

Certification of the Identity between International registered marks and their Basic marks

Results of JPO's Study from the Perspective of Promoting
Wider Use of the International Registration System
under the Madrid Protocol

June 2016
Japan Patent Office

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1. Outline of the JPO's Study

(1) Current Status of Operations at the JPO in certifying the identity of marks

The JPO sets the standards for its operating procedures in certifying the identity of marks, in its Trademark Examination Manual.

Standard operating procedures for certifying the international application marks are identical to their basic marks

- Judgments should be made strictly, based on the principle that the compositions of these marks should be identical (including similar figures).
- In Japan, trademarks cannot be recognized to be identical even if they have the following differences, which are generally within the scope of similarity: differences in ways of writing (fonts, letters (capital letters and small letters), display direction, which are generally accepted from common sense to be identical; and differences within the scope in which amendments are acceptable as those that do not change the fundamentals.

Example 1  **KOBE** ↔   **KOBE**

Example 2 **STRAWBERRY** ↔  **STRAWBERRY**

Users often claim that the standards at the JPO in certifying the identity of trademarks are very strict.

1. Outline of the JPO's Study

(2) Purposes for and ways of conducting the Study

The JPO conducted the Study to better understand the actual states of identification and operating practices to promote wider use of the Madrid System and to consider possible improvements in the System. The study included:

(1) Studies on the actual state and operating practices for certifying the identity between international application marks and their basic marks; and

(2) Studies on the actual state and operating practices of trademark examinations on goods and services

■ **Document searches**

Number of international trademark registrations on which the studies were conducted:
around 71,000 (Trademarks that were internationally registered in 55 countries/regions in 2013 and 2014)
Comparative study on the compositions of basic trademarks and international registrations

■ **Questionnaire survey of IP offices (offices of origin (OOs))**

Countries in which the survey was conducted:
Member countries of the Madrid System (50 countries/regions)

■ **Questionnaire survey of users**

Targeted users: Top 70 companies in the world using the Madrid System

■ **Interviews of users**

Users that were interviewed: 10 Japanese companies

2. Results of the Study

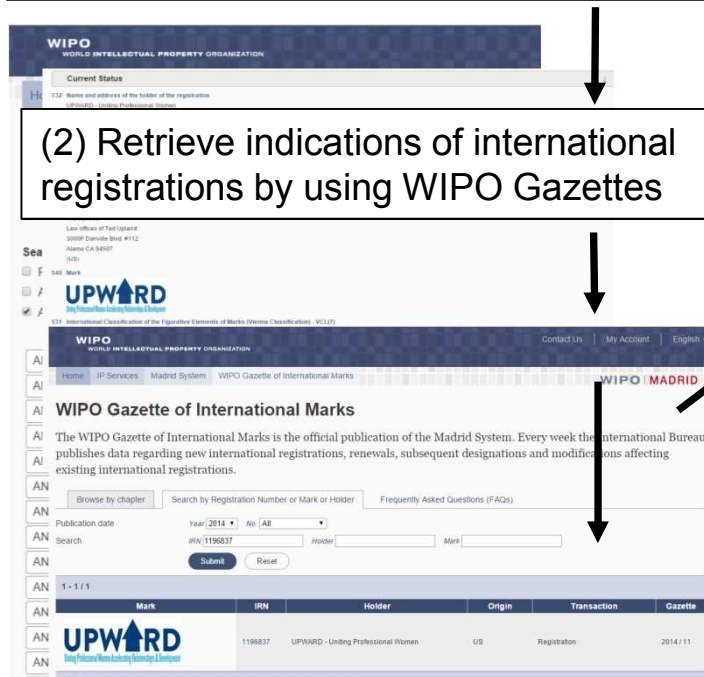
(1) Document searches

Procedures for conducting document searches


(1) Conduct searches by using ROMARIN for trademarks that were internationally registered in 2013 and 2014.

