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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Twenty-Second Session
Geneva, November 23 to 26, 2009

SUMMARY OF REPLIES TO THE QUESTIONNAIRE ON LETTERS OF CONSENT

prepared by the Secretariat

INTRODUCTION

1. At its twentieth session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) requested the Secretariat to prepare an information document on the subject of letters of consent, for consideration by the SCT at its second session in 2009, and based on information to be collected by the Secretariat by means of a concise list of questions, to be addressed to SCT Members in the first half of 2009 (paragraph 287 of document SCT/20/5).
2. Accordingly, the Secretariat elaborated a questionnaire, the purpose of which was to gather information on the law and practice of Member States in connection with letters of consent. The questionnaire was sent by post and made available on the WIPO Website for reply until August 31, 2009.
3. In some jurisdictions, letters of consent are seen as a possibility of overcoming an objection to the registration of a trademark, when such an objection is based on a prior registration. In particular, a refusal of registration citing an earlier registration may be overcome if the holder of the prior right consents to the registration of the later trademark. The consent may be expressed in different ways and may be called differently

(e.g. coexistence or transactional agreement). However, the general term “letter of consent” will be used in this Questionnaire to identify a written agreement of the holder of a prior registered trademark consenting to the registration of a later trademark.

4. This document reproduces the information provided by 58 Member States and one intergovernmental organization, namely: Algeria, Australia, Austria, Azerbaijan, Bangladesh, Bosnia and Herzegovina, Brazil, Bulgaria, China, Colombia, Cuba, Cyprus, Czech Republic, Denmark, Ecuador, El Salvador, Estonia, Ethiopia, Finland, Germany, Greece, Guatemala, Hungary, Ireland, Italy, Japan, Kazakhstan, Kyrgyzstan, Lithuania, Malaysia, Mexico, Morocco, New Zealand, Norway, Oman, Pakistan, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Sao Tome and Principe, Serbia, Singapore, South Africa, Spain, Sudan, The former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Tunisia, Turkey, United Kingdom, United States of America, Uzbekistan, Viet Nam, Yemen and the Benelux Organization for Intellectual Property (BOIP). Returns are reproduced in tabulated form showing individual replies according to country. This part is followed by a quantitative analysis of the replies.

5. *The Standing Committee is invited to consider the present document and:*

(i) confirm whether the information reflected in the Summary is accurate or indicate the nature of any proposed amendments;

(ii) consider any further aspects concerning letters of consent that it may wish to address, and

(iii) indicate whether it wishes to undertake any further action with regard to items (i) and (ii).

Responding countries/Regional IP offices	1. It is possible to overcome the following through the presentation of a letter of consent		
	(a) an <i>ex officio</i> refusal of a trademark registration based on an earlier registered trademark	(b) an opposition to a trademark registration based on an earlier registered trademark	(c) a request for invalidation or cancellation of a trademark registration based on an earlier registered trademark
Algeria	YES	N.A.	N.A.
Australia	YES	YES	YES
Austria	N.A.	N.A.	YES
Azerbaijan	YES	YES	YES
Bangladesh	YES	YES	YES
Bosnia and Herzegovina	YES	N.A.	YES
Brazil	YES	YES	YES
Bulgaria	YES	YES	YES
China	N.A.	YES	YES
Colombia	NO	NO	NO
Cuba	YES	YES	YES
Cyprus	YES	YES	YES
Czech Republic	YES	YES	YES
Denmark	N.A.	YES	YES
Ecuador	YES	YES	YES
El Salvador	YES	YES	N.A.
Estonia	YES	YES	YES
Ethiopia	YES	YES	YES
Finland	YES	YES	N.A.
Germany	N.A.	NO	YES
Greece	YES	N.A.	N.A.
Guatemala	YES	YES	N.A.
Hungary	N.A.	YES	YES
Ireland	YES	NO	NO
Italy	N.A.	N.A.	N.A.
Japan	NO	NO	NO
Kazakhstan	NO	YES	YES
Kyrgyzstan	YES	NO	NO
Lithuania	YES	YES	YES
Malaysia	NO	N.A.	N.A.
Mexico	NO	N.A.	YES
Morocco	N.A.	YES	NO
New Zealand	YES	NO	NO
Norway	YES	YES	N.A.
Oman	YES	YES	YES
Pakistan	YES	YES	YES
Philippines	NO	NO	NO
Poland	YES	YES	YES
Portugal	YES	YES	YES
Republic of Korea	NO	NO	NO
Romania	YES	YES	YES
Russian Federation	YES	N.A.	YES
Sao Tome and Principe	YES	YES	YES
Serbia	YES	N.A.	N.A.
Singapore	YES	N.A.	N.A.
South Africa	YES	NO	NO
Spain	N.A.	YES	NO
Sudan	YES	YES	YES
The former Yugoslav Republic of Macedonia	N.A.	YES	YES
Trinidad and Tobago	YES	NO	NO
Tunisia	NO	YES	NO
Turkey	NO	NO	N.A.
United Kingdom	YES	YES	YES
United States of America	YES	YES	YES
Uzbekistan	YES	YES	YES
Viet Nam	YES	YES	YES
Yemen	YES	YES	YES
BOIP (Benelux Organization for Intellectual Property)	N.A.	N.A.	N.A.

