

2025 FICPI Symposium

Jeju Korea



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN





FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Sponsor of the
FICPI Korean Symposium

PRACTICE TOPIC 4

Availability of a letter of consent and potential risk for concurrent use of a similar trade mark under a co-existence agreement



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

4 April 2025
16:00-17:30

Moderator:

Ho-Hyun NAHM

Lead Partner

BARUN IP & LAW

email: hh-nahm@barunip.com; website: barunip.com

Republic of Korea



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

BARUN
IP & LAW

Introduction

MODERATOR

Mr. Ho-Hyun NAHM

Partner, Barun IP & LAW (KR)

- Lead Partner at BARUN IP & LAW, Seoul – **40 years of experience** in intellectual property
- **Former President:** APAA Korean Group, FICPI Korean Group, Intellectual Property Forum
- Chairman, Korea Internet Dispute Resolution Committee (KIDRC)
- Former **Member, Presidential Council** on State Science & Technology, Republic of Korea
- Specializes in trademarks, patents, designs, licensing, and domain name disputes
- Represented globally renowned clients:

Hardy Amies, Nike, Jimmy Choo, Lady Gaga, Studio Ghibli,

Supercell Oy, Bayer, Hyundai Motor Company, Accor Hotels



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea



Introduction

MODERATOR

Mr. Ho-Hyun NAHM

Partner, Barun IP & LAW (KR)

- Rendered over 1,500 arbitration decisions
- Lectured in the IP CEO Program at Seoul National University and at Handong International Law School
- Served as a visiting professor, delivering lectures at the Korean National Police University and Sookmyung Women's University
- Speaker at over 70 international and domestic IP conferences
- Author of 8 bestselling books on intellectual property
- Contributor to *INTA Opposition Guide* and *INTA Enforcement Guide*
- Host of the TV program *Ho-Hyun Nahm's Fun Anecdotes of Patents*
- Holds an MPA from Seoul National University and an LL.B. from Chungju University
- Visionary IP leader advancing innovation and global standards in IP practice



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea



Session Introduction

Practice Topic 4“Availability of a Letter of Consent and Potential Risks of Concurrent Use of Similar Trade Marks under a Co-Existence Agreement”

- Good afternoon!
- It is my honor to moderate this session on a topic that is both practical and complex.
- As trademark practitioners, we face increasing challenges in clearing marks amidst a flood of prior filings.
- In this context, letters of consent offer a solution—but not without risk.



2025 FICPI Symposium
JeJu Korea
2-5 April, 2025 Jeju, Korea



Session Introduction

Opportunity vs. Risk

✓ Why Letters of Consent Matter:

- Conventional arguments (e.g., non-use or dissimilarity) often fall short
- Letters of consent can facilitate coexistence

⚠ But Risks Abound:

- Dilution and consumer confusion
- Possible invalidation of registrations
- Strategic and legal dilemmas for both parties

Let us explore how far coexistence can go—and at what cost.



2025 FICPI Symposium
JeJu Korea
2-5 April, 2025 Jeju, Korea

BARUN
IP & LAW

Session Introduction

Our Speakers and Jurisdictions

We are joined by four distinguished experts:

- **Esther Seow**

→ Singapore, Australia, NZ, Japan, China

- **Professor Won-oh Kim**

→ Korea

- **Anna King**

→ United States, Canada, Latin America

- **Ana de Sampaio**

→ EU, UK, Poland, other European countries

Each will share jurisdiction-specific insights on the structure, availability, and risks of consent-based coexistence.



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea

B A R U N
I P S L A W

Session Introduction

Risks and Complexities

- Coexistence through consent is **not without risks**:
 - Dilution of distinctiveness
 - Consumer confusion
 - Potential cancellation of registrations
- Strategic and legal implications for both prior and new rights holders.



2025 FICPI Symposium
JeJu Korea
2-5 April, 2025 Jeju, Korea

B A R U N
I P S L A W

Session Introduction

Key Issues to Be Addressed (1/2)

- **Availability** and legal basis of letter-of-consent systems
- Nature of consent: **irrevocable vs. conditional**
- **Territorial limitations** and jurisdictional contrasts(e.g., U.S. vs. EU; Japan's proactive measures requirement)
- **Legal effect and enforceability** of consent-based registrations
- **Prevention of consumer confusion** and parties' obligations



2025 FICPI Symposium
JeJu Korea
2-5 April, 2025 Jeju, Korea



Session Introduction

Key Issues to Be Addressed (2/2)

- Timing and proper form of consent (unilateral vs. contractual)
- Handling defective or ambiguous letters of consent
- Revocation of consent and its implications
- Assignability and scope of rights in coexistence arrangements
- Practical considerations and drafting cautions for practitioners



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea

B A R U N
I P S L A W

Session Introduction

Session Format & Closing

- Each speaker: **15 minutes**
- Q&A after all presentations
- Please hold questions until the end
- Let's begin a practical exploration into the strategic use—and limitations—of trademark coexistence through consent. Thank you!



2025 FICPI Symposium
JeJu Korea
2-5 April, 2025 Jeju, Korea



Esther Seow

Partner

Davies Collison Cave

Singapore



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



Introduction

SPEAKER

Ms. Esther SEOW

Partner, Davies Collison Cave (SG)

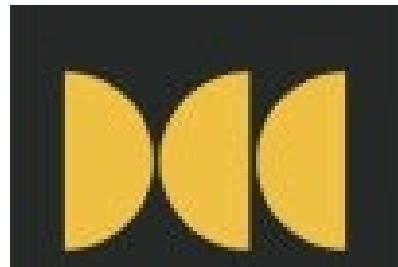
- 20+ years of experience in IP law in Singapore and Malaysia
- Advocate & Solicitor in SG, MY, and member of the Inner Temple (UK)
- Registered Patent, TM & Design Agent (Malaysia)
- Advises on TM protection, enforcement, franchising & licensing, NDAs
- Ranked by WTR 1000 for Prosecution & Strategy (2022–2024)
- Council Member, Institute of Singapore Trademark Agents (ISTMA)
- Executive Committee, APAA Singapore Group
- Committee member, INTA Unreal Campaign
- Member, AIPPI (Singapore Group)



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea



CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

4 APRIL 2025

Esther Seow

Principal
Davies Collison Cave

PREPARED BY

Esther Seow

DATE

4 April 2025

AGENDA

1. Availability of Consent System in ASEAN and other countries in Asia
2. Singapore
3. Australia and New Zealand
4. China
5. Japan
6. Letter of Consent vs Coexistence Agreement
7. Potential risks of granting consent
8. What are the considerations and cautionary measures for utilizing the letter of consent

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

AVAILABILITY OF CONSENT SYSTEM

AVAILABILITY OF CONSENT SYSTEM IN ASEAN

Country	
Cambodia	O
Indonesia	X
Laos	O
Malaysia	✓
Philippines	O
Singapore	✓
Thailand	X * Assignment back
Vietnam	O
Myanmar	X

AVAILABILITY OF CONSENT SYSTEM IN OTHER COUNTRIES IN ASIA

Country	
Australia	✓
China	✓
Hong Kong	✓
India	✓
Japan	✓
New Zealand	✓
South Korea	✓
Taiwan	✓

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

Singapore



Consent system in Singapore

- Trade Marks Act provides that the Registrar may (at his/her discretion) register a Filed Mark where the proprietor of the Prior Mark or earlier right consents to the registration
- Exception – the Registrar may reject a LOC where there is an overriding policy reason.
- Could use to overcome relative grounds (e.g. prior marks, well known marks, GI, Certification marks, Collective marks)
- Can be submitted during prosecution, refusals, opposition, appeal, invalidation.
- LOC should not contain any conditions.
- LOC should be signed by the proprietor/authorized representative
- A statement unequivocally indicate that consent to the registration of the mark is given
- The representation, details of the marks, good and/or services should be specified
- LOC cannot be withdrawn in Singapore
- Sensitive information can be redacted, depending on the specific case

Note: the consent system in Malaysia is fairly similar to Singapore, except there is no restrictions as to the timing of withdrawal of the consent.

