

MAXIMISING ENFORCEMENT SUCCESS IN POLAND

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Brand owners should note that the enforcement of rights before the Polish courts is more effective if a trademark owner enjoys protection under the national system

In Poland, as in all other EU member states, trademark protection may be obtained under three procedures:

- the national procedure - registration with national offices;
- the international procedures under the Madrid Agreement and Protocol- registration through the World Intellectual Property Organisation; and
- the Community trademark (CTM) procedure - registration through the Office for Harmonisation in the Internal Market (Trademarks and Designs) (OHIM).

Choosing one or a combination of these procedures depends on many aspects, including the territorial range of protection required, the costs of registration, potential threats of opposition and refusal on absolute or relative grounds.

The CTM system is undoubtedly very attractive as it offers the possibility to file a single application to obtain protection in 27 countries. In addition, OHIM examines trademark registrability exclusively on absolute grounds, and the blocking of registration on relative grounds may take place only if a trademark faces an opposition. In spite of this, the unquestionable advantages of the CTM system may also be perceived as disadvantages. This is the case when a trademark owner is not interested in obtaining protection for use of a mark in all EU member states, or when the mark is not particularly distinguished and there is a justified threat that the granting of protection will be blocked in the whole European Union as a result of discovering earlier third-party rights in only one other member state. Nonetheless, some trademark owners feel more confident if a decision on registration is issued by the relevant authorities in a given country after examination of the mark on relative grounds.

Thus, they have certainty that their marks infringe no third-party rights. Therefore, attractive as the CTM system may be, many trademark owners still prefer to seek protection through the national procedure or to designate a country of interest in an international trademark registration.

Before it issues decisions on granting protection, the Polish Patent Office examines the registrability of marks on both absolute and relative grounds. It takes approximately 12 months from filing of a trademark application for a decision to be issued on the grant of protection. The Patent Office's assessment of trademark registrability on relative grounds is to a large extent based on EU case law. First, for the purposes of assessing the risk of misleading customers, the Patent Office has accepted a model of the average consumer who is deemed to be reasonably well informed, observant and circumspect. As regards the assessment of similarity between the goods or services, the Patent Office analyses all essential factors which are crucial to the relationship between those goods or services, in particular their character, their destination or use and whether they are competitive or complementary in relation to each other.

A prevailing number of trademarks filed with the Patent Office are traditional trademarks - that is, word marks, design marks or word and design marks. Non-traditional marks are rarely applied for and their successful registration is even more rare.

So far, under the existing law, the Patent Office has registered no single colours as trademarks. However, guidelines and requirements which a single colour must fulfil in order to be registered as a trademark have been established. It is considered that a colour does not have primary distinctiveness *per se*, and that in order to be registered, it must show acquired distinctiveness. It is possible to admit the existence of *acqui* In spite of this, the unquestionable advantages of the CTM system may also be perceived as disadvantages. This is the case when a trademark owner is not interested in obtaining

protection for use of a mark in all EU member states, or when the mark is not particularly distinguished and there is a justified threat that the granting of protection will be blocked in the whole European Union as a result of discovering earlier third-party rights in only one other member state. Nonetheless, some trademark owners feel more confident if a decision on registration is issued by the relevant authorities in a given country after examination of the mark on relative grounds.

Thus, they have certainty that their marks infringe no third-party rights. Therefore, attractive as the CTM system may be, many trademark owners still prefer to seek protection through the national procedure or to designate a country of interest in an international trademark registration. Before it issues decisions on granting protection, the Polish Patent Office examines the registrability of marks on both absolute and relative grounds. It takes approximately 12 months from filing of a trademark application for a decision to be issued on the grant of protection. The Patent Office's assessment of trademark registrability on relative grounds is to a large extent based on EU case law. First, for the purposes of assessing the risk of misleading customers, the Patent Office has accepted a model of the average consumer who is deemed to be reasonably well informed, observant and circumspect. As regards the assessment of similarity between the goods or services, the Patent Office analyses all essential factors which are crucial to the relationship between those goods or services, in particular their character, their destination or use and whether they are competitive or complementary in relation to each other.

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One colour has been used extensively by one company;
Goods have been advertised on a large scale in connection with the subject colour;
A large number of customers associate a specific colour attached to the goods with the manufacturer of those goods; and
A colour has been used for a long time in respect of the relevant goods.

The burden of proof to support the acquired distinctiveness rests with the applicant, which may provide the following information as evidence:

opinion poll results as to whether customers associate a specific colour with the goods to which it is affixed;
commercial evidence (eg, invoices);
advertising materials;
the length of time for which the mark has been used; and
the territorial extension of the mark's recognition by customers.

