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Correspondence of Marks for Certification Purposes

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Background for questionnaire

- Trademark owners may wish to reach customers across several regions using different scripts

- Could there be some flexibility for the Offices of origin when they certify international applications?

- From previous discussions in the Roundtable, we know that some Offices require absolute identity between the basic and the international mark, while other Offices appear more flexible in their approach

- Are provisions in the legal framework harmonized?
    - Article 3(1) of the Protocol states "correspondence between the particulars" while Rule 9(5)(d)(iv) requires that the mark in the international application is "the same" as in the basic application or registration…

The questionnaire

- The purpose of the questionnaire:
  - to gather more information on the certification practices by Offices to see if there could be basis to introduce guidelines or a "best practices" approach

- 59 Offices provided detailed answers
  - 62 Offices replied, but 3 of these use online forms, so there would always be full identity

General information on the questionnaire

- Applications in Latin characters vs other scripts:
  - 44 Offices receive mostly in Latin characters
  - 14 Offices receive in Latin characters and other scripts
  - 4 Offices receive mostly in other scripts

- Declaration of mark standard character vs word mark
  - 46 Offices consider these to be the same
  - 7 Offices would consider these to be the same in certain circumstances
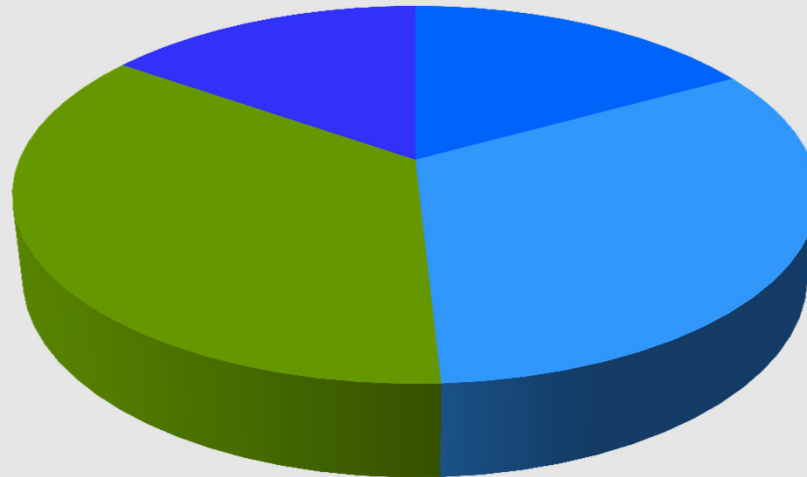 - 6 Offices do not consider these to be the same

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Summary of Replies

A.1: Basic mark comprising the same word(s), letter(s) or number(s) but in a **different font**?"

YES: 38 Offices

Never: 21 Offices

Yes, always the case (10)	Yes, with standard character declaration (19)	Never (21)	Yes, under certain circumstances (9)*

Examples of different fonts

Apple Pies (Bold)* to Apple Pies			
Yes (25)	Yes, with standard character declaration (12)	No (21)	Depends (4)

Apple Pies (Italic)* to Apple Pies			
Yes (18)	Yes, with standard character declaration (9)	No (30)	Depends (4)

Apple Pies **(Bradly Hand)** to Apple Pies			
Yes (10)	Yes, with standard character declaration (3)	No (45)	Depends (1)

Apple Pies **(Old English)** to Apple Pies			
Yes (9)	Yes, with standard character declaration (2)	No (47)	Depends (1)

A large number of Offices (41) indicated flexibility where the difference was bold text
A large number of Offices (47) indicated a strict approach where the difference was between a standard text and highly stylized text.

*Two Offices checked two boxes.

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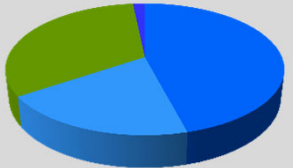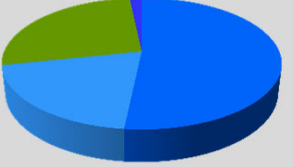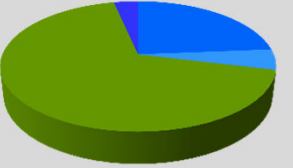
A.3 (a) Basic mark comprising the same word(s), letter(s) or number(s) in the same font but (a) in a different size

