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**Trademark protection system
from the perspective of international law and the law of the European
Community**

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Introduction

The history of man is a history of his needs being satisfied. The task is endless since satisfaction of some of them gives rise to the next ones, reaching farther. Such situation is forcing perfection of the ways of gaining control over the external world. And so, the man has been forced to design an "invention" being a condition for unlimited access to material goods, and then to develop the way of marking it which would indicate that a given commodity originates with a specific producer. Already in the nineteenth century, the practice of international trade engendered the need for the protection of the same trademark to be quickly obtained in many countries.

Currently, we can say that the protection of trademarks may be of international nature (based on international agreements), Community (based on *acquis communautaire*) and national (based on national law).

The subject of this study is examination of currently (i.e. in July 2011) applicable regulations concerning trademarks on the level of international law and the law of the European Union. The study consists of three chapters. In chapter one, an attempt at defining a trademark and possibilities of presenting the mark have been discussed.

Chapter two describes the sources of trademark protection in international law. The Paris Convention for the Protection of Industrial Property of March 20, 1883¹ is the oldest and still the most important instrument of international law in the area of industrial property. However, the authors of the Paris Convention did not mean it as the only instrument of international law relating to the issue in question. In the original text, the authors of the Convention provided for a possibility of entering into international agreements between parties to the Convention and established the relation of those agreements to the provisions of the Convention. A further part of this chapter contains an analysis of special agreements in the area of the trademark law, important from the viewpoint of the issues discussed.

Chapter three of this study describes the trademark regulations in the Community law. As regards the original law, one should point out article 36 of the Treaty on the Functioning of the European Union² which includes "*the protection of industrial and commercial property*" as a basis for an exception to the principle of the free movement

¹ The Paris Convention for the Protection of Industrial Property, signed in Paris, France, on March 20, 1883, Journal of Laws of 1975, No. 9, item 51; http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html; hereinafter: *The Paris Convention*;

² OJ EU. 2010 C No. 83, p. 7.; hereinafter: TFEU

of goods. The term "*industrial and commercial property*" applies to all industrial or intellectual property rights, including trademarks.

In respect of the derivative law, this study contains a discussion on both legal solutions applied in the directive enacted by the European Parliament and the Council on October 22, 2008 to approximate the laws of the Member States relating to trademarks³, and the Regulation No. 207/2009 on the Community trademark⁴ adopted by the Council.

This study discusses a lot of regulations. Some of them have been discussed in detail, while the other have only been mentioned. The complexity and multidimensional nature of the issues involving trademarks are the reasons why, in order that a product could have the best protection possible and the whole undertaking could produce positive and anticipated results, many aspects should be taken into consideration since the protection of trademarks may not be limited to a certain pattern.

³ Directive 2008/95/EC of the European Parliament and the Council of October 22 2008 to approximate the laws of the Member States, OJ EU L 2008 No. 299, p. 25; earlier Directive No. 104/89; hereinafter: Directive 2008/95/EC

⁴ Council Regulation No. 207/2009 of February 26, 2009 on the Community Trademark, OJ EU L 2009 No. 78, p. 1; earlier Regulation No. 40/94; hereinafter: Regulation No. 207/2009.

I. Definition of a trademark

A trademark is a distinctive sign or indicator used by an individual, business organization, or other legal entity to identify that the products or services to consumers with which the trademark appears originate from a unique source, and to distinguish its products or services from those of other entities⁵.

A trademark is typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements. There is also a range of non-conventional trademarks comprising marks which do not fall into these standard categories, such as those based on colour, smell, or sound⁶.

The owner of a registered trademark may commence legal proceedings for trademark infringement to prevent unauthorized use of that trademark. However, registration is not required. The owner of a common law trademark may also file suit, but an unregistered mark may be protectable only within the geographical area within which it has been used or in geographical areas into which it may be reasonably expected to expand⁷.

Terms such as *"mark"*, *"brand"* and *"logo"* are sometimes used interchangeably with *"trademark"*. *"Trademark"*, however, also includes any device, brand, label, name, signature, word, letter, numerical, shape of goods, packaging, colour or combination of colours, smell, sound, movement or any combination thereof which is capable of distinguishing goods and services of one business from those of others. It must be capable of graphical representation and must be applied to goods or services for which it is registered.

