

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Seventeenth Session  
Geneva, July 22 to 26, 2019**

### **FINDINGS OF THE SURVEY ON ACCEPTABLE TYPES OF MARKS AND MEANS OF REPRESENTATION**

*Document prepared by the International Bureau*

1. At its sixteenth session, held in Geneva from July 2 to 6, 2018, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) discussed types of marks, other than those explicitly mentioned in 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” and “the Protocol”)<sup>1</sup>.
2. The Working Group requested the International Bureau to conduct a survey among Offices of the Contracting Parties of the Madrid System on acceptable types of marks and means of representation, and to present a document on the findings of that survey at its seventeenth session<sup>2</sup>.
3. On January 14, 2019, the International Bureau sent to the Offices of the Contracting Parties of the Madrid System Note C. M 1480, with a link to an online questionnaire, devised for the purposes of the afore-mentioned survey, on acceptable types of marks and means of representation and invited Offices to reply to the questionnaire by February 15, 2019.

<sup>1</sup> See document MM/LD/WG/16/5.

<sup>2</sup> See document MM/LD/WG/16/11, paragraph 17.

4. The International Bureau received 82 replies to the above-mentioned questionnaire, from Afghanistan (AF), African Intellectual Property Organization (OA), Albania (AL), Algeria (DZ), Antigua and Barbuda (AG), Armenia (AM), Australia (AU), Austria (AT), Bahrain (BH), Belarus (BY), Benelux Office for Intellectual Property (BX), Bhutan (BT), Bosnia and Herzegovina (BA), Botswana (BW), Bulgaria (BG), Cambodia (KH), China (CN), Colombia (CO), Croatia (HR), Cuba (CU), Curaçao (CW), Cyprus (CY), Czech Republic (CZ), Denmark (DK), Estonia (EE), European Union (EM), Finland (FI), France (FR), Gambia (GM), Georgia (GE), Germany (DE), Ghana (GH), Greece (GR), Hungary (HU), Iceland (IS), India (IN), Ireland (IE), Israel (IL), Italy (IT), Japan (JP), Kazakhstan (KZ), Kenya (KE), Lao People's Democratic Republic (LA), Latvia (LV), Lesotho (LS), Liberia (LR), Lithuania (LT), Madagascar (MG), Malawi (MW), Mexico (MX), Monaco (MC), Mongolia (MN), Morocco (MA), Mozambique (MZ), Namibia (NA), New Zealand (NZ), North Macedonia (MK), Philippines (PH), Poland (PL), Portugal (PT), Republic of Moldova (MD), Romania (RO), Russian Federation (RU), Samoa (WS), San Marino (SM), Sao Tome and Principe (ST), Serbia (RS), Singapore (SG), Slovakia (SK), Spain (ES), Sweden (SE), Switzerland (CH), Syrian Arab Republic (SY), Thailand (TH), Tunisia (TN), Turkey (TR), Ukraine (UA), United Kingdom (GB), United States of America (US), Uzbekistan (UZ), Viet Nam (VN) and Zimbabwe (ZW).

5. The questionnaire and all the replies received are available at: [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=50421](https://www.wipo.int/meetings/en/details.jsp?meeting_id=50421). A summary of the replies to the above-mentioned questionnaire is presented in an Annex to this document.

*6. The Working Group is invited to consider the present document and the findings presented in its Annex, and to provide guidance to the International Bureau on a possible way forward.*

[Annex follows]

## SUMMARY OF THE REPLIES TO THE QUESTIONNAIRE ON ACCEPTABLE TYPES OF MARKS AND MEANS OF REPRESENTATION

### I. DEFINITION OF TRADEMARK

1. ACCORDING TO THE APPLICABLE LEGISLATION OR TO THE PRACTICES OF THE OFFICE, MARKS ARE DEFINED AS:

a. **Visually perceptible signs?**

– **Yes** 35 (43%)

– **No** 47 (57%)

b. **Signs capable of being represented graphically?**

– **Yes** 47 (57%)

– **No** 35 (43%)

c. **Any sign capable of distinguishing goods and services from one undertaking from those of another?**

– **Yes** 72 (88%)

– **No** 10 (12%)

### II. SIGNS EXCLUDED FROM REGISTRATION

2. ARE ANY SIGNS EXCLUDED FROM REGISTRATION AS A MARK?

– **Yes** 59 (72%)

– **No** 23 (28%)

– **Comments:** Examples of signs excluded from registration indicated by the Offices include those lacking in distinctiveness, descriptive signs, or signs that are likely to mislead the public about the nature, quality or geographical origin of goods.

