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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

*Document 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). It also reproduces the information provided by the following 10 countries after the twenty-second session of the SCT: Antigua and Barbuda, Argentina, Chile, Croatia, Dominican Republic, Peru, Republic of Moldova, Saint Kitts and Nevis, Sweden and Uruguay. Returns are reproduced in tabulated form showing individual replies according to country. This part is followed by a quantitative analysis of the replies.

5. At the twenty-second session of the SCT, the Secretariat was requested to finalize the Summary of replies contained in document SCT/22/5 Prov., in line with the comments made by delegations on specific answers contained in the tables and on the comments section of the document, with a view to publishing the final version of this document for future reference.

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.
Antigua and Barbuda	NO	NO	N.A.
Argentina	YES	YES	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
Chile	YES	YES	NO
China	N.A.	YES	YES
Colombia	NO	NO	NO
Croatia	N.A.	N.A.	N.A.
Cuba	YES	YES	YES
Cyprus	YES	YES	YES
Czech Republic	YES	YES	YES
Denmark	N.A.	YES	YES
Dominican Republic	YES	NO	NO
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
Peru	YES	YES	NO
Philippines	NO	NO	NO
Poland	YES	YES	YES
Portugal	YES	YES	YES
Republic of Korea	NO	NO	NO
Republic of Moldova	YES	YES	YES
Romania	YES	YES	YES
Russian Federation	YES	N.A.	YES
Saint Kitts and Nevis	YES	N.A.	N.A.

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
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
Sweden	YES	YES	N.A.
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
Uruguay	NO	YES	NO
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.

**AUSTRIA:** Claims for invalidation/cancellation before the Cancellation Department of the Austrian Patent Office or such actions before Civil Courts may be rejected if a written agreement between the holder of the prior registered trademark and the defendant concerning the allowance of use of the later trademark exists (Latest Court Decision: Austrian Supreme Patent and Trademark Senate of 13 Feb. 2008).

**CROATIA:** Earlier rights are not examined by the Office, but the holder of an earlier right can raise an opposition after the application has been published. Whether or not the opposition procedure is conducted is up to the holder of the earlier right. If he wishes to terminate the opposition procedure he may withdraw the opposition and the application will proceed to registration. Such withdrawal is considered not to correspond to what is understood to be a “letter of consent” as defined above.

**PORTUGAL:** The affirmative answer to Question 1(c) depends on the decision by a judge to accept or refuse letters of consent in order to overcome invalidation.

**SPAIN:** When agreement is reached in opposition procedures, it is only necessary that the opponent withdraw its opposition. The Office does not examine prior rights *ex officio*, but if necessary, it would send a communication to the potential opponent.

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
Antigua and Barbuda	NO
Argentina	YES
Australia	YES
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	YES
Brazil	YES
Bulgaria	N.A.
Chile	NO
China	NO
Colombia	NO
Croatia	N.A.
Cuba	YES
Cyprus	N.A.
Czech Republic	YES
Denmark	NO
Dominican Republic	YES
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
Peru	NO
Philippines	YES
Poland	YES
Portugal	YES
Republic of Korea	NO
Republic of Moldova	NO
Romania	NO
Russian Federation	YES
Saint Kitts and Nevis	YES
Sao Tome and Principe	YES
Serbia	YES
Singapore	YES
South Africa	YES

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
Spain	YES
Sudan	NO
Sweden	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
Uruguay	YES
Uzbekistan	NO
Viet Nam	YES
Yemen	YES
BOIP (Benelux Organization for Intellectual Property)	N.A.

**AUSTRALIA:** A letter of consent is not necessarily acceptable when filed by an applicant that is a legal person belonging to the same group of enterprises as the holder, unless an appropriate commercial relationship exists between them.

**FINLAND:** If the words “filed by” are understood as equivalent to “signed by”, the answer would have to be in the negative.