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

Australia & New Zealand



Consent system in Australia & New Zealand

- Trade Marks Acts in both AU and NZ provide LOC system for trade mark coexistence.
- Could use to overcome relative grounds (e.g. prior marks, well known marks, Certification marks for both AU & NZ; Collective marks and GI for NZ only).
- Can be submitted during prosecution, overcoming refusals.
- LOC must be unconditional.
- LOC/Coexistence agreement should be signed by the proprietor/authorized representative
- The images, details of the marks, good and/or services should be specified.
- Not possible to withdraw once LOC is submitted.

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN



CHINA



Consent system in China

- Trade Mark Office can refuse to accept LOC/Coexistence agreement if the marks in concern are considered confusingly similar, in fact in most administrative cases.
- Would be helpful in defending an infringement claim from the counter party who issues/signed the LOC/Coexistence agreement.
- Can be submitted in the procedures of various trade mark administrative and disputed cases.
- LOC with conditions is not acceptable in administrative cases.
- LOC/Coexistence agreement needs to be notarized and legalized.
- The images, details of the marks, good and/or services should be specified.
- LOC submitted cannot be withdrawn.
- Sensitive information can be redacted, depending on the specific case

CASE STUDY 1

Google's Mark (Class 9 – hand-held computers and portable computers)	Cited mark owned by Shimano Inc. (Class 9 – computers for bicycles)
	

In 2016, the Supreme People's Court (SPC) ruled that the word marks composed of identical letters may coexist.

Note: this is a rare decision, and no similar cases of approving the coexistence of 2 pretty much identical marks have been seen in recent years.

CASE STUDY 2

IR. 1605753 Mark
(Class 12 – Dump trucks for use
in mining and for hard rock
loading and hauling for
constructions purposes)

TORO 

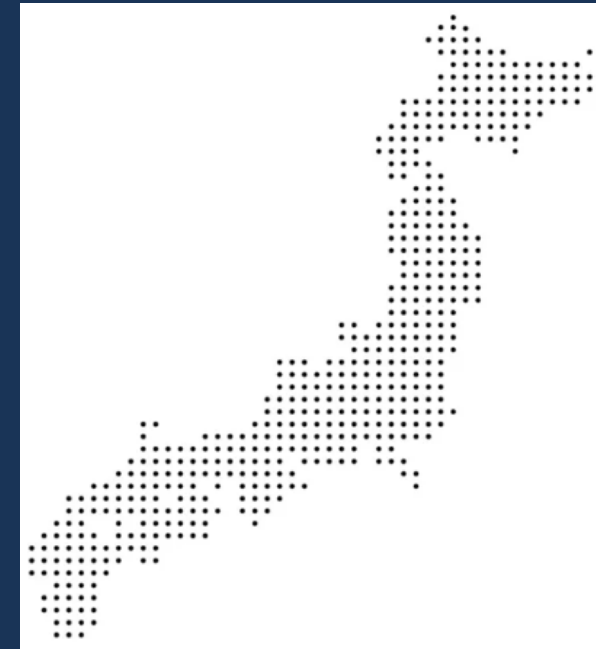
Cited mark
(Class 12 – Vehicles, namely,
trucks, multi-purpose utility
vehicles, lawn and garden
tractors and structural parts of
the foregoing)

TORO

In 2023, the BIPC refused to accept the LOC obtained by the Cited Mark Owner, considering that the marks have identical letters and similar goods that may confuse the relevant public.

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

JAPAN



Consent system in Japan

- Letter of Consent came into effect on 1 April 2024.
- Japan Patent Office (“JPO”) has discretion to reject application even if a LOC is obtained if the Examiner believes that there is a likelihood of confusion.
- Written consent and materials that demonstrate that “there is no likelihood of confusion” are to be submitted.
- Could use to overcome relative grounds. However, JPO would not accept a LOC for identical mark with respect to the identical goods and/or services of the prior mark.
- Can be submitted during prosecution, overcoming refusals until the decision to grant to registration. As Japan adopts the post-registration opposition system, thus, LOC is NOT allowed to submit in opposition proceedings.
- LOC must be without limitations on the consent period or regions.
- No physical signature or company seal is generally required. However, JPO may require it when the existence or authenticity of the original is in doubt. The images, details of the marks, good and/or services should be specified.
- No provision but a LOC cannot be withdrawn after registrations.

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

LETTER OF CONSENT VS COEXISTENCE AGREEMENT

Letter of Consent	Coexistence Agreement
Simple and quick	Take longer time to conclude
Less costly	More costly (time and resources to draft)
Limited to the use and registration of the mark in concerned	Detailing issues important to both parties
	Could address potential risks in the future, e.g. if business intends to expand into new jurisdictions, scope of goods/services, industries, etc.

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

POTENTIAL RISKS OF GRANTING CONSENT

Potential risks

- Coexistence of identical/similar marks may dilute the marks in the marketplace
- Potential future conflicts
- Potential loss of commercial flexibility
- Potential loss and/or limitation of existing trade mark registrations
- Restrict use and registration of a mark
- Risk of potential infringement claim raised by the prior mark owner
- Risks of confusion to the consumer or public

RISK OF CANCELLATION/INVALIDATION IN ASEAN

Q: Can a Mark registered based on LOC be cancelled/invalidated in view of relative grounds?

Country	
Cambodia	✓
Indonesia	✓
Laos	✓
Malaysia	✓
Philippines	✓
Singapore	✓
Thailand	✓
Vietnam	✓
Myanmar	0

RISK OF CANCELLATION/INVALIDATION IN **OTHER COUNTRIES IN ASIA**

Q: Can a Mark registered based on LOC be cancelled/invalidated in view of relative grounds?

Country	
Australia	✓
China	✓
Hong Kong	✓
India	✓
Japan	✓
New Zealand	✓
South Korea	✓
Taiwan	✓

CONSENT SYSTEM IN ASEAN, CHINA, JAPAN

PRACTICAL CONSIDERATIONS AND MEASURES

Practical consideration and measures

- Whether parties are operating in different geographical areas
- Whether parties' target consumers are different
- To avoid rebranding, if possible
- Prevent future conflicts
- Extent of the parties' rights and limitations
- Non-challenge / non-objection provision to the use or registration of the marks
- To cover future expansion of the scope of goods and/or services, jurisdictions
- Whether parties could transfer the agreement to a third party
- Duration and renewal of the coexistence agreements
- Termination and breach of coexistence agreements



Esther Seow

Principal, Singapore

eseow@dcc.com

WonOh KIM

Director of Law Research
Institute and AI-Data Law
Center

Inha University

Republic of Korea



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



INHA UNIVERSITY

Introduction

SPEAKER

Prof. Won-Oh Kim

Professor of Intellectual Property Law, Inha University

Education

- LL.B., LL.M. (International Law), Ph.D. (IP Law), Korea University

Career Highlights

- Patent Attorney (since 1993)
- Former Deputy Director, Myung-shin Int'l Patent & Law Firm
- Former Professor, Sookmyung Women's University
- Full Professor, Inha University Graduate School of Law (2013–present)
- Director, Law Research Institute & Head, AI·Data Law Center



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea



INHA UNIVERSITY

Introduction

SPEAKER

Prof. Won-Oh Kim

Professor of Intellectual Property Law, Inha University

Key Activities

- President, Korea Intellectual Property Forum (current)
- Advisor, Korea Intellectual Property Society
- Chairman, KIPO Idea System Improvement Council
- Former President, Korean Intellectual Property Society & Korean Trademark Society
- Member of various national IP policy committees

Publications

- *Trademark Law* (2006), *Patent Law* (2009)
- *Data Law* (2021), *AI Law* (2023) — Representative Co-author



2025 FICPI Symposium
JeJu Korea

2-5 April, 2025 Jeju, Korea



INHA UNIVERSITY

Key Issues in Korea's Trademark Coexistence Agreement System

FICPI Korea Symposium
April 4, 2025

Director of the Center for AI Data Law at
Inha University Law School
Professor **Won-Oh Kim**

WIPO Questionnaires on Letters of Consent (document SCT/22/5)

Questions	
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
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	
3. A letter of consent regarding identical marks for identical goods or services is acceptable	
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	

5. A letter of consent should meet formal requirements such as:	(a) a mandatory content
	(b) an Office form
6. A letter of consent could be admissible only for a specific period of time	
7. There are restrictions to transfer a trademark which was granted on the basis of a letter of consent	
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	
9. The presentation of a copy of the letter of consent is required for the renewal of a trademark registration granted on that basis	

Table of Contents



I . Background and Current Status of Korea's Coexistence Consent System

II. Basic Features of the Korean Coexistence Consent System

III. Principles and Exceptions to the Coexistence Consent System

IV. Operational Features of the Korean Consent System

V. Practical issues and caveats

VI. Future System Improvements

I-1. Korea's Coexistence Consent System

- ◆ Korea's coexistence agreement system for trade marks has been active **since May 1, 2024**,
 - ◆ aimed at reducing disputes and broadening trademark options.
- The primary focus is to address conflicts outlined in Article 34(1)(7) and Article 35(1) of the Trademark Law.
 - In the initial eight months, 845 coexistence consent Applications were received, indicating early success. (Ref. next sheet)
 - However, as the system is still new, it will undergo significant trial and error regarding legal details and examination standards, with more applications and case law expected to develop over time.

