

ANNEX

DRAFT QUESTIONNAIRE ON THE LEGAL, ADMINISTRATIVE, AND PROCEDURAL ASPECTS OF EXAMINATION AND REGISTRATION OF CERTIFICATION MARKS

I. DEFINITIONS

This section is intended to determine how certification marks are defined under the laws of each SCT member, including whether “certification marks” are referred to by another term, e.g., “guarantee marks”.

1. Do your laws provide for the registration of certification marks, or marks identified otherwise (e.g., “guarantee marks”) that are used by authorized users to show consumers that particular goods or services, or the providers of those goods or services, have met certain standards¹ set by a certifying organization?

Yes No N/A

Please use this space to provide any additional comments².

- a. If the answer to question 1 is “yes,” please (i) indicate what these marks are called in your jurisdiction and (ii) identify the specific laws or regulations that permit registration of these types of marks.

- b. If the answer to question 1 is “yes,” please state whether your jurisdiction has a specific definition of this type of mark and set out the definition in the space provided below, along with the specific statute, law, rule or regulation number for the definition.

2. If the answer to question 1 is “yes,” please state the name of the administrative authority that registers certification marks or similar marks as identified in your jurisdiction (hereinafter all referred to as “certification marks”).

3. If the answer to question 1 is “no,” please identify what type of application, if any, that may be filed by a certifying entity to protect a mark used to indicate that the goods or services of another meet certain standards.

¹ Secretariat note: The terms “regulations of use” or “standards” should be understood as referring to comparable concepts, namely the rules or criteria governing the use of certification marks. As noted in document [WIPO/STrad/INF/6](#) (Technical and Procedural Aspects relating to the Registration of Certification and Collective Marks), the terminology used, such as regulations or standards, refers to comparable concepts across jurisdictions, even if the specific content and formulation may vary (see paragraph 40). Respondents are therefore kindly invited to interpret the terminology used in the draft Questionnaire in a functional manner and map it to equivalent concepts under their national systems when answering the questions.

² Free-text fields proposed by the Delegation of Japan for additional comments.

4. Is registration a requirement to protect a certification mark?

Yes No N/A

Please use this space to provide any additional comments.

5. If your laws do not provide for registration of certification marks, please explain why, (e.g., too difficult to implement, faced industry opposition, legislative hurdles, etc.).

6. If the answer to question 1 is “yes,” what characteristics or features of a product or service can the certifying entity certify? (please check all that apply)

- a. The material comprising all of the goods meets certain standards Yes No N/A
- b. The material comprising part of the goods meets certain standards Yes No N/A
- c. The mode of manufacture of the goods Yes No N/A
- d. The mode of performance of the services Yes No N/A
- e. The quality of the goods or services Yes No N/A
- f. The characteristics of the goods or services Yes No N/A
- g. That the work or labor on the goods or services was performed by members of a union or other organization Yes No N/A
- h. The geographic origin of the goods or services Yes No N/A
- i. Other (Please specify):

Please use this space to provide any additional comments.

II. REQUIREMENTS FOR REGISTRATION

This section is intended to determine the requirements for filing and registration of certification marks.

7. Please select which requirements must be satisfied to receive a filing date for an application to register a certification mark, and which requirements are needed for a complete application (*i.e.*, being in order for acceptance and registration).

Requirements	Filing-date requirement	Complete application requirement
a. Name of applicant/owner	<input type="checkbox"/>	<input type="checkbox"/>
b. Applicant/owner's business address	<input type="checkbox"/>	<input type="checkbox"/>
c. Owner's entity type (individual, partnership, corporation, other)	<input type="checkbox"/>	<input type="checkbox"/>
d. Citizenship of individual owner or country in which owner entity is incorporated or otherwise formed	<input type="checkbox"/>	<input type="checkbox"/>