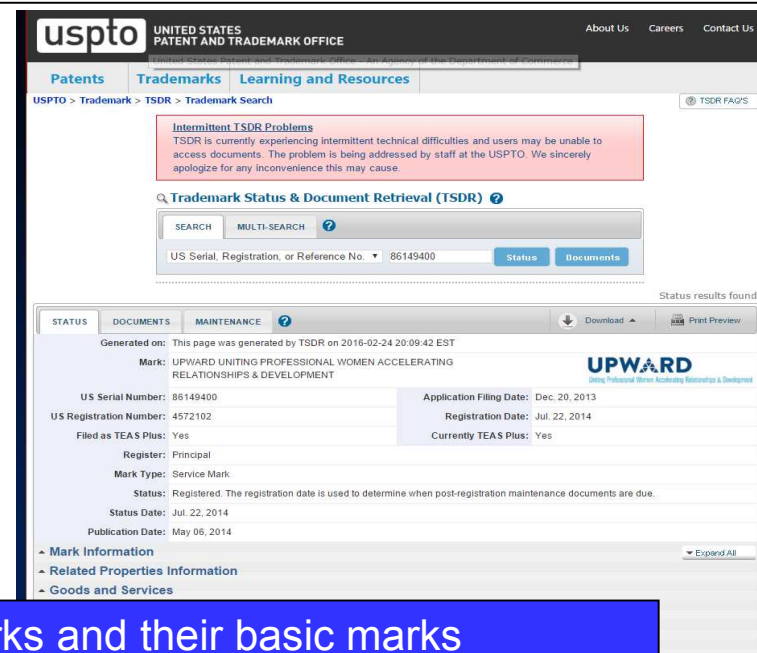
(3) After confirming application numbers or registration numbers of basic marks, conduct searches for the basic marks by using the database at offices in countries/regions

(2) Retrieve indications of international registrations by using WIPO Gazettes



The screenshot shows the WIPO Gazette of International Marks search interface. A search for 'UPWARD' has been performed, resulting in a table with the following data:

Mark	IRN	Holder	Origin	Transaction	Gazette
	1196837	UPWARD - United Professional Women	US	Registration	2014/11



The screenshot shows the USPTO Trademark Search results for the 'UPWARD' mark. The search results include the following information:

- Mark: UPWARD UNITING PROFESSIONAL WOMEN ACCELERATING RELATIONSHIPS & DEVELOPMENT
- US Serial Number: 86149400
- Application Filing Date: Dec. 20, 2013
- US Registration Number: 4572102
- Registration Date: Jul. 22, 2014
- Filed as TEAS Plus: Yes
- Currently TEAS Plus: Yes
- Register: Principal
- Mark Type: Service Mark
- Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
- Status Date: Jul. 22, 2014
- Publication Date: May 06, 2014

(4) Compare international registered marks and their basic marks

International registered marks

Basic marks



2. Results of the Study

(1) Document searches

Case in which offices of origin (OOs), i.e. offices in countries/regions where basic marks are registered, determined to be identical for marks with the declaration of standard characters

A. Trademarks that differ in fonts	
International registration	Basic registration
MONACO	MONACO



B. Trademarks that differ in capital letters and small letters	
International registration	Basic registration
KJK JEWELRY	KJK Jewelry
International registration	Basic registration
MY LOOK	my look

2. Results of the Study

(1) Document searches

Case in which offices of origin (OOs) determined to be identical for trademarks with the declaration of standard characters (contin'd)

C. Case in which international registrations consist of letter elements that are extracted from their basic registration

International registration	Basic registration
Allied WorldWide	
International registration	Basic registration
VISCEROLOGIE	

D. Case in which a basic registration consist of letters in both the national language and English and its international registration consists solely of the extracted part from either of the languages.

International registration	Basic application
ZIMBER	ZIMBER זימבר

2. Results of the Study

(1) Document searches

Case in which offices of origin (OOs) determined to be identical for trademarks without the declaration of standard characters






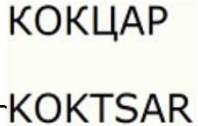
A. Cases in which marks differ in terms of the arrangement of their constituent elements

International registration	Basic application
	
International registration	Basic registration
	
International registration	Basic registration
	

2. Results of the Study

(1) Document searches

Case in which offices of origin (OOs) determined to be identical for trademarks without the declaration of standard characters (contin'd)

