be applied to any product or service. ”

IP LAW. ARTICLE 98 bis.1. “The declaration or any updates issued shall constitute an administrative act by means of which the Institute declares, based on the evidence provided, that the conditions by virtue of which a trademark is well known or famous persist at the time that the act is issued.

The impediments provided for in ARTICLE 90, subparagraphs XV and XV bis, for the protection of well-known or famous trademarks, shall apply independently of whether those trademarks are registered or declared.”

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

All kind of evidence is acceptable to show the fame or well known of a mark. However it is important to be aware of some important issues.

- a) The relevant trademark must be registered in Mexico to protect the products or services in which the notoriety or fame of the trademark was originated.
- b) In general, use of a mark is not required for registration but in order to achieve a declaratory of notoriety or fame, use of the mark must be shown in México or abroad.
- c) Documents issued by Agencies (local or foreign) are considered full proof.
- d) Foreign documents must be submitted with its respective translation into Spanish.
- e) It is preferable to submit foreign documents duly notarized and legalized even if the documents were issued by an Official Agency.
- f) Testimonials must be shown in a written form (no notarization or legalization is needed).
- g) Testimonials and affidavits duly notarized and legalized shall be a stronger proof.
- h) Balance sheets reflecting sales, royalties, advertising expenditure, might be certified by a public accounting firm.
- i) Surveys and market research reports conducted in Mexico attest the consumers awareness to a mark.
- j) Inspections conducted by MPTO’s officers can be requested to show presence of the mark in an specific time, place and condition.
- k) License and/or franchise agreements granted.
- l) Local or foreign advertising (printed, digital, radio & TV broadcasts). Better if can be linked to a specific date of release.
- m) Third parties valuation of a mark (Forbes, Interbrand)
- n) Invoices issued (plain copies are acceptable, but notarized shall be a stronger proof)
- o) Cease and desist letters and/or documents showing actions to enforce the exclusive rights granted by the mark against infractors.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No.

Famous marks certainly are recognized in Mexico as stated in the previous answer. However, such recognition is founded not in a Dilution doctrine but in the awareness of the mark. In fact, a dilution doctrine is opposite of the recognition of fame as you can see in Article 153 of the MIPL:

ARTICLE 153.

“There shall be grounds for cancellation of the registration of a trademark if its owner has caused or condoned its conversion into a generic name denoting one or more of the products or services for which it was registered in such a way that, in commercial circles and in the course of its generalized use by the public, the trademark has lost its distinctive character as a means of distinguishing the product or service to which it is applied.”

When a trademark owner allow the non-regulated use of his trademark and/or not pursue infringers to its exclusive right attached to a trademark registration, such mark could be cancelled and its owner will lose its exclusive right with regard such brand.

Moreover, article 98 bis-8 of the MIPL remarks that a declaration of Fame/Well Known shall be invalid if the mark register in which the declaration was based on is declared cancelled by an administrative decision by considering the mark diluted.

Article 98 bis-8. The declaration shall be invalid if:

- it was granted in violation of the provisions of this Chapter;
- the evidence supporting the declaration is false;
- it was granted based on an incorrect assessment of the evidence;
- it was granted to a person who had no right thereto.

Administrative decisions of invalidity shall be issued by the Institute, at the request of persons having a legal interest who prove the grounds on which their request is based.

When the mark registration or registrations, on the basis of which the declaration was issued, become invalid, lapse or are cancelled, the declaration shall lose its evidentiary value.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

The evidence needed to show the fame of a mark is basically the same used for the well-known trademarks and already listed in answer 2 above.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices /	TV / Printed Adverts	Online & Other Adverts
Mexico / Victor M. Adames (Becerril, Coca & Becerril, S.C.)/ Luis Pavel Garcia (Costinica & Asociados)	<p>Mandatory Volume of sales of products or income perceived by the provision of services protected under the mark, during the last 3 years.</p> <p>We may consider here royalties paid by licensees or franchisees granted in Mexico and abroad.</p>	Mandatory. It should cover the time of effective advertising of the mark in Mexico, and abroad and the investment made during the last 3 years in advertising or promotion of the mark in Mexico, and abroad.	Certified copies of each document during the term the mark has been in use in México and abroad.	Showing as many products as possible	<p>Editorial features, trade fairs, fashion shows, distributors and stores list</p> <hr/> <p>Survey Evidence</p> <p>Mandatory.</p> <p>The survey must prove a)the sector of the public integrated by real or potential consumers that identify the mark with the products or services that it protects; b) Other sectors of the public, different from real or potential consumers, that identify the mark with the products or services that it protects, y; c) The commercial circles integrated by retailers, industrialists or service providers involved in the business of the trademark owner. (competitors, vendors, clients, directly related) that identify the mark with the products or services that it protects.</p>
Owner's Website	3rd Website	Industrial Awards	Foreign Certificates	Successful Enforcement	
This is not mandatory but definitely will help to obtain the declaration.	<p>Websites, written testimonials or information requested through the Mexican PTO are admitted. This is not mandatory but definitely will help to obtain the declaration.</p>	Prestige of awards or recognition granted by third parties (i.e. local or foreign press). This is also not mandatory but helpful to obtain the declaration.	A certified copy of all the certificates of registration of the mark in Mexico, and overseas. A certified copy of the certificate of registration of the Mark in Mexico covering the products or services on which the mark originated notoriety or fame is mandatory.	Local and foreign including raids, customs, Court actions, etc.	

Authentication and Relevance of Evidence:

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Mexico / Victor M. Adames (Becerril, Coca & Becerril, S.C.)/ Luis Pavel Garcia (Costinica & Asociados)	There is no obligation to submit local or foreign dates of first use. However, it must be analysed on a case by case basis.	The Mexican Industrial Property Law establishes that a registered or previously filed mark can constitute an obstacle to a new one if the latter is not declared or regarded as well-known or famous by the authorities. Once the notoriety or fame declaration is issued, the Mexican PTO must not grant trademark registrations to any third party applying for an identical or similar mark regardless of the products or services it distinguishes	The geographic area of effective influence of the mark must be proved. Speaking about WK trademarks, the applicant must show the mark is recognized only within its business circle. However, speaking about Famous trademarks, the applicant must show the trademark is known by almost the entire country.	There is no obligation to submit this type of evidence. However, it will definitely help to obtain the Declaration.	Most of the documents and proofs must be issued in Mexico and abroad. Evidence provided from foreign jurisdictions will be considered as testimonials. There is no difference from the evidence rendered by a specific country, however, evidence rendered duly notarized and legalized will be considered stronger than any other one.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Foreign FW recognition can be submitted and it is possible to request the MPTO to apply article 6 of the Paris agreement.	Mandatory. It is necessary to submit the number representing the brand value according to the company balance.	All documents in foreign language must be translated into Spanish.	Preferably originals or certified copies, otherwise subject to challenge	Not necessary but recommended for some proves (for example an attestation of facts). Affidavits and notarized declarations shall be considered as full proof. Non notarized or affidavits shall be considered as a presumption of proof which must be linked to some other evidence to be considered full proof.	Shall apply. Apostille or legalization. This will depend if the foreign evidence is rendered by an authority of a country member of the Hague conference.



Nicaragua

Contributors: Maria Eugenia Garcia (Jarquin-García)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, Nicaraguan law recognizes the Well-Known Marks in connection with articles 79 to 82.

The Law of Nicaragua provides protection to the Well-Known Marks, even if it is not registered at the country. Also provides protection to trademark applications and to registration trademarks as well. Protection is afforded in case of administrative oppositions and judicial actions.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Nicaragua accepts all kind of evidence, even if the mark has been declared Well-Known abroad. Affidavits are useful to include all documents as sole evidence.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

Yes. The Law of Nicaragua provides protection to Well-Known Marks under a Dilution doctrine in articles 8 section b); 26 section f) and 84 b) and is applicable to registration/opposition/cancellation/litigation. Famous Marks are not specifically protected in Nicaragua, but they could be included into the Well-Known Marks.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer		Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
NICARAGUA Maria Eugenia Garcia (Jarquin-García)		Annual advertising figures.	Sample copies from each year.	Showing as many products as possible. This is persuasive, when the product is advertised in TV, magazines, Internet or other publications in the US, Central America, Mexico region.	Editorial features, trade fairs, fashion shows, distributors and stores list. This is helpful and it also contributes to other TV or printed adverts, which are persuasive for local judges.
Sales \$ Annual sales figures. It is persuasive if the mark is sold in Nicaragua, but even more so if it's in several different countries. For some cases it may be helpful to also include # of units sold, or countries where the product is sold					
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
This is useful and helps to understand how the mark is used, where it comes from and the company behind it.	Wikipedia or Google search results etc. are useful.	It is persuasive, since the awards could show the recognition achieved by the mark in the territory and abroad.	At least from owner's home country. It is helpful in oppositions and legal actions to show the scope of protection of the mark.	Foreign decisions are very useful especially when in that decision the mark has been declared Well-Known.	Not particularly useful.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
NICARAGUA María Eugenia García (Jarquin-García)	All the evidence needs to be dated.	At least in theory, the weaker the mark the more evidence will be needed to show FW status.	Local and foreign evidence of use and fame is necessary, especially from Latin America	It would be helpful but not relevant and it needs to be complemented with other evidence.	Foreign evidence is accepted but if it has an effect inside the territory.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Foreign FW recognition is accepted.	It is useful Marketing Report, Expert Analysis or world's most famous brands rating etc.	For oppositions or judicial actions, all documents shall be translated into Spanish in a Deed issued by a local Notary Public.	Preferably certified and notarized copies, otherwise they might be subject to challenge	Yes. Any document issued by Foreign Authority must be duly notarized and legalized or apostilled. Those documents could be admitted as evidence. Foreign Affidavits or notarized declarations are accepted as a part of the whole evidence. However, they would be helpful but not relevant nor persuasive	Yes, it needs to be duly legalized with the Apostille



Panama

Contributors: Farah Molino (Fabrega, Molino & Mulino)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes. The Law of Panama affords protection to well-known marks. Protection is afforded in trademark registration and opposition/cancellation proceedings. If possible, please mention the specific articles of law applicable to the case.