Requirements	Filing-date requirement	Complete application requirement
e. Prescribed fee	<input type="checkbox"/>	<input type="checkbox"/>
f. Identification of the goods or services to be certified	<input type="checkbox"/>	<input type="checkbox"/>
g. Classification of the goods or services to be certified	<input type="checkbox"/>	<input type="checkbox"/>
h. Statement that application is for registration of a certification mark	<input type="checkbox"/>	<input type="checkbox"/>
i. Statement of what the mark certifies	<input type="checkbox"/>	<input type="checkbox"/>
j. A copy of the certification standards	<input type="checkbox"/>	<input type="checkbox"/>
k. A representation or drawing of the mark	<input type="checkbox"/>	<input type="checkbox"/>
l. Specimen showing use of the mark	<input type="checkbox"/>	<input type="checkbox"/>
m. Declaration of use or intent to use the mark	<input type="checkbox"/>	<input type="checkbox"/>
n. Signature of the applicant/owner	<input type="checkbox"/>	<input type="checkbox"/>
o. Email address	<input type="checkbox"/>	<input type="checkbox"/>
p. Local counsel	<input type="checkbox"/>	<input type="checkbox"/>
q. Other additional requirements (Please specify):	<input type="checkbox"/>	<input type="checkbox"/>

Please use this space to provide any additional comments.

8. For certification marks indicating regional origin, what additional requirements must be fulfilled for the application to be approved for registration?
- | | |
|---|---|
| a. Certification statement identifying what goods will be certified | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| b. Regional demarcation of where products are produced | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| c. Copy of the standards of review used to certify the goods | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| d. Protection in the country of origin | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| e. Authority to control the use of the geographic term | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| f. Map of production area | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| g. Specimen of use (e.g., a label on a certified product or documentation for services showing that the certification mark has certification significance in the marketplace) | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| h. List of names of authorized users | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| i. Statement that applicant will not certify its own goods or services | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |
| j. Statement of non-production of goods to be certified | Yes <input type="checkbox"/> No <input type="checkbox"/> N/A <input type="checkbox"/> |

- k. Disclaimer of any common names Yes No N/A
- l. Other additional requirements that must be fulfilled before the application can be approved for registration of the mark (Please specify):

Please use this space to provide any additional comments.

9. If the application contains incorrect information, can the application be amended or must the application be refiled with loss of the original filing date? (Please explain)

10. Which amendments of the application affect the original filing date?³

11. Is there a special classification of products or services when applying for registration of a certification mark?⁴

Yes No N/A

- a. If yes, please explain what it consists of and whether it differs from the Nice Classification.

- b. If no, please indicate in which class of the Nice Classification this type of mark is being applied for registration.

12. Where the applicant is required to submit regulations of use, what is the minimum required content of those regulations?⁵

- a. The persons or categories of persons authorized to use the mark Yes No N/A
- b. The conditions for use of the mark Yes No N/A
- c. The consequences of use contrary to the regulations Yes No N/A
- d. Other mandatory content (please specify) Yes No N/A

13. Is the applicant required to submit a statement of the nature of its activities as a certifying body?⁶

- a. The applicant is required to submit a statement in all cases Yes No N/A
- b. The applicant is required to submit a statement only if the

³ Addition proposed by the Delegation of Saudi Arabia.

⁴ Addition proposed by the Delegation of Mexico.

⁵ Addition proposed by the Delegations of Finland and Lithuania.

⁶ Addition proposed by the Delegation of Finland.

- information cannot be obtained from publicly accessible registers Yes No N/A
- c. The applicant is not required to submit a statement Yes No N/A

Please use this space to provide any additional comments.

14. Should the regulations governing the use of a certification mark be publicly available?⁷

Yes No N/A

Please use this space to provide any additional comments.

15. Is it possible to amend the regulations governing the use of a certification mark after its registration?⁸

Yes No N/A

Please use this space to provide any additional comments.

16. What is the procedure for amending the regulations of use after the certification mark has been registered?⁹

- a. Is the holder required to notify the IP office of any amendment to the regulations of use?

Yes No N/A

- b. Must amended regulations of use satisfy the same substantive requirements as the original regulations of use?

Yes No N/A

- c. From what date do amended regulations of use take effect? (Please check all that apply)

- From the date the amendment is made by the holder
- From the date the amended regulations are submitted to the IP office
- From the date the amendment is approved and entered in the register
- Other (please specify below)

- d. What are the consequences if the holder fails to notify the IP office of an amendment? (Please check all that apply)

⁷ Addition proposed by the Delegation of Lithuania.

⁸ Addition proposed by the Delegation of Lithuania.

⁹ Addition proposed by the Delegation of Finland.