Responding countries/Regional IP offices	2. A letter of consent is acceptable if it is filed by an applicant that is a legal person belonging to the same group of enterprises as the holder
Algeria	NO
Australia	YES
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	YES
Brazil	YES
Bulgaria	N.A.
China	NO
Colombia	NO
Cuba	YES
Cyprus	N.A.
Czech Republic	YES
Denmark	NO
Ecuador	NO
El Salvador	YES
Estonia	YES
Ethiopia	YES
Finland	YES
Germany	N.A.
Greece	NO
Guatemala	YES
Hungary	NO
Ireland	NO
Italy	N.A.
Japan	N.A.
Kazakhstan	YES
Kyrgyzstan	YES
Lithuania	NO
Malaysia	N.A.
Mexico	NO
Morocco	NO
New Zealand	YES
Norway	NO
Oman	YES
Pakistan	YES
Philippines	YES
Poland	YES
Portugal	YES
Republic of Korea	NO
Romania	NO
Russian Federation	YES
Sao Tome and Principe	YES
Serbia	YES
Singapore	YES
South Africa	YES
Spain	YES
Sudan	NO
The former Yugoslav Republic of Macedonia	NO
Trinidad and Tobago	N.A.
Tunisia	NO
Turkey	NO
United Kingdom	YES
United States of America	YES
Uzbekistan	NO
Viet Nam	YES
Yemen	YES
BOIP (Benelux Organization for Intellectual Property)	N.A.

Responding countries/Regional IP offices	3. A letter of consent regarding identical marks for identical goods or services is acceptable
Algeria	NO
Australia	YES
Austria	YES
Azerbaijan	NO
Bangladesh	
Bosnia and Herzegovina	YES
Brazil	NO
Bulgaria	NO
China	NO
Colombia	NO
Cuba	NO
Cyprus	YES
Czech Republic	YES
Denmark	YES
Ecuador	NO
El Salvador	NO
Estonia	NO
Ethiopia	NO
Finland	YES
Germany	N.A.
Greece	NO
Guatemala	NO
Hungary	YES
Ireland	YES
Italy	N.A.
Japan	N.A.
Kazakhstan	YES
Kyrgyzstan	NO
Lithuania	YES
Malaysia	NO
Mexico	NO
Morocco	YES
New Zealand	YES
Norway	YES
Oman	YES
Pakistan	YES
Philippines	NO
Poland	NO
Portugal	YES
Republic of Korea	NO
Romania	YES
Russian Federation	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	YES
South Africa	YES
Spain	YES
Sudan	YES
The former Yugoslav Republic of Macedonia	YES
Trinidad and Tobago	NO
Tunisia	YES
Turkey	NO
United Kingdom	YES
United States of America	YES
Uzbekistan	NO
Viet Nam	NO
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