The protection for Well-Known Marks is regulated by the Law No. 61 (October 5th, 2012), in Article 95, which considers as a Famous Mark and as a Well-Know Trademark, any mark that: (i) it has been used in the market or in publicity; (ii) it has a distinctiveness and; (ii) it is knowledge by general public.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Panama accepts all kind of evidence. Evidence can be from within or outside the jurisdiction.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, the Dilution Doctrine is not specifically recognized in Panama, but it can be argued in litigation.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Please Refer to Chart.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
PANAMA Farah Molino (Fábrega, Molino & Mulino)	This evidence is accepted in the jurisdiction. Evidence on national and international sales of products is considered particularly persuasive	Advertising showing consumer knowledge of the mark in the territory. Mass advertising is persuasive(TV, Radio, Newspapers)	Necessary to demonstrate real and effective use.	Accepted but it is important to demonstrate use in the commerce.	This evidence can be accepted.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Web pages are important material to demonstrate the use of the brand internationally.	Google search results are useful.	It is persuasive, since the awards could show the recognition and quality of the mark.	It is important to demonstrate prior use and international trademark registrations.	Not particularly used, only if it's local evidence, but it's not mandatory	Not particularly useful.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
PANAMA Farah Molino (Fábrega, Molino & Mulino)	The evidence must be dated.	All evidence is required to show that a mark is Well-Known by the general public.	Local evidence of use and fame is necessary.	The Judge in the act of hearing can certify the existence of the webpage in Internet or a certification of a Notary Public is permitted. May we suggest the following wording: Existence of a web page on the Internet can be certified by a Notary Public or by a judge at a hearing	Must be authenticated by notary public and legalized by Apostille or Consul.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Foreign FW recognition is not accepted.	It is not relevant.	All evidence must be translated into Spanish.	Copies must be certified and notarized.	Yes, if the evidence, copy or certification is signed outside of Panama. Any document issued by Foreign Authority must be duly notarized and legalized or apostilled. Those documents could be admitted as evidence. Foreign Affidavits or notarized declarations are accepted as a part of the whole evidence. However, they would be helpful but not relevant nor persuasive.	Yes, foreign evidence must be legalized by the Panamanian Consul or Apostille.



Paraguay

Contributors: Laura Lezcano (Zacarias & Fernandez)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes, Well-Known Marks are specifically protected in our Trademark Law. Indeed, pursuant to Article 2 g) the following signs may not be registered as trademarks:

“signs which constitute a reproduction, imitation, translation, transliteration or transcription in full or in part of an identical or similar distinctive sign, **well known to the public in the corresponding sector and belonging to a third party**, irrespective of the products or services to which the sign is applied, if its use and registration are liable to cause confusion or a risk of association with this third party, or mean taking advantage of the reputation of the sign or weakening its distinctive character, irrespective of the manner or way in which the sign was made known”.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

No specific evidence is required by our legislation to prove that a trademark is Well-Known. Indeed, all type of evidence mentioned in the below chart will help for the purpose.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No, Famous Marks are not specifically protected under a Dilution doctrine.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Not applicable.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
PARAGUAY / Laura Lezcano (Zacarías & Fernández)	Yes, it is useful.	Yes, it is useful.	Yes, it would be useful but since this is a sensitive information, not very used.	Yes, very commonly and practical.	Yes, very commonly and practical.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes, very commonly and practical.	Yes. However, not very determinant.	Yes, but not very determinant.	Yes. This evidence is also very efficient and it is not very expensive for the owner.	Yes, but not determinant.	Yes, Surveys will help a lot. However, considering the costs of this evidence, it is not very used.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
PARAGUAY / Laura Lezcano (Zacarías & Fernández)	relevant	relevant	relevant	relevant	relevant
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Not very relevant	relevant	necessary	necessary	necessary	Necessary. Commonly, an Affidavit attesting the relevant data (such as the foreign registrations numbers, expiration date, countries, etc.) is filed before the PTO. Since a couple of months ago, our country accepts apostille too.



Peru

Contributors: Renzo Scavia (Scavia & Scavia)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes.

Sub-paragraph h) of article 136 of Andean Decision 486, which prohibits registration of distinctive signs that affect the rights of third parties, specifically when they consist of a total or partial reproduction, imitation, translation, transliteration, or transcription of a well-known sign without regard to the type of product or service to which it shall be applied, provided the use of such distinctive signs would lead to a likelihood of confusion or erroneous association with third parties, the unfair advantage of the prestige of the well-known sign; or the weakening of its distinctive force or its value for commercial or advertising purposes.

This prohibition is also extendable to designations of origin, pursuant to Article 89 of Legislative Decree 1075, which approves complementary provisions of Andean Decision 486.

Articles 224-236 of Andean Decision 486 provide the concept of well-known distinctive signs and establish some standards for the determination of their existence.

It should be mentioned that article 231 of Andean Decision 486 indicates that the owner of a well-known distinctive sign is entitled with legal actions to prohibit its use by third parties. However, such an article only specifies the opposition —whether Andean or not— as an admissible proceeding for well-known distinctive sign claims.

Furthermore, Article 235 of Andean Decision states that provided there is a specific rule in the Andean Country Member, the owner of a well-known trademark may seek for the cancellation of the registration of a trademark which is identical or similar to such a well-known trademark. Nevertheless, Peruvian regulations on the matter do not provide the cancellation proceeding related to well-known trademarks.

Consequently, in Peru Article 231 of Andean Decision make it possible to determine the existence of a well-known trademark within an opposition proceeding. Article 98 of Legislative Decree 1075 also makes it possible for the Trademark Office to declare the existence of well-known trademarks within nullity proceedings and infringement actions.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Further comments: On November 9, 2009, The Intellectual Property Board, which is the second administrative instance for IP matters in our country, issued Resolution N° 2951-2009/TPI-INDECOPI setting forth a precedent of mandatory compliance on the determination of the well-known status of

distinctive signs. Notwithstanding, the criteria set out in such a precedent does not differ from the standards contained in the legal dispositions of the Andean Decision 486.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No. In broad terms, our legislation does not draw a difference between well-known distinctive signs and famous marks. Hence, the dilution doctrine

Is applicable to both well-know and famous trademarks, according to subparagraph h) of Article 136.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Please Refer to Chart.

Types of Evidence:

Peru/ Renzo Scavia	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Peru Renzo Scavia (Scavia & Scavia)	Necessary Annual sales figures for at least 5 years. The documents with higher evidential value are those which show the annual sales figures in comparison with the annual sales of the competitors. It is not necessary the Breakdown for each class of goods. It is advisable to also include no. of units sold.	Necessary Annual sales figures for at least 5 years	Necessary Sample copies from each year, and need to match product to the well-known distinctive sign.	Necessary Showing as many products as possible	Recommended Editorial features, trade fairs, fashion shows, distributors and stores list.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Recommended It is advisable that a Notary Public certifies the content of the web page and to indicate the date in which such a certification is made.	Recommended Wiki or Google search results etc. are relevant.	Recommended Explanation of prestige of awards or recognition required	Necessary In particular, certificates of Andean Community would be more persuasive.	Recommended Local and foreign including raids, customs, Court actions, etc.	Necessary Useful in some cases but are usually subject to heavy scrutiny.

Authenticate and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Peru Renzo Scavia (Scavia & Scavia)	At least 5 years and must be pre-filing evidence. Evidence needs to be dated.	At least theoretically, the weaker the mark the more evidence will be needed to show notoriety status.	Local evidence of use and notoriety is necessary.	Relevant but need to be pre-filing and mostly related to the Andean Community.	Local evidence is important. Can supplement with foreign evidence, especially from the other Andean Country Members.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Consular Legalization Or Apostille
Recognition from other jurisdictions is particularly persuasive.	Such as say independent auditor's report or world's most famous brands rating etc.	At least relevant sections and foreign languages translations should be certified.	Simple copies will suffice.	Not necessary.	Only for documents issued abroad. Affidavits or notarized declarations as a way of including non-notarized or legalized documents as evidence may have low evidential value



Uruguay

Contributors: Victoria Fox (Fox & Lapenne)

1. Does your country have specific recognition/protection for Well-Known Marks?

No, Uruguay does not afford specific protection for well-known marks as in other jurisdictions; even so, well known marks are recognized and considered in our Trademark Act in relation to nullity actions in article 5, which states that

“Under the present Act the following may not be registered as marks and shall incur relative nullity: subsection 6: Signs or words which are a reproduction, imitation or a full or partial translation of a well-known mark or trade name”.

