

# ■ Can Marks in Different Scripts Be Considered as the Same Mark for Certification Purposes?

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# Requirements for filing an international application

- Entitlement
- “Basic mark”
- Rule 6(1): The international application shall be in English, French or Spanish...”.
- Rule 9(4)(a): The international application shall contain or indicate...(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application

# Consequences of Latin script requirement

- The Madrid System is built upon the basis of the Latin script
- There are no provisions for non-Latin script reverse to Rules 6 and 9
- Trademark holders coming from Contracting Parties using non-Latin scripts, may file a new mark in Latin script for the purpose of using the Madrid System
- This “new” mark filed in the Office of origin will be considered as the “basic mark” for an international application
- The purpose for this action: improved brand recognition in export markets where Latin script is used
- Added vulnerability: Non-use cancellation actions (“central attack”)

# Core objective of the Madrid System

- “The Madrid Agreement was a prescient recognition of the intensification of international trade. Radical changes in the means of transportation and communication resulted in a massive flow of products, and, with them, the marks that distinguished the origins of those products, across frontiers...The Madrid Agreement has, in its own small and specialized area...contributed to the process of internationalization (of commerce)”
- The Madrid System contains the two legal pillars of an intensified cooperation in the area of marks in international commerce

# Core objective... cont.

- The internationalization of trade is an ever-growing reality
- 96 members covering 112 countries... and growing
- Holders market their products and services in jurisdictions far away from their national origins
- This implies that the mark be presented in the characters of the linguistic culture of the targeted market
- There is a need to express international marks in characters which are not necessarily the same of those in the national mark

