International Trademark Association

Updated Framework for Well-Known Marks Protection

SPONSORING COMMITTEE: Famous and Well-Known Marks Committee

RESOLUTION: Presented on November 18, 2025

WHEREAS: The global protection of well-known marks is defined by Article 6*bis* of the Paris Convention and Article 16 of the TRIPS Agreement, with additional guidance provided in WIPO's Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

WHEREAS: The International Trademark Association has historically expressed its support for the effective protection and enforcement of well-known marks worldwide, including through its 1996 resolution on Protection of Well-known Marks, its 1999 resolution on WIPO Provisions for the Protection of Well-Known Marks, its 2005 resolution on Well-Known Mark Registries, and its 2011 resolution on Well-Known Mark Protection in the United States of America.

WHEREAS: The International Trademark Association has provided further guidance for the protection of well-known marks through the 2024 Model Trademark Law Guidelines and 2023 Guidelines for Trademark Examination and numerous *Amicus Briefs* supporting the adoption and implementation of the aforementioned rules and standards regarding the protection of well-known marks.

WHEREAS: The existing global framework for protecting well-known marks fails to adequately protect well-known marks considering the commercial, information and consumer trends that have developed globally over the past decades, to the detriment of consumers, brand owners, and governments.

BE IT RESOLVED, that the International Trademark Association endorses the following principles as essential components of an effective well-known marks system:

1. Well-known marks must be protected against conflicting marks that are used in connection with dissimilar goods and services at least when one of the following conditions is fulfilled:
    a. the use of the conflicting mark would indicate a connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and would be likely to damage that owner's interests; or
    b. the use of the conflicting mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark; or
    c. the use of the conflicting mark would take unfair advantage of the distinctive character of the well-known mark.

2. Well-known marks must be protected against conflicting marks that consist of identical or similar reproductions, imitations, translations, and transliterations of a well-known mark.

3. Well-known marks must be protected against conflicting marks that are identical or similar in their entirety to, or regarding the core (or essential) elements of, the well-known mark.

4. Adoption of a flexible approach to analyzing the similarities between a well-known mark and conflicting marks to provide protection where a conflicting mark has incorporated minor changes or additions such as, but not limited to, minor changes in stylization, color adoption, and additional elements.

5. Domestic use (within the jurisdiction where well-known mark protection is sought) shall not be a condition for determining whether a mark is a well-known mark within that jurisdiction.

6. Domestic registration or application for registration (within the jurisdiction where well-known mark protection is sought) shall not be a condition for determining whether a mark is a well-known mark within that jurisdiction.

7. Evaluation of well-known marks may be based on their global notoriety, not just their domestic notoriety.

8. Establishment of a comprehensive framework to challenge the registration, or application for registration, of a conflicting mark through opposition and cancellation/invalidation procedures.

9. In determining whether a mark is a well-known mark, a competent authority should undertake a flexible evaluation of all relevant factors, including, but not limited to:
    a. the degree of knowledge or recognition of the mark in the relevant sector of the public;
    b. global or domestic sales of goods or services bearing the mark (including sales conducted through cross-border or domestic e-commerce and sales made by third parties);
    c. advertising expenses (within the jurisdiction, outside the jurisdiction, or both);
    d. market share (within the jurisdiction, outside the jurisdiction, or both);
    e. physical stores/locations (within the jurisdiction, outside the jurisdiction, or both);
    f. market survey results;
    g. social media presence (including social media activity controlled by the brand owner and social media activity by others, such as consumers);
    h. domestic and foreign press covering the brand;
    i. extent of collaboration projects (especially outside of the brand's core classes); and
    j. sales of, and enforcement against, counterfeit products.

    The above, non-exhaustive list of factors, which are guidelines in determining whether a mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the peculiar circumstances of that case. In some cases, all the factors may be relevant; in other cases, only some will be relevant; and others, none of them may be relevant. The decision may be based on additional factors not listed above.

10. The “relevant sector of public” should include (1) actual or potential consumers; (2) channels of distribution; and (3) business (industry) sector representatives; awareness among the public or consumers at large shall not be a condition for determining whether a mark is a well-known mark.

Background

The Famous and Well-Known Marks Committee has analyzed the global framework that establishes and provides guidance regarding the protection of well-known marks, as well as numerous national laws and practices that implement this framework. This Committee concluded that, notwithstanding certain obligations contained in treaties and elaboration from guidance provided by international organizations, there exist both significant lack of harmonization in how jurisdictions protect well-known marks and deficiencies that hinder effective protection of well-known marks, to the detriment of consumers, brand owners, and governments. Counterfeiters and bad faith actors have learned how to exploit gaps in the existing system and take advantage of the peculiarities of different legislation and standards to target well-known marks and shield their nefarious activities. This includes obtaining trademark registrations that are identical or confusingly similar to established well-known marks.

