

Trade marks and unfair competition

Introduction

Here is yet another bulletin on trade mark and unfair competition law.

This edition includes coverage of plans of the European Commission to change the trade mark protection system. The draft amendments presented by the Commission aim at modernizing the system for registering trade marks throughout the EU, leading to a simplification and harmonization of registration procedures and to increased effectiveness of the measures used in fighting counterfeit goods shipped through EU territory. In addition, one of the Commission's goals to be implemented through the reform is to facilitate cooperation among relevant member state authorities and the OHIM.

I encourage you not to miss the articles on current rulings and decisions issued at both the Community and domestic levels in the first quarter of this year.

In one such ruling in relation to the figurative designation 'MEDINET', the General Court of the EU considered, among other issues, those of a claim of seniority of earlier trade marks and a lack of identity between the marks.

In another ruling in respect of the designations 'WALICHNOWY MARKO' and 'MAR-KO', the EU General Court mainly addressed the issue of the likelihood of consumers being confused.

And in a third ruling, we give you insight into the circumstances of a dispute resolved by the EU General Court in which both sides to the dispute were Polish companies. The key issue was, again, the likelihood of consumers being confused.

We have also included an article on a mark which you certainly know, which shows a polo player on a horse. In March of this year, that designation was confronted with a designation showing a polo player on a bicycle. The OHIM Board of Appeal reached the conclusion that the two figures are not similar to each other, and that therefore there is no risk of consumers being confused as to the origin of the goods concerned.

From among recent rulings by Polish courts, we have chosen two which treat the similarity of designations such as 'PROVENDA' and 'PROVENA', or 'STIHL' and 'STILO', as well as a ruling in which the Provincial Administrative Court addressed the subject of registering geographic names as trade marks.

This year, we plan to continue including press articles published by members of our team. In this issue, I recommend an article on how to protect your own brand against competitors.

I hope you enjoy the bulletin, and as always encourage you to send in any comments you may have – for which I thank you in advance.

Oskar Tułodziecki

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Legislative initiatives

EU – European Commission plans changes to the protection of trade marks

On 27 March 2013, the European Commission presented a raft of initiatives designed to make the registration of Community trade marks at the Office for Harmonization in the Internal Market (OHIM), as well as national trade marks in individual EU countries, less expensive, faster and more predictable. The proposed reform is aimed at increasing the popularity of registering distinctive marks as trade marks as well as allowing more effective use of the protection of marks in the face of goods marked with counterfeit trade marks being introduced to trade in the EU.

The proposed package contains three initiatives: (i) an amendment of Directive 2008/95/EC to bring the laws of Member States relating to trade marks closer together, (ii) an amendment of Regulation 207/2009/EC regarding Community trade marks, and (iii) an amendment of the regulation on the fees payable to the OHIM. Work on these projects is still ongoing. The transformation of Directive 2008/95/EC and Regulation 207/2009/EC proposed in the form of a legislative proposal, which must be adopted by the European Parliament and the Council under a co-decision procedure, will probably take place in mid-2014. Amendments to the regulation governing fees will be adopted by the Commission in the form of secondary legislation, probably by the end of this year.

Further harmonization of laws

One of the most significant proposed changes is that national patent offices should

examine matters relating to the registration of trade marks only in relation to the absolute prerequisites for the protection of the marks, without examining the relative evidence, i.e. that relating to the existence of prior similar or identical trade marks belonging to other entities that may constitute an obstacle to registration of the mark. According to the Commission, the main argument in favor of this change is the large number of disputes between competitors entitled to similar trade marks in a number of EU countries, including Poland, despite analyses of the relative prerequisites for protection having been conducted.

The draft directive also includes the establishment of administrative procedures for the invalidation of protection rights to trade marks in those countries where such procedures do not apply. The provisions of the Industrial Property Law provide for an administrative-law procedure for invalidating trade marks in the course of litigation proceedings before the Patent Office of the Republic of Poland, so this change will not cause a transformation of the current system of annulments in Poland.

Requirement for the graphic's representability to be amended

One of the basic criteria for the registrability of trade marks is that they be presented in graphic form in the trade mark application. This criterion is easy to meet when the application concerns a traditional trade mark consisting of letters, numbers, or other forms perceptible by sight. A mark submitted in a non-traditional form (such as an audio mark or a fragrance) and which is not subject to visual perception can be accused of failing to meet the criterion of graphic representability, so an attempt has been

