



ROUNDTABLE

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CORRESPONDENCE OF MARKS FOR CERTIFICATION PURPOSES

Document prepared by the International Bureau

1. This document, for discussion in the Madrid Working Group Roundtable, presents the findings of a survey¹, conducted by the International Bureau, on the practices of Offices of origin concerning the correspondence of marks in the certification of the international application.

BACKGROUND

2. The Madrid Working Group Roundtables of 2015 and 2016 discussed the possibility of a more flexible approach to the certification function.

3. The discussions were twofold: addressing the branding needs of trademark owners, wanting to reach customers across several regions using different scripts, and assessing whether there could be any flexibility for Offices of origin in the Madrid System when certifying international applications.

4. The discussions also raised the question of whether the requirement of sameness between the basic and the international marks, in Rule 9(5)(d)(iv) of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”, “the Agreement” and the “Protocol”), is stricter than the requirement under Article 3(1) of the Protocol, which refers to the correspondence between the particulars in the international application and those of the basic application or registration.

¹ Published at: http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=371316.

5. In previous Roundtable meetings, representatives of some Offices have shared information on their certification practices², which revealed that some Offices require absolute identity between the basic and the international marks, while other Offices take a more nuanced approach when certifying international applications.

6. In view of the discussions and shared information, there seemed to be a need for more information on the certification practices by Offices, to see if guidelines or a “best practices” approach could be introduced, to assist Offices interested in clarifying their certification practice.

GENERAL INFORMATION

7. On February 24, 2017, the International Bureau sent Note C.M. 1446 to the Offices of the Contracting Parties of the Madrid System with a questionnaire on *Correspondence of Marks for Certification Purposes* and invited Offices to reply to the questionnaire by April 3, 2017. The questionnaire and the replies by participating Offices are available on the Madrid System website at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=43285.

8. By May 12, 2017, the International Bureau had received responses from 62 Offices. Three of these Offices indicated that applicants must use an on-line application form that automatically includes the reproduction of the basic mark kept in their databases. Given that there is always identity between the basic and international marks for these Offices, they were not required to answer any further questions.³ Therefore, this document is based on replies provided by the remaining 59 Offices.

9. Of the replying Offices, 44 reported that they mostly receive applications for marks in Latin script; four Offices reported that they mostly receive applications for marks in other scripts and 14 Offices reported that they receive applications for marks in both Latin and other scripts.

10. Of the replying Offices, 46 Offices indicated that they consider that a standard character declaration in an international application is equivalent to a declaration that the mark is a word mark, while six Offices indicated that they did not. Seven Offices also replied that they would, depending on the circumstances. For example, one Office said that it would accept the declaration if the mark was in what the Office deems as standard characters. Another Office indicated that it would disregard the declaration and examine the mark as filed.

SUMMARY OF THE REPLIES

“A. Marks that consist of word(s), letter(s), number(s) or any combination thereof

“– Typefaces (font or effect)

“1. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- in a given font, would the Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) but in a different font?”

The following answers were recorded:

Yes		38
Yes, always the case	10	
Yes, with standard character Declaration	19	
Yes, in certain circumstances	9	
Never		21

² See MM/LD/WG/13/RT http://www.wipo.int/meetings/en/details.jsp?meeting_id=37742 and MM/LD/WG/14/RT http://www.wipo.int/meetings/en/details.jsp?meeting_id=39952.

³ In addition, one Office indicated that applicants must use the on-line application form and cannot change the reproduction of the mark, but nevertheless filled out the full questionnaire. Another Office allows the applicant to choose either an on-line form or paper form.

11. Of the 38 Offices that replied “yes”, 28 Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, where differences are not noticeable.

12. When responding to specific examples (question A. 2.), Offices replied that they would consider there is correspondence in the following circumstances:

- When the difference was from one particular font to the same font in bold typeface (37 Offices; however, 12 of those Offices stating only with a standard character declaration).
- When the difference was from one particular font to the same font in italic (27 Offices, while nine of those Offices stating only with a standard character declaration).
- When the difference was from Bradley Hand to Arial (13 Offices, while three of those Offices stating only with a standard character declaration).
- When the difference was from Old English Text to Arial (11 Offices, while two of those Offices stating only with a standard character declaration).

“– **Size, spacing and scaling**

“3. If the mark in an international application consists of word(s), letter(s), number(s) - or any combination thereof- in a given font, would your Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) in the same font but:

“a. in a different size?

“b. with different character spacing or scaling?”

The following answers were recorded to (a.):

Yes		54
Yes, always the case	28	
Yes, with standard character declaration	16	
Yes, in certain circumstances	10*	
Never		6

*One Office answered “yes, with standard character declaration” and “yes, in certain circumstances”.

13. Of the 54 Offices that replied “yes”, 26 Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, when all elements are in the same scale.