As a result, INTA believes that more effective tools to protect well-known marks are needed to protect consumers, brand owners, and governments from the confusion and potential damage that can be caused by such targeted activity.

Global protection of well-known marks finds its origin in Article 6*bis* of the Paris Convention adopted in 1925 and subsequently amended (1934 and 1958).

Thereafter, as part of the creation of the World Trade Organization (WTO), members agreed to expand protection for well-known marks through the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Finally, in an effort to harmonize the common obligations contained in the Paris Convention and TRIPS, WIPO and the Paris Union issued, in 1999, a guiding document called The Joint Recommendation concerning the Provisions on the Protection of Well-Known Marks (Joint Recommendation). Although non-binding, this Joint Recommendation sought to create common standards regarding well-known mark protection, including by providing an illustrative list of factors to help evaluate whether a mark is well known, and outlining what should constitute the “relevant sector of the public”, and recommending the scope of protection as applied against “conflicting marks”.

With this background in mind, the Famous and Well-Known Marks Committee surveyed seventy-seven (77) jurisdictions and found both that the common standard that the Joint Recommendation tried to create was not fully implemented and that global retail, distribution, information, and communication systems have changed significantly since the adoption of the Joint Recommendation in 1999. Meanwhile, the global framework has remained frozen and is proving less and less capable of addressing prolific registration of trademarks that mimic or copy well-known marks of legitimate owners, including when such registration is done in bad faith. It is imperative that the global framework adjust to today’s market and communication realities and again serve the interests of brand owners and consumers alike.

The current situation derives in large part from the lag between global consumer awareness of a brand and protecting that brand in every potential market with trademark registrations. Through today's digital, global marketplace and expansive media reach (both traditional and social media), consumers in one market often learn of a foreign brand well before the brand is available in that market, even well before the brand anticipates entering that market. This "overnight" awareness is made possible only because of today's digital tools, many of which didn't exist or were in their infancy twenty-six years ago. This is especially true for brands operating in "niche" segments, where consumers "in the know" globally are able to follow, interact with, and purchase products of that brand even where the public at large may be only faintly aware of the brand.

In today's partially connected global trademark system these gaps are being exploited. Consumers, legitimate businesses, and governments are on the losing end of this exploitation as the purpose of a trademark is to serve as a link between *consumers* and *brand owners*, relaying information on quality, source, price, and other characteristics of goods and services. At its core, a trademark (and trademark law) must serve consumers through trust built upon consistency and reliability.

Overly prescriptive and unworkable well-known mark systems are now exposing consumers to manipulation and harm. As our world becomes increasingly connected through e-commerce, global information channels, improved logistics systems, and new consumer trends, this problem will only continue to grow. Consequently, the Famous and Well-Known Marks Committee concludes that a properly focused system can help slow or even prevent such problems. Updating the international system outlining protection for well-known marks is more important now than ever before. Some jurisdictions, for example, will only consider a mark's notoriety within that jurisdiction. Other jurisdictions, however, will consider foreign notoriety and may grant well-known mark status where a mark is well known outside of the jurisdiction but not within. INTA believes it is necessary not only to promote harmonization and align treatment across the international spectrum, but also to do so in a way that aligns with those jurisdictions that meet the needs of brand owners and consumers today.

The rationale behind the principles that are outlined as essential components of an effective well-known marks system is the following:

- **Application of protection for well-known marks to dissimilar goods and services**

  Few businesses today limit their commercial activity to a discrete set of goods and services, necessitating cross-class protection in the trademark context. Cross branding and collaboration projects are common; in some sectors, collaboration (including outside traditional sectoral boundaries) is necessary for survival. Consumers are accustomed to seeing brands they know used on a wide range of products and services and would, therefore, likely be confused where a logo or mark they recognize is used in what may at first glance be considered an unrelated class of goods or services. The obligations within TRIPS and the standards of the Joint Recommendation strike an appropriate balance when it comes to protecting well-known marks outside of classes of use or registration, yet many jurisdictions fail to implement this framework either in law or practice.