Responding countries/Regional IP offices	4. If a third application is filed for a similar trademark as was registered on the basis of a letter of consent, the applicant is required to file letters of consent from all holders of earlier registrations
Algeria	YES
Australia	YES
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	YES
Brazil	NO
Bulgaria	YES
China	YES
Colombia	NO
Cuba	YES
Cyprus	YES
Czech Republic	YES
Denmark	N.A.
Ecuador	NO
El Salvador	YES
Estonia	YES
Ethiopia	YES
Finland	YES
Germany	N.A.
Greece	YES
Guatemala	N.A.
Hungary	N.A.
Ireland	NO
Italy	N.A.
Japan	N.A.
Kazakhstan	NO
Kyrgyzstan	NO
Lithuania	N.A.
Malaysia	N.A.
Mexico	N.A.
Morocco	NO
New Zealand	NO
Norway	YES
Oman	YES
Pakistan	YES
Philippines	N.A.
Poland	YES
Portugal	YES
Republic of Korea	NO
Romania	NO
Russian Federation	YES
Sao Tome and Principe	YES
Serbia	YES
Singapore	YES
South Africa	YES
Spain	N.A.
Sudan	YES
The former Yugoslav Republic of Macedonia	NO
Trinidad and Tobago	YES
Tunisia	NO
Turkey	N.A.
United Kingdom	YES
United States of America	YES
Uzbekistan	YES
Viet Nam	YES
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

Responding countries/Regional IP offices	5. A letter of consent should meet formal requirements such as:	
	(a) a mandatory content	(b) an Office form
Algeria	YES	NO
Australia	YES	NO
Austria	NO	NO
Azerbaijan	YES	
Bangladesh	NO	NO
Bosnia and Herzegovina	YES	NO
Brazil	YES	NO
Bulgaria	YES	NO
China	NO	NO
Colombia	NO	NO
Cuba	NO	NO
Cyprus	NO	NO
Czech Republic	YES	NO
Denmark	YES	NO
Ecuador	NO	NO
El Salvador	YES	NO
Estonia	YES	NO
Ethiopia	YES	NO
Finland	N.A.	NO
Germany	NO	N.A.
Greece	NO	NO
Guatemala	YES	NO
Hungary	YES	NO
Ireland	NO	NO
Italy	N.A.	N.A.
Japan	N.A.	N.A.
Kazakhstan	YES	YES
Kyrgyzstan	YES	NO
Lithuania	NO	NO
Malaysia	N.A.	N.A.
Mexico	NO	NO
Morocco	NO	NO
New Zealand	YES	NO
Norway	YES	NO
Oman	YES	NO
Pakistan	YES	N.A.
Philippines	N.A.	N.A.
Poland	YES	YES
Portugal	NO	NO
Republic of Korea	N.A.	N.A.
Romania	NO	NO
Russian Federation	YES	NO
Sao Tome and Principe	YES	YES
Serbia	YES	NO
Singapore	YES	NO
South Africa	NO	YES
Spain	NO	NO
Sudan	YES	
The former Yugoslav Republic of Macedonia	N.A.	N.A.
Trinidad and Tobago	NO	NO
Tunisia	NO	NO
Turkey	N.A.	N.A.
United Kingdom	NO	YES
United States of America	YES	NO
Uzbekistan	YES	YES
Viet Nam	YES	NO
Yemen	YES	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.	N.A.

Responding countries/Regional IP offices	6. A letter of consent could be admissible only for a specific period of time
Algeria	NO
Australia	NO
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
China	NO
Colombia	NO
Cuba	NO
Cyprus	NO
Czech Republic	NO
Denmark	NO
Ecuador	YES
El Salvador	NO
Estonia	N.A.
Ethiopia	YES
Finland	NO
Germany	N.A.
Greece	NO
Guatemala	NO
Hungary	NO
Ireland	NO
Italy	N.A.
Japan	N.A.
Kazakhstan	NO
Kyrgyzstan	YES
Lithuania	NO
Malaysia	N.A.
Mexico	NO
Morocco	YES
New Zealand	NO
Norway	NO
Oman	NO
Pakistan	NO
Philippines	N.A.
Poland	YES
Portugal	NO
Republic of Korea	N.A.
Romania	NO
Russian Federation	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO
Sudan	YES
The former Yugoslav Republic of Macedonia	NO
Trinidad and Tobago	NO
Tunisia	NO
Turkey	N.A.
United Kingdom	N.A.
United States of America	NO
Uzbekistan	NO
Viet Nam	NO
Yemen	YES
BOIP (Benelux Organization for Intellectual Property)	N.A.