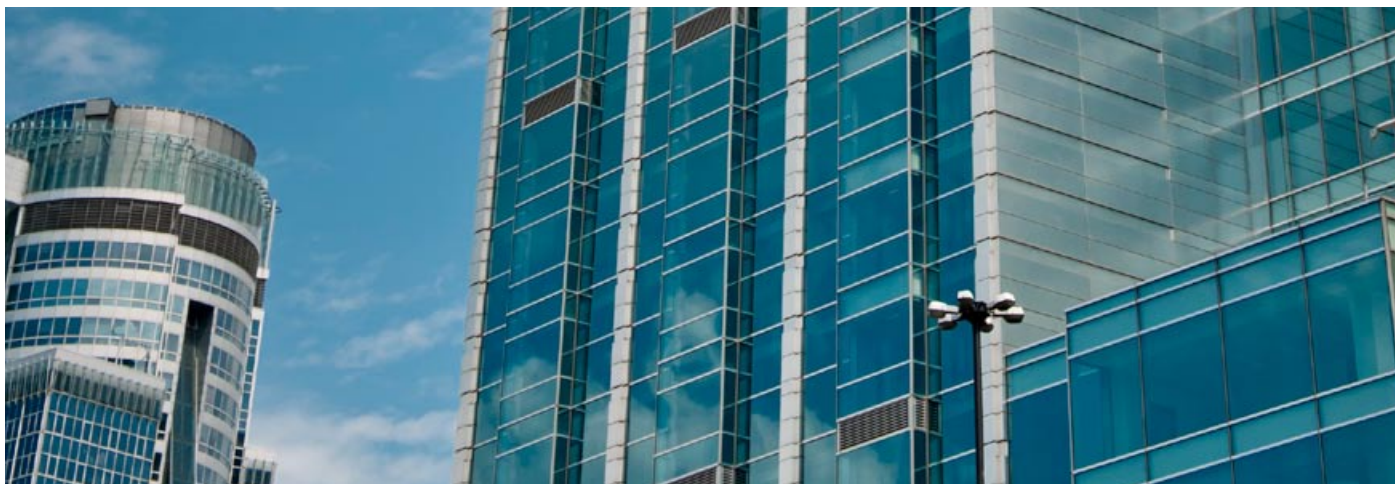
made to redefine this criterion. This involves accepting the possibility of registering unusual characters, which are increasingly common due to advances in technology. This change affects applications for Community as well as national trade marks.

A fee for each class

The Commission proposes rules for the payment of fees for a single class of goods or services for which the trade mark is applied for. This rule will apply to applications for both Community and domestic trade marks. In the current system, the basic application fee for a Community trade mark at the OHIM, as well as for a domestic mark at the Polish Patent Office, automatically covers the first three chosen classes of goods or services in the Nice Classification. This is the case even though an applicant may seek protection for goods or services of only one class. If the proposal is adopted, the fees for entities which would like to obtain protection only for goods in one class of the Nice Classification will be different from those charged to entities seeking protection in more classes.

Lower official fees for Community trade mark applications

The current basic fee for a Community trade mark (CTM) for goods or services of three classes is 900 euro. The proposed basic fee is 775 euro for one class, 825 euro for two classes, and 900 euro for three classes (plus 150 euro for each additional class). The changes in fees will only affect those entities that apply for the protection of goods or services of one or two classes of the Nice Classification. A reduction will also apply to the fees for extending protection of a trade mark for a further ten-year period:



1,000 euro in one class, 1,100 euro for two classes and 1,250 euro for three classes.

The application fee for a Community trade mark may be settled within one month from the date of submission of the mark to the OHIM. Under the new proposal, proof of payment of the fee must be presented when submitting the application.

CTM applications only at the OHIM

It will only be possible to apply for a Community trade mark at the OHIM. Currently, it is possible to apply at a national patent office, which then forwards the application to the OHIM. With advances in technology, the most popular form of applying is electronically, and so plans are afoot to abolish the option of submitting an application for registration at the national patent office.

Source: www.ec.europa.eu ■



Case-Law

EU – Claiming the seniority of an earlier trademark and lack of similarity of the designation ‘MEDINET’: ruling of the General Court of the EU

In a ruling of 20 February 2013, the EU General Court (T-378/11) dismissed a complaint by the company Franz Wilhelm Langguth Erben GmbH & Co. KG with its registered office in Germany, which had submitted a motion for invalidation of a decision of the OHIM dismissing an application on a claim of the seniority of earlier trade marks (national and international).

In 2009, the company registered the Community trade mark ‘MEDINET’, seen below:



The company also claimed seniority of earlier graphic marks – a domestic mark registered in Germany and effective in Austria, the Benelux countries, the Czech Republic, France, Hungary, Italy, Poland, Slovakia and Slovenia. The earlier trade mark comprises the following figurative sign with the word element ‘MEDINET’:



The OHIM found that the claim of seniority could not be accepted, because the marks do not meet the requirement of being identical. The trade mark applied for did not indicate any color, while the earlier marks were in the color gold.

The Court confirmed the reasoning and decision of the OHIM. It stated that, in order for an application for a claim of the seniority of an earlier trade mark over an application for a Community trade mark to be accepted, three conditions must be satisfied: first, the goods and services covered by the Community trade mark applied for must be identical to those covered by the earlier trade mark or contained within those classes. Second, the earlier trade mark and the trade mark applied for must be identical. And finally, the owner of the marks in question should be the same entity.

According to the OHIM, the prerequisite for the identity of the marks was not satisfied in this case. Having considered the applicant’s complaints, and after examining whether the OHIM correctly assessed those prerequisites, the Court confirmed the correctness of the OHIM decision. The key matter in this case was to answer the question of whether the difference between the marks results from the fact that the earlier marks are in a gold color while the mark submitted does not indicate any color constitutes a difference which prevents the marks from being deemed identical.

