



CURRENT ISSUES OF THE LEGAL REGULATION OF COEXISTENCE AGREEMENTS FOR THE USE OF TRADEMARKS

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Abstract

This article examines the theoretical and practical issues associated with the legal regulation of agreements on the joint use and coexistence of trademarks. The legal and doctrinal approaches developed in the legislation and judicial practice of China, Russia, and other foreign jurisdictions are analysed from a comparative legal perspective. Particular attention is paid to the legal nature of trademark coexistence agreements, their place within the system of intellectual property law, the rights and obligations of the parties, as well as contractual mechanisms aimed at protecting consumer interests and maintaining fair competition. The author provides a scholarly justification for treating a trademark coexistence agreement as an innominate contract in the field of intellectual property and for assessing it through the concept of a “limited derivative exclusive right.” In addition, the article formulates proposals for introducing special provisions governing trademark coexistence agreements into the Civil Code of the Republic of Uzbekistan in order to ensure clear and consistent legal regulation of these relations.

Keywords

trademark, intellectual property, exclusive right, limited derivative exclusive right, innominate contract, coexistence agreement, consent clause.

The effective legal protection of intellectual property rights is one of the fundamental prerequisites for fostering an innovation-driven economy, promoting fair competition, and safeguarding the legitimate interests of business entities. Among the various objects of intellectual property, trademarks occupy a distinctive position. A trademark serves not only as a means of distinguishing the goods and services of one undertaking from those of others, but also as a valuable intangible asset reflecting the





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right holder's business reputation, market standing, consumer confidence, and competitive advantage. Accordingly, improving the legal mechanisms governing the exercise and disposition of exclusive trademark rights has become one of the key priorities of contemporary intellectual property law.

Article 65 of the Constitution of the Republic of Uzbekistan guarantees the inviolability of private property and its protection by the State. This constitutional principle also provides the legal foundation for protecting proprietary rights relating to intellectual property objects. In addition, the Civil Code of the Republic of Uzbekistan recognizes exclusive rights to intellectual property objects and establishes the general legal framework for their exercise and protection.

In Chinese legal doctrine, the legal and theoretical approaches to trademark coexistence agreements are generally classified into three principal categories¹:

1. Prohibitive approach. According to this view, allowing multiple parties to use the same trademark may mislead consumers and create confusion regarding the commercial origin of goods or services. Such confusion undermines the essential function of a trademark as an indicator of origin and may distort fair competition in the marketplace. Consequently, proponents of this approach argue that trademark coexistence based on contractual arrangements should not be permitted.

2. Liberal approach. This position places primary emphasis on the principle of freedom of contract. Under this approach, where two or more persons possess rights relating to a trademark, they should be free to determine, by mutual agreement, the conditions under which the trademark may be used concurrently. State intervention in such private arrangements is considered unnecessary, provided that the agreement does not violate mandatory rules of civil law or competition law.

¹ Yu F. et al. Prevalence of 16S rRNA methylase genes in *Klebsiella pneumoniae* isolates from a Chinese teaching hospital: coexistence of *rmtB* and *armA* genes in the same isolate //Diagnostic microbiology and infectious disease. – 2009. – T. 64. – № 1. – P. 57-63.





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3. Functional compromise approach. This approach recognizes the legal validity of contractual arrangements governing relationships not expressly regulated by legislation, while emphasizing that such agreements must not prejudice the interests of consumers, the State, or society. Accordingly, although the parties may contractually allocate rights to the concurrent use of a trademark, the agreement should also establish safeguards ensuring that the exercise of those rights does not mislead third parties, impair market transparency, or adversely affect fair competition.

The functional compromise approach has also been reflected in Chinese judicial practice. In particular, in the Google v. Shimano case decided in 2016, the court upheld the legality of the parties' contractual arrangement for the coexistence and concurrent use of the trademark. In its reasoning, the court emphasized that the decisive criterion was whether the agreement adversely affected consumer interests. It concluded that the coexistence agreement primarily served to clarify the legal relationship between the respective trademark owners and that, given the clear distinction between the parties' fields of commercial activity, the agreement was unlikely to cause consumer confusion or disrupt the orderly functioning of the market².

According to the court, when assessing the validity of such agreements, priority may be given to the legitimate interests of trademark proprietors, provided that the agreement neither misleads consumers nor infringes upon the public interest.