The following answers were recorded to (b.):

Yes		42
Yes, always the case	14	
Yes, with standard character declaration	19	
Yes, in certain circumstances	9	
Never		17

14. Of the 42 Offices that replied “yes”, 28 Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, when the overall impression does not change.

15. When responding to specific examples (question A. 4.), Offices were consistent with their answers to the general question. However, 40 Offices replied that they would never consider there is correspondence when spacing has been adjusted to form a conjoined word.

“– **Accented letters, capitalization or punctuation**

“5. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- would the Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) but with accented letters, capitalization or other punctuation?”

The following answers were recorded:

Yes		22
Yes, always the case	8	
Yes, with standard character declaration	3	
Yes, in certain circumstances	11	
Never		37

16. Of the 22 Offices that replied “yes”, 14 Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, when the difference does not change the meaning or pronunciation of the word.

17. When responding to specific examples (question A. 6.), Offices were consistent with their answers to the general question.

18. However, 32 Offices indicated that they would consider there is correspondence when the difference was a change from all words (and characters) in uppercase to all words (and characters) in lowercase:

- 17 indicated that this would always be the case;
- 15 indicated that this would be the case providing there is a standard character declaration; and,
- Two indicated that this would depend on other factors, which related to specific practices undertaken by those Offices.

“– **Positioning, direction**

“7. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- would your Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) but represented with different positioning or direction?”

The following answers were recorded:

Yes		9
Yes, always the case	5	
Yes, with standard character declaration	2	
Yes, in certain circumstances	2	
Never		50

19. Of the nine Offices that replied “yes”, four Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, when the difference was strictly limited to positioning or direction.

20. When responding to specific examples (question A. 8.), Offices were consistent with their answers to the general question. However, 18 Offices replied that they would consider there is correspondence when the difference was a change from all words in two lines to all words in one line. Of these Offices, 13 indicated that this would always be the case, while five indicated that this would be the case with a standard character declaration.

“– Descriptive elements

“9. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- would your Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) but with additional descriptive elements?”

The following answers were recorded:

Yes		12
Yes, always the case	6	
Yes, with standard character declaration	-	
Yes, in certain circumstances	6	
Never		45
No response		2

21. Of the 12 Offices that replied “yes”, six Offices indicated that they would consider correspondence in certain circumstances, for example, where the additional element is a trademark symbol such as “®”.

22. When responding to specific examples (question A. 10.), Offices were consistent with their answers to the general question. However, 29 Offices replied that they would consider there is correspondence when the basic mark includes the registered symbol “®” and the international mark does not. Of these Offices, 21 indicated that this would always be the case, while eight Offices indicated that this would be the case provided there was a standard character declaration.

“B. Transliteration or translation

“1. If a basic mark consists of word(s), letter(s), number(s) -or any combination thereof- in a given language and script (e.g. English in Latin script), would the Office consider that it corresponds to an international mark that consists of its (their) transliteration or translation into other language or script (e.g. Arabic, Chinese, Cyrillic)?”

The following answers were recorded:

Yes		8
Yes, always the case	5	
Yes, with standard character declaration	1	
Yes, in certain circumstances	2	
Never		50
No response		1

23. Of the eight Offices that replied “yes”, three Offices indicated that they would consider correspondence when there is a standard character declaration or in certain circumstances, for example, when translated from the language used by the Office into English.

24. When replying to specific examples (question B. 2.), Offices were consistent with their answers to the general question.

“C. Representation of the international mark in color

“1. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- in either color or grayscale, would the Office consider that it corresponds to a basic mark comprising the same word(s), letter(s) or number(s) but in black and white?”

The following answers were recorded:

Yes		20
Yes, always the case	13	
Yes, with standard character declaration	-	
Yes, in certain circumstances	7	
Never		39

25. Of the 20 Offices that replied “yes”, seven Offices indicated that they would consider correspondence in certain circumstances, for example, when color has not been claimed in the basic mark.

26. When replying to specific examples (question C. 2.), Offices were consistent with their answers to the general question.

“D. Variations of figurative elements

“1. If the Office considers that the mark in an international application and the basic mark do not differ in respect of their material features but only in respect of minor features, would the Office consider that they correspond?”

The following answers were recorded:

Yes		27
Yes, always the case	9	
Yes, with standard character declaration	-	
Yes, in certain circumstances	18	
Never		31
No response		1

27. Of the 27 Offices that replied “yes”, 18 Offices indicated that they would consider correspondence in certain circumstances, for example, when the differences are so minor that they may go unnoticed.

28. However, when replying to the specific examples (question D. 2.), the following was noted:

– Addition of a color element: Of the replying Offices, 13 indicated that they would consider there is correspondence when the difference is an addition of color to one element in the international mark. Forty-five Offices would not consider correspondence in such circumstances.