Yes: 54 Offices

Never: 6 Offices

Yes, always the case **(28)**	Yes, with standard character declaration **(16)**	Never **(6)**	Yes, under certain circumstances **(10)***
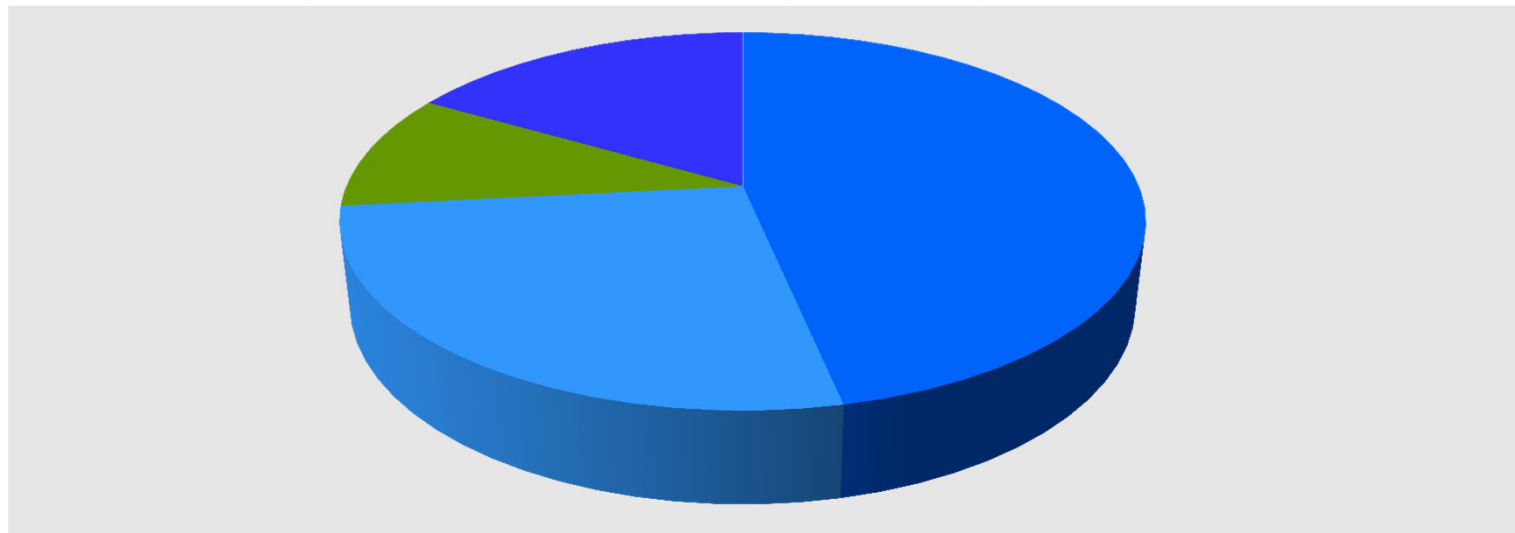
A.3 (b) Basic mark comprising the same word(s), letter(s) or number(s) in the same font but **with different character spacing or scaling**

Yes: 42 Offices

Never: 17 Offices

Yes, always the case **(14)**	Yes, with standard character declaration **(19)**	Never **(17)**	Yes, under certain circumstances **(9)***
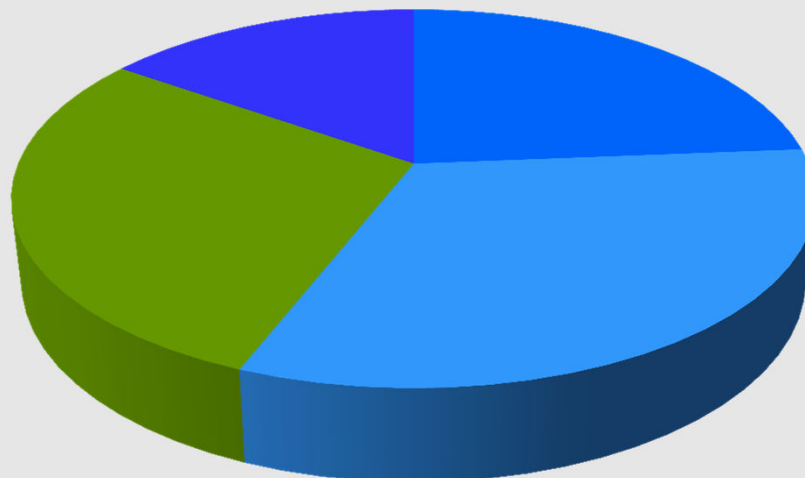
Examples: Size, spacing and scaling

International Mark: Apple Pies

A p p l e P i e s (expanded by 2 points)*			
Yes (28)	Yes, with standard character declaration (12)	No (20)	Depends (1)

Apple Pies (reduced by 80%)*			
Yes (31)	Yes, with standard character declaration (12)	No (16)	Depends (2)

ApplePies (conjoined)			
Yes (14)	Yes, with standard character declaration (3)	No (40)	Depends (2)

A large number of Offices (40) indicated no flexibility when different spacing resulted in a combined word

Two Offices checked 2 boxes

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A.5: Basic mark comprising the same word(s), letter(s) or number(s) but with **accented letters, capitalization or punctuation**
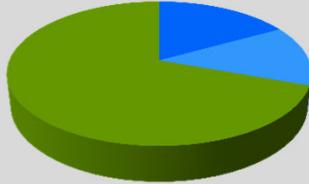
Yes: 22 Offices
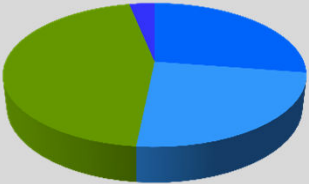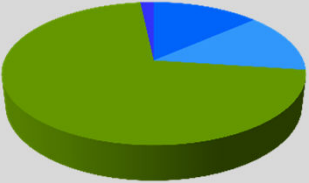
Never: 37 Offices

Yes, always the case (8)	Yes, with standard character declaration (3)	Never (37)	Yes, under certain circumstances (11)*

