

Intellectual Property - Poland

Trademark protection for shape of products and packaging

Contributed by **Sołtysiński Kawecki & Szlęzak**

May 11 2015

[Industrial Property Law](#)
[Patent Office decisions](#)
[Viewpoint of courts](#)
[Comment](#)

This update examines the trademark protection of a product's shape and packaging under Polish trademark law. The criteria that the Patent Office applies for the registration of marks that consist of a product's shape or packaging and the viewpoint of the courts concerning the scope of protection of such trademarks from infringement, are analysed below.

Industrial Property Law

The Industrial Property Law complies with the EU Trademarks Directive (2008/95/EC) and sets out that the shape of a product or its packaging may qualify for trademark protection if:

- it is capable of distinguishing the goods or services of one undertaking from those of another; and
- the shape is not excluded from trademark protection on the basis of an absolute grant of refusal.⁽¹⁾

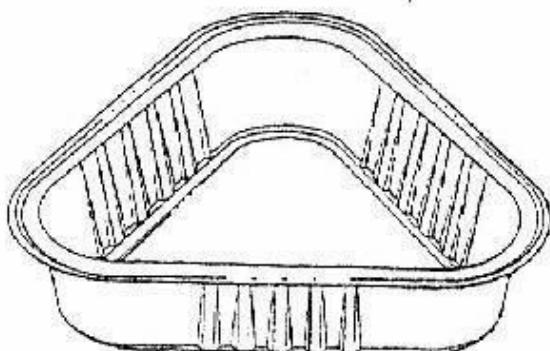
Pursuant to Article 120(2) of the Industrial Property Law, a trademark may be any mark that is capable of being represented graphically, if it is capable of distinguishing the goods or services of one undertaking from those of another. Article 131(2)(6) of the law provides that a sign can be registered as a trademark if it:

- does not exclusively result from the nature of the good itself;
- is not necessary to obtain a technical result; and
- does not give substantial value to the goods.

Under this European-harmonised trademark law, rules regarding signs which consist exclusively of shapes that are indispensable – for technical or other reasons – are in place to ensure that those signs can never obtain protection, as doing so would prevent others from competing in specific markets irrespective of the level of distinctiveness they may have acquired through use.

Patent Office decisions

Few Patent Office decisions have assessed the functional features of trademarks. Among its decisions, the Patent Office refused to register the following shapes of products on absolute grounds for refusal because of a functional feature:



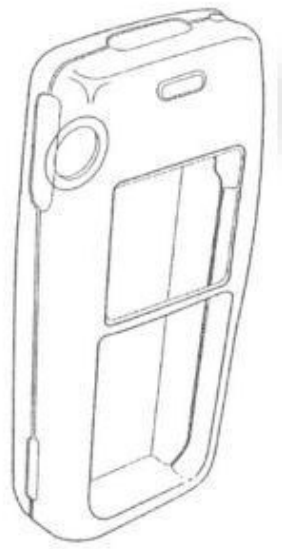
Authors

Szymon Gogulski



Agnieszka Szoldman





Z-308325 (Class 09)



Z- 364726 (Classes 11, 16)

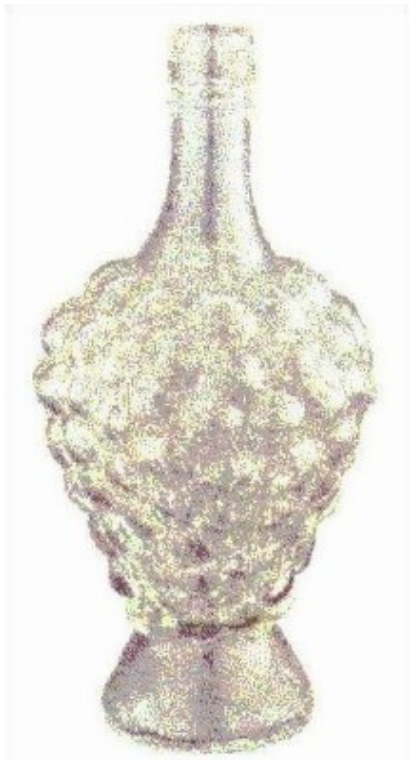


Z- 220995 (Class 32)

Conversely, the Patent Office registered the following product shapes and reasoned that there were no grounds to refuse them on the absolute ground of functionality or substantive value of a shape:



R-137173 (Class 12)



R-102131 (Class 33)



R-169658 (Class 33)

Viewpoint of courts

In its July 18 2014 judgment the Voivodeship Administrative Court in Warsaw dismissed Danone's appeal of the Patent Office's decision in which it refused to register the specific dual chamber package of Danone's Fantazja yogurt as a trademark. The court stated that the shape of the yogurt packaging was a technical feature and that the dual chamber package had functional significance. Further, the court stated that trademark registration in such a case would circumvent the limited time of patent protection, which is a means to protect technical features.⁽²⁾



IR-700040 (Classes 5, 29, 30 and 32)