– Modernization: Of the replying Offices, eight Offices indicated that they would consider there is correspondence where the difference is a modernization of the international mark. Fifty Offices would not consider correspondence in such circumstances.

– Clearer Image: Of the replying Offices, 38 Offices indicated that they would consider there is correspondence where the difference is a clearer or sharper image of the basic mark. Nine Offices indicated that such correspondence would depend on other factors such as whether the overall impression remained the same or the identity of the mark is altered. Fourteen Offices would not consider correspondence in such circumstances.

“E. Three-dimensional and sound marks (where applicable)”

Three-dimensional marks

29. The majority of Offices indicated that they would not consider correspondence where a three-dimensional basic and a three-dimensional international mark comprised of representations of inconsistent views in particular this would be case where:

– the international mark comprised a combined view and the basic mark comprised a single view (49 Offices);

– the international mark comprised a single view and the basic mark comprised a combined view (46 Offices).

30. Some Offices (21) indicated that they would consider correspondence where the international mark consists of a combined view and the basic mark consists of two separate views.

Sound marks

31. The majority of Offices indicated that they would not consider correspondence where the basic mark consists of a sound represented in a different manner to that represented in the international mark. Offices indicated in particular that they would not consider there is correspondence in the following circumstances:

– where the basic mark consists of a sonogram and the international mark consists of a pentagram (43 Offices);

– where a basic mark consists of a sound recording and the international mark consists of a pentagram (36 Offices);

– where a basic mark consists of a sound recording and the international mark consists of a written description (37 Offices).

32. Several Offices replied that it “depends on other factors” to indicate that their legislation does not provide for sound marks. Some Offices provided further information concerning the other factors. For example, one Office indicated that it works with applicants on a case-by-case basis to determine the best course of action, while another Office reported that it was engaged in a proactive review of sound marks.

“F. Series of marks (where applicable)”

33. Of the 55 Offices that replied to the question concerning correspondence relating to series marks, 47 Offices would not consider correspondence where the international mark consists of verbal elements extracted from a series of marks in a basic mark. Six Offices indicated that they would consider correspondence in this case.

34. A significant number of Offices (38) would not consider correspondence where the international mark consists of one mark selected from a series of marks in a basic mark. Thirteen Offices indicated that they would consider correspondence in this case. Five Offices indicated that correspondence would depend on other factors (for example, the mark selected from the series of basic marks must be identical to the international mark).

MAIN FINDINGS OF THE EXERCISE

35. A large number of Offices consider that a standard character declaration is equivalent to a declaration that the mark is a word mark.

36. A review of the replies to the questionnaire suggests that an important number of Offices exercise some degree of flexibility regarding the certification of the international application when:

- the basic and international marks are in different fonts but the Office deems they are commonly used fonts (e.g. Arial);
- the basic and international marks are in the same font but one of them is in bold typeface;
- the characters in the basic and international marks are in the same font but the marks are presented in different size.
- the characters in the basic mark are spaced in a way which is different than the one used in the international mark;
- the basic mark is in uppercase and the international mark is not, or vice versa;
- the basic mark includes the registered symbol “®” and the international mark does not;
- the international mark consists of a clearer or sharper image of the basic mark.

37. The review also suggests that most Offices are less flexible concerning the certification of the international application when:

- the basic and international marks are in different fonts and the Office deems they are less commonly used fonts (e.g. Old English);
- the basic and international marks are in the same font but one of them is in italic typeface;
- the basic mark consists of more than one word and spacing in the international mark has been adjusted to form a conjoined word;
- the basic mark has some letters in uppercase and the international mark does not;
- the basic mark has accented letters or punctuation marks and the international mark does not;
- the basic and international mark differ in respect of positioning or direction;
- the international mark is a translation or transliteration of the basic mark;
- there are differences in color between the basic and international mark;

- there are variations between the basic and international mark, when these have figurative elements;
- the representation of the international mark is different than the representation of the basic mark, when these are three-dimensional or sound marks;
- the international mark consists of one mark or verbal elements extracted from the basic mark, when the latter is a series of marks.

38. Some Offices consistently indicated that they would not certify the international application under any of the circumstances or cases presented in the questionnaire.

39. Therefore, it seems that, regarding the certification function, the practices of the Offices range from being moderately flexible to requiring identity with the basic mark.

40. Finally, it appears that the immediate problem with special types of marks, such as three-dimensional marks and sound marks is not directly related with their certification, but with requirements concerning their representation.

POSSIBLE WAYS FORWARD

41. The findings reveal that there are different practices amongst the Offices when certifying international applications. Some Offices seem to require “identity”, which makes them less flexible, while other Offices seem to require “correspondence” between the basic and international marks, which makes them more flexible. In view of the above, a deeper analysis and further discussion may be necessary to reach general principles and possible guidelines or “best practices” for those Offices that are interested.

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