

# Striving for definition

## Polish law does not set out regulations for famous trademarks, but protection is nonetheless available

The protection of well-known and famous marks in Poland is guaranteed by the Industrial Property Law (June 30 2000), as well as the Unfair Competition Law (April 16 1993).

Polish law does not set out regulations for famous trademarks, leaving this as a purely academic term. 'Famous trademarks' are defined as trademarks that both have a reputation and are well known. They are considered to be more widely recognised and more attractive to the public than marks that merely have a reputation.

The notion of 'reputation' is not defined in Polish law. According to case law, a trademark's reputation is associated with established opinion among customers about the characteristics of the goods bearing the mark or the services provided thereunder. Thus, reputation is not only a simple consequence of a trademark's use and circulation, but also a well-established and deeply rooted image in the consciousness of the relevant consumers. It comes about as a result of the rights holder both maintaining the quality of the goods sold under the mark and consistently presenting the mark on the market through long-term, intensive advertising.

Determining whether a trademark has obtained a reputation should involve consideration not only of how well known it is among potential customers, but also of the circumstances of each individual case, focusing on the following factors:

- participation in the market (with regard to both the quantity and value of the sale of goods), and the scope and duration of advertising under the mark;
- the territorial extent and duration of the mark's use;
- licences granted for the mark's use and the quality of goods sold under it;
- the value of the trademark, as assessed by independent financial institutions;

- the amount spent on promoting the mark;
- the relation in price between the goods covered by the mark and substitute goods; and
- whether and to what extent the mark is used by third parties.

Judicial decisions have established that in order for a mark to have a reputation, it must be known to a significant part of the relevant public – its target customers. However, there is no definition of 'a significant part' in case law. Thus, each case must be evaluated individually.

Polish case law also fails to define a 'well-known trademark'. Instead, a definition has been arrived at by the jurisprudence and relevant literature, according to which well-known trademarks are those that do not merely indicate their origin. Therefore, the acquisition of rights in well-known trademarks does not depend on registration – rather, the trademark must have become well known as a result of use. When evaluating whether a trademark has acquired well-known status, it is essential to establish whether it is recognised by more than half of the potential customers of the relevant goods and services. A trademark's notoriety is examined based on features other than the quality of the product – although this may be one of the criteria taken into consideration.

The main criteria for evaluating whether a trademark is well known are as follows:

- the duration of the trademark's use;
- the trademark's position on the market – its quantity, availability, means and range of distribution; and
- the trademark's distinctiveness.

The relevant population in determining a mark's knowledge, recognition or fame is the public affected by the trademark

(ie, either the public at large or a more specialised sector of the public, depending on the goods or services being marketed). If the goods or services designated by the mark have a specific application or are exclusively designed for professional use, the relevant public is limited to the specific purchasers.

In this respect the Polish courts and the Patent Office should follow the criteria set out in the European Court of Justice's verdicts in *El Cortes Ingles* (T420/03) and *General Motors* (C-375/97) – that is, the relevant public for the determining the recognition or fame of a mark is the public affected by that trademark.

However, in a recent Polish administrative case which considered the harm done to the reputation of the TIFFANY mark (II GSK 522/10), the Supreme Administrative Court stressed that the well-known character of a trademark should be assessed with respect to the public relevant from the perspective of the attacked trademark.

Protection of well-known registered trademarks is provided under Article 132.2.3 of the Industrial Property Law, according to which: "a right of protection for a trademark shall not be granted if the trademark is identical or similar to a trademark registered earlier or applied for registration with an earlier priority date (provided that the latter is subsequently registered) on behalf of another party for any kind of goods, if it without due cause would bring unfair advantage to the applicant or be detrimental to the distinctive character or the repute of the earlier trademark." This provision shall apply accordingly to unregistered trademarks which have become well known.