Article 34 (Trademarks Ineligible for Trademark Registration)

7. Any trademark used on goods identical or similar to the designated goods, which is identical or similar to a registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file: **Provided, That where the consent of such another person has been obtained for the registration of the trademark (excluding the case where such consent has been obtained for a trademark that is the same trademark and is used on goods identical to the designated goods), trademark registration may be obtained;**

Article 35 (First-to-File)

Trademark Coexistence Agreement Overview and Usage

- Number of trademark coexistence agreements received: **845 in total (as of 12/31/24)**

	Personal	Small and medium-sized businesses	Midsize Businesses	Large enterprises	Foreign companies	Other*
Number of cases	108	421	103	92	112	9

*(Other) Municipalities, nonprofits, etc.

- Applicant criteria: Individual, Small Business, Medium Business, Large Business, International

Steps	Pending review (Comments submitted, not received, pending, etc.)	Publication	Decision to register	Judgment phase*	Other**
Number of cases	337	148	315	12	33

(Trial stage) 12 cases submitted a coexistence agreement at the appeal stage of the rejection decision

** (Other) Withdrawal, appeal, etc.

Background on adoption consent system

- ◆ **Previously**, the **Korean Trademark Act** strictly excluded late-filed trademarks conflicting with prior ones from registration, even if the prior trademark holder consented.
- The **Supreme Court's stance also** did not consider the consent of the trademark owner regarding the cited trademark.
- To address these refusals, attempts were made to **partially transfer** similar registered trademarks or rights, mimicking a trademark coexistence agreement or employing "**assign-back**."
- This approach created **challenges**, including **difficulties in managing trademarks** across affiliated groups and issues with affiliate trademark usage fees, leading to claims of Fair Trade Act violations.

The utility of trademark consent system

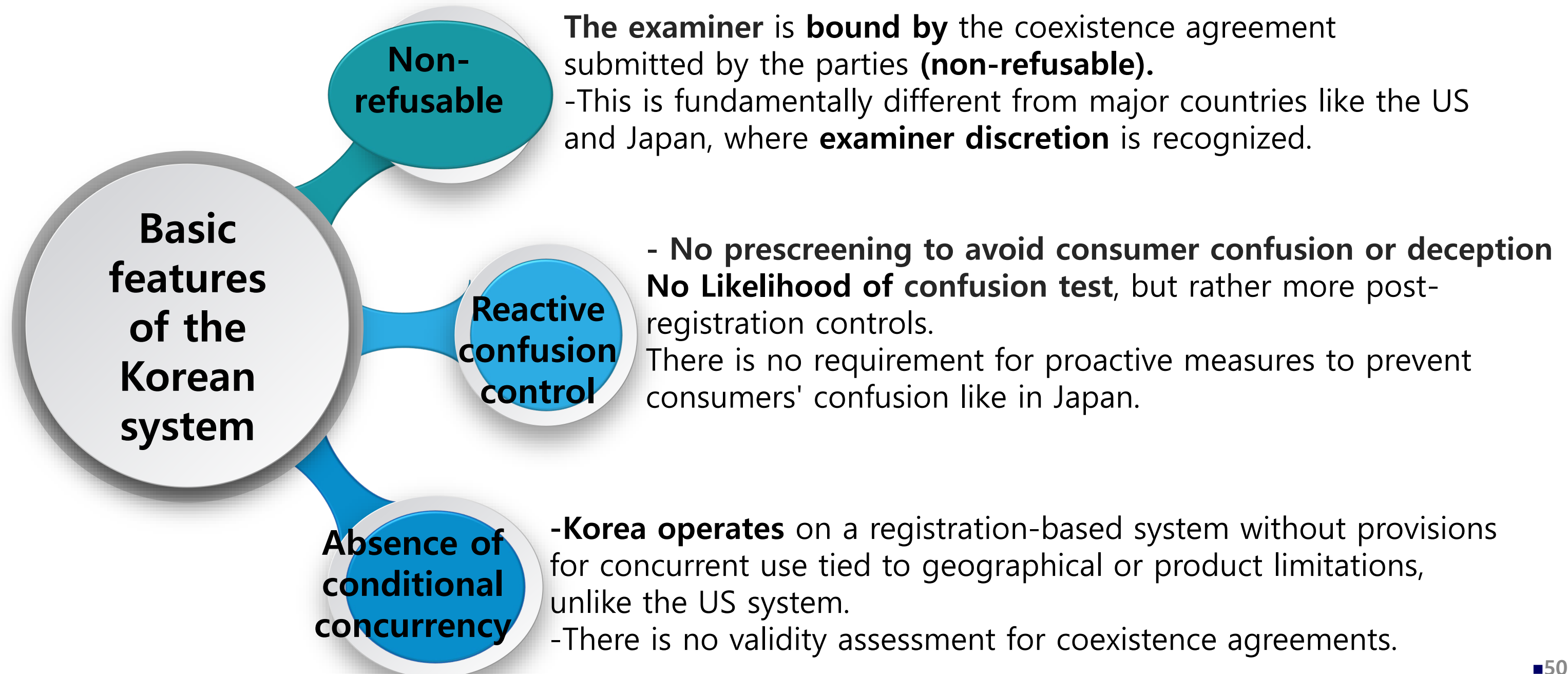
[pros]

It eliminates many of the limitations of workaround methods such as temporary assignment(assign-back) or divisional transfer of trademark rights when a later application is rejected for being identical or similar to a prior trademark.

At the same time, there are advantages for large companies that share the gist of their trademarks to multiply the efficiency of trademark management at the group level.

[cons] On the other hand, it is weak on consumer protection and could diminish the role of trademark law as a competition law.

II-1. Characteristics of the Korean Coexistence System



Features of the Korean system

1. NO examiner discretion.

The trademark coexistence agreement system in Korea is strictly governed by the agreements submitted by the involved parties. This contrasts sharply with the approaches of major nations like the United States and Japan, which allow for examiner discretion.

2.Enhanced post-registration management: Rather than addressing potential source confusion prior to registration, this system focuses on strengthening management measures after a trademark has been registered. Unlike Japan, there is no obligation to implement preventive strategies to avert confusion.

3.Characteristics of a registration-based country: South Korea operates as a registrationist nation and does not utilize a system reliant on geographic restrictions, such as the concurrent use system in the United States.

4.It is also compared to the EU's framework, which treats the infringement of an existing trademark as a relative basis for non-registration and permits coexistence without an agreement unless an opposition is raised.

These characteristics make Korea's trademark coexistence agreement system distinctive and highlight.

The necessity for ongoing attention and enhancements is required in the future management and evolution of the system.