In its September 23 2013 judgment the court concluded that the absolute grounds for refusal "exclusively result from the nature of the good itself", meaning that the shape is not separate from the sign *per se*. Further, the court observed that the absolute ground of functionality or substantive value of the shape applies only to three-dimensional (3D) trademarks, and not to other types of sign (eg, figurative or position marks).⁽³⁾

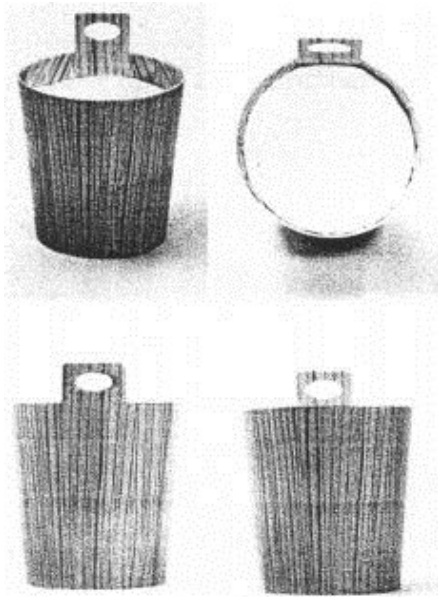
In its May 29 2005 judgment the Supreme Administrative Court observed as follows:

- The aim of the absolute grounds for refusal with respect to shape marks is to prevent a situation in which the protection conferred by trademark rights leads to the grant to a trademark holder of a trade monopoly on technical solutions or functional characteristics of goods that are sought by the consumer goods of competitors.
- Following the reasoning of the lower instance presented in the Voivodeship Administrative Court's October 18 2004 judgment,⁽⁴⁾ the registration of a 3D trademark for the shape of a biscuit could not be granted, as it would result in the monopolisation of the relevant biscuit's market by the trademark holder.⁽⁵⁾

Further, Polish jurisprudence elaborates on the permissible usage and scope of protection of 3D trademarks. In its January 21 2014 judgment the Court of Appeal ruled that:

- the absolute ground of functionality or substantive value of a shape must be interpreted in accordance with EU case law;
- the rationale behind the absolute ground of functionality or substantive value of a shape and packaging is in the general interest of free competition; and
- a sign cannot be registered as a trademark if both prerequisites are met (ie, a shape has technical features and its registration would obstruct the production and market use of similar technical features).⁽⁶⁾

In a controversial July 5 2012 judgment concerning infringement claims, the Supreme Court concluded that the holder of the following trademark could not prohibit other traders from using the mark:



IR-736770 (Class 29)



Holder's product



Alleged infringer's product

The Supreme Court indicated that a trademark monopoly does not confer a mere idea or its source; rather, it confers a concrete representation as presented in the form of a trademark. Therefore, presenting a figurative representation of a 3D trademark on packaging does not constitute trade use and thus the trademark was not infringed in this case.⁽⁷⁾

Comment

In trademark decisions that invoke functionality as a ground for refusal, features of technical necessity lead to the majority of rejections. In Poland, as in other EU member states, the courts and the Patent Office seem to be wary of far-reaching consequences and exercise caution when applying exclusion clauses. This approach has several practical implications:

- The authorities and courts apply a strict test when assessing the functionality of a shape;

- It is acknowledged that 3D trademarks require the same level of distinctiveness as other types of signs; and
- The scope of protection should be assessed in light of free competition, which means assessing the legitimate interests of other competitors when ruling on a trademark's capacity to be registered or the scope of protection from infringement.

For further information on this topic please contact [Szymon Gogulski](#) or [Agnieszka Sztoldman](#) at [Soltysiński Kawecki & Szlęzak](#) by telephone (+48 22 608 7000) or email (szymon.gogulski@skslegal.pl or agnieszka.sztoldman@skslegal.pl). The [Soltysiński Kawecki & Szlęzak](#) website can be accessed at www.skslegal.pl.

Endnotes

- (1) Articles 2 and 3 of the EU Trademark Directive (2008/95/EC).
- (2) Voivodeship Administrative Court, Warsaw, July 18 2014, VI SA/Wa 2897/13.
- (3) Voivodeship Administrative Court, Warsaw, September 23 2013, VI SA/Wa 473/13.
- (4) Voivodeship Administrative Court, Warsaw, October 18 2004, II SA 3199/03.
- (5) Supreme Administrative Court, May 29 2005, II GSK 92/05.
- (6) Warsaw Court of Appeal, January 21 2014, I ACa 1067/13.
- (7) Supreme Court, July 5 2012, IV CSK 23/12.

The materials contained on this website are for general information purposes only and are subject to the [disclaimer](#).

ILO is a premium online legal update service for major companies and law firms worldwide. In-house corporate counsel and other users of legal services, as well as law firm partners, qualify for a free subscription. Register at www.iloinfo.com.

Online Media Partners



© Copyright 1997-2015
Globe Business Publishing Ltd