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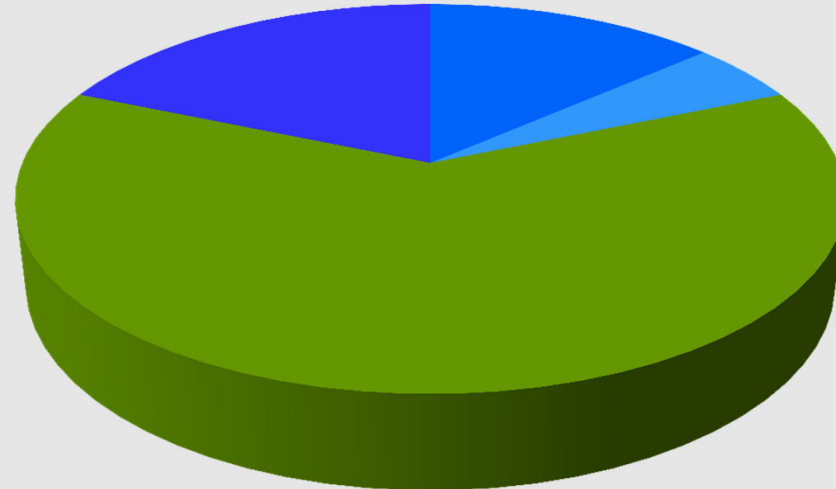
Examples: Capitalization

International Mark: Apple Pies
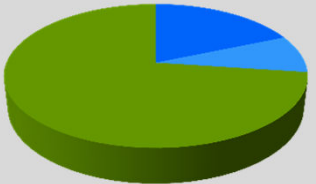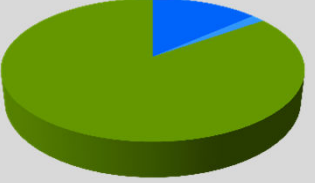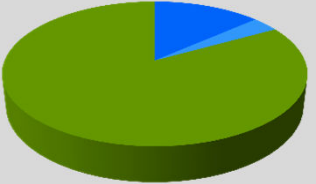
APPLE PIES (all uppercase)*			
Yes (17)	Yes, with standard character declaration (15)	No (28)	Depends (2)

APPle pies (random capitalization)			
Yes (8)	Yes, with standard character declaration (8)	No (42)	Depends (1)

Apple PIES (partial capitalization)			
Yes (10)	Yes, with standard character declaration (8)	No (41)	Depends

Some Offices (34) indicated some flexibility where the basic mark is in all uppercase and the international mark is not

* Three Offices ticked two boxes

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Examples: Accents and punctuation

International Mark: Apple Pies

"Apple Pies" (quotation)			
Yes (11)	Yes, with standard character declaration (5)	No (43)	Depends

Âpplé Pïes (accents)			
Yes (8)	Yes, with standard character declaration (1)	No (50)	Depends

Apple-Pies (hyphen)			
Yes (8)	Yes, with standard character declaration (2)	No (49)	Depends

Offices indicated a very strict approach when the basic mark contained accents or a hyphen and the international mark did not

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A.7: Basic mark comprising the same word(s), letter(s) or number(s) **but with different positioning or direction**

Yes: 9 Offices

Never: 50 Offices

Yes, always the case (5)	Yes, with standard character declaration (2)	Never (50)	Yes, under certain circumstances* (2)
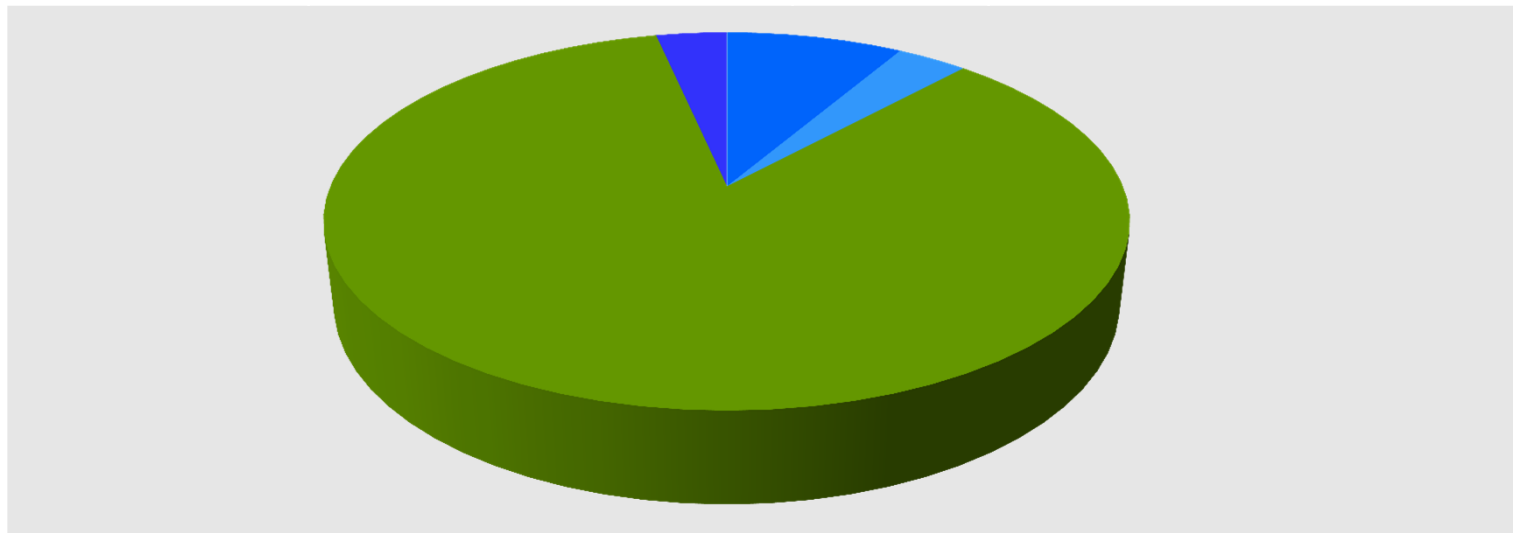
Examples: Positioning, direction (1)