The well-known trademark status can be obtained in an opposition proceeding or in a cancellation action; there is no specific declaration of well-known trademark in our country.

This status needs to be proved on a case by case basis, specifically according to the examiner that studies the matter.

Paris Convention and TRIPS provisions are also recognized by our Law.

2. If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?

The usual evidence consists in advertising, presence in media (tv, printed media, online), annual sales, registrations worldwide (listing with all the applications/registrations of the mark), copies of relevant registration certificates (usually from our region), other judicial or administrative resolutions that have declared the mark well known, etc. Local recognition is usually required.

3. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

No.

4. If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Uruguay / Victoria Fox (Fox & Lapenne)	Sales volumes that go back the necessary time to cancel an already registered trademark.	Originals of advertisements are really appreciated in Uruguay. Advertisements in the region are important to file.	YES	YES, again originals are important for local authorities.	Duly certified by Notary Public.
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Sometimes we use this evidence but it is quite subjective, so not always taken into account	YES, duly certified by notary public.	YES	Listing of all the registrations worldwide, and copies of foreign certificates in countries of our region, and relevant countries as US, CE, etc. This is one of the most valuable documents.	Prior rulings are highly useful.	This is not a common tool to use as evidence but nevertheless sometimes used.

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Uruguay / Victoria Fox (Fox & Lapenne)	The evidence needs to go back in time to show notoriety at the time the mark you want to act against was filed; i.e. you want to cancel a mark that was filed on 2001, you need evidence that shows the notoriety of the mark prior to this date.	N/A	Local or regional notoriety is necessary. Even so, in some cases if the mark is widely notorious in the country of origin the chances of success are good. Criterion varies depending on the examiner that reviews the matter.	Admitted but not always taken into account.	Local / regional evidence is more important than foreign evidence, even so it is rather useful.
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Very useful.	Not commonly used.	The affidavit needs to be translated, also relevant parts of the exhibits.	Yes	Yes, Affidavits need to be certified by a notary public, in the affidavit we describe all the evidence that will be filed; certain evidence is included in the body of the affidavit and some evidence is added as exhibits. The exhibits do not need to be notarized. Other documents, such as those issued abroad.	Apostille is required.

Middle East, Africa, South Asia

India

Contributors: Suhrita Majumdar (S. Majumdar & Co.); Elizabeth Puthran (Puthran & Associates); and Santosh Vikram Singh (Fox Mandal & Associates)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes.

In India, Section 2(1)(zg) of the Trade Marks Act, 1999 ["the Act"] defines "*well-known trademarks*", *in relation to any goods or service, means a mark which has become so to the substantial segment of the public, which uses such goods or receives such services, that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services.*

Therefore, to fulfill the criteria of a well-known mark, every trademark must be: i) Well-known to the substantial segment of the public in relation to the goods/services; ii) There must be a likelihood of confusion as to the origin of the goods/services, if another person uses the same mark.

Sections 9 and 11 of the Act, also recognizes and bestows protection to Well-known Trademarks. The Proviso to section 9(1) of the Act enables marks to be accepted and not refused registration, if before the date of application, it is a well-known mark. On the other hand, Sections 11(6) to 11(10) of the Act also deals with the protection of Well-known trademarks, in which Section 11(6) and 11(7) lays down the characteristics for determining a well-known mark; Section 11(8) states that if the Registrar/Court has declared the mark to be well-known among one relevant section of the public in India, then the trademark is well-known; Section 11(9) lists out the factors which the Registrar does not have to consider while determining whether the trademark is a well-known mark; Section (10) requires the Registrar to protect a well-known trademark against an identical or similar marks, while considering an application for registration or an opposition filed.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Section 11(6) and Section 11(7) of the Act lays down the following characteristics for determining a well-known mark:

- i. The knowledge or recognition of the alleged well known mark in the relevant section of the public including knowledge obtained as a result of promotion of the trademark.
- ii. The duration, extent and geographical area of any use for that trademark.
- iii. The duration, extent and geographical area for any promotion of the trademark including advertising or publicity and presentation at fairs or exhibition of the goods or services in which the trademark appears.
- iv. The duration and geographical area of any registration of any publication for registration of that trademark under this Act to the extent that they reflect the use or recognition of that trademark.
- v. The record of successful enforcements of the rights in that trademark, in particular the extent to which the trademark has been recognized as a well-known trademark by any Court or Registrar under that record.
- vi. The number of actual or potential consumers of the goods or services.
- vii. The number of persons involved in the channels of distribution of the goods or services.
- viii. The business circle dealing with the goods and devices to which the trademark applies.

Further, Section 11(8) of the Act states that “where a trade mark has been determined to be a well-known in at least one relevant section of the public in India by any Court or Registrar, the Registrar shall consider that trade mark as a well know trade mark for registration under this Act”.

As per the various Indian case laws, the following characteristics have been identified to determine a ‘well-known mark’:

1. The mark is a well-known trade mark in respect of a specific class of goods or services
2. Use of this mark without due cause for any other products would be likely to deceive or cause confusion, unfair advantage and be detrimental to the distinctive character and repute of mark.
3. Deception or confusion would be with respect to the minds of a prudent consumer.
4. The company enjoys a certain goodwill and reputation.
5. The mark enjoys a trans-border reputation.
6. The mark is in long-standing use.
7. The mark is widely publicized.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

Every trademark application is examined under Sections 9 and 11 of the Act, in which Section 9 deals with the absolute grounds for refusal, and Section 11 deals with the relative grounds for refusal. Under Section 9(1), the Registrar shall not register a trademark on the grounds that the trademark is devoid of distinctive character; or if the trademark designates the goods/services offered; or if the trademark has become customary in the current language or practices of trade. However, the proviso to the above is that the Registrar shall not refuse the trademark registration, if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark. However, the above proviso becomes applicable, only when the Registrar determines whether or not the trademark is well-known.

In order to designate a mark as a well-known mark, the Registrar has to consider several factors, which are laid out under Sections 11(6) and 11(7) of the Act. The Act therefore provides an exhaustive list of factors to determine the criteria for a well-known mark.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Yes.

Section 11(1) of the Act provides that a trademark which is identical with an earlier mark and filed for similar goods; or which is similar to an earlier mark and filed for identical goods shall not be registered if there exists likelihood of confusion or association with the earlier mark registration of trademark can be refused.

Further, Section 11 (2) of the Act provides that a mark identical with or similar to an earlier mark and is filed for goods not similar to that of the earlier mark shall not be registered if the earlier mark is a well-known mark in India and the use of the later mark would take unfair advantage of or be detrimental to the distinctive character of the earlier trademark and registration of trademark can be registered.

According to Section 11(10) of the Act, while considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall protect a well-known trade mark against the identical or similar trademarks and take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

However section 11(5) of the Act provides that a trade mark shall not be refused registration on the grounds specified in subsections (2) and (3) of section 11, unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark. Hence if a mark filed is identical or similar to a well-known mark, but is filed for different goods, the same shall not be refused by the Trade Marks Office unless the proprietor of the earlier mark opposes the subsequent mark.

Further section 11(4) states that nothing in section 11 shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances. The explanation to section 11(4) states that for the purposes of this section, earlier trade mark also means a trade mark which, on the date of the application for registration of the trade

mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.

Further Section 11(11) of the Act provides that where a trademark has been registered in good faith or where right to the same has been acquired through use in good faith, then, nothing in the Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark.

5. Is it possible to file an opposition in your country, based on the claim that the advertised trademark is identical or deceptively similar to a well-known mark?

Yes.

Section 21 (1) of the Act, provides for preventing a third party from registering an identical or similar mark to that of the famous/well-known mark through opposition procedure

6. Is it possible to seek cancellation of a registered trademark in your country, based on the claim that the given registered trademark is advertised trademark is identical or confusing similar to a well-known mark?

Yes.

Section 57 of the Act deals with the power to cancel or vary registration and to rectify the register. Under Section 57(1) of the Act, on an application made by any aggrieved person to the Appellate Board or the Registrar, the tribunal may cancel or vary the registration of a trademark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

Section 57(2) of the Act provides that any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply to the Appellate Board or to the Registrar, and the tribunal may make such orders for making, expunging or varying the entry as it may

think fit. Thus, it is possible to seek cancellation of a registered trademark, based on the claim that the given registered trademark is identical or confusingly similar to a well-known mark.

7. *In an action for infringement of well-known mark what kind of remedies would be available to the claimant/complainant?*

An Infringement action can be brought under either section 29(4) or section 29(5) of the Act. Section 29(4) is available if the infringer uses the 'infringing mark' in relation to the same goods in respect of which the well-known mark is most famous for. The test is that whether it may lead to dilution of trade mark as well as confusion 'as to source, affiliation or connection' among the potential purchasers [*Caterpillar Inc. v. Mehtab Ahmed 2002 (25) PTC 438 (Del.)*].