**PORTUGAL:** The answer would depend on whether a power of attorney was submitted.

**RUSSIAN FEDERATION:** If the right holder of a trademark is a Russian legal person, the signature of an authorized person should be affirmed with the seal of the company. In the case of foreign legal persons, the signature is affirmed with the seal, if this is provided under the national legislation of a country where the legal person is established.

If the letter of consent is signed by the representative, the corresponding power of attorney (directly authorizing the representative to give the consent for registration of a claimed sign as a trademark on behalf of the right holder) should be submitted. If the power of attorney is not submitted or does not authorize the representative to give consent for registration of a trademark on behalf of the right holder, then the document signed on the basis of such power of attorney cannot be deemed to be the expression of consent of the right holder for the registration of a claimed sign as a trademark.

Responding countries/Regional IP offices	3. A letter of consent regarding identical marks for identical goods or services is acceptable
Algeria	NO
Antigua and Barbuda	NO
Argentina	NO
Australia	YES
Austria	YES
Azerbaijan	NO
Bangladesh	
Bosnia and Herzegovina	YES
Brazil	NO
Bulgaria	NO
Chile	NO
China	NO
Colombia	NO
Croatia	N.A.
Cuba	NO
Cyprus	YES
Czech Republic	YES
Denmark	YES
Dominican Republic	NO
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
Peru	NO
Philippines	NO
Poland	NO
Portugal	YES
Republic of Korea	NO
Republic of Moldova	NO
Romania	YES
Russian Federation	NO
Saint Kitts and Nevis	YES
Sao Tome and Principe	YES
Serbia	NO
Singapore	YES
South Africa	YES
Spain	YES

Responding countries/Regional IP offices	3. A letter of consent regarding identical marks for identical goods or services is acceptable
Sudan	YES
Sweden	YES
The former Yugoslav Republic of Macedonia	YES
Trinidad and Tobago	NO
Tunisia	YES
Turkey	NO
United Kingdom	YES
United States of America	YES
Uruguay	NO
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
Antigua and Barbuda	
Argentina	YES
Australia	YES
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	YES
Brazil	NO
Bulgaria	YES
Chile	NO
China	YES
Colombia	NO
Croatia	N.A.
Cuba	YES
Cyprus	YES
Czech Republic	YES
Denmark	N.A.
Dominican Republic	NO
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
Peru	NO
Philippines	N.A.
Poland	YES
Portugal	YES
Republic of Korea	NO
Republic of Moldova	NO
Romania	NO
Russian Federation	YES
Saint Kitts and Nevis	YES
Sao Tome and Principe	YES
Serbia	YES
Singapore	YES

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
South Africa	YES
Spain	N.A.
Sudan	YES
Sweden	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
Uruguay	N.A.
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
Antigua and Barbuda		
Argentina	N.A.	N.A.
Australia	YES	NO
Austria	NO	NO
Azerbaijan	YES	
Bangladesh	NO	NO
Bosnia and Herzegovina	YES	NO
Brazil	YES	NO
Bulgaria	YES	NO
Chile	NO	NO
China	NO	NO
Colombia	NO	NO
Croatia	N.A.	N.A.
Cuba	NO	NO
Cyprus	NO	NO
Czech Republic	YES	NO
Denmark	YES	NO
Dominican Republic	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.
Peru	NO	NO
Philippines	N.A.	N.A.
Poland	YES	YES
Portugal	NO	NO
Republic of Korea	N.A.	N.A.
Republic of Moldova	NO	NO
Romania	NO	NO
Russian Federation	YES	NO
Saint Kitts and Nevis	YES	NO
Sao Tome and Principe	YES	YES
Serbia	YES	NO
Singapore	YES	NO
South Africa	NO	YES

Responding countries/Regional IP offices	5. A letter of consent should meet formal requirements such as:	
	(a) a mandatory content	(b) an Office form
Spain	NO	NO
Sudan	YES	
Sweden	YES	NO
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
Uruguay	N.A.	N.A.
Uzbekistan	YES	YES
Viet Nam	YES	NO
Yemen	YES	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.	N.A.