- The amendment has no legal effect
- The registration may be revoked or cancelled
- Other (please specify below)

17. If the applicant is required to submit a copy of the standards that govern the use of its certification mark, are the standards presumed valid?

Yes No N/A

Please use this space to provide any additional comments.

a. If the answer to question 17 is "yes," is any documentation required to show that the certifying body has expertise or appropriate knowledge necessary to certify goods or services?

Yes No N/A

b. If documentation is required, please identify the types of documents that can be submitted to demonstrate the certifying body's expertise:

18. If the standards are not presumed valid "on their face," what information is required? (Please check all that apply)

- a. Information demonstrating that the certifier is required to take reasonable steps to prevent the public from being misled. Yes No N/A
- b. Information detailing how the owner authorizes/controls/monitors the use of the mark. Yes No N/A
- c. Governmental substantiation of the standards Yes No N/A
- d. Inspection by a government body required Yes No N/A
- e. May standards be promulgated by private research or industry? Yes No N/A
- f. Other additional information (Please specify):

19. If the certification standards are not presumed valid "on their face," will an extension of time be granted to allow the applicant to submit amended standards or additional supporting information?

Yes No N/A

Please use this space to provide any additional comments.

20. Will any other government agency be consulted to determine registrability of the certification mark?

Yes No N/A

Please use this space to provide any additional comments.

21. On what basis can certification marks be refused? (Please check all that apply)

- a. Likelihood of confusion Yes No N/A
- b. Immoral/scandalous Yes No N/A
- c. Functional Yes No N/A
- d. Lacking distinctive character Yes No N/A
- e. Deceptive Yes No N/A
- f. Standards appear discriminatory against certain producers Yes No N/A
- g. Applicant does not appear to be capable of exercising control over the mark and the certification standards Yes No N/A
- h. Applicant appears to be engaged in the production or marketing of goods or services to which the mark is applied (rather than being an impartial certifier) Yes No N/A
- i. Evidence of lack of control of use of the mark by the applicant certifying party Yes No N/A
- j. Potential for public confusion to be misled regarding nature or significance of the mark Yes No N/A
- k. Discrepancy between the goods or services mentioned in the standards and the list of goods or services filed in the application¹⁰ Yes No N/A
- l. Other grounds (Please specify):

Please use this space to provide any additional comments.

22. Is the test for a refusal based on lack of distinctive character the same test that is applied to trademarks?

Yes No N/A

Please use this space to provide any additional comments.

23. If the answer to question 22 is "no," what factors may be taken into account in assessing whether a mark has or lacks distinctive character:

- a. The inherent nature of the mark itself Yes No N/A
- b. The standards used to certify goods Yes No N/A
- c. The goods or services Yes No N/A

¹⁰ Addition proposed by the Delegation of Norway.

d. Other factors (Please specify):

Please use this space to provide any additional comments.

24. Can a refusal based on lacking distinctive character be overcome with evidence of acquired distinctiveness?

Yes No N/A

Please use this space to provide any additional comments.

25. Will your IP office consider any of the following sources as evidence that the certification mark has or does not have distinctive character?

a. Dictionaries Yes No N/A

b. Newspapers or other publications Yes No N/A

c. Relevant websites Yes No N/A

d. Marketing materials showing how device is used and sold in the territory Yes No N/A

e. Other factors (Please specify):

Please use this space to provide any additional comments.

26. In the case of a mark that certifies regional origin, what factors other than those in question 25 are considered in determining whether the term has or does not have distinctive character? (Please check all applicable)

a. If the term sought to be registered is used within your member state to refer to the same type of goods or services Yes No N/A

b. Whether the term is used in relevant international standards to refer to a type or class of goods, such as Codex Alimentarius Yes No N/A

c. Whether the goods named by the term sought to be registered are imported into your territory from any other territories other than that identified in the application Yes No N/A

d. Whether the goods named by the term sought to be registered are manufactured or produced in any territories other than that identified in the application Yes No N/A

e. Whether persons or entities other than the applicant use the term

to name the type of product identified in the application Yes No N/A

Please use this space to provide any additional comments.

27. Is it possible to refuse the registration of a certification mark due to insufficient or unclear regulations?¹¹

Yes No N/A

Please use this space to provide any additional comments.