B. Case in which the constituent elements of marks are differently arranged, and a black and white color setting of their constituent elements is inverted	
International registration	Basic application
	
C. Case in which the arrangement of the constituent elements of trademarks is same, but the marks differ in fonts.	
International registration	Basic application
	
D. Case in which a basic registration consists of letters in both the national language and English, and its international registration consists solely of the extracted part from either of the languages.	
International registration	Basic registration
	

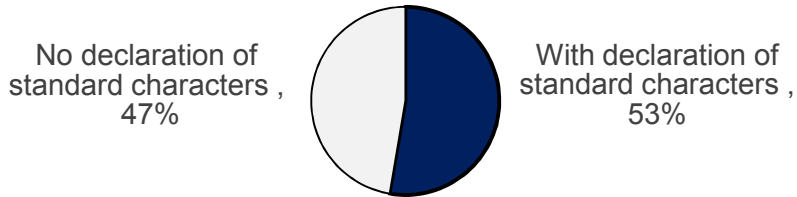
2. Results of the Study

(1) Document searches

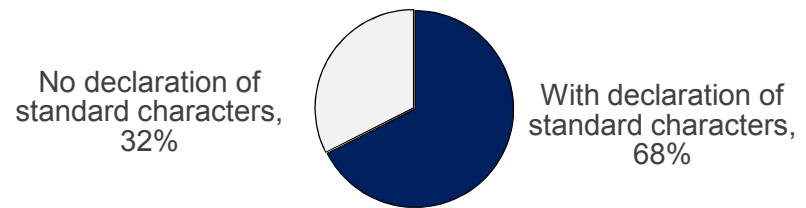
Major Differences and Overall Trends

- More than half of them were trademarks with the declaration of **standard characters**. When trademarks had such declaration, the JPO found some flexibility in determining the identity the marks.
- The JPO divided the search results by types of major differences. **“fonts,” “colors (including graduations of color),” and “constituent elements”** of marks
- The JPO subdivided the **“differences in the constituent elements”** of marks into those of **“capital letters/small letters,” “number of lines,” “signs for characters,” and “changes of compositions.”**

Types of trademarks for which searches were conducted

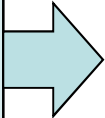


Number and % of trademarks that were not determined to be identical



Types of Differences

Differences	Details of differences
Fonts	Differ in fonts
Constituent elements	Differ in constituent elements and/or patterns of trademarks
Colors (including graduations of colors)	Differ in colors of pictures and characters, including graduations of colors



Types of subdivided “Constituent elements”
Number of lines
Capital letters/small letters
Signs for characters
Differences in spelling ; for example, color and colour
Changes in compositions (Additions/deletions) Some parts of the designs are changed due to additions/deletions of the compositions or the arrangement of constituent elements are changed
Vertical writing/horizontal writing

2. Results of the Study

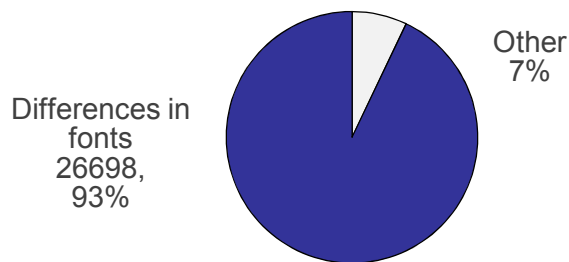
(1) Document searches

Differences in fonts and capital letters/small letters

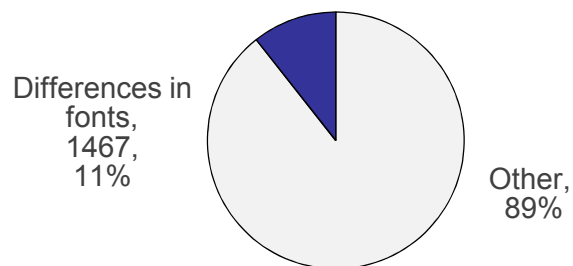
- When trademarks are those with the declaration of standard characters, most of them were determined to be identical, even though they differed in **fonts**. Also, in such cases, some differences were determined between **capital letters and small letters** of the marks.
- Even in case trademarks are those without the declaration of standard characters, some marks were determined to be identical, even though their **fonts** were different. Also, as differences **in the compositions of trademarks**, we found many differences in their arrangement. Other differences include colors, including gradation of colors.