Specialized types of trademark include certification marks, collective trademarks and defensive trademarks. A trademark which is popularly used to describe a product or service (rather than to distinguish the product or services from those of third parties) is sometimes known as a genericized trademark. If such a mark becomes synonymous with that product or service to the extent that the trademark owner can no longer enforce its proprietary rights, the mark becomes generic.

⁵ Terminology: the styling of trademark as a single word is predominantly used in the United States and Philippines only, while the two-word styling trade mark is used in many other countries around the world, including the European Union and Commonwealth and ex-Commonwealth jurisdictions (although Canada officially uses trade-mark pursuant to the Trade-mark Act, trade mark and trademark are also commonly used).

⁶ P. Podrecki „Środki ochrony praw własności intelektualnej”, Warszawa 2010, s. 94.

⁷ E. Nowińska, U. Promińska, M. du Vall, „Prawo własności przemysłowej. Przepisy i omówienie”, Warszawa 2003, s. 183.

A trademark may be designated by the following symbols:

- TM for an unregistered trade mark, that is, a mark used to promote or brand goods,
- SM for an unregistered service mark, that is, a mark used to promote or brand services,
- ® for a registered trademark.

The marks used in business activities can be divided according to many criteria. Depending on the entity using a mark, we can distinguish:

- trade marks (used by manufacturers);
- service marks (used by entities rendering services);
- trade names (used by sellers)

If we establish the scope of trademark protection as a criterion for the division, it can be assumed that there are three basic groups of marks functioning in the economy:

- ordinary;
- well-known (including famous) and
- protected under registration procedure⁸.

The essential function of a trademark is to exclusively identify the commercial source or origin of products or services, such that a trademark, properly called, indicates source or serves as a badge of origin. In other words, trademarks serve to identify a particular business as the source of goods or services. The use of a trademark in this way is known as trademark use. Certain exclusive rights attach to a registered mark, which can be enforced by way of an action for trademark infringement, while unregistered trademark rights may be enforced pursuant to the common law tort of passing off⁹.

It should be noted that trademark rights generally arise out of the use or to maintain exclusive rights over that sign in relation to certain products or services, assuming there are no other trademark objections.

⁸ W. Kotarba „Ochrona znaku towarowego w przedsiębiorstwie”,
http://www.zti.com.pl/instytut/pp/referaty/ref7_full.html.

⁹ T. Szymanek, Prawo własności przemysłowej, podręcznik akademicki, Warszawa 2008, str. 153.

II. Trademarks regulations in international law

International regulations on the protection of industrial property are contained in the Paris Convention. That document regulates on international level legal relations regarding objects of industrial property, i.e. inventions, utility designs, trade names, geographic origin marks, repression of unfair competition, as well as trademarks.

Pursuant to article 19 of the Paris Convention, the following are, inter alia, special agreements in the area of trademarks: the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891¹⁰, as revised by the protocol at Stockholm on 14 July 1967¹¹ and the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957¹². However, the Agreement on Trade-Related Aspects of Intellectual Property of April 15, 1994¹³ is not such special agreement. A distinctive feature of TRIPS is its equal status with the Paris Convention. As it appears from the content of that agreement and current practice, the provisions thereof are at present of increasingly great importance in the area of trademark protection.

1. The Paris Convention

1.1. General issues

The Paris Convention established a Union for the protection of industrial property. The Convention is still in force as of 2011. The Paris Convention is administered by the World Intellectual Property Organization (WIPO), based in Geneva, Switzerland.

According to articles 2 and 3 of this treaty, juristic and natural persons who are either national of or domiciled in a state party to the Convention shall, as regards the protection of industrial property, enjoy in all the other countries of the Union, the advantages that their respective laws grant to nationals.

¹⁰ The Madrid Agreement Concerning the International Registration of Marks of April 14, 1891; hereinafter referred to as: The Madrid Agreement.

¹¹ Protocol of 14 July 1967 relating to the Madrid Agreement; hereinafter referred to as: the Protocol relating to the Madrid Agreement.

¹² The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957; hereinafter referred to as: The Nice Agreement.