In the contested decision, the OHIM stated that EC Regulation no. 207/2009 does not contain a norm under which a black-and-white sign is protected in all colors. The Court pointed out, however, that in light of the prerequisites for priority to a trade mark, the scope of protection is

not important and should not be taken into account. On this point, the reasoning of the OHIM was not correct, but despite this error, the OHIM issued the correct decision.

The Court explained that when the OHIM and the parties refer to the black-and-white mark, it does not mean that the Community trade mark for which registration was made indicates the colors black and white, but that the mark does not indicate any particular color at all. Hence, the trade mark cannot be regarded as identical to the earlier gold-colored mark.

For these reasons, the Court dismissed the complaint.

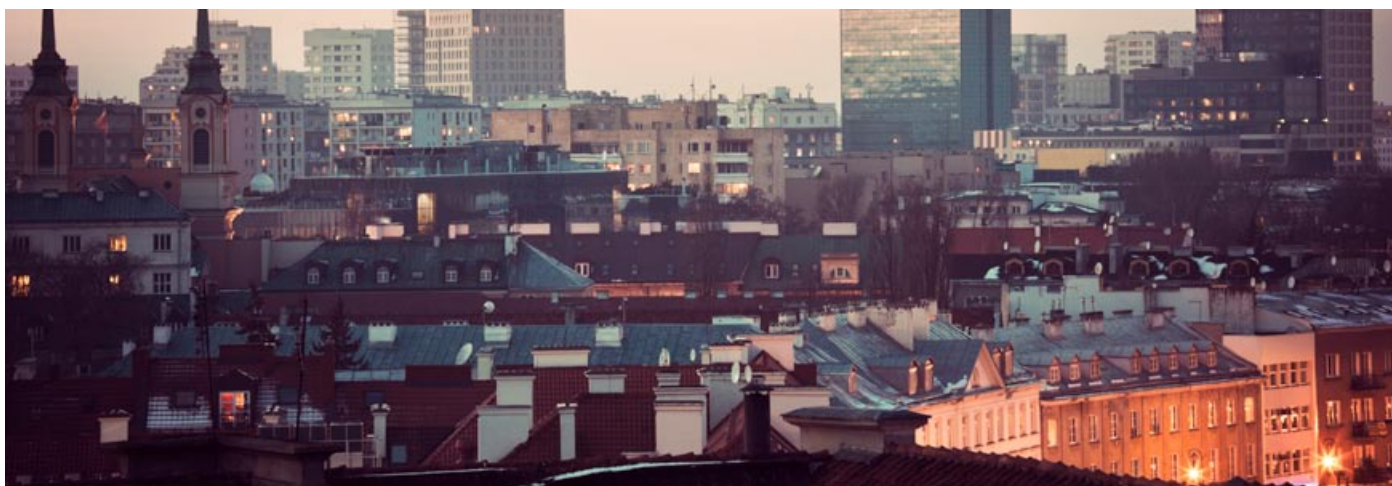
Source: www.curia.europa.eu

EU – ‘WALICHNOWY MARKO’ and ‘MARK-KO’ and the likelihood of consumers being confused: ruling of the General Court of the EU

On 14 August 2008, Mr. Marek Marszałkowski filed an application for registration of the Community trade mark ‘WALICHNOWY MARKO’, including for goods belonging to Class 29 of the Nice Classification. That application was published in the Community Trade Marks Bulletin No. 3 of 26 January 2009.



On 19 February 2009, the company Mark-Ko Fleischwaren GmbH & Co. KG lodged an opposition to the registration of the ‘WALICHNOWY MARKO’ mark, claiming



an infringement of Article 8 par. 1 letter b) of Regulation 40/94 (current Article 8 par. 1 letter b) of Regulation 207/2009), under which, in response to an opposition by the owner of an earlier trade mark, a mark submitted is not registered if “because it is identical or similar to the earlier mark there exists a likelihood of public opinion being confused within the territory in which the earlier mark enjoys protection; the likelihood of confusion of the consumers also includes the likelihood of an association with the earlier mark”. The party raising the opposition based its position on the previous registration of the Community word trade mark ‘MAR-KO’, registered for its benefit on 20 September 2005 (CTM 336451) for goods belonging to Class 29 of the Nice Classification.

By a decision of the OHIM Oppositions Division on 9 April 2010, that opposition was dismissed. The Oppositions Division held that, in the case at hand, there was no likelihood of consumers being confused.

On 3 May 2010, Mar-Ko Fleischwaren GmbH & Co. KG appealed against that decision by the Oppositions Division. In a decision of 11 January 2011, the OHIM Fourth Board of Appeal partially agreed with the appeal, thereby overturning the decision issued by the Oppositions Division as it pertained to there being no likelihood of consumers being confused. The Board of Appeals emphasized that an evaluation of the existence of such a likelihood must be correlated with the way in which a given sign is perceived, and it is sufficient to take account only of part of the European Union, in this case “all Polish consumers”. Further, in the view of the Board of Appeal, the term ‘marko’ possesses an average level of distinctiveness, and therefore there does exist a likelihood of consumers being

confused with regard to goods which are similar, and in fact partially identical.

