Naked Consent: When Does Yes Mean No?

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Consent agreements - in which a prior U.S. Patent and Trademark Office (USPTO) rights-holder provides consent to registration of a later-filed trademark - can be an efficient path to registration in situations where the parties agree that confusion between their respective marks is unlikely. The USPTO typically gives "great weight" to properly constructed consent agreements, and the USPTO's rules of practice caution that it should not "substitute its judgment concerning likelihood of confusion for the judgment of the parties in interest without good reason."

However, as the Trademark Trial and Appeal Board (TTAB) reiterated in its August 25, 2015 decision in In re Flying Mojo, a consent to registration is "but one factor" to be taken into account when evaluating likelihood confusion, and consent agreements must meet certain minimum standards in order to be accorded substantial weight.

The Applicant in In re Flying Mojo sought to register PURPLE HAZE for "electronic sound pickup for guitars and basses" in Class 9. Registration was refused based on a prior registration for the mark HAZE, registered for "sound amplifiers" also in Class 9. Although the parties had entered into a coexistence agreement, the Examining Attorney and the TTAB agreed that the terms of that agreement constituted a "naked consent" insufficient to support registration of PURPLE HAZE. Notably, the agreement did not include the reasons why a likelihood of confusion did not exist between the marks, and did not describe any arrangements between the Applicant and the Registrant to avoid confusion. Perhaps even more damning, the agreement also required the Applicant to obtain additional consent from the owner of the cited registration to register PURPLE HAZE.

For those looking to overcome a 2(d) rejection by obtaining consent to register, this case is a good reminder that a proper, persuasive consent letter from the owner of a registration cited in a 2(d) refusal ideally should include the following three components: (1) the specific reasons why there is no likelihood of confusion between the parties' respective marks, (2) a description of the actions the parties agree to take to avoid confusion among relevant customers, and (3) signatures of both parties. If the agreement does not contain this language, it will likely be considered a naked consent, and will not be given due weight in the registration analysis.

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