¹³ The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) is an international agreement administered by the World Trade Organization that sets down minimum standards for many forms of intellectual property regulation as applied to nationals of other WTO Members; hereinafter referred to as: TRIPS.

In other words, when an applicant files an application for a patent or a trademark in a foreign country member of the Union, the application receives the same treatment as if it came from a national of this foreign country. Furthermore, if the intellectual property right is granted (e.g. if the applicant becomes owner of a patent or of a registered trademark), the owner benefits from the same protection and the same legal remedy against any infringement as if the owner was a national owner of this right.

Moreover, the Paris Convention exhaustively defines the **status of collective trademarks**. The subject of rights to a collective trademark may be an association whose existence is not contrary to the law of the country of origin¹⁴. For an association to be recognized as the said beneficiary, it should not be important that it is not established in the country where protection is sought or is not constituted according to the law of the latter country¹⁵.

The Paris Convention does not contain full regulation of **transferability of the right to a trademark**. It allows for accessoriness of alienation in relation to the transfer of the business entitled to a mark. However, in this case it restricts dependence of effectiveness of the transfer of rights to a mark only on the need for a transferee to be granted exclusive rights to manufacture or sell products bearing the transferred mark in a given country where a production company or commercial establishment (or a portion thereof) is located together with which the right to a mark is being assigned. Such solution should be a sufficient protection against the risk of misleading customers about the origin, nature or essential qualities of the goods to which the mark is applied by using the mark subject to alienation. However, it may not be classified as a criterion for assessment of validity of the transfer of any mark the use of which could be viewed as being misleading¹⁶.

The provision quoted corresponds to the view about the absence of accessoriness of the right to a trademark in relation to a business. This means that disposition of the right to a mark is independent of the fortunes of a given business. On this account, the restriction that results from the principle of accessoriness is currently of no importance.

Moreover, a signatory State is not obligated to introduce the obligation to use a trademark into its internal law¹⁷. However, if it imposes such an obligation requirements of article 5 C section 1 of the Paris Convention should be met at the same time. A Member State is obligated to make the possibility of cancelling the registration or diminishing the protection granted to the mark by reason of the failure to use it

¹⁴ See article 7bis section 1 of the Paris Convention.

¹⁵ See article 7bis section 3 of the Paris Convention.

¹⁶ See article 6quarter of the Paris Convention.

¹⁷ See article 5 C sections 1 and 2 of the Paris Convention.

conditional upon the expiry of a reasonable period as well as to concede to the person concerned the possibility of conducting defence by justifying his inaction. It is allowable to meet the obligation to use a registered trademark by the use thereof in a different form. Such form of the mark may differ from the form registered in elements only which do not alter the distinctive character of the mark.¹⁸

The question of compulsory use of a mark is also raised by the provision of the Convention which stipulates that recognition of the right to protection may not be conditional upon¹⁹ any mention or indication being placed on the goods.

The Convention now has 173 contracting member countries, which makes it one of the most widely adopted treaties worldwide. Notably, Taiwan and Kuwait are not parties to the Convention. However, according to Article 27 of its Patent Act, Taiwan recognizes priority claims from contracting members. The Paris Convention entered into force in Thailand on August 2, 2008, bringing the total number of Nation States party to the Convention to 173.

1.2. Fundamental principles of the Convention

A fundamental principle of the Paris Convention is the principle of national standard also known as the principle of national treatment or assimilation²⁰. It means that the Countries who have ratified the Paris Convention are obligated, as regards the protection of industrial property, to grant to natural and juristic persons of another State party to the Paris Convention the same protection as they grant to their own entities.

The essential regulation is the introduction of **the principle of minimum protection** providing that Member States of the Paris Union are obligated to grant the minimum level of protection arising out of the Convention, otherwise eligible entities may directly invoke their rights under the Convention.

In accordance with the literature of the subject, entities entitled to effectively invoke provisions of the Convention establishing the minimum protection in a country are not nationals of a given country but entities of other member countries of the Paris Union²¹. Adoption of such a construction leads to the phenomenon of reverse discrimination, i.e. discrimination of own citizens and legal entities who may not directly invoke the aforementioned regulations. However, member countries of the Paris Union have made legislative efforts intended to remove discriminatory provisions.