- **Broader understanding of what constitutes a "conflicting mark"**

  Well-known marks systems must incorporate a broad understanding of what constitutes a conflicting mark so that they prevent marks that consist of identical or similar reproductions, imitations, translations, and transliterations of a well-known mark, and also marks that are identical or similar in their entirety or regarding the core (or essential) elements of the well-known mark.

- **Flexible approach to analyzing the similarities between a well-known mark and conflicting marks**

  A strict analysis requiring exact or near similarity retains a significant loophole easily exploited by bad faith actors, as experience has shown that they will employ every trick in the book to profit at another's expense, including introducing minor stylization differences, color adaptations, added elements, etc. to assert their mark is not confusingly similar.

- **Eliminating requirements for domestic use or registration/application**

  A mark should be judged on the strength of its notoriety, which in today's global market is easily developed well before any local use or application. Marks not yet registered or used in one jurisdiction are at risk of being grabbed with the intent and impact of creating an unfair commercial landscape and introducing consumer confusion, hence imposing domestic use or registration/application requirements severely undermines the objective and effectiveness of well-known marks systems.

- **Protection of trademarks that are well known either domestically or in foreign jurisdictions**

  Commerce and communication are global; trademarks that quickly gain notoriety at home or abroad soon become high-value targets. Many well-known marks systems today look only at whether a trademark has sufficient notoriety within that jurisdiction; they place little or no value on the mark's global notoriety. This institutionalizes a gap ripe for targeting by bad faith actors who scour the Internet, foreign e-commerce sites, and even foreign trademark registries to help them target brands that are on the precipice of domestic notoriety. Some jurisdictions, however, recognize the global nature of commerce and have incorporated an expansive scope into their laws, providing a means to grant a trademark well-known mark status based on notoriety outside of the jurisdiction. INTA believes this expansive scope is necessary to fully support the interests of brand owners and consumers.

- **Establishment of a comprehensive framework for cancelling or opposing conflicting marks**

  The purpose of a well-known marks system is to prevent unfair competition and consumer confusion caused by association with a well-known mark. Consequently, to be effective, a well-known marks system must prioritize preventing the registration of a conflicting mark – including through *ex officio* rejection by a trademark office – while maintaining efficient systems to challenge the conflicting mark, both before and after the registration.

- **Flexible evaluation of factors for determining whether a mark is well-known**

  Companies and consumers operate very differently today, compared to when well-known marks protection was first introduced (100 years ago) and even when the framework was updated by the Joint Recommendation (over 25 years ago). Global e-commerce and communication tools allow companies and consumers to interact across physical boundaries and instantaneously. New business models exist that focus on limited production runs and periodic release (or "drop") dates. Companies collaborate with partners outside of traditional market synergies to broaden exposure and expand consumer awareness. Advertising campaigns developed for and deployed within one market easily extend into other markets, often driven by consumers rather than the brand owner. Thus, brand awareness and growth may be driven by consumers' use of social media interactions rather than traditional marketing or advertising. Consumers may even travel to different countries seeking out a brand that they cannot get or is scarce in their home market. These and other trends often fall outside traditional well-known marks analysis, which values high in-market sales, advertising expenses, and even physical presence; significant market share, often based on a broad consideration of what constitutes the relevant "market"; and duration and geographical use, registration, and promotion of trademarks. Businesses, consumers, and even bad faith actors have all moved beyond these traditional trends; our well-known marks systems must similarly reflect the realities of business today.

An adaptable standard of analysis must enshrine flexibility to consider any and all relevant factors. This Board Resolution provides an illustrative list of factors, reflecting common and developing business practices and strategies within the relevant business sector(s), including niche sectors. None of these factors, however, should be treated as essential across every evaluation of whether a mark is well known. In some cases, all the factors may be relevant; in other cases, some may be relevant while others are not; and in other cases, none of these factors may be relevant. The decision may be based on additional factors not listed above.

- **Uniform and reasonable standards for determining who constitutes the "relevant sector of the public"**

  An overly restrictive understanding of "relevant sector of the public" can easily create a scenario where a trademark quickly gains global notoriety within a small but core consumer base yet lacks similar recognition by the broader public. A brand's investment in developing this focused reputation cannot be overlooked or misunderstood. A well-known mark system should therefore consider several distinct groups that can constitute the "relevant sector of the public", including actual or potential consumers, channels of distribution and business (industry) sector representatives, and under no circumstances should awareness among the public or consumers at large be required.

CONCLUSION

By implementing the key aspects mentioned in this board resolution, local or regional IP systems would achieve more consistency from which brand owners, consumers and governments alike will benefit, particularly considering the increasing prevalence of bad faith trademark actors.