Section 29(5) is broader test which requires the proprietor to establish 'deceptive similarity', as well as reputation in India [or dilution of value of trade mark]. A passing off action involves application of classical three step doctrine of 'i. Reputation of the mark ii. Possibility of deception and iii. Likelihood of damage' [*Laxmikant case 2002(24) PTC 1 (sc)*]. The proprietor will succeed in the passing off action if he is able to establish through evidence the far reaching reputation of the mark [which qualifies it for being well-known].

Section 135 discusses the remedies for infringement or passing off. According to Section 135(1), in a suit for infringement, the Court may grant an injunction and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery up of the infringing labels and marks for destruction or erasure. Under Section 135(2) an order of injunction in relation to the above section, may include an ex-parte injunction or any interlocutory order for the following matters namely:

- a) discovery of documents;
- b) preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit.

c) Restraining the defendant from disposing of or dealing with his assets in manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff

According to Section 135(3) the Court shall not grant damages, other than nominal damages or accounts of profits in cases where-

- a) Infringement is of a certified trade mark or collective trade mark;
- b) The defendant satisfies the court (in a case of infringement or passing off) that he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use and that when he became aware of the existence and nature of the plaintiff's right in the trademark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered.

8. *Has your country established a separate register for well-known marks?*

Yes.

The Trade Marks Registry has created a separate register for the marks that have been determined by the Court or the Tribunals to be 'well-known trade mark'. The list of well-known marks in India is published and is available at <http://ipindiaservices.gov.in/tmrpublicsearch/wellknownmarks.aspx>.

9. *What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No. Indian law does not differentiate between famous mark and well known mark. The concept of dilution is not specifically discussed in the Act. However the law under Section 11 of the Act provides for protection of a well-known mark against detriment to the distinctive character or repute of the earlier trade mark. Section 29 dealing with infringement also states

that a trademark is infringed if the registered trade mark has a reputation in India and the use of a later mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

11. What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
India	Yes	Yes	Yes	Yes	Yes
Owner's Website	3rd Party Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes	-	Yes	Yes	Yes	Yes

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
India	Persuasive	Persuasive	Persuasive	Persuasive	Persuasive
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Persuasive	Persuasive	Required	Acceptable subject to notarization	Evidence by Affidavit	Not required for all documents.



Nepal

Contributors: Janak Bhandari (Global Law Associates); and Bharath Subramanian (Anand & Anand)

1. Does your country have specific recognition/protection for Well-Known Marks?

Yes.

[Proviso clause of Section 18 (1)]

(1) In case any person files an application under Section 17 for registration of trademark, the department shall register such trademark in the name of the applicant the specimen form indicated in Schedule 2 (c), shall conduct necessary investigation and provide sufficient opportunity to defend him/herself and also conduct further inquiry based on the cense made and if finds it appropriate to register it.

Provided that in case it is felt such trade-mark may hurt the prestige of any individual or institution or adversely affect the public conduct or morality or undermine the national interest or the reputation of the trade-mark of any other person, or in case such trade-mark is found to have already been registered in the name of another person, it shall not be registered.

2. What are the factors/thresholds (either pursuant to statute or customary practice) that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?

No Statutory Guidance

Customary practice suggests following being relevant:

- Use Details
- Promotional Materials
- Import/Export Details
- Volume of sales of goods
- Value of sales of goods

3. If one were to apply for registration of trademark in your country (and at the same time claim that its mark is a well-known one) then would the trademark office in your country exempt such application from any (absolute or relative) grounds for examination?

No.

4. *Would the trademark office in your country (either pursuant to statute or customary practice) refuse registration of a trademark that is identical or confusing similar to a well-known mark?*

They may.

[Proviso clause of Section 18 (1)]

(1) In case any person files an application under Section 17 for registration of trademark, the department shall register such trademark in the name of the applicant the specimen form indicated in Schedule 2 (c), shall conduct necessary investigation and provide sufficient opportunity to defend him/herself and also conduct further inquiry based on the cense made and if finds it appropriate to register it.

Provided that in case it is felt such trade-mark may hurt the prestige of any individual or institution or adversely affect the public conduct or morality or undermine the national interest or the reputation of the trade-mark of any other person, or in case such trade-mark is found to have already been registered in the name of another person, it shall not be registered

5. *Is it possible to file an opposition in your country, based on the claim that the advertised trademark is identical or deceptively similar to a well-known mark?*

Yes.

6. *Is it possible to seek cancellation of a registered trademark in your country, based on the claim that the given registered trademark is advertised trademark is identical or confusing similar to a well-known mark?*

Yes.

7. *In an action for infringement of well-known mark what kind of remedies would be available to the claimant/complainant?*

Yes, it can be filed in the form of an injunction petition before the court or file a request letter before the Trademark Office. But, it is required to establish that the complainant's mark is well-known and if the court or office will be convinced then they will pass the necessary orders.

8. *Has your country established a separate register for well-known marks?*

Not at all.

9. *What kind of evidence is necessary/recommendeded to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart.

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

11. *What kind of evidence is necessary/recommendeded to establish (before a trademark office/court) that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Nepal	YES	YES	YES	YES	YES
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
YES	YES	YES	YES	YES	YES

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Nepal	YES	YES	YES	YES	YES
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
YES	YES	YES	YES	YES (if legalized then Notarization not	YES (if notarized then legalization not



Nigeria- Current Law

Contributors: Florence Atuluku (ABFR & Co.); Sym Otiye-Odibi (Johnson Bryant); Segun Okwoubi (Rehoboth Attorneys); and Tolu Olaoye (Jackson Etti and Edu)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

Yes (in a very limited sense)

Well-known marks are recognized under the Trademarks Act for the purposes of defensive registration pursuant to Section 32 of the Act, which provides:

“Where a trademark consisting of an invented word or invented words has, as respects any goods in respect of which it is registered and in relation to which it has been used (in this subsection referred to as ‘the familiar goods’), become so well known that its use in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trademark in relation to the familiar goods, the trademark may, on the application in the prescribed manner of the proprietor registered in respect of those other goods as a defensive trademark, notwithstanding that the proprietor registered in respect of the familiar goods does not use or propose to use the trademark in relation to those other goods...and while so registered, the trademark shall not be liable to be taken off the register of those goods...”

2. *What are the factors/thresholds (either pursuant to statute or customary practice) that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?*

There are no statutory thresholds. However, pursuant to customary practice, when such questions arise, then one is expected to demonstrate that the trademark is well-known in Nigeria [with substantial geographical coverage] as the mark of a proprietor and used for identical or similar goods.

3. *If one were to apply for the registration of a trademark in your country (and at the same time claim that its mark is a well-known one) then would the trademark office in your country exempt such application from any (absolute or relative) grounds for examination?*

No. There is no exemption [statutory or customary] with respect to examination of any application to register a mark on the ground that the mark is well-known.

The application will be subjected to all the requirements and procedure for the registration of any other mark.

4. *Would the trademark office in your country (either pursuant to statute or customary practice) refuse the registration of a trademark that is identical or confusing similar to a well-known mark?*

No.

There is no statutory scheme/ground for refusing an application in order to safeguard the interest of a well-known mark. The Trademarks Registrar will refuse registration of a trademark identical or confusingly similar to a well-known mark only if the well-known mark is registered in Nigeria. [Section 13 of the Trademarks Act]

5. *Is it possible to file an opposition in your country, based on a claim that the advertised trademark is identical or deceptively similar to a well-known mark?*

No.

By virtue of Section 20 of the Trademarks Act, any person can oppose the registration of a trademark. However, the success of an opposition based on the claim that an advertised trademark is identical or deceptively similar to a well-known mark will depend on whether the well-known mark is registered in Nigeria.

6. *Is it possible to seek cancellation of a registered trademark in your country, based on a claim that the given registered trademark is identical or confusing similar to a well-known mark?*

No.

The grounds for cancellation or removal of a registered trademark from the Register are: Non-Use and Entry on the Register without sufficient cause or entry wrongly remains on the Register. There are no specific grounds relating to well-known trademarks.

7. *In an action for infringement of a well-known mark what kind of remedies would be available to the claimant/complainant?*

None. There are no specific remedies for infringement of well-known marks.

However, the following remedies are generally available/applicable: orders of injunction restraining current and future acts of infringements; delivery of infringing articles and items; and accounts for profits, costs, damages.

A Plaintiff claiming in an action for infringement of his trademark must prove or establish the following:

1. that the trademark is registered;
2. that he is the proprietor or a registered user entitled to use the trademark;
3. that the defendant has acted or threatens to act in such a way as to infringe the right conferred upon him by the registration of the trademark;
4. that he has suffered loss or is really likely to suffer losses by reason of the defendant's goods or services, which seems to suggest that they emanate from the Plaintiff.

8. *Has your country established a separate register for well-known marks?*

No.

9. *What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart.

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

11. *What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?*

Please Refer to Chart.

Types of Evidence:

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Nigeria	Yes	Yes	Yes	Yes	Yes
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes	-	Yes	Yes	Yes	Yes

Authentication and Relevance of Evidence:

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Nigeria	Persuasive	Persuasive	Persuasive	Persuasive	Persuasive
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Persuasive	Persuasive	Required	Acceptable	Not Required for documents.	Not required for all documents.