That assessment was confirmed by the Court in a ruling of 4 February 2013 (T-159/11), in which it emphasized that “generally, the concept of cold meats overlaps with that of meat”. The Court upheld the reasoning of the Board of Appeal, which had expressed the view that, in evaluating the likelihood of confusion, it was sufficient only to consider the distinctive and dominant element of the word element ‘marko’, while the other components of the mark could be deemed of little relevance in this case. For it is the word element which dominates in what a given group of consumers remembers about the mark as a whole, and so the other elements cease to be significant. Consequently, it had been correctly determined that there did exist a likelihood of confusion, and the appeal had been rightly dismissed.

Source: www.curia.europa.eu

EU – A Polish acronym and a Community trade mark: ruling of the General Court of the EU

Increasingly, disputes between Polish companies over trade marks reach the General Court of the EU. In March, a ruling was handed down in a conflict between Fabryka Łożysk Tocznych – Kraśnik S.A. and Impexmetal S.A. The two companies fell into conflict over marks containing the word-figurative element ‘FŁT’.

A mark containing that acronym inscribed in a circle and decorated with a drawing of a stag with a drawing of a roller bearing in the background was submitted for

registration by Fabryka Łożysk Tocznych from Kraśnik. The registration was opposed by Impexmetal, which holds the right to an earlier Community trade mark comprising a graphic presentation of the acronym ‘FŁ’ in the color red. The marks concern goods which are identical, that is, roller bearings. The identical nature of the goods was not contested by the parties to the dispute.



FŁT

The OHIM refused to register the designation submitted by Fabryka Łożysk Tocznych from Kraśnik, which then filed a complaint with the EU General Court.

The complainant based its appeal on a single claim, namely, that the OHIM had committed an error in holding that the coexistence of marks may lead to a risk of consumers within the EU territory being confused. In accordance with case law, there is a likelihood of confusion if consumers could believe that the given goods or services identified with the marks derive from the same company or from companies which have economic ties with each other. This is possible where the marks in question are identical or similar.

The complainant argued that the mark it submitted is not similar to the Impexmetal mark. Fabryka Łożysk Tocznych claimed that the only common element between the



marks is the capital letters 'F', 'Ł' and 'T', and further, that Fabryka's mark contains a number of distinctive figurative elements. The graphic appearance of the acronym 'FŁT' itself differs widely in the two marks. In the complainant's opinion, the marks can be easily differentiated, even only by their different coloration.

And yet, as the Court emphasized (T-571/10), although a trade mark must be assessed in terms of the overall impression it makes, word elements are in principle more distinctive than figurative elements. When referring to a mark, the average consumer will use only its verbal element (since only this can be pronounced). Moreover, the capital letter 'Ł', unknown to people who do not speak Polish, will be particularly significant – those who see the mark will pay particular attention to it as something which is foreign. This is especially important in the case of Community trade marks which apply in an area inhabited by large numbers of people who do not speak Polish. The shape of the letters has no significant impact on the impression made by the graphic aspect of the designation. In summary, the Court concluded that the contested marks are similar on the phonetic level, as well as visually to a certain extent.

The assessment of the likelihood of confusion should be made with regard to the relevant group of consumers. The contested marks are addressed to persons having a level of attention higher than that of the average consumer (they are specialized businesses using roller bearings in industry). The complainant, however, failed to provide any evidence that that specialized group of consumers associated the element 'FŁT' with it, and not with Impexmetal.

The Court dismissed Fabryka's argument that the mark will be identified with its name because the mark is an acronym of that name, and is therefore particularly distinctive in nature. The Court emphasized that a previous 'FŁT' mark exists, and that, if one admits the particular distinctiveness of the mark submitted by Fabryka, one must also ascribe that same distinctiveness to the earlier mark with which Fabryka's mark is in conflict. In other words, a mark having particular distinctiveness would be in collision with another mark having particular distinctiveness. Therefore, that argument is irrelevant to the case.

The complainant also tried to draw on the situation within Poland to show that there is a lack of likelihood of confusion by the mark it submitted. It claimed that in Poland the two marks coexist with each other. In the Court's view, however, the complainant failed to demonstrate that this coexistence did not involve consumers being confused.

Therefore, the two marks should be deemed similar, and since the complainant did not produce evidence showing that consumers are not being confused by its designation, the EU General Court dismissed the complaint.

Source: www.curia.europa.eu

EU – Many (polo) players in the clothing industry: decision of the OHIM Board of Appeal on the submission of a figurative mark showing a polo player on a bicycle

In case R 15/2012-2, heard in March 2013, the OHIM Board of Appeal had to determine

whether a newly-submitted Community figurative trade mark showing a polo player on a bicycle is similar to the well-known polo player on a horse – the one used by Polo Ralph Lauren to identify its products, clothing in particular.



The bike polo designation was submitted for goods from Classes 18, 25 and 28 of the Nice Classification, including clothing, headwear and shoes. Polo Ralph Lauren filed an opposition to the submission based on its prior possession of similar trade marks for identical products. The OHIM Oppositions Division dismissed the opposition in its entirety, justifying its decision in that there is no ultimate similarity of the marks, despite the identity of the goods for which they were submitted. The marks were held to be sufficiently different visually to such extent that consumers would not be confused as to the origin of the goods they identify.

