

The high standing of unregistered trademarks

In Poland, unregistered trademarks are categorised as 'well known' and afforded exclusive rights

All trademarks that are used in economic activity may be grouped into certain categories. This article focuses on registered trademarks (ie, those which have been granted protection by a decision of the Patent Office) and trademarks which have not been registered (ie, no official decision on granting protection has been issued), but which enjoy similar protection. These trademarks are categorised as 'well-known' trademarks, which are afforded exclusive rights regardless of registration. There is no uniform definition of a 'commonly known' or 'well-known' trademark under Polish, European or international legislation. In order to decide whether a mark is already well known, it is necessary to refer to academic law, judicial decisions and the practice of relevant state authorities.

Evaluation of 'well-known' status

Regulations regarding well-known (or commonly known) trademarks have not been unified across the European Union. Therefore, practice in this respect may differ in each member state. Although it is generally assumed that a well-known trademark is guaranteed protection with regard to not only similar or identical goods or services, but also completely different goods or services, a French court permitted the use of the COCA-COLA trademark on t-shirts, even though the mark is commonly regarded as well known. It was also in France that the Ritz Hotel was denied protection of its name in a case in which the hotel attempted to oppose the use of the designation 'Charles of the Ritz' for the marketing of cosmetics and clothes. On the other hand, in the United Kingdom, it was decided that the trademark LEGO could not be used for garden hoses, even though garden hoses are completely different goods from the plastic toys that are produced

under the LEGO mark.

The term 'commonly known' first appeared in Article 6*bis* of the Paris Convention and the complementary Article 12.2 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). In order to establish whether a mark is well known, it is necessary to take into consideration how well known it is among customers, including the extent to which it is well known as a result of promotion. In 1999 the World Intellectual Property Organisation (WIPO) issued a recommendation regarding the protection of well-known trademarks, which attempted to specify the criteria for evaluating whether a mark is already well known. According to WIPO's recommendation, in order to decide whether a mark is well known, the competent authorities must take into consideration the circumstances in which the mark is used, in particular:

- the extent to which it is known in relevant customer circles;
- the time, range and territorial extension of trademark use;
- the time, range and territorial extension of trademark promotion;
- the duration and territorial extension of trademark protection;
- the extent of inherent and acquired distinctiveness;
- the kind of goods and their distribution channels; and
- how well the goods are associated with the mark.

Priority date for obtaining right of protection

According to Article 132.1.2 of the Polish Industrial Property Law, a right of protection will not be granted to a trademark in respect of similar or identical goods if the trademark is similar or identical

to a trademark which, before determination of the priority date for obtaining a right of protection, has been used as a trademark and is regarded as well known in respect of another party's goods. However, this article does not apply in cases where a trademark is commonly known (ie, a notorious trademark) and has been used for goods originating from the applicant itself.

Article 132.1.2 of the Industrial Property Law provides general provisions on common knowledge of marks before the priority date for obtaining the right of protection. The term 'common knowledge of a trademark' suggests that a trademark is known to the majority of customers (ie, more than 50%). If a trademark is known to less than 50% of its potential customers, it cannot be regarded as commonly known.

In practice, it is essential to determine the threshold of knowledge among customers that a trademark must reach in order for it to be considered well known. Only potential customers of the goods or services under the mark in question should be taken into consideration.

Territorial extension

Another question to be clarified concerns territorial extension, which is necessary for a trademark to achieve or maintain well-known status. In particular, it is important to address whether a trademark which is well known internationally may prevent similar or identical registrations in Poland, or whether perhaps common knowledge of a trademark in any country that is a signatory to the Paris Convention or in any EU member state is sufficient to prevent such registration. First, it should be noted that Article 4.2d of the EU Trademarks Directive (2008/95/EC) makes reference to Article 6*bis* of the Paris Convention, which prohibits the registration of a trademark if

another trademark is commonly known in a given EU member state. Exclusion of a trademark from registration in Poland occurs when the mark cited as an obstacle is 'well known' within the meaning of Article 6*bis* of the Paris Convention.

It is also necessary to determine the required territorial extension within one EU member state for a trademark to be considered well known. Most often, a mark is regarded as well known if it is familiar to customers in the whole territory of a given EU member state.

However, a question arises regarding the status of a trademark if it is well known only in part of a country's territory. In the case of *Alfredo Nieto Nuno*, the European Court of Justice (ECJ) decided that "an earlier mark must be commonly known in the whole territory of a EU member state which is the country of registration, or in its predominant part". Taking into consideration the circumstances of the particular case, the competent authorities of the EU member state in question must evaluate whether the part of the territory in which the mark is known can be regarded as 'predominant'. Given the factual findings on which the ECJ based its decision, it may be argued that knowledge of a trademark in a big city and its neighbourhood or in the territory of one province does not qualify the trademark as commonly known in the whole of Poland. However, it seems that knowledge of the mark among customers in a number of provinces (eg, in the southern part of Poland) would fulfil the requirement for being commonly known in the predominant part of the country.

Common knowledge of a trademark in the whole of Poland or its significant part usually results from extensive and long-lasting use of a sign as a trademark in that territory. In practice, common knowledge of a mark is generated by introducing goods under that mark into the market and by advertising (eg, on television, radio or in the printed press). However, it cannot be ignored that Poland receives television advertising of products from abroad and popular films are shown in Poland that feature products that are unavailable on the Polish market. In other words, in exceptional cases a trademark can become well known in Poland even though the goods or services under that mark are unavailable on the Polish market. However, this is not the case in situations where a designation is known in Poland as, for example, the title of a film or a book. Such knowledge is irrelevant in light of Article 132.1.2 of the Industrial Property Law.



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National versus international legislation

Article 16.2 of TRIPs provides specific regulations for the above situation: "in determining whether a trademark is well known, Members [member states which are parties to TRIPs] shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark"

Article 16.2 grants protection to commonly known trademarks, irrespective of their use in connection with the introduction of goods onto the market in a given member state.

Therefore, it must be determined whether Article 132.1.2 of the Industrial Property Law is in contradiction of Article 16.2 of TRIPs, or whether perhaps there is an alternative interpretation that allows a legal norm to stipulate that use of a commonly known trademark is not conditioned by the application of Article 132.1.2.

In order to make the national legal norm (Article 132.1.2 of the Industrial Property Law) consistent with Article 16.2 of TRIPs, it should be assumed that the notion of using a mark according to Article 132.1.2 covers promotion of the mark which need not be accompanied by use of the mark on goods

or services. In practice, this standpoint means that if the holder of a commonly known mark is faced with a dispute before the Polish Patent Office over another party's similar or identical application, it must prove the necessary common knowledge of the mark; however, it is not obliged to provide evidence of use of the mark.

As a signatory to the Paris Convention, Poland is obliged to observe Article 6*bis*. In light of the provisions set forth under the convention, a commonly known trademark enjoys the same extent of protection in registration proceedings before the Patent Office, as well as in court proceedings that may result from infringement. If a trademark obtains the status of being well known, this will constitute an obstacle to the registration of an identical or similar mark for identical or similar goods (Article 132.1.2 of the Industrial Property Law and Article 8.1c of Resolution 40/49), and is a basis for refusal to grant exclusive rights in respect of any goods (Article 132.2 of the Industrial Property Law and Article 3.1c of Resolution 40/94). A well-known mark is protected against the risk of confusion and parasitic use to the same extent as marks with reputation (Article 301 in connection with Article 296.2 of the Industrial Property Law). These regulations are in keeping with international obligations under Article 6*bis* of the Paris Convention and TRIPs. [WTR](#)