Nigeria-Draft Law

Contributors: Florence Atuluku (ABFR & Co.); Sym Otike-Odibi (Johnson Bryant); Segun Okwoubi (Rehoboth Attorneys); and Tolu Olaoye (Jackson Etti and Edu)

1. Does the IPCOM Bill have specific statutory provisions recognizing Well-Known Marks?

Yes. See the following provisions of the IPCOM Bill:

Section 30 (4)(e)

A mark shall not be validly registered if it is:

“identical with or in a confusing way similar to, or constitutes a translation of a mark or trade name which is well known in Nigeria for identical or similar goods or services of another enterprise, or if it is well known and registered in Nigeria for goods or services which are not identical or similar to those in respect of which registration is applied for, provided in the latter case that use of the mark in relation to those goods or services shall indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark-are likely to be damaged by such use”.

Section 32

“(1) The owner of a well-known mark has the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade, a mark which is identical with or in a confusing way similar to or constitutes a translation of, a mark or trade name which is well known in Nigeria, for goods or services which are identical or similar to those in respect of which the mark is well known, where the use would result in a likelihood of confusion and in the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed”.

(2) The rights of an owner of a registered well known mark under subsection (1) of this section shall extend to goods and services which are not identical with or similar to those in respect of which the well-known mark has been required, provided that, the use of the sign in relation to those goods or services indicated, a connection between those goods or services and rights of the owner of the well-known mark are likely to be damaged by such use”.

Section 60

“Where a trade mark consisting of an invented word or invented words has, with regard to any goods in respect of which it is registered and in relation to which it has been used (in this subsection referred to as "the familiar goods"), become so well known that its use in relation to other goods would be likely to be taken as indicating a connection in the

course of trade between those goods and a person entitled to use the trademark in relation to the familiar goods, the trademark may, on the application in the prescribed manner of the proprietor registered in respect of the familiar goods, be registered in his name in respect of those other goods as a defensive trademark, despite that, the proprietor registered in respect to the familiar goods, does not use or propose to use the trademark in relation to those other goods.....”

2. *What are the factors/thresholds in the IPCOM Bill, if any, that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?*

Section 32(3) of the IPCOM Bill provides the threshold for determining a well-known mark. Any one claiming that a mark is well known is required to demonstrate **“Knowledge of the trademark in the relevant sector”**. Knowledge obtained as a result of the promotion of the trademark would also be taken into account.

3. *Is there any provision in the IPCOM Bill that would exempt an application for the registration of a well-known mark from any [relative or absolute] grounds of examination?*

No.

The IPCOM Bill does not provide any exemption with respect to examination of an application to register a mark on the ground that the mark is well known.

4. *Is there any provision in the IPCOM Bill for refusal of the registration of a trademark that is identical or confusing similar to a well-known mark?*

Yes.

Section 30 (4)(e) of IPCOM Bill provides that, a mark shall not be validly registered if it is: **“identical with or in a confusing way similar to, or constitutes a translation of a mark or trade name which is well known in Nigeria for identical or similar goods or services of another enterprise,** or if it is well known and registered in Nigeria for goods or services which are not identical or similar to those in respect of which registration is applied for, provided in the latter case, the use of the mark in relation to those goods or services shall indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark-are likely to be damaged by such use”.

5. *Would it be possible to file an opposition [under the IPCOM Bill] based on a claim that the advertised trademark is identical or deceptively similar to a well-known mark?*

YES, it would be possible by virtue of Section 30 (4)(e) of the IPCOM Bill which provides that, a mark shall not be validly registered if it is:

“identical with or in a confusing way similar to, or constitutes a translation of a mark or trade name which is well known in Nigeria for identical or similar goods or services of another enterprise, or if it is well known and registered in Nigeria for goods or services which are not identical or similar to those in respect of which registration is applied for, provided in the latter case, the use of the mark in relation to those goods or services shall indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark-are likely to be damaged by such use”.

6. *Would it be possible to seek cancellation of a registered trademark under the IPCOM Bill, based on a claim that the given registered trademark is identical or confusing similar to a well-known mark?*

No.

There is no specific provision in the IPCOM Bill relating to cancellation of registered trademark on the ground that the given registered trademark is identical or confusingly similar to well-known trademark.

7. *In an action for infringement of a well-known mark what kind of remedies would be available to the claimant/complainant under the IPCOM Bill?*

There are no specific provisions in the IPCOM Bill relating to remedies for infringement of well-known marks. However, the IPCOM Bill provides the following remedies for infringement of a registered trademark:

Section 34:

(1) In an action for infringement of a registered mark, the plaintiff may make an ex parte application supported by affidavit to the court for an order for the inspection of any house or premises where he knows or suspects are kept, goods with his infringed marks on them or his infringed marks intended to be used on goods or in respect of services; and for the seizure of such goods or marks.

(2) Where there is reasonable cause for suspecting that goods with the infringed marks on them or the Infringed marks intended to be used on goods or in respect of services are in the house or premises, the court may issue an order on such terms as it deems fit authorizing the applicant to - power of court to make order of inspection and seizure:

(a) enter the house at any reasonable time by day or night accompanied by a police officer not below the rank of Assistant Superintendent of Police;

- (b) seize, detain and preserve the goods bearing the infringing mark;
- (c) inspect all or any documents in the custody or under the control of the defendant relating to the action.

8. *Does the IPCOM Bill provide for the establishment of a separate register for well-known marks?*

No.

There is no provision in the IPCOM Bill for a separate register of well-known marks.

9. *What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart.

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

11. *What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?*

Please Refer to Chart.

Types of Evidence:

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Nigeria	Yes	Yes	Yes	Yes	Yes
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes	-	Yes	Yes	Yes	Yes

Authentication and Relevance of Evidence:

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Nigeria	Persuasive	Persuasive	Persuasive	Persuasive	Persuasive
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Persuasive	Persuasive	Required	Acceptable	Not required for all documents.	Not required for all documents.



Pakistan

Contributors: Faisal Daudpota (Daudpota International)

1. Does your country have specific statutory provisions recognizing Well-Known Marks?

Yes. There is a statutory scheme for recognition and protection of well-known marks.

STATUTORY CONCEPT (AS DERIVED FROM PARIS CONVENTION)

- 1) Well known trade mark shall be a mark which is so entitled:
 - a) under the Paris Convention of 1883, and
 - b) is also well known in Pakistan (and belongs to a person that is entitled to national treatment under Paris Convention, whether or not that person carries on business, or has any goodwill, in Pakistan)

[S. 86(1) of TMO'01]

STATUTORY CONCEPT (AS A SUBSET OF AN "EARLIER TRADE MARK")

- 2) An "earlier trade mark", amongst other things, includes a well-known trade mark that is entitled to protection under the Paris Convention

[S. 18(1)(c) of TMO'01]

2. What are the factors/thresholds (either pursuant to statute or customary practice) that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?

FACTORS TO ESTABLISH A MARK AS WELL KNOWN

Under TMO '01, the claimant of a well-known trade mark, must prove the following:

- a) Amount of Pakistan or worldwide recognition of the trade mark;
- b) Degree of inherent or acquired distinctiveness of the trade mark;
- c) Pakistan or worldwide duration of the use and advertising of the trade mark;
- d) Pakistan or worldwide commercial value attributed to the trade mark;
- e) Pakistan or worldwide geographical scope of the use and advertising of the trade mark;
- f) Pakistan or worldwide quality and image that the trade mark has acquired; and
- g) Pakistan or worldwide exclusivity of use and registration attained by the trade mark and the presence or absence of identical or deceptively similar third party trademarks validly registered or used in relation to identical or similar goods and services.

[S. 86(2) of TMO'01]

3. If one were to apply for registration of trademark in your country (and at the same time claim that its mark is a well-known one) then would the trademark office in your country exempt such application from any (absolute or relative) grounds for examination?

EXEMPTIONS FROM CERTAIN ABSOLUTE GROUNDS EXAMINATION

- 3) An application for well-known trade mark is exempted from certain absolute grounds as to refusal. More specifically if an applicant for a trade mark registration is able to demonstrate that its mark is a well-known one, then such application shall not be examined on the absolute grounds as to:
- a) Whether or not the given trade mark is devoid of any distinctive character;
 - b) Whether or not the given trade mark consists exclusively of marks or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
 - c) Whether or not the given trade mark consists exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade

[S. 14(1) of TMO'01]

4. Would the trademark office in your country (either pursuant to statute or customary practice) refuse registration of a trademark that is identical or confusing similar to a well-known mark?

CERTAIN RELATIVE GROUNDS FOR REFUSAL – TO ACT AS SAFEGUARDS TO WELL KNOWN MARKS

- 4) An “earlier trade mark”, amongst other things, includes a well-known trade mark that is entitled to protection under the Paris Convention

[S. 18(1)(c) of TMO'01]

- 5) TMO'01 prohibits registration of a trade mark if such:

- a) Trade mark (as applied for) is:

- (1) identical to an earlier trade mark,
- (2) the goods or services, for such applied for trade mark, are identical with the goods or services for which the earlier trade mark is registered.