International Mark: Apple Pies

Apple Pies			
Yes **(9)**	Yes, with standard character declaration **(2)**	No **(48)**	Depends

Apple Pies			
Yes **(8)**	Yes, with standard character declaration **(1)**	No **(50)**	Depends

Strict approach taken by most Offices

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Examples: Positioning, direction (2)

International Mark: Apple Pies

Apple Pies				
Yes (8)	Yes, with standard character declaration (2)	No (49)	Depends	

Apple Pies				
Yes (9)	Yes, with standard character declaration (3)	No (47)	Depends	

Apple Pies				
Yes (13)	Yes, with standard character declaration (5)	No (41)	Depends	

Strict approach taken by most Offices

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A.9: Basic mark comprising the same word(s), letter(s) or number(s) but with additional descriptive elements

Yes: 12 Offices

Never: 45 Offices

Yes, always the case (6)	Yes, with standard character declaration (0)	Never (45)	Yes, under certain circumstances** (6)
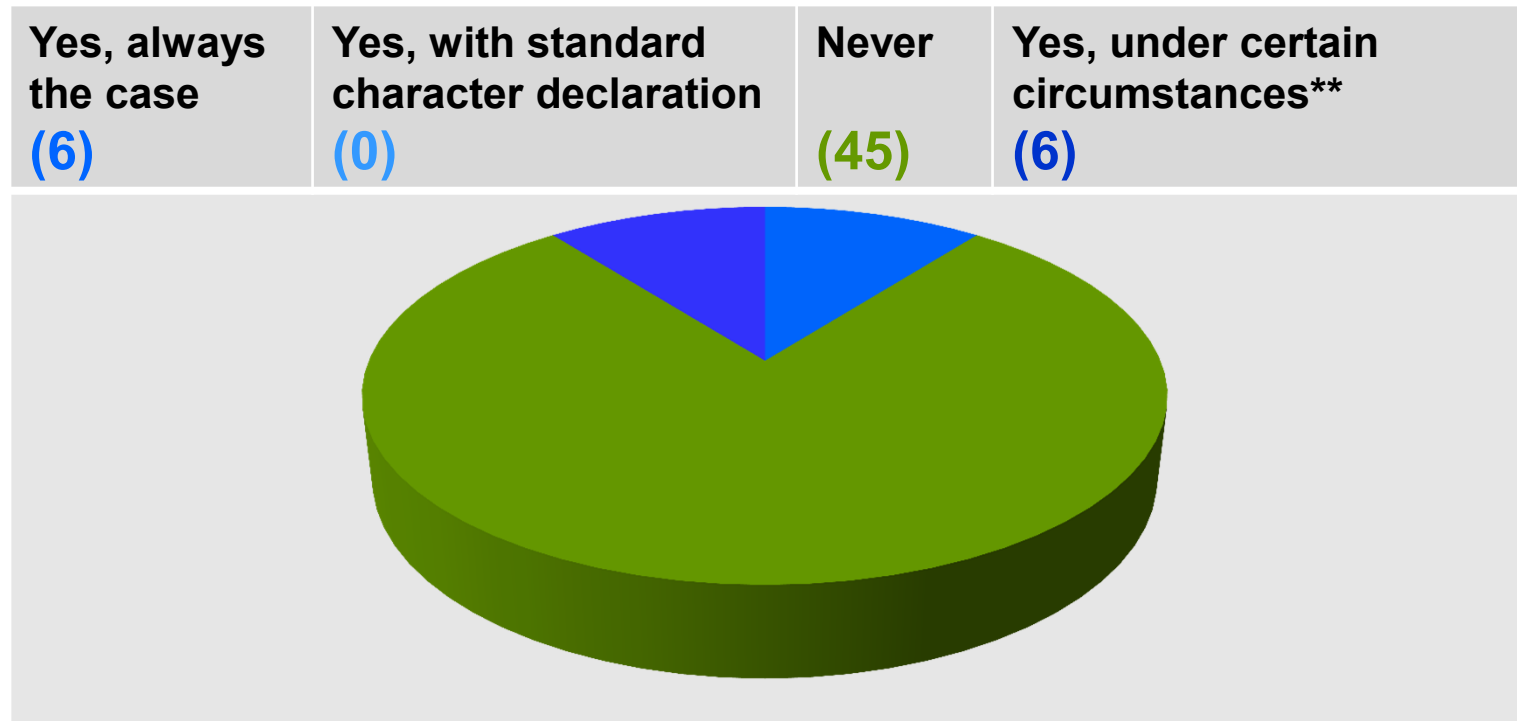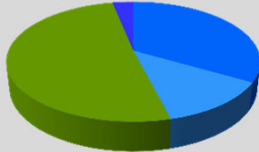
Two Offices did not respond to this question

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Examples: Descriptive elements (1)

International Mark: Apple Pies
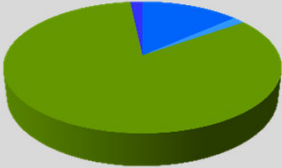
Apple Pies®* (**Registered Trademark Symbol**)				
Yes **(21)**	Yes, with standard character declaration **(8)**	No **(32)**	Depends **(2)***	

Apple Pies.com				
Yes **(9)**	Yes, with standard character declaration **(1)**	No **(49)**	Depends	

Apple Pies ltd				
Yes **(9)**	Yes, with standard character declaration **(1)**	No **(49)**	Depends	

A large number of Offices indicated flexibility when the basic mark contains a ® symbol but the international mark does not.