The company Polo Ralph Lauren appealed against that decision, claiming that the marks compared have many similarities, both visually and conceptually. It also argued that the use of the later mark showing a polo player on a bicycle to identify clothing products could be taken by consumers as an expansion of the existing portfolio of Polo Ralph Lauren trade marks.

The OHIM Board of Appeal also found



the two marks to be dissimilar. Even though both players use a long mallet, they use a different means of transport, which unambiguously differentiates the two marks. The Board of Appeal then conducted a survey of whether, despite the absence of similarity between the marks and the identical nature of the goods involved, consumers could be confused as to the origin of goods identified by the marks. It concluded that there is no risk of confusion, and buyers of goods identified with the bike polo player will not believe they are buying Polo Ralph Lauren brand products, or that there are economic ties between the two companies in dispute.

Source: www.oami.europa.eu

Poland – Similarity of the designations ‘PROVENDA’ and ‘PROVENA’: ruling of the Provincial Administrative Court in Warsaw

In a decision of May 2012, the Polish Patent Office (PPO) invalidated a protection right to the trade mark ‘PROVENDA’ as pertains to certain goods from Class 30 of the Nice Classification. The protection right to the word-figurative trade mark ‘PROVENDA’ belongs to E. sp. z o.o.

The proceeding for invalidation of the protection right to the word-figurative trade mark ‘PROVENDA’ was initiated in result of an opposition by R. in July 2010, based on that party’s rights to the Community word trade mark ‘PROVENA’.

The PPO made an assessment of the similarity of the two trade marks, first comparing the goods to which they apply.

The PPO found that R.’s opposition was partially justified, although it did not share R.’s opinion regarding the similarity of the products bearing the disputed trade mark, such as semi-finished food products from powder based on starch, including potato pancakes, potato puree, breadings, spices, and stiffeners for whipped cream from Class 30 of the Nice Classification. The PPO held that those products, as well as similar or complementary products, are not protected by the other trade mark.

In evaluating the similarity of the two trade marks, the PPO also held that both marks are phonetically similar. In pronouncing the trade mark ‘PROVENDA’, the letter ‘D’ is pronounced ‘shortly’ and indistinctly. In the PPO’s view, this means the two marks cannot be sufficiently distinguished, and a potential consumer could easily overlook the slight difference between them. Moreover, according to the PPO, the visual aspect of the contested mark also plays a role in the similarity between the two marks.

Finally, the authority held that the identical or similar nature of the goods involved and of the designations in the two trade marks means that there is a risk of consumers being confused as to the origin of the goods the marks identify. In the opinion of the PPO, consumers, who in this case are average Polish consumers, could believe that goods identified with the marks compared derive from a single source or belong to a series of marks. Goods identified with the marks ‘PROVENDA’ and ‘PROVENA’ are offered in the same outlets, namely, in grocery stores, supermarkets and hypermarkets.

In May 2012, R. and E sp. z o.o. filed complaints against the PPO decision. In a ruling on 10 January 2013

(VI SA/Wa 1981/12), the Provincial Administrative Court (PAC or Court) in Warsaw held that R.’s complaint is justified, whereas that of E. sp. z o.o. is not.

In the PAC’s view, R. rightly charged that the PPO had not tested the case exhaustively, had neglected a series of circumstances important to its decision, and had incorrectly justified its decision.

With regard to E. sp. z o.o.’s complaint, the PAC ruled that the PPO had correctly accepted that, in assessing the similarity of protected marks, the allocation of the goods is of decisive importance. When buying goods, the average consumer does not perceive differences between extracts and concentrates or between fruit sauces without starch and semi-finished powdered food products based on starch, including sauces and instant sauces. For consumers, such goods are merely products used to prepare meals.

The Court also shared the position of the PPO regarding the similarity of the designations in each of the two trade marks. In accordance with the view well established in the legal doctrine and case law, a comparison of marks is made according to their similarities, not their differences. That is why, in the opinion of the Court, the PPO correctly focused on the word elements ‘PROVENDA’ and ‘PROVENA’, perceiving that they are similar. The Court shared the PPO’s position in this respect all the more so since in the ‘PROVENDA’ mark the graphic elements are not distinctive enough to prevail over the word element.

In addition, the Court found no basis for questioning the authority’s assessment of the risk of consumers being confused as to the origin of the goods identified with the two trade marks. The Court found that



there does exist a risk of confusion among consumers, who would have reason to believe that goods identified with 'PROVENA' and 'PROVENDA' derive from the same business or from companies which are somehow organizationally connected with each other.

Source: <http://orzeczenia.nsa.gov.pl>

Poland – The word-figurative marks 'STILO' and 'STIHL' are not similar: ruling of the Supreme Administrative Court in Warsaw

In a previous bulletin (3/2011), we described a ruling of the Provincial Administrative Court (PAC or Court) in Warsaw of 27 April 2011, case file No. VI SA/Wa 275/11, dismissing a complaint by Andreas Stihl AG & Co. KG against a decision by the Polish Patent Office (PPO) on registration of the word-figurative trade mark 'STILO' for the benefit of Przedsiębiorstwa Produkcyjno Usługowo Handlowego PROMA Rafał Grabczyk for goods from Class 8 of the Nice Classification.