With declaration of standard characters

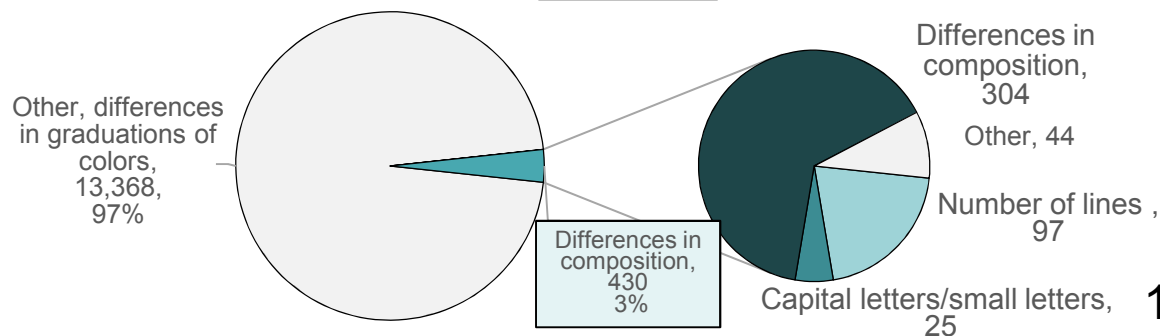
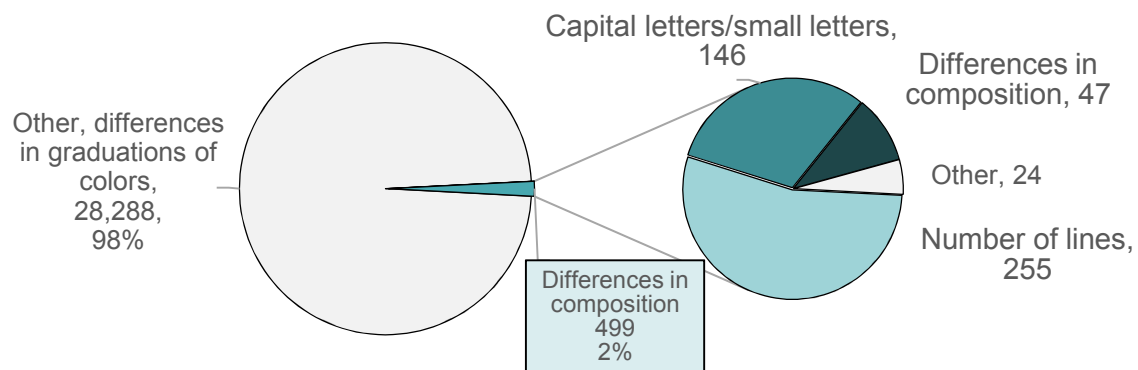
Percentage of differences in fonts



No declaration of standard characters



Differences in composition and their details (Differences are indicated by multiple choice options)