### III. ACCEPTABLE TYPES OF MARKS AND MEANS OF REPRESENTATION

3. IS THE APPLICANT REQUIRED TO SPECIFY IN THE APPLICATION THE TYPE OF MARK FOR WHICH REGISTRATION IS REQUESTED?

– **Yes** 64 (78%)

– **No** 18 (22%)

4. IS A DESCRIPTION OF THE MARK<sup>1</sup> (ONE OPTION ONLY)<sup>2</sup>

- a. **Mandatory?** 18 (22%)
- b. **Optional?** 62 (77%)
- c. **Not allowed?** 1 (1%)

5. WHEN AN INDICATION OF THE TYPE OF MARK IS NEITHER SPECIFIED NOR INCLUDED IN THE DESCRIPTION, WOULD THE OFFICE ACCEPT AND PROCESS THE APPLICATION?

- **Yes** 49 (60%)

If "Yes" to question 5,

- a. *Without an indication of the type of mark?* 10 (20%)
- b. *With an ex officio indication of the type of mark?* 20 (41%)
- c. *Other(s)?* 19 (39%)

- **No** 33 (40%)

- **Comments:** 19 Offices indicated that they provided the applicant an opportunity to specify the type of mark.

6. PLEASE, INDICATE BELOW THE TYPES OF MARKS ACCEPTED BY THE OFFICE AND, WHERE APPLICABLE, THE WAY IN WHICH THEY MUST BE REPRESENTED:

a. **Word marks**

- **Yes** 82 (100%)

If "Yes" to question 6.a.,

i. *Does the Office require the use of a standard character for the representation of word marks?*

- **Yes** 37 (45%)
- **No** 45 (55%)

ii. *Where applicable, does the Office require that words be translated into the language used by the Office?*

- **Yes** 50 (61%)
- **No** 32 (39%)

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<sup>1</sup> Eighty-one Offices replied to this question.

<sup>2</sup> Two Offices expressed reservations about the way in which this question was formulated and indicated that the answer depended on the type of mark. Accordingly, the Offices said that the option to select more than one answer should have been allowed.

iii. *Where applicable, does the Office require that words be transliterated following the phonetics of the language used by the Office?*

- Yes 56 (68%)
- No 26 (32%)

- **No** 0 (0%)

- **Comments:** All Offices indicated that they accept word marks. Thirteen Offices indicated that they accept marks in any font, 11 Offices indicated that they accept standard, usual or non-stylized fonts, such as, for example, Arial or Times New Roman. Eleven Offices indicated that they require specific fonts, in particular:

- seven Offices accept Times New Roman only;
- one Office accepts Arial, Calibri and Times New Roman only;
- one Office accepts Arial, Courier and Times New Roman only;
- one Office accepts Calibri only; and
- one Office accepts Courier only.

**b. Figurative marks (device marks)**

- **Yes** 81 (99%)

- **No** 1 (1%)

- **Comments:** Most Offices indicated that the mark must be graphically represented and clear (for example, with an image, drawing or picture). Some Offices indicated other requirements, such as, for example, requirements concerning the size and quality of the representation or that the applicant provide a clear indication of color, where applicable. Acceptable formats indicated include JPEG, GIF and PNG.

**c. Hologram marks**

- **Yes** 50 (61%)

- **No** 32 (39%)

- **Comments:** Most Offices indicated that they require several images (drawings or pictures) of the mark to identify the effect of the hologram. Many Offices also indicated that they accept digital or video files. Acceptable formats indicated include MP4 and JPEG.

**d. Three-dimensional marks (shape marks)**

- **Yes** 79 (96%)

If “Yes” to question 6.d.<sup>3</sup>

*i. Product packaging<sup>4</sup>*

- Yes 70 (89%)
- No 7 (9%)

*ii. Product shape<sup>5</sup>*

- Yes 76 (96%)
- No 2 (3%)

- **No** 3 (4%)

- **Comments:** Most Offices require a photographic reproduction or graphic representation of the mark, from all perspectives. One Office also requires a physical sample, when deemed necessary. Acceptable formats indicated include JPEG, OBJ, STL and X3D.

**e. Color marks**

- **Yes** 76 (93%)

If “Yes” to question 6.e.,

*i. A single color*

- Yes 62 (82%)
- No 14 (18%)

*ii. A combination of colors*

- Yes 76 (100%)
- No 0 (0%)

- **No** 6 (7%)

- **Comments:** Most Offices require a clear reproduction of the mark in color. Where the mark comprises a combination of color, a reproduction showing the systematic arrangement of the color combination is often required. Many Offices also require a clear description or an indication of the color or a color code according to an international recognized color standard (e.g. Pantone). The most commonly indicated format was JPEG.

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<sup>3</sup> Not all the Offices that replied “Yes” to question 6.d. indicated whether they protect product packaging or product shape.

<sup>4</sup> Two Offices didn’t reply (2%).

<sup>5</sup> One Office didn’t reply (1%).

