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Intellectual Property - Poland

Will the Patent Office allow letters of consent again?

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Background

As the purpose of a trademark is to distinguish the goods of one business from those of another, distinctive character is an essential condition required for registration of a trademark.

Polish trademark law is aligned with EU law, in particular the EU Trademarks Directive (2008/95/EC). In registration proceedings, the Polish Patent Office (PPO) will examine *ex officio* whether a trademark filed for registration is identical or similar to earlier marks for the same or similar goods, or whether there is a risk of misleading the public, particularly with respect to an earlier trademark. If a conflict is found, the PPO will refuse to register the new trademark.

International trademark practice has developed letters of consent to overcome a *prima facie* conflict between trademarks. Despite the ban against registering confusingly similar or identical signs, the applicant may file a letter of consent indicating that the owner of the earlier mark consents to the use and registration of its mark. The PPO has accepted letters of consent in the past; however, a couple of years ago it changed its position and it now refuses to acknowledge them.

Existing law

Letters of consent are accepted under EU trademark law. Article 4(5) of the EU Trademarks Directive states that in appropriate circumstances, registration need not be refused or a trademark need not be declared invalid where the owner of the earlier mark or other earlier right consents to registration of the later trademark.

Currently, Polish law explicitly provides for the possibility of issuing a letter of consent only where the earlier trademark has expired and a further two-year period for registration of the same trademark has not elapsed.

Polish Patent Office practice

The position of the PPO with respect to letters of consent has changed. In the 1990s and for a couple of years thereafter, the PPO looked kindly on letters of consent, allowing businesses or organisational groups to register co-existing trademarks where they were identical or confusingly similar to other earlier trademarks. However, its practice in this regard subsequently changed.

In a series of administrative court rulings the PPO denied any binding effects of letters of consent. In particular, the administrative courts pointed out that:

- no provisions on the admission of consent or grounds for consent to be legally effective are set out in Polish law (December 20 2007, Case II GSK 279/07);
- letters of consent impose no obligation on the PPO to register a trademark (February 27 2008, Case VI SA/Wa 1548/07);
- letters of consent should not influence the registration decision where there is a risk of confusion on the part of consumers (July 20 2010, Case VI SA/Wa 600/10);
- letters of consent may eliminate the barrier to registration where the mark conflicts with another mark that has expired (July 20 2010, Case VI SA/Wa 600/10); and

- a close relationship of the companies cannot be the basis for the registration of very similar signs for various businesses (June 21 2010, Case VI SA/Wa 710/10).

The administrative courts have also clearly indicated that their position, and Polish trademark law, is in line with Article 4(5) of the EU Trademarks Directive, which provides only that member states may permit letters of consent.

Proposed legislative amendments

For almost two years a debate has been ongoing on amendments to the trademark provisions of the Industrial Property Law. One of the topics under discussion is the possibility to allow the owner of an earlier trademark to consent to registration of a new trademark under specific conditions, even though its earlier trademark has not yet expired.

One of the proposed ideas is to allow such consent where a coexistence agreement is executed. It is assumed that the coexistence agreement would eliminate the risk of confusion between the two trademarks. This means that the coexistence agreement should clearly identify, for example, the different customer bases of the two trademark owners, the different channels of distribution, the different ways of using the trademarks and so on. Both parties will be obliged to obey the coexistence rules.

Another idea under discussion is that consent may be granted if the two trademarks are not identical and there are commercial relationships between their owners.

Both exceptions under discussion are ambiguous - for instance, every agreement can be terminated at some point. Also, one can easily imagine that a commercial relationship may be terminated shortly after consent is submitted to the PPO. Additionally, the very term 'commercial relationship' appears to be vague. There is no clear indication of whether possible termination of the coexistence agreement or discontinuance of the commercial relationship (eg, due to a sale of shares) should trigger the possibility to invalidate the new trademark.

Comment

At present, letters of consent may be submitted to the PPO, but there is no real value in them as they are not binding on the PPO. If the proposed legislative amendments come into force, letters of consent will once again be accepted by the PPO, as long as some quite detailed statutory requirements are met.

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