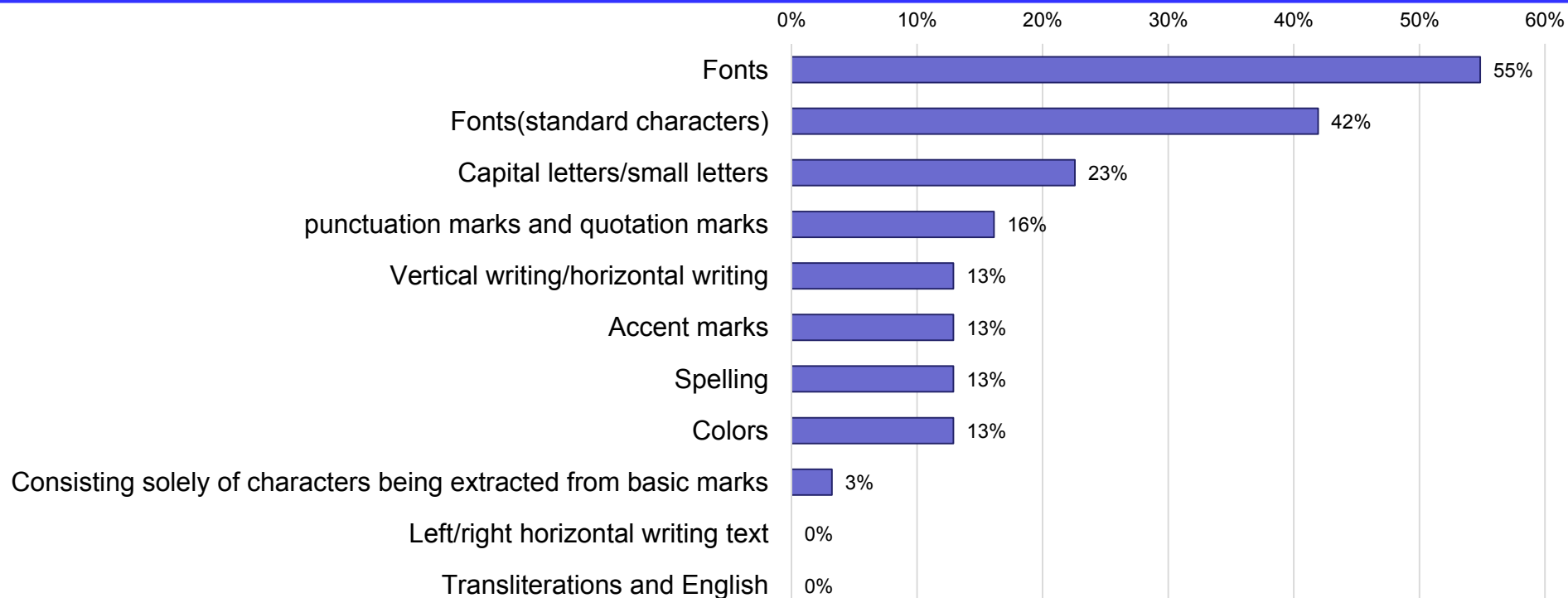


2. Results of the Study

(2) Questionnaire survey of IP offices

- When the **fonts** of trademarks were different, more than half of the IP offices had some flexibilities in certifying the identity. In particular, when trademarks were those with the declaration of standard characters, most of the offices responded that they would determine trademarks to be identical regardless of the difference in fonts.
- When trademarks were different in terms of **capital letters and small letters**, more than 20% of the offices responded that they would determine such trademarks to be identical.
- On the other hand, almost all offices responded that they would not determine the following to be identical: international registrations consisting **solely of some extracted parts** from their basic marks containing several constituent elements.

Results of responses(31): IP offices responded that they would determine the following to be identical, even if in the international applications the trademarks vary in terms of the following points



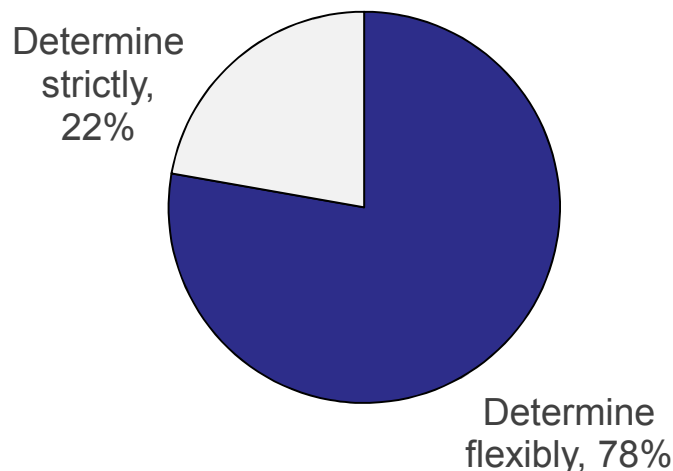
2. Results of the Study

(3) Questionnaire survey of companies in and outside Japan and interviews of Japanese companies