[S. 17(1) of TMO'01]

- b) Trade mark (as applied for) is:

- (1) identical to an earlier trade mark,
- (2) the goods or services, for such applied for trade mark, are similar to the goods or services for which the earlier trade mark is registered, and
- (3) there exists a likelihood of confusion/likelihood of association (on the part of the public) between the applied for trade mark and the earlier trade mark.

[S. 17(2)(a) of TMO'01]

- c) Trade mark (as applied for) is:

- (1) similar to an earlier trade mark,
- (2) the goods or services, for such applied for trade mark, are identical with or similar to the goods or services for which the earlier trade mark is registered, and
- (3) there exists a likelihood of confusion/likelihood of association (on the part of the public) between the applied for trade mark and the earlier trade mark.

[S. 17(2)(b) of TMO'01]

- d) Trade mark (as applied for) is:
- (1) identical with or similar to an earlier trade mark,
 - (2) the goods or services, for such applied trade mark, are not similar to the goods or services for which the earlier trade mark is registered, and
 - (3) the use of such applied for trade mark, would (without due cause) take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark in Pakistan.

[S. 17(3) of TMO'01]

5. Is it possible to file an opposition in your country, based on the claim that the advertised trademark is identical or deceptively similar to a well-known mark?

WELL KNOWN MARK CLAIM TO PROVIDE GROUND FOR AN OPPOSITION AGAINST SUBSTANTIALLY IDENTICAL OR DECEPTIVELY SIMILAR MARKS APPLICATIONS

- 6) The registration of trade mark in respect of particular goods or services may be opposed on the grounds that:
- a) it is substantially identical with, or deceptively similar to, a well-known trade mark
 - b) that ... had acquired a reputation in Pakistan, and
 - c) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would cause
 - d) dilution or would be likely to deceive or cause confusion

[S. 29(4)(a) of TMO'01]

- 7) Where "dilution" means the lessening of the capacity of a well-known trade mark to identify and distinguish the goods or services, regardless of the presence or absence of competition between owner of the well-known trade mark or other parties or likelihood of confusion or deception

[S. 2(xiii) of TMO'01]

6. Is it possible to seek cancellation of a registered trademark in your country, based on the claim that the given registered trademark is identical or confusing similar to a well-known mark?

CANCELLATION OF REGISTRATION THAT OFFENDS WELL KNOWN MARKS

- 8) The registration of a trade mark may be declared invalid on the ground that there is ... an earlier trade mark in relation to which the conditions set out in sub-section (1), (2) or (3) of section 17 obtained (i.e. the grounds as to refusal that are highlighted as above)
- [S. 80(3)(a) of TMO'01]

7. In an action for infringement of well-known mark what kind of remedies would be available to the claimant/complainant?

SAFEGUARDS AGAINST INFRINGEMENT OF WELL KNOWN MARKS

- 9) A person shall infringe a registered trade mark if the person uses in the course of trade mark which:
- a) is identical with or deceptively similar to the trade mark; and
 - b) is used in relation to goods or services which are not similar to those for which the trade mark is registered.
 - c) Provided that the given trade mark is a well-known trade mark,
 - d) or has a reputation in Pakistan,
 - e) and the use of the mark being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark

[S. 40(4) of TMO'01]

REMEDIES AGAINST INFRINGEMENT - INTERIM OR PERMANENT INJUNCTIONS

- 10) The owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be entitled to restrain by injunction the use in Pakistan of a trade mark which, or the essential part of which, is identical with or deceptively similar to the well-known trade mark:
- a) in relation to identical or similar goods or services, where the use is likely to cause confusion; or
 - b) where such use causes dilution of the distinctive quality of the well-known trade mark

[S. 86(3) of TMO'01]

REMEDIES AGAINST INFRINGEMENT - DAMAGES AND ACCOUNT OF PROFITS

- 11) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor of the trade mark as is available in respect of the infringement of any other property right.

[S. 46(2) of TMO'01]

REMEDIES AGAINST INFRINGEMENT - ORDER FOR ERASURE OF OFFENDING MARK

- 12) Where a person is found to have infringed a registered trade mark, the High Court or a District Court may make an order requiring him-
- a) to cause the offending trade mark to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
 - b) to secure the destruction of the infringing goods, material or articles, if it is not reasonably practicable for the offending trade mark to be erased, removed or obliterated.

[S. 47(1) of TMO'01]

REMEDIES AGAINST INFRINGEMENT - ORDER FOR DELIVERY UP OF INFRINGING GOODS, MATERIAL OR ARTICLES

- 13) The proprietor of a registered trade mark may apply to the High Court or a District Court for an order for the delivery up to him, or such other person as the High Court or a District Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

[S. 48(1) of TMO'01]

REMEDIES AGAINST INFRINGEMENT - ORDER AS TO DISPOSAL OF INFRINGING GOODS, MATERIAL OR ARTICLES

- 14) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 48, an application may be made to the High Court or a District Court-
- a) for an order that they be destroyed or forfeited to such person as the High Court or a District may think fit; or
 - b) for a decision that no such order should be made

[S. 48(1) of TMO'01]

8. Has your country established a separate register for well-known marks?

No.

9. What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?

Please Refer to Chart.

10. Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?

Yes.

- 15) The registration of trade mark in respect of particular goods or services may be opposed on the grounds that:
- e) it is substantially identical with, or deceptively similar to, a well-known trade mark
 - f) that ... had acquired a reputation in Pakistan, and
 - g) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would cause
 - h) dilution or would be likely to deceive or cause confusion

[S. 29(4)(a) of TMO'01]

- 16) Where "dilution" means the lessening of the capacity of a well-known trade mark to identify and distinguish the goods or services, regardless of the presence or absence of competition between owner of the well-known trade mark or other parties or likelihood of confusion or deception

[S. 2(xiii) of TMO'01]

11. What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?

Please Refer to Chart.

Types of Evidence:

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Pakistan	Yes	Yes	Yes	Yes	Yes
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Yes	Yes	Yes	Yes	Yes	Yes

Authentication and Relevance of Evidence:

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
Pakistan	Persuasive	Persuasive	Persuasive	Persuasive	Persuasive
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Persuasive	Persuasive	Persuasive	Acceptable	Evidence by Affidavit	Not Required



Kingdom of Saudi Arabia

Contributors: Maren Hanson (Gulf Consultants for Protection of Intellectual Property)

1. Does your country have specific statutory provisions recognizing Well-Known Marks?

Yes.

Article 1 of the Trademarks Law states that:

“trademarks shall be names of distinct shapes, signatures, words, letters, numbers, drawings, symbols, stamps and protruding inscriptions or any other sign or combination thereof which can be recognized by sight and suitable to distinguish industrial, commercial, vocational or agricultural products or a project to exploit forests or natural resources or to indicate that the object upon which the trademark is put belongs to the owner of the trademark on grounds of manufacture, selection, invention thereof or trading therewith or to indicate the rendering of a certain service.”

This definition precludes certain non-traditional marks such as scent, taste, touch and sound which cannot be “*recognized by sight*”. It is also not possible to register a trademark consisting of a single color in Saudi Arabia although multi-colored marks may possibly be registered (however, we know of no such registrations). Lastly, Saudi law does not mention 3-dimensional marks, and will sometimes reject a 2-dimensional mark if standing alone and not accompanied by words or label.

Well Known trademarks are covered by Article 2 (10) of the Trademarks Law which does not permit the registration of any

“Marks identical with or similar to internationally known marks even if they are not registered in the Kingdom [of Saudi Arabia]”.

From the wording of this provision, it appears that “famous” or “Well-Known” Marks are defined as those marks “internationally known”, and not just those marks well known in the country or region as is defined in the trademark law of some countries. It should be noted that Saudi Arabia is a member of the Paris Convention. It is interesting to find that the definition of Well-Known Marks in the Trademarks Law is in the negative, i.e. what marks cannot be registered.

2. What are the factors/thresholds (either pursuant to statute or customary practice) that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?

There are no statutory threshold requirements as such. When the concept of a well-known mark is used in an opposition or infringement/counterfeiting case, one must provide proof showing that the mark is well-known preferably in Saudi Arabia although it is not mandatory. The Paris Convention is used as a reference to define “internationally well-known” marks.

3. *If one were to apply for registration of trademark in your country (and at the same time claim that its mark is a well-known one) then would the trademark office in your country exempt such application from any (absolute or relative) grounds for examination?*

No.

A claim of a mark being well-known is not made at the time of registration in Saudi Arabia, and would not, therefore, preclude any grounds (absolute or relative) for examination. All trademark applications undergo the same scrutiny regardless of whether or not they are well-known.

4. *Would the trademark office in your country (either pursuant to statute or customary practice) refuse registration of a trademark that is identical or confusing similar to a well-known mark?*

No.

The Saudi Trademarks Department will reject an application for registration of an identical or confusing mark to a mark already registered in the same class in the Kingdom. In actuality, the fact of a mark being well-known has little bearing in spite of the wording of Article 2(10) for classes other than the one(s) with the registered mark.

