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 <u>checking</u> boxes or <u>typing</u> your answers, using as much space as needed. Once you have finished, email your answers to <u>madridlegal@wipo.int</u>, by **April 3, 2017**.

BACKGROUND INFORMATION:

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

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

E-mail address: …………………………………………………………

A. Marks filed with the Office are mainly in:

☐   Latin script

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

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

B. 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

C. 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:

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 (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] …………………………………………………………………..

2. 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**

3. 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:

   a. 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] …………………………………………………………………….

    b. 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] …………………………………………………………………….

4. 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**

5. 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] …………………………………………………………………….

6. 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**

7. 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. ꟼɿOM)?

☐ Yes, always

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

☐ Never

☐ Yes, but only in the following circumstances:

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

8. 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**

9. 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] ……………………………………………………………………….

10. Would the Office consider that the international mark appearing below corresponds to the following basic marks?[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 Pies	Figurative elements	☐	☐	☐	☐

Please provide details of the other factors by typing here:

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 (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] ……………………………………………………………………….

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[1]   Pie picture courtesy of iStock.com/plastic_buddha.

2. 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		Translation from Arabic to Chinese		☐	☐	☐	☐
Apple Pies	فطائر تفاح	Translation from Arabic to English	☐	☐	☐	☐	☐
Fataaer tofah		Transliteration from Arabic to English		☐	☐	☐	☐
فطائر تفاح		Translation from Chinese to Arabic		☐	☐	☐	☐
Apple Pies	苹果派	Translation from Chinese to English	☐	☐	☐	☐	☐
Pingguo Pai		Transliteration from Chinese to English		☐	☐	☐	☐
苹果派		Translation from English to Chinese		☐	☐	☐	☐
Tartes aux Pommes	Apple Pies	Translation from English to French	☐	☐	☐	☐	☐
Эпл пайз		Transliteration from English to Russian		☐	☐	☐	☐
فطائر تفاح		Translation from French to Arabic		☐	☐	☐	☐
Apple Pies	Tarte aux Pommes	Translation from French to English	☐	☐	☐	☐	☐
Тарт о пом		Transliteration from French to Russian		☐	☐	☐	☐
苹果派		Translation from Hebrew to Chinese		☐	☐	☐	☐
Apple Pies	פַּאי תַפּוּחִים	Translation from Hebrew to English	☐	☐	☐	☐	☐
Pie Tapuchim		Transliteration from Hebrew to English		☐	☐	☐	☐
苹果派		Translation from Japanese to Chinese		☐	☐	☐	☐
Apple Pies	アップルパイ	Translation from Japanese to English	☐	☐	☐	☐	☐
appurupai		Transliteration from Japanese to English		☐	☐	☐	☐
苹果派		Translation from Korean to Chinese		☐	☐	☐	☐
Apple Pies	사과 파이	Translation from Korean to English	☐	☐	☐	☐	☐
Sha-gwa Pai		Transliteration from Korean to English		☐	☐	☐	☐
苹果派		Translation from Russian to Chinese		☐	☐	☐	☐
Apple Pies	Яблочные пироги	Translation from Russian to English	☐	☐	☐	☐	☐
iablochnye pirogi		Transliteration from Russian to English		☐	☐	☐	☐
苹果派		Translation from Spanish to Chinese		☐	☐	☐	☐
Apple Pies	Tartas de Manzana	Translation from Spanish to English	☐	☐	☐	☐	☐
Тартас де мансана		Transliteration from Spanish to Russian		☐	☐	☐	☐

* *Please provide details of the other factors by typing here*:

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 (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] …………………………………………………………………….

2. 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:						

D. Variations of figurative marks

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?

   ☐ Yes, always

   ☐ Never

   ☐ Yes, but only in the following circumstances:

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

2. Would the Office consider that the international marks appearing below correspond to the following basic marks?[2]

International mark	Basic mark	Description of the difference	YES	NO	Depends on other factors*
		Addition of color	☐	☐	☐
		Addition of color	☐	☐	☐
		Modernization	☐	☐	☐
		Clearer image	☐	☐	☐
* *Please provide details of the other factors by typing here*:					
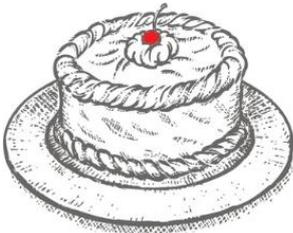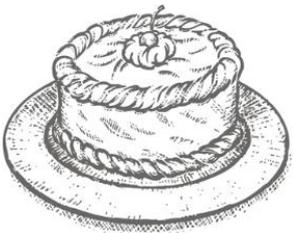
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2   Drawing of girl with balloon courtesy of iStock.com/TheresaTibbetts; drawing of cake courtesy of iStock.com/animatedfunk; drawing of Elizabeth Tower (Big Ben) courtesy of iStock.com/Tatiana_Ti; and, engraving of Elizabeth Tower courtesy of iStock.com/Man_Half-tube.

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

Would the Office consider that the international marks appearing below correspond to the following basic marks?[3]

International mark	Basic mark	Difference between international and basic mark	YES	NO	Depends on other factors*
		From two single views to a combined view	☐	☐	☐
		From one single view to a combined view	☐	☐	☐
		From a combined view to one single view	☐	☐	☐
The mark consists of a beamed eighth note	A sound recording of a sound mark (e.g. MP3 or WAV)	From a sound recording to a pentagram	☐	☐	☐
		From a sound recording to a description of the sound	☐	☐	☐
		From a sonogram to a pentagram	☐	☐	☐
* Please provide details of the other factors by typing here:					
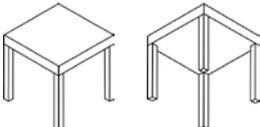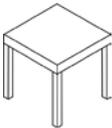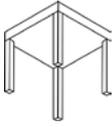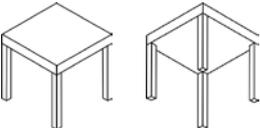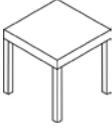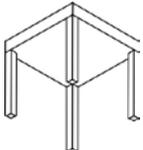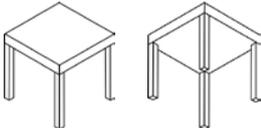
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[3]   Drawings of tables courtesy of Mr. Hideo Yoshida; drawing of musical notes courtesy of iStock.com/johavel; and, drawing of sound waves courtesy of iStock.com/lasagnaforone.

F. Series of marks (where applicable)

Would the Office consider that the international marks appearing below correspond to the following basic marks?[4]

International mark	Basic mark	Element of Series Mark	YES	NO	Depends on other factors*
Apple Pies	Apple Pies APPLE PIES Apple Pies	One mark selected from a series of marks	☐	☐	☐
Apple Pies	*Apple Pies.gov* APPLEPIES.GOV applepies.int	Verbal elements extracted from a series of marks	☐	☐	☐
* Please provide details of the other factors by typing here:					

[End of questionnaire]

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[4]   Pie picture courtesy of iStock.com/plastic_buddha.