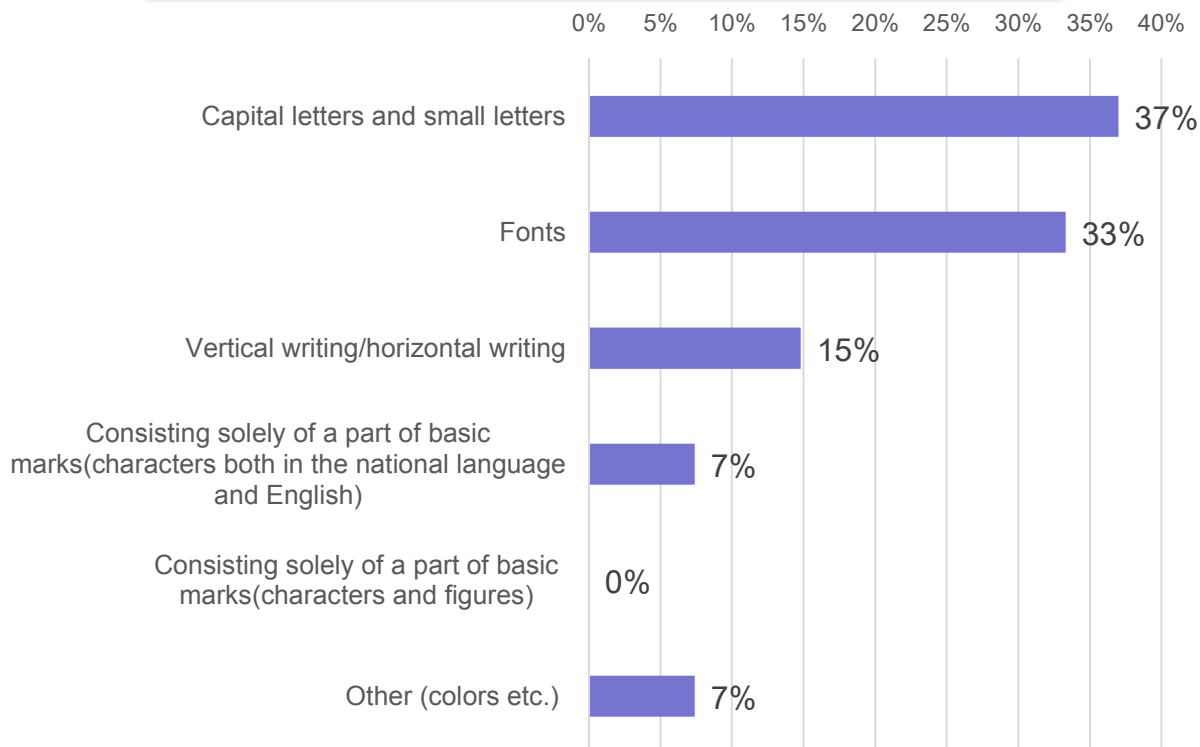
- The JPO sent a questionnaire to the top 70 companies in and outside Japan, which use the Madrid System, and received responses from 18 companies.
- Among the respondents, the JPO conducted interviews with seven companies in addition to the survey.

Example of the responses to the questionnaire survey

Do you want IP offices to have some flexibilities in certifying identity?



In what points do you want flexible determination?

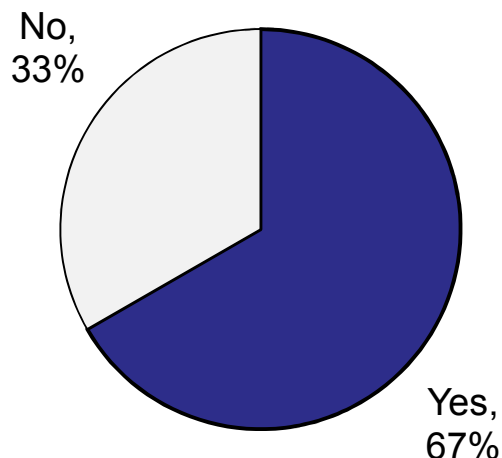


2. Results of the Study

(3) Questionnaire survey of companies in and outside Japan and interviews of Japanese companies

Examples of responses

Have you ever filed trademark applications just to serve as basic marks for international filings?