As an example, a third party tried to register Dell with the “E” slanting down in class 18 for computer bags, and the mark was accepted and published. Under Article 2(10), the mark should not have been given preliminary acceptance as DELL is a well-known mark. Dell Inc. did not have registrations in Saudi Arabia of any of its marks in class 18 although there are DELL registrations in several classes including the mark DELL with the “E” slanting up. In fact, Dell’s only registration worldwide in class 18 is in Chile. Dell filed an opposition against the registration of the mark with the “E” slanting down. The Board of Grievances decided in favor of Dell partially based on the argument that Dell is a well-known mark.

5. *Is it possible to file an opposition in your country, based on the claim that the advertised trademark is identical or deceptively similar to a well-known mark?*

Yes.

It is possible to file an opposition to a mark based on the claim that the published is identical or similar to a well-known mark. An opposition to cancel the registration of another mark that has been published on the Ministry website is made to the Board of Grievances (court) during the 90 day waiting period from the date of publication. First the opposition case is filed against the Ministry of Commerce & Industry (Trademarks Department) with the Board of Grievances (court). Next, the Ministry is notified of the filing date with a copy of the Board of Grievances registration of the case along with the case number requesting the Ministry to stop any further procedure towards the registration of the published mark. The Ministry then sends the other party a letter informing it of the opposition. The date of the first hearing at the Board of Grievances will be set.

The Ministry will generally bring a written answer to the first hearing, but usually the lawyer of the applicant will ask for time to respond. The Ministry may give a copy of the opposition claim to the lawyer

of the applicant as an interested third party in the case. At the second hearing (which may be scheduled for several months later), the applicant's lawyer will submit his answer and it will then respond at the third hearing. This procedure will continue until neither party has anything more to add. The Board of Grievances will then render its decision, which may be appealed by either party.

6. *Is it possible to seek cancellation of a registered trademark in your country, based on the claim that the given registered trademark is advertised trademark is identical or confusing similar to a well-known mark?*

No.

The grounds for cancellation of a trademark registered in Saudi Arabia make no mention of well-known marks and are found in Article 29 of the Trademarks Law. The competent government department is the Trademarks Department – Ministry of Commerce & Industry.

Article (29) The competent [government] department or an interested party may request cancellation of a mark's registration under the following conditions:

1. If the mark's owner does not use it in a serious manner for a period of five successive years without reasonable justification.
2. If the mark was registered in violation of public order and public morality.
3. If the mark was registered fraudulently or according to false information.

The Board of Grievances shall have competence to decide upon requests for cancellation of registration.

7. *In an action for infringement of well-known mark what kind of remedies would be available to the claimant/complainant?*

Generally speaking, trademark infringement cases are not as developed and complicated in Saudi Arabia as in the U.S. with its detailed discovery. Cases in the Kingdom have been largely restricted to the copying of the actual trademark (sometimes with a slight change) and using it on imitated products. For example, passing-off (an old common law cause of action in England), in spite of its presence as a major factor in imitation, is unfamiliar to Saudi judges and is not used as an independent cause of legal action against infringers in Saudi Arabia.

Because a complaint of infringement or counterfeiting is made to the Ministry of Commerce & Industry, an investigation is made and a criminal case is filed with the Board of Grievances. Penalties are described in Articles 49-52 of the Trademarks Law and range to up to one year in prison and a fine up to SR 50,000/- or both. Penalties are doubled for repeat violators. A civil case for the same will be postponed until the criminal case is decided.

Parties injured as a result of a violation specified in this law shall be entitled to claim suitable compensation for the damages sustained from those responsible for this violation. Article 54 of the Trademarks Law provides that "*Parties injured as a result of a violation specified in this law shall be entitled to claim suitable compensation for the damages sustained from those responsible for this violation.*" However, in practice, there are very few cases (if any) where compensation has been awarded. A permanent injunction is the usual remedy.

Lastly under Article 58 of the Trademarks Law, the Board of Grievances, in any civil or criminal suit, issue a judgment to confiscate the seized items to dispose of them in accordance with the conditions and procedures provided for by the Implementation Regulations. It may also order the publication of the judgment in one or more newspapers at the expense of the guilty party, and may order the destruction of all forged or imitation marks (goods) along with the means of their production.

The Grievance Board may order the publication of the judgment in one or more newspapers at the expense of the guilty party. It may also order the destruction of the forged or imitation marks or those marks wrongfully placed or used and order, when necessary, the destruction of the items carrying such marks even if a judgment of acquittal is reached.

8. *Has your country established a separate register for well-known marks? [That is, in addition to the regular one for registration of trademarks]*

No.

9. *What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart.

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

11. *What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
Saudi Arabia	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable

Authentication and Relevance of Evidence

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage (Worldwide)	Internet Evidence	Foreign Evidence
Saudi Arabia	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable



United Arab Emirates

Contributors: Faisal Daudpota (Daudpota International)

1. Does your country have specific statutory provisions recognizing Well-Known Marks?

STATUTORY CONCEPT (AS DERIVED FROM PARIS CONVENTION AND TRIPS AGREEMENT)

- 17) The UAE has made Paris Convention (1883) as part of its national laws, through Federal Decree No. 20 of 1996 Concerning the UAE's Accession to Paris Convention to Protection of Industrial Property
- 18) So, by extension, the UAE affords all the protections that are incorporated Article 6bis of Paris Convention, which includes, ex officio or on application of an interested person:
 - a) refusal or cancellation of registration of well-known mark for identical or similar goods;
 - b) prohibition as to use, reproduction, imitation, translation, capable of confusion with a well-known mark on identical or similar goods
- 19) The UAE has also ratified TRIPs Agreement through its Federal Decree No. 21 of 1997 Concerning the UAE's Accession to the World Trade Organization
- 20) Again, by extension, the UAE affords all the protections that are incorporated in Article 16(1) and (2) of TRIPs Agreement, which includes, ex officio or on application of an interested person:
 - a) refusal or cancellation of registration of well-known mark for identical, similar or dissimilar goods and services;
 - b) prohibition as to use, reproduction, imitation, translation, capable of confusion with a well-known mark on identical, similar or dissimilar goods and services (as long as there is likelihood of association leading to damage to owner

2. What are the factors/thresholds (either pursuant to statute or customary practice) that one must prove/demonstrate before the competent tribunal (i.e. trademark office or court) if one were to claim that his trademark is a well-known mark?

FACTORS TO ESTABLISH A MARK AS WELL KNOWN

- 21) Under Federal Law No. 37/1992 (as amended by Federal Law No. 8/2002), the claimant of a well-known trade mark, must prove the following:
 - h) the extent to which the mark is known to the relevant public as a result of its promotion
[Art. 4(2) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002]

3. If one were to apply for registration of trademark in your country (and at the same time claim that its mark is a well-known one) then would the trademark office in your country exempt such application from any (absolute or relative) grounds for examination?

No.

4. *Would the trademark office in your country (either pursuant to statute or customary practice) refuse registration of a trademark that is identical or confusing similar to a well-known mark?*

STATUS OF WELL KNOWN MARK – TO ACT AS A GROUND FOR REFUSAL, OPPOSITION, OR CANCELLATION

- 22) Art. 3(14) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 prohibits registration of a trade mark if such:
- a) mark constitutes a translation of a well-known mark or other previously registered mark, where the registration would cause confusion amongst consumers in relation to the products that are distinguished by the mark or similar products.
- 23) Art. 4(1) and (3) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 maintains that:
- a) It shall not be permissible to register internationally well-known Trademarks with a reputation that surpasses the boundaries of the country of origin for the trademark to other countries, unless it is requested by the original proprietor or pursuant to a power of attorney given by him.
 - b) It shall not be permissible to register well-known trademarks to distinguish goods or services that are not similar or identical to goods or services in respect of which a well-known trademark is registered, if:
 - The use of the trademark would indicate a connection between those goods and services and the proprietor of the registered trademark.
 - The interests of the proprietor of the registered trademark are likely to be damaged by such use.

5. *Is it possible to file an opposition in your country, based on the claim that the advertised trademark is identical or deceptively similar to a well-known mark?*

STATUS OF WELL KNOWN MARK – TO ACT AS A GROUND FOR REFUSAL, OPPOSITION, OR CANCELLATION

- 24) Art. 3(14) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 prohibits registration of a trade mark if such:
- b) mark constitutes a translation of a well-known mark or other previously registered mark, where the registration would cause confusion amongst consumers in relation to the products that are distinguished by the mark or similar products.
- 25) Art. 4(1) and (3) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 maintains that:
- c) It shall not be permissible to register internationally well-known Trademarks with a reputation that surpasses the boundaries of the country of origin for the trademark to other countries, unless it is requested by the original proprietor or pursuant to a power of attorney given by him.
 - d) It shall not be permissible to register well-known trademarks to distinguish goods or services that are not similar or identical to goods or services in respect of which a well-known trademark is registered, if:
 - The use of the trademark would indicate a connection between those goods and services and the proprietor of the registered trademark.

- The interests of the proprietor of the registered trademark are likely to be damaged by such use.

