

Acceptance of Coexistence Agreements & Letters of Consent

SPONSORING COMMITTEE: Enforcement Committee¹

RESOLUTION: Presented on September 15, 2025

WHEREAS, Trademark Offices² (“TMOs”) in some jurisdictions conduct *ex officio* examinations on relative grounds to assess potential conflicts between applied-for marks and earlier trademark registrations or applications based on likelihood of confusion;

WHEREAS, coexistence agreements and letters of consent³ (collectively, “Consent Agreements”) can help overcome *ex officio* refusals based on likelihood of confusion with prior registrations or applications;

WHEREAS, some jurisdictions do not accept, or give limited weight to Consent Agreements as a means of potentially overcoming likelihood of confusion-based *ex officio* refusals and instead prioritize statutory criteria rooted in consumer protection over private party arrangements and/or maintain unclear standards for the acceptance of such Consent Agreements, making it difficult for applicants to rely on them;

WHEREAS, the inability for trademark applicants to use coexistence agreements or letters of consent in certain jurisdictions to overcome *ex officio* refusals based on likelihood of confusion or uncertainty surrounding their acceptance can hinder business operations and enforcement strategies by creating unpredictability around registrability, scope of rights, and the effectiveness of negotiated settlements between parties;

WHEREAS, trademark owners are generally best positioned to assess the likelihood of consumer confusion since they operate directly in the marketplace and engage with consumers, and they have a genuine commercial interest in avoiding actual confusion and reducing enforcement risks and costs;

¹ The Enforcement Committee consulted with the TMO Practices Committee who endorsed its conclusions and recommendations on this subject.

² “TMOs” as used in this document refers to the bodies responsible for registering trademarks in any particular jurisdiction. We appreciate that the specific names of these bodies may differ from jurisdiction to jurisdiction.

³ Coexistence agreements generally reflect the parties’ mutual acknowledgment that their respective marks can coexist without giving rise to likelihood of confusion, whereas letters of consent serve a more limited function by providing explicit consent from the holder of the cited prior registration(s) or application(s) to the registration of the later-filed mark. Coexistence agreements outline specific guidelines for how each party can use their trademarks, including potential limitations on product categories or geographic areas, in addition to potential constraints on applications or registrations for the marks. Letters of consent are typically a more streamlined document that might just state that one party agrees to the other’s registration and/or use of the mark without such additional details. A coexistence agreement is often used when two companies have similar trademarks and want to avoid potential disputes by clearly defining how they can co-exist in the market, while a letter of consent is frequently used when one party needs quick permission from another to register a trademark.

WHEREAS, INTA previously adopted the INTA Guidelines for Trademark Examination as most recently amended on November 14, 2023 (the “Examination Guidelines”), and affirms that the principles reflected therein appropriately balance the interests of individual trademark owners on the one hand and the public interest in avoiding consumer confusion represented by public authorities including TMOs and courts on the other hand; and

WHEREAS, INTA favors greater global harmonization and predictability of TMO practices and related laws, regulations, and jurisprudence including with respect to the treatment of Consent Agreements.

BE IT RESOLVED, that INTA seeks to support TMOs and trademark registrants and applicants in the evaluation of responses to likelihood of confusion-based *ex officio* refusals to register trademarks, and in particular the consideration of Consent Agreements as ways to overcome such refusals, and endorses the following policy principles:

- I. INTA supports the increased consideration and acceptance of Consent Agreements as means of resolving likelihood of confusion-based *ex officio* refusals and affirms that trademark laws and practices should provide for the parties’ ability to submit such Consent Agreements, and that due deference should be given to the parties and the justification set forth in these Consent Agreements in support of their mutual assessment that no likelihood of confusion exists.
- II. INTA supports and encourages amendments to existing trademark laws, regulations, and/or TMO examination guidelines or practices to incorporate the process set out in I above in jurisdictions that currently conduct *ex officio* examination of trademark applications on relative grounds but do not currently allow for, or impose significant restrictions on, the consideration of Consent Agreements as basis for overcoming confusion-based *ex officio* refusals.
- III. INTA supports reasonable independent evaluation of Consent Agreements by the TMOs to the extent necessary to protect the public interest by confirming that the coexistence agreement or letter of consent adequately sets forth sufficient justification as to why coexistence of the parties’ marks is unlikely to cause consumer confusion.