Responding countries/Regional IP offices	7. There are restrictions to transfer a trademark which was granted on the basis of a letter of consent
Algeria	YES
Australia	NO
Austria	NO
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
China	N.A.
Colombia	NO
Cuba	N.A.
Cyprus	NO
Czech Republic	NO
Denmark	NO
Ecuador	NO
El Salvador	NO
Estonia	NO
Ethiopia	YES
Finland	NO
Germany	N.A.
Greece	NO
Guatemala	NO
Hungary	NO
Ireland	NO
Italy	N.A.
Japan	N.A.
Kazakhstan	NO
Kyrgyzstan	NO
Lithuania	N.A.
Malaysia	N.A.
Mexico	N.A.
Morocco	NO
New Zealand	NO
Norway	NO
Oman	NO
Pakistan	YES
Philippines	N.A.
Poland	YES
Portugal	NO
Republic of Korea	N.A.
Romania	NO
Russian Federation	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO
Sudan	NO
The former Yugoslav Republic of Macedonia	NO
Trinidad and Tobago	NO
Tunisia	NO
Turkey	N.A.
United Kingdom	N.A.
United States of America	NO
Uzbekistan	NO
Viet Nam	YES
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

Responding countries/Regional IP offices	8. It is possible to withdraw a letter of consent after a trademark was granted on that basis	8(a). Withdrawal causes the registration to lapse
Algeria	NO	NO
Australia	NO	N.A.
Austria	N.A.	N.A.
Azerbaijan	NO	
Bangladesh	YES	YES
Bosnia and Herzegovina	NO	YES
Brazil	NO	NO
Bulgaria	YES	NO
China	N.A.	N.A.
Colombia	NO	NO
Cuba	NO	N.A.
Cyprus	NO	NO
Czech Republic	YES	NO
Denmark	NO	N.A.
Ecuador	NO	NO
El Salvador	NO	N.A.
Estonia	NO	NO
Ethiopia	YES	YES
Finland	NO	N.A.
Germany	N.A.	N.A.
Greece	NO	NO
Guatemala	NO	NO
Hungary	NO	NO
Ireland	NO	N.A.
Italy	N.A.	N.A.
Japan	N.A.	N.A.
Kazakhstan	N.A.	N.A.
Kyrgyzstan	NO	NO
Lithuania	NO	
Malaysia	N.A.	N.A.
Mexico	NO	N.A.
Morocco	NO	NO
New Zealand	NO	N.A.
Norway	NO	N.A.
Oman	NO	
Pakistan	NO	N.A.
Philippines	N.A.	N.A.
Poland	YES	NO
Portugal	NO	N.A.
Republic of Korea	N.A.	N.A.
Romania	NO	NO
Russian Federation	NO	NO
Sao Tome and Principe	YES	YES
Serbia	NO	NO
Singapore	NO	N.A.
South Africa	NO	N.A.
Spain	NO	NO
Sudan	NO	N.A.
The former Yugoslav Republic of Macedonia	NO	N.A.
Trinidad and Tobago	N.A.	YES
Tunisia	NO	NO
Turkey	N.A.	N.A.
United Kingdom	YES	NO
United States of America	NO	YES
Uzbekistan	NO	NO
Viet Nam	N.A.	N.A.
Yemen	NO	N.A.
BOIP (Benelux Organization for Intellectual Property)	N.A.	N.A.