6. *Is it possible to seek cancellation of a registered trademark in your country, based on the claim that the given registered trademark is advertised trademark is identical or confusing similar to a well-known mark?*

STATUS OF WELL KNOWN MARK – TO ACT AS A GROUND FOR REFUSAL, OPPOSITION, OR CANCELLATION

26) Art. 3(14) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 prohibits registration of a trade mark if such:

- c) mark constitutes a translation of a well-known mark or other previously registered mark, where the registration would cause confusion amongst consumers in relation to the products that are distinguished by the mark or similar products.

27) Art. 4(1) and (3) of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 maintains that:

- e) It shall not be permissible to register internationally well-known Trademarks with a reputation that surpasses the boundaries of the country of origin for the trademark to other countries, unless it is requested by the original proprietor or pursuant to a power of attorney given by him.
- f) It shall not be permissible to register well-known trademarks to distinguish goods or services that are not similar or identical to goods or services in respect of which a well-known trademark is registered, if:
 - The use of the trademark would indicate a connection between those goods and services and the proprietor of the registered trademark.
 - The interests of the proprietor of the registered trademark are likely to be damaged by such use.

7. *In an action for infringement of well-known mark what kind of remedies would be available to the claimant/complainant?*

REMEDIES AGAINST INFRINGEMENT – PROVISIONAL MEASURES

28) Art. 41 of Federal Law No. 37/1992 as amended by Federal Law No. 8/2002 maintains that the owner of a well-known mark (even without having a registration in the UAE) may obtain a Court order to conduct the necessary provisional measures, especially:

- a) Conduct an inventory report showing in detail the description of the machinery and equipment that is being used or was used to commit any of the crimes mentioned in this Law (Federal Law No. 37/1992 as amended) as well as the domestic or imported products or goods, as well as the address of shops or description of packages or paper or other items bearing the trademark or the information involved in these crimes.
- b) A seizure against the abovementioned items after providing a security deposit to be paid as an indemnity to the person against whom the injunction is ordered if deemed applicable.

8. *Has your country established a separate register for well-known marks? [That is, in addition to the regular one for registration of trademarks]*

No.

9. *What kind of evidence is necessary/recommended to establish the factors/thresholds (before a trademark office/court) that a mark is Well-Known?*

Please Refer to Chart.

10. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine?*

No.

11. *What kind of evidence is necessary/recommended to establish (before a trademark office/court) that a mark is Famous?*

Please Refer to Chart.

Types of Evidence

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Printed Adverts	Online & Other Adverts
UAE	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable
Owner's Website	3P Website	Industrial Awards	Foreign Certificates	Successful Enforcement	Survey Evidence
Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable

Authentication and Relevance of Evidence:

Country / Volunteer	Dates	Inherent Strength of Mark	Geographical Coverage	Internet Evidence	Foreign Evidence
UAE	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable
Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable	Not Applicable



United States

Contributors: Jan Jensen (Jensen Law Firm), Anessa Owen Kramer (Honigman Miller Schwartz and Cohn LLP)

1. *Does your country have specific recognition/protection for Well-Known Marks?*

No. The United States does not have specific statutory recognition/protection for Well-Known Marks.

2. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Well-Known?*

Not applicable.

3. *Does your country have specific recognition/protection for Famous Marks under a Dilution doctrine? [Answer should be Yes/No with a brief description of the source of the protection and if it doesn't apply in registration/opposition/cancellation/litigation contexts this should be noted]*

Yes. Famous Marks under a Dilution doctrine are protected in the United States.

The source of the protection includes the following: (1) statutory protection under the Lanham Act pursuant to 15 U.S.C. § 1125 (c); and, (2) in certain states, statutory protection under state statutes. Where the concerning use occurs before October 6, 2006 and the plaintiff is seeking monetary damages, the court may apply the Federal Trademark Dilution Act of 1995, under which the plaintiff must prove actual dilution.

If, however, the alleged diluting mark is first used in commerce after October 6, 2006, the Trademark Dilution Revision Act of 2006 applies, which allows the plaintiff to succeed upon a lesser showing of a "likelihood of dilution." A famous mark must be "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner," which is often viewed as tantamount to a household name. See 15 U.S.C. § 1125 (c)(2)(A). Some state statutes are identical or virtually identical to the federal anti-dilution statute, while others include important differences.

4. *If yes, what kind of evidence is necessary/recommended to establish that a mark is Famous?*

Under federal anti-dilution law as set forth in 15 U.S.C. § 1125 (c)(2)(A), the "court may consider all relevant factors" regarding fame, including the following: "(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark. (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on

the principal register.” 15 U.S.C. § 1125 (c)(2)(A). These factors guide the evidence that should be presented, and generally it may include any evidence that establishes any of the factors. For more detail see the chart below.

Types of Evidence Chart

Country / Volunteer	Sales \$	Advertising \$	Invoices	TV / Print/Digital Adverts
U.S. (1) Jan Jensen; (2) Anessa Kramer	Annual sales figures, with U.S. sales breakdown. Must establish fame prior to the challenged use, so include figures well before that use. A specific number of years is not required. But, the more, the better, as the standard is very high. Breakdown should be for each mark at issue. Detailed breakdown is advisable, e.g., for each class of goods. For some cases it may be helpful to include no. of units sold.	Annual advertising figures pertaining to the mark at issue (include U.S. Breakdown). Include figures prior to the challenged use. A specific number of years is not required. But, the more, the better, as the standard is very high. Evidence of advertising should include evidence of target audience for the ads.	Sales figures must be supported, e.g., by invoices and evidence of payment or through witness testimony. Sample copies from each year, that match product codes to products, would help support the sales figures.	Showing duration, extent, and geographic reach of advertising and publicity of the mark (whether by the owner or third parties) in connection with relevant products. Samples that emphasize and promote the mark may be particularly persuasive
Other Adverts	Owner's Website	3P Website Unsolicited Press	Industrial Awards	
Showing duration, extent, and geographic reach of advertising and publicity of the mark (whether by the owner or third parties), including in editorial features, trade fairs, fashion shows, distributors and retailer list.	To show duration, extent, and geographic reach of advertising and publicity of the mark by owner. Supplement with domain name search to show date of first registration of domain name. Include excerpts pre-dating the challenged use, and consider including web traffic analytics.	To show duration, extent, and geographic reach of unsolicited press and publicity of the mark. Include Wiki or Google search results etc. Unsolicited media coverage is good evidence.	Useful evidence of recognition and scope of use. Explain prestige of awards or recognition and ensure they pertain to the mark at issue, not the company in general.	
Foreign Certificates	Successful Enforcement	Survey Evidence		
U.S. evidence of registrations of the mark(s) at issue should be included. May include evidence of foreign registrations and certificates, but these are unlikely to be strong evidence, given that the mark must be famous in	Local and foreign enforcement, including raids, anticounterfeiting procedures, cease and desist letters, customs, court actions, etc. Previous court/TTAB decisions finding the mark to be famous can be highly persuasive.	Surveys showing dilution may be useful in some cases (especially in close calls). Surveys are frequently presented in US cases, but are usually subject to heavy scrutiny. The survey should ideally show the mark(s) at issue as actually		

the U.S.	encountered by consumers and should target a diverse and size-appropriate population, using a double-blind method. Brand recognition surveys that pre-date the challenged use may be persuasive.
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Authentication and Relevance of Evidence Chart

Country / Volunteer	Dates	Inherent Strength of	Geographical Coverage	Internet Evidence		
U.S. (1) Jan Jensen; (2) Anessa Owen Kramer	A specific number of years of evidence is not required. But, more is better, as the standard is very high. The evidence must show defendant began using its mark in commerce after plaintiff's mark became famous. So, evidence pre-dating the challenged use is critical. Must include evidence of registration of mark(s) at issue. Evidence needs to be dated, but for example © notice on printed ads or date stamp on photos will suffice.	The degree of inherent strength is one factor that courts can consider. So, proof of that should be provided. Yet, even descriptive marks could be found to be famous if they are "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."	Mark must be "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Niche fame is insufficient. Present evidence showing duration, extent, and geographic reach of advertising and publicity of the mark within the U.S. (whether by the owner or third parties).	Relevant but must also include evidence of use before the defendant began using its mark in commerce. In the Trademark Trial and Appeal Board, Internet evidence is self-authenticating, only if the information bears the online source and the date of access. Otherwise, it must be authenticated. Even chat-room evidence can be relevant, but it is subject to challenge. Unsolicited media attention can be relevant. Again, all evidence must be authenticated or meet self-authentication standards of the relevant arbiter, if any.		
Foreign Evidence	Foreign FW Recognition	Brand Value	Translation	Photocopies	Notarization	Legalization
U.S. evidence is key. Can supplement with foreign evidence, but low-probative value.	U.S. evidence is key. Can supplement with foreign evidence, but low probative value.	Expert or independent auditor's report, unsolicited brand recognition or value survey may be probative.	Must submit English translation. Follow FRCP and local rules regarding certification of translation.	Photocopies are generally acceptable, provided that they are authenticated. Evidence must be authenticated according to the Federal	Generally not required.	Not required unless required by owner's or signatory's home jurisdiction or corporate regulations.

Rules of Evidence or the relevant arbiter. FRCP 901 sets forth examples of ways to authenticate documents in federal court, and FRCP 902 lists certain categories of documents that are self-authenticating. Other documents must be admitted through witness testimony.