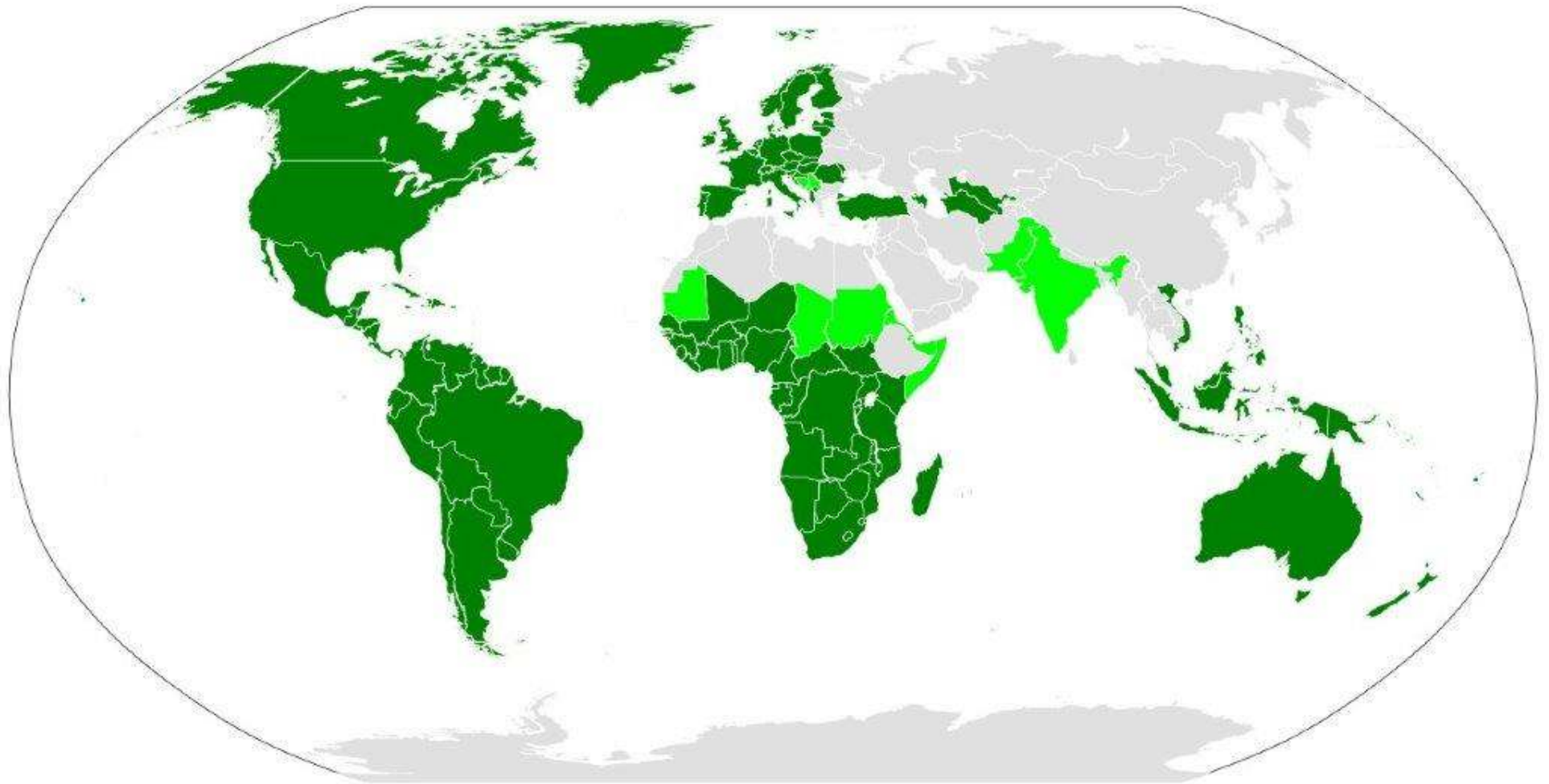
# Linguistic requirements

- The Madrid System is built upon the basis of the Latin script
- No formal discrimination regarding the linguistic requirement as nothing prevents a holder from filing an international application with a mark in non-Latin script
- Nothing prevents a holder from filing an international application with a mark in Latin script (meant for markets with non-Latin script)
- BUT perhaps a practical discrimination as the Madrid System does not take into consideration the linguistic diversity of its members?
- The linguistic framework does not correspond to the linguistic diversity of its constituency