Comparing the Korean system to other examples

Category	Examiner Discretion	Pre-Confusion Audit	Applied to well-known Trademarks	Submission Period	Applied to the same trademark
USA	Yes	Yes	Yes	React for OA	Yes
EU	Relative reasons for rejection	By opposition procedures	Yes	NO need	Yes
JAPAN	Yes	Yes	Yes	React for OA	Yes
New Zealand	NO	NO	Yes	12Month from application	Yes
KOREA	NO	NO	NO	pending	NO

Table of Contents



I . Background and Current Status of Korea's Coexistence Consent System

II. Basic Features of the Korean Coexistence Consent System

III. Principles and Exceptions to the Coexistence Consent System

IV. Operational Features of the Korean Consent System

V. Practical issues and caveats

VI. Future System Improvements

Overview of consent system principles and exceptions

Principles

Only between entities using similar marks in violation of Article 34 (1) (7) & Article 35 (1) of the Trademark Act

Exception

- ✓ To the same mark for identical goods not applicable
 - ✓ Special Mark Exceptions
 - ✓ Conditional vs. broad consent disallowance

- ◆ **Principle:** Korea's "trademark coexistence consent system" only applies to prior holder and later-applicant of similar trademarks that violate **Article 34(1)(7) of the Trademark Act ("Conflict with an early Registered Trademark")** and **Article 35(1) (First-to-File)**.
- ◆ Individuals and **entities, whether or not** they are affiliated with the same company.
- ◆ It is more of a co-existence **agreement** between the senior and junior trademark owners than a unilateral consent.

Exceptions (1)

1) It does **not** apply to **the identical trademark** used for the identical **goods**. This is because there is a high risk of damage caused by misidentification and confusion of the source of goods by consumers (Art §34①7, Article 35 ①).

2) **Grounds for Rejection (Item 9, 10, 12, and 13)**, which are premised on the **fame** of the prior trademark and the **unfair competition intent** of the user of the trailing trademark, **cannot be overcome** by a coexistence agreement.

Exceptions for Special marks

- ❖ The Korean Trademark Examination Guidelines additionally address marks that do not have a coexistence agreement.
- ❖ First of all, identical or similar marks **of geographical indications and collective marks** are not covered by the coexistence agreement, as they fall under the grounds for refusal in § 34①8 of the Act.
- ❖ **Applications for collective marks(with geographical indication) certification marks (with geographical indication) , and business emblem** do not meet the purpose of the coexistence agreement because the nature of the marks is such that transfer and establishment of licenses are strictly limited, and therefore, in principle, the coexistence agreement does not apply.

Exceptions (3): Conditional and broad consent disallowed

- **Conditional coexistence agreements**, which include time and geographical limitations or partial exclusions, are not acknowledged.
- When dealing with multiple trademarks and blanket coexistence agreements, you must provide **all** registration numbers of prior or subsequently filed trademarks and secure agreements from all rights holders.
- **Blanket agreements**, such as "I agree to the coexistence of **all** trademarks in the application, including main part A," are also not recognized.

Table of Contents

I . Background and Current Status of Korea's Coexistence Consent System

II. Basic Features of the Korean Coexistence Consent System

III. Principles and Exceptions to the Coexistence Consent System

IV. Operational Features of the Korean Consent System

V. Practical issues and caveats

VI. Future System Improvements



IV. Overview of the Korean system's operational features

1. Obtain trademark rights of equivalent effect

If a trademark is registered under a coexistence agreement, **there is no difference in effectiveness** compared to a regular registered trademark.

2. Reactive duty to avoid confusion.

It imposes a reactive obligation instead of a proactive duty to avoid confusion, which is subject to cancellation review in the event of post-registration confusion.

3. No right to claim to avoid confusion

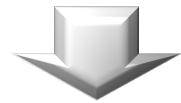
It does not recognize a separate "right to claim for avoiding confusion" for a trademark holders.

4. Exceptions to trademark coverage

The scope of refusals that can be overcome by consent is narrow, and as a matter of law, refusals that violate well-known trademark (Item 9) cannot be overcome.

IV-2. System Operational Features(1)

1. A trademark registered under a coexistence agreement has no difference in effectiveness compared to an ordinary registered trademark.



The validity of trademark rights (Articles 89, 108(1)(1)), claims of non-infringement (Article 107), and trials confirming the scope of rights (Article 121) as well as applications for renewal (Article 84) are important.

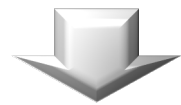
If a trademark is registered under a coexistence agreement and is renewed, submitting the agreement again is unnecessary.

Nonetheless, there should be limitations on the transfer and licensing of registered trademark rights.



IV-2. System Operational Features(2)

2. Imposing a reactive duty instead of a proactive duty to avoid confusion, resulting in post-registration confusion, subject to cancellation trial review.



A trademark holder registered under a coexistence agreement, or one of the elected trademark holders who has given a coexistence agreement, may be able to use their trademark's

By using its registered trademark for the purpose of unfair competition for the same or similar goods as the designated goods, the trademark holder may cause the consumer to believe that the goods

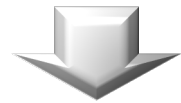
Anyone who causes confusion as to the quality of the goods, or causes confusion with goods related to the work of others, may file a complaint with the Patent Trial and Appeal Board.

A trademark registration may be canceled by filing a trademark cancellation trial. (Art. §119①5-2)



IV-2. System Operational Features(3)

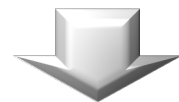
3. Does not recognize the "right to claim for avoiding confusion" for a trademark holders.



South Korea's "non-refusable" coexistence agreement, made it even more necessary to confer the Right. There is no separate right of action for a trademark holder to prevent confusion caused by the other trademark holder.

Unlike in Japan, there is no explicit provision that recognizes a right of action for preventing confusion. so it cannot be claimed and must rely on other sanctions, such as cancellation trials.

The need for its adoption is controversial, and a legislative review is warranted.



IV-2. System Operational Features(4)

4. The range of objections that can be overcome with consent is narrow.



1. Korea's 'Trademark Coexistence Agreement System' applies **only to refusals** under **Article 34 (1) (7)** and **Article 35 (1)** of the **Trademark Act**. If the cited mark is a well-known trademark, multiple reasons for refusal may be invoked.
2. The examination of a later-filed trademark can have several refusal grounds if the cited trademark is renowned, including those under Article 34(1)(9), and Item 11 to 13.
3. The applicant must submit a trademark coexistence agreement to adhere to Articles 34 (1) (7) and 35 (1) of the Trademark Act and clarify their position regarding any additional applicable rules that could affect the refusal basis.