**f. Sound marks**

- **Yes** 60 (73%)

If “Yes” to question 6.f.,

*i. A musical sound*

- **Yes** 56 (93%)
- **No** 4 (7%)

*ii. Any sound*

- **Yes** 50 (83%)
- **No** 10 (17%)

- **No** 22 (27%)

- **Comments:** National or regional practices concerning the reproduction of sound marks vary significantly. Many Offices require either a sound file or a graphical representation of the musical notation, with or without a description of the sound. Some Offices require both a sound file and a graphical representation of the sound, or accept other reproductions of the sound, such as, for example, sonograms or phonograms. Some Offices offer the applicant a choice of reproduction(s).

**g. Motion marks**

- **Yes** 44 (54%)

- **No** 38 (46%)

- **Comments:** 21 Offices indicated that they accept motion marks represented in video or graphical form (series of images with a description). Five Offices require a video and graphical representation. 16 Offices require a graphical reproduction (series of sequential images). Not all Offices specified how the mark should be represented, but indicated that acceptable formats include JPEG and MP4.

**h. Multimedia marks (motion and sound)**

- **Yes** 36 (44%)

- **No** 46 (56%)

- **Comments:** 15 Offices indicated that they accept or require audio-visual files combining the image and the sound. Many Offices require videos in MP4 format. However, a few Offices still require a graphical reproduction of the mark (multiple images) with a detailed description.

- i. **Other(s) (e.g. gesture marks, olfactory marks, pattern marks, position marks, taste marks, texture marks, trade-dress)**
- **Yes** 49 (60%)
  - **No** 33 (40%)
  - **Comments:** 49 Offices indicated that they accept other types of marks such as, for example, pattern marks (21 Offices), position marks, (23 Offices) trade dress (nine Offices), olfactory marks (eight Offices), tactile marks (six Offices), taste marks (seven Offices) and gesture marks (six Offices). Ten Offices indicated that they would accept any mark capable of being represented graphically.

#### IV. **FORMAT AND MEANS TO FILE AN APPLICATION WITH THE OFFICE**

7. **WHICH OF THE FOLLOWING ARE ACCEPTABLE FORMATS TO FILE AN APPLICATION WITH THE OFFICE?**

a. **A paper form**

- **Yes** 75 (91%)
- **No** 7 (9%)

b. **The image of a paper form (e.g. PDF, JPG)**

- **Yes** 40 (49%)
- **No** 42 (51%)

c. **Structured data (e.g. e filing, XML files)**

- **Yes** 56 (68%)
- **No** 26 (32%)

8. **HOW DOES THE APPLICANT SUBMIT THE APPLICATION?**

a. **On a physical support (e.g. paper, CD ROM, USB device)**

- **Yes** 75 (91%)
- **No** 7 (9%)

b. **By fax**

- **Yes** 20 (24%)
- **No** 62 (76%)

c. **Electronically, other than fax (e.g. by e mail, by e filing)**

- **Yes** 60 (73%)
- **No** 22 (27%)



9. IS THE APPLICANT EITHER REQUIRED OR ALLOWED TO SUBMIT AN ELECTRONIC REPRESENTATION OF THE MARK ALONG WITH THE APPLICATION?

- **Yes** 61 (74%)
- **No** 21 (26%)

10. DEPENDING ON THE TYPE OF MARK, MAY THE ELECTRONIC REPRESENTATION CONSIST OF ONE OR MORE DIGITAL STILL IMAGES?

- **Yes** 58 (71%)

If "Yes" to question 10, please select the format(s) accepted by the Office

	<i>Format</i>	<i>Yes</i>	<i>No</i>
a.	<i>GIF</i>	18 (31%)	40 (69%)
b.	<i>JPEG</i>	55 (95%)	3 (5%)
c.	<i>PNG</i>	19 (33%)	39 (67%)
d.	<i>TIFF</i>	16 (28%)	42 (72%)
e.	<i>Other(s)</i>	21 (36%)	37 (64%)

If "Yes" to question 10, when the representation consists of more than one digital still image:

a. *All images must be included in one file*

- Yes 46 (79%)
- No 12 (21%)

b. *Each image may be in a separate file*

- Yes 19 (33%)
- No 39 (67%)

- **No** 24 (29%)

- **Comments:** Other formats commonly mentioned include BMP, PDF, MP3 and MP4. Other formats mentioned include JPG, OBJ, and STL, X 3D, XML, WAV, WMA, WMV, CDA, MPEG, MPG, DOC and TXT.

11. DEPENDING ON THE TYPE OF MARK, MAY THE ELECTRONIC REPRESENTATION CONSIST OF A DIGITAL RECORDING OF SOUND ONLY (I.E. WITHOUT MOVING IMAGES)?