Although trademark coexistence has not yet been comprehensively regulated under Chinese legislation, its legal nature has been shaped through judicial practice and academic doctrine. Coexistence agreements concluded on the basis of the principles of freedom of contract and protection of private property are generally recognized within the framework of general legal principles, provided that they do not prejudice consumer interests or undermine market order. Consequently, the functional compromise approach

² Ming Deng and Nicole Yu. Trademark Coexistence or Trademark Confusion? —A Comparative Study from Perspectives of Europe and China. China patents & trademarks No.4, 2017. — P. 74.
URL: <http://www.cpt.cn/uploadfiles/20180131121232759.pdf>





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has emerged in Chinese legal practice as the most balanced and pragmatic mechanism for governing trademark coexistence, striking an appropriate balance between the autonomy of trademark owners, consumer protection, and the maintenance of fair competition.

In the Russian Federation, the registration of trademark coexistence agreements is subject primarily to an assessment of whether the agreement is likely to mislead consumers³. However, the approach adopted by Russian courts in disputes arising from such agreements differs from the administrative examination carried out during registration. In judicial proceedings, courts generally do not reassess the potential for consumer confusion. Instead, they focus on whether the coexistence agreement was concluded with the consent of the trademark proprietor and whether it has been duly registered in accordance with the applicable legal requirements. Consequently, the validity and enforceability of the agreement are determined primarily by its compliance with statutory formalities rather than by an independent judicial evaluation of its possible impact on consumers⁴.

In international practice, the rights and obligations of the parties to a trademark coexistence agreement may include the following: the right to expand their commercial activities by registering the trademark for new categories of goods; the right to bring a claim in respect of conduct constituting a breach of the agreement; and the obligation to provide a letter of consent for the registration of the relevant trademark through a consent clause or a separate letter of consent.

The parties may also undertake to refrain from using or registering the trademark in a particular form, colour, size, or visual presentation, and to avoid incorporating

³ Заключение Палаты по патентным спорам от 21 июля 2020 г. (Приложение к решению Роспатента от 23 июля 2020 г. по заявке № 0001388077); Заключение Палаты по патентным спорам от 16 января 2019 г. (Приложение к решению Роспатента от 30 января 2019 г. по заявке № 0001328780); Заключение Палаты по патентным спорам от 20 марта 2018 г. (Приложение к решению Роспатента от 19 апреля 2018 г. по заявке № 2016722840)

⁴ Ходаков И.Д. Договоры о сосуществовании товарных знаков в российской и международной практике. Журнал Суда по интеллектуальным правам / Июнь 2021. – С. 168-169.





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certain distinctive elements of the earlier or senior trademark. A coexistence agreement may further contain a no-challenge clause, under which a party agrees not to contest the validity, registration, or use of the senior trademark, even where the proprietor of that trademark does not use it in relation to certain goods.

Other common contractual obligations include territorial, product-based, or field-of-use restrictions limiting the use of the trademark to a specified geographical area, category of goods, or sphere of commercial activity, as well as an undertaking not to seek the cancellation or revocation of the trademark's legal protection. The agreement may also contain a cooperation clause requiring the parties to take reasonable measures to reduce the risk of consumer confusion.

Furthermore, the parties may be required to refrain from any conduct capable of damaging the reputation or goodwill of the trademark or its proprietor. Finally, the agreement may impose restrictions on the disposition or exploitation of trademark rights, including, for example, a prohibition on licensing, assigning, or otherwise granting third parties the right to use the trademark^{5,6}

Furthermore, the subject matter of a trademark coexistence agreement may also encompass an undertaking to refrain from certain acts, thereby imposing negative obligations on the parties. Such obligations typically require a party to abstain from engaging in specified conduct, including the registration, use, licensing, assignment, or enforcement of trademark rights in circumstances that could conflict with the rights or legitimate interests of the other party. These negative covenants constitute an essential component of trademark coexistence agreements, as they are designed to preserve contractual equilibrium, minimize the likelihood of consumer confusion, and ensure the peaceful coexistence of similar or identical trademarks in the marketplace.⁷ On the basis

⁵ Carin Thomsen. Trademark Co-existence Agreements in the Perspective of EU Competition Law. P.31-33. URL https://gupea.ub.gu.se/bitstream/2077/32214/1/gupea_2077_32214_1.pdf

⁶ Standard form of Trademark Coexistence Agreement in the United States. URL: <https://uk.practicallaw.thomsonreuters.com>

⁷ Neil J. Wilkof, Daniel B., Christopher S.. Trade Mark Licensing. – P. 202.





of the foregoing considerations, it may be concluded that a trademark coexistence agreement cannot properly be characterized either as a licence agreement or as an agreement for the assignment or other disposition of trademark rights. Unlike a licence agreement, such an arrangement does not confer an independent right to use an earlier trademark upon another party. Nor does it operate as an assignment or transfer of the exclusive right to the trademark. Rather, its principal function is to regulate the coexistence of the parties' respective trademark rights and to establish the conditions under which similar or identical trademarks may coexist without giving rise to consumer confusion or legal conflict⁸. In legal practice, trademark coexistence agreements are, in most cases, concluded on a gratuitous basis.⁹