Responding countries/Regional IP offices	9. The presentation of a copy of the letter of consent is required for the renewal of a trademark registration granted on that basis
Algeria	NO
Australia	NO
Austria	N.A.
Azerbaijan	NO
Bangladesh	
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
China	N.A.
Colombia	NO
Cuba	NO
Cyprus	NO
Czech Republic	NO
Denmark	NO
Ecuador	NO
El Salvador	NO
Estonia	NO
Ethiopia	YES
Finland	NO
Germany	N.A.
Greece	NO
Guatemala	NO
Hungary	NO
Ireland	NO
Italy	N.A.
Japan	N.A.
Kazakhstan	N.A.
Kyrgyzstan	NO
Lithuania	NO
Malaysia	N.A.
Mexico	NO
Morocco	NO
New Zealand	NO
Norway	NO
Oman	NO
Pakistan	NO
Philippines	N.A.
Poland	NO
Portugal	NO
Republic of Korea	N.A.
Romania	NO
Russian Federation	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO
Sudan	NO
The former Yugoslav Republic of Macedonia	NO
Trinidad and Tobago	NO
Tunisia	NO
Turkey	N.A.
United Kingdom	NO
United States of America	NO
Uzbekistan	NO
Viet Nam	NO
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

10. Other remarks concerning letters of consent* .

AZERBAIJAN: During the trademark examination stage and in the event of a positive decision as a result of examination, the consent letter of the owner of a similar trademark for identical or similar goods or services or another document on agreement can be considered by the Appeal Council.

COLOMBIA: Even where there is consent by the holder of a prior right, the administration is obliged to refuse the registration if it considers that the risk of confusion persists.

CUBA: Letters of consent are accepted only when there is no risk of confusion or association, and it is only possible to use a letter of consent in the case of invalidation and not in the case of cancellation procedures. Lapsing of a registration may only occur when the term of validity is reached and due to lack of use of the mark.

CZECH REPUBLIC: The letter of consent must be in writing and the consent to register the junior or subsequent mark must be expressed precisely.

EL SALVADOR: A letter of consent is an agreement and therefore the following formalities should be fulfilled: (1) express agreement of both parties must be indicated. (2) If the agreement is given locally, it must be contained in a notarized document. If it is granted abroad, it should be issued with the formalities required in the country of origin, and properly authenticated to be valid in El Salvador. (3) In a case where the authorization (unilateral letter of consent) is granted in the country of origin, the applicant's acceptance must be issued in a separate document. The rules described in No. 2 apply in both cases.

GUATEMALA: A letter of consent must be legalized by a notary public. If the person giving its consent acts in the name of a legal person, he/she must be duly authorized to do so.

MEXICO: There is no definition of consent in the applicable law. However, in practice, an expression of consent may be considered in the following cases: if the marks are not identical; if one mark is not reproduced in the other mark and the interested parties engage themselves to avoid confusion in the marketplace. With regard to applications for marks similar to those already registered on the basis of a letter of consent, the applicant is not required to provide consent agreements from all the holders of prior rights. There is no restriction in the applicable law to transfer marks granted on the basis of a letter of consent. It is considered that the law establishes the transfer of rights which derive from a trademark registration or a pending trademark application and accordingly, a person who acquires a trademark registration, acquires amongst others, the right to transfer the rights on that registration.

NEW ZEALAND: Essential criteria to be contained in a consent document, and set out in the Intellectual Property Office of New Zealand (IPONZ) Practice Guidelines are as follows: (1) The consent document must clearly identify the applicant's mark. The application number(s) is sufficient. It is not essential to include the trade mark or to identify the earlier trade marks owned by the person giving consent. (2) The consent document must clearly identify the person giving consent and be signed by that person. Where the person giving consent is not recorded on the register as the owner of the mark, the letter should indicate that the person signing has the necessary authority to consent on behalf of the owner and proof of that authority should be supplied. For example, for corporate bodies, the person signing

should indicate his or her name and position within the company, on official letter-headed paper or on paper carrying the company seal. (3) The consent document must relate to the registration of the applicant's mark. (4) The consent document may identify the goods and services. Where the consent document does not refer to the specification, IPONZ will assume that the applicant's specification is acceptable to the party giving consent. However, if the owner of the cited mark consents to the registration of the applicant's mark, but in respect of a narrower specification of goods or services than that originally applied for, then the applicant must request a limitation of its specification, so that the specification includes only those goods or services listed in the consent document.