In its justification, the PAC referred to Article 132 par. 2 pt. 3 of the Industrial Property Law, which lists the prerequisites for obtaining a protection right to a trade mark. The absence of any of those prerequisites prevents the Article from being applied. They are: the identical or similar nature of the trade marks, the renown of the mark having earlier priority, detriment to the distinctiveness or renown of the mark having earlier priority, or the submitting party reaping unjustifiable benefits.

STIHL

STILO

The court of first instance compared the contested marks on the phonetical, semantic and visual levels, given their verbal nature, assuming that the average consumer is duly informed, prudent and rational.

The PAC concluded that, on the phonetic level, the two marks are pronounced differently, given that the contested mark 'STILO' contains a suffix which causes it to be pronounced differently than 'STIHL'. On the level of meaning, the court of first instance noted that both marks derive from a foreign language, but for the average consumer the words they use are understandable and their meaning correctly perceived. The word 'STIHL' is a fantasy word of no defined meaning, whereas 'STILO' may suggest a well-known place. The court ruled that, visually, the two marks differ considerably in their construction – although their appearance is not complex, both being composed of a commonplace font written in capital letters on a white background.

Based on such an assessment, the court held that there is no risk of consumers being confused as to the origin of goods the two marks identify, and that therefore the prerequisite in Article 132 par. 2 pt. 3 of Industrial Property Law of the identical or similar nature of the trade marks had not been met.

The PAC also held that the authorities ruling in the case had conducted the proceedings correctly, in accordance with the standards contained in the Code of Administrative Procedure. In particular, the court of first

instance pointed out that, in proceedings before the PPO, the burden of proof lies primarily on the party to the proceeding.

The complainant lodged a cassation appeal against that decision to the Supreme Administrative Court, claiming that the ruling breached material law by holding that goods identified with the mark 'STILO' are not similar to those identified by the mark 'STIHL', and that those marks are not similar to each other, and that registration of the mark 'STILO' will not cause consumers to be confused in making an erroneous association between it and the mark 'STIHL'.

In its response to the appeal, the SAC upheld the position presented by the PAC in its ruling and dismissed the appeal, case file No. GSK 1877/11.

Source: <http://orzeczenia.nsa.gov.pl>

Poland – A geographical name as a trade mark – 'PLISKA': ruling of the Provincial Administrative Court in Warsaw

In a ruling of 26 February 2013, the Provincial Administrative Court (PAC or Court) declared itself on the subject of registering geographical names as trade marks (VI SA/Wa 2306/12).

The dispute on which the above non-binding ruling was handed down concerned the designation 'PLISKA'. Pliska is a small town in Bulgaria. In Poland, 'PLISKA' functioned for many decades as a designation for Bulgarian brandies sold throughout the Communist period. The mark's first registration expired as a result of the bankruptcy of the manufacturer, after which it was resubmitted to the Polish Patent



Office (PPO). The PPO refused to grant the registration, and the matter went to the administrative court. In a first ruling issued in 2010, the PAC dismissed the applicant's complaint, maintaining the position that the designation is not distinctive. Since 'Pliska' is a geographical name, in the view of the Court any registration thereof could hinder other businesses from using it in trade. The Court also held that the registration of a designation associated with Bulgaria by a Polish company having its registered office in Warsaw is inherently confusing for consumers.

As a result of a complaint against that ruling, the case went to the Supreme Administrative Court, which overturned it for procedural reasons, and the problem was referred back to the PAC for reconsideration. After a renewed analysis, the PAC ruled that a geographical name is ineligible for registration only when the average consumer associates the designation in question with its geographical usage. Therefore, there is no obstacle to geographical names being registered as trade marks in other situations. What is more, the fact that consumers could associate a mark with a given geographical name, and not with a once-popular alcohol, would have to be documented. The Court also expressed the view that there is no automatic prohibition on registering foreign names by companies having their registered office in Poland. Such a registration does not necessarily mean that the mark in question will be confusing for consumers.

Source: <http://prawo.rp.pl>;
<http://orzeczenia.nsa.gov.pl> ■



Other issues

Poland – How to protect your own brand against competitors¹

Marta Wysokińska

Marks have always been very important and constituted something of great value. It is for this reason that they became subject to legal protection. The basic way of protecting marks and other designations of goods and services came to be the registration of trade marks. The registration of a trade mark, that is, obtaining legal protection of a trade mark, guarantees the exclusive rights to use that mark commercially or professionally throughout the entire area of the Republic of Poland. Such a mark fulfills the basic function of distinguishing certain goods and services from those of competitors.

In order to register a trade mark, it is necessary to submit the designation to the Patent Office. If, after considering the matter, the Patent Office decides to grant a protection right to the trade mark, that right will be effective retroactively, in that protection will be afforded since the date of the application. Trade marks are registered in relation to specific goods, which must be specified in the trade mark application. A protection right to a mark guarantees the exclusive use of that mark in relation to the goods specified in the application. The Patent Office notifies market participants about submissions and grants protection rights by way of relevant announcement. These are published in the *Patent Office Bulletin*, and once this has taken place, we can familiarize ourselves not only with the mark itself, but also with the list of goods for which it is designated. Information on the issuance of decisions granting protection rights, that is, on the factual registration of marks, is published by the Patent Office in *Patent Office News*.