Examples of responses to the JPO's interviews with Japanese companies

- Since company logos often change, we wish to file international trademark applications for the names of products as trademarks **in standard characters**. We also wish that determination would be eased in terms of any differences in fonts.
- When international application marks and their basic marks are different in terms of **fonts** and **capital letters/small letters**, some foreign IP offices allow them to be identical for determining priority rights. Based on this, we consider that they should be substantially identical.
- We would be pleased if international application marks would be determined to be identical with their basic marks when they consist of **an extracted part** of their basic marks that are written in both the national language and English in double column format. Nonetheless, we believe that some rules would be necessary to determine the extent of such extracted parts.
- When easing the standard for the identity, it is essential for IP offices to clarify standards and operating procedures on which they judge requirements for identity.

2. Results of the Study

(4) Summary of the Study Results and Reviews

- In some member countries, the scope of the “identity” between basic marks and international application marks is determined flexibly to some extent. For example, in many member countries, the trademarks were determined to be identical even if their **fonts** (in case of indistinguishable fonts) and **capital letters/small letters** were different.
- In **the survey with IP offices**, in particular, when applicants declare that they wish their trademarks to be considered as trademarks **in standard characters**, most of the respondents replied that they would determine such marks to be identical, even though these marks differed in **fonts**.
- Also, even if there are differences in **capital letters/small letters** in marks, some IP offices responded that they would determine such marks to be identical.
- Based on **the questionnaire survey** and interviews with users, many users wanted IP offices to certify the identity **flexibly** between the marks, even if the **fonts** and **capital letters/small letters** are different.
- When IP offices ease standards in certifying identity, some users expressed their concerns that the unified judgement standards for operational practices at IP offices might be unclear. Therefore, it is essential **to clarify and specify the scope** under which IP offices recognize marks as being identical.



Possible solutions to promote wider use of the Madrid System from the perspective of certifying the identity of marks

- **Short-term initiative**: Consider more flexible operating procedures in certifying identity and present their specific details
- **Long-term initiative**: Clarify the standards used to determine “identity” among the member IP offices and share the specific details with users.

3. Recommendations

The JPO would like to recommend that specific details be stated about certification of identity the marks, in **the Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol**, for cases in which applicants declare that they wish their trademarks described in international applications to be considered as trademarks in standard characters.

Proposed draft of revision to the “Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol”

PART B: PROCEDURE

CHAPTER II: THE INTERNATIONAL PROCEDURE

Presentation of the International Application/The Application Form

Item 13: Certification and Signature by Office of Origin

07.77 (omitted)

07.78 The declaration of the Office of origin in item 13 of the application form must certify:

(a) (omitted)

(b) that the mark indicated in item 7 is identical to the mark in the basic registration or application mentioned in item 5; where the Office of origin allows a mark to be altered (whether during the application stage or after registration), the declaration may be made provided that the mark that is the subject of the international application is identical to the mark in the basic registration or application at the time when the Office certifies the international application;

However, when the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, the declaration may be made, even though the mark that is the subject of the international application is different from the mark in the basic registration or application in terms of fonts and/or capital letters/small letters.

Long term initiative

An agreed understanding of the meanings of the terms “correspond”, “same” and “identical” in the Madrid Protocol, the Common Regulations, and the Guide and share the judgment standards for or ways of thinking about certifying the identity between international application marks and their basic marks

(Reference) Current descriptions in the Madrid Protocol, the Common Regulations, and the Guide

Madrid Protocol

Article 3 International Application

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

Common Regulations

Rule 9 Requirements Concerning the International Application

(5)[Additional Contents of an International Application]
(d) The international application shall contain a declaration by the Office of origin certifying
(iv) that the mark that is the subject matter of the international application is **the same** as in the basic application or the basic registration, as the case may be,

Guide to the International Registration of Marks

PART B CHAPTER II: THE INTERNATIONAL PROCEDURE

07.78 The declaration of the Office of origin in item 13 of the application form must certify:

(a) (omitted), (b) that the mark indicated in item 7 is **identical to the mark in the basic registration or application mentioned in item 5;** where the Office of origin allows a mark to be altered (whether during the application stage or after registration), the declaration may be made provided that the mark that is the subject of the international application is identical to the mark in the basic registration or application at the time when the Office certifies the international application;

THANK YOU!
ありがとうございました