Four Offices checked more than one box

Examples: Descriptive elements (2)

International Mark: Apple Pies

Joint Stock Company **Apple Pies**				
Yes **(8)**	Yes, with standard character declaration **(1)**	No **(49)**	Depends **(1)**	

Apple Pies (with image)				
Yes **(5)**	Yes, with standard character declaration **(2)**	No **(50)**	Depends **(2)**	

Most Offices take a strict approach when the basic mark contains an figurative descriptive element and the international registration does not

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B.1: Basic mark comprising the same word(s), letter(s) or number(s) **but <u>in a different language, or script</u>***

Yes: 8 Offices

Never: 50 Offices

Yes, always the case **(5)**	Yes, with standard character declaration **(1)**	Never **(50)**	Yes, under certain circumstances **(2)**

*One Office did not reply

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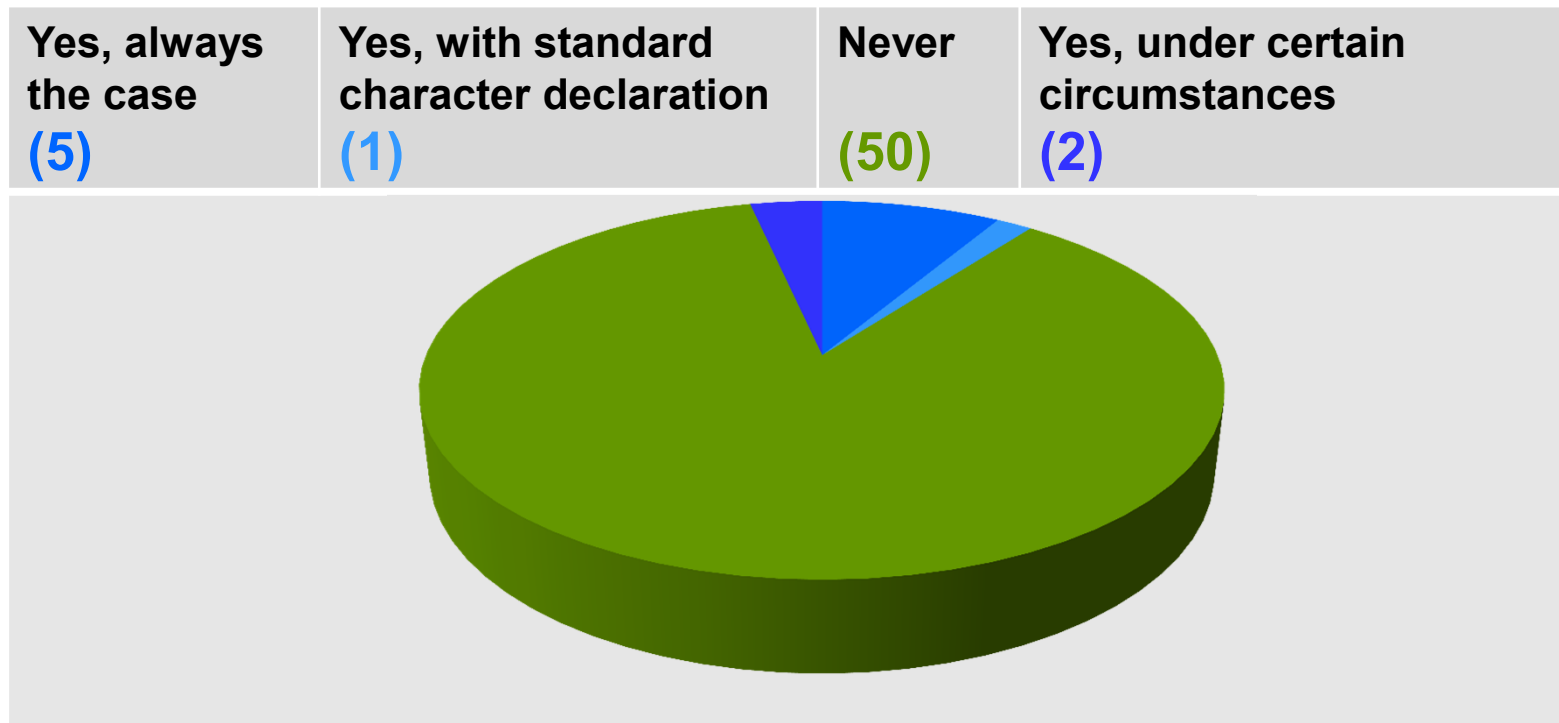
Examples: Different language/scripts*

苹果派 to Apple Pies (Chinese to English translation)

Yes (7)	Yes, with standard character declaration (1)	N/A (13)	No (37)	Depends (0)
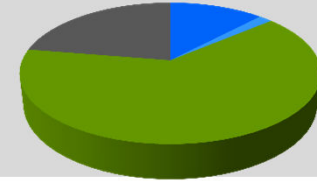
فطائر تفاح to Apple Pies (Arabic to English translation)