The Patent Office also publishes electronically

Information on trade mark applications and decisions issued on granting protection rights can serve as tools of defense against competitors registering designations which are too close to our own trade mark. Patent Office publications are available in electronic form on the Patent Office website, and afford a means of checking what steps competitors may be taking in respect of trade mark registrations.

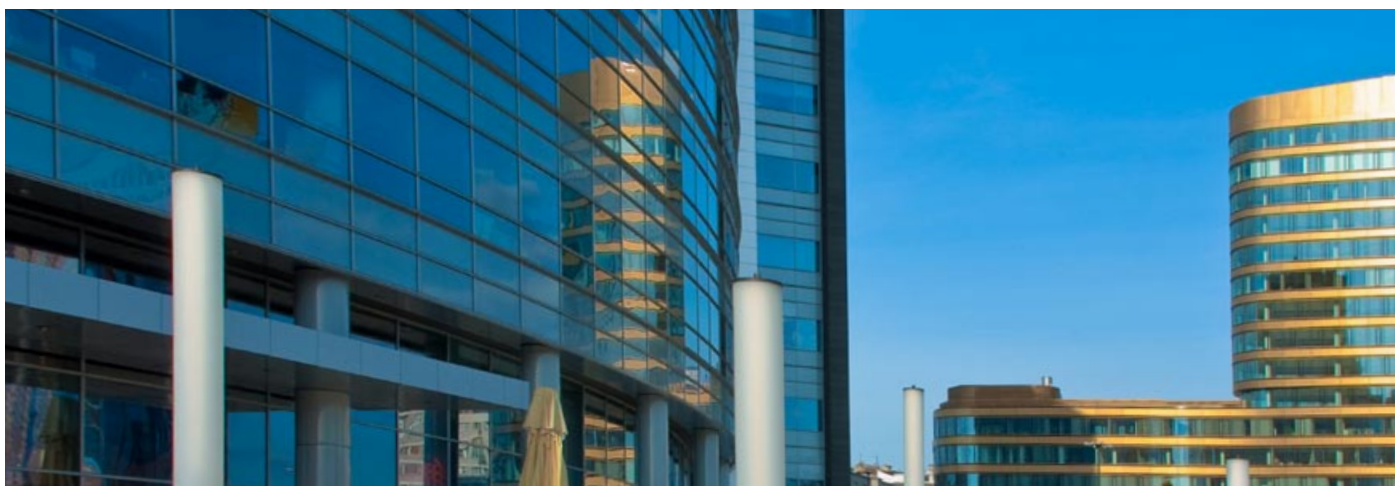
When registration is rejected

There are a number of reasons for which the Patent Office should not register a mark. Under the Industrial Property Law, for example, it results that protection rights are not granted for designations whose use infringes the personal or property rights of third parties. One of those rights is copyright to a work such as a graphic trade mark. It should be remembered that, in order to make use of such a right where a mark was not created by the entity applying for registration of the mark, care should be taken to effectively acquire copyright (in light of the Copyright and Related Rights Act) from the graphic designer who created the mark.

Other reasons for refusing to register a mark submitted result from the registration of an earlier identical or similar mark. In principle, the Patent Office should not grant a protection right to a trade mark which is identical to a trade mark registered or previously submitted for registration for identical goods. In other words, if we are dealing with an attempt to register an identical later mark for identical goods, the mark submitted later should not be registered.

The provision states, moreover, that the Office should not register a designation which is identical or similar to an earlier trade mark for the same or similar goods if there arises a risk of consumers being confused. The risk of confusing consumers also covers the possibility of the mark submitted for registration being associated with the earlier mark. This means that, in the case of identical marks but different goods bearing those marks, the entity having earlier registration can protect itself against registration of its competitor's mark if it can show that the goods covered by the new mark are similar to its goods and that the coexistence of the two marks on the market entails a risk of consumers being confused as to the origin of the goods. Being confused involves, e.g., buyers of goods identified with the later mark believing that they derive from the entity entitled to the earlier mark. Protection is also due where there is an attempt to register a mark which is not identical, but similar, but for identical or similar goods – in such a case there must be prior registration of the mark and the risk of consumers being confused must be demonstrated.

¹ This article appeared in Rzeczpospolita on 25 January 2013 under the same title; the author is an attorney cooperating with K&L Gates Jamka sp. k.



In certain situations, it is not necessary to have prior submission for registration by the Patent Office in order to have a competitor's application rejected. If a mark has not been submitted for registration but is widely known, it may be possible to demand that it be protected. However, it is not easy to prove that a designation is widely known – and so it is worth registering your marks.