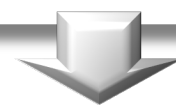


Table of Contents



I . Background and Current Status of Korea's Coexistence Consent System

II. Basic Features of the Korean Coexistence Consent System

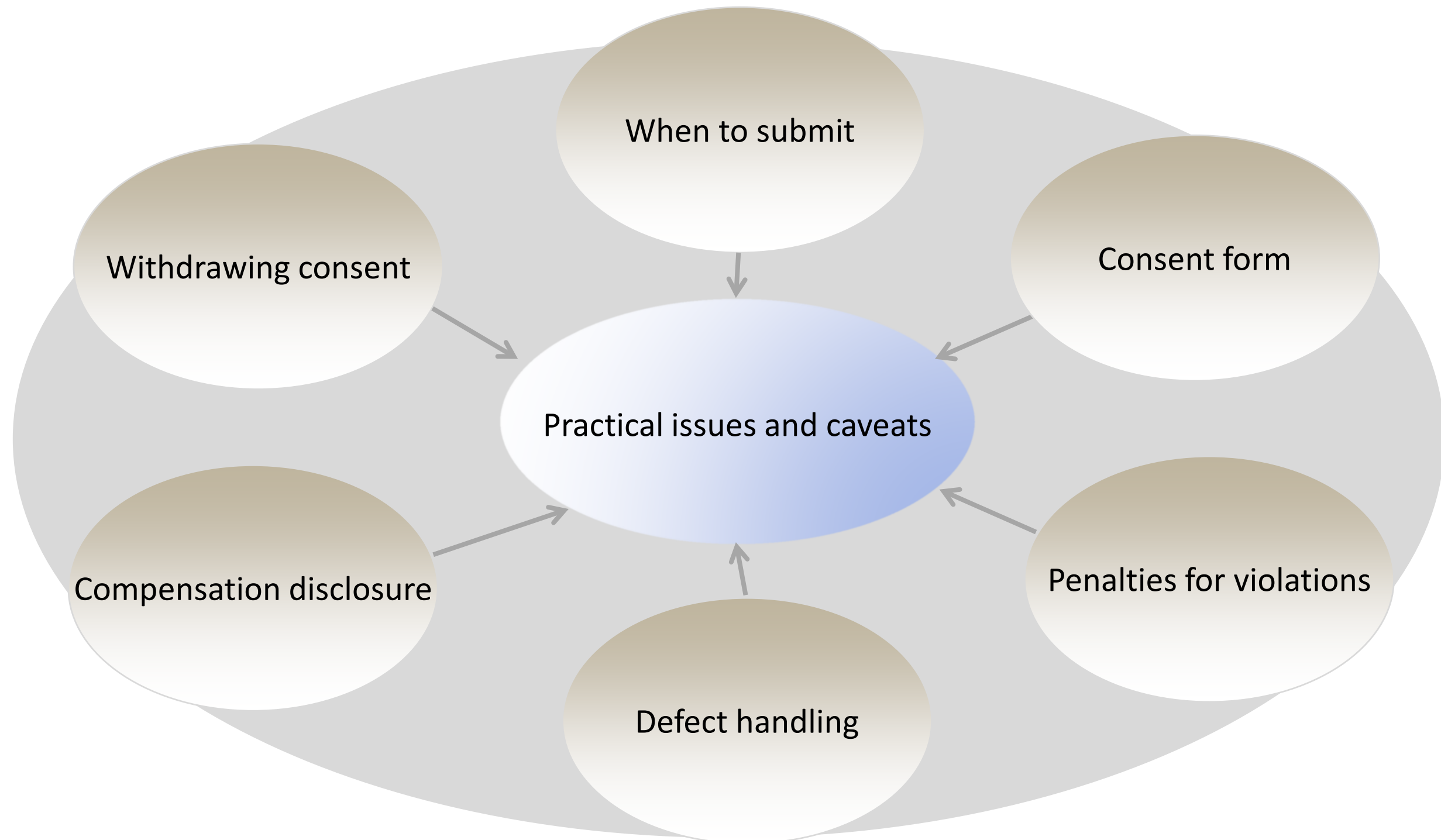
III. Principles and Exceptions to the Coexistence Consent System

IV. Operational Features of the Korean Consent System

V. Practical issues and caveats

VI. Future System Improvements

V-1. Practical Issues and Caveats



When to submit consent

- ❑ The 'Trademark Implementing Rules' have clear rules on when to file. Usually at the same time as the trademark application or at the time of submitting an opinion to overcome the reasons for refusal.

According to **Article 26(2) of the Implementing Rules**, consent submission must comply with the latter part of Article 55(1) and Article 87(2) of the Act.

When providing reasons for refusal or responding to an opposition under Article 66(1), submissions can still be attached **during the correction period** specified in Article 26, Paragraph 2.

However, there are discussion that **it is impossible** submitting a coexistence agreement **post trademark registration**.

The Implementing Rules **allow** submissions **during the appeals process**, including requests for appeal of refusals under Article 116, although there is no specific rule, **simultaneous submissions with the application** are accepted.

Consent forms and supporting documentation

(i) As a mandatory part of the coexistence agreement, first **identify the trademark application** that is the subject of the coexistence agreement.

Specificity is requested. The **application number** is usually provided, or if you don't already have an application number, you **can list** the applicant, the trademark (mark), and the designated goods for which you consent to registration.

(ii) **Secondly**, the coexistence agreement must **detail its content**. An example from the Patent Office states: "The following pre-registered (elective) trademark holder is the applicant OOO, I agree to use it," along with your patent account number, co-consent statement, or the names of both the trademark holder and the consenting party specific to the trademark. Ensure the agreement is signed (sealed) and attach proof of seal when sealing.

Handling defective consent forms

- ❑ **Submissions of coexistence agreements with correctable defects are treated differently before and after the notice of opinion is sent.**

If a defect exists in the attached coexistence agreement **prior to sending the notice of opinion**, it can be rectified according to § 34①7 of the Act.

When issuing a notice of comments under §35①, it must also inform about any defects in the coexistence agreement.

After the notice for comments is dispatched, if the attached coexistence agreement is flawed or if the comment submission deadline has passed, the authority will issue a Notice of Intent to Deny if a valid coexistence agreement is not provided.

An unrecognized coexistence agreement will be treated as defective and managed **accordingly**.

Withdrawing consent and what it means

(i) The Coexistence Agreement is subject to negotiation and can be revoked by the Parties and the contract's invalidity (cancellation) may be acknowledged , **while a withdrawal by one party** and the contract's invalidity (cancellation) will **not be accepted**.

(ii) **Different Before and after** the registration decision.

Before the decision on the later application, the opinion, correction, informational letter, etc., are involved, **you assert and demonstrate** the invalidity of the coexistence agreement via withdrawal, the examiner will address it in the review.

While it can be noted, for legal stability, withdrawing the coexistence consent **post-registration** decision is not permitted. You may opt for an adjudication process or court ruling.

Compensation disclosure

(i) A trademark coexistence agreement can essentially function as a license agreement that partially transfers trademark rights. For the trademark holder, it is probable that this agreement will necessitate consideration(Compensation).

(ii) In a group of companies, the origin and use of the group's trademark, along with credit history, may lead to different considerations. These factors should be addressed in the parties' settlement agreement but may not be reflected in the trademark coexistence agreement submitted to the **Patent and Trademark Office, which does not require** specifying an "amount."

Validity and enforcement of coexistence agreements

The scope, duration, and enforceability of coexistence agreements, including sanctions for breach.

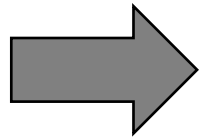
- ❖ **You cannot attach conditions** to a coexistence **agreement filed with the Patent Office**, but you **can attach any conditions** to a coexistence agreement that is valid **in civil court** between the parties.
- ❖ Therefore, **if you want to attach conditions** to the coexistence agreement, you can **create a separate agreement** to obligate yourself to terminate the trademark registration if a condition arises that allows you to revoke the agreement.
- ❖ If the violator fails to fulfill the obligation of deletion on their own, the registration can be deleted by a court decision **through a lawsuit**.
- ❖ If a reason for cancellation of the contract occurs after the trademark transfer contract or license agreement, it is the same as if it should be resolved by a court's final judgment for breach of contract.

V-2. Practical Notes

- **The Trademark Examination Guidelines briefly summarize the main practical issues discussed above as cautions.**
- ① If there are multiple pre-registered (applied for) trademarks falling under §34①7 and §35① of the Trademark Act, a coexistence agreement must be obtained from all pre-registered (applied for) trademark holders to resolve the reasons for refusal under §34①7 and §35① of the Act.
- ② The coexistence agreement can only be applied to **§34①7 and §35①** of the Act, and **not to other reasons for refusal**.
- ③ In the case of **identical date applications** (Act § 35②), the coexistence agreement system shall be applied after determining the priority right holder through consultation and lottery.
- ④ Since the coexistence agreement is a document to resolve the reasons for refusal under §34①7 and §35① of the Act, the coexistence agreement **shall not be applied** to the examination if the coexistence agreement is submitted for an application mark that **the examiner considers to be dissimilar**.

Cross-Trademark Coexistence Agreements

- From the prior trademark holder's perspective, it is preferable that the trademark coexistence agreement be a cross-over agreement, taking into account the future position of the prior trademark holder.



It may be required to get coexistence **consent from both** the senior trademark holder for the junior trademark and from the junior trademark holder for the senior holder's new application for a similar trademark after the junior trademark is registered.

- Therefore, **it is advisable to** ensure that the agreement is a true "Cross Trademark Co-existence Agreement" that includes **mutual consent** of both parties **to prevent future disputes**.

At the international/ overarching brand strategy level agreement

- 1) **Divided** into trademarks (signs), goods, and regions (countries), and organize each agreement by distinguishing between i) agreements on coexisting **registration** of trademarks and ii) agreements on **the use** of trademarks.
- 2) **Note that some countries** do not adopt the coexistence agreement system / some countries may refuse even if you submit an agreement / some countries require a sufficient explanation that there is no possibility of confusion in the coexistence agreement.
- 3) Keep in mind the solution in case of disputes over registration/use of trademarks (marks), goods, and regions (countries) **not agreed** upon in the coexistence agreement.
- 4) **Prioritize applications** in countries/commodity areas not covered by the agreement
- 5) The prior trademark holder should also have a "**mutual cross-existence agreement**" in place for the future.
- 6) Specify the main terms of the agreement, including the prohibition of transfer, and stipulate that the trademark registration shall be **voluntarily canceled** within some months from the date of receipt of the notice of violation of the coexistence agreement.