Yes (7)	Yes, with standard character declaration (0)	N/A (12)	No (37)	Depends (0)
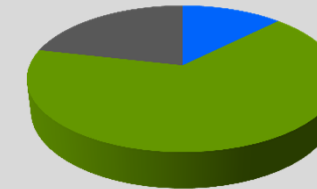
アップルパイ to 苹果派 (Japanese to Chinese translation)

Yes (3)	Yes, with standard character declaration (2)	N/A (14)	No (36)	Depends (0)
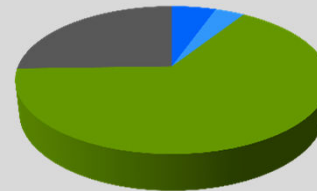
Яблочные пироги to Apple Pies (Russian to English translation)

Yes (6)	Yes, with standard character declaration (4)	N/A (11)	No (38)	Depends (0)
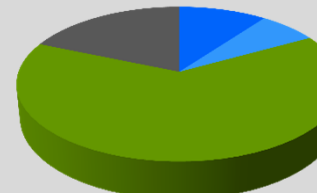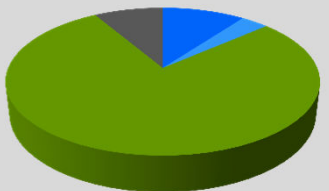
Many Offices omitted to check all relevant boxes, some Offices checked two boxes

More examples*

Apple Pies to 苹果派 (English to Chinese)

Yes (5)	Yes, with standard character declaration (1)	N/A (5)	No (46)	Depends (0)

Apple Pies to Эпл пайз (English to Russian transliteration)

Yes (5)	Yes, with standard character declaration (3)	N/A (5)	No (44)	Depends (0)

Apple Pies to Tartes aux Pommes (English to French translation)

Yes (6)	Yes, with standard character declaration (2)	N/A (5)	No (46)	Depends (0)

Apple Pies (Spanish to English translation)

Yes (7)	Yes, with standard character declaration (2)	N/A (7)	No (43)	Depends (0)

Many Offices omitted to check all relevant boxes, some Offices checked two boxes

C.1: International Mark is in color or grayscale. Basic mark comprises the same word(s), letter(s) or number(s) **but <u>in black and white</u>**
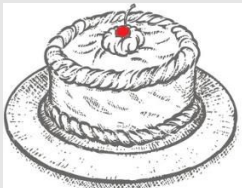
Yes: 20 Offices

Never: 39 Offices

Yes, always the case (13)	Yes, with standard character declaration (0)	Never (39)	Yes, under certain circumstances* (7)

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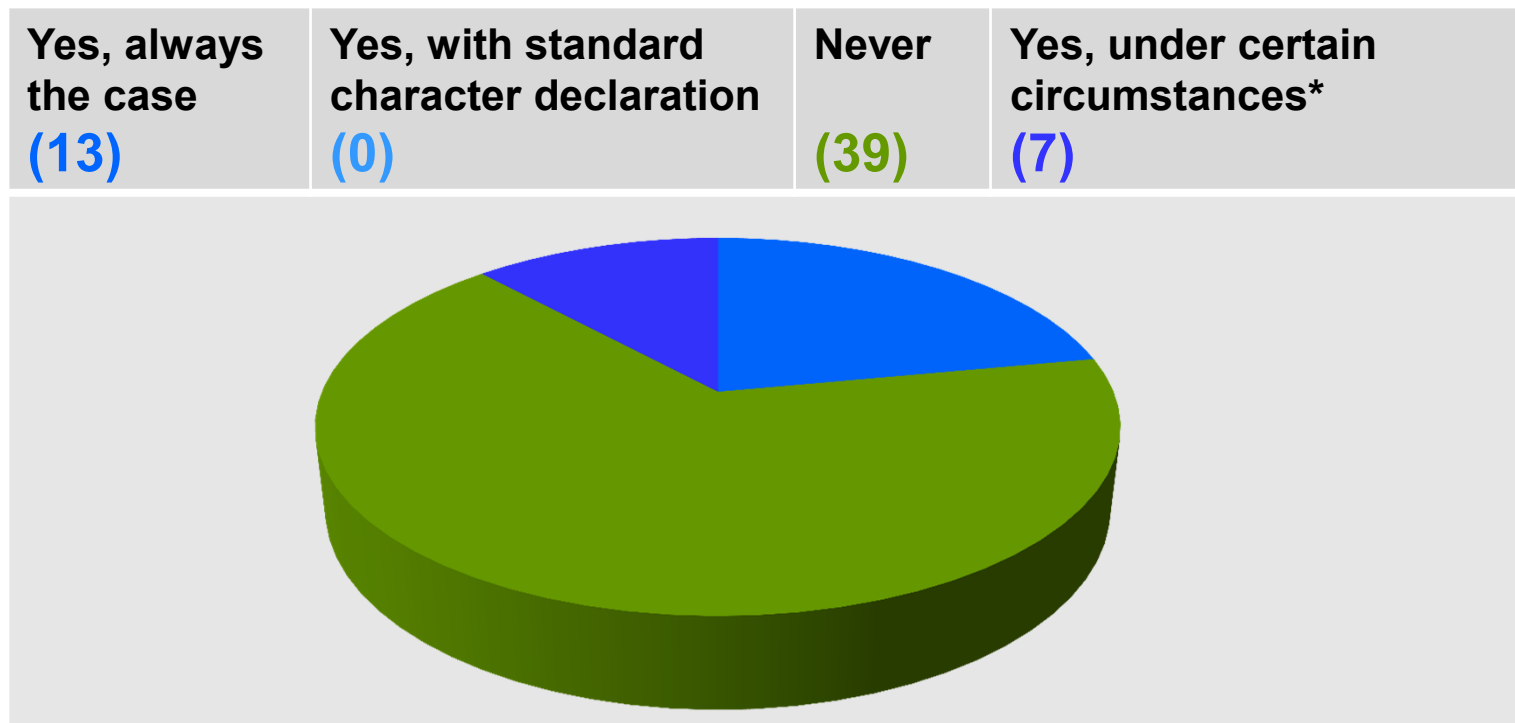
Examples: Color