# Development of the Madrid System

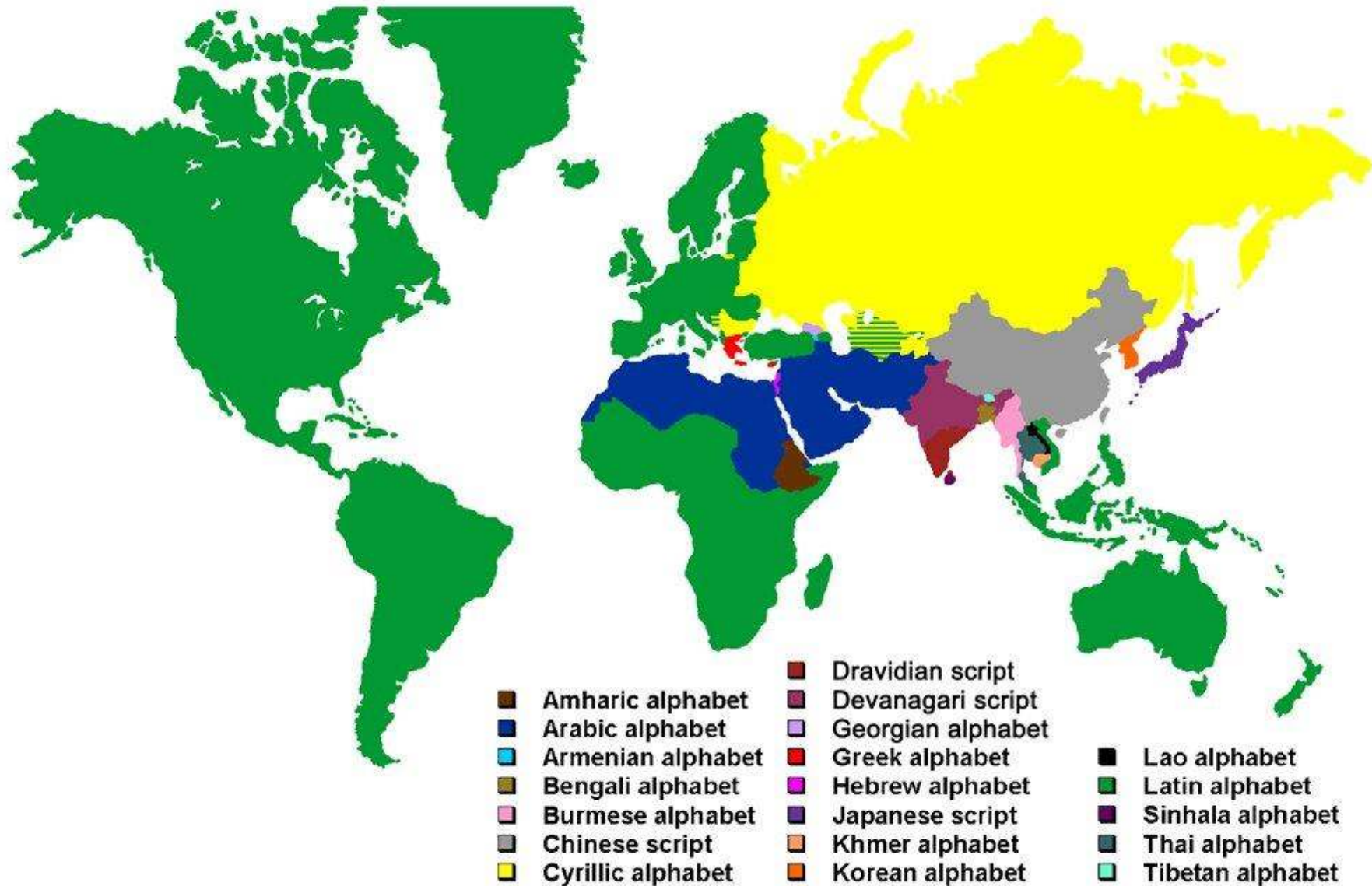
- In terms of non-Latin script Contracting Parties (CPs)
- Madrid Agreement 1891 – 2000:
  - 16 CPs having non-Latin script as official language
- In the Madrid System in 2015
  - 28 CPs having non-Latin script as official language
- A number of potential future members will also have non-Latin script as official language

# Distribution of Latin script





# The world's scripts and alphabets



# Certification function by Office of origin

- The Office of origin must certify the correspondence between the particulars appearing in the international application and the basic application or the basic registration (Article 3(1))
- The international application shall contain a declaration by the Office of origin certifying that ... the mark is the same as in the basic application or the basic registration (Rule 9(5)(d))
- It has been traditionally considered that the Office of origin must certify the identity between the basic and the international mark
- But – more stringent requirement in the Common Regulations now than under the Agreement only; Rule 9(2) only talked about the particulars corresponding...

# Consequence of the identity requirement

- A consequence of the requirement of identity of marks is that the Office of origin cannot certify the international application if the mark is in different script than the one of the basic mark
- The Office of origin, under the constraint of the identity requirement, needs a basic mark which exactly mirrors the mark in the international mark to perform the certification function
- With the result that some holders chose to file a new national mark with a script in use in specific export markets, but not in the home market
  - Increased vulnerability (non-use cancellation actions)

## Consequence of the identity... cont.

- The issue concerned arises where the holder intends to market his products and services under an international mark which is *the equivalent* in Latin script to the non-Latin script mark used in the country of origin
- Also applicable where the basic mark is in Latin script, but where the export markets use non-Latin script
- This is a legitimate need resulting from the increasing expansion of global trade