Protection against dilution of a trademark can also be sought under Articles 3 and 10 of the Unfair Competition Law. Pursuant to Article 3, "the act of

unfair competition shall be the activity contrary to the law or good practices which threatens or infringes the interest of another entrepreneur or customer". Where the infringer's activity is likely to mislead potential customers as to the origin or quality of goods, Article 10 can be applied: "such indication of products or services or its lack, which may mislead customers in relation to the origin, quantity, quality, components, manufacturing process, usefulness, possible application, repair, maintenance and another significant features of products or services, as well as concealing the risks connected with their use, shall be the act of unfair competition."

The protection of well-known trademarks is provided for under Article 132.1.2 of the Industrial Property Law, according to which "a right of protection shall not be granted for a trademark in respect of identical or similar goods, if the trademark is identical or similar to a trademark which, before the date according to which priority to obtain a right of protection is determined, has been well-known and used as a trademark in respect of the goods of another party".

Well-known trademarks may also be protected in Poland under the Paris Convention (Article 6bis) and the Unfair Competition Law, according to which, in some cases, the holder of an unregistered trademark can prevent third parties from using later marks on the market, provided that the earlier unregistered mark has been used in the course of trade. Important factors that need to be taken into consideration in this regard are the duration of use and whether the sign was used as a trademark.

Well-known marks enjoy broader protection in Poland than ordinary marks. They are protected not only against the risk of confusion among customers, but also against the risk of dilution and further parasitic use. Pursuant to Article 296(2)(iii) of the Industrial Property Law, "infringement of the right of protection to a trademark consists in unlawful use in the course of trade of a trademark identical or similar to a reputed trademark registered for any kind of goods, if such use without due cause would bring unfair advantage to the user or be detrimental to the distinctive character or the repute of the earlier trademark". Protection against parasitic use and dilution of the mark is also afforded beyond the similarity of goods. It concerns any kind of goods, irrespective of the factual scope of registration and use of the well-known mark. However, if two conflicting marks are destined for different kinds of



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goods, it is necessary to provide evidence of parasitic use of the reputation of the earlier mark or its dilution by the later mark.

The owner of an earlier well-known or reputed mark can file its remarks (so-called 'observations') with the Polish Patent Office against granting protection to the later mark. However, observations are regarded only as supplementary material by the examiner reviewing the application. If such a mark proceeds to registration despite the observations, it is possible to file a formal opposition against granting the right of protection thereto. According to Article 246(1) of the Industrial Property Law: "Within six months of the publication in the Official Journal of the Polish Patent Office of the mention of the grant of protection,

any person can give a reasoned notice of opposition against a valid decision of the Patent Office on the grant of the right of protection". Based on Article 296(1) of the Industrial Property Law, it is possible to demand the cessation of use of the later trademark. Accordingly, "any person whose right of protection to a trademark has been infringed, or any person enjoying the same status under the quoted Law, can demand the cessation of infringement, the surrender of unlawfully obtained profits, or – if infringement is intentional – the redress of its consequences". Cases involving trademark infringement are examined in civil proceedings before common courts in accordance with these general principles.

Due to their special character, reputed marks enjoy broader protection than ordinary marks. Trademarks that have obtained a reputation are perceived by customers as a proof of high quality, exceptionality and luxury. The high value of reputed marks makes them vulnerable to illegal use by unauthorised parties. Using the renown of another's party's trademark allows a user to promote its own goods or services without bearing the necessary costs. The infringement of a well-known mark may consist, for example, of the dilution of its reputation. Dilution may have two forms: loss of individuality of the mark (ie, dilution by blurring) or depreciation of the mark's reputation (dilution by tarnishing).

The owner of a well-known or reputed mark can oppose the registration or use of a later mark irrespective of whether it is destined for similar or dissimilar goods. However, in order to oppose a trademark destined for dissimilar goods, it is necessary for the rights holder not only to prove the reputation of its own mark, but also to file evidence of the parasitic use or dilution. The owner of an earlier mark can enforce its claims in litigation before the Patent Office, as well as in civil and criminal proceedings before the courts. [WTR](#)