Table of Contents



I . Background and Current Status of Korea's Coexistence Consent System

II. Basic Features of the Korean Coexistence Consent System

III. Principles and Exceptions to the Coexistence Consent System

IV. Operational Features of the Korean Consent System

V. Practical issues and caveats

VI. Future System Improvements

Introduction of the right to claim for avoiding confusion

- ◆ Korea's irrevocable consent to a coexistence trademark system, unlike the reserved system used by many countries, necessitates careful management of consumer confusion arising from two trademarks coexisting.
- ✓ To address these issues, it may be beneficial to mandate the disclosure of trademark coexistence agreements during the original registration and to establish regulations for cancellation of trademark registrations thereafter.
- ✓ However, since consumers cannot access the registration ledger while buying products, consideration should be given to introducing a "**right to claim for avoiding confusion**" that allows the prior registrant to request that the later registrant make necessary changes to minimize consumer confusion during trademark use.

Transferability of registered trademarks through consent

- **Current trademark law allows** for the unrestricted transfer of a registered late-filed trademark to a third party under a coexistence agreement.
- **General succession**, particularly during **hostile M&A** involving a late-filed trademark holder, may lead to trademark transfers. It's advisable to secure written consent from prior rights holders for such assignments.

- The prohibition on transferring trademarks under coexistence agreements is **especially important within corporate groups** to protect trademark rights.
- **Legislation** should clarify the ban on transferring post-filing registered trademarks obtained through consent.
- **Even prior to legislation**, coexistence agreements **should specify a non-transfer provision**, including licensing, and state that violations will result in revocation of the agreement and voluntary termination of the trademark registration.

Including Item 9 as an objection that can be overcome

- The Korean Intellectual Property Office(KIPO) is seeking ways to function, considering other country's legislative examples that conflict with well-known trademark can be resolved through coexistence agreements.

➤In essence, the KIPO does **not cite both** violations of **Item7** (conflict with prior registered trademark) **and Item9** (conflict with well-known trademark) as grounds for refusal, **but only refers to Item 7.**

- It is beneficial **to clarify through legislation** that **Article 34(1)(9) of the Act** can also be overcome by consent.

Thanks.
oneofkim@inha.ac.kr

Anna KING

Partner
Banner & Witcoff
USA



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



Introduction

SPEAKER

Ms. Anna KING

Partner, Banner & Witcoff (US)

- **US Attorney** specializing in TM, unfair competition, domain name, copyright
- Active in **global portfolio** management, enforcement, licensing, and oppositions
- **Chair, AIPLA** Trademark Treaties & International Law Committee
- Member, INTA; **2024 Fellow, Leadership Council** on Legal Diversity
- **Lecturer:** AIPLA Bootcamp, Japan Trademark Association
- **Contributor** to: ABA, INTA, PLI, BNA, World Trademark Review
- **Contributor** to *Legal Principles in Computer Games and Immersive Entertainment*
- **Deep knowledge of US IP procedures and international harmonization**



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea





The Americas and Canada:
***Availability of a Letter of Consent and Potential
Risks of Concurrent Use of Similar Trade Marks
under a Co-Existence Agreement***

Anna King
aking@bannerwitcoff.com

UNITED STATES



Valid Consent Agreements Accepted

- Naked (invalid) versus Clothed (valid) consents
 - Naked: has no provisions regarding how the parties will coexist (only permission and brief statement that confusion is unlikely).
 - Clothed: includes appropriate details of coexistence.
- In likelihood of confusion decisions, Trademark Trial and Appeal Board gives deference to consent agreements that detail arrangements to avoid confusion.



Factors Considered by USPTO

- TMEP 1207.01(d)(viii):
 - (1) Whether the consent shows an agreement between both parties;
 - (2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
 - (3) Whether the parties agree to restrict their fields of use;
 - (4) Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
 - (5) Whether the marks have been used for a period of time without evidence of actual confusion.

Whether the consent shows an agreement between both parties

- The letter of consent should be signed by both parties – it is not just permission from one party to another, but an agreement to work together.



Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels

- This can be a general statement without going into details, e.g., the parties have considered their marks and goods/services and their distinct trade channels and believe confusion is unlikely.
- **Practice Tip:** The more detail, the more ammunition for examiners to refuse the letter of consent. Keep it simple.



Whether the parties agree to restrict their fields of use

- This can be risky. If the restriction results in a record that is less than what a US registration affords, then it will not be accepted. For example, if the parties carve up their territories, this is not acceptable as a US registration affords federal protection.
- **Practice tip:** If you are making concessions such as geographic regions or use only in specific stylizations to coexist, then add those restrictions to the coexistence agreement and make the letter of consent filed with the USPTO an exhibit.

Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future

- This statement is enough to suffice.
- We recommend including contact information for each party to report potential confusion evidence to each other.



Whether the marks have been used for a period of time without evidence of actual confusion

- This can be relevant and should be included, if accurate.
- A statement that the parties are unaware of any cases of actual confusion will generally suffice.



Risks of Concurrent Use / Coexistence

- Weakens both marks.
- Opens the door for third parties to argue coexistence between two marks and room for their use/registration as well.
- Potential for negative impact on brand as a result of poor reputation of other party.
- If agreement doesn't address future technologies, then future disputes may arise.
- Reduced flexibility of business growth.

Concurrent Use Registrations in US

- Concurrent use registration is a **post-publication inter partes proceeding** where TTAB determines whether one or more applicants are entitled to registration. A concurrent registration is **one with conditions and limitations**, fixed by TTAB, **as to mode or place of use** of applicant's mark.
- Must be (a) ordered by court; (b) owner of conflicting registration consents to concurrent use; or (c) the applicant first used its mark in commerce prior to filing date of conflicting mark's record.
- The applicant shall state in the application the geographic area, the goods or services, and the mode of use for which the applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the geographic areas of such use; the goods or services on or in connection with which such use is made; the mode of such use; and the time periods of such use.

Mexico



Availability and Risks of Consent

- Letters of consent are accepted by the MPTO and are often used to overcome likelihood of confusion refusals.
- Any coexistence in similar marks in the same class may weaken the rights of the senior owner.
- However, it is valid to argue that the first owner is permitted to consent to another specific owner's application and not others.



Brazil



Availability and Risks of Consent

- Letters of consent are generally accepted.
- However, BPTO evaluates the documents on a case-by-case basis, considering whether the coexistence could lead to consumer confusion.
- Entering into a consent/coexistence agreement may limit future enforcement actions if conflicts arise.



CANADA



Consent Agreements Considered

- CIPO will accept a consent agreement or letter of consent from the owner of a prior cited mark, but it is within the Registrar's discretion whether consent would result in the withdrawal of a likelihood of confusion refusal.
- There are no provisions in Canada legislations which recognize mutual consent of parties as a basis for waiving likelihood of confusion criteria.
- In practice, can be difficult to get consent agreements accepted – but strategically worthwhile to try where parties' goods, services, and businesses are very different and trade channels don't overlap.



Relevant Factors

- The parties have operated their businesses in different areas;
- The trademark for which the registration is in question (the pending application) had acquired distinctiveness and a reputation in Canada, as it was frequently and continuously used in Canada for a number of years;
- There is no real confusion between the trademarks in question during their cohabitation period (coexistence), and
- if coexistence abroad is mentioned, the following factors pertaining to the foreign jurisdiction are considered relevant to determine if there is a likelihood of confusion:
 - the market condition;
 - the channels of trade used by the trademark owners;
 - the type of goods and services offered;
 - the legal test applicable to establish likelihood of confusion; and
 - the existence of any mechanism to facilitate the reporting of cases of confusion.

Coexistence Risks

- Coexistence on the register can weaken marks that share a common element by narrowing the scope of protection for each mark.
- The state of the register and marketplace evidence showing common use of a shared element in trademarks can be used to support an argument that the scope of protection is diluted and that relatively small differences should be sufficient to distinguish two marks.