Apple Pies to Apple Pies (Black to Blue)*			
Yes **(15)**	Yes, with standard character declaration **(1)**	No **(41)**	Depends **(1)**
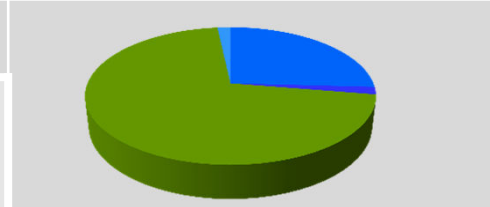
Apple Pies to Apple Pies (Black to Grayscale)			
Yes **(17)**	Yes, with standard character declaration **(2)**	No **(37)**	Depends **(2)**
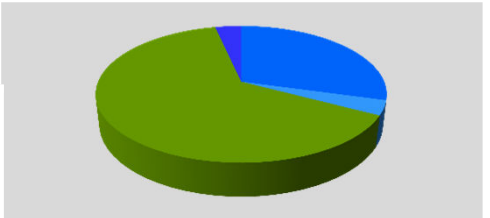
Apple Pies to Apple Pies (Red to Dark Red)*			
Yes **(12)**	Yes, with standard character declaration **(1)**	No **(42)**	Depends **(3)**
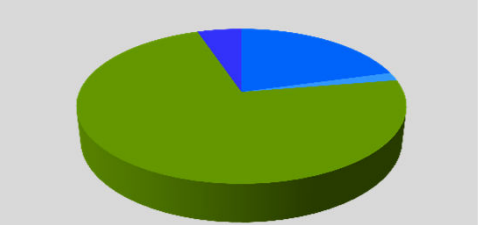
Apple Pies to Apple Pies (Red to Salmon)*			
Yes **(14)**	Yes, with standard character declaration **(1)**	No **(40)**	Depends **(3)**
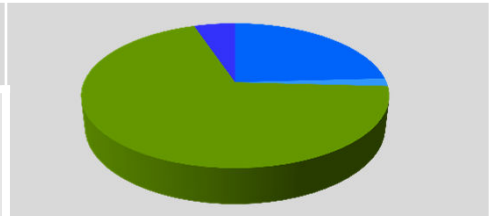
One Office did not reply

D. 1: Basic mark differs in respect of minor features

Yes: 27 Offices

Never: 31 Offices

Yes, always the case (9)	Yes, with standard character declaration (0)	Never (32)	Yes, under certain circumstances (18)*
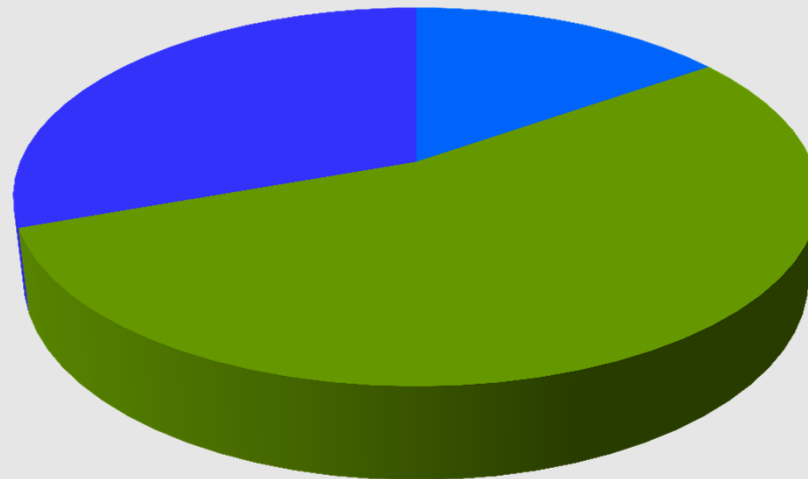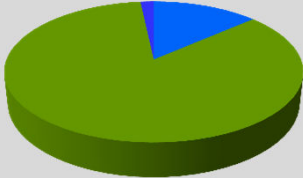
Examples: Figurative with addition of color