# EXAMPLES OF MARKS FILED USING DIFFERENT SCRIPTS

# Example (1)

- IRN 1180054
- Holder: Rainbow S.R.L, Italy
- Description of the mark: Trademark consisting of the wording “WINX CLUB” transliterated into Hebrew
- Designations : Israel

מועדון וינקס



## Example (2)

- IRN 1160744
- Holder: ALFA WASSERMANN S.p.A., Italy
- Description of the mark: The mark consists of the word “NORMIX” reproduced in Arabic characters
- Designations: Egypt

نورميكس

NORMIX

## Example (3)

- IRN 815467
- Holder: FINMECCANICA S.p.A, Italy
- Description of the mark: Transliteration in Japanese katakana characters of the wording OTO MELARA
- Designations: Japan

オト メララ

oto melara



## Example (4)

- IRN 1005984
- Holder: BLUE BOX GROUP S.R.L, Italy
- Description of the mark: The trademark consists in the wording “BLUE BOX” in Cyrillic, phonetic transliteration
- Designations: EE, GE, LT, TM, UZ, AM, AZ, BG, BY, KG, KZ, LV, MD, RU, TJ, UA

блѹ бокс

blue box

## Example (5)

- IRN 889281
- Holder: BACCARAT, France
- Description of the mark: The mark comprises the transliteration in Chinese characters of the word “BACCARAT”
- Designations: CN, SG

巴卡拉

*Baccarat*

## Example (6)

- IRN 1050192
- Holder: BACCARAT, France
- Transliteration: BACCARAT
- Designations: MA

بـاـكـارـا

*Baccarat*

## Example (7)

- IRN 1039954
- Holder: FROMAGERIES BEL, France
- Description of the mark: LA VACHE QUI RIT in Arabic characters
- Designations: DZ, BH, OM, SY, EG, IR, MA

البقرة الضاحكة

LA VACHE QUI RIT

## Example (8)

- IRN 10796695
- Holder: Volkswagen Aktiengesellschaft, Germany
- Description of the mark: The mark consists of the Hebrew words whose transliteration is “VOLKSWAGEN”
- Designations: IL

פולקסווגן

VOLKSWAGEN

## Example (9)

- IRN 1212488
- Holder: İSTİKBAL MOBİLYA SANAYİ VE TİCARET ANONİM ŞİRKETİ , Turkey
- Description of the mark: The mark consists of the blue letters İSTİKBAL in Japanese language and there are three horizontal waves in yellow color placed at the right of the term İSTİKBAL
- Designations: JP



## Example (10)

- IRN 791121
- Holder: LABORATORIOS DEL DR. ESTEVE, S.A., Spain
- Description of the mark: The name "OTOCLEAN" is written in capital letters and below, this name is repeated, represented in Japanese characters
- Designations: JP

**OTOCLEAN**

**OTOCLEAN**

**オトクリーン**

## Example (11)

- IRN 1141958
- Holder: KUBARA HINKE SHOKUJIN CO., LTD., JAPAN
- Designations: CN, EM, KR, SG, US, VN

KAYANOYA

茅乃舎  
かやのや



# Possible improvements?

- The linguistic framework does not correspond to the linguistic diversity of its constituency
- This is a legitimate need to add flexibility resulting from the increasing expansion of global trade
- What can we do?
- Re-define the certification function, to align with the less strict wording of the treaties and the Regulations under the Agreement?
- The Office of origin would certify not the identity, but the *correspondence* on the basic mark and the international mark

# Possible improvements...cont.

- Redefinition would lead to benefits
  - No need to file a “new” basic mark
  - Less vulnerability of threats from third parties
  - Less additional expenses
  - Increased use of the Madrid System?
- Would require an amendment to Rule 9(5)?
- Offices can require transliteration and evidence
- Would not exclude identity, but would give the Offices the possibility to certify identity or equivalence
- Would then support the core objective of the Madrid System, to foment and stimulate the development of global trade in a user-friendly manner

Thank you  
for your attention

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