28. Is the decision to grant registration published?

Yes No N/A

Please use this space to provide any additional comments.

29. Is the decision to deny registration published?

Yes No N/A

Please use this space to provide any additional comments.

30. May the decision to refuse registration be appealed?

Yes No N/A

Please use this space to provide any additional comments.

31. If the answer to question 30 is “yes,” is there a specific time period during which the applicant may appeal the decision to deny registration?

Yes No N/A

Please use this space to provide any additional comments.

32. If there is a limited time period for appeal, please specify below:

- (i) the length of the time period: _____
 (ii) when it begins and ends: _____

33. May a decision to register be opposed?

Yes No N/A

Please use this space to provide any additional comments.

¹¹ Addition proposed by the Delegation of Lithuania.

34. If there is a limited time period during which the approval of certification marks may be opposed, please specify below:

- (i) the length of the time period: _____
 (ii) when it begins and ends: _____

35. Will the opposition notice include a disclaimer of common terms?

Yes No N/A

Please use this space to provide any additional comments.

36. Are the factors for determining infringement for certification marks the same as the factors for trademark infringement?

Yes No N/A

Please use this space to provide any additional comments.

37. If the answer to question 36 is "no," please explain how the tests for infringement are not the same.

38. Will the database and certificate of registration include any disclaimers?

Yes No N/A

Please use this space to provide any additional comments.

39. Is it possible to convert the type of mark after filing or after registration, in particular:¹²

a. Can a certification mark application be converted to an ordinary trademark or collective mark application before registration, or vice versa? Yes No N/A

b. Can a registered certification mark be converted to an ordinary trademark or collective mark registration, or vice versa? Yes No N/A

c. If any conversion is permitted, what conditions must be satisfied? (Please explain)

d. If conversion is not permitted after registration, please explain why.

¹² Addition proposed by the Delegations of Finland and Lithuania.

40. Is it possible for the same mark to be registered simultaneously as both a certification mark and an ordinary trademark or collective mark, in particular:¹³

a. Can the same mark be registered as both a certification mark and an ordinary trademark for the same goods or services?

Yes No N/A

b. Can the same mark be registered as both a certification mark and a collective mark for the same goods or services?

Yes No N/A

c. Is the prohibition on parallel registration (where it exists) an absolute ground for refusal or a relative ground for refusal?

Absolute ground for refusal

Relative ground for refusal

Other (please specify below)

d. If parallel registration is not permitted, does consent from the earlier right holder allow an exception?

Yes No N/A

Please use this space to provide any additional comments.

e. If parallel registration is not permitted, please describe the legal mechanism by which it is prevented (e.g. absolute ground for refusal, relative ground for refusal, opposition).

Please use this space to provide any additional comments.

41. Can a person who holds a certification mark and is authorized to provide certification services in their home country apply for registration of the same mark in your country?¹⁴

Yes No N/A

Please use this space to provide any additional comments.

¹³ Addition proposed by the Delegation of Finland.

¹⁴ Addition proposed by the Delegation of Lithuania.

42. In your jurisdiction what is the total number of:¹⁵

- certification mark applications filed with the IP Office _____
- certification mark registered by the IP Office _____
- certification mark applications refused by the IP Office _____

43. In your jurisdiction, are there any practical or administrative obstacles encountered by the IP Office in registering certification marks?¹⁶

Yes No N/A

- a. If the answer is “yes,” please indicate the obstacle(s) your IP Office faces in registering certification marks:

Please use this space to provide any additional comments.

III. OWNERSHIP AND CONTROL

The following section is intended to determine what type of entity is eligible to own, control and apply to register certification marks.

44. What type of entity is authorized to register certification marks?

- a. An individual or entity, i.e., the certifier, that is not engaged in the use of the mark for its own goods or services Yes No N/A
- b. An individual or entity that is using the mark in connection with its own goods or services, i.e., a producer Yes No N/A

Please use this space to provide any additional comments.

45. The certifying entity may be:

- a. An individual Yes No N/A
- b. A partnership Yes No N/A
- c. A corporation Yes No N/A
- d. A joint venture Yes No N/A
- e. An association Yes No N/A
- f. A collective Yes No N/A
- g. A government entity Yes No N/A
- h. Any entity recognized by a foreign applicant’s state/country of

¹⁵ Addition proposed by the Delegation of Saudi Arabia.