Anna King

Trademark Partner at Banner Witcoff



Thank you!

Anna King
aking@bannerwitcoff.com



BANNER



**BANNER
WITCOFF**

BANNERWITCOFF.COM

CHICA

**71 SOUTH
CHICAGO**

CHICAGO

**71 SOUTH WACKER DRIVE / SUITE 3600
CHICAGO IL 60606**

WASH

**1100 13TH
WASHING**

WASHINGTON DC

**1100 13TH STREET NW / SUITE 1200
WASHINGTON DC 20005**

BOSTO

**28 STATE
BOSTON I**

BOSTON

**28 STATE STREET / SUITE 1800
BOSTON MA 02109**

PORTI

**ONE WOR
121 SOUTH
PORTLAN**

PORTLAND

**111 SW 5TH AVENUE / SUITE 3150
PORTLAND OR 97204**

Ana de SAMPAIO

Partner

J.E. Dias Costa, Lda.

Portugal



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

JEDC Founded in
1929
LEADING IP
J.E. Dias Costa

Introduction

SPEAKER

Ms. Ana de SAMPAIO

Partner, J.E. Dias Costa, Lda. (PT)

- Portuguese Attorney & Industrial Property Agent
- 30+ years of IP law practice: trademarks, patents, litigation, domain names
- Vice President, ACPI (Portuguese IP Consultants Assoc.)
- Professional Representative before EUIPO
- Law degree, Catholic Univ. of Lisbon; Post-grad in Communication Law, Coimbra Univ.
- Former Visiting Lawyer, Willian Brinks Hofer Gilson & Lione (Chicago)
- Member, INTA Trademark Office Practices Committee
- ICC Paris representative in EUIPO User Meetings
- Fluent in Portuguese, English, Spanish, French



2025 FICPI Symposium

JeJu Korea

2-5 April, 2025 Jeju, Korea



Ana de Sampaio
ana.sampaio@jedc.pt

Availability of a Letter of Consent and Potential Risks of Concurrent Use of Similar Trade Marks under a Co-Existence Agreement

4 April 2025



2025 FICPI Symposium
JeJu Korea

2-5 April, 2025 Jeju, Korea





What are Letters of Consent ?

A document in which the owner of an existing trade mark agrees to allow another party to register and use a similar or identical trade mark in relation to specific goods or services, agreeing not to challenge it on the grounds of infringement or likelihood of confusion.

What is the purpose of Letters of Consent?

They are often used to overcome objections raised by the authorities or resolve conflicts between trade marks.

The “perfect” Letter of Consent:

Specific and detailed: the consent is for which trade mark, which jurisdiction, for which goods or services;

The parties (bilateral): clearly identified, group of companies, successors in title; / Unilateral.

Conditional or open: some countries will not accept that the consent is given with certain conditions (compensation or limitations on use or other registrations, for instance);

Revocation of consent (if changes occur): some countries may not accept this;

Signatures: check entitlement to sign (legalization or notarization?).

Think ahead: will this document be sufficient or adequate in 5 years (market expectations)?

Coexistence Agreements and Letters of Consent:

In some (most) cases obtaining a letter of consent will entail celebrating a coexistence agreement, where the parties:

- acknowledge each other trade mark rights;
- define the presente situation;
- agree not to challenge each other;
- include present and future trade marks (in detail: signs, goods, services, territories);
- ensure compliance with all applicable trade mark laws, regulations;
- define business areas;
- successors and assignees;
- define geographic scope of the agreement (worldwide, national?);
- competent laws and courts.

The coexistence agreement does not necessarily need to be filed with the IP Office. It may be a private document regulating the parties' wishes.



Always include a clause about **the issuance of** (future) **letters of consent**:

On request of one party, the other party will sign a letter of consent which is necessary for registration of the trade marks pursuant to this agreement.

Always include a clause about the **geographic extension** of the agreement:

This agreement shall be valid for the European Union.



Always include a clause about the **successors in title**:

This agreement shall also be binding upon and enure to the benefit of related companies, successors, assigns and licensees of the parties who have registered or use identical trademarks for the same goods or services, or have acquired a trademark referred to herein. Furthermore, the parties undertake to impose the obligations assumed under this agreement to their successors in right.



Enforceability of the agreement:

The legitimacy of the consent is essential – also formal requirements;

Avoid revocable consents;

Make sure the clauses depict the market reality but also the possible future developments in the business.

Aplicable law and competent courts

This is many times a topic of disagreement. A possible solution may be the following:

This agreement shall be governed by the laws of Ireland. The Parties agree that this agreement shall be governed by the laws of Ireland or the laws of Portugal according to the preference of the party commencing proceedings for enforcement of the terms of this agreement. If xxxxx is commencing such proceedings this agreement shall be governed by the laws of Ireland and if xxxxxx is commencing such proceedings this agreement shall be governed by the laws of Portugal.


Irish or Portuguese courts shall be appointed as the competent court for any disputes which may arise from this agreement . according to the preference of the party commencing proceedings for enforcement of the terms of this agreement.

Europe:

Ex officio examination of both absolute and relative grounds of refusal: Portugal, Ireland, Sweden, Finland, Russia.

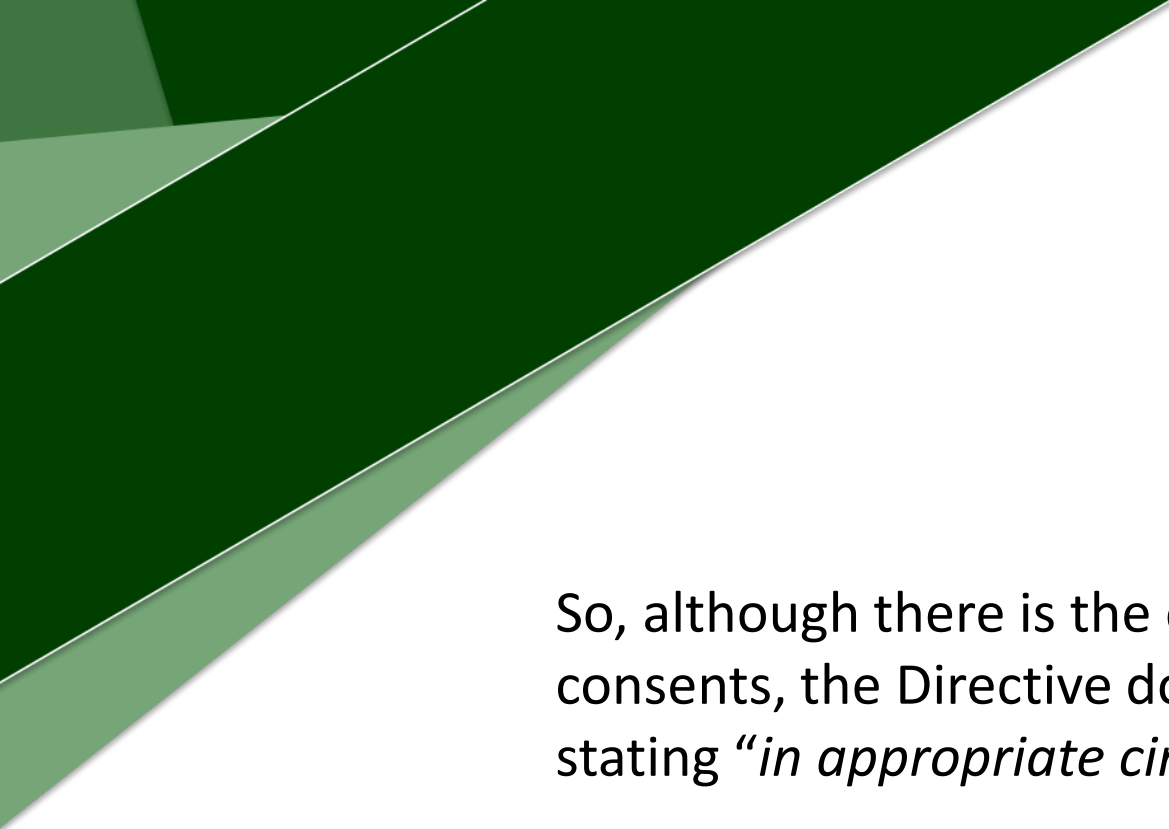
Ex officio examination of absolute grounds of refusal: EUIPO, UK, Spain, France etc...