International Mark	Basic Mark	Yes	No	Depends	
		13	45	1	
		13	45	1	

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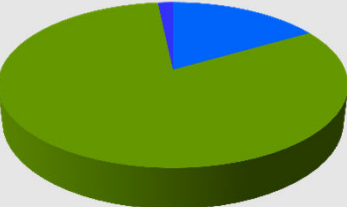The International
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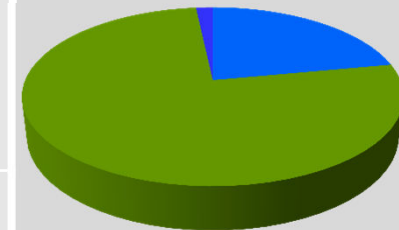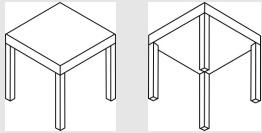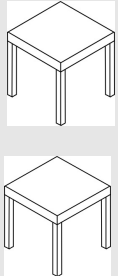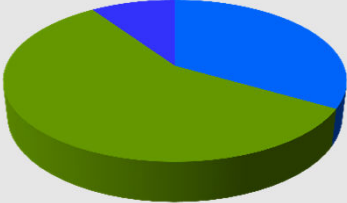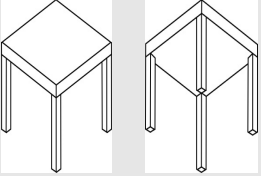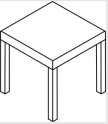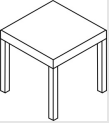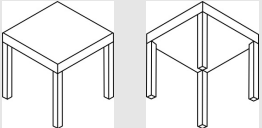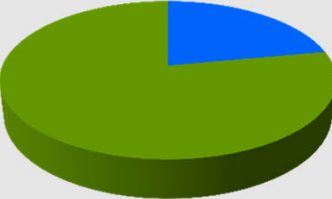
Examples: Figurative with modernization or ==clearer image==

International Mark	Basic Mark	Yes	No	Depends	
		8	50	1	
		38	14	9	

Offices showed some flexibility where the difference is a clearer image

Two Offices checked two boxes

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Examples: 3D Marks

International Mark	Basic Mark	Yes	No	Depends	
(combined view)*	(2 single views)	**21**	**36**	**6**	
(combined view)**	(single view)	**10**	**49**	**1**	
(single view)***	(combined view)	**13**	**46**		
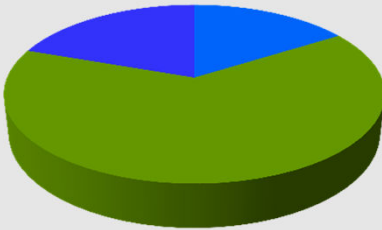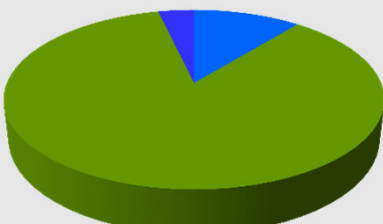
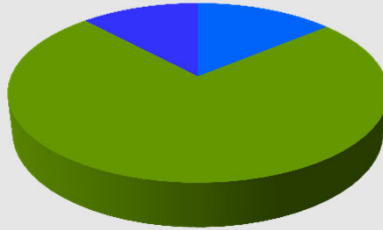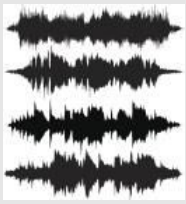*Four Offices checked two boxes, ** One Office checked two boxes, *** Two Offices checked two boxes
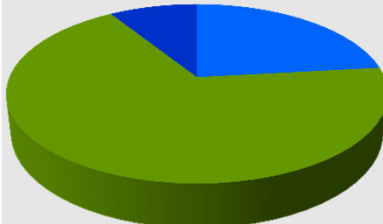
Examples: Sound Marks*

International Mark	Basic Mark	Yes	No	Depends	
(pentagram)	*Actual sound recording (e.g MP3 or WAV)*	**9**	**36**	**11**	
(description) *The mark consists of a beamed eighth note*	*Actual sound recording (e.g MP3 or WAV)*	**7**	**37**	**12**	
(pentagram)	(sonogram)	**6**	**43**	**6**	

A number of Offices did not reply

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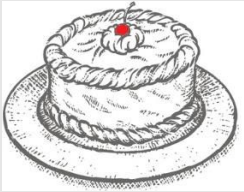
Examples: Series Marks

International Mark	Basic Mark	Yes	No	Depends	
Apple Pies *(One mark selected from a series of marks)*	Apple Pies APPLE PIES Apple Pies 🥧	13	38	5	
Apple Pies (Verbal elements extracted from a series of marks)	*Apple Pies.gov* APPLEPIES.GOV applepies.int	6	47	2	

Main findings: Flexible approach

FLEXIBILITY	Basic Mark	International Mark
Commonly used fonts		Apple Pies
Bold type face		**Apple Pies**
Same font but different size	Apple Pies	Apple Pies
Spacing		Apple Pies
Uppercase		APPLE PIES
®		Apple Pies ®
Clearer image		

Main findings: Less flexible approach

Strict Approach	Basic Mark	International Mark
Less commonly used fonts		𝕬𝖕𝖕𝖑𝖊 𝕻𝖎𝖊𝖘
Conjoined word		**ApplePies**
Random uppercase letters	Apple Pies	APPle pies
Accents or punctuation		Âpplé Pïes
Different positioning or direction		Apple Pies
Translations/transliterations		苹果派
Color		Apple Pies
Figurative		

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Some Offices consistently indicated that they would not certify the international registration under any of the circumstances presented in the questionnaire

Main findings: Less flexible … cont.

■ Offices would be less flexible to certify where

   ■ the international mark consists of one mark or verbal elements extracted from the basic mark, when the basic mark consists of a series of marks

   ■ the representation of the international mark is different than the representation of the basic mark, when the basic mark is three-dimensional mark or a sound mark*

Possible ways forward

- The practices of the Offices range from being moderately flexible to requiring identity with the basic mark

- Deeper analysis and further discussion may be necessary to reach general principles and possible guidelines "best practices" for those Offices that are interested