POLAND OVERVIEW – THE DEVIL IS IN THE DETAILS

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Trademarks is one of the most dynamic and extensive areas of the intellectual property law. Therefore, this brief overview cannot cover the whole spectrum. It focuses on selected aspects of Polish trademark law and practice, starting from the obligation of genuine use of trademark, letters of consent, filing of trademark application in bad faith and ending with trademark renown. Please note the fact that the Act on Industrial Property Law dated June 30, 2000 was harmonized with Community legislation. Hence, I refrained from referring to the Polish Law provisions which stipulate regulations corresponding to the Community ones, yet, as it often happens, only reviewing some matters enables to see more colours and nuances which frequently have a decisive impact on the outcome of a case.

As you certainly know, the obligation of genuine use of trademarks for the goods protected under the trademark rights is one of the fundamental conditions enabling to maintain and enforce the protection resulting from their registrations. According to the Polish legal system, the fact that right holder of a trademark may use its designation in a form which is modified in comparison with the one as registered is not challenged. Establishing the scope of admissible changes, the Supreme Administrative Court (the SAC) takes a stand that classifying a trademark in a modified form as genuine use is possible only as much as such modification does not affect the distinctive features of the trademark as well as does not lead to the change of the trademark substance itself. Yet, in order to render a decision on fulfillment of the obligation to use a trademark being different from its registered form, opinion of average consumer is significant above all (SAC's judgment of January 31, 2012, case no. II GSK 1502/10).

The case which covered the above theses concerned maintenance of the protection of the word trademark „transpak gotuj ze smakiem" destined for *all kinds of spices/condiments.* At this point, the readers who do not know the Polish language need to be explained that the word "transpak" is of fancy character in Polish and the words "gotuj ze smakiem" may be categorized as a slogan which means "cook with taste". Additionally, the word "Transpak" as well as the slogan "gotuj ze smakiem" were not placed next to each other on packaging of the right holder's goods as the words "gotuj ze smakiem" were inserted on their reverse side.

Another aspect considered in the subject case was the scope in which the right holder used the trademarks. Since in the course of the proceedings before the Polish Patent Office he produced the evidence regarding only the use of the designation for *single-component spices/condiments* (inter alia: lovage, granulated garlic, allspice). Hence, in the SAC's opinion, the right holder failed to provide the evidence for genuine use of the conflict trademark for *all kinds of spices/condiments.* By the same, the Court pointed to a potential possibility of declaring the subject right lapsed in the part regarding *multi-component spices/condiments* (inter alia: condiments for stew, condiments for tripe, condiments for bigos [typical Polish dish], Provencal herbs). The SAC took a position that the goods category, namely *all kinds of spices/condiments* is broad enough to distinguish several sub-categories within it, including *single-component spices/condiments* sub-category. Taking into consideration the above SAC's attitude, which needs to be accounted for by lower instances since the case was transferred for re-examination, it seems that it will be difficult for the right holder to prove the genuine use in this respect.

The next aspect which is of recurrent nature in the Polish practice is registering of similar trademarks for the benefit of related business entities or upon so called "letter of consent" granted by right holder.

In the SAC's view, the information about the source of origin contained in trademark, i.e. business-related group of enterprises, must ensue from the trademark itself and it cannot be derived from legal and organizational relations between two or more companies for the purpose of being granted protection. Furthermore, in light of the binding national law, the protection right to trademark enables the right holder to enjoy the exclusive right to use such trademark in the territory of the Republic of Poland. For this reason, granting the protection right for a given trademark means that other business entity may not be granted with the same. Consequently, from the perspective of binding law provisions, financial/equity relations between the trademark right holder and different business entity may not be the factor entitling said different business entity to have identical or similar trademark destined for identical or similar goods registered in its name (SAC's judgment of December 16, 2011, case no. II GSK 1378/10).
Another SAC's judgments states that the industrial property law is to guarantee the protection of interests of both entrepreneurs and consumers where the entrepreneurs' will alone does not directly shape public policy. Accordingly, the will of the parties to agreement may not be valid and effective against the mandatory law provisions concerning eg. confusing similarity (SAC's judgment of December 8, 2011, case no. II GSK 1261/10). Accounting for the above, the current Polish case law excludes registration of similar or identical trademarks in the name of different legal entities even in the cases when they are organizationally related and/or the right holder of prior trademark consents to such registration.

One of the conditions making registration of a trademark possible in the Polish Patent Office is the fact of filing a trademark application in bad faith. Such condition refers, in a straight line, to the intention which the applicant had doing so. In the case law it is underscored that this specific condition is applicable in the situation when the trademark was applied for the purpose of i) blocking another application or ii) blocking the use of the designation which was used by a legal entity in the market or iii) for the purpose of taking over the market position from the legal entity using the trademark. Bad faith is also applicable iv) when trademark application was filed for speculative reasons without intent to use such trademark but only to profit from the entity which is in possession of such trademark. A trademark application is filed in bad faith also v) in the circumstances when applicant, without exercising due diligence or being aware of it, files the same with infringement of the rights vested in other person as well as when it files application inconsistently with good and fair trading practice (District Administrative Court's judgment of January 17, 2012, case no. VI SA/Wa 2051/11).
The above theses were discussed with quite interesting facts of the case since they concerned granting the protection right to the trademark COOL RIVER which was contested by the right holder of the renowned trademark COOL WATER. However, both the Polish Patent Office and the District Administrative Court [the DAC] stated that the two juxtaposed trademarks are not sufficiently similar to find any infringement of the renown. Moreover, in the DAC's opinion, the designation COOL RIVER refers to a certain natural phenomenon (cool flowing river) whereas the words COOL WATER has no character. The DAC also underlined that the trademark COOL RAIN (cool falling rain) would be closer in the description of such phenomenon and by the same, dissimilar to the meaning of the trademark COOL WATER. Consequently, in light of no similarity, in the DAC's opinion neither acting in bad faith nor infringements of the renown are applicable here.

Finally, I would like to draw your attention to one more interesting judgment wherein the SAC opposed to mechanical and artificial applying of prerequisites to establish renown which were referred in the hitherto case law (eg. ECJ's judgment of September 14, 1999 in the case C-357/97, CHEVY). In some cases these prerequisites are not adequate, specifically with respect to the designations whose market position was not developed in relation to the services and goods widely offered, such as FMGC. The SAC confirmed that the obligation to consider all substantial facts of the case should not be identified with the necessity of applying all criteria of assessment indicated in the hitherto case law each and every time. In SAC's view, in each case the authority which applies the law should stipulate which criteria of the assessment of trademark renown are adequate for making the assessment in specific facts of the case. Facing the facts of the case the above judgment refers to, the Court stated that that

a relation between the trademark DAKAR and the sport event, i.e. the rally and the renown associated with this event as well as the field of exploitation of the said trademark in the market are the aspects which are particularly noteworthy (judgment of May 25, 2011, case no. VI II GSK 857/10).

I hope that the above brief (out of necessity) and concise overview has enabled its readers to gain at least some knowledge of current problems which trademarks face in the Polish practice.

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