To guide such evaluation, INTA further supports the adoption by TMOs of specific guidelines that explicitly set out that Consent Agreements should be favorably considered as possible means of overcoming likelihood of confusion-based *ex officio* refusals and the specific criteria for evaluating their acceptability.

INTA endorses the use of evaluation criteria of Consent Agreements by TMOs consistent with those set forth in the Examination Guidelines specifically including, but not limited to the following non-exhaustive and illustrative factors, intended as guiding considerations and not prerequisites in every case:

- a. That the applicant’s goods/services are distinct from the goods/services of the cited mark(s);
- b. That the trade channels and/or the purchaser groups are different;

- c. That a significant period of concurrent use has passed with no evidence of actual confusion among the relevant purchasing public;
- d. That the applicant and the owners of the cited mark agree not to use the mark of the other on their own goods/services, and to take measures to prevent consumer confusion including, for example, by restricting registration and use of their respective marks for similar goods or services;
- e. That if confusion should occur, the owners of the respective marks will work together and take reasonable action(s) to promptly obviate such confusion; and/or
- f. Inclusion of any other relevant factors illustrating that in this specific case, a likelihood of confusion does not exist.

BACKGROUND

The primary purposes of trademark laws are to protect the public from confusion and to safeguard the goodwill, reputation and value that businesses build in their brands. This inherently requires a balance between public and private interests. Letters of consent and coexistence agreements offer a way to resolve conflicts at the TMO when parties believe there is no likelihood of confusion. These agreements can therefore help ensure a relatively quick, inexpensive, predictable, and generally non-intrusive way to overcome the refusal and enable the applicant for the refused application to obtain the trademark registration – while still taking the public interest in avoiding confusion into account.

INTA has no overarching formal policy, resolution, or position regarding the use of letters of consent or coexistence agreements to overcome confusion-based refusals by TMOs.

In light of the importance of Consent Agreements in the trademark prosecution and protection strategy of INTA members, INTA's Enforcement Committee (via its Coexistence Consent Agreements Working Group) conducted surveys in various countries worldwide to assess how TMOs consider Consent Agreements in resolving confusion-based refusals.⁴

The surveys revealed differing approaches in *ex officio* jurisdictions (where TMOs examine for confusion on relative grounds based on prior registrations or applications) versus opposition jurisdictions (where confusion with prior registrations or applications is addressed via opposition proceedings from interested parties, not based on evaluation by the TMO). In opposition jurisdictions, the TMO does not review or assess coexistence agreements or letters of consent, since all challenges are addressed in the framework of inter-partes opposition proceedings. On

⁴ Two separate surveys were conducted. The first survey did not distinguish between *ex officio* systems and opposition-based systems where examination on relative grounds is not conducted. The first survey garnered responses from representatives in 24 jurisdictions: Argentina, Australia, Brazil, Canada, Chile, China, Colombia, Denmark, Egypt, Finland, Germany, India, Israel, Italy, Mexico, Nigeria, Poland, Portugal, Russia, Singapore, South Korea, Ukraine, the United Kingdom, and the United States. The second survey focused only on *ex officio* systems to assess TMO practices where examination on relative grounds is conducted and the TMO issues refusals of applications based on alleged likelihood of confusion with marks in prior third-party filings. The second survey garnered responses from representatives in 16 jurisdictions: Canada, China, Colombia, Costa Rica, Hong Kong, India, Indonesia, Japan, Macau, Mexico, New Zealand, Philippines, South Korea, Taiwan, Turkey, and the United States.

the other hand, the surveys found that TMOs in ex officio jurisdictions apply varying treatment to Consent Agreements.