¹⁸ See article 5 C sections 1 and 2 of the Paris Convention.

¹⁹ See article 5 D of the Paris Convention.

²⁰ See article 2 of the Paris Convention.

²¹ R. Skubisz, *Znaki towarowe w prawie międzynarodowym i prawie Unii Europejskiej*, SPP, 2010, Nr 1, str. 118.

Furthermore, it is worth noting that at the level of the European Union, ECJ modifies the principle of direct application of the provisions of the Convention indicating that the provisions of the Convention may not be directly applied by a Member State. However, this does not concern the situation when the community law *expressis verbis* points to a specific provision of the Convention²². Cases of literal reference have considerable significance in practice.

The Paris Convention adheres to the **territoriality principle of protection** to the full extent. The reason is that the laws of the country of the required protection stipulate conditions for providing protection for a given trademark, define content and extent of rights infringement as well as means of protection. The result of the territoriality principle is independence of obtaining and continuing to hold industrial property rights for the same intangible good in individual member countries of the Union²³. Therefore, invalidation or extinction of a right in one member country does not *per se* produce such an effect in other countries.

Among the more specific principles of the Paris Convention, one should point to the principle of **Convention priority right** consisting in granting the person who files an application for the registration of a trademark the right to cite the date of earlier filing of the same trademark in a signatory country of the Paris Convention, if any subsequent filing in one of the countries party to this Convention follows within 6 months of the date of the filing of that mark²⁴.

A trademark which has been duly registered in a signatory country may enjoy the **privilege of *telle-quelle* mark**. It is about the possibility of filing and protecting such mark, in the same form, in other signatory countries²⁵. Registration is a prerequisite condition for protection of the mark on *telle-quelle* basis. However, when seeking registration of the *telle-quelle* mark, the absence thereof is not an obstacle to the exercise of priority right to the mark in the country of origin if finally it is registered there if only after filing in another country.

The principle of protecting the proprietor of a trademark in a signatory country of the Paris Convention is of essential importance in practice in case of an attempt by his agent or representative to appropriate it in another country of the Paris Union. A condition for such protection is legitimization of a given person as the proprietor of the

²² ECJ judgment of 25.10.2007 in case C-238/06 P Develley, Collection of Judicial Decisions 2007, p. I-9375, points 40-43.

²³ See article 6 sections 1-3 of the Paris Convention.

²⁴ See article 6quinquies of the Paris Convention.

²⁵ See article 6quinquies of the Paris Convention.

right to the mark in one of the signatory countries. Such person is granted the right to a number of actions against his agent or representative who without his consent files in other signatory countries for protection of this mark or has already been granted such right.

2. Madrid Agreement

2.1. General issues

The Madrid Agreement Concerning the International Registration of Marks is one of the oldest multilateral agreements in the area of industrial property. The Madrid Agreement was aimed at alleviating difficulties that occurred in the course of registration of trademarks in many countries, simplifying the procedure and reducing the costs related to this procedure.

However, it was not the intention of the authors to create a uniform system of trademark protection at international level. Therefore, entry of a trademark in an international register is actually only a filing of that mark for protection. In order to acquire the right effective in countries covered by the application, it is necessary that a suitable confirmation should be given by relevant authorities of that country. As a result of recognition of effects of an international mark in signatory countries, the entitled person acquires a number of national protective rights.

2.2. Chief principles of the Madrid Agreement

Within the context of the Agreement, several principles can be singled out, including:

- **the principle of basic registration**, i.e. protection of a mark in states party to the Agreement on the basis of a single filing but based on national registration. The prerequisite for such protection is prior registration of that mark in one of state parties (country of origin) and only then filing thereof with the International Office through the agency of the office of the country of origin. The condition for protection in other states is to name them in the application filed with the international register²⁶;
- **the principle of national protection**, which means that international registration of a trademark provides the same protection as would result from the national registration thereof²⁷. Therefore, an international mark is subject to

²⁶ E. Waliszko, R. Golat „Znaki towarowe”, Bydgoszcz - Warszawa 2006, str. 37.

²⁷ See article 4 of the Madrid Agreement.

