**QUESTIONNAIRE ON CORRESPONDENCE OF MARKS**

**FOR CERTIFICATION PURPOSES**

The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (“Working Group”) has in previous sessions, in its Roundtable event, discussed the certification process by Offices of origin, and more specifically, the correspondence of marks. The discussions have shown that, in this respect, there are diverging practices amongst the members of the Madrid System.

The purpose of this questionnaire is to gather information on the current practice of Offices when checking the particulars of the basic application/basic registration (“basic mark”) and the international application for certification purposes. Of particular interest in this context is how the comparison between the representation of the basic mark and the mark in the international application is made, and how Offices determine whether the marks correspond or not.

The compilation of the replies to this questionnaire will be presented to the Roundtable organized back to back with the next session of the Working Group which will be held from June 19 to 22, 2017.

Please, download this questionnaire from *http://www.wipo.int/meetings/en/details.jsp?meeting\_id=42293* and reply by checking boxes or typing your answers, using as much space as needed. Once you have finished, email your answers to madridlegal@wipo.int, by **April 3, 2017**.

**Background information:**

The name of the Office: …………………………………………………………….…….….

Name of the contact person: …………………………………………………………...

E-mail address: ………………………………………………………

1. Marks filed with the Office are mainly in:

Latin script

Other script (such as Arabic, Chinese or Cyrillic); please specify:

[Type here] ……………………………………………………………………….

1. Does the Office provide an on-line international application form that is automatically filled-in with the basic mark reproduction?

Yes, applicants must use the on-line application form and cannot change the reproduction of the mark (If this option is checked, there is no need to complete the rest of the questionnaire; however, please send it to madridlegal@wipo.int)

Yes, but applicants can either submit their own reproduction or file an international application using the paper form MM2

No

1. Does the Office consider that an international application with a standard character declaration is equivalent to a declaration that the mark is a “word mark” (rather than, for example, a “figurative mark”)?

Yes

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

**QUESTIONS:**

1. **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 (e.g. “word”), 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 (e.g. “word”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international mark appearing below corresponds to the following basic marks?

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Font/effect | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | Apple Pies | Bradly Hand |  |  |  |  |
| Apple Pies | Old English Text |  |  |  |  |
| **Apple Pies** | Bold |  |  |  |  |
| *Apple Pies* | Italic |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

* **Size, spacing and scaling**

1. If the mark in an international application consists of word(s), letter(s), number(s) - or any combination thereof- in a given font (e.g. “word”), 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:
   1. in a different size (e.g. “word”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

* 1. with different character spacing or scaling (e.g. “word” or “word”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international mark appearing below corresponds to the following basic marks?

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Character spacing/scaling | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | Apple Pies | Expanded  by 2 point |  |  |  |  |
| Apple Pies | Reduced by 80% |  |  |  |  |
| ApplePies | Conjoined word |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

* **Accented letters, capitalization or punctuation**

1. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- (e.g. “word”), would your 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 (e.g. “WORD” or “Wörd”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international mark appearing below corresponds to the following basic marks?

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Case, accents or punctuation | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | APPLE PIES | All uppercase |  |  |  |  |
| APPle pies | Random capitalization |  |  |  |  |
| Apple PIES | Partial capitalization |  |  |  |  |
| “Apple Pies” | Quotation |  |  |  |  |
| Âpplé Pïes | Accents |  |  |  |  |
| Apple-Pies | Hyphen |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

* **Positioning, direction**

1. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- (e.g. “word”), 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 (e.g. )?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international mark appearing below corresponds to the following basic marks?

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Direction | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | Apple Pies | Counter clockwise |  |  |  |  |
| Apple Pies | Top to bottom |  |  |  |  |
| Apple Pies | Upside down |  |  |  |  |
| Apple Pies | Arched |  |  |  |  |
| Apple  Pies | Two lines |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

* **Descriptive elements**

1. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- (e.g. “word”), 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 (e.g. “word.com”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international mark appearing below corresponds to the following basic marks?[[1]](#footnote-1)

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Descriptive elements | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | Apple Pies® | TM symbol |  |  |  |  |
| Apple Pies.com | Domain name |  |  |  |  |
| Apple Pies ltd | Legal nature (abbreviation) |  |  |  |  |
| Joint Stock Company  Apple Pies | Legal nature (entity) |  |  |  |  |
| Apple PiesD:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-173812556.jpg | Figurative elements |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

1. **Transliteration or translation**
2. If a basic mark consists of word(s), letter(s), number(s) -or any combination thereof- in a given language and script (for example, 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)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the following international marks correspond to the basic mark appearing below?

*Please, respond only in respect to the basic mark(s) that corresponds to the language(s) or script(s) mainly used for marks filed with the Office. In all other cases, check N/A.*