Trade Mark Directive 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks states in its Article 5 (5):


*The Member States shall ensure that **in appropriate circumstances** there is no obligation to refuse registration or to declare a trade mark invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.*



So, although there is the obligation for Member States to accept consents, the Directive does leave room for interpretation by stating “*in appropriate circumstances*”.

These circumstances could be: confusion in the market, misleading of consumers, the trade mark has a deceptive character (for instance, as regards the quality of the goods or services) etc.

In these cases, the registration of the later mark *may* be refused.



In countries where the IP office only performs an examination as to absolute grounds letters of consent are neither required nor accepted and the issue of consent is a private matter between the parties.

In countries where the IP office performs an examination as to relative grounds the letters of consent will be an important tool to overcome objections but it is also up to the parties to negotiate.



Validity of trade mark rights after a consent:

The consent will be in force as long as the trade marks involved remain valid. This is also a clause frequently included in the coexistence agreement.

If trade marks are cancelled (by a third party initiative) after a consent is given the practical effect of the consent disappears.

Consent means that it is possible that similar marks coexist in the market for similar goods and there may even be confusion for consumers.



Validity of trade mark rights after consent:

Consents are purely a matter of the parties' wishes and in most European jurisdictions, the private interests of the parties will prevail over the public interest.

An exception to this will be the consumer protection on safety and health matters (for instance pharmaceutical trade marks).

Since consents are a matter of parties' wishes the risk of cancellation will not be different from trade marks that were not object of a consent.

If a third party considers the consent/coexistence of two trade marks is harmful to their own trade mark rights a cancellation action is always possible, as per the verification of the conditions of the law.



Common scenario of Letters of Consent in jurisdictions
with *ex officio* Examination on Absolute Grounds



Spanish Trade Mark Application **OLÉ**, class 25:

Opposition filed by on the basis earlier EUTM **OLÁ**, class 25;
Contact the owner of the EUTM and suggest negotiations;
Payment of compensation (only legal fees or reasonable amount);
Negotiate coexistence agreement (national, EU or worldwide);
Include a clause about the issuance of (future) letters of consent;

Negotiate withdrawal of opposition.



Common scenarios of Letters of Consent in jurisdictions with *ex officio* Examination on Relative Grounds



Portuguese Trade Mark Application **ABC**, class 25:

Provisional refusal on the basis of one earlier EUTM **ABZ**;

No opposition from the owner of the earlier mark;

1 month to reply to the Portuguese INPI (+ 1 additional month);

Contact the owner of the EUTM and request consent;

Payment of compensation (only legal fees or reasonable amount);

- Obtain Letter of Consent to overcome objection
- Granting decision.

Portuguese Trade Mark Application **XYZ**, class 25:

Provisional refusal on the basis of one earlier EUTM **XYA**;
No opposition from the owner of the earlier mark;
1 month to reply to the Portuguese INPI (+ 1 additional month);
Contact the owner of the EUTM and request consent;
Payment of compensation (only legal fees or reasonable amount);

- Owner does not agree to issuance of Letter of Consent;
- Still possible to file legal arguments on the No Likelihood of Confusion between the marks;
- Ask for evidence of Use (if earlier mark has been registered for over 5 years).

Portuguese Trade Mark Application **MNLOP** classes 41, 43:

Provisional refusal on the basis of two earlier EUTMs:

MMLOP, Class 41

NNLOP, Class 42

in the name of two different entities;

No oppositions from the owners of the earlier marks;

1 month to reply to the Portuguese INPI (+ 1 additional month);

Contact the owners of the EUTM and request consent;

Payment of compensation (only legal fees or reasonable amount);

Obtain only 1 Letter of Consent (permitting registration for services in class 41);

May still file legal arguments on the No Likelihood of Confusion between the marks;

Ask for evidence of Use (if earlier mark has been registered for over 5 years;

Final decision may be refusal for services in class 43 and granting for services in class 41.



Some risks and considerations when giving consent:

Who are you giving consent to (know the other party);
How does this affect your trade mark rights (dilution);
Are the marks sufficiently different?;
Are the markets overlapping?;

Limit the consent for a specific sign/mark;
Limit the consent for specific goods and services;
Limit the consent for the territory where there was an objection;

Ask for a compensation/costs.



Some risks and considerations when receiving consent:

Will your mark change (rebranding)?

Will the goods and services (business areas) be the same in 2/3 years?

Will there be an international expansion of your mark?

Are you filing new trade marks (to include them)?

Are you willing to pay a compensation for the issuance of the consent?

Ana de Sampaio
ana.sampaio@jedc.pt

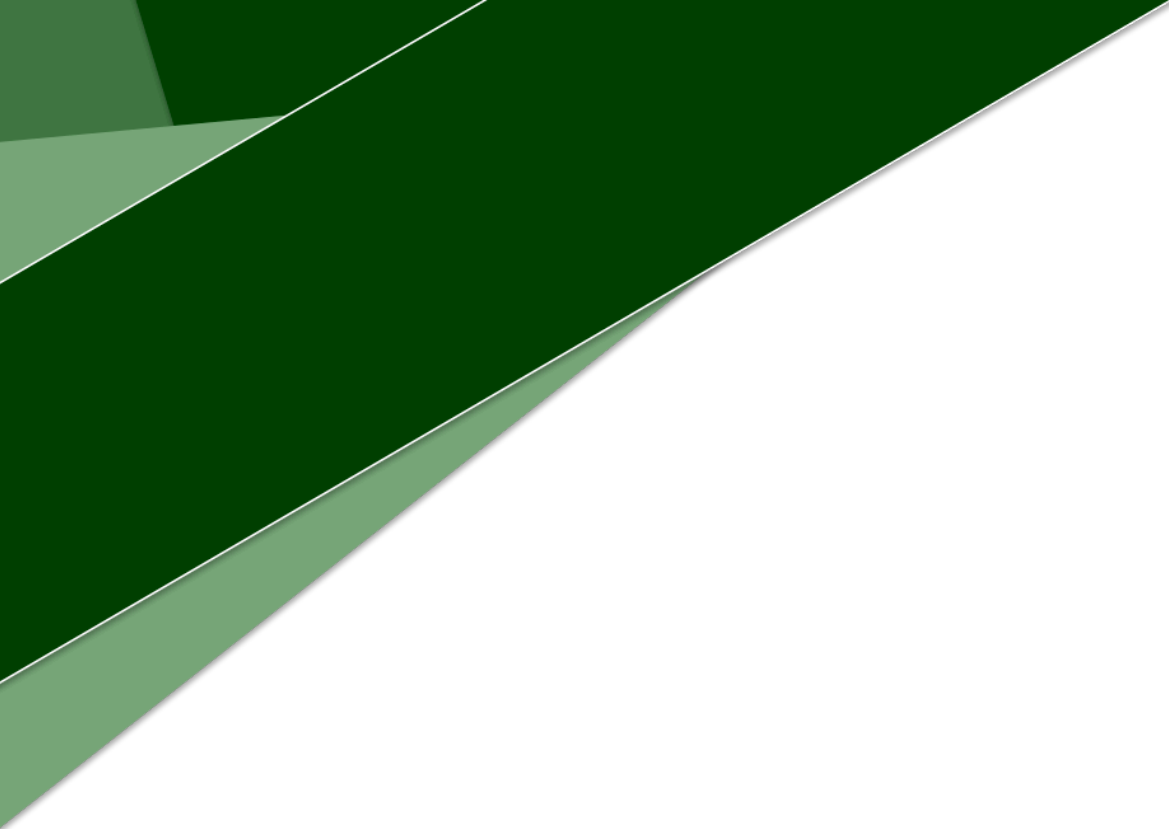
Thank you!



2025 FICPI Symposium
JeJu Korea

2-5 April, 2025 Jeju, Korea

JEDC 90
Cabinet Dias Costa anos
LEADING IP



PRACTICE TOPIC 4

Discussion



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

4 April 2025
16:00-17:30