In the author's view, in order to eliminate the existing legal uncertainty and legislative gap surrounding trademark coexistence agreements, consideration should be given to incorporating this type of agreement into the system of contracts governing the disposition of exclusive intellectual property rights. Such legislative recognition would establish a clearer legal framework for regulating the rights and obligations of the parties and would strengthen the enforceability of coexistence arrangements.¹⁰

Accordingly, where two or more trademark proprietors intend to use identical or similar trademarks in relation to the same category of goods, and such concurrent use does not adversely affect the public interest, the law should permit the conclusion of a trademark coexistence agreement as an appropriate legal instrument. In light of the comparative analysis of the legislation and legal practice of several foreign jurisdictions, it is proposed that the Civil Code of the Republic of Uzbekistan be supplemented with a separate legal framework governing Trademark Coexistence Agreements.

On the basis of the foregoing analysis, the following definition may be proposed:

⁸ Parsons G., Whittingham S. Merck Global v Merck US: the intricacies of co-existence agreements //Journal of Intellectual Property Law & Practice. Journal of Intellectual Property Law & Practice, Volume 13, Issue 7, July 2018, Pages 521–523, <https://doi.org/10.1093/jiplp/jpy054>

⁹ Offner E. D. Trademark licensing in foreign countries //J. Pat. Off. Soc'y. – 1958. – Т. 40. – P. 178.

¹⁰ Елисеев В.И. Соглашения на регистрацию и соглашения о сосуществовании товарных знаков. //Патенты и лицензии. Интеллектуальные права, – № 3. Март. – 2017. – С. 66.





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A trademark coexistence agreement is a bilateral or multilateral agreement under which the proprietor of a trademark grants one or more interested parties consent to register, own, and use identical or confusingly similar trademarks. Such an agreement may be concluded either for consideration or on a gratuitous basis. However, the holder of the derivative right acquired under the agreement shall not be entitled to dispose of the trademark right or otherwise transfer the exclusive right to third parties.

The Law of the Republic of Uzbekistan “On Trademarks, Service Marks and Appellations of Origin” of 30 August 2001 does not regulate the concurrent use of trademarks by multiple persons as an independent legal institution. Consequently, trademark coexistence agreements are not expressly governed under the existing legislative framework and may only be interpreted indirectly through certain statutory provisions. In particular, the second and third paragraphs of subparagraph 13 of Article 10(1) provide that, with the consent of the proprietor of an earlier trademark, an identical or confusingly similar mark may also be registered in the name of another person. Although this provision does not expressly regulate trademark coexistence agreements, it implicitly recognizes the legal possibility of concurrent ownership and use of similar trademarks in circumstances determined by the consent of the prior right holder.

However, the current legislation contains no comprehensive legal mechanism governing the conditions for trademark coexistence, the rights and obligations of the contracting parties, the relationship between such agreements and licensing, assignment, inheritance, or pledge of trademark rights, or the allocation of liability for defective goods marketed under coexisting trademarks. Consequently, a trademark coexistence agreement cannot properly be classified as either a licence agreement, an agreement on the assignment of exclusive rights, or an agreement involving the waiver or abandonment of trademark rights.

Nor does such an agreement fall within the concept of a collective trademark as defined in Article 3(2) of the Law. A collective trademark is intended to identify the





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goods or services of members of a particular association acting in pursuit of common objectives and is based on collective ownership and use. By contrast, a trademark coexistence agreement arises from the mutual consent of two or more legally independent entities, each retaining its own separate trademark rights. Accordingly, it neither establishes collective ownership nor serves the purposes characteristic of a collective trademark.

Since a trademark coexistence agreement does not belong to any established category of intellectual property contracts—such as a licence, assignment, testamentary disposition, or other recognized form of rights transfer—the general principles of civil law should apply. In particular, Articles 103 (exercise of civil rights) and 110 (prohibition of abuse of rights) of the Civil Code of the Republic of Uzbekistan provide an appropriate normative basis for regulating such agreements. These provisions require contractual rights to be exercised in good faith, fairly, and consistently with their intended purpose, while ensuring a proper balance between the legitimate interests of the parties and preventing the abuse of subjective rights.

In light of the foregoing analysis, it is proposed that a trademark coexistence agreement should be characterized, as a matter of legal doctrine, as creating a limited derivative exclusive right. Under this concept, the primary exclusive right is the full statutory right vested in the proprietor of the earlier trademark, whereas the derivative right is a subsequently created and legally dependent right that is derived from, and exercised within the limits established by, the primary right.