Remarks and oppositions

Where, thanks to Patent Office publications, an attempt to register a mark which infringes the rights of a given business is identified, two remedies are available. The choice depends on what stage the registration process is at. After publication of information on the submission of a trade mark in the *Patent Office Bulletin*, but before the Patent Office issues a decision on granting a protection right, remarks may be submitted to the Office, in which it should be stated why the trade mark submitted should not be registered. Even though the Patent Office analyzes all marks submitted, it is worth providing such remarks, for they may eliminate the need to take further action at the next stage, as discussed below. If, however, remarks are not submitted in the expectation that the Office will make an appropriate assessment on its own and refuse to grant the registration, or if the Office does not take account of remarks submitted, or if the announcement on the mark was noticed too late to submit remarks, then it is possible to file an opposition against the issuance of the protection right to the trade mark. An opposition must be filed within 6 months following the date of publication on the granting of the protection right in the *Patent Office News*. Referring, for example, to the aforementioned conditions for refusing to register the mark submitted, the opposition must contain the reasons why registration should not have occurred. The Office informs the entity which applied for registration of the mark about the opposition and sets a deadline for it to submit its position in the matter. If the applicant argues that the opposition is groundless, a dispute proceeding begins before the Patent Office, during which the Office considers the conditions for refusing registration as stated in the opposition. After the dispute proceeding, the Office decides on whether to invalidate the protection right. If, however, the applicant does not claim that the opposition is groundless, the Patent Office issues a decision overturning the decision to grant the protection right and adjourns the proceeding.

If at first you don't succeed

If, after judging the merits of the opposition in the dispute proceeding, the Patent Office dismisses the opposition and upholds the protection right to the trade mark, a party which is dissatisfied with such a ruling has the right to submit a motion for reconsideration of the matter. Such a motion acts as an appeal. If the Patent Office dismisses that motion, protection can still be sought. A complaint against the decision of the Patent Office can be filed with the Provincial Court of Administration.

Practice

In practice, there is no lack of conflicts between designations. The results of such disputes are difficult to predict. Legal counsel try to convince the Patent Office and administrative courts that their point of view is correct, illustrating the similarities between marks, or that there exists a risk of consumers being confused if too similar marks are allowed to coexist. An example of such a case is the long-standing dispute before the Provincial Administrative Court in Warsaw over the designation 'Globi Codziennie Niskie Ceny' ('Globi Low Prices Daily'), which well illustrates the complexity of the issues relating to trade mark protection. The Patent Office registered the word-figurative mark 'Globi Codziennie Niskie Ceny'. An opposition was raised by the company entitled to the word-figurative mark 'Biedronka Codziennie Niskie Ceny', arguing that the two marks are very similar. What is more, that entity claimed that the use of the mark 'Globi Codziennie Niskie Ceny' is parasitic in relation to the renown of the mark 'Biedronka Codziennie Niskie Ceny'. The entity which had obtained registration for the mark 'Globi Codziennie Niskie Ceny' defended itself by arguing that the two marks create a completely different impression and that it is not possible for any customer to associate the two. The Patent Office took the position that the marks are not similar, emphasizing that the use of the same slogan cannot determine the assessment of the two marks, and that the elements 'Globi' and 'Biedronka' sufficiently distinguish the marks from each other. However, in a ruling of 7 March 2012, the Provincial Administrative Court overturned the Patent Office's decision,



criticizing the hasty evaluation of the lack of similarity. The Court emphasized that a mark should be assessed as a whole, and not – as the Patent Office did – by concentrating solely on differences. The Court ordered consideration of such issues as the planned spatial usage of the two marks. The Patent Office had not fully considered the graphic aspect of the mark, nor had it sufficiently addressed the phonetic aspect.

This story proves that the opposition procedure, though formally simple, opens a whole range of complicated considerations involving the similarity of signs, goods and services, and of the risk of confusion. What may at first glance seem similar can turn out to be dissimilar in the meaning of the Industrial Property Law. In many cases, the positions of renowned academics on how to interpret the individual conditions for refusing to grant registration diverge widely. In the field of trade mark law, we are confronted with large doses of discretion and subjective evaluation. That is why, in order to raise an effective opposition, it is worth being well acquainted with this extensive subject – both in theory and in practice. ■

The logo for K&L GATES, featuring the text "K&L GATES" in white, uppercase, sans-serif font centered within a dark red rectangular background.

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Information on the activities of the K&L Gates Warsaw intellectual property team

K&L Gates' intellectual property team consists of seven lawyers (including a patent attorney) who provide services to Polish and foreign clients on all aspects of their businesses.

We advise on protecting intellectual property rights, including in litigation, customs protection proceedings, and penal proceedings concerning piracy and other exclusive rights infringements. We prepare applications and submissions to the Polish Patent Office and the Office for Harmonization in the Internal Market on registering trade marks, and we represent clients in dispute proceedings. We also focus on various issues relating to unfair competitions and conflicts between designations.

We have extensive experience in preparing agreements concerning copyright and media concluded between business entities, including licensing, publication, distribution and dubbing agreements, as well as agreements concerning film and television production.

We deal with the regulations covering new technologies, personal data protection and issues relating to the protection of business secrets and advertising law.

Our intellectual property experience is wide and varied. We represent clients before both the civil and criminal courts, as well as before public authorities and the administrative courts.

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