General letter of consent: A general letter of consent may be provided confirming that one party is prepared to consent to any trade mark applications made by another party. The general consent document must still meet the requirements above except that the general consent need not identify the applicant's mark. The general consent document need only identify the applicant to whom the general consent is being given. Whenever a copy of the general letter of consent is filed or referred to, the applicant or their agent must supply a covering letter certifying that the general consent is still valid and on which file the general consent is attached.

NORWAY: The Norwegian IP Office accepts coexistence agreements instead of letters of consent if these agreements fulfill the following conditions: (1) The trademark subject to the co-existence agreement is identical to the trademark in the application/designation. (2) The goods and/or services in the co-existence agreement are included in the application/designation. (3) The co-existence agreement indicates clearly that it is consent to registration/acceptance of the trademark. (4) The parties that have signed the coexistence agreement (name and address) are identical to the ones of the relevant trademarks. Furthermore, there are no requirements that any coexistence agreement must be filed through a representative. So, for example, a holder of an international registration can submit this directly to the Norwegian IP Office after receiving a provisional refusal without the need to contact a Norwegian representative. It is sufficient to submit a copy of the letter of consent or the coexistence agreement.

RUSSIAN FEDERATION: Under the Administrative Regulations, if from the point of view of the applicant, the sign applied for is confusingly similar to the sign previously registered in the name of another person, the application may be submitted accompanied by a written consent of that person. The confirmation of the consent may be in the form of a written agreement, in which it is recommended to establish the conditions on which the consent to registration is given, the obligations of the parties and the consequences of failure to fulfil such obligations.

In practice, a number of serious issues have been indicated, which require supplementary research. Some of those issues are included in the questionnaire. However, it seems appropriate to further explore the following questions: (1) In which cases does a letter of consent not lead to the registration of the trademark (in other words, whether the Registrar is obliged to register similar designations if the letter of consent is given or it has the right not to accept this letter regarding to the confusingly similar designations)? (2) Can the registration of similar signs be refused, when there is a letter of consent from the owner of "senior" rights, but, according to the examiner, this registration would be contrary to public order, or would mislead the consumers (for example, in the case of a trademark with respect to medicines)? (3) Should the revocation of a letter of consent be allowed and in which cases? What is the effect of the revocation of previously submitted letters of consent? (4) Should the

information on the existence of a letter of consent be published? (5) Can the copies of letters of consent be provided upon the request of any person?

SINGAPORE: With regard to Question (2), that suggested letter of consent would only be acceptable if it has been issued in the name of the holder of the prior registered mark. A letter of consent from a person other than the holder of the prior registered mark would not be acceptable, even if that holder had explained the corporate relationship between the applicant and the holder of the prior registered mark, however intimate that corporate relationship might be. With regard to Question (3), the Registrar has a discretion to accept or reject a letter of consent given by the holder of the prior registered mark. Generally, the Intellectual Property Office of Singapore (IPOS) will accept such a letter of consent even in respect of an identical mark and identical goods/services. However, IPOS may reject such a letter of consent where there is an overriding policy reason, eg. adverse consequences over the possibility of confusion over identical marks in respect of pharmaceutical products.

SOUTH AFRICA: In terms of the Trade Marks Act (Act 194 of 1993), the Registrar has no discretion in accepting or not accepting a letter of consent. Even if the Registrar is of the opinion that the letter of consent will not overcome the possibility of deception and confusion to the public, the Registrar cannot refuse to accept the letter of consent –even when it is filed for an identical mark for identical goods or services. The rationale behind this is that the holder of the prior mark is in the best position to determine if there is a likelihood of deception or confusion, and if he provides a letter of consent to a later applicant it cannot be up to the Registrar to rule that there is still a possibility of deception or confusion.

