

Exploring non-traditional trademarks in Poland

Despite the growth in use of non-traditional trademarks in Poland, there is still confusion over exactly what applications should contain in order to qualify for protection

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The Industrial Property Law, which came into force on 30th June 2000, is the most important piece of legislation governing trademark issues in Poland. Pursuant to the law, any sign that is capable of being represented graphically may be considered as a trademark, provided that it can distinguish the goods of one undertaking from those of another. In addition, the law sets out an open list of signs that may qualify for trademark protection. These include words, designs, ornaments, combinations of colours, three-dimensional (3D) shapes of goods or their packaging, as well as melodies or other acoustic signals.

To date, the majority of trademark applications filed with the Polish Patent Office have been for traditional marks (ie, word marks, design marks or word and design marks). However, technological developments have triggered the creation of a new category of trademark: non-traditional marks. These include 3D marks, sound marks, fragrance marks, textured marks, single colours or their combinations, and motion or positioned marks. While applications for the registration of such marks are still relatively rare, they are on the rise – especially for 3D marks.

3D trademarks

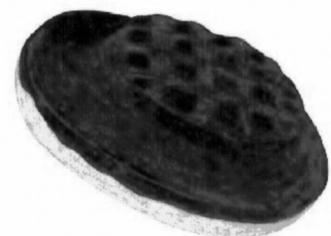
The Industrial Property Law expressly mentions 3D marks as an example of signs

that may qualify for trademark protection. The most common 3D marks in Poland are representations of the product itself or its containers. However, in the case of such marks it is important to remember that pursuant to Article 131.2.6 of the Industrial Property Law, “the right of protection shall not be granted for a sign if it constitutes a form or other feature of the goods or their packaging, is dictated exclusively by the nature of the goods, is necessary to achieve a technical result or gives substantial value to the goods”.

The Supreme Administrative Court commented on the registration of 3D marks in its judgment of 29th June 2005. The litigation concerned a 3D trademark for Delicje biscuits, which was in the form of a round cookie with a characteristic bulging top, as illustrated opposite.

A registration for this mark was granted for the marking of confectionery in Class 30. However, the Supreme Administrative Court upheld an earlier judgment of the District Administrative Court ruling that the subject trademark had no distinctive features within the meaning of Article 4 of the Trademarks Law of 31st January 1985, which was in force when the application for the mark was made. The Supreme Administrative Court confirmed that the mark was not capable of distinguishing goods of the same kind of one undertaking from those of other undertakings operating within the confectionery industry.

In the reasons for its judgment, the court argued that Article 4 should be interpreted in light of Article 3.1e of the First Trademarks Directive (89/104/EEC), which states that a sign consisting exclusively of a product’s form cannot be registered if it is proven that the form’s basic functional features are solely a result of technical properties. Therefore, Article



“ The right of protection shall not be granted for a sign if it constitutes a form or other feature of the goods or their packaging, is dictated exclusively by the nature of the goods, is necessary to achieve a technical result or gives substantial value to the goods ”

3.1e prevents signs such as that illustrated above from being granted protection in Poland. In its judgment the court stressed that this doctrine also makes it inadmissible to register as a trademark an element that determines the product's identity (eg, a product's form). Such registration would be contrary to the statutory definition of a trademark as an element that distinguishes the origin of the goods marked therewith.

The court's judgment also states that in order to qualify for trademark protection, “the form of a given product cannot be necessary to ensure its technical properties. The shape must differ from ordinary norms used in trade to the extent that the mark represents a form of a given product but does not exist by itself in that form; or else the mark must contain at least one added element that exceeds the product's customary shape determined by the technical requirements of its use”.

As regards the subject matter, the Supreme Administrative Court ruled that the trademark in question was nothing but a representation of a Jaffa Cake-type cookie (ie, a sponge biscuit topped with chocolate-coated jelly). Such biscuits are made not only by the rights holder, but also by the party filing the complaint and other participants to the proceedings. According to the court's judgment, all the mark's properties were determined by the product's functional features.

Single colours

Single colours may be registered as trademarks in Poland even though this is not directly stated in the Industrial Property Law. However, in order to obtain registration for a single colour, it is necessary to prove that it has acquired distinctiveness. This involves presenting

evidence that a given mark, before its application date, already conveyed information about the goods' origin.

The District Administrative Court commented on the registration of single colours as trademarks in its judgment of 31st October 2006; the case concerned an application to register the colour red for goods in Classes 6, 7, 8, 9 and 20. The court dismissed the applicant's complaint against the Patent Office's refusal to register the colour, arguing that although a colour *per se* can function as a trademark (so-called primary distinctiveness), in this instance the colour did not have sufficient distinctive features in relation to the goods covered by the application (ie, specific distinctiveness).

According to the court, the distinctiveness of a single colour should be interpreted in the light of public interest, and it is not in the public interest to limit the availability of colours unjustifiably to parties that offer goods or services of the same kind as those covered by the subject application. Such an interpretation is consistent with decisions issued by the Court of Justice of the European Union (ECJ).

The District Administrative Court also stated that the trademark application for the colour red was not sufficiently distinctive, as it had no features that would remain in customers' memories and allow them to distinguish a given product from other products of the same kind originating from other undertakings.

The court also shared the Patent Office's view that the applicant presented insufficient evidence that the subject mark had acquired distinctiveness. The applicant did prove long-time use of the mark over 30 years. However, while this is an essential and necessary criterion for proving acquired distinctiveness, it is not the only one that must be met and by itself it is insufficient.

The court was given no evidence to show the results of an opinion poll conducted among customers by a specialised independent firm using scientific methods. Nor was it presented with evidence of advertising in mass media or information regarding the amount of goods bearing the mark in question on the market – according to the court, this can be a useful indication for assessing whether a mark has acquired distinctiveness.