**AUSTRIA:** The parties are free to negotiate the content of such kind of letters of consent or written agreements. There are no mandatory contents. Nevertheless, the will of the parties regarding the consent of use and/or allowance of registration of a later trademark should be clear.

**RUSSIAN FEDERATION:** Letters of consent are drafted in free written form and submitted in original to be attached to the application file. The document should contain the following data: (1) complete details of the person giving his or her consent to the registration of a trademark, allowing to identify him or her as a right holder of an opposed trademark (name, place of residence or location); (2) complete details of the person receiving the consent to register the claimed sign as a trademark allowing to identify this person as an applicant (name, place of residence or location); (3) consent to the registration of a claimed sign as a trademark indicating the application number if assigned and description of the claimed sign with respect to which the consent to registration as a trademark is given along with the attached claimed sign; (4) specific list of goods/services regarding which the right holder does not object to registration of the similar trademark; (5) date of compilation of the document and signature of an authorized person. The letter of consent could also contain other information, which is taken into consideration during the examination of a claimed sign.

Responding countries/Regional IP offices	6. A letter of consent could be admissible only for a specific period of time
Algeria	NO
Antigua and Barbuda	
Argentina	NO
Australia	NO
Austria	N.A.
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
Chile	NO
China	NO
Colombia	NO
Croatia	N.A.
Cuba	NO
Cyprus	NO
Czech Republic	NO
Denmark	NO
Dominican Republic	YES
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
Peru	NO
Philippines	N.A.
Poland	YES
Portugal	NO
Republic of Korea	N.A.
Republic of Moldova	NO
Romania	NO
Russian Federation	NO
Saint Kitts and Nevis	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO

Responding countries/Regional IP offices	6. A letter of consent could be admissible only for a specific period of time
Sudan	YES
Sweden	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
Uruguay	NO
Uzbekistan	NO
Viet Nam	NO
Yemen	YES
BOIP (Benelux Organization for Intellectual Property)	N.A.

AZERBAIJAN: Under the Madrid System, a letter of consent might be submitted in writing at any time by the prior right holder even when no contradiction has been raised during the examination procedure.

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
Antigua and Barbuda	
Argentina	NO
Australia	NO
Austria	NO
Azerbaijan	YES
Bangladesh	YES
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
Chile	NO
China	N.A.
Colombia	NO
Croatia	N.A.
Cuba	N.A.
Cyprus	NO
Czech Republic	NO
Denmark	NO
Dominican Republic	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
Peru	YES
Philippines	N.A.
Poland	YES
Portugal	NO
Republic of Korea	N.A.
Republic of Moldova	NO
Romania	NO
Russian Federation	NO
Saint Kitts and Nevis	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO

Responding countries/Regional IP offices	7. There are restrictions to transfer a trademark which was granted on the basis of a letter of consent
Sudan	NO
Sweden	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
Uruguay	N.A.
Uzbekistan	NO
Viet Nam	YES
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

AUSTRIA: In the case of a request of the recordal of a change in ownership of a trademark the Austrian Patent Office has no right to examine whether the use of a transferred trademark would be a breach of the letter of consent to the previous owner. Therefore, the Austrian Patent Office could not refuse a request for the recordal of a change in ownership even if it would be obvious that the assignee has no (derived) right for the use of the transferred later trademark in the case that the use of the transferred trademark would infringe an earlier trademark right.



