

Mexican standoff: how the recognition of consent letters is enabling trademark coexistence

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Managing IP



Several pieces of Mexican legislation in recent years have established the validity of consent letters in formalising the coexistence of identical or similar trademarks, explains Sergio Olivares Nieto of OLIVARES

Border In the field of industrial property, a letter of consent is a document frequently used internationally to overcome potential conflicts between identical or confusingly similar trademarks. Such a document is basically the written consent of a person or an entity whose rights could be affected by a third party's trademark application.

For a long time, consent letters or other documents such as coexistence agreements were not ruled on in Mexican law, and their acceptance was subject to the criteria adopted by the trademark office, which changed frequently with the changes of the administration in turn.

However, as of August 10, 2018, the date on which the amendments to the Federal Industrial Property Law (a previous law) entered into force, these types of documents were expressly recognized in Mexican legislation as a valid means to allow the coexistence of identical or similar trademarks of different holders.

The role of consent letters in Mexico

The Mexican Institute of Industrial Property considers the consent letter as an element that can be filed by applicants to demonstrate that there is an agreement or consent on the part of the affected party. The submission of a consent letter can help to avoid possible oppositions or refusals to an application for registration of a similar trademark and is likewise a remedy that ensures the possibilities of overcoming an objection raised by the examiner.

The acceptance of such documents, in accordance with the penultimate paragraph of Section XXII of Article 173 of the Federal Law on the Protection of Industrial Property that came into effect in 2020, applies by way of exception in the case of similar marks in degree of confusion or identical trademarks for similar products or services. In this sense, the only situation that is not covered by the exception is identical trademarks for identical products or services.

It is worth mentioning that to obtain a letter of consent, it is necessary to approach the owner of the trademark registration to initiate a negotiation, in which the necessary clauses can be added to achieve the objective of the letter of consent; namely, coexistence in the registration of two similar trademarks.



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