Another essential issue was also raised in the discussion: whether a trademark can acquire distinctiveness if it is also used by other producers. The District Administrative Court referred to a judgment issued by the Supreme Administrative Court on 8th November 2002, in which it indicated that a trademark cannot acquire distinctiveness if it is not identified with the goods originating from a particular undertaking. Such identification, as set out by the Supreme Administrative Court, is not generally possible if a trademark is used by different producers.

In view of this, the District Administrative Court decided that it would be difficult for a trademark in the form of the colour red to acquire distinctiveness through its use in a situation where different undertakings used that colour to market goods that were identical or similar to those covered by the subject application.

Combinations of colours

Combinations of colours are expressly mentioned under the Industrial Property Law as an example of signs that may be qualify for trademark protection. In order to obtain registration for these types of trademark, it is not necessary to prove acquired only distinctiveness – it is necessary to present the mark in a definite and uniform way.

An ambiguous representation of a trademark comprising two colours was given as the reason for refusing to extend protection to International Registration IR-667827 to Poland. The Supreme Administrative Court shared the view taken by the lower court that the subject trademark was not distinctive because of the way in which it was represented. The Supreme Administrative Court ruled that the description of the mark was not sufficiently precise as it failed to contain any information about the line separating the colour white from the colour orange. In addition, the description did not specify the proportion of these two colours. A trademark that is insufficiently described and does not appear in one consistent form is not capable

of developing and enhancing an association among customers relating to the origin of goods from one particular undertaking, as a result of which it lacks distinctiveness.

In justifying its decision, the Supreme Administrative Court referred to judicial decisions of the ECJ, including a decision of 24th June 2004 in the case of *Heidelberger* (Case C-49/02), in which the ECJ confirmed that a single colour or a combination of colours may constitute a trademark if the application presents this as a planned composition of colours combined in a predetermined and uniform manner. The ECJ maintained that this requirement cannot be met by a simple combination of two or more colours without form or contours, or a combination of colours in any possible form. Such an imprecise representation allows for numerous different combinations, which prevent customers from recognising and remembering the mark and may result in them being misled into repeatedly buying a product from the same undertaking.

Pictured opposite are some examples of colour trademarks which have been granted protection by the Patent Office.

Motion trademarks

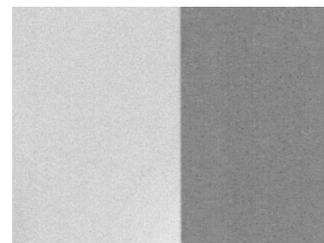
To date, the Patent Office has not granted protection for any motion trademarks. Applications for such marks are rare and practice in this field is still being developed.

On 17th August 2006 the Patent Office issued a decision on the motion trademark presented opposite.

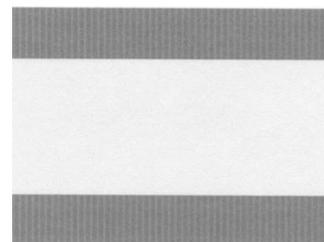
Registration was applied for pharmaceutical and sanitary products, and dietetic substances for medical use in Class 05. According to the applicant’s description, the mark represented a wave, which changed colour from red to green in a continuous manner within eight seconds.

The Patent Office refused to grant protection to the mark, arguing that it could not be regarded as a trademark within the meaning of the Industrial Property Law.

The applicant’s representative filed a request for re-examination. However, after re-examination, the Patent Office upheld its earlier decision to refuse protection. In setting out its reasons, it referred to the ECJ’s decision in Case C-283/01, 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. This representation must be clear, precise, compact, easily accessible, understandable, permanent and objective.



Reg 201666; goods in Class 30



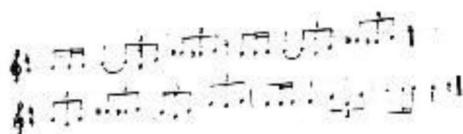
Reg 184568; goods in Classes 29, 30 and 31



Reg 178645; goods in Class 30



Motion trademark



Reg 82258



Reg 137502



Reg 143540



Reg 150427

According to the Patent Office, the way that the mark was represented graphically had a crucial impact on its decision. One objection raised against the application was that it failed to fulfil the requirement of uniformity within the meaning of Article 138.2 of the Industrial Property Law, which provides that: “One and the same application may relate to one trademark only. In the case of colour trademarks, a sign that incorporates one arrangement of colours shall be considered one trademark.” According to the office, the application was for a colour mark in which three colours were mentioned: green, yellow and red. Therefore, *de facto*, these were three different designations.

Moreover, the Patent Office found that only a cognitive uniform object is capable of being distinctive. The subject 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

So far, the Patent Office has registered only a few sound marks, all of which have been represented graphically using musical notation. When filing an application to

register a sound mark in Poland, applicants must provide the following:

- A graphic representation of the mark that would enable it to be reproduced.
- Two copies of a tape, or some other carrier, with a recording of the subject sound.
- A description of the mark (the manner of how it should be perceived).

Pictured opposite are some presentations of registered sound marks.

Conclusion

Continuous technological developments force entrepreneurs to seek novel and original ways of distinguishing their goods and services on the market. Non-traditional trademarks have become a valuable marketing tool. Even marks that have failed to qualify for protection can function in customers' minds as an indication of the source of origin of goods.

So far, the Patent Office's practice with regard to non-traditional marks has been relatively erratic. However, there is hope that within the next few years, clear and precise criteria will be established for non-traditional trademarks in order for them to qualify for protection in Poland. **iam**



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