

# USE OF A TRADE MARK IN A FORM DIFFERING FROM THE ONE REGISTERED

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# AGENDA

- Legal frames
- Use of the trade mark
- Genuine use
- Identity
- Modification
- Polish case law

# LEGAL FRAMES

- Paris Convention for the Protection of Industrial Property of March 20, 1883,
- Agreement on Trade-Related Aspects of Intellectual Property Rights, TRIPS
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks;
- Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 of December 2016 amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version)
- Act of 30 June 2000 – Industrial Property Law (OJ 2013.1410 dated 29 November 2013, as amended)

# USE OF THE TRADE MARK AS A RIGHT AND OBLIGATION

- Use of trade mark is an exclusive right arising from registration
- right to use the trademark without the time limit (due to renewal)

under the condition that the trademark is used :

- genuine
- to define the origin of goods or services
- in connection with the registered goods and services
- **in the form as it was registered or slightly amended**
- on the defined territory



# USE OF THE TRADE MARK AS A RIGHT AND OBLIGATION

The use of the trade mark:

- is crucial to save the trademark before the cancellation due to non-use
- has an impact on fighting with the trademark infringements
- elimination and lack of protection for a trademark which has not been used

# GENUINE USE OF TRADE MARK

The use must be:

- consistent with the essential function of a trademark, i.e. to guarantee the **identity of the origin** of the goods or services and to **distinguish the goods or services** from others which have another origin
- **actual** use of the mark.
- by way of **real commercial exploitation** of the mark on the market for the relevant goods or services
- quantitative terms

# THE IDENTITY OF THE TRADE MARKS

- the signs should be identical and no elements should be added or taken away
- reasonably, well-informed consumer who compares the trade marks from memory
- differences so insignificant that they may go unnoticed by an average consumer

# IDENTITY OF TRADEMARKS

## IDENTICAL

Earlier Mark	Contested mark	Ref. No.
Apetito	APETITO	T-129/09
IDRIVE	iDrive	T-105/14

## NOT IDENTICAL

Earlier Mark	Contested mark	Ref. No.
NOVALLOY	NOVALOY	B 29 290
HERBO FARMA	HERBOFARM	R 1752/2010-1
	IHOTEL	T-277/11



# MODIFICATION OF THE TRADE MARKS BY ADDITION OR OMISSION

Shall have no impact if amendments:

- refer to negligible elements, are not distinctive, are weak, do not alter the distinctive character of the registered trade mark
- are insignificant
- refer to generic indication of the product and descriptive terms
- are the addition of the 'type of enterprise'

# EXAMPLES FROM POLISH CASE LAW

## Registered trade mark

Ava (word) R.088238



Ava (fig.) R.088239

**Ava Mustela** (word) R.092013 (contested)

## Used trademark



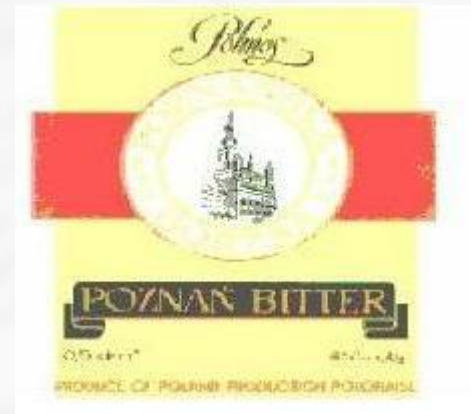
Mustela

II SA 4086/03 WSA in Warsaw 04.11.2004

# EXAMPLES FROM POLISH CASE LAW

## Registered trade mark

**Poznańska Gorzka R.86960 (contested)**



## Used trademark

II SA 1885/02 WSA in Warsaw 15.04.2004



# EXAMPLES FROM POLISH CASE LAW

## Registered trade mark

**Dziecko (word) R. 95197(contested)**

Twoje dziecko (word) R.70170

## Used trademark

Twoje Dziecko

VI SA/Wa 2320/05 WSA in Warsaw 17.03.2005

II GSK 190/06 NSA



# EXAMPLES FROM POLISH CASE LAW

## Registered trade mark

**Radio 73,2 Eska** R.98909 (contested)



## Used trademark

Eska

Eska Nord

Eska Trójmiasto

VI SA/Wa 1749/05 WSA in Warsaw 07.02.2006

II GSK 173/06 NSA 10.10.2006



# EXAMPLES FROM POLISH CASE LAW

## Registered trade mark

**NAOMI** IR.614636 (contested)  
NAOMI CAMPBELL IR.706887

## Used trademark

NAOMI CAMPBELL

VI SA/Wa 937/05 WSA in Warsaw 12.10.2006  
II GSK 70/06 NSA 24.105.2006



# POLISH CASE LAW EXAMPLES

## Registered trade mark



## Used trademark



District Court in Warsaw 28.02.2011 r. Ref. no. XX GC 499/10

# THANK YOU FOR YOUR ATTENTION



# CONTACT



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