|  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic Mark | Transliteration/  translation | N/A | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| 苹果派 | فطائر تفاح | Translation from Arabic to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Arabic to English |  |  |  |  |
| Fataaer tofah | Transliteration from Arabic to English |  |  |  |  |
| فطائر تفاح | 苹果派 | Translation from Chinese to Arabic |  |  |  |  |  |
| Apple Pies | Translation from Chinese to English |  |  |  |  |
| Pingguo Pai | Transliteration from Chinese to English |  |  |  |  |
| 苹果派 | Apple Pies | Translation from English to Chinese |  |  |  |  |  |
| Tartes aux Pommes | Translation from English to French |  |  |  |  |
| Эпл пайз | Transliteration from English to Russian |  |  |  |  |
| فطائر تفاح | Tarte aux Pommes | Translation from French to Arabic |  |  |  |  |  |
| Apple Pies | Translation from French to English |  |  |  |  |
| Тарт о пом | Transliteration from French to Russian |  |  |  |  |
| 苹果派 | פַּאִי תַפּוּחִים | Translation from Hebrew to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Hebrew to English |  |  |  |  |
| Pie Tapuchim | Transliteration from Hebrew to English |  |  |  |  |
| 苹果派 | アップルパイ | Translation from Japanese to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Japanese to English |  |  |  |  |
| appurupai | Transliteration from Japanese to English |  |  |  |  |
| 苹果派 | 사과 파이 | Translation from Korean to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Korean to English |  |  |  |  |
| Sha-gwa Pai | Transliteration from Korean to English |  |  |  |  |
| 苹果派 | Яблочные пироги | Translation from Russian to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Russian to English |  |  |  |  |
| iablochnye pirogi | Transliteration from Russian to English |  |  |  |  |
| 苹果派 | Tartas de Manzana | Translation from Spanish to Chinese |  |  |  |  |  |
| Apple Pies | Translation from Spanish to English |  |  |  |  |
| Тартас де мансана | Transliteration from Spanish to Russian |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | | |

1. **Representation of the International mark in color**
2. If the mark in an international application consists of word(s), letter(s), number(s) -or any combination thereof- in either color or grayscale (e.g. “Word”, “Word”), 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 (for example “Word”)?

Yes, always

Yes, but only if the international application has a standard character declaration

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international marks appearing below correspond to the following basic marks?

|  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Color/grayscale/shades | YES | YES, with standard character declaration | NO | Depends on other factors\* |
| Apple Pies | Apple Pies | From black to blue |  |  |  |  |
| Apple Pies | From black to gray |  |  |  |  |
| Apple Pies | Apple Pies | From red to dark red |  |  |  |  |
| Apple Pies | From red to salmon red |  |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | | |

1. **Variations of figurative marks**
2. 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?

Yes, always

Never

Yes, but only in the following circumstances:

[Type here] ……………………………………………………………………….

1. Would the Office consider that the international marks appearing below correspond to the following basic marks?[[2]](#footnote-2)

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Description of the difference | YES | NO | Depends on other factors\* |
| D:\Users\sawasato\Pictures\Balloon2.jpg | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-455592295 (2).jpg | Addition of color |  |  |  |
| D:\Users\sawasato\Pictures\iStock-165635930.jpg | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-165635930 (2).jpg | Addition of color |  |  |  |
| D:\Users\sawasato\Pictures\iStock-466038487.jpg | D:\Users\sawasato\Pictures\iStock-452477187.jpg | Modernization |  |  |  |
| D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-173812556.jpg | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-173812556.jpg | Clearer image |  |  |  |
| \* *Please provide details of the other factors by typing here*: | | | | | |

1. **Three-dimensional and sound marks (where applicable)**

Would the Office consider that the international marks appearing below correspond to the following basic marks?[[3]](#footnote-3)

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Difference between international and basic mark | YES | NO | Depends on other factors\* |
|  | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\1-1 perspective1 (2).jpg | From two single views to a combined view |  |  |  |
| D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\1-1 perspective 2 (2).jpg |
|  | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\1-1 perspective1 (2).jpg | From one single view to a combined view |  |  |  |
| D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\1-1 perspective 2 (2).jpg |  | From a combined view to one single view |  |  |  |
| D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-479597693 (2).jpg | A sound recording of a sound mark (e.g. MP3 or WAV) | From a sound recording to a pentagram |  |  |  |
| The mark consists of a beamed eighth note | From a sound recording to a description of the sound |  |  |  |
| D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-479597693 (2).jpg | D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-463316177 (3).jpg | From a sonogram to a pentagram |  |  |  |
| *\* Please provide details of the other factors by typing here:* | | | | | |

1. **Series of marks (where applicable)D:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.IE5\KLPNYB82\blockpage[3].gif**

Would the Office consider that the international marks appearing below correspond to the following basic marks?[[4]](#footnote-4)

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| International mark | Basic mark | Element of Series Mark | YES | NO | Depends on other factors\* |
| Apple Pies | Apple Pies | One mark selected from a series of marks |  |  |  |
| APPLE PIES |
| Apple PiesD:\Users\sawasato\AppData\Local\Microsoft\Windows\Temporary Internet Files\Content.Outlook\T9DDT86H\iStock-173812556.jpg |
| Apple Pies | Apple Pies.gov | Verbal elements extracted from a series of marks |  |  |  |
| APPLEPIES.GOV |
| applepies.int |
| *\* Please provide details of the other factors by typing here:* | | | | | |

[End of questionnaire]

1. Pie picture courtesy of iStock.com/plastic\_buddha. [↑](#footnote-ref-1)
2. Drawing of girl with balloon courtesy of iStock.com/TheresaTibbetts; drawing of cake courtesy of iStock.com/animatedfunk; drawing of Elizabeth Tower (Big Ben) courtesy of iStock.com/Tatiana\_Ti; and, engraving of Elizabeth Tower courtesy of iStock.com/Man\_Half-tube. [↑](#footnote-ref-2)
3. Drawings of tables courtesy of Mr. Hideo Yoshida; drawing of musical notes courtesy of iStock.com/johavel; and, drawing of sound waves courtesy of iStock.com/lasagnaforone. [↑](#footnote-ref-3)
4. Pie picture courtesy of iStock.com/plastic\_buddha. [↑](#footnote-ref-4)