UNITED KINGDOM: The United Kingdom Intellectual Property Office (UKIPO) operates what would generally be termed a ‘liberal’ regime, with express legal provision for consent to avoid a relative grounds objection (s 5(5) of the Trade Marks Act 1994). The UKIPO even encourage parties to eg. an opposition or potential opposition to come to their own consent or co-existence agreement, which may avoid expensive litigation. Our advice includes the need to seek expert guidance on the drafting of such agreements. Nor does the UKIPO generally concern itself with the terms under which consent is given, regarding it as a matter for the parties. Occasionally however an agreement between the parties may come to be interpreted or construed by the courts or the Office where, in an *inter partes* context, it is relevant to e.g. the determination of an opposition. This may, for example, arise where the agreement lacks clarity, is considered against the public interest or may e.g. form the basis of an estoppel which may bind one of the parties.

UNITED STATES OF AMERICA: Requirements which must be met for a letter of consent to be valid include the following: Consent agreements typically provide the reason(s) why confusion is not likely and/or state any arrangements undertaken by the parties to avoid confusion. For instance, a valid consent agreement might state that the parties have agreed to limit use of their respective marks to certain channels of trade or markets or to certain consumers. The agreement may limit any expansion of the goods and/or services of the parties. It might also state that the parties will refrain from using their marks in forms, formats or contexts that could lead to confusion.

A consent agreement that contains conclusory statements about the likelihood of confusion and consents by which the parties merely agree to allow for the registration of a mark, without establishing any limitations on the use of the mark so as to avoid confusion, is considered a “naked” consent. “Naked” consent agreements are afforded little or no weight during examination. Consents also may not serve merely as a more convenient alternative to a valid trademark license between the parties.

The general rule is that agreements between the parties, whether two applicants or an applicant and a registrant, are afforded substantial weight. Such agreements are understood to be in the mutual pecuniary interests of the parties because they are necessary for their economic survival, impact large product development and marketing expenditures, and are entered into with knowledge of the goods or services and the relevant marketplace. Therefore, if the parties have provided a valid agreement signed by the owner of the application or registration, or by someone with legal authority to bind the owner, and the examining attorney is persuaded that the letter of consent adequately resolves the likelihood of confusion, he or she may withdraw the refusal of registration or the suspension of the application.

Quantitative Summary of Replies to the Questionnaires on Letters of Consent
(document SCT/22/5 Prov.)

Questions	Replies	YES	%	NO	%	N/A	%	
1. It is possible to overcome the following through the presentation of a letter of consent	(a) an <i>ex officio</i> refusal of a trademark registration based on an earlier registered trademark	58	39	67%	9	16%	10	17%
	(b) an opposition to a trademark registration based on an earlier registered trademark	58	36	62%	11	19%	11	19%
	(c) a request for invalidation or cancellation of a trademark registration based on an earlier registered trademark	58	34	58.6%	12	20.7%	12	20.7%
2. A letter of consent is acceptable if it is filed by an applicant that is a legal person belonging to the same group of enterprises as the holder	58	30	52%	19	33%	9	15%	
3. A letter of consent regarding identical marks for identical goods or services is acceptable	57	27	47%	26	46%	4	7%	
4. If a third application is filed for a similar trademark as was registered on the basis of a letter of consent, the applicant is required to file letters of consent from all holders of earlier registrations	58	31	54%	13	22%	14	24%	
5. A letter of consent should meet formal requirements such as:	(a) a mandatory content	58	29	50%	20	34%	9	16%
	(b) an Office form	56	6	11%	40	71%	10	18%
6. A letter of consent could be admissible only for a specific period of time	58	10	17%	37	64%	11	19%	
7. There are restrictions to transfer a trademark which was granted on the basis of a letter of consent	58	8	14%	37	64%	13	22%	
8. It is possible to withdraw a letter of consent after a trademark was granted on that basis	58	7	12%	38	66%	13	22%	
8(a). Withdrawal causes the registration to lapse	55	6	11%	21	38%	28	51%	
9. The presentation of a copy of the letter of consent is required for the renewal of a trademark registration granted on that basis	57	2	4%	44	77%	11	19%	

[End of document]

* Note by the Secretariat: Replies to question No. 10 are not reproduced *in extenso* but only to the extent that they address the legal effect and form of letters of consent.