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
Antigua and Barbuda		
Argentina	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
Chile	NO	NO
China	N.A.	N.A.
Colombia	NO	NO
Croatia	N.A.	N.A.
Cuba	NO	N.A.
Cyprus	NO	NO
Czech Republic	YES	NO
Denmark	NO	N.A.
Dominican Republic	NO	NO
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.
Peru	NO	
Philippines	N.A.	N.A.
Poland	YES	NO
Portugal	NO	N.A.
Republic of Korea	N.A.	N.A.
Republic of Moldova	NO	
Romania	NO	NO
Russian Federation	NO	NO
Saint Kitts and Nevis	NO	N.A.
Sao Tome and Principe	YES	YES
Serbia	NO	NO
Singapore	NO	N.A.
South Africa	NO	N.A.
Spain	NO	NO

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
Sudan	NO	N.A.
Sweden	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
Uruguay	N.A.	N.A.
Uzbekistan	NO	NO
Viet Nam	N.A.	N.A.
Yemen	NO	N.A.
BOIP (Benelux Organization for Intellectual Property)	N.A.	N.A.

SERBIA: If the owner of the earlier mark decides at a later stage to withdraw the consent and asks for the cancellation of the mark, the Office would refuse the cancellation, since the withdrawal of consent is a new fact that did not exist at the time of granting the protection. A trademark could only be cancelled when the legal conditions for protection were not fulfilled at the time of registration.

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
Antigua and Barbuda	N.A.
Argentina	NO
Australia	NO
Austria	N.A.
Azerbaijan	NO
Bangladesh	
Bosnia and Herzegovina	NO
Brazil	NO
Bulgaria	NO
Chile	NO
China	N.A.
Colombia	NO
Croatia	N.A.
Cuba	NO
Cyprus	NO
Czech Republic	NO
Denmark	NO
Dominican Republic	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
Peru	NO
Philippines	N.A.
Poland	NO
Portugal	NO
Republic of Korea	N.A.
Republic of Moldova	NO
Romania	NO
Russian Federation	NO
Saint Kitts and Nevis	NO
Sao Tome and Principe	YES
Serbia	NO
Singapore	NO
South Africa	NO
Spain	NO

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
Sudan	NO
Sweden	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
Uruguay	N.A.
Uzbekistan	NO
Viet Nam	NO
Yemen	NO
BOIP (Benelux Organization for Intellectual Property)	N.A.

## Q10. Other remarks concerning letters of consent\* .

AUSTRIA: Letters of consent may play an important role in post registration cancellation procedures. The scope and the content of such written agreements concerning the consent to the use of a later trademark could be a crucial factor for the outcome of a decision of the competent Civil Court or the Cancellation Department of the Austrian Patent Office.

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 the 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.

The confirmation of consent of the right holder for the registration of a claimed sign should be submitted in Russian or another language. If it is submitted in another language, a duly certified translation into Russian should be attached. 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 does it have the right to not 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 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)

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	68	46	68%	11	16%	11	16%
	(b) an opposition to a trademark registration based on an earlier registered trademark	68	41	60%	14	21%	13	19%
	(c) a request for invalidation or cancellation of a trademark registration based on an earlier registered trademark	68	35	51%	16	24%	17	25%
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		68	34	50%	24	35%	10	15%
3. A letter of consent regarding identical marks for identical goods or services is acceptable		67	29	43.3%	33	49.2%	5	7.5%
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		67	35	52%	16	24%	16	24%
5. A letter of consent should meet formal requirements such as:	(a) a mandatory content	67	30	45%	25	37%	12	18%
	(b) an Office form	65	6	9%	46	71%	13	20%
6. A letter of consent could be admissible only for a specific period of time		67	10	15%	45	67%	12	18%
7. There are restrictions to transfer a trademark which was granted on the basis of a letter of consent		67	8	12%	44	66%	15	22%
8. It is possible to withdraw a letter of consent after a trademark was granted on that basis		67	7	10.4%	45	67.2%	15	22.4%
8(a). Withdrawal causes the registration to lapse		62	6	9.7%	24	38.7%	32	51.6%
9. The presentation of a copy of the letter of consent is required for the renewal of a trademark registration granted on that basis		67	2	3%	51	76%	14	21%

[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 issues covered by the questionnaire.