

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

Geneva, June 26, 2009

QUESTIONNAIRE ON LETTERS OF CONSENT

prepared by the Secretariat

INTRODUCTION

1. At the eighteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in Geneva from November 12 to 16, 2007, members initiated discussions on letters of consent, as part of trademark opposition procedures (paragraphs 50 to 52 of document SCT/18/3 Prov.).
2. At its twentieth session, held in Geneva from December 1 to 5, 2008, the 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).
3. Accordingly, the Secretariat has elaborated the questionnaire contained in the Annex, the purpose of which is to gather information on the law and practice of Member States in connection with letters of consent.
4. The questionnaire is structured in a manner that facilitates the evaluation of replies. A reply is requested by checking the relevant box (YES/NO/N.A.).
5. Returns to the questionnaire should be sent to the Secretariat of the World Intellectual Property Organization (WIPO), c/o Mrs. Martha Friedli, Head, Trademark Law Section, Brands and Designs Division, Sector of Trademarks, Industrial Designs and Geographical Indications, WIPO, by mail: 34, chemin des Colombettes, 1211 Geneva 20, Switzerland; by facsimile: +41 22 338 87 45 or by e-mail to *sct.mail@wipo.int*. Returns should reach the Secretariat by August 31, 2009.

[Annex follows]

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ANNEX

REPLY ON BEHALF OF THE OFFICE OF

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.

1. Is it possible to overcome the following through the presentation of a letter of consent?

(a) An *ex officio* refusal of a trademark registration based on an earlier registered trademark?

YES NO N.A.

(b) An opposition to a trademark registration based on an earlier registered trademark?

YES NO N.A.

(c) A request for invalidation or cancellation of a trademark registration based on an earlier registered trademark?

YES NO N.A.

2. Is a letter of consent acceptable if it is filed by an applicant that is a legal person belonging to the same group of enterprises as the holder?

YES NO N.A.

3. Is a letter of consent regarding identical marks for identical goods or services acceptable?

YES NO N.A.

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4. If a third application is filed for a similar trademark as was registered on the basis of a letter of consent, is the applicant required to file letters of consent from all holders of earlier registrations?
- YES NO N.A.
5. Should a letter of consent meet formal requirements such as:
- (a) Mandatory content?
- YES NO N.A.
- (b) An Office form?
- YES NO N.A.
6. Could a letter of consent be admissible only for a specific period of time?
- YES NO N.A.
7. Is there any restriction to transfer a trademark which was granted on the basis of a letter of consent?
- YES NO N.A.
8. Is it possible to withdraw a letter of consent after a trademark was granted on that basis?
- YES NO N.A.
- (a) Does withdrawal cause the registration to lapse?
- YES NO N.A.

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9. Is the presentation of a copy of the letter of consent required for the renewal of a trademark registration granted on that basis?

YES NO N.A.

10. Any other remark concerning letters of consent:

[End of Annex and of document]