Such treatment generally falls into three broad categories:

1. Generally accepted: coexistence agreements or letters of consent are generally accepted by the TMO and are usually considered sufficient to overcome confusion-based refusals.
2. Conditionally accepted: coexistence agreements or letters of consent are generally accepted if they contain sufficient justification with the reasons why the parties believe no likelihood of confusion exists and specifying any arrangements undertaken to avoid or mitigate confusion. A "naked" consent that does not provide appropriate justification for coexistence may not be accepted and in some jurisdictions, even coexistence agreements containing such justification may be rejected if the TMO disagrees based on its own independent assessment.
3. Generally not accepted: TMOs will rarely accept coexistence agreements or letters of consent to overcome a confusion-based refusal. This category applies to jurisdictions where there is no explicit legal prohibition against the use of coexistence agreements or letters of consent but still affords the examiner full discretion to decide without any deference to the parties' positions.

The survey responses show that the rationale for the refusal (likelihood of confusion) and whether or not the TMO will accept or consider a coexistence agreement or letter of consent generally hinges on the same fundamental issue: the public interest in preventing consumer confusion. But whether and to what extent a particular jurisdiction may accept or consider a coexistence agreement or letter of consent to overcome a confusion-based refusal depends on the extent to which the jurisdiction prioritizes its own institutions' evaluation regarding the best interest of the public or that of the private entities whose trademark rights are at issue.

More accepting jurisdictions recognize that the private parties are generally best situated to evaluate the potential for marketplace confusion – particularly since the parties determine the actual use of the marks and interface directly with consumers, which the TMO does not evaluate. However, while some of these jurisdictions have specific criteria for accepting Consent Agreements, many simply consider the issue on a case-by-case basis without any generally applicable guiding requirements or principles.

Jurisdictions that fall into the non- or less-accepting category, on the other hand, tend to focus on statutory criteria or general principles of consumer protection law rather than private arrangements. As a result, applicants in these jurisdictions generally cannot rely on coexistence agreements or letters of consent to overcome ex officio confusion-based refusals.

The surveys demonstrate the lack of global harmonization on this issue. While broad categories of treatment have emerged as noted above, trademark owners must still navigate a fairly complex and nuanced set of approaches depending on jurisdiction. This presents challenges and barriers for trademark owners seeking to expand and operate in an increasingly global economy.

Furthermore, the state of play in this area continues to develop with changes in law or practice in recent years in various jurisdictions – and not necessarily in the same direction.

Against this background and given its overarching support for greater global harmonization of trademark law and practice, INTA supports greater consideration and acceptance of Consent Agreements, based on the view that the private trademark parties are best positioned to assess potential confusion, and that this approach improves predictability and reduces undue barriers to registration.

INTA offers the following additional explanation for the positions set forth above:

1. Conflicts identified by a TMO are usually established based on the goods and/or services as specified in the registrations or applications, which may not fully or accurately reflect the intended scope of coverage or use of a mark, especially in jurisdictions that adhere to rigid and/or broad descriptions of goods or services. This can potentially create undue challenges for the junior applicant in securing rights, even where the respective trademark-owners could otherwise coexist in the marketplace – and can stymie the development and launch of new brands, brand expansions, international licensing or franchising schemes, and other opportunities.
2. The respective parties would be best situated to evaluate the potential for confusion since the parties determine actual use of the marks, which the TMO does not evaluate.
3. In a number of ex officio jurisdictions, applicants cannot rely on coexistence agreements or letters of consent to overcome confusion-based refusals due to local trademark laws, regulations, jurisprudence, or practices. This is unduly prohibitive for junior applicants who should otherwise be able to coexist with senior registrants or applicants.
4. The private parties are unlikely to superficially enter into a coexistence agreement or provide consent if they do not genuinely believe they can coexist (for instance, merely to save a registration that might otherwise be subject to cancellation for non-use etc.).
5. A more liberal system in terms of accepting Consent Agreements already works in many countries, as demonstrated by the surveys, so it is clear it can effectively be applied elsewhere. This has been borne out in practice by jurisdictions who have shifted from a less accepting to a more accepting system.
6. INTA supports this shift toward greater acceptance of well-founded Consent Agreements despite the potential availability of other means of resolving confusion-based refusals, as these other options are generally less predictable, can unnecessarily limit the scope of the applicant's rights, and/or may be more costly.
7. These principles are already at least implicitly endorsed in the Examination Guidelines.