It is essential that all evidentiary materials and referential circumstances date back to the time preceding the filing of an application for registration of the mark. Thus, if the owner intends to obtain the right of protection for a trademark that is a single colour, it should conduct a customer survey well before the application date and to gather the relevant commercial evidence to prove acquired distinctiveness.

According to the Patent Office, the evidence for proving acquired distinctiveness for the colours green (in respect of motor fuel and service stations), red (with regard to chocolate products) and another red (for the marking of different kinds of tool) was insufficient and subsequently the office refused to grant protection for those colours as trademarks.

Compositions of colours are expressly mentioned in the Law on Industrial Property as an example of signs that may be regarded as trademarks. Therefore, it is unquestionable that designations of this

kind are registrable in Poland. In order to obtain registration for this type of trademark, acquired distinctiveness need not be proved; rather, the mark must be presented in a definite and uniform way. Three-dimensional (3D) marks are also mentioned in the Law on Industrial Property as an example of signs that may be considered as trademarks. Usually, 3D marks are the packaging of products. In order to be registered, they simply need to be distinctive and sufficiently different from other earlier third-party 3D marks. Frequently, a 3D mark is also at the same time a 3D representation of the product. In such cases a sign will not be granted the right of protection if it constitutes the form or another feature of the goods or their packaging which is dictated exclusively by their nature, is necessary to achieve a technical result or which gives substantial value to the goods. For example, the Patent Office has granted the right of protection for a 3D trademark in the form of a round cookie with a characteristic bulging top in respect of confectionery in Class 30. Registration of this trademark was opposed by the trademark owner's competitor on the grounds of a lack of sufficient distinctiveness. During the litigation procedure, it was decided that the trademark was not capable of distinguishing the same kinds of good of one undertaking from those of other undertakings that operate in the confectionery industry. Moreover, it was stated that a sign consisting exclusively of the form of a product could not be registered as it has been proven that basic functional features of that form are related only to technical properties (ie, sponge cookies with chocolate-coated jelly on the top).

To date, no protection has been granted for any motion trademarks. The main objection raised by the Patent Office in respect of motion trademarks is the lack of capability to be represented graphically in an appropriate and clear way. The Patent Office's examination of applications for this kind of mark is based on an ECJ decision which implies that a trademark may be composed of a designation which by itself cannot be perceived visually, provided that it can be represented in a graphic form, in particular by the use of images, lines and symbols, and that this representation must be clear, precise, compact, easily accessible, understandable, permanent and objective (Case C-283/01). By way of example, the Patent Office refused protection for a mark filed in respect of pharmaceutical and sanitary products and dietetic substances for medical use in Class 5, and described as a "movement mark: the colours in the waves are changing continuously from red to green upwards from bottom left to top right in an 8-second time span".

The Patent Office decided that the application did not fulfil the requirement of uniformity, which provides that "one and the same application may relate to one trademark only". As observed by the Patent Office, the trademark could not be shown in a graphic form by use of images, lines and symbols in such a manner that such presentation is at the same time clear, precise, compact, easily accessible, comprehensible, durable, objective and uniform. Therefore, the mark was deemed devoid of distinctive character. It was unquestionable for the Patent Office that the mark applied for registration was a colour mark in which three colours were mentioned, and that therefore, *de facto*, these were three different designations. Moreover, the Patent Office found that only a cognitive uniform object may be regarded as capable of being distinctive. An object shall be regarded as uniform if its structure is such that it may be perceived through one cognitive act, which does not take place in the subject matter.

Sound marks are also mentioned in the Law on Industrial Property as signs that may be considered as trademarks. They must be represented graphically through the use of a musical notation. In order to fulfil the requirements for filing an application for registration of a sound trademark in Poland, the applicant must provide the following information:

- a graphic representation of the mark that enables its reproduction;
- two copies of recorded tape or other carrier with a recording of the subject sound; and
- a description of the mark (ie, the manner in which it should be perceived).

The Patent Office registers position marks provided that they are sufficiently distinctive. In order to specify the extent of protection, it is commonly accepted that the particular position of a trademark for which protection is sought is marked on a dashed-line contour of a product to which the mark is to be affixed.

Meanwhile, at present, there is no case law or examples regarding registration applications for smell, taste and touch trademarks in Poland. The national system is still very attractive. It is believed that the enforcement of rights before Polish courts is more effective if a trademark owner enjoys protection under the national system. Moreover, during the essential examination of applications and when

issuing decisions in litigation cases regarding national marks, the Patent Office frequently relies on OHIM case law. There is little case law created by the Patent Office relating to non-traditional marks but it seems that continuous development in this field and the functioning of these kinds of mark on the market and in customers' minds as designations of origin of products marked therewith will eventually push the Patent Office into assuming a more liberal attitude to the registration of non-traditional marks.

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