A derivative exclusive right does not exist independently of the primary right. Rather, it is contingent upon the continued existence of the earlier trademark right and is contractually limited in its duration, scope, and content. Such a right is not protected as an autonomous exclusive right acquired through an independent trademark registration. Instead, it arises directly from the consent of the proprietor of the earlier trademark and exists only to the extent permitted by the coexistence agreement.





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Accordingly, this legal relationship preserves the superior legal position of the proprietor of the earlier trademark while conferring upon the other party only a limited and conditional right to register and use a similar or identical trademark. Consequently, the derivative right does not include the power to dispose of the trademark, grant licences, assign the right, or otherwise transfer it to third parties.

The legal regulation of trademark coexistence agreements in Uzbekistan remains insufficiently developed. Since the current legislation contains no specific provisions governing such contractual relationships, disputes arising from them must be resolved primarily on the basis of the general principles of civil law. From a doctrinal perspective, classifying the rights arising under a trademark coexistence agreement as a limited derivative exclusive right provides a coherent theoretical framework for explaining their legal nature. At the same time, legislative intervention is desirable in order to establish clear statutory rules governing the formation, operation, and enforcement of this contractual institution. A limited derivative right should therefore be understood not as an independent exclusive right but as a civil-law entitlement exercised solely with the consent and under the control of the proprietor of the primary trademark. By its nature, it is derivative, existing only because of, and remaining legally dependent upon, the primary exclusive right.

In the context of trademark coexistence, the derivative right holder is entitled to use the trademark only within the limits expressly provided by the agreement. In particular, the derivative right holder is not entitled to:

- grant licences to third parties in respect of the trademark;
- assign, sell, donate, exchange, pledge, or otherwise dispose of the trademark right;
- waive the right or transfer it through any other legal transaction; or
- independently renew the term of trademark protection, as any renewal must be carried out with the consent of the proprietor of the primary trademark.

Accordingly, the derivative right is strictly limited with respect to its scope, duration,





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legal powers, and capacity for disposition, and it exists exclusively within the legal sphere determined by the proprietor of the primary trademark. It does not provide comprehensive legal protection equivalent to that enjoyed by the proprietor of the trademark; rather, it confers only a limited contractual entitlement to use the trademark for agreed purposes. Its principal objective is to enable a third party to derive legitimate commercial benefits from the coexistence arrangement without prejudicing the commercial interests or exclusive legal position of the proprietor of the earlier trademark.

In order to provide legal certainty, it is proposed that the Civil Code of the Republic of Uzbekistan be supplemented with a new Article 1106¹, entitled “Trademark Coexistence Agreement.” This provision should define a trademark coexistence agreement as a conditional and limited civil-law relationship under which, with the written consent of the proprietor of an earlier trademark, one or more third parties may register and use an identical or confusingly similar trademark solely in relation to the goods or services covered by the earlier trademark.

The proposed article should further provide that such agreements are intended to permit third parties to benefit from the commercial reputation and market recognition associated with the earlier trademark by registering and using an identical or similar trademark within an agreed sphere of commercial activity, with or without territorial limitations specified by the proprietor of the earlier trademark. The parties to such agreements should be limited to commercial legal entities and business operators.

The agreement should establish a derivative exclusive right that remains legally dependent upon the earlier trademark and continues only for the duration of the registration of that trademark. Renewal of the trademark should ordinarily require the consent of the proprietor of the earlier trademark. However, where such consent is unreasonably withheld, the derivative right holder should be entitled to apply to a court, which may, where justified by the circumstances, order the renewal of the trademark. Following such judicial renewal, the exclusive right in the renewed trademark may,





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where appropriate, pass from the original proprietor to the derivative right holders acting jointly in accordance with the statutory rules governing collective ownership.

To ensure legal certainty, it is further proposed that the Civil Code be supplemented with Article 1106², entitled “Form and Registration Requirements for a Trademark Coexistence Agreement.” This article should require that the agreement be concluded in writing and registered with the competent authority. Failure to comply with these formal requirements should render the agreement invalid.

It is also proposed to introduce Article 1106³, entitled “Remuneration under a Trademark Coexistence Agreement.” Under this provision, the derivative right holder may remunerate the proprietor of the earlier trademark by means of a lump-sum payment, periodic royalty payments, a percentage of revenue, mark-ups on wholesale prices of goods supplied by the proprietor, or any other form of consideration agreed by the parties. Consistent with international practice, however, the parties should also be free to conclude a trademark coexistence agreement on a gratuitous basis.

Finally, it is proposed to introduce Article 1106⁴, entitled “Liability of the Proprietor of the Earlier Trademark for Claims against the Derivative Right Holder.” Under this provision, where claims are brought against the derivative right holder on the ground that goods marketed under the coexistence agreement fail to comply with the agreed quality standards, the proprietor of the earlier trademark should bear subsidiary liability for such claims.

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