¹⁶ Addition proposed by the Delegation of Saudi Arabia.

domicile

Yes No N/A

i. Other (Please specify):

Please use this space to provide any additional comments.

46. If the applicant is not a governmental entity, is the applicant required to demonstrate they have been granted authority either from the national government or other governmental authority to operate a certification program?

Yes No N/A

Please use this space to provide any additional comments.

47. If the answer to question 46 is "yes," what documentation or evidence is necessary to demonstrate that the certifying entity has been authorized to certify goods or services?

48. If the certifying applicant is not "authorized" by its national government or other relevant authority, but shows that such authorization is not required under its country's law, will your IP Office make an allowance permitting the mark to be registered?

Yes No N/A

Please use this space to provide any additional comments.

49. Once registered, is the owner authorized to use the mark for purposes other than to certify, e.g., on its own goods or services, or goods promoting the mark?

Yes No N/A

Please use this space to provide any additional comments.

50. Can certification marks be assigned?

Yes No N/A

Please use this space to provide any additional comments.

51. If the answer to question 50 is "yes," is the approval of the IP office required for an assignment to be valid?

Please use this space to provide any additional comments.

Yes No N/A

52. If the answer to question 50 is "yes," are there any other conditions that must be fulfilled prior to an assignment?

53. Are certification types of marks subject to cancellation?

Yes No N/A

Please use this space to provide any additional comments.

54. If certification types of marks subject to cancellation, what are the grounds? (Please check all that apply)

a. The owner is not exercising legitimate control over the use of the mark. Yes No N/A

b. The applicant is engaged in, or will be engaged in, the production or marketing of any goods or services to which the mark is applied. Yes No N/A

c. The applicant has failed to observe the certifying standards. Yes No N/A

d. The owner permits use of the mark for purposes other than to certify. Yes No N/A

e. The owner discriminately refuses to certify, e.g., if a party seeks to use the mark on its goods that meet the certifier's standards, but the certifier refuses the party's use Yes No N/A

f. Other grounds for cancellation (Please specify):

Please use this space to provide any additional comments.

55. Can a licensee challenge ownership of the certification mark?

Yes No N/A

Please use this space to provide any additional comments.

56. Is the registration term the same as trademark registrations?

Yes No N/A

Please use this space to provide any additional comments.

57. Is it possible to renew the registration?

Yes No N/A

Please use this space to provide any additional comments.

58. If the answer to question 57 is "yes," please specify the conditions required to renew registration.

59. Is renewal required for continued protection?

Yes No N/A

Please use this space to provide any additional comments.

60. Do your courts enforce the IP rights granted through registration of certification marks?

Yes No N/A

Please use this space to provide any additional comments.

a. If the answer to question 60 is "no," please explain why:

61. Is it mandatory to register authorized users of the certification mark with the industrial property office?¹⁷

Yes No N/A

Please use this space to provide any additional comments.

62. If proof of use of the certification mark is required, what documentation should be submitted as evidence?¹⁸

63. Does your jurisdiction have mechanisms in place to monitor the use of certification marks online and on digital trade platforms?¹⁹

Yes No N/A

Please use this space to provide any additional comments.

¹⁷ Addition proposed by the Delegation of Mexico.

¹⁸ Addition proposed by the Delegation of Mexico.

¹⁹ Addition proposed by the Delegation of Saudi Arabia.

IV. CERTIFICATION MARKS INDICATING REGIONAL ORIGIN AND GEOGRAPHICAL INDICATIONS (GIs)

The following section is intended to determine the connection between certification marks and GIs.

64. Are GIs eligible for registration as certification marks?

Yes No N/A

Please use this space to provide any additional comments.

65. If your IP laws provide for registration and protection of both certification marks and GIs, is it possible to apply to register the same mark as both a certification mark and as a GI?

Yes No N/A

Please use this space to provide any additional comments.

66. Is there a benefit to applying for registration of both? (Please explain)

67. Is there a benefit for applying for GI protection instead of a certification mark? (Please explain)

V. EXAMPLES

68. Please provide examples of certification marks for goods, certification marks for services, and regional certification marks currently protected in your jurisdictions.

[End of Annex]