- **Yes** 41 (50%)

If "Yes" to question 11, please select the format(s) accepted by the Office

	<i>Format</i>	<i>Yes</i>	<i>No</i>
a.	<i>MID</i>	1 (2%)	40 (98%)
b.	<i>MP3</i>	41 (100%)	0 (0%)
c.	<i>WAV</i>	14 (34%)	27 (66%)
d.	<i>Other(s)</i>	10 (24%)	31 (76%)

*Comments:* Other formats commonly mentioned include AVI, JPEG and MP4. Other formats mentioned include WMA, WMV, MOV, MPG, MPEG, GIF, PDF, JPG and CDA.

- **No** 41 (50%)

12. DEPENDING ON THE TYPE OF MARK, MAY THE REPRESENTATION CONSIST OF A DIGITAL RECORDING OF MOVING IMAGES WITHOUT SOUND?

- **Yes** 33 (40%)

If "Yes" to question 12, please select the format(s) accepted by the Office

	<i>Format</i>	<i>Yes</i>	<i>No</i>
a.	<i>AVI</i>	9 (27%)	24 (73%)
b.	<i>GIF</i>	8 (24%)	25 (76%)
c.	<i>MOV</i>	5 (15%)	28 (85%)
d.	<i>MP4</i>	29 (88%)	4 (12%)
e.	<i>MPEG</i>	6 (18%)	27 (82%)
f.	<i>WMV</i>	6 (18%)	27 (82%)
g.	<i>Other(s)</i>	7 (21%)	26 (79%)

*Comments:* Other formats commonly mentioned include JPEG and PDF. Other formats mentioned include CDA, JPG, WMA, MPG, MP3 and VOB.

- **No** 49 (60%)

13. DEPENDING ON THE TYPE OF MARK, MAY THE REPRESENTATION CONSIST OF A DIGITAL RECORDING OF MOVING IMAGES AND SOUND?

- **Yes** 34 (41%)

If “Yes” to question 13, please select the format(s) accepted by the Office

	<i>Format</i>	<i>Yes</i>	<i>No</i>
a.	<i>AVI</i>	11 (32%)	23 (68%)
b.	<i>MP4</i>	30 (88%)	4 (12%)
c.	<i>MPEG</i>	6 (18%)	28 (82%)
d.	<i>WMV</i>	7 (21%)	27 (79%)
e.	<i>Other(s)</i>	4 (12%)	30 (88%)

*Comments:* Other formats most commonly mentioned include MP3 and JPG. Other formats mentioned include JPEG, GIF, PDF, WAV, CDA, MOV, MPG and WMA.

- **No** 48 (59%)

**V. FORMATS AND STANDARDS USED BY THE OFFICE TO STORE, MANAGE AND PUBLISH ELECTRONIC REPRESENTATION OF MARKS**

14. DOES THE OFFICE STORE AND MANAGE AN ELECTRONIC REPRESENTATION OF THE MARK (WHETHER PROVIDED BY THE APPLICANT OR PRODUCED BY THE OFFICE) IN A DATABASE?

- **Yes** 73 (89%)

- **No** 9 (11%)

15. IF “YES” TO QUESTION 14, IS THE ELECTRONIC REPRESENTATION OF THE MARK AVAILABLE TO THE PUBLIC?

- **Yes** 56 (77%)

If “Yes” to question 15, how can the public access the electronic representation of the mark?

a. *At the Office only (e.g. a dedicated computer terminal)*

- Yes 12 (21%)

- No 44 (79%)

b. *Online (e.g. online database)*

- Yes 50 (89%)

- No 6 (11%)

- **No** 17 (23%)

16. IN WHICH FORMAT DOES THE OFFICE STORE, MANAGE AND PUBLISH THE ELECTRONIC REPRESENTATION OF THE MARK WHEN THIS CONSISTS OF (INDICATE THE RELEVANT FORMAT, SUCH AS, FOR EXAMPLE, JPEG, MP3 OR MOV OR TYPE N/A IF NOT APPLICABLE)<sup>6</sup>

**a. One or more digital still images?**

- JPEG (62 Offices)
- TIF/TIFF (9 Offices)
- GIF (8 Offices)
- PNG (7 Offices)
- BMP (5 Offices)
- PDF (4 Offices)
- JPG (4 Offices)

**b. A digital recording of sound only?**

- MP3 (42 Offices)
- WAV (10 Offices)
- MP4 (5 Offices)
- JPEG (3 Offices)

**c. A digital recording of moving images without sound?**

- MP4 (29 Offices)
- JPEG (6 Offices)
- GIF (3 Offices)
- MP3 (2 Offices)

**d. A digital recording of moving images and sound?**

- MP4 (29 Offices)

[End of Annex and of document]

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<sup>6</